

New Matter

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President's Letter



Greetings MIPLA Members!

We have officially turned the corner into 2008 and my year as President is more than half over.

This article provides me with an opportunity to both reflect on our accomplishments to date, and to plan for the activities and events we have remaining.

Our 2007-2008 year has had many successful events, and we are glad to see so many people coming out to enjoy the events that our Programs Committee, CLE Chair, and many committee chairs have worked so hard to put together. After the publication of our last New Matter, November included the Fall Social, held at the ever popular Chambers Hotel, and enjoyed a large crowd.

In December, the Law Revisions Committee held a CLE titled: In re Seagate – Practical Implications for Opinion Practice and Freedom to Operate Analyses. This event gave us all an opportunity to gain some CLE credits before the year came to an end.

In January, we kicked the year off right with a social at Fulbright & Jaworski that was the first Meet the Firms event and first MIPLA event of 2008. The Meet the Firms events were created by President Phil Goldman in 2002 and continue to be a popular event because they allow us an opportunity to socialize and network, provide opportunities for students to meet their future peers in a relaxed environment, and all us to see the facilities of the various firms around town.

MIPLA also co-sponsored an event with the MSBA International Business Law Section where presenter Jay Erstling discussed imminent changes in the PCT and European patent processes and what they mean to U.S. attorneys and their clients. This event gave us a unique perspective on world patent events.

As in the past, the Association has continued our tradition of funding scholarships at the various law schools to support students hoping for a career in IP and in supporting their IP moot court programs.

This year, we have revamped the way in which we give money to the schools for their Giles Rich Moot Court Programs. Instead of funding each school, we have worked with the schools to create a MIPLA Cup event that will be held each year just prior to the AIPLA Regional Rounds of the Giles Rich Competition.

In this way, all of our local teams will get a chance to hone their skills before attending the national competition and, hopefully, it will improve the performance of our Minnesota Law Schools in the National Competition. Not that their performance has been too shabby in the past. We have had several National Champions, Finalists, Regional Champions and Finalists, and many Best Brief and Best Oral Advocate Award Winners in the past ten years. The MIPLA Cup preparation should only make them better. We wish them luck in the Inaugural MIPLA Cup and AIPLA Competitions this coming March.

The Random Lunch Program offered every other month is going strong under its leadership by Board Member Dina Khaled. There are currently over 70 participants involved in the program and I am sure it will continue to grow. That is over 10% of our roughly 650 member association!

With respect to upcoming events, the Trademark and Unfair Competition Committee would like to kick off their 2008 activities with a lunchtime CLE presentation on February 14th. The topic is to be "Trademark Law Developments: Changes That Impact Registration and Enforcement." and will feature speakers Laura Borst and Patrick Gallagher of Fulbright & Jaworski. The Patent Agents Committee is also planning to host an event in February with details coming out shortly to their members.

We have a few more things up our sleeves for the rest of the year and we are hopeful that you stay involved in MIPLA as much as you can. See you at the next event and Happy New Year everyone!

Sincerely,

Jeff Cameron
2007-2008 MIPLA President

Upcoming Events



Save the dates! Mark your calendars so that you don't miss out on the following MIPLA Events:

Authors and Inventors Dinner -- Wednesday, February 27, 2008 at the Mill City Museum, Cocktails/Cash Bar begins at 6:00 p.m., Dinner, Speaker, and Recognition Ceremony begins at 7:00 p.m. The keynote speaker is the famous polar expedition leader Will Steger.

Meet the Firm Social -- Thursday, March 13, 2008 at Patterson Thuente Skaar & Christensen PA (IDS Center - 48th Floor), 5:00 to 7:00 p.m.

CLE Stampede -- Tuesday, May 20, 2008 at Windows on Minnesota (IDS Center - 50th Floor), Registration begins at 8:30 a.m. and the program starts at 9:00 a.m.

Young Inventors Dinner & Annual Meeting -- Tuesday, May 20, 2008 at Windows on Minnesota (IDS Center - 50th Floor), Cocktails/Cash Bar begins at 5:00 p.m., Dinner begins at 6:30 p.m.

Meet the Firm Social -- Tentatively scheduled for Wednesday, June 18, 2008; firm TBD.

Golf Social -- Scheduled for Thursday, July 31 at Bunker Hills Golf Course in Coon Rapids.

Meet the Firm Social -- Tentatively scheduled for Thursday, August 21, 2008; firm TBD.

Young Inventors Program: Volunteers Needed



The Young Inventors Program needs help from the MIPLA membership in judging events this month as well as at the Young Inventors Fair taking place in April. Each year the annual Young Inventors Program supports students in grades 4 thru 9 as they develop original inventions. They need your help in judging the gadgets and gizmos created by students from participating schools from all over the Twin Cities area. Student inventions are evaluated for attributes such as creativity, originality, and function. After a short training, volunteer teams are guaranteed to be "wowed" by great ideas from the next generation of innovators and problem solvers. The top 100 inventions are invited to the Regional Young Inventors Fair at Landmark Center in St. Paul on April 5, 2008.

If you are interested in volunteering, please see the Volunteer Form at <http://www.successbeyond.org/documents/YIFVolunteerForm08%20kja.doc>.

Intellectual Property - It's Not Supposed To Be Easy⁽¹⁾

By Jay Erstling⁽²⁾ of William Mitchell College of Law

Imagine this: The international community is locked in a bitter debate over international standards for patent protection. Countries are divided into three camps and seem incapable of agreeing even on basic principles. Some countries are essentially anti-patent; others favor patents, provided they support public policy goals; and still others are unabashedly pro-patent, believing that patents constitute an inherent property right. While this sounds a lot like recent debates on international patent law and policy, especially those dealing with the harmonization of national patent laws and the role of patents in public health, it in fact describes the negotiations that took place in the late 1800s when the first multilateral patent agreement, the Paris Convention for the Protection of Industrial Property, was established. Even more strikingly, the countries espousing the strongest anti-patent positions at that time were Switzerland, Germany, and Holland, which wanted the freedom to develop their own domestic industries by copying other countries' advances.

Setting international patent standards is not meant to be easy, and the history of international patent law-making is rife with accounts of challenge and struggle. This is how it should be. Patent law constitutes a critical balancing act, and achieving a stable equilibrium is a daunting task, particularly when competing interests shift over time. To get the balance right, the interest we all share in rewarding inventors with strong patent rights to encourage innovation must be weighed against, and sometimes tempered by, the need to ensure the public good by requiring fair and equitable access to the benefits those innovations generate.

Every country's position in international negotiations is driven by its own interests and concerns and constrained by its national laws and policies. Countries will not initially see eye-to-eye because their levels of economic development, their legal traditions, and their perceptions of the role of the patent system differ. The objective of international patent negotiations, whether they take place within the World Intellectual Property Organization (WIPO) or elsewhere, is to find convergence among varying

interests. That process takes enormous time, effort, and goodwill. A skewed outcome that advances the interests of one set of countries but overlooks the wellbeing of others is a recipe for an unstable and conflict-ridden patent system. Patience, persistence, and a determination to keep on talking are the best ways we know to overcome the obstacles to international consensus.

Given all the stumbling blocks, it is remarkable that consensus ever occurs. But every so often there is a breakthrough that permits the international patent system to progress in a way that benefits all countries and disadvantages none. WIPO recently held its annual meeting of member states, and while the meeting as a whole was a failure, WIPO may have achieved just such a breakthrough. After several years of intense conflict, WIPO's member countries adopted an initiative, called the Development Agenda, which could change the way patent law is debated and developed.

The Development Agenda has a lofty objective: to enhance WIPO's policy-making and technical assistance work in order to promote balanced patent policies that are responsive to the needs of all countries, particularly the world's poorer ones. This is not the first time that WIPO has attempted a development focus, but it is apparently the first time that no country has made clear its determination to defeat it. Now, however, words have to be turned into actions, and that is where the real challenge lies. If WIPO and its member countries have the will and are willing to devote the resources, an increasing number of countries will be able to realize and benefit from effective patent systems that comply with international standards and also support their developmental needs. The implementation of the Development Agenda, if successful, should lead to patent systems that better enhance global markets and boost economic growth to the benefit of us all. But if the Development Agenda is left to languish and this opportunity is lost, the patent system as a

whole, and therefore all of us who participate in it, may suffer. Only time will tell.

⁽¹⁾ Based on an op-ed article by the author, published in French in the September 26, 2007, edition of the *Tribune de Genève* (the daily newspaper of Geneva, Switzerland, the headquarters of WIPO).

⁽²⁾ Professor of Intellectual Property Law at the William Mitchell College of Law in St. Paul, Minnesota, USA, and Of Counsel at the firm of Patterson, Thunte, Skaar and Christensen in Minneapolis, Minnesota. From 2002 to 2007, the author was the Director of the Office of the PCT and Director-Advisor to the Director General of WIPO.

William Mitchell's IP Institute Files Amicus Brief In Significant Patent Case

By Wendy Burt of William Mitchell College of Law

IP Institute argues that U. S. Patent and Trademark Office exceeded its authority.

The Intellectual Property Institute at William Mitchell College of Law has filed an amicus brief in a case that could significantly impact U.S. patent law. The case is scheduled to be argued Feb. 8, 2008, before the District Court for the Eastern District of Virginia.

Drafted principally by William Mitchell Professor Carl Moy, with the assistance of William Mitchell Professor Jay Erstling and student research assistants Nathan Ellefson, Martha Engel, Nicholas Hergott, Michael McKeen, Marsha Pernat, Tyler Torgimson, and Aditya Tyagi, the IP Institute filed an amicus brief on December 27, 2007 in support of the plaintiffs. The case – *Tafas v. Dudas*, consolidated with *Smithkline Beecham v. Duda* – deals with the legitimacy of major rules recently promulgated by the U.S. Patent Office.

The case is important for the patent community because if the rules are permitted, they will significantly reduce the ability of patent applicants to extend the prosecution of their applications in complex cases. In addition, the case presents the possibility that the U. S. Patent and Trademark Office (USPTO) will secure for itself historically unprecedented rule-making powers. It is the IP Institute's

view that the USPTO's rule-making authority is limited, and that certain specific aspects of the proposed rule should not go forward.

“This case illustrates exactly the sort of unique, important role that academic institutions can play in assisting the courts.” said Professor Moy.

The Institute was represented pro bono in this matter by two prominent Eastern District of Virginia attorneys Charles Gorenstein and Michael K. Mutter from the firm of Birch, Stewart, Kolasch and Birch. The Eastern District of Virginia requires that attorneys be admitted in the Eastern District of Virginia.

The Intellectual Property Institute is an entity within the William Mitchell College of Law. The mission of the Institute is to foster and protect innovation through educational, research, and service initiatives. Among its activities, the Institute advocates for the responsible development and reform of intellectual property law, including the patent laws and the patent system of the United States. A purpose of the Institute is to raise issues and arguments in light of the public interest and the best interests of the patent system as a whole.

Read the amicus brief online at:

<http://www.wmitchell.edu/intellectual-property/files/Amicus%20Brief.pdf>

Patent Agent Job Descriptions

By Jim Keogh, Milena Higgins, and Brad Wright of the MIPLA Patent Agents Committee

The Patent Agents Committee has created a job description to help describe the various capacities which patent agents can be employed and have included some helpful resources to aid those who may be considering a career as a patent agent. Many thanks to Jim Keogh, Milena Higgins, and Brad Wright and to their committee members for putting this information together.

Non-Attorney IP Careers for Engineers and Scientists

Engineers and scientists have a variety of career options to choose from in the area of intellectual property (IP), including a number of non-attorney IP careers. An engineer or scientist may find a career in IP portfolio management, e.g., as an IP portfolio manager, in patent prosecution, e.g., as a patent agent, in IP Litigation, e.g., as a scientific advisor, or in patent examination, e.g., as a patent examiner. Some IP careers may require registration with the U.S. Patent and Trademark Office (PTO).

The PTO maintains a register of patent attorneys and patent agents. To be admitted to this register, a person must comply with the regulations prescribed by the PTO, which require a college degree from an accredited U.S. college or university in engineering or physical science or the equivalent of such a degree from a foreign university and the passing of a Patent Bar examination.

U.S. Patent Bar Exam Information

U.S. Patent and Trademark Office at

<http://www.uspto.gov>

Thomson Prometric at <http://www.prometric.com>

Patent Bar Review Courses

Patent Resources Group (PRG) at

<http://www.patentresources.com/>

Practicing Law Institute (PLI) at

<http://www.pli.edu/>

IP Portfolio Management

Typical Employer: Industry

Typical Job Titles: Patent Agent, Patent Liaison, IP

Specialist, IP Strategist, Portfolio Manager, IP Manager, Intellectual Assets Manager

General Job Description: Duties may include conducting prior art and patentability searches, developing and implementing IP strategies, ensure IP strategies align with business's strategies, conducting IP portfolio analyses, conducting IP map/landscape assessments, conduct competitor IP surveillance, participating in due diligence activities, assisting in technology transfer activities, integration of acquired IP, support R&D by providing advice and direction to scientists and managers on patentability of inventions and filing strategies, plan and manage brainstorming sessions, manage the flow of invention disclosures, coordinate the efforts of inventors, patent counsel and business management around drafting of patent applications, build and maintain an accurate inventory of business's IP assets and develop ways to create leverage and revenue generation from these assets, provide leadership and training to improve inventor and management knowledge and understanding of IP and the process for bringing a concept through the invention process and protection, and work with attorneys to ensure freedom to operate with respect to new product development activities.

Typical Experience: Several years of technical experience plus experience with Intellectual Property (IP) (e.g. patents, trademarks, copyrights, trade secrets). Preferably, candidates have an advanced degree in a relevant scientific discipline and/or an MBA. In addition, a candidate may be registered as a patent agent with the PTO.

Minimum Requirements: A Bachelor's degree in a relevant scientific discipline and relevant IP experience.

Patent Prosecution

Typical Employer: Industry, Law Firms

Typical Job Titles: Patent Agent, Technical/Technology Specialist, Scientific Advisor, Patent Engineer/Scientist

General Job Description: Duties typically include preparing and prosecuting patent applications. Duties may also include conducting prior art searches, prior art analyses, infringement analyses, patent invalidity analyses, preparation of invention disclosures, managing the flow of invention disclosures, conducting patentability studies, reviewing file histories, negotiating and assisting in the preparation of patent agreements, assisting in the preparation of confidentiality agreements, freedom to operate opinions, invalidity opinions and infringement opinions, managing outside patent counsel, and performing due diligence activities. Registered Patent Agents directly interact with the PTO. Entry level positions typically support patent preparation and prosecution.

Typical Experience: Several years of technical experience and/or an advanced degree in a relevant scientific discipline, patent prosecution experience, and PTO Patent Agent registration.

Minimum Requirements: A Bachelor's degree in a relevant scientific discipline and patent prosecution experience or an advanced degree in a technical discipline with no patent prosecution experience.

PTO Registration: The PTO registers both attorneys at law, referred to as "patent attorneys" and persons who are not attorneys at law, referred to as "patent agents." Patent agents are just as qualified as patent attorneys regarding the preparation and prosecution of patents however patent agents cannot conduct patent litigation in the courts or perform various services which the local jurisdiction considers as practicing law.

IP Litigation

Typical Employer: Law Firms

Typical Job Titles: Patent Agent, Science Advisor, Technical Specialist

General Job Description: Duties may include conducting prior art searches, prior art analyses, infringement analyses, patent invalidity analyses, infringement analyses, preparing for technical depositions, attending technical depositions, identifying expert witnesses, preparing expert witnesses, working with experts regarding claim construction (Markman) hearing declarations and expert reports,

drafting infringement, validity and claim construction claim charts, assisting in drafting claim construction briefs, assisting in the preparation of inventor and expert affidavits, preparing for court hearings and preparing demonstrative exhibits.

Typical Experience: Advanced degree, several years of technical experience, Intellectual Property (IP) (e.g. patents, trademarks, copyrights, trade secrets) experience, and PTO Patent Agent registration.

Minimum Requirements: A Bachelor's degree in a technical discipline and IP experience or an advanced degree in a technical discipline with no IP experience.

Patent Examiner

Employer: U.S. Patent and Trademark Office

Job Title: Patent Examiner

General Job Description: Duties include reviewing patent applications to determine if they comply with basic format, rules and legal requirements, determining the scope of the protection claimed by the inventor, researching relevant technologies to compare similar prior inventions with the invention claimed in the patent applications, and communicating your findings as to the patentability of an applicant's invention via a written action to inventors/patent practitioners. Patent Examiners are responsible for the quality, productivity, and timely processing of patent applications, which is the basis of their performance evaluation. Supervisors and experienced examiners train new examiners to apply their technical and analytical skills in the patent examining process. Valuable classroom and on-job training boost an examiner's skills and provides an examiner with knowledge of the needed legal analysis.

Minimum Requirements: Be a U.S. citizen and have a Bachelor's degree in a physical sciences, life sciences, engineering, or computer science discipline. If a person has an advanced degree and/or relevant work experience in the technical area for which they are being considered, they may qualify for a higher starting salary competitive with those offered by private industry.