

# New Matter

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## Spring 2004

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**MIPLA** MINNESOTA  
INTELLECTUAL  
PROPERTY LAW  
ASSOCIATION

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Ann McCrackin [mccrackin@slwk.com](mailto:mccrackin@slwk.com)

# Recent Developments in Patent Law, Rules and Procedures

Sponsored by Fredrikson & Byron P.A.

**TOPICS INCLUDE:**

- Rule changes relating to Reexamination and appeals to the Board of Appeals and Interferences, and of a proposal by the AIPLA for the creation of a post-issuance review procedure for patents.
- The proposed USPTO rules relating to ethics and how they will affect practice before the USPTO.
- Recent developments from the U.S. Court of Appeals for the Federal Circuit - Patent Opinions and Your Client's Duty of Care.

**SPEAKERS:** Jay Brooks of E.J. Brooks & Associates PLLC  
Tim Czaja of Dicke, Billig & Czaja PLLC  
Dennis Daley of Merchant & Gould PC

**WHEN:** Tuesday, June 15, 2004  
Registration: 8:00 a.m. - 8:30 a.m. (Continental breakfast will be provided.)  
Program: 8:30 a.m. - 11:30 a.m.

**WHERE:** Fredrikson & Byron  
Pillsbury Center, 40th Floor, 200 South Sixth Street in downtown Minneapolis

\*CLE credits will be applied for. The cost for this CLE is \$30. Registrations should be received by Thursday, June 10.

REGISTER TODAY by completing and mailing this form with a check (made payable to MIPLA) for \$30 to:

- Erica Vickers  
Fredrikson & Byron, P.A.  
200 South Sixth Street, #4000  
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# Committee News

## Corporate Practices Committee Year-end Summary

The corporate practices committee met several times during the course of the fiscal year to discuss recent developments in case law, U.S. and international patent practice, current 'best IP practices,' and the like.

In addition, the CPC sponsored an afternoon CLE held on March 26 at the MSBA, which was attended by about 35 MIPLA members. This program has been approved for 3 CLE credits.

I plan to reprise my role as chair of the CPC for next fiscal year with several planned improvements in the operation of the committee, so please stay tuned!

*Paul H. McDowall*  
*Patent Counsel*  
*Medtronic, Inc.*

## WIPLA Committee

The Women in Intellectual Property Law Committee has sponsored three CLEs since the last committee report. In November 2003, Mary Bauman and Kara Smith gave a presentation on licensing. Mary is an officer at Fredrikson & Byron and Kara is an associate at Fredrikson & Byron. Then, in February Becky Thorson, a partner at Robins Kaplan Miller & Ciresi, spoke to the group about using graphics technology to enhance your IP practice both in and out of the courtroom. Both of those programs were approved for 1.0 CLE credits. In March Judith Rush, a solo practitioner and a Board Member of Lawyers Concerned for Lawyers, spoke about quality of life and balance in the practice of law. This program has also been approved for 1 CLE credit.

Our next event is a reception on May 25 at The Minneapolis Café co-sponsored by the Women in IP Law and Halleland Lewis Nilan Sipkins & Johnson. Other upcoming meeting announcements will be sent to WIPLA members by e-mail. If you would like to receive



these announcements, please contact Sue Bores at sbores@mnbar.org and request that your e-mail address be added to the WIPLA mailing list.

Our WIPLA random lunch groups also continue to meet regularly. Mara Liepa coordinates the random lunch groups. Every two months Mara organizes the participants into lunch groups. The individual groups meet once for lunch. The lunch groups are a great way to meet other women practicing IP in the twin cities.

The last WIPLA committee report included a program by Kate Larson, a professional coach. Kate spoke to the group about balancing work and life. Kate was generous enough to provide in writing some comments on what firms are doing to address the problems of overload, burnout and retention of female attorneys. Kate's comments, including a four-step life balance checklist, are reproduced in this issue of New Matter. The WIPLA committee hopes that all of the New Matter readers will be able to benefit from Kate's tips.

*Co-chairs Ann McCrackin and Catherine Klima  
Silberg*

## Changes to MIPLA Committee Membership Standing

In an effort to provide Committee Chairpersons with a more accurate picture of committee member interest, the MIPLA Board has approved several changes to the way in which Members become, and remain, part of the various MIPLA committees. Previously, when completing the annual Dues Statement, Members were asked to "check" on any committee of interest. Once a Member had selected a committee, s/he continued to be on the committee's roster in future years unless that Member remembered to "cross off" the committee on a subsequent Dues Statement. Further, Committee Chairpersons have no way of knowing whether a listed committee member truly has an interest in being actively involved. To alleviate these problems, the following changes will

be implemented, and will become apparent when viewing Dues Statements in July 2004:

- 1) Membership status in a MIPLA Committee will be either “active” or “mailing only”. “Active” status indicates that the committee member intends to participate in committee functions. “Mailing only” status indicates that the committee member is interested in the committee generally, but does not intend to participate in committee functions. For any issue relating to operations of the committee, only “active” committee members shall be entitled to a vote.
- 2) Members will be required to make positive decisions regarding committee membership on an annual basis. Thus, committee membership will automatically end on June 30 of each year (i.e., the last day of the MIPLA membership year). Membership in a committee, including “active” or “mailing only” status, will not automatically carry over from year-to-year.
- 3) Members can change their selected committee status during the MIPLA membership year.
- 4) Members are limited to “active” status in a maximum of three committees.
- 5) The Dues Statement will be changed to provide the “active” and “mailing only” status choices for all MIPLA Committees. Further, efforts will be made to highlight this change in committee membership enrollment with the next Dues Statement.

The Board is confident that the above changes will provide Committee Chairpersons with a complete list of committee members who are truly interested in actively pursuing committee goals, and will result in a more rewarding committee experience.

Please keep the changes in mind when reviewing your Dues Statement next July!

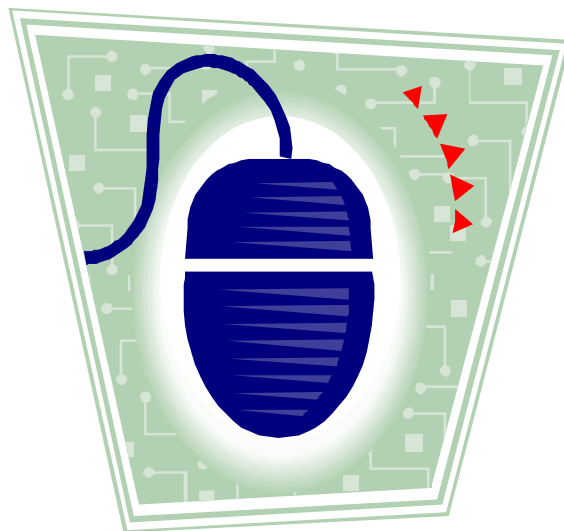
## **Publications Committee Report**

*By: Eduardo Drake*

This issue is our second one of the year. Thanks to submissions from the membership, particularly Anthony Zeuli of Merchant & Gould and Dave Fairbairn et al. of Kinney & Lange, it’s chock full of some very useful material. Special thanks to everyone else who provided content for this issue and to MSBA Staffer, Janny Grice, for putting it all together so beautifully.

Other news is that we continue to work on bringing our website into the 21st Century. The Ardel Group, a local business that specializes in non-profit association management, including website design & hosting, is scheduled to meet with our Board on May 18. If you’d like to help with this project or simply have ideas or thoughts on desirable website functionality, please contact me via email at [drake@slwk.com](mailto:drake@slwk.com).

In closing, I note that the next *New Matter* is tentatively slated for late October or early November. Further details will be announced via email.



# Case Notes

By: Anthony R. Zeuli

In *PSC Computer Prods., Inc. v. Foxconn Int'l, Inc.*, 355 F.3d 1353 (Fed. Cir. 2004), the Court of Appeals for the Federal Circuit addressed for the first time the specificity required of a disclosure in a patent that results in a dedication to the public. When a patentee discloses more of her invention in the patent but does not claim it all, that unclaimed part is considered dedicated to the public, i.e., not covered by the patent literally or equivalently. The Court held for the first time that only “specific” disclosures result in dedication to the public, while “general” disclosures do not. So what is the difference? This Court held that PSC’s disclosure of plastic for use as a resilient clip or strap was specific – and therefore dedicated to the public because the inventor only claimed a metal strap. In contrast, this Court found that PSC’s disclosure of “other resilient materials” was too general to dedicate to the public all resilient strap materials other than metal. The Federal Circuit reaffirmed the “Disclosure-Dedication Rule” stating that “a patent applicant who discloses but does not claim subject matter has dedicated that matter to the public and cannot reclaim the disclosed matter under the doctrine of equivalents.”

In *Fieldturf, Inc. v. Southwest Rec. Indus., Inc.*, 2004 U.S. App. LEXIS 1642 (Fed. Cir. 2004), the Federal Circuit again navigates the treacherous waters of standing as it relates to patent infringement lawsuits. To have standing in an action for patent infringement, the “party must be either a patentee, a successor in title, or an exclusive licensee.” But an exclusive licensee must demonstrate possession of “all substantial rights in the patent.” Holding that the license agreement in this case did not convey “all” rights to the exclusive licensee, and thus standing existed, the Court found significant omissions in the license. The license did not address the licensee’s right to enforce the patent against infringers or the licensor’s right to practice the invention. The case was remanded to the trial court to determine if standing could be cured. If it cannot be, the case will be dismissed with prejudice.

In *Nat’l Steel Car, Ltd. v. Canadian Pac. Ry., Ltd.*, 2004 U.S. App. LEXIS 1346 (Fed. Cir. 2004), the Federal Circuit looked at a rarely used patent-infringement defense – temporary presence in the U.S. Dependent upon specific conditions, 35 U.S.C. §272 (Temporary Presence in the United States) allows “the use of an invention in a vehicle”

to enter the U.S. temporarily without being an infringement. National Steel Car (NSC) sought to enforce its patent on railway cars that Canadian Pacific Railway (CPR) used to haul lumber from Canada to the U.S. CPR did not contest use of the invention, but argued instead that under section 272 there could be no liability because its cars are only in the U.S. “temporarily.” The undisputed evidence revealed that the CPR cars were present in the U.S. about 56% of the time they were in operation. Nevertheless, the Federal Circuit held that the CPR rail cars may be eligible for the defense if CPR can prove that its cars are “entering the United States for a limited period of time for the sole purpose of engaging in international commerce.” Significantly, the meaning of “limited period of time” was broadly interpreted as a “finite period of time,” apparently any amount of time other than permanent. The Court remanded, however, for a determination of whether CPR’s use of the rail cars was “solely” for use in international commerce. Stay tuned for a ruling on the meaning of that seemingly unambiguous word.

## **Patents; Validity; Inherency.**

The Courts of Appeals for the Federal Circuit affirmed a finding that a drug metabolite patent was inherently anticipated by the earlier patent on the drug from which the metabolite is formed once in the body. The Court of Appeals held that a prior art reference may anticipate, inherently, without disclosing a single feature of the claimed invention if the entire claimed invention is necessarily present, or inherent in the prior art reference. In this case, the prior art reference was a patent on the drug. While the prior art was completely silent as to the now-claimed metabolite, the Court of Appeals found that the metabolite was formed readily upon ingestion by the patient. As a result, the metabolite claims are anticipated and invalid. *Schering Corporation v. Geneva Pharmaceuticals, Inc.*, 02-1540 (Fed Cir. 08-01-03).

## **Trademark; Infringement; Preliminary Injunction.**

Judge Kyle denied a motion for preliminary injunction in a trademark infringement suit because ASICS had claimed its trademark design in two patents. ASICS alleged that Target’s PROSPIRIT brand “Wyat” running shoes infringed the ASICS’ “Stripe Design” trademark. The Court found that the same design had been claimed as an element in two patents owned by ASICS. The Court determined that ASICS was unlikely to succeed on the merits because having claimed the Stripe Design as an element in two patents, the

recent *Traffix* decision barred ASICS claim. In *Traffix*, the U.S. Supreme Court struck down alleged trade dress as functional based on a patent claiming the same design. The Supreme Court reasoned that one cannot extend the life of a patent by later claiming the material as trade dress. The line is functionality: trademark law prohibits controlling a useful product feature in perpetuity. A presumption of functionality exists when the owner receives a patent covering its design, ASICS could not overcome the presumption of functionality. *ASICS Corporation v. Target Corporation*, 03-3486 (D. Minn. 08-04-03).

#### **Patent; Attorney Fees.**

The Court of Appeals for the Federal Circuit reversed an award of attorney fees to the defendant in a patent infringement suit because the plaintiffs alleged “scheme” was neither inequitable conduct nor litigation misconduct. McNeil had obtained several patents on improved formulations of Imodium. McNeil filed an infringement suit when Perrigo attempted to market a generic version of the antidiarrheal drug Imodium after the original patent on Imodium expired. The district court concluded that McNeil’s Imodium improvement patents were obvious over three prior art references. The district court awarded attorney fees to Perrigo stating that McNeil had engaged in a scheme for extending the patent life of Imodium by obtaining improvement patents.

The Court of Appeals affirmed the district court’s invalidity findings but reversed the award of attorney fees. The Court of Appeals disagreed with the district court’s determination that McNeil’s improvement patents were a scheme, but reversed because McNeil’s acts did not fall in the two categories of inequitable conduct: egregious conduct during litigation or inequitable conduct before the USPTO. *McNeil-PPC Inc., v. L. Perrigo Company*, 02-1516 (Fed. Cir. 08-01-03).

Recent patent decisions offer warnings for the unwary. Judge Davis and the Court of Appeals for the Federal Circuit (“CAFC”) remind litigants that many procedural issues in patent litigation are decided under Federal Circuit law, not regional circuit law. Similarly, a recent CAFC decision reminds litigants that there are only four ways to establish appellate jurisdiction in a patent case.

In *Travel Tags, Inc. v. Digital Replay, Inc.*, 02-CV-4276 (D. Minn. 09/15/03), Judge Davis applied Federal Circuit law, not Eighth Circuit law, to determine that defendant had sufficient contacts with Minnesota to support personal jurisdiction. Digital Replay relied on Eighth Circuit law in arguing that a distinction exists between patent infringement and patent invalidity for personal jurisdiction requirements. In correcting the defendant, the Court reminded litigants that it applies Federal Circuit law, not regional circuit law, in determining

even personal jurisdiction in patent cases – despite the literal words of the choice-of-law test.

In *Dana v. E.S. Originals, Inc., et al.*, 02-CV-1531 (Fed. Cir. 09/08/03), the CAFC restated the choice-of-law test: “On procedural issues not unique to [patent law], we apply the law of the regional circuit.” The substantive issue was whether the district court properly applied offensive collateral estoppel to bar the defendants from relitigating infringement and invalidity – claims that had been decided against defendants in an earlier action involving the same patent but a different plaintiff. The CAFC applied regional law and affirmed. However, it is far from clear that collateral estoppel and res judicata issues are always “procedural issues not unique to patent law.” In a concurring opinion, Judge Dyk points to cases in which issues of res judicata and collateral estoppel were decided under Federal Circuit law. He advocates for application of Federal Circuit law to all issues of collateral estoppel and res judicata because it will reduce forum shopping caused by differences in regional law.

The moral: research which law applies to all procedural issues in patent cases, even those issues that on their face do not appear to be unique to patent law.

Finally, be certain that the CAFC has jurisdiction before you appeal your client’s patent case – and especially before oral argument. Failure to do so could make for a long, uncomfortable trip home from the Court of Appeals. In *Nystrom v. Trex*, 03-CV-1092 (Fed. Cir. 08/08/03), the CAFC dismissed Nystrom’s appeal – after it was fully briefed and on the morning of oral argument - for lack of appellate jurisdiction. The problem: issues of patent invalidity had not been finally decided by the trial court before it entered final judgment. Nystrom sued Trex for patent infringement. Trex brought a counterclaim that all of the patent claims were invalid. After construing the patent-claim terms, the trial court granted summary judgment of non-infringement, invalidity of three of the 20 patent claims, and final judgment. In such a situation, not uncommon in patent cases, where issues of invalidity remain after a finding concerning infringement, appellate jurisdiction can be achieved in one of only four ways. First, the trial court can dispose of the validity issues on the merits. Second, the trial court can dismiss the remaining claims, usually without prejudice. Third, the trial court can expressly direct entry of final judgment on fewer than all claims under Federal Rule of Civil Procedure 54(b). Fourth, the losing party can seek permission to immediately appeal under 28 U.S.C. 1292. The trial court in *Nystrom* stayed the remaining claims. Citing the final judgment rule, the CAFC “declined to entertain” the appeal because the stay did not dispose of the remaining claims and was not final. I am certain the parties were not entertained.

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# The Role of the Patent Attorney

By: David R. Fairbairn, Sherri Rombach, and Trisha Adamson

In 1972, two-time Nobel prize winner John Bardeen looked back at his invention of the transistor 25 years earlier: They were very exciting days after the invention of the point-contact transistor. One of my jobs was to work with the patent attorney, Harry Hart, and we spent many hours together trying to define the invention.

**“Three Men Who Changed Our World B 25 Years Later,”  
Bell Laboratories Record, Vol. 50, No. 11, pp 335-339.**

This simple statement captured the roles played by inventor and patent attorney, working together. The invention had been made, but a critical step remained: to define the invention in words. Dr. Bardeen paid a great tribute to the contributions of his patent attorney and friend, Harry Hart.

The patent attorney plays a crucial role in the patent process. The vast majority of all patent applications are prepared by patent attorneys who represent inventors or the assignees of inventors. It is the patent attorney who obtains the information from the inventor, determines what the invention is, prepares the specification describing the invention, drafts the claims that define the scope of the invention, and prosecutes the patent application through the examination process in the Patent and Trademark Office. To do the job right, the patent attorney must provide **insight, vision, and effective communication**.

## A. Insight

The insight provided by the patent attorney is the identification of what is the patentable invention. What has the inventor invented or discovered that has never been done before and represents a nonobvious advance over the state of the art? This insight is crucial and fundamental to the entire patent application process. A failure to identify the invention, in its most basic or fundamental form, will result in a patent application that does not communicate the proper scope of the invention. Most significantly, the failure to identify the invention will result in patent claims that are superficial in some respect and fail to define the scope of protection that the inventor deserves.

## B. Vision

Vision is required because the world does not stand still. Technology continues to change, at an ever-increasing pace. From the filing date of the application, to the expiration date

of the patent 20 years later, technology will change. It is crucial that the patent attorney bring to the patent drafting and prosecution process a vision of not only what the invention is today, but how it is likely to evolve and be used over the next two decades.

## C. Communication

The communication skills required of the patent attorney take a number of different forms. The patent attorney must be able to communicate effectively with the inventor. It is crucial that the patent attorney do more than simply understand a written disclosure or other materials that may have been provided. The patent attorney must also draw out from the inventor other information needed to disclose the invention fully and to identify the true scope of the invention that has been made. Rarely does the inventor define the invention in its most basic form without interaction with the patent attorney. These interpersonal and verbal communication skills are essential to the ability to provide insight as well as vision. The inventor is usually the greatest resource for knowing what the invention contributes beyond the state of the art, and is also a primary resource for what uses the invention may have in the future.

The patent attorney also must have the ability to communicate effectively with the business people who will be commercializing the invention. Proper claiming strategy requires an understanding of the business of the patent owner, in order to be sure that the patent rights obtained will be a useful tool for furthering the patent owner's business. For example, strategies may differ depending upon whether the patent owner intends to manufacture and sell products itself or intends to license others. Similarly, claiming strategy will differ if the patent owner makes a significant amount of revenue from replacement parts that form components of the product that has been invented.

The communication skills needed by the patent attorney also include writing skills. The drafting of the patent application as well as the interaction with the Patent and Trademark Office during the examination process involve written communication. Poor writing skills can undermine good inventions.

In the patent drafting process, the invention should be described in an organized fashion and in a way that makes clear what the invention is. The importance of good written communication skills in patent drafting cannot be overstated. Poor grammar, poor organization, and poor word

choice can make the patent application difficult or even impossible to understand. Worse yet, they can make the scope of the claims too broad so they are invalid, too limited so they do not properly cover what the inventor contributed to society, or so unclear that the claims are either invalid or destined to be embroiled in litigation over their meaning. The patent attorney's communication skills must include the power of persuasion. The patent application (and later the issued patent) must persuade a patent examiner of patentability, must persuade potential licensees and potential infringers of the merit and scope of the invention, and ultimately must persuade a judge and a jury of what the invention is and why the patent owner is entitled to the patent rights that it seeks to enforce.

Claim construction has become the most significant step in any infringement or invalidity analysis. The patent attorney

must be acutely aware of words used in the claims, specification, and prosecution history so that when the claims are construed, they are given their intended meaning. Therefore, the attorney's insight, vision, and communication skills during drafting and prosecution of the patent are crucial in helping to convey the intended meaning of the claims.

*This is an excerpt from the paper titled, "Someone Has Been Making Claim Construction Too Hard" written by David R. Fairbairn, Sherri Rombach, and Trisha Adamson of Kinney & Lange, PA and presented by David R. Fairbairn on March 31, 2004 at a CLE sponsored by MIPLA. Visit [www.kinney.com](http://www.kinney.com) to read about the authors and to learn about the services provided by Kinney & Lange, P.A. To receive a complete copy of the paper, please send an email to Kim Stringer at [stringk@kinney.com](mailto:stringk@kinney.com).*

## Top Ten Nuggets from Corporate Transactions Seminar

By: Eduardo Drake

I had the good fortune recently of attending a 15-hour seminar entitled The Patent Attorney's Vital Role in Corporate Transactions. The seminar, which was held in Naples, Florida, was sponsored by the Patent Resources Group and presented by attorneys from the Boston GP firm, Palmer & Dodge. I boiled my notes down to a list of 10 takeways and thought that you might find them valuable as food for thought. Bon appetit!

1. Failure to correct Patent Term Adjustment error on issued patent might render patent unenforceable.
2. Consider putting burden on patent seller/licensor to verify accuracy of Patent Term Adjustment calculations.
3. Ways to preserve privilege of IP opinions in due diligence context: a) provide a synopsis of the opinion in the form of an IP "comfort" letter; b) provide only a verbal "walkthrough" of the opinion; c) use joint-defense or common-legal-interest doctrine (preferably documented in agreement)
4. Exclusive license may trigger need for Hart-Scott-Rodino Antitrust Filing depending on value of assets and/or size of parties; value threshold for asset sale (or exclusive license) is \$50M plus; transactions between party with revenues of \$100M plus and party with \$10M plus require filing.
5. Patent Misuse Issue: Royalty payments can be structured past expiration of payments, if they accrue during life of patent; E.g., one can tie royalties to use of technology prior to commercialization
6. Remind corporate attorneys that patent assignments are not effected by transfer clause in purchase agreement; separate patent assignment document is needed.
7. For international transactions involving trademark licenses, check that licenses have been recorded in foreign jurisdictions where recording is a prerequisite to enforcement of the license
8. "No Shop Provisions" in Letters of Intent can be structured with "fiduciary out" provisions to allow for consideration of other deals under specified circumstances; Seller should seek to include employee/customer non-solicitation provisions along with "No Shop" provisions
9. In international transactions, change in ownership may affect ability to carry on foreign oppositions or infringement suits; E.g., in Japan change of ownership can destroy right to carry on invalidation proceeding.
10. In IPO prospectus, cross-reference related disclosure items to avoid issues with failure to disclose for particular purposes.



# Are you working more and enjoying life less?

A WIPLA-sponsored article

By: *Kate Larsen, PCC*

The ABA Commission on Women (The Unfinished Agenda; Women and the Legal Profession) survey results probably didn't surprise you. Two-thirds of lawyers reported experiencing work/family conflict. A few factors that have caused increased stress and less joy day to day are the twelve hour days, weekend hours and technological advances that allow work to bleed over into the home. Unpredictable deadlines, uneven workloads, or frequent travel pose further difficulties for those with family obligations.

Do any of these stress-related symptoms sound familiar? You find yourself feeling unproductive, unable to concentrate, and nagged by a sense of constant frustration. You end up with a backache, headache, fatigue and/or sleepless nights. You don't have time for friends or hobbies. You determine you need to take better care of yourself because you want to have more clarity, higher energy and less physical and emotional exhaustion. Yet, good intentions don't become actions.

What is the truth about your life and your work? Are you experiencing the joy you desire? How often do you reflect back on your day, satisfied with the impact you are having with clients? Or, like so many attorneys, male and female, are you working more and enjoying life less?

Would you be willing to give yourself permission to pause and examine a process that will improve your health and relationships, while allowing you to effectively and profitably serve your clients?

There are three categories of work/balance for attorneys; the first includes those who are content with their work, satisfied with their client work and contented in their personal lives. The second are those who have or are surrendering their self to the system; along with their soul, health, family and friends. They see change (in the system or the field) as impossible. You can see it on their faces and in the way they function at work. The third group consists of those I see often. These are lawyers who recognize that while challenging, taking charge and making changes is worth the effort. Those changes are both attitudinal and behavioral.

Law firms are just beginning to recognize the cost to their firms by allowing experienced, dedicated, but burned-out lawyers to leave their midst. According to the Project for Attorney Retention, a nonprofit group based at American University in

Washington, a firm can lose an investment of \$200,000 to \$500,000 when an associate leaves. This study done in 2001 went on to say, "Effective reduced-hours programs can save law firms millions of dollars through increased retention rates. Permitting attorneys to work fewer hours without stigma can create attorney satisfaction, establish a firm as an 'employer of choice' that cares about diversity, and improve recruiting efforts."

There is a dramatic discrepancy between the number of female attorneys graduating (50%) and the number of partners represented across the country (5%-16% depending on which report you read). While there are a number of reasons for the gap, one could be burnout. At the point a female attorney sees "partnership" on the horizon, family responsibilities become more intense, healthier lifestyle choices become more important and their client responsibilities climax.

Flex-Time Lawyers, a networking organization catering to such lawyers, conduct monthly meetings in New York and Philadelphia. Hundreds of lawyers attend these meetings. Attendees include midlevel associates with children to senior partners worried that their firms will fall behind the competition. They want to learn how to tip the work-life balance more toward life. Early on, many attorneys signed in providing only their home vs. work phone numbers as if they had to hide the fact they were seeking solutions to the stress challenge.

## Starting Small Does Not Mean Insignificant

If you yearn to have more energy, creativity and enthusiasm for your work, as well as your life, you can do something today that will make a difference. In becoming an attorney, you have already exhibited the skills of self-discipline, tenacity, patience and determination. These are the exact skills required to take better care of your health and personal life. If you were to commit one quarter of the discipline you put into your professional life into your personal life, you would see results faster than you can say, "Stop the madness!"

## Do you need a time-out?

Professional women in particular have a hard time caring for themselves. In the ABA Journal's 2000 poll, a third of women doubted that it was realistic to combine successfully the roles of lawyer, wife and mother. The number of women expressing such doubts has almost tripled over the past two decades. While discouraging, there is hope. Rachel S. is an attorney who questioned her ability to handle her varying roles without

forfeiting the most important things in her life; her family and health. Through coaching and following this four-step process, she has transitioned her life and still made partner in the process! Take time for YOU and explore how you can work differently and have more energy while developing your ability to be stress resilient.

### **Try this four-step Life Balance Check-Up:**

**Step 1. Inventory: Assess where you are at today.** To help achieve your business or career goals, you prepare by reviewing your assets, liabilities, investments, budget and aspirations. You have to know where you are to plan where you want to go. The same is true for you physically, emotionally, spiritually, relationally and intellectually. How satisfied are you with each of these areas of your life? Which area(s) is/are most neglected? The key question: What do you *really* need right now? When was the last time you really considered what you would like your life to look like in one month, one year, or five years? Take time to inventory what's working and what's not serving you well in your life. You may be in a new season of life, your responsibilities at work have changed, while your coping techniques have not. If they are no longer working for you, reassess your strategy and direction.

**Step 2. Plan for and create the lifestyle/workstyle changes** necessary based on your inventory. Evaluate what is “do-able” to make the changes needed to reach your goals for better health, relationships, etc. Set standards around your goals; what are your minimum and maximum standards. Remember that smaller, realistic changes make for *lasting* changes. For example, losing 10 pounds, joining a yoga or aqua class, taking one weekend off each month, or pursuing a long-forgotten hobby like playing the piano are great goals to begin with. What is stopping you from doing this now? Are you worth it? (Answer: YES!) By the way, picking *one thing at a time to change* may be wiser than all at once. Start by getting fifteen to thirty more minutes of sleep a night. You'll be amazed at the difference it makes.

**Step 3. Execute your plan, making adjustments as you practice.** Challenge the internal message that says “other people's needs must always come before” your needs. The most difficult aspect of creating new habits is sticking with them during the transition period when a new behavior has not become a regular habit. Intentional, planned accountability and support is essential. Your career goals, health goals and relationship goals need to be woven together so that one does not conflict with the other. Create a plan that takes into account the people and character qualities you value most. Reevaluate how well the plan is working on a regular basis. If you hit an impossible obstacle, find another route to your goal. You know about personal discipline; your clients see it everyday! Use it to your own advantage.

**Step 4. Accountability is important for staying on track** Just as partners and associates need to be accountable for decisions, you as your own “life manager,” need to be accountable. Determine how you will measure your progress and monitor it regularly. Enlisting the help of friends, family or a coach can help. What gets measured gets done. You will hear more and more about lawyers using professional coaches to realign their careers and/or lifestyle habits. The reason the relationship works is because the obstacles are so great, that a coach—whose job is to be dedicated to *your* pursuits—is a powerful tool for implementing change.

The way to increase your energy, health, vitality and joy is to do it one choice at a time. Ultimately, small choices make a big difference. Instead of heading for burnout, turn in the direction of brilliance.

*Kate Larsen, PCC coaches executives and professionals to greater success and health at work and home. She works with firms who want their attorneys engaged and contributing for the long term. She is the creator of the Think, Choose, Win Series. Kate can be reached at [www.katelarsen.com](http://www.katelarsen.com) or 888 Lif-Walk.*

# WIPO



**WORLD INTELLECTUAL PROPERTY ORGANIZATION**

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## **WIPO LAUNCHES ELECTRONIC FILING OF INTERNATIONAL PATENT APPLICATIONS**

PCT applicant's now have the option of filing their applications electronically with WIPO's International Bureau as the Receiving Office (RO/IB). Using WIPO's newly deployed system called PCT-SAFE ("Secure Applications Filed Electronically"), applicants can file on-line or using physical media such as CD-R and take advantage of a reduced fee of up to 300 Swiss francs.

Until recently, international patent applications could only be filed on paper. The volume and increasing complexity of applications, in particular from the biotechnology sector, has prompted WIPO to implement business solutions that enable its Receiving Office to meet the needs of PCT users by continuing to deliver cost-effective and quality services.

Information relating to PCT-SAFE is available through the WIPO PCT web site at <http://www.wipo.int/pct-safe/en/index.htm>, the PCT Newsletter, or by ordering the WIPO publication entitled "What is PCT-SAFE?" (publication number 496 via the WIPO electronic bookshop [www.wipo.int/ebookshop](http://www.wipo.int/ebookshop)). General information on the PCT can be found at <http://www.wipo.int/pct/en>, or by contacting the PCT Infoline at [pct.infoline@wipo.int](mailto:pct.infoline@wipo.int)

US applicants should keep in mind that they may need a foreign filing license to file at the RO/IB.

# Minnesota Firms Win National Honors for Patent Quality

*By: Eduardo Drake & Brad Forrest*

Three Minnesota firms captured a total of seven top-ten national rankings for patent quality in a study published by IP Law & Business magazine ([www.iplawandbusiness.com](http://www.iplawandbusiness.com).) Schwegman, Lundberg, Woessner & Kluth ([www.SLWK.com](http://www.SLWK.com)) led the way with top-ten rankings in five of the six technical categories studied. (SLWK tied with Blakely Sokoloff for the most top-ten rankings.) These included a number-one ranking for the medical category, number-three rankings for biotech and chemical categories, and number-four rankings for computer and electrical. Crompton Seager & Tufte and Vidas Arrett & Steinkraus garnered the last two Minnesota wins with respective number two and number four rankings for their medical work. Notably, Minnesota earned three of the top four spots in the medical category.

The patent-quality study was conducted by PatentRatings LLC of Newport Beach, California ([www.patentratings.com](http://www.patentratings.com)), which devised a computer model to objectively measure the quality of patents in six technologies: electrical, computer, mechanical, chemical, biotech, and medical. The model scored patents based on factors, including the length of their claims and specifications. IP Law and Business is a publication of American Lawyer Media - the parent company of the National Law Journal.

## Trademark Award

Dorsey & Whitney LLP will be receiving a NameProtect *Trademark Insider*® Award for its significant trademark filings in 2003. It was ranked the #12 law firm for U.S. trademark filings in 2003. Awards are determined by the total number of new trademark applications filed with the United States Patent and Trademark Office during calendar year 2003. Dorsey held the same ranking in 2002. This award is being given as part of NameProtect's 2003 Annual *Trademark Insider*® report, a publication which provides the general business and legal industries with insight into trademark filing and trademark industry activities.

*Julie Snow Samanant  
Dorsey & Whitney LLP  
Director of Marketing and Business Development*

# Dorsey & Whitney Open House October 16, 2004

*Photos courtesy of Toni Byard, Dorsey & Whitney*



*Left to Right: Lori Marco and Kama Berg, Briggs and Morgan.*

# Dorsey & Whitney Open House October 16, 2004

*Photos courtesy of Toni Byard, Dorsey & Whitney*



*Pictured left to right: Tim Czaja (MIPLA President), Paul Kempf, and Steve Dicke, all of Dicke Billig & Czaja.*





All MIPLA members are encouraged to submit articles pertaining to intellectual property law issues for publication in *New Matter*. Please send your articles to Eduardo Drake by e-mail, [edrake@slwk.com](mailto:edrake@slwk.com), or by conventional mail to Schwegman, Lundberg, Woessner, and Kluth P.A., 121 S. Eighth Street, Suite 1600, Minneapolis MN 55402. Submissions in electronic format (e.g. on a diskette or by e-mail) are preferred.

**Visit the MIPLA Home Page --**

**[www2.mnbar.org/mipla](http://www2.mnbar.org/mipla)**

## MIPLA Committees

They exist to serve you . . . but they don't exist without you.

A MIPLA committee is created whenever MIPLA members have enough interest in a particular IP subject matter or procedural area. For example, the Women in Intellectual Property Law Committee didn't exist five years ago and today it's one of our most active groups. Last year, our Patent and Trademark Office Committee became very active in response to a proposed USPTO Rule change. All of our current committees have volunteer chairs except for the Small Business Committee. The Board will disband this committee if no one steps forward to chair it.

If you would like to chair our Small Business Committee or propose the formation of a new committee, give me a call.

Tim Czaja  
MIPLA President  
612-573-2000  
[taczaja@dbclaw.com](mailto:taczaja@dbclaw.com)

The MIPLA website includes:

- MIPLA Schedule of Events
- Jury Instructions
- Committee Chair Names
- Listing of approved MIPLA CLEs
- Hot Links to Other IP Websites
- *New Matter*

Make it a BOOKMARK today!

Send your comments about the MIPLA website to Eduardo Drake, [edrake@slwk.com](mailto:edrake@slwk.com).

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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: \_\_\_\_\_  
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**Annual dues in the amount of:**

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