

New Matter

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Summer 2002

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MIPLA MINNESOTA
INTELLECTUAL
PROPERTY LAW
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July 30, 2002

United States House of Representatives
Committee on the Judiciary
Subcommittee on Courts, the Internet and Intellectual Property

Ladies and Gentlemen:

The Minnesota Intellectual Property Law Association, an affiliate of the Minnesota State Bar Association, represents over 600 attorneys and agents involved in handling patent, copyright, and trademark matters on behalf of both corporate clients and individuals.

Our organization strongly opposes the fee legislation (Reauthorization Act, Fiscal Year 2003) recently and suddenly proposed by the U.S. Patent and Trademark Office. The proposed fee increases would be substantial, especially in the high-tech industries that help drive the U.S. economy. Resulting dramatic changes in practice would severely and negatively affect the enforceability and value of patents. Further, and of key concern, this effective “tax” on inventors and applicants would not be used to improve USPTO service, but would instead be largely siphoned off for other government purposes.

While there may be some merit to the concerns that the legislation is said to address, the legislation will only serve to exacerbate those concerns, while creating others as well. The legislation will not simplify processing patent applications, instead it will make it even more complex, as applicants continue their attempt to seek the broadest permissible protection, while ameliorating the financial cost. Perhaps most importantly, the legislation would serve to effectively weaken the economic value of intellectual property of U.S. industry on the global market, by putting U.S. applicants at a distinct procedural and financial disadvantage as compared to the rest of the world.

With regard to process itself, we believe it is improper to push through this significant overhaul of the patent system as a “mere” appropriations bill without study and public debate of its likely deleterious impact on the U.S. economy.

The U.S. Constitution mandates that Congress establish a patent system “To *promote* the Progress of Science and useful Arts” (emphasis added). The U.S. economy is the largest in the world. It was built using the successful current patent fee system, through which fees have increased periodically over the years, and generally in direct response to legitimate concerns. In turn, U.S. businesses invest heavily here to develop and protect their inventions, with the patent system protecting that investment by allowing patent holders to exclude others from copying the patented technology for a limited time.

The proposed fee structure would not impose minor additional expense that would be comfortably absorbed by industry. Rather, it would exponentially increase the application fees for patents with multiple claims, necessitating radical changes in practice. In applications covering complex inventions, proper protection often requires on the order of hundreds of claims, of which a score or more might be “independent” in form. While the current fees for such an application might total in the range of several thousand dollars, at most, the corresponding fees under the proposed legislation would amount to several hundred thousand dollars or more. Yet other applications, although unusual and expensive even by today’s standards, would incur fees of several billions of dollars under the proposed new structure.

The use of patent claims, including the use of various claim styles and formats permitted by the law, is a necessary professional practice, not a frivolous waste of words. The justifications presented for the revised fee schedule state that one objective is to make the filing of a significant number of claims increasingly financially burdensome so the PTO will have fewer claims to examine. By contrast, the very case law that practitioners must take as their guidance *supports* the premise that the

applicant may pursue all claims believed necessary to protect the various aspects of an invention. Moreover, significant other changes have been imposed on the patent practice and patent owners over the past few years, including severe limitations that have been effectively placed on application of the “Doctrine of Equivalents”.

All of these changes, including severely restricted claim interpretations that have been imposed by at least some panels of the Court of Appeals for the Federal Circuit, have prompted the patent practice to the style of claim drafting in common use today. It is important to remember that complex inventions often require many independent claims in order to fully and adequately protect the invention.

If anything can be done to affect change in this regard, it will require a careful attempt to address those underlying causes, as compared to a wholesale and blind attempt to affect behavior by simply taxing it severely.

We ask the Committee members to consider these comments, and at the very least, to permit consideration of any such fee increase to be the subject of public debate and input.

Respectfully submitted

Philip M. Goldman, President
Minnesota Intellectual Property Law Association

c: MN Congressional Members
Under Secretary James E. Rogan

Letter From The President

To the MIPLA Membership:

I am pleased to take the reins as 2002-2003 President of MIPLA at this time of challenge and change. Thanks to outgoing President Brad Forrest for his efforts, successes, and leadership over the past year, and for leaving us with an aggressive agenda and healthy budget for the year ahead.

The IP profession is undergoing tremendous reform and change – everything from the PTO’s new 21st Century Strategic Plan (and even more recent proposed fee increases) to the Supreme’s weighing in on *Festo*, to the hot topic of “marketing intellectual assets.”

It is my goal to make MIPLA a vibrant and integral force on behalf of the Minnesota profession. I particularly hope to increase the organization’s level of involvement and visibility, and in turn, to increase the impact MIPLA has on our profession – both regionally and nationally.



My goals are simple, and my role models are few.

In the words of our esteemed President, we will find the non-doers and smoke them out of their caves.

And in the footsteps of Governor Ventura, I am confident that even I can achieve these goals by encouraging good, creative people to take active roles on the Board and the organization’s committees. Among the new members to the Board this year, we welcome Professor Carl Moy, to provide a long overdue academic perspective, as well as Mara Liepa, in recognition of her energy and involvement to date.

Finally, I hope to follow Brad’s “open door” policy with respect to any input you may have – if you have any ideas to offer or want to become more actively involved, please give me a call or email. Any problems or complaints, you can continue to call Brad.

Phil Goldman

Committee Reports

Biotechnology and Chemical Law



During the past academic year, the Biotechnology and Chemical Law Committee conducted its usual series of monthly CLE presentations on topics of current interest. Two presentations included broad theoretical discussions of protecting products of biotechnology and life sciences. Other presentations got to the nuts-and-bolts of patent law covering

topics like the reality of the Hatch-Waxman act, current case law, and tips for drafting meaningful claims. One presentation provided an overview of bioinformatics.

We are looking forward to making next year another active year of CLE activities of interest to chemical and biotech practitioners. Of course, we're always looking for volunteer speakers. Contact me if you wish to volunteer.

Mark Skoog

Copyright Law



During the 2001-2002 year, the Copyright law committee met several times and focused its efforts on providing education to the public – with at least three members offering such education. In May, Julie and Gillian Uecker Rosenquist presented a seminar on completing copyright applications for Springboard for the Arts. In addition, Julie is working with Women Venture to

schedule some copyright and basic intellectual property rights classes.

In mid-July, I will be a presenter for the Minnesota Council of Nonprofit's at their "T2: Mission Technology" event. The topic will be copyright and general issues relating to websites for nonprofit organizations.

Gillian Uecker Rosenquist will provide a presentation at the Minnesota Literacy Council. This presentation will train the staff on the basics of copyright law and fair use.

Steven Lieske

Useful Websites



The following hyperlinks are very useful for people interested in gaining a basic knowledge of molecular biology, gene sequencing, and bioinformatics. I demonstrated many of these links at a presentation to the Committee on May 16, 2002.

Beginner's Guide to Molecular Biology:

<http://www.iacr.bbsrc.ac.uk/notebook/courses/guide/>

Bioinformatics FAQs:

<http://bioinformatics.org/faq/> - age

Animation of Transcription to mRNA:

<http://www.ncc.gmu.edu/dna/mRNAanim.htm>

Animation of Translation of mRNA to Protein:

<http://www.ncc.gmu.edu/dna/mRNAanim.htm>

Discussion of DNA micro-array chips:

<http://www.gene-chips.com/>

National Library of Medicine Entrez Search System:

<http://www.ncbi.nlm.nih.gov/entrez/query.fcgi>

Demonstration of gene sequencing using Polymerase Chain Reaction:

<http://www.hhmi.org/lectures/biointeractive/vlabs/index.htm>

Three-dimensional protein structure demonstration:

<http://www.rcsb.org/pdb/pe/explorer/explore.htm?id=1A00&>

Human Genome Project:

<http://www.wi.mit.edu/news/genome/natureg.html>

ExpASy Molecular Biology Server:

<http://www.expasy.ch/>

Nelson Capes

William Mitchell Student Intellectual Property Law Association

The William Mitchell Student Intellectual Property Law Association (SIPLA) provides students with a greater understanding of the technology and opportunities available in Intellectual Property law. In addition to monthly meetings, SIPLA members participate in a number of roundtable meetings, law firm tours, MIPLA events, and social gatherings.

During the 2001-02 school year, SIPLA hosted a number of roundtable events, including talks on Licensing and Technology Transfer, Trademark Law and Domain Name Disputes. SIPLA also co-sponsored an Entertainment Law Symposium for 2.5 CLE credits with the William Mitchell Law Review.

Participation in SIPLA continues to climb. SIPLA has already begun preparations on events for next year, including more roundtable events and the addition of moot court competitions.

The William Mitchell SIPLA officers for 2002-03 are:

Gretchen Randall - President - grandall@wmitchell.edu
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Chris Sullivan - Secretary - csulliv2@wmitchell.edu
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Jay Brooks



January Inventors & Authors Dinner



Inventor Bjorn Stansvik of MentorMate (inventor of PDA-based educational software); guest speaker Paul Douglas of WCCO (inventor of weather forecasting system); and MIPLA president Brad Forrest.



Paul Douglas congratulates Bjorn Stansvik.

[Special thanks to Steve Schaefer for submitting these photos.]



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, 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

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.

Phil Goldman
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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.

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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?
State(s) _____ Yes No

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: Sue Bores, MIPLA Administrator, 600 Nicollet Mall, Suite 380, Minneapolis MN 55402.