

# New MATTER

Newsletter of the Minnesota Intellectual Property Law Association

JUNE | 2011



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## UPCOMING EVENTS

### 16TH ANNUAL GOLF EVENT

Thursday, July 21, 2011  
Location: Majestic Oaks Golf Course  
Dinner / Social to follow

### Questions:

Contact Debbie Norton  
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## Message from the OUTGOING PRESIDENT

Dear Colleagues,

My year as President is fast drawing to an end. I would like to thank the Committee Chairs for their contributions to MIPLA this year. The committees were very active, each committee holding at least two meetings. I am grateful for their energy and appreciate all of their efforts this year.

The Programs Committee organized many excellent events this year, including Happy Hours, the new Holiday Social, Meet the Firm events, a rousing bowling event, and the always-fun Young Inventor's Dinner featuring enthusiastic young inventors. Tim Czaja arranged the annual fun-packed Golf outing, and Brad Forrest put together another wonderful Stampede. Tim and Brad received the MIPLA President's Award for their contributions to MIPLA over the years.

The annual MIPLA Cup was very successful. Thanks to the judges who gave up their Sunday afternoon so that the law school teams could compete against each other right before the regional moot court competition. Congratulations to first place winners Abigail Tyson and Ochen Kaylan from William Mitchell College of Law, recipients of a \$4000 award, and to second place finalists Matthew Greenstein and Ryan Meehan from Hamline University School of Law, recipients of a \$1000 award from MIPLA.

I have really enjoyed working with the Board members. Their time, dedication and contributions to MIPLA this year have made MIPLA the strong organization it is! I could not have done it without you.

Thank you for giving me the opportunity to serve as MIPLA President this past year. It was a great honor, and has been a wonderful year. Congratulations and best wishes to President-elect, Robin Sannes, the incoming Board, and Committee Chairs for another great year!

Best regards,

**Hallie Finucane**  
MIPLA President, 2010-2011

## A Message from Our INCOMING PRESIDENT

MIPLA has provided numerous educational and networking opportunities for me since I became a member during my third year of law school in 1998. MIPLA has been instrumental in assisting me to grow professionally, and I am grateful for the opportunity to serve as MIPLA President for 2011-2012.

Hallie Finucane has done an excellent job as President for 2010-2011, which is evident in many ways, especially by how active the organization and its committees have been this last year. To continue along Hallie's path, I will encourage the committees to continue providing CLEs and social events. These events provide opportunities for education and networking at little to no cost to its members. I will also encourage our members to be active in participating in these events so that we can increase the momentum and provide additional events.

I would like to get a national or international intellectual property association meeting scheduled in the Twin Cities.

We have been in contact with AIPLA, and we are hoping a spring meeting will be hosted in the Twin Cities in the relatively near future. It would be great if we could host other association meetings, too! Not only is the Twin Cities a great venue, but this will give us an opportunity to showcase the great talent we have in Minnesota.

Upcoming events will be posted on our website ([www.mipla.net](http://www.mipla.net)) and in our New Matter publications. Please also watch for e-mail notices regarding upcoming events. If you have any suggestions for upcoming events, please contact either me or one of the committee chairs.

I sincerely thank MIPLA's members for allowing me to serve as President for 2011-2012. I am looking forward to another active year!

**Robin Sannes**  
2011-2012 MIPLA President

## Board Members 7/1/11 - 6/30/12

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## Updates on the Law By E.L. Belden<sup>1</sup>

# THE LONG ARM OF SECTION 112, PARAGRAPH ONE

Filing a provisional application for patent is a relatively straightforward and inexpensive means to establish an early effective filing date for a subsequently filed non-provisional patent application that has the potential to issue as a patent. If pending patent reform legislation, as set forth in the “America Invents Act” (H.R. 1249), is ever signed into law, the United States will replace its “first to invent” system with a “first to file” system.<sup>2</sup> In response, we may look to the provisional application more often as a means to capture the earliest possible filing date. But, even as we “fast track” the conversion of our inventors’ lab notebook pages into provisional applications, we should set aside time for careful deliberation. Far-sighted applicants understand that close attention to substantive detail is warranted when drafting a specification for the provisional application.

The specification of a provisional application serves as a foundation for a subsequent non-provisional application claiming priority thereto, as set forth in Section 119(e) of the Patent Laws.<sup>3</sup> Section 119(e) makes specific reference to the first paragraph of Section 112 of the Patent Laws<sup>4</sup> in characterizing the provisional application, which is filed under Section 111(b) of the Patent Laws.<sup>5</sup> Compliance with the *first paragraph* of Section 112, as set forth in Section 111(b), requires that the specification of an application for patent “contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art... to make and use the same, and shall set forth the best mode ...”

Claims are *not* a required component of the provisional application. (The second and following paragraphs of Section 112 address the claims.) But applicants should consider potential patent claims when preparing the specification of the provisional, since, in order to have the benefit of the earlier

provisional filing date, claims to the invention require support from the specification of the provisional application.

The *en banc* decision of the Court of Appeals Federal Circuit in *Ariad v. Lilly*<sup>6</sup> is relevant, in that it addresses the first paragraph of Section 112. The Court invalidated Ariad’s patent claims for failure to meet the written description requirement of Section 112, paragraph one.<sup>7</sup> Although no provisional patent application played a role in this case, the opinion of the court gives us guidance for determining when and how to prepare an invention disclosure, be it in the form of a provisional or a non-provisional patent application, to establish the earliest possible filing date without sacrificing adequate support for claims to the invention. For example, Judge Newman, in her Additional Views, reminds us that “[b]asic scientific principles are not the subject matter of patents”<sup>8</sup> and that the written description and enablement requirements of Section 112 can only be met upon “transition from theory to practice, from basic science to its application, from research plan to demonstrated utility.”<sup>9</sup>

Thus, in the initial stages of concept development, when the pressure may be on to establish the earliest possible filing date, and the provisional application for patent seems like a relatively quick, easy, and inexpensive route, be wary. Consider that the foundation provided by a provisional application is a conditional one. Take a moment to consider what patent claims you will be seeking, and whether or not a detailed description of the concept in its current state can clear the hurdle of Section 112, paragraph one. Unless you can draft a specification that describes at least one practical application of the concept, so as to enable one skilled in the art to make and use it, the provisional application is premature and has little chance to establish a stable foundation for subsequent patent claims.

1. E.L. Belden is a registered patent agent and independent consultant specializing in comprehensive patent application preparation.

2. H.R. 1249 transforms the U.S. system to a “first to file” system by means of amendment to 35 U.S.C. §102 whereby subsections (a) through (g) (conditions precluding entitlement to a patent) are replaced with a new subsection (a), which specifies precluding conditions in two parts, and a new subsection (b), which specifies exceptions to subsection (a) in two corresponding parts. If H.R. 1249 is enacted without further change, relevant portions of 35 U.S.C. §102 would read as follows:

§102. Conditions for patentability; novelty

(a) NOVELTY; PRIOR ART.—A person shall be entitled to a patent unless—

(1) the claimed invention was patented, described in a printed publication, or otherwise disclosed to the public before the effective filing date of the claimed invention; or

(2) the claimed invention was described in a patent issued under section 151, or in an application for patent published or deemed published under section 122(b), in which the patent or application, as the case may be, names another inventor and was effectively filed before the effective filing date of the claimed invention.

(b) EXCEPTIONS.—

(1) DISCLOSURES MADE 1 YEAR OR LESS BEFORE THE EFFECTIVE FILING DATE OF THE CLAIMED INVENTION.—A disclosure to the public made 1 year or less before the effective filing date of a claimed invention shall not be prior art to the claimed invention under subsection (a)(1) if—

(A) the disclosure was made by the inventor or joint inventor or by another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor; or

(B) the subject matter disclosed had, before such disclosure, been disclosed to the public by the inventor or a joint inventor or another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor.

(2) DISCLOSURES APPEARING IN APPLICATIONS AND PATENTS.—A disclosure shall not be prior art to a claimed invention under (a)(2) if—

(A) the subject matter disclosed was obtained directly or indirectly from the inventor or joint inventor;

(B) the subject matter disclosed had, before such subject matter was effectively filed under subsection (a)(2), been

disclosed to the public by the inventor or a joint inventor or another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor; or

(C) the subject matter disclosed and the claimed invention, not later than the effective filing date of the claimed invention, were owned by the same person or subject to an obligation of assignment to the same person.

3. 35 U.S.C. §119(e)(1); the relevant portion of the statute reads:

“An application for patent filed under section 111(a) or section 363 of this title for an invention disclosed in the manner provided by the first paragraph of section 112 of this title in a provisional application filed under section 111(b) of this title, by an inventor or inventors named in the provisional application, shall have the same effect, as to such invention, as though filed on the date of the provisional application filed under section 111(b) of this title, if the application for patent filed under section 111(a) or section 363 of this title is filed not later than 12 months after the date on which the provisional application was filed and if it contains or is amended to contain a specific reference to the provisional application.”

4. 35 U.S.C. §112; the relevant portion of the statute reads:

“The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.”

5. 35 U.S.C. §111(b); the relevant portion of the statute reads:

“(1) AUTHORIZATION.—A provisional application for patent shall be made or authorized to be made by the inventor, except as otherwise provided in this title, in writing to the Director. Such application shall include— (A) a specification as prescribed by the first paragraph of section 112 of this title; and (B) a drawing as prescribed by section 113 of this title. (2) CLAIM.—A claim, as required by the second through fifth paragraphs of section 112, shall not be required in a provisional application.”

6. *Ariad Pharmaceuticals, et al. v. Eli Lilly and Company*, 598 F.3d 1336 (Fed. Cir. 2010)

7. The majority held that “the hallmark of written description is disclosure” in that “the specification must describe an invention understandable to [the] skilled artisan and show that the inventor actually invented the invention claimed”, and that Ariad’s specification failed to do so. *Id.*, at 1351.

8. *Id.*, at 1359

9. *Id.*

## Updates on the Law By: Ryan Toriello\* and Zuzana Tonarova\*

# RAMBUS, INC. PATENT CONTROVERSY

### Introduction

Rambus, Inc. (“Rambus”) holds a family of patents for dynamic random-access memory (“DRAM”).<sup>1</sup> Rambus’s patent portfolio for DRAM has been the subject of controversy in two types of cases: (1) antitrust and (2) spoliation of evidence. First, Rambus’s anticompetitive conduct consisted of not disclosing its intent to file and its pending patent applications for four technologies covered by the industry standard for DRAM,<sup>2</sup> while participating in the Joint Electron Device Engineering Council (“JEDEC”).<sup>3</sup> It is also alleged that Rambus continued to receive information about JEDEC meetings from an informant after it withdrew from JEDEC.<sup>4</sup>

Second, a recent decision by the Court of Appeals for the Federal Circuit (“CAFC”) affirmed the finding that Rambus destroyed relevant evidence—in implementing its “Document-Retention Policy”—when litigation was reasonably foreseeable.<sup>5</sup> Rambus held “shred days” in accordance with its “Document-Retention Policy,” where it destroyed all documents and emails prior to the issuance of its DRAM patents.<sup>6</sup>

An investigation of the antitrust allegations reveals that Rambus effectively “captured” the industry standard for DRAM.<sup>7</sup> However, the recent holding on spoliation by CAFC may have a windfall effect on the enforceability of Rambus’s DRAM patents, pending a finding of bad faith and prejudice by the lower courts.<sup>8</sup>

### ANTITRUST—Proceedings with FTC 2000–2010

Rambus’s four divisional applications were all issued in 1999—the same year JEDEC’s amended industry standard for DRAM went into effect.<sup>9</sup>

In June of 2002, the Federal Trade Commission (“FTC”) filed a complaint under section 5(b) of the FTC Act;<sup>10</sup> the allegations claimed that Rambus engaged in unfair competition with JEDEC, and procured patent rights for the DRAM industry standard by deception.<sup>11</sup> The FTC found that Rambus’s deceptive conduct while participating with JEDEC was sufficient for a monopolization claim under section 2 of the Sherman Act.<sup>12</sup>

Rambus subsequently appealed the FTC decision at the Circuit Court of Appeals for the District of Columbia

(“CADC”). CADC held that the FTC failed to demonstrate that Rambus inflicted harm on the *competitive process*; therefore, Rambus’s conduct did not rise to the level of exclusionary conduct under the Sherman Act.<sup>13</sup> The Supreme Court denied the FTC’s petition for writ of Certiorari.<sup>14</sup>

Rambus’s conduct while participating in JEDEC was also the subject of a European Commission investigation as potential “abuse of dominant position.”<sup>15</sup>

### SPOLIATION—History of Private Litigation 2000–2009 Leading to CAFC Decision

In late-1999 and early-2000, Rambus negotiated licensing agreements with Toshiba, Oki, NEC, and Hitachi.<sup>16</sup> Rambus filed its first suit against Infineon Technologies AG in August of 2000.<sup>17</sup>

The CEO of Rambus met with the CEO of Micron in August of 2000, and tentatively set plans to negotiate a licensing agreement in September of 2000.<sup>18</sup> However, without warning, Micron filed suit against Rambus on August 28, 2000 in the District of Delaware.<sup>19</sup> The next day, Hynix filed suit against Rambus in the Northern District of California.<sup>20</sup> Rambus counterclaimed for infringement.<sup>21</sup>

Both Hynix and Micron filed an unclean hands defense based on spoliation of evidence.<sup>22</sup> In *Hynix Semiconductor, Inc. v. Rambus, Inc.* (“*Hynix I*”), Hynix argued that Rambus’s contemplation of litigation against DRAM manufacturers triggered the massive destruction of documents relevant for potential patent litigation.<sup>23</sup> The district court held that Hynix failed to demonstrate that Rambus’s “Document-Retention Policy” was intentionally designed to get rid of particular damaging documents.<sup>24</sup>

However, in *Micron Technologies, Inc. v. Rambus, Inc.* (“*Micron I*”), the court found that Rambus had a duty to preserve potentially relevant evidence;<sup>25</sup> and, the appropriate sanction for spoliation was dismissal or unenforceability of Rambus’s DRAM patents.<sup>26</sup>

### CAFC Decision May 13, 2011

*Micron Technologies, Inc. v. Rambus, Inc.* (“*Micron II*”)<sup>27</sup> and *Hynix Semiconductor, Inc. v. Rambus, Inc.* (“*Hynix II*”)<sup>28</sup> were consolidated on appeal at CAFC, to be argued consecutively before the same panel.<sup>29</sup> Both *Micron II* and *Hynix II* were decided May 13, 2011.<sup>30</sup>

## Rambus, Inc. continued

In *Micron II*, CAFC affirmed the outcome of the unclear hands defense—Rambus had a duty to preserve evidence and engaged in spoliation by “destroying relevant discoverable documents”—the district court did not err under the “clear error standard” in finding that litigation was reasonably foreseeable prior to the second shred day in August 1999.<sup>31</sup> The dismissal sanction was vacated by CAFC due to lack of a clear finding of bad faith and prejudice, and remanded in accordance with the standards set by CAFC.<sup>32</sup>

In *Hynix II*, CAFC reversed the finding of spoliation by the district court, stating that the standard used by the court was too narrow, and applied the spoliation holding of the companion case, *Micron II*.<sup>33</sup>

### Conclusion

Rambus tailored its patent applications to the industry standard for DRAM while participating in JEDEC.<sup>34</sup> But, Rambus successfully obtained a favorable judgment by CADR, effectively avoiding liability for violation of antitrust laws.<sup>35</sup>

How was Rambus able to utilize the patent system, “capturing” the industry standard for DRAM while participating in JEDEC, then? Rambus was able to avoid liability for violation of antitrust laws, as well as affirmative defenses in patent law—such as patent misuse and inequitable conduct—because Rambus destroyed all of the documents relevant to the defenses.<sup>36</sup> Although CAFC vacated the dismissal sanction, which would render Rambus’s DRAM patents unenforceable, affirming the finding of spoliation is a major step.

## PRACTITIONER RECEIVES 50+ PATENTS FOR MEDTRONIC

Jim Keogh, PhD has had the incredible honor of receiving 52 patents in the medical devices area. Each of these patents is assigned to Medtronic. Jim is a registered patent agent who is currently employed by Medtronic.

\*J.D. Candidate, William Mitchell College of Law, 2012; B.S., Chemistry III, University of Portland, 2009. Research Assistant for Patent Professor, Robert C. Moy. Editor of *Cybaris*® Intellectual Property Law Review.

\* Ph.D. Candidate in Commercial Law, Masaryk University, Czech Republic. Research Assistant for Patent Professor, Robert C. Moy.

1 There are a total of twelve U.S. Patents at issue: United States Patent Nos. 5,915,105; 5,953,263; 5,954,804; 5,995,443; 6,032,214; 6,032,215; 6,034,918; 6,038,195; 6,324,120; 6,378,020; 6,426,916; and 6,452,863. Brief of Appellant at xii n.1, *Micron Tech., Inc. v. Rambus, Inc.*, No. 2009-1263 (filed July 2, 2009) [hereinafter *Rambus Opening Brief*].

2 See *Rambus Inc. v. F.T.C.*, 522 F.3d 456, 460 (D.C. Cir. 2008) (The industry standard includes the following technologies for which Rambus holds patents: “programmable CAS latency, programmable burst length, on-chip phase lock, delay lock loops (on-chip PLL/DLL), and dual-edge clocking.) (alteration in original).

3 Joint Electron Device Engineering Council, *Subcommittee meetings JC-42.3*, <http://www.jedec.org/committees/jc-42> (last visited Apr. 8, 2011).

4 Richard H. Stern, *Rambus v. Infineon: The Superior Aptness Of Common-Law Remedies Than Antitrust For Standardization Skulduggery*, 23 *Eur. Intell. L. Rev.* 495, 497 (2001). There were numerous emails exchanged between Rambus and a participant in JEDEC, known as the “secret squirrel” concerning the industry standard for RAM. *Id.* Although there was a media outcry about the “secret squirrel,” the court focused on evidence showing that Rambus amended its patent claims to meet the industry standard discussed in JEDEC. *Id.*

5 *Micron Tech., Inc. v. Rambus, Inc.*, \_\_\_ F.3d \_\_\_, No. 2009-1263, 2011 WL 1815975 (Fed. Cir. 2011).

6 *Micron Tech., Inc. v. Rambus*, 255 F.R.D. 135, 142 (D. Del. 2009); *Hynix Semiconductor, Inc. v. Rambus, Inc.*, 591 F.Supp.2d 1038, 1053 (N.D. Cal. 2006).

7 Janice M. Mueller, *Patenting Industry Standards*, 34 *J. Marshall L. Rev.* 897, 900 (2001).

8 *Micron*, \_\_\_ F.3d at 27\*, 29\*.

9 *Rambus, Inc. v. F.T.C.*, 522 F.3d 456, 460 (D.C. Cir. 2008).

10 15 U.S.C. § 45(b) (2006).

11 *F.T.C.*, 522 F.3d at 461.

12 *In re Rambus*, No. 9302, Opinion of the Commission, at 4 (F.T.C. Aug. 2, 2006).

13 See *F.T.C.*, 522 F.3d at 462.

14 *Rambus, Inc. v. F.T.C.*, 522 F.3d 456 (D.C. Cir. 2008), *cert. denied*, 129 S.Ct. 1318 (2009).

15 Commission Decision (EC) 30/09 of 9 December 2009, 2010 O.J. (C 30) 1.

16 *Id.* at 20.

17 *Rambus v. Infineon Techs. AG*, 155 F.Supp.2d 668, 671 (E.D. Va. 2001), *rev’d in part & vacated in part*, 318 F.3d 1081 (Fed. Cir. 2003).

18 *Rambus Opening Brief*, *supra* note 1, at 20.

19 *Micron Tech., Inc. v. Rambus, Inc.*, 409 F.Supp.2d 552, 554 (D. Del. 2006).

20 *Hynix Semiconductor, Inc. v. Rambus, Inc.*, 591 F.Supp.2d 1038, 1042 (N.D. Cal. 2006).

21 *Hynix Semiconductor, Inc. v. Rambus, Inc.*, 609 F.Supp.2d 998, 998 (N.D. Cal. 2009).

22 *Hynix*, 591 F.Supp.2d at 1044.

23 *Id.* at 1060.

24 *Id.* at 1064.

25 *Micron Tech., Inc. v. Rambus, Inc.*, 255 F.R.D. 135, 150 (D. Del. 2009).

26 *Id.* at 135.

27 *Micron Tech., Inc. v. Rambus*, \_\_\_ F.3d \_\_\_, No. 2009-1293, 2011 WL 1815975 (Fed. Cir. 2011).

28 *Hynix Semiconductor, Inc. v. Rambus*, \_\_\_ F.3d \_\_\_, 2009-1299, -1347, 2011 WL 1815978 (Fed. Cir. 2011).

29 Brief of Appellees Micron Technology, Inc. at xiii, *Micron Tech., Inc. v. Rambus, Inc.*, No. 2009-1263 (filed Aug. 28, 2009) [hereinafter *Micron Brief*].

30 *Micron*, \_\_\_ F.3d \_\_\_; *Hynix*, \_\_\_ F.3d \_\_\_.

31 *Micron*, \_\_\_ F.3d at 16\*.

32 *Id.* at 26–27.

33 *Hynix*, \_\_\_ F.3d at 4\*.

34 *Micron Brief*, *supra* note 31, at 7.

35 *Rambus, Inc. v. F.T.C.*, 522 F.3d 456, 466–67 (D.C. Cir. 2008).

36 *Micron Tech., Inc. v. Rambus*, \_\_\_ F.3d \_\_\_, No. 2009-1293, 2011 WL 1815975, at \*29 (Fed. Cir. 2011) (citing *Micron Tech., Inc. v. Rambus, Inc.*, 255 F.R.D. 135, 150–51 (D. Del. 2009)).

## Pioneering Pro Bono Patents - Pilot Program to Offer OPPORTUNITIES FOR IP ATTORNEYS TO GIVE BACK

**The** opportunities for patent attorneys to do pro bono work in their area of expertise are slim to none. Those who make a commitment to pro bono work, spend their time helping underserved individuals with lease agreements, child custody disputes and disability benefits. That is all about to change. A new initiative, the LegalCORPS Inventor Assistance Program, will open the door for patent attorneys to do pro bono patent prosecution.

What began as a conversation between Jim Patterson of Patterson Thuente IP and USPTO Director David Kappos has become the first in the nation pro bono program to represent low income inventors seeking to patent their inventions. If successful, other states will be encouraged by the USPTO to launch similar programs, using the Minnesota initiative as a model.

"The independent inventor community fuels innovation, which draws investments, creates new businesses and provides new jobs," said Under Secretary of Commerce for Intellectual Property and Director of the USPTO, David Kappos. "Providing assistance to these inventors is an excellent investment toward economic growth in the United States. We applaud the Twin Cities legal community for taking on this important initiative"

The project was co-founded by nonprofit legal services provider, LegalCORPS, and three Twin Cities law firms, and co-funded by a group of 13 local corporations and law firms. LegalCORPS will ultimately facilitate the program by handling intake, screening, client and volunteer attorney matching, and other case-related administrative tasks. LegalCORPS will also carry liability

insurance on behalf of its attorney volunteers. Once the program ramps up, LegalCORPS expects to handle up to 70 cases per year.

Initially, cases will come directly from the USPTO, which will review pro se filings by Minnesota applicants and offer those with technical merit the opportunity to participate in the program. Eligible applicants will be referred to LegalCORPS, which will then screen the applicant for income eligibility, commercial merit and potential conflicts. If eligibility is determined, LegalCORPS will match applicants with volunteer attorneys.

Those involved in launching the project also hope to connect applicants with reduced fee services, such as prior art searching and illustration, as well as with organizations that provide education and assistance to entrepreneurs.

The project co-founders include: LegalCORPS and the law firms of Lindquist & Vennum, Meyer & Njus, and Patterson Thuente IP. Founding funders of the project include: 3M; Barnes & Thornburg; Dorsey & Whitney; Ecolab; Faegre & Benson; Fish & Richardson; Fredrikson & Byron; Merchant & Gould; Mueting, Raasch & Gebhardt; Robins, Kaplan, Miller & Ciresi; Schwegman, Lundberg & Woessner; Shumaker & Sieffert; and Valspar.

A training session will be offered in June to attorneys interested in volunteering. Further detail about the process will be provided at that time. If you have questions or are interested in participating in the LegalCORPS Inventor Assistance Program, either as a funder or volunteer attorney, please contact Michael Vitt at (612) 278-6374 or [mvitt@legalcorps.org](mailto:mvitt@legalcorps.org).

### MIPLA Golf Outing

The Sixteenth annual MIPLA Golf Event is being held at Majestic Oaks Golf Course on Thursday, July 21, 2011. Lunch, 18 holes of golf, and dinner with all your MIPLA friends - what could be better? Registration form will be sent soon. In the interim, any firm or corporation interested in sponsoring a hole or other activity should contact:

**Tim Czaja**

612-573-2004 or [czaja@dbclaw.com](mailto:czaja@dbclaw.com)

## MIPLA Committee UPDATES

### AIPLA/WIPLA Networking Dinner a Success

On May 4th, about fifty women IP professionals gathered at Windows on Minnesota for an evening of CLE, networking, and tasty dessert. The evening began with an elimination of bias CLE entitled "Is it Really All About the Shoes?" presented by Ms. Patricia Gillette of the Orrick law firm in San Francisco. The CLE continued with a panel discussion among Ms. Gillette, Ms. Kathy Kowalchuk of Merchant & Gould, and Ms. Denise Kettelberger of Faegre & Benson. The dinner was part of the AIPLA North American Women in IP Networking Event where women IP professionals in twenty-five cities across the U.S. and Canada gathered for a communal evening of networking. Everyone left with some new connections and one hour of approved bias credit. The Minneapolis event was sponsored by Merchant & Gould and WIPLA.

WIPLA's next event will be a cocktail reception held in connection with the Midwest IP Institute in late September.

**Erin Nichols Matkaiti**  
Hollingsworth & Funk, LLC

### Patent Litigation Committee

The Patent Litigation Committee held a timely presentation on issues relating to induced infringement only a few days after the issue was argued to the U.S.

Supreme Court on February 23, 2001 in the case Global-Tech Appliances Inc. v. SEB, S.A. [Case No. 10-6]. Tony Beasley of Robins, Kaplan, Miller & Ciresi provided a very good presentation and analysis of the case addressing the state of mind necessary to support induced infringement and standards that may be adopted by the Supreme Court that address those issues. Committee members attended both in person and via conference call as part of a brown bag lunch meeting format adopted by the committee this past year.

The Patent Litigation Committee conducted a few of these meetings over the past year to address timely topics that are of interest to the members of the committee. The Litigation Committee continues to look for members or future members who are interested in presenting on a topic or helping organize group meetings or gatherings. The year has gone by very quickly and I would like to thank the committee members who presented or attended our meetings over the past year and encourage anyone interested in the MIPLA litigation committee to become more involved and help grow the committee. Thank you and I wish everyone a great Minnesota summer—once it arrives!

**Mike Pape**  
Fish & Richardson, P.C.

## MIPLA committees

If you are interested in getting involved in any of the committees, please contact the current chair/co-chairs.

### Biotechnology/Chemical – Co-Chairs:

Loren Albin, Charles Marabella and Paul Parins

**CLE – Chair:** Brad Forrest

**Copyright:** Chair, Ken Kunkle

**Corporate Practice:** Chair, Paul McDowall

**Events:** Chair, Victor Jonas

**IP Law Revision:** Chair, Brad Pederson

**International Law / EPO:** Chair, Jeff Cameron

**IP Licensing:** Chair, Greg Sebald

**New Matter:** Editor, Laurie Young

**Patent Agents:** Co-Chairs, Stephen Crooks and Nathan Lee

**Patent Litigation:** Chair, Michael Pape

**Patent Prosecution:** Co-Chairs, Tim Bianchi and Ted Magee

**Software Protection:** Chair, Paul Godfread

**Trademarks & Unfair Competition:** Chair, Bruce Little

**US Bar-EPO Liaison:** Chair, Jamie Ackley

**WIPLA:** Co-Chairs, Kathy Kowalchuk and Erin Nichols Matkaiti

## In Memoriam MEMORIALS

Recently, the Hennepin County District Court, in association with the Hennepin County Bar Association, conducted a memorial session to honor and remember those attorneys that have recently passed away. MIPLA member James R. Haller was among those memorialized.

Although he did not practice in Hennepin County, we also need to acknowledge the contributions of Daniel R. Pastirik to our local IP and legal community.

It is critical that we pause and reflect on those that have come before us and helped make our Minnesota IP community as strong and vital as it is today. By doing so, we honor those who have left us for their service to their clients, to the legal community in general, to each of their broader social communities, and for their devotion to their families.

As you can see by reading each of these short memorials, each person made a significant difference in the lives of many, far beyond the daily impact of providing legal services to their clients. We are grateful for having known them, and for having been their colleagues.

**Jim Young**  
Westman, Champlin & Kelly, P.A.

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### IN MEMORIAM

JAMES ROY HALLER

*June 20, 1935 – December 28, 2010*

Jim was born June 20, 1935, and raised in La Crosse, Wisconsin. He graduated from the University of Wisconsin-Madison in 1962 with a bachelor's of science in chemical engineering and later worked at 3M while earning his law degree from William Mitchell College of Law in 1969.

After graduating from law school, he worked in 3M's Office of General Counsel in its Intellectual Property Department. He entered private practice in 1972 and joined Fredrikson & Byron in 1977, where he founded and led the firm's Intellectual Property Department and spent the remainder of his career.

Before Jim, there were a few unsuccessful efforts to start an IP practice at Fredrikson. When Jim arrived and became

the new "founder," it was clear that it would be successful – that a department would be built on that foundation and around him. He was generous with his time as he mentored young lawyers on the finer points of IP law, helping those around him grow into experts whom he would trust. To many of us, his patent claims read more like poetry than prose. Jim taught us the importance of honesty, integrity and hard work, but balanced these ideals with great humor. He taught the need for critical thinking, but balanced this with the joy of wonder.

We always felt a great sense of comfort knowing Jim was around because we could go to him with our greatest challenges and he would help us solve them every time. Bouncing difficult questions off Jim was akin to bouncing them off a judge. His judgment was superb, and his value as a lawyer in our department was incredible. If one was to tally all the wins the IP department has had over the years, it would be tough to find one where Jim's influence did not play a role in the success.

I am still in awe as to how he could command such a presence with his gentle professionalism. Jim had grace and dignity, not to mention a positive attitude – always asking, by name, how my kids were, recalling their ages and what they enjoyed doing – all while he was battling his illness.

Jim had a truly exceptional character – humility, genuine kindness and compassion for others. He loved the practice of law. He had a deep attachment to his friends, family, colleagues and clients, and was considered a mentor to many.

Outside of work, Jim's passions included spending time with family, reading, sailing on Lake Pepin and traveling the world with his best friend, love and wife, Audrey. One of his favorite experiences was sailing the Greek Islands with his wife and family in 2007.

After waging a courageous four-year battle with lung cancer, our beloved Jim died peacefully surrounded by his family on the evening of December 28, 2010. He is survived by his wife Audrey; sons, James (Jane), Joseph (Kristen) and John (Anne-Marie Mischel); and grandchildren, James, Daniel, Amelia and Emmett. He will be deeply missed.

**Chuck Segelbaum**  
Fredrikson & Byron, PA



## Memorials continued

### IN MEMORIAM

DANIEL ROBERT PASTIRIK

*November 28, 1957 – February 27, 2011*

Dan Pastirik was a patent attorney at 3M and, before that, a partner in a Chicago law firm. But more than that, he was a son, a father, an uncle, and a friend and colleague to many. He will be deeply missed by all.

Dan was born in Chicago on November 28, 1957 – Thanksgiving Day; at the age of five he moved to Des Plaines, Illinois where he spent his youth.

Dan's evolution as a patent attorney followed a path that is familiar to many. He received a bachelor's degree in chemistry from the University of Illinois in 1981 and embarked on a career as an analytical chemist working for Universal Oil Products in his hometown of Des Plaines. He soon met Julia Anders whom he married in 1982.

With the strong support and encouragement of Julia, Dan enrolled in the Chicago-Kent College of Law affiliated with the Illinois Institute of Technology, at first on a part-time basis and then as a full-time student. He graduated with honors in 1987.

Upon graduation, Dan joined the Chicago law firm of Alex, Fitzgibbon, Cummings and Lockwood where he quickly became an accomplished litigator and then a partner.

In 1994, Dan made a seminal decision – to leave Chicago and law firm practice and move to the Twin Cities and go "in-house," joining 3M's Office of Intellectual Property Counsel. During his nearly 17 years at 3M Dan was the lead patent attorney for businesses in fields as diverse as home care products, roofing materials, abrasives, adhesives, tapes, medical products, batteries, and air and water filtration products.

Dan enjoyed a complete practice, drafting and prosecuting patent applications, handling large and complex transactions, and managing litigation in the U.S. and overseas. He brought a low-key, quiet style to all of these matters that inspired trust and confidence in his clients who characterized his professional skills using words such as reliable, dependable, diligent, dedicated, meticulous, and collaborative.

Beyond his "client work," Dan was a big part of 3M's intellectual property department. At one time or another he chaired every major committee in our office. And as his personality and demeanor made him a natural teacher; he mentored and coached the professional development of at least a half-dozen 3M patent attorneys and patent agents. To his work colleagues Dan was a kind, caring, considerate, compassionate, modest, and unassuming man who was a good listener with a sense of humor. Although Dan's legal skills were valued, it is as a friend that he will be missed.

But Dan was much more than a legal professional. Stepping into his 3M office for even a moment you would see the many pictures of Julia and his daughters, Stephanie and Amanda, showing that, first and foremost, Dan was a family man, a devoted father, and a loving husband. To his family, Dan was a long-time softball coach who lugged equipment around town for his daughters' weekend practices and tournaments, a husband who stayed home with his girls while Julia ventured to Haiti to build an orphanage, a health enthusiast who loved running, and a man who enjoyed reading and travel.

In addition to his wife of 29 years, Julia, daughters Stephanie (21) and Amanda (16), Dan is survived by his mother, Mary Ann, brothers Robert, William and David, and several nieces and nephews.

## Recent Events

### 2011 MIPLA ANNUAL MEETING / YOUNG INVENTORS



Sharna Wahlgren opened the event.

**AT THE ANNUAL MEETING** on May 23, the new slate of MIPLA officers and revisions to the Bylaws were approved. Tim Czaja received the President's Award for his outstanding service and dedication to MIPLA in arranging the MIPLA Golf Outing since 1999, and Brad Forrest received the President's Award for his outstanding service and dedication to MIPLA in arranging the Stampede for the last six years. Congratulations, Tim and Brad!

**THE YOUNG INVENTORS' DINNER** was held on May 23, 2011 at Windows in the IDS building. It was a successful event with 10 young inventors (grades 3-6) from the metro area present to show off their inventions. Each young inventor was presented with a certificate congratulating them on their achievement. This dinner is always a highlight of the year because the MIPLA members in attendance have the opportunity to see how creative children can be when it comes to items which they feel need to be invented. The following students presented their inventions to the MIPLA members in attendance.

#### **JESSE CALDWELL-TAUTGES**, Age 12

(received the MIPLA Thinking Outside the Box Award at the Young Inventors Fair on April 30, 2011)

Grade 6 - St. Louis Park Jr. High

#### ***Go Green Pop Machine***

This remarkable prototype saves three things that are important to all of us savvy soda drinkers: The environment, money and TIME. Use your very own bar-coded/scanable stainless steel cup and never again worry about having to dig in your desk drawers for change when you are hankerin' for a soda.

#### **HAILEY DELUCA-DAVIS**, Age 11

Grade 5 - Nellie Stone Johnson Community School

#### ***Math Chairs***

It's a game! It's a lesson! It's Math Chairs! If you enjoy Musical Chairs, then you will LOVE this new, active and exciting way to practice your math skills. Multiplication, Addition, Subtraction, Division... you name it, we'll play it (and actually learn it!).

#### **LUKE JOHNSON**, Age 8

Grade 3 - Lake Harriet Community School

#### ***Mystery Prize***

Get your chores done AND have fun by using this exciting game that involves teamwork, scavenger hunts and PRIZES!

#### **GABRIEL PILLA**, Age 12

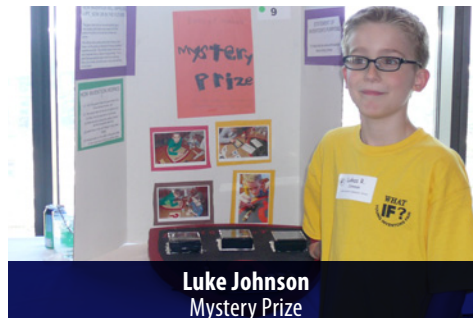
Grade 6 - Carondelet Catholic School

#### ***Pitch Back Machine***

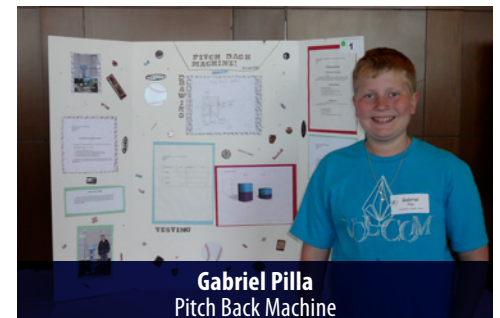
Don't worry if there is no one nearby with which to practice your mad baseball skills. This cool invention



Jesse Caldwell-Tautges  
Go Green Pop Machine

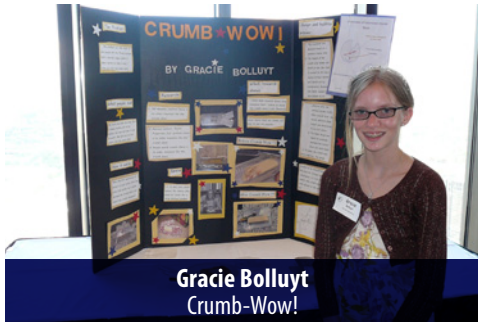


Luke Johnson  
Mystery Prize



Gabriel Pilla  
Pitch Back Machine

## Young Inventors' Dinner continued



**Gracie Bolluyt**  
Crumb-Wow!

allows you to throw and pitch without the help of anyone or anything but an electrical outlet.

**CASSIDY GEDDES**, Age 11  
Grade 6 - Carondelet Catholic School

### *Baggie Holder*

Ever need an extra hand when attempting to fill a Ziploc bag with potato chips? Look no more! This unique gizmo allows you to effortlessly hold the sides of the bag open while you fill to your heart's content...

**GRACIE BOLLUYT**, Age 10  
Grade 5 - Red Pine Elementary

### *Crumb-Wow!*

Crumby butter? Not anymore! This cleverly simple little gadget keeps the soggy crumbs out of the butter and keeps the butter dish looking fresh and lovely.

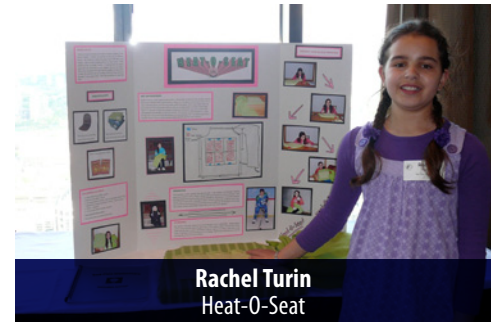
**ALEX KOCH**, Age 9  
Grade 4 - Jonathan Elementary School

### *Superb Saucepan Separator*

Does one of your kids like long spaghetti noodles and the other like elbow mac? You COULD cook them in the same saucepan and let them eat only what they like, OR you could try this fun little invention and keep both kids happy



**Alex Koch**  
Superb Saucepan Separator



**Rachel Turin**  
Heat-O-Seat

(and you will be happy, too – because you only have to dirty one saucepan).

**RACHEL TURIN**, Age 9  
Grade 4 - Red Pine Elementary

### *Heat-O-Seat*

Cold buns at the skating rink? Keep your backside warm by taking the Heat-O-Seat with you to all chilly endeavors...

**ADAM LABIOSA**, Age 10  
Grade 4 - Greenleaf Elementary School

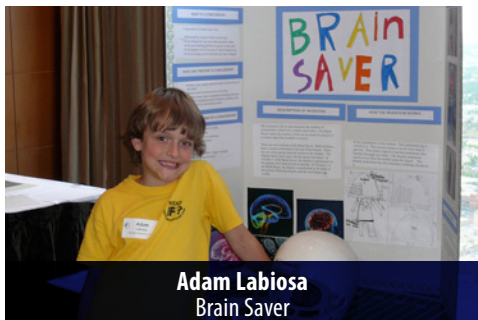
### *Brain Saver*

Keep your contact-sport athletes safe by using this ingenious sensor that monitors and records the number of times a player receives an impact on the head during a game. Parents and coaches can monitor an athlete's number of impacts and decide if she or he can still play or if they should "sit this one out."

**ISAAC TROCKMAN**, Age 9  
Grade 3 - Lake Harriet Community School

### *Sogg-be-gone*

Is soggy cereal getting you down? No need to suffer any more drippy breakfasts. You can have a crunch-tastic day if you use this smart little nesting bowl contraption.



**Adam Labiosa**  
Brain Saver



**Isaac Trockman**  
Sogg-be-gone



Robin Sannes incoming President, presented Hallie Finucane with an appreciation award for serving as the 2010 - 2011 MIPLA President.

## Annual Meeting photos



Hallie Finucane MIPLA President presented Brad Forrest from Schwegman, Woessner & Lundberg with the President's Award



Hallie Finucane, MIPLA President, with the MIPLA scholarship recipients



Hallie Finucane MIPLA President presented Tim Czaja from Dicke Billig & Czaja PLLC with the President's Award

### Hamline Law School

The IP Moot Court Program for Hamline University School of Law just finished a very successful season. Both teams received honors at tournaments they competed in. The team of Matt Greenstein and Ryan Meehan advanced to the championship round at the MIPLA Cup, finishing as first runner-up. The team of Steve Helseth and Jennifer Middleton finished first runner-up at the Chicago Regional Competition for AIPLA's Giles Sutherland Rich Competition, advancing to the National Round of the competition in Washington, D.C. The trip to Nationals provided the team with the unique opportunity to argue in the Court of Appeals for the Federal Circuit and the team (Steve and Jennifer) finished as semi-finalists at Nationals. Hamline University and the members of its IP Moot Court Program would like to thank MIPLA for its support of the MIPLA Cup and MIPLA's members who helped as practice judges and MIPLA Cup judges to prepare the teams for competition.

#### Jeffrey Cameron

Brooks, Cameron & Huebsch, PLLC

### William Mitchell Students win Minnesota Intellectual Property Law Association Cup Competition

For the second consecutive year, a team of William Mitchell students has won the annual Minnesota Intellectual Property Law Association (MIPLA) Cup Competition. Third-



Hallie Finucane with the MIPLA Cup Participants



MIPLA Cup presented to the 1st place team from William Mitchell, Abigail Tyson and Ochen Kaylan.

year Mitchell students Abigail Tyson and Ochen Kaylan were awarded first place in the final round, arguing against a team from Hamline University. The MIPLA Cup winners receive a \$5,000 scholarship.

William Mitchell is the only Minnesota law school to have placed a team in the final round of the MIPLA Cup Competition each of the four years in which it has taken place. This year's competition included 7 teams from Minnesota's four law schools. Teams present oral arguments before competition judges, who are among the state's most distinguished intellectual property law practitioners.

MIPLA sponsors the MIPLA Cup Competition to help Minnesota law

schools prepare their teams for the Giles Rich Intellectual Property Moot Court Competition, which held a Midwest Regional Competitions on March 13. The Tyson/Kaylan team advanced to the semi-final round of the Midwest Regional Competition. Third year Mitchell students Jennifer Enskat and Chad Hammerlind also participated. Mitchell's teams were coached by Jim Baker '03, intellectual property counsel at 3M.

#### Kristine Dorrian

National Arbitration Forum