

New Matter

New Matter is a trademark of the Minnesota Intellectual Property Law Association, and is registered with the U.S. Patent and Trademark Office.

Fall 2001

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MIPLA MINNESOTA
INTELLECTUAL
PROPERTY LAW
ASSOCIATION

MIPLA 2001-2002 Officers and Board of Directors

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- Bradley A. Forrest, President
- Phil Goldman, Vice President
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- Jay Brooks

MIPLA 2001-2002 Committees

Auditing

James Young, Chair. jlyoung@kinney.com

Biotechnology / Chemical Law

Mark Skoog, Chair. mskoog@merchant-gould.com

Bylaws Revision

Timothy Czaja, Chair. taczaja@dbclaw.com

Continuing Legal Education

Timothy Bianchi, Cochair. tbianchi@slwk.com
Chad Hanson, Cochair. hanson@fr.com

Copyright Law

Steven Lieske, Cochair. slieske@oppenheimer.com
Julie Finch, Cochair. jfinch@hinshawlaw.com

Corporate Practice

Shawn Dempster, Chair. sbd@legal.stsv.seagate.com

Ethics

Bradley Forrest, Chair. bforrest@slwk.com

Intellectual Property Law Revision

Sten Hakanson, Chair. stenh@cornelius.com

Intellectual Property Licensing

Paul Busse, Chair. pbusse@faegre.com

International Law

Min Xu, Cochair. axu@merchant-gould.com
R Moy, Cochair. cmoy@wmitchell.edu

Nominations

James Young, Chair. jlyoung@kinney.com

Patent Litigation - ADR - CAFC

David Gross, Chair. dgross@faegre.com

Programs

Jeffery Cameron, Cochair. jeff@nrslaw.com
Glenn Seager, Cochair. seager@cstlaw.com

PTO Committee

Michael Smith, Chair. msmith@slwk.com

Public Relations

Jay Brooks, Chair. jbrooks@slwk.com

Publications

Eduardo Drake, Chair. drake@slwk.com

Software Protection

Thomas Brennan, Chair. tbrennan@slwk.com

Trademarks

James Voegeli, Chair. jfvoegeli@mmm.com

Women in Intellectual Property Law

Dina Colling, Chair. dmcolling@kinney.com

MIPLA MSBA Board of Governors Representative

John L. Gresens, jgresens@merchant-gould.com

MIPLA NCIPLA Delegate

Jay Brooks, jbrooks@slwk.com

MIPLA US Bar/EPO Liaison

John Hornickel

MIPLA MSBA House of Delegates Representative

Stephen R. Schaefer, schaefer@fr.com

MIPLA MSBA Administrator

Sue Bores, sbores@statebar.gen.mn.us

MIPLA 2002 Schedule

January 2002	Authors and Inventors Night	Contact: Glenn Seager
February 2002	Bowling Social (tentative)	Contact: Jeff Cameron
March 22, 2002	MIPLA Formal	Contact: Mara Liepa
May 8, 2002	MIPLA Annual Meeting/Young Inventors Dinner	Contact: Jeff Cameron
July 18, 2002	Golf Social	Contact: Tim Czaja

Other events in the works:

Socials at law firms around town: one every two to three months with MIPLA paying for the event

Meet and greets at the Law Schools, organized by Public Relations Committee, have been small information type sessions, but may be full social events hosted by the Programs Committee; however, the format is still in flux.

Anyone wishing to help with the planning or execution of these events should contact the event organizer listed above.

Plug For Inventor Recognition Night

Our annual MIPLA Inventor Recognition Dinner is currently being planned.

This is a great event for recognizing your inventors. They receive dinner, an excellent speech, and a proclamation from the Governor recognizing them as a Minnesota Inventor. You can create some pretty good good will with inventors and the companies they work for by sponsoring your favorite inventors at this dinner. When I worked for a large company in Rochester, a photo of the inventors was posted in multiple hallways, and one was autographed for me with congratulations from the highest ranking executive in the plant.

As you can see, not only do inventors appreciate the recognition, it can help your career too. This



year, we are planning for exhibition space prior to the dinner for inventors to show their stuff. After dinner, attorneys introduce their inventors and they are given their individual proclamations. It makes for a very interesting and rewarding evening. Bring one or more inventors to this event and they will forever be in your debt. Well, maybe not, but it is a fun event, and they will appreciate you for it.

Look for details of this event in the coming weeks. Line up your inventors now, as it can take a couple weeks to get the proclamations. We look forward to seeing you and your inventors at this event.

Bradley A. Forrest



MIPLA Urges U.S. Senate to Approve Rogan



October 24, 2001

Honorable Patrick Leahy, Chairman
Committee on the Judiciary
United States Senate
Washington, DC 20510

Honorable Orrin Hatch, Ranking Minority Member
Committee on the Judiciary
United States Senate
Washington, DC 20510

Dear Mr. Chairman and Senator Hatch:

This letter is written on behalf of the Minnesota Intellectual Property Law Association to urge prompt action in the Committee and Senate on the nomination of former representative James Rogan as Undersecretary of Commerce and Director of the United States Patent and Trademark Office (USPTO).

The USPTO plays a key role in the intellectual property system of the United States, which helps create new jobs, protect U.S. industries from unfair foreign competition, maintain a healthy economy, and advance the well-being of all our citizens. Two years ago, when you and your colleagues in Congress wisely decided to give greater responsibilities to the Office and its Director, you made that role even more critical. The American Inventors Protection Act provides that the USPTO “shall exercise independent control of its budget allocations and expenditures, personnel decisions and processes, procurements, and other administrative and management functions.” To carry out these responsibilities, the Office must have the leadership mandated by Congress — a Director who has been selected and nominated by the President, and in whom the support of the Congress has been reflected in a Senate vote to confirm.

The increasing attention that Congress is giving to improving the management and direction of the USPTO, as exemplified in the mandates in pending appropriations and authorization legislation for it, make the need for leadership by the USPTO Director all the greater.

The PTO needs to act diligently now to avoid slipping further behind on its increasingly large workload, let alone catch up on its already too long backlog. The current threat of economic recession also argues that the USPTO should have its leadership in place now, to fill fully and ably its traditional role of encouraging investment in the creation of new jobs and new industries.

We therefore urge your prompt action on the nomination of James Rogan.

Sincerely yours,

Bradley A. Forrest
President
Minnesota Intellectual Property Law Association

cc: MIPLA Board

NCIPLA Report

By: Jay Brooks



Jay Brooks, MIPLA NCIPLA representative, and Brad Forrest attended the recent NCIPLA meeting during AIPLA in DC. The acting commissioner, Nick Godici, provided some insights into the state of the patent office and glimpses into their five year plan that is currently being prepared. The PTO plans to move into its new space by the end of 2003. On the PTO hiring

front, attrition is down from 14% to 7.8% and their office has increased hiring from 200 examiners in the previous year to 400 new examiners over the past year, such that the PTO is experiencing a net increase in examiners. The PTO has experienced an average 11-12% growth in the number of patent filings (6-8% in mechanical/chem. related apps and 20% is electrical related apps). An average pendency for first office actions is 14.4 months, but the PTO has still not cleared its backlog and there is a wide discrepancy in the figure between bio-tech and electrical cases (avg. 1 yr for bio-tech, 18-19 mos. for electrical). It was estimated that approximately 24% of pending cases may qualify for term extensions with an average term added of 32 days. On the quality front, the PTO reports that over the past year the error rate has dropped from 6.7 to 5.7%. The bulk of the five year plan appears mostly to address the "electronic" status of the office, and how they have a goal for going almost entirely paperless in the future.

Anne Chasser, Director of the Trademark Office was also present to summarize the status of her office. She reported that the amount of trademark filings were down to around 300 thousand filings. As such, the Trademark Office currently has more examiners than are needed for new filings. However, the office will not be making any cutbacks in their ranks of 383 examiners since they have appropriately budgeted to support this number and are using this surplus of examiners to tackle their backlog. Further, Anne noted that filings seem to track the NASDAQ. Just like the NASDAQ, no one can predict the filing rate.

A member from the Governing Bodies committee attended the meeting and commented on the following points. First, it was noted that a review of domain names report has recently been issued by WIPO. Their position is to keep the review

within the standings committee of TMS vs. in the hands of WIPO. Second, a position on Festo was expressed. In their amicus brief, they support efforts to re-characterize the definition of what a "narrowing amendment" means. Recognizing the concern for notice and certainty, it was expressed that the assumption that any amendment was made for narrowing reasons should be a rebuttable presumption and not an absolute. Third, it was noted that the Federal Circuit recently handed down a decision stating that the USPTO the same standard of review as that of other administrative offices, e.g. a substantially erroneous standard.

Finally, an amendment to the bylaws of NCIPLA was proposed to make it easier for the association to take positions on current issues. Currently, unanimous consent of all the member organizations is required. The proposed changes would allow the board to take a position and note that certain member organizations did not support the position. MIPLA has decided not to support the amendment. While the current leadership of the organization indicated that it would not take a position in that type of situation, we were uncertain what future leaders would do.

PR Committee Report

By: Jay Brooks

Over the course of the past year the Public relations committee was involved in an extended outreach to our local law schools. Members from MIPLA visited and spoke to the IP student sections at William Mitchell and Hamline School of law. The committee initiated and sustained a dialogue with the respective presidents and other student members of these groups at the various schools. In this manner, awareness and involvement in MIPLA by the next generation of IP practitioners was increased. Similar efforts will continue in the coming year.

The committee aided and complimented MIPLA's Young Inventors Night. The committee further coordinated a presence at the Minnesota Inventors Congress held annually in Redwood Falls, MN.

Most recently, members of the committee actively participated in recruiting attendance for the annual New Member Social and Intellectual Property Bowl. This event gave current members the opportunity to share in conversation with their colleagues around town, meet new members and engage in some good natured competition.

MIPLA CLE on Electronic Filing a Success

By: *Tim Bianchi*



MIPLA hosted a CLE and luncheon concerning electronic filing of U.S. patent applications on Thursday, October 11, 2001. The featured speaker, Administrator Frederick Schmidt of the USPTO Search and Information Resources Administration, addressed a group of about 70 attorneys, paralegals and staff on electronic access and electronic filing of patent

applications. He encouraged all practitioners to obtain an encryption key for access to records using the USPTO's PAIR system. He also discussed recent changes and improvements to the electronic filing software (EFS).

of EFS would become available soon. According to Administrator Schmidt, each registered patent agent and attorney will receive a copy of the latest version of EFS. Mr. Schmidt also informed us that the EFS software will operate on several versions of Microsoft Windows(TM), but would not be developed for Macintosh systems. After his presentation, Administrator Schmidt answered questions from the audience.

Our additional guest speaker was Dr. Mark Horsburgh from the law firm of Fisher, Adams & Kelly, in Queensland, Australia. Dr. Horsburgh addressed several topics relating to changes in Australian patent law, including electronic access and filing issues with the Australian Patent Office. Dr. Horsburgh also logged into the Australian Patent Office website for a special presentation of the features now supported.

A moment of silence was offered by all in attendance as a sign of respect and consideration for all affected by the tragic events of just one month earlier. MIPLA is indebted to both of these fine speakers for making their presentations despite travel complications and difficulties arising from the tragedies at the World Trade Center and Pentagon.

For example, the latest version of EFS will include a feature for submission of provisional patent applications. The attendees were also interested to learn that a network version



Young Inventor Thanks MIPLA For Opportunity

Dear Jeff and MIPLA,
Thank you for giving me the opportunity to show my invent
I had a lot of fun showing it!
Thank you for inviting me and
my parents to come have dinner
we really enjoyed it!

Sincerely,
Michael Green
Inventor of The
Double Camera

New Member Social/ Intellectual Property Bowl III

By: *Jeff Cameron*



The New Member Social and third annual Intellectual Property Bowl was another success with encouraging membership turn out despite the enticing, unseasonable warm weather on the evening of the event. This year's event was held on the second floor at Bravo's in downtown Minneapolis. Our space on the second floor afforded a nice overlook of the Theater strip while enjoying socializing and refreshments.

To start the event, an amendment to MIPLA's By-Laws was ratified, reducing the annual dues for student membership to \$10. Next, new members and student guests were introduced and welcomed by the MIPLA organization. Many students from our local law schools turned out for the event, despite conflicting evening class schedules. And, it is believed that the student attendance represents a growing interest in our organization among

matriculating IP students. The reasonably sized gathering enabled most to speak to and interact with the new members and student attendees.

The evening then progressed to the Intellectual Property Bowl tournament. Phil Goldman of Fredrickson & Byron generously volunteered his time to once again MC the tournament. The tournament now includes a full range of questions across the disciplines of patent, trademark and copyright law. As such, it is hoped MIPLA members from each of these respective practices will be encouraged to participate in the coming years. Phil produced a myriad of patent, trademark, and copyright questions. These questions, more often than not, stumped the participants. Many thanks to Phil for providing us all with some humility.

Five teams participated in the event. Among the participants were teams from Fredrickson & Byron, Kinney & Lange, Merchant & Gould, SLWK, and Nawrocki, Rooney & Sivertson. This year's champion is the team from Nawrocki. Challenges are issued to our fellow practitioners for next year!

Photos courtesy of Brad Forrest.



David Peterson and Arlene Forrest



Unknown MIPLA Socialites.



*l. to r.:
Mark Gambetta,
Gary Speier, and
Marv Beekman.*



MIPLA Board member Chuck Rubow (far right) with new members.

*l. to r. Dustin
Du Fault,
Jo and Dave
Fairbairn..*





Three new members.



Pictured left to right: John Gould and Larisa Vishkovetsky.



Law students at New Member Social.

*l. to r. Jay Brooks,
Jeff Cameron,
Walt Linder.*



MIPLA Intellectual Property Bowl III

Photos by Brad Forrest



*Fredrikson & Byron squad, (left to right) Eric Snustad,
Raymond Russell, and Tom McMasters.*

*Schwegman-Lundberg
Band (left to right):
Mark Gambetta,
David Peterson, Gary
Speier laugh in the
face of adversity.*



*Host-with-the-
most, Phil
Goldman, lights
up the night as
Kinney & Lange
team watches.*

*Nawrocki,
Sivertson dares
to glare, as
competition for
the coveted cup
heats up.*





*Kinney & Lange
team (left to right):
Dave Fairbairn,
Mai Lauer, and
Dustin DuFault.*

*Nawrocki,
Sivertson &
Rooney wins cup,
with aid of Jay
Brooks of
Schwegman,
Lundberg. Pic-
tured left to right
are Jay Brooks,
Jeff Cameron,
Rick Stempkovski,
Jr., and Phil
Goldman.*





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.

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.

Brad Forrest
MIPLA President
612-373-6972

bforrest@slwk.com

Visit the MIPLA
Home Page --

www2.mnbar.org/mipla

The MIPLA website includes:

- MIPLA Schedule of Events
- Jury Instructions
- Committee Chair Names
- Committee Chair Reports
- 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.

New Members

Ms. Diane Miller
The Pillsbury Company
200 S Sixth St
MS 3726
Minneapolis, MN 55402
Phone: 612-317-1447
Fax: 612-330-8893
dmiller@pillsbury.com

Mr. Matthew Graham
2775 Lexington Av N #219
Roseville, MN 55113
grah0058@tc.umn.edu
Student

Mr. Richard Kempf
Maslon Edelman Borman & Brand LLP
90 S Seventh St #3300
Minneapolis, MN 55402-4140
Phone: 612-672-8200
Fax: 612-672-8397
Rick.Kempf@maslon.com

Mr. Charles Ho
1314 Marquette Av #502
Minneapolis, MN 55403
charles_ho@yahoo.com
Student

Ms. Roseann Bour
4314B Clemson Circle
Eagan, MN 55122
rjbour@law.com
Student

Mr. Nicholas Boebel
Robins Kaplan Miller & Ciresi LLP
800 LaSalle Av #2800
Minneapolis, MN 55402
Phone: 612-349-8500
Fax: 612-339-4181
nsboebel@rkmc.com

Mr. Fernando Tibayan
15330 18th Av N, #913
Plymouth, MN 55447
Phone: 763-258-2702
ftibayanjr@yahoo.com

Mr. John Crimmins
Faegre & Benson LLP
90 S Seventh St #2200
Minneapolis, MN 55402-3901
Phone: 612-766-7749
Fax: 612-766-1600

Ms. Cecilia Jaisle
Gray Plant Mooty Mooty & Bennett PA
33 S Sixth St
Minneapolis, MN 55402-3796
Phone: 612-343-2903
Fax: 612-333-0066
cecilia.jaisle@gpmlaw.com

Mr. John Haack
Schwegman Lundberg Woessner & Kluth PA
121 S Eighth St #1600
Minneapolis, MN 55402
Phone: 612-359-3270
jhaack@slwk.com

Mr. Robert Kalinsky
Merchant & Gould PC
80 S Eighth St #3200
Minneapolis, MN 55402
Phone: 612-336-4771
Fax: 612-332-9081
rkalinsky@merchant-gould.com

Mr. James Rodgers
Crompton Seager & Tufte LLC
331 Second Av S #895
Minneapolis, MN 55401
Phone: 612-677-9050
james.rodgers@cstlaw.com

Ms. Sonya Southward
3435 Holmes Av
Minneapolis, MN 55408
Phone: 612-823-4767
ssouthward@tpt.org
Student

Mr. Erik Drange
565 W Sandhurst Dr #105
Roseville, MN 55113
Phone: 651-494-1025
erik_drange@adc.com
Student

Ms. Catherine Prody
2238 Ulysses St NE
Minneapolis, MN 55418
Phone: 612-781-9022
cprody@qwest.net
Student

Ms. Erin Nichols
1609 Pleasant St #208
Lauderdale, MN 55108
Phone: 651-603-0836
enichols@wmitcheil.edu
Student

Mr. Charles A Jacobson
Merchant & Gould PC
80 S Eighth St #3200
Minneapolis, MN 55402
Phone: 612-766-6054
Fax: 612-332-9081
cjacobson@merchant-gould.com

Mr. Brian Stakston
228 N Victoria St #3
St Paul, MN 55104
Phone: 651-225-1322
bstaksto@wmitcheil.edu
Student



Note: Address changes will be reflected in the 2002 MIPLA Directory -- due out in January.

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:

- \$85 Active \$10 Student
- \$42.50 (1/1/02-6/30/02) Active

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