

New Matter®

Winter 2003

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Letter From The President

To My MIPLA Colleagues:

My reign, or rather tenure, as MIPLA President is now well over half completed, and provides me with the ideal opportunity to *both* reflect on our accomplishments to date, and to plan for the activities and events we have remaining, while also preparing to hand the baton to Tim Czaja.



Finally, and in synch with my original goal, we seem to have revitalized a fair number of Committees, with several more still to go, while maintaining the expected high level of activity from many others, including the CLE, Program, Biotech/Chem, and Women in IP Law Committees. Kudos also to Sue Bores, for her help throughout the year, and her determination in publishing the new and improved MIPLA directory.

Our 2002-2003 year has been highlighted by several successful events, including our summer golf tournament, which continues to be a high point of the year, and our first ever “meet the firm” open houses, with more in the works. The first open houses, hosted by Fredrikson & Byron and Merchant & Gould, were both well attended and equally well received. In addition to good food and company, they seem to provide an ideal opportunity for the many local law students having IP interests to rub elbows with the rest of us, in an informal and easy way. In turn, the Association has continued our tradition of funding scholarships at the various law schools to support students hoping for a career in IP.

On a more educational and international note, we were graced by a “News from WIPO” presentation by our mutual colleague, Jay Erstling, who is currently serving in his first year as US Director to the PCT at WIPO in Geneva. Jay’s first session sold out within hours of it being posted, leading to a second session for the overflow crowd.

Events to come include the Author’s and Inventor’s Night Dinner, the Spring formal fling, and the Young Inventors Night Dinner/Annual Meeting in May, together with a wide variety of MIPLA organized or sponsored CLE events.

In March, I will be following in Brad Forrest’s footsteps and joining other state IP association Presidents in attending the annual Judge’s Night Dinner (a black tie event at the Waldorf, no less), sponsored by the New York Intellectual Property Law Association.

Other events underway or still unfolding include proposed “brown bagger” lunch sessions that will permit practitioners and others to get together even more frequently, and informally, in order to get to know each other better, and explore areas of mutual interest.

Thanks to all for your help and ideas to date, and looking forward to an active and good Spring.

Phil Goldman

Orrin M. Haugen Memorial

Orrin M. Haugen, one of the senior members of the Minnesota Intellectual property Law Association passed away on March 1, 2003, at the age of 75. Orrin was active in the practice of law for 53 years and at the time of his death was practising law with his son Eric at Haugen Law Firm PLLP. His PTO Registration number was 17972, indicating his early entry into, and long service in, the practice of patent law. He will be remembered as a skilled patent attorney, both as a

patent office practitioner and a litigator. He was always ready to tell or listen to a good story or joke, but was a tough and principled opponent when representing his clients. He loved the practice of law but found time to enjoy outdoor activities, such as skiing at Jackson Hole. He is survived by his wife of 52 years, Marilyn, four children and their spouses, and nine grandchildren.

Submitted by Nick Westman

Minnesota Firms Earn Top National Rankings for Patent Quality

Submitted by Brad Forrest

Five Minnesota firms captured a grand total of 11 top-ten national rankings for patent quality in a study published by *IP Law & Business*. Schwegman, Lundberg, Woessner & Kluth (SLWK) ranked among the three best firms in the nation in five of the six technical categories studied, specifically earning first-place rankings for its biotech, computer, and medical patents; a second-place ranking for its electrical patents; and a third-place ranking for its chemical patents. Dorsey & Whitney finished second, fourth, and fifth, respectively, in the computer, electrical, and chemical categories. The final three notches for Minnesota firms were won by Mueeting Raasch & Gebhardt, which won a number one ranking for its chemical patents, Vidas Arrett & Steinkraus, which won a number two rating for its medical patents, and Crompton, Seager & Tufte, which won a number-eight ranking for its medical patents.

The patent-quality study was conducted by PatentRatings LLC of Newport Beach, California (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 devices. The model scored patents based on factors, including the length of their claims and specifications and number of times they were cross-referenced by other patents. According to a quote on the PatentRatings website from its co-founder and CEO Jonathan Barney, "One interesting fact the study reveals is that experience and expertise within specific technology sectors weigh heavily toward higher quality patents." (The website also reveals that Minnesota is second in the nation, behind Idaho, in terms of number of issued patents per million in state population.) *IP Law and Business* is a publication of American Lawyer Media - the parent company of the *National Law Journal* and one of the most respected legal publishers in the country.

Implementation of the Madrid Protocol

Submitted by Michael A. Essien

The protection of trademarks within and outside the United States is changing for the better as the United States prepares to join the group of nations with a uniform system for registration and maintenance of trademarks. The need to extend the reach of protection for brands and marks in the global marketplace has never been so important. E-commerce drives home this point. Cybersquatters in foreign countries have been known to snatch up domain names that are identical or confusingly similar to domestic company marks and brands, thus igniting disputes about goodwill, dilution of the mark, source confusion, etc.

In 1891, the Madrid Agreement created a single registration system under which marks registered in the "Member States" that are signatories to the agreement become registered in the other Member States. This treaty was last revised at Stockholm in 1967. As of October 15, 2002, 52 states acceded to this treaty. The United States expressed reservations about the provisions of the treaty and is not a party to it. Key issues of contention included:

- **International Registration Based on Home Registration Only** - Registration of a mark with WIPO was based on a national or home registration. The Senate viewed this as not favoring American companies because the workload at the PTO delayed the processing of applications. As a result, a company could lose its priority if another party applied for registration of the same mark in the other Member State after the United States application was filed, but before the registration issued.
- **French Only** - The only acceptable language was French.
- **Central Attack** - This aspect was viewed as unfair because it made the lawful use of a mark abroad contingent on staving off any challenge to domestic rights. Further it allowed a party making a single complaint or objection in the country of origin to bring down a mark in states where the objector had minimal or no prior rights

- **Fees, etc.** - Other issues such as fees, deadlines and administrative burdens also played to the decision to refuse accession to the Agreement.

In 1989, a supplemental treaty, the Madrid Protocol was created to address concerns of the United States and other countries with the Madrid Agreement. As of October 15, 2002, 56 states had become parties to the Madrid Protocol. On October 17, 2002, the United States Senate finally gave its advice and consent for the accession to the Madrid Protocol. On November 2, 2002, President Bush signed the Bill. Some countries have acceded to both the Agreement and the Protocol, others are parties to one and not the other. In all, about 70 countries have acceded to either or both treaties. In particular, the Madrid Protocol introduces the following:

- **International Registration may be Based on Home Application or Registration** - This allows a domestic company to file an "intent-to-use" (ITU) application in the United States, and use it immediately as the basis for seeking registration in the Madrid Protocol states. An American company does not risk losing their priority simply because an application may take longer to process at the Patent and Trademark Office (PTO).
- **Languages** - The application may also be filed in English.
- **Fees Structure** - Each home country may set its fees, even higher fees than under the Madrid Agreement, although not higher than under the Madrid Protocol. The United States may maintain its current fee structure. This also means that the Member States may continue to charge individual fees.
- **Extended Review Period** - Each national office (such as the PTO) has 18 months (or longer, in the case of oppositions) to notify WIPO of objections to the international registration. The Madrid Agreement allowed only 12 months.
- **No Central Attack Doctrine** - The doctrine of "central attack" was abrogated. In the event that the home application or registration is limited or cancelled during the first five years, the applicant has the option, within three months, of converting the international applications to national applications without loss of priority. After the first five years, the international registration is independent of the home application or registration.

Implications for American Companies

- **Significant Cost Savings** - Although the initial registration may not show a remarkable cost savings, given that

each contracting state may set their fees independently; the prospect of a single renewal and maintenance system offers significant cost savings. More than one half of the Member States have elected the standard fee structure that includes the base fee for the international bureau (about \$430), a complementary fee for each country (about \$50), and a supplementary fee for each class of goods and services beyond three (about \$50). Above all, there is tremendous savings due to a single renewal cost (about \$100).

- **Reduced Professional fees** - The need to retain counsel or practitioners in every jurisdiction of interest will be eliminated as a single application suffices for each of the Member States.
- **Expanded Protection** - The goodwill, value and reach of a mark will be markedly increased as each mark registered under the Madrid Protocol is potentially valid in all the Member States.
- **Improved Efficiency** - Efficiency will be greatly improved as is often in the case where cross communication between the Member States brings about a streamlining of processes, procedures and reduces the confusion associated with natively adopted rules and regulations.
- **Single Recordation** - A single ownership and assignment recordation process increases efficiency as well as cost savings. A recordation at WIPO serves as constructive notice to any interested party.
- **Broader Search** - Clearance searches for potential marks now have to be broader to include the Member States. This may potentially add cost to companies, even those not desiring protection in the other Member States.
- **Enhanced Value** - The accession to the Madrid Protocol by the United States will likely encourage more states to become parties to the treaty, thus enhancing the value and goodwill associated with a company's mark.
- **Potential CTM membership** - Once the European Community becomes a party to the Protocol, marks registered under the Community Trade Mark (CTM) may be eligible for registration under the Madrid Protocol.

The above is an overview of the recently adopted Madrid Protocol. After more than 110 years of consideration, it may indeed provide domestic businesses with many advantages in the use of marks around the globe.

Is it a Computer Related Patent or a Biotech Patent?

The Emerging Standards for Bioinformatics Patent Prosecution

Submitted by Brad Forrest

"I am at one with my duality"

"The Strange Case of Dr. Jekyll and Mr. Hyde," Robert Louis Stevenson 1886. Maybe - it was a quotation from a Jekyll & Hyde website.

Introduction

The mapping of the DNA sequence in animals, plants and other organisms has unleashed a veritable tsunami of realized and forthcoming scientific and medical advances. These include, but are not limited to, the diagnosis and treatment of disease, improving the properties of existing organisms, and the cloning of complex lifeforms. Underlying much of the understanding and exploitation of the DNA sequence is the nascent but rapidly growing field of bioinformatics.

Bioinformatics uses computer related technology to solve some of the most demanding challenges of biology. Genetic information is voluminous, often involving millions of potential data points. Bioinformatics uses computers to predict, analyze, and organize these vast volumes of biological data. It uses such tools as computer databases, software, and hardware to analyze, store, retrieve, and display the results of biological research in order to find solutions, predictions, and trends.

Computer related technologies, such as semiconductor processing techniques are being used to create nanostructures that are used as sensors to generate the vast volumes of biological data. Such structures are integrated onto chips to form the almost here "lab on a chip" to perform thousands of diagnostic tests from one drop of blood.

Universities, major research institutes, and biotech, pharmaceutical, and agricultural companies worldwide have recognized the enormous potential of bioinformatics – spending and research are growing dramatically.

Bioinformatics includes new inventions, as well as novel combinations of old technologies. Research in this field requires knowledge of at least two distinct scientific disci-

plines: information sciences (such as computation, pattern matching, computer graphics, data storage and mining, semiconductor processing and networking) and life sciences (such as molecular biology, cellular biology, genetics and biochemistry). Few practitioners are well versed in both technologies. Writing patent applications may require the practitioner to learn a very different technology.

It is not surprising, then, that prosecution of bioinformatics patents requires the skills of two distinct patent practitioners – computer/software specialists and biotech patent specialists. This is far from a natural collaboration; indeed, the two areas of patent law have developed along different paths. Yet, both must come together to properly protect bioinformatics inventions.

Bioinformatics patent requirements

Bioinformatics patents are granted for a) methods, techniques, algorithms, approaches used to analyze biological data, and b) the structures and functions discovered using bioinformatics approaches.

Examples are:

- Predicting structures of proteins from amino acid sequence
- Predicting protein folding
- Predicting structure of binding sites
- Evidence based treatments
- Drugs that bind a receptor
- Modeling of complex structures
- Proteomics
- Genomics
- Nanostructures for biological analysis

Patent prosecution practice for computer related and biotech related patent applications has followed different paths. Computer related patent prosecution suffered a barrage of statutory challenges since the 1970's. In the 1990's, the barrage appears to have been deflected. In *re Lowry*, 32 F. 3d 1579, 32 USPQ2d 1031 (Fed Cir. 1994) allowed claims to data structures stored on a computer readable medium. State

Street Bank & Trust co. v Signature Financial Group Inc. 149 F.3d 1368; 47 U.S.P.Q.2d 1596 (Fed. Cir.1998), established that software and methods of doing business are patentable, which was later affirmed by AT&T Corporation v Excel Communications, Inc. 172 F. 3d 1352, 50 USPQ 2d 1447 (Fed Cir.1999)

Biotech related patent prosecution has stringent requirements regarding utility, enablement, and written description. In demanding a showing of utility In re Brana , 51 F.3d 1560 (Fed. Cir. 1995) stated that “if a claimed invention does not have a utility, the specification cannot enable one to use it.” In requiring enablement, Amgen Inc. v Chugai Pharmaceutical Co. , 927 F.2d 1200 (Fed. Cir. 1991) declared that DNA analogs were not enabled. Further cases have held that the utility be specific to claimed subject matter, that there be substantial real world practical uses, and that the evidence of utility be credible to one of ordinary skill.

Regarding written description, Fiers v Revel , 984 F.2d 1164 (Fed. Cir. 1993) stated that claiming all DNA that achieve a result without defining their sequences is “an attempt to preempt the future.” It said complete and correct sequences are needed, because description of the function of a DNA and a method of making it is inadequate. The inventor must show that he or she was in possession of the invention.

Prosecution of bioinformatics application may bring both biotech and computer issues into play. However, most practitioners are well versed in one or the other practice. The computer related technology practitioner knows how to claim software in its many different claim formats. However, such a practitioner may not be as familiar with writing examples of the invention. How many such practitioners include an express statement of utility? How many computer related technology practitioners know when to submit a sequence listing, much less what one looks like or how to submit it? Biotech practitioners are not as familiar with means plus function, computer readable medium claims, or data structure claims.

The utility requirement highlights one of the differences between computer and biotech related applications. Utility is basically assumed in computer related and other mechanical inventions. If one couples a shaft to a motor, it is rather intuitive that the shaft will rotate, and that it will be useful to transfer power, or create motion. However, if one comes up with a new compound or DNA sequence, we don't know what it is useful for unless the applicant tells us. There is no current hard science that indicates how the compound will interact with other substances. Hence, the courts have made the requirement for proving utility of biotech related applications much more stringent than that for other inventions.

Bioinformatics is a science that may bridge the gap. In other words, it may provide the hard science indicating what will happen, and thus reduce the requirement of expressly stating a credible utility.

Another difference between drafting software related applications and biotech applications involves the sufficiency of functional descriptions. In software applications, it is clear that describing the function of the software allows an programmer of average skill to make and use the invention without undue experimentation. Fonar Corporation et al., v General Electric Company, et al., 107 F.3d 1543; 1997 U.S. App. LEXIS 3402; 41 U.S.P.Q.2D (BNA) 1801 (Fed. Cir. 1997). Yet in Enzo Biochem, Inc. v. Gen-Probe Incorporated, et al., 285 F.3d 1013; 2002 U.S. App. LEXIS 5642; 62 U.S.P.Q.2D (BNA) 1289 (Fed Cir. 2002), the court held that a functional description of DNA probes was not sufficient disclosure, even in view of the samples that were submitted (Samples recently held to be sufficient).

A further potential area where the disciplines differ involve the ability to claim a computer readable medium with a program stored on it for performing a computer implemented method. The analog to this in the biotech arena is a machine readable medium having a sequence stored on it. The USPTO has held these to be written descriptive materials that are not patentable, citing In re Gulack, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983)

However, if one simply adds that the machine is a synthesizer that can create genetic material automatically from the stored sequence information, it looks more like a computer program that causes a machine to do something. Of course, utility for the sequence will be required.

Working with the USPTO

The merging of the two sciences, and the different nature of prosecution of patents for each, has proved challenging for the U.S. Patent & Trademark Office. Bioinformatics patent applications are reviewed by Group 1631, which was formed in December 1999. Currently, this group is made up of examiners better versed in chemical and pharmaceutical issues than computer and software issues. They are receiving significant education in the examination of computer and software related patents. To that end, we've developed some issues to keep in mind when drafting bioinformatics patents:

- Attorneys need to be increasingly aware of overlapping biotech and computer technologies when drafting patent applications.
- To the extent that an invention overlaps into the computer arts, biotech attorneys should become familiar

with the examination guidelines for computer-related inventions, and vice versa, to ensure that disclosure is ample for both fields.

- The clarity of and support for claim language has been a central issue in bioinformatics patent applications. Claims tend to be broad and actual embodiments are frequently difficult to understand, leading to confusion for Examiners. Drafters need to pay particular attention to these issues.
- Consult MPEP 2106.01-2106.02 for information on the submission of computer programs and/or flow charts: www.uspto.gov/web/offices/pac/dapp/oppd/patoc.htm.
- Avoid claims to a computer readable media with sequence data on it. These claims are drawn to non-statutory matter. However, a claim to a software program on a disk may be statutory.
- Take care to distinguish clearly between manipulation of molecules and sequence information, e.g., software that deletes flanking vector sequences from insert sequences after sequencing a clone. Do not phrase the claim to recite deletion of nucleic acids from the vector nucleic

acid, if you really intend to refer to sequence data or information.

- Know when and how to submit sequence listings.
- Become familiar with the utility guidelines, and how to assert a practical utility and how it is realized in the specification.
- Team up with a practitioner of the other technology and have them review your application, or possibly split the responsibilities in writing the application.
- If you don't want your application to end up in the bioinformatics group, avoid words like "gene" or "protein".

Conclusion

Successful bioinformatics patent applications depend on the combined talents of the software patent attorney and the biotech patent attorney. These patents must meet the requirements of a biotech patent while addressing software patent issues. For bioinformatics patents, we must become one with our duality, or better yet, work together as a duality.

Kenneth L. Port Named Director of Intellectual Property Law Studies



William Mitchell College of Law President and Dean Harry J. Haynsworth has named Professor Kenneth L. Port director of Intellectual Property Law Studies at the college. As director, Port will be responsible for the development of the law school's intellectual property law program and curriculum. Currently, the law school's

intellectual property law program has one of the most developed curricula in the nation, with 14 courses in patent, copyright, and trademark law and more in development. Three full-time faculty members are dedicated to the program.

"William Mitchell has long been devoted to the study of intellectual property law. As the demand for attorneys in this area of law grows larger, we have the opportunity to develop

our program further," Haynsworth said. "Ken Port has the knowledge, experience, and enthusiasm to take our intellectual property program to the next level."

Port joined William Mitchell as a full-time faculty member in fall 2002, after serving for a year as a visiting professor. He specializes in U.S. and international trademark law and is known internationally for his work on Japanese legislation affecting intellectual property laws worldwide. Port has twice been a Fulbright visiting scholar to Tokyo University. He is the author of numerous books and articles and the winner of the Ladas Memorial Award in 1995. Prior to joining the William Mitchell faculty, he was a professor of law at Marquette University in Milwaukee, Wis.

Mary McGlynn

William Mitchell

Student Intellectual Property Law Association

The Spring 2003 semester has once again proven to be a busy one for the William Mitchell SIPLA chapter. We have been involved and continue to be involved in putting on a number of programs that are open to all who wish to attend.

At the beginning of the semester we assisted with a Public Square Lecture Series program, featuring Dr. Daniel Drell. The program, entitled, "Societal Implications of the Human (and Other) Genome Programs: What Now?" was held on Wednesday, February 5, 2003 and encompassed Dr. Drell's work on the Human Genome Project. Shortly thereafter, on Wednesday February 12, we were fortunate enough to be able to host attorney's and recruiting staff from Schwegman, Lundberg, Woessner and Kluth, who discussed how to secure an IP position in today's marketplace – particularly in an IP boutique firm – and what you can expect once you arrive at a firm.

The remainder of the semester proves to equally as interesting. On Friday February 28, 2003, at 5:30pm in the Kelly Boardroom we will host a discussion on the "Unique Considerations for Biotechnology Patents." Mary Bauman from Fredrikson & Byron, Dr. Ron Lundquist from Fish & Richardson and Dr. Denise Kettelberger from Merchant & Gould will be speaking and Professor Ken Port will moderate. Our final Public Square lecture Series Program will be held on Wednesday, March 12, 2003 beginning at 7pm in the William

Mitchell Auditorium. Mr. Edward Richards will be speaking about "Bioterrorism and Emerging Infectious Diseases: Balancing Private Rights and Public Safety." Following that, on March 19, 2003, in Room 223, at 6:30 p.m. we will host a discussion on "Distribution of Music in Digital Formats." Panelists Cal Litsey from Faegre & Benson, Paul Stark from Twin Tone Records and Dan Satorius of Abdo & Abdo will speak and Professor Niels Schaumann will moderate. Finally, we are hoping to secure one final program at the end of March or beginning of April with the Minnesota State Bar Association's Computer Law Section in which members of the computer law section would come to talk to students about their practice in information technology and intellectual property law.

Additionally, William Mitchell sent the team of Christine Fordahl and Mike Skram to the Saul Lefkowitz moot court competition in Chicago over the weekend of February 21-23, and will be sending the team of Jim Baker and Charles Ware to the Giles Rich Moot Court Competition in March. Congratulations and Good luck William Mitchell teams!

The William Mitchell SIPLA officers for 2002-03 are:

Gretchen Randall – President - grandall@wmitchell.edu
Erik Drange – President-Elect - erik_drange@adc.com
Katherine Kelly – Treasurer - kell0404@umn.edu
Chris Sullivan – Secretary - csulliv2@wmitchell.edu

The Minnesota Inventors Congress Needs Your Help!

The Minnesota Intellectual Property Law Association has been a supporter of the Minnesota Inventors Congress for many years by providing us with consultants for our annual three-day event in Redwood Falls, MN, and speakers for our seminars that are held throughout the year.

The MIC is a 501(c)3 non-profit, volunteer organization that for 46 years has been dedicated to serving inventors through encouragement of invention and innovation. We provide this service through an annual event that provides inventors with an opportunity to display their new product and gain feedback from the general public, thereby providing the new product developer with a test market. We also have a year-round

office that provides inventors with support on a daily basis. Since 1986, the MIC has been funded with a grant from the State of Minnesota. That \$50,000 per year grant has been discontinued and we are asking for help from the members of MIPLA so that we may continue to do what we have been doing for 46 years - help inventors.

Please consider a sponsorship of the MIC so that together we can keep working with, and for, the inventor. For information on being a MIC sponsor, please call us at (507) 637-2344, or email mic@invent1.org

Thank you on behalf of the MIC and all future new product developers!

Request for Submissions

All members are not only eligible, but encouraged to submit materials for publication in New Matter, the official newsletter of MIPLA. For example, members are encouraged to submit items, such as case briefs, practice tips, legal commentary, legal bulletins, CLE summaries, MIPLA-event photos, CLE summaries, IP oddities, fascinating patents, and so forth.

Please forward an electronic copy of your submission (in Microsoft Word) to Publications Committee Chair Eduardo Drake at edrake@slwk.com, using the subject heading "New

Matter Submission" in combination with other descriptive text. (For example, New Matter Submission: Patent Law Committee Report.) If you have pictures to submit, please email these in a JPEG or TIFF format, with a suitable subject heading.

The next due date for submissions is tentatively set for mid-May.

Committee Reports

Biotechnology and Chemical Law

Meetings schedule: Usually one-hour seminars once per month

News/Activities: The Committee has had various noon seminars this year, including one by Mark Skoog on the new written description requirement under 35 USC 112 and another by Anne McCrackin on the proposed fee changes to the patent law. A noon seminar is planned in late March on patent protection for DNA computers. The noon seminars have been very well attended.

Mark Skoog

Copyright Law

The Committee plans to have or sponsor three events this spring.

- First, an ABA-CLE teleconference event entitled "Copyright Law: State of the Copyright office and Recent Developments" on April 4, 2003.
- Second, the Committee intends to sponsor a University of Minnesota Law School 1 - 2 hour panel discussion on April 7 or 8 regarding emerging issues in copyright law, especially the ramifications of the Eldred decision for future litigation and legislation. More information regarding this event (specific date, time, and panel members) will follow shortly.

- Third, a CLE-credit approved half-day seminar on protecting software through copyright law this spring or summer.

Jessica Sherman

International Law

Meetings schedule: May/June and October/November
News/Activities: Meetings and social activities with practitioners from different countries. The upcoming event will be in May/June regarding Madrid Protocol and Implementation

Min (Amy) Xu

Licensing

To analyze, review and discuss issues related to transferring intellectual property rights and technology by licensing, to consider and study best practices related to licensing and to provide networking and support to Committee members for their intellectual property licensing activities.

Meetings Schedule: One or two additional meetings in 2003. One meeting will focus on networking

News/Activities: Our first Licensing Committee meeting of the 2002-2003 year was on February 25, 2003. Philip Goldman from Fredrikson & Byron, P.A. spoke about the "Anatomy of a License Agreement."

Mary P. Bauman and Paul W. Busse

Publications

This issue of New Matter is one of the most successful yet, particularly with the inclusion of substantive articles from Mike Essien and Brad Forrest, numerous photos from Phil Goldman, and interesting organizational announcements. Special thanks to MSBA staffers Sue Bores and Tina Jalivay for their assistance in putting this issue together.

The next issue is tentatively planned for late May or early June, with a mid-May due date for submissions. Further details will be announced via email.

Eduardo Drake

Women in Intellectual Property Law - WIPLA

The Women in Intellectual Property Law group continues to remain active. In January, Barbara Grahn of Oppenheimer, Wolf, and Donnelly, and Cheryl Classen, paralegal at Oppenheimer, spoke regarding the Madrid Protocol as well as an update in Trademark Procedures before the Patent Office. At our meeting in February, The Honorable Judge Ann D. Montgomery, U.S. District Judge for the District of Minnesota, shared about her route to the federal bench and her

experience as the one of the first female judges on the Minnesota Federal Bench. More meetings will be scheduled soon, with notices provided by email.

Our random lunch groups continue to meet regularly, with an average of 60 members getting together in small groups to have lunch with one another every other month. These groups have been a wonderful opportunity to network with other members of the group, and we encourage every member of WIPLA to participate. We thank Mara Liepa for her help in organizing the random lunch groups.

If you would like to join or learn more about WIPLA, please email Catherine Klima at cklima@slwk.com or Ann McCrackin at amccrackin@slwk.com. We look forward to seeing you at future meetings!

Upcoming CLEs

The Patent Litigation-ADR-CAFC sponsored a Minnesota CLE seminar on **Basic and Advanced Patent Law** and is planning a CLE lunch seminar for this spring in which **John Dragseth of Fish & Richardson** will present an introduction to the judges of the Federal Circuit. Future lunch seminars are in development.

Patent Lore

Submitted by Philip Goldman

Lead cups were often used to drink ale or whiskey. This made a pint of beer go from being merely intoxicating to downright lethal in some cases. Anyway, a potent combination of lead and alcohol generally left you passed out for days. Given the rather poor state of medicine at the time, a rudimentary stethoscope at best, there were some who passed more for dead than just passed out. So, as a precaution to a premature burial, people with the appearance of death were usually laid out on the kitchen table and family would gather to see if the person would wake up. This was the beginning of the custom of a "wake." Of course, we know there were recorded instances of people buried alive. It was a genuine fear. So coffins were rigged, plainly or ornately depending on your social status, with a string attached to a small bell. Someone would sit in the graveyard all night to listen for the bell, a term that became known as "the graveyard shift", in order to determine if someone needed to be "saved by the bell" or was merely a "dead ringer."

*From "Dead Ringer"
Josh Shepherd and Kevin Garrison
Morbidityoutlook.com*

Last Summer's MIPLA Golf Social

It's the middle of winter, so what better time to recall The Seventh Annual MIPLA Golf Social held July 25, 2002 at Oak Marsh Golf Course? We filled the course with 144 "golfers", and unfortunately had to turn several away. I hope to accommodate anyone and everyone who is interested with next year's event. While rain was still falling less than 30

minutes before the shotgun start, thankfully the next five hours were dry! As always, Jeff Cameron and Robin Sannes ensured that everything went smoothly, and I hope that everyone had an enjoyable time (notwithstanding the unintentional scoring error reported below and possible signage tampering).

The awards from the golf tournament were as follows:

Low Team Score:

First Place (-14):

Doug Christensen, Randall Skaar, Thomas Brandt & Scott Ulbrich

Second Place (-11):

Matthew Doscotch, Derek Vandenburg, Jeff Ali & Alan Stewart

Note that Doscotch et al.'s scorecard was inadvertently misplaced so that they did not receive proper credit for their second place finish at the awards banquet. My apologies!

Third Place (-10):

Gary Speier, Brad Forrest, John Haack & Dave Peterson

Closest to Pin:

Tom Brandt and Pete Gafner

Longest Putt:

Harry Gwinell and Alison Johnson

Longest Drive (male):

Tom Brandt and Dave Peterson

Longest Drive (female):

Jennifer Koswinski and Robin Sannes

We were fortunate to have a number of firms sponsor the 2002 MIPLA Golf Social, with their donations offsetting the costs of golf and dinner. Our kind sponsors included, in alphabetical order:

Crompton, Seager & Tufte
Kagan Binder
Dicke, Billig & Czaja
Kinney & Lange
Dorsey & Whitney
Merchant & Gould
Faegre & Benson
Mueiting, Raasch & Gebhardt
Fish & Richardson
Nawrocki, Rooney & Sivertson
Fogg, Slifer, Polglaze, Leffert & Jay
Patterson, Thuente, Skaar & Christensen
Fredrikson & Byron
Schwegman, Lundberg, Woessner & Kluth
Fulbright & Jaworski
Shumaker & Siefert
IPLM Group
Westman, Champlin & Kelly

See you this Summer!

Tim Czaja

MIPLA's "Meet the Firm" Social Event

The second in this series of events, hosted by Merchant & Gould, was an unqualified success. The following photographs were provided by Phil Goldman.



Jack Clifford (Merchant & Gould) leading yet another tour of the firm's new location.



John Gould (Merchant & Gould) and Jon Tuttle (Dorsey & Whitney).



MIPLA members mingle.



Steve Schaefer (Fish & Richardson), honoring us on the occasion of his 40th birthday, with host and Program Committee Chair, Mara Liepa (M&G).



Mark Schuman (Merchant & Gould) and an unknown member.

Authors and Inventors Dinner

Photographs courtesy of Phil Goldman.

President Phil Goldman (Fredrikson & Byron), introducing Barbara Gislason (Gislason & Associates), who introduced our speaker.



Deborah Woodworth, author of the “Shaker Series” of Mysteries, and our guest speaker at the Inventors and Authors Night Dinner, February 26, 2003.

Jim Young (right, Kinney & Lange) and his guest inventor, Mark Bergman.



Lance Sanders (General Mills) and inventors.

Announcements From MIPLA Members

Kagan Binder, PLLC, an intellectual property law firm in Stillwater, Minnesota, is pleased to announce that **Dale Bjorkman** and **Kim Jordahl** became partners of the firm on January 1, 2003. Dale focuses his patent practice in the food science, chemical, and pharmaceutical arts. Dale has extensive patent prosecution experience both in the United States and abroad, and he has participated in a number of opposition proceedings before the EPO.

Additionally, Dale has an extensive opinion practice regarding freedom to practice, invalidity and noninfringement of patents. Dale is further known for his transaction expertise, including technology transfer licenses, joint development agreements, divestiture, and confidentiality agreements. Kim focuses her patent practice in chemical, pharmaceutical, and biological technologies.

Kim's practice includes patent preparation and prosecution, agreements, opinions, and due diligence investigations. Kim also brings with her the experience of managing the intellectual property portfolio of a Fortune 500 company. Before joining Kagan Binder, Kim served as Chief Intellectual Property Counsel at The Pillsbury Company. As a result, Kim is experienced in the management of United States and international intellectual property portfolios, the development of intellectual property strategies, and in performing risk assessments and advising senior level management with respect to the same.

Altera Law Group Expands Medical Technology Services

Minneapolis, MN — January 6, 2003 — **Altera Law Group** has announced an expansion of technical and legal resources to service the medical device sector. This move finally establishes a Twin Cities source for intellectual property legal services that has the technical credentials to match the development teams of medical technology companies.

Altera Law Group is pleased to announce the addition of **Hallie Finucane**. She is a Biologist and former Chief Intellectual Property Counsel at St. Jude Medical. Hallie joins **Iain McIntyre**, a Ph.D. Physicist and Patent Attorney (one of Minnesota Lawyer's 10 "Up and Coming Attorneys" for 2002) and **Dr. Steven Furlong**, a Ph.D. Physicist with more than 25 years' R&D experience in the medical device industry, who

helped launch 5 medical device companies before joining Altera Law Group. Dr. Furlong's and Ms. Finucane's extensive industry experience provides further depth to the team in anticipating and navigating the business related challenges of start-up and emerging stage companies that are unique to the medical technology sector.

Dr. McIntyre observed that, "Our initial association with both Medical Alley and MedicalSuds has been very successful. Now with the addition of Hallie, and the superb support staff that we've developed, Altera has an amazing depth and breadth of technical credentials as well as industry experience to apply to our already significant legal experience."

"This is a great step for Altera," said **Karen McDaniel**, Managing Director of the firm. "With these important additions, Altera has all the technical areas covered - electrical, mechanical, software, telecommunications, medical devices, and chemical and optical engineering, in addition to our trademark and counseling work."

Altera Law Group, founded in 1999, is an intellectual property law firm located in the southwest metro area dedicated to serving local, national, and international clients developing high technology products. The firm's focus is working with emerging technology companies to build intellectual property portfolios to enhance the client's strategic position and bottom line.

For information: <http://www.alteralaw.com>
Contact: Karen McDaniel at kmcdaniel@alteralaw.com
Phone: (952) 253-4102

Faegre & Benson, which has long offered one of the largest intellectual property transactional and litigation practices in Minnesota, has announced the formation of a formal Intellectual Property practice group. The move brings together under a single management structure the patent prosecutors, technology and licensing lawyers, trademark attorneys, and intellectual property litigators from the firm's offices in the United States and Europe. **Ken Liebman** will head the group. **Walt Linder**, **Cal Litsey** and **Natalie Hanlon-Leh** (resident in the Denver office) are administrative partners. The group now has 50 lawyers, including 15 attorneys in its Minneapolis, Denver and Boulder offices that devote substantial amounts of time to patent prosecution. "By bringing our varied IP expertise together into a single team, we can deliver

more efficient service," said **Phil Garon**, Chair of the firm's Management Committee. "We can better leverage the experience of multiple lawyers on behalf of clients. We'll also be in a better position to help clients manage their full IP portfolio as a strategic asset."

E.J. Brooks & Associates, PLLC Opens for Business

On October 15, 2002, the Intellectual Property Law firm of **E.J. Brooks & Associates, PLLC** began securing innovation for Fortune 100 companies and inventive entities of all sizes. Founding attorneys include **Edward J. Brooks III (Jay)** and **Jeffery L. Cameron**, both active MIPLA members. The firm focuses on the transactional side of Intellectual Property Law including: opinion, licensing, due diligence, patent solicitation and prosecution, and other IP related agreement work. Initial work is centered on the electrical, software, and medical arts, representing local and national clients. The firm intends to grow into a chemical practice through the addition of new talent and clientele.

Attorneys at E.J. Brooks & Associates, PLLC possess experience managing and counseling both large and small clients on their IP portfolios and related endeavors. Jay and Jeff work with semiconductor, wireless, software, computer

hardware and architecture, medical device, imaging, and global positioning system technologies. IP representation also includes patent related e-commerce and information technology services to clients in the financial and advertising industries.

The firm collaborates with local colleagues that specialize in the areas of general practice, trademark, copyright, and trial practice in the Twin Cities to facilitate a network of legal resources for clients.

E.J. Brooks & Associates, PLLC is located at 1221 Nicollet Mall, Suite 500. The firm can be reached via phone at 612-659-9340 or via email at Brooks@bipl.net or Cameron@bipl.net.

New Shareholder at SLWK

Schwegman, Lundberg, Woessner & Kluth is pleased to announce that in the fall Eduardo Drake became a shareholder in the firm. Eduardo's focus is on electrical, computer software, and medical-device technologies, building strategic patents and counseling clients on infringement, validity, licensing, and portfolio-management issues. He earned his B.S.E.E. degree (magna cum laude) from Mississippi State University and his law degree from the University of Virginia. Eduardo is also the proud father of twins, who just started walking.

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.