THE JOHN MARSHALL LAW SCHOOL®

CENTER FOR INTELLECTUAL PROPERTY LAW NEWS SOURCE

FALL 2011

NEWS FROM THE CENTER

This past year has been an extremely busy one at The John Marshall Law School and its Center for Intellectual Property Law.

For those of you in Chicago, you may have noticed the disappearance of a number of stores and fast food establishments on Jackson Boulevard between Plymouth Court and State Street. Gone is the dollar store (thank goodness). Unfortunately, we had to sacrifice the Chicken Planet and the Walgreen's as well. But the changes are exciting as John Marshall kicks off construction on the first phase of our expansion at 304 South State Street. This first phase of the $10 million expansion will include a new State Street entrance to the law school and a "student commons" area with bookstore and food services.

Ultimately, the law school will expand its space by 50,000 square feet. "The new face of the law school on State Street is emblematic of the many good things we are doing here at John Marshall and will convey the feeling of pride we have in both our law school and our graduates," said Dean John Corkery. "This enhanced space will help us accommodate the needs of current and future students, and reaffirms our commitment to expanding our student body, our faculty, and our alums, and to growing our relationship with the Chicago legal community. With 1,600 students, we are one of the largest law schools in the country—and our facilities must keep pace with our growth."

In addition to the physical changes at John Marshall, we also are proud to announce the addition of several new IP faculty members.

BENJAMIN LIU practiced IP law at the firm Stroock & Stroock & Lavan in New York, where he obtained and enforced patent rights on behalf of clients in the U.S. and Asia, including pharmaceutical start-ups and chemical manufacturers. He received a JD from the University of California, Los Angeles, where he was an editor for the *UCLA Law Review* and the *UCLA Pacific Basin Law Journal.* Liu received an AB in biochemistry and molecular biology from Harvard University and conducted drug-discovery research at the pharmaceutical company Eli Lilly & Co. before entering the legal profession. He is fluent in Mandarin and Japanese.

Liu's practical and international experience informs his teaching and scholarship. His research focuses on IP issues in Asia and cross-border IP enforcement issues. In fall 2011 he will teach a course examining how administrative agencies and courts work together to address IP enforcement issues at the U.S. border. He will also teach a seminar comparing U.S. and China IP law from various analytical perspectives and encompassing economic, cultural, and social factors. He is the director of John Marshall's Chinese IP Resource Center, which has the dual goal of training Chinese IP specialists and providing a window onto the evolving Chinese IP framework to specialists here in the U.S.

DARYL LIM is an assistant professor at The John Marshall Law School. Previously he was the inaugural Microsoft Teaching and Research Fellow at the Fordham Law School Intellectual Property Law Institute, where he taught courses on U.S. patent law, copyright law, and the interface between IP and antitrust law and European IP law. Lim is a frequent speaker in the U.S. and abroad, and has spoken on the IP and antitrust laws of the United States, European Union, Japan, China, India, and Singapore.

His book, *Patent Misuse: An Empirical Study*, will be published by Edward Elgar in 2011. His articles have been published in leading IP law reviews and books in the U.S., Europe, and Asia. At ATRIP's annual meeting in Stockholm last summer, he delivered his paper on patent misuse that won the grand prize in the 2009 International Essay Writing Competition.

Lim has graduate law degrees from Stanford University and the National University of Singapore. He also has an undergraduate degree in law from the National University of Singapore as well as another in economics and management from the London School of Economics. Before joining academia, Lim was in private practice at the

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For further information, contact Michele Bridges, Executive Director, at 312.427.2737 ext. 581, 312.427.5280 (fax), or at *6bridges@jmls.edu*.

IP & Technology Department of Allen & Gledhill LLP, Singapore's largest law firm. He was a residential scholar at the Max Planck Institute for IP, Competition and Tax Law and later at the Queen Mary IP Research Institute.

Lim has served as an intern on the staff of Commissioner William E Kovacic at the Federal Trade Commission and in the chambers of Chief Judge Randall R. Rader of the Court of Appeals for the Federal Circuit.

Doris Estelle Long

Maureen Collins

William Ford

Professors Liu and Lim join our other IP full-time faculty members, Professors Doris Estelle Long, Maureen Collins, and William Ford.

The IP Center at John Marshall also has another new face—Elizabeth Sherman, who joined our team in 2010 and serves as program coordinator for the Center. She works on alumni and student records, social networking, marketing, and recruitment.

Elizabeth Sherman

William T. McGrath

Michele Bridges

Associate Director William T. McGrath has agreed to assume the duties of acting director (once again) while the law school recruits a new director for the IP Center. Professor Richard Gruner, who has served as the director of the IP Center since 2007, has decided to return to his home and family in California.

In addition to serving as acting director, Bill McGrath also is a long-time adjunct professor at John Marshall, teaching Copyright Law & Practice and Copyright Litigation. He also writes a monthly column for the *Chicago Daily Law Bulletin* and—let's not forget—practices law with Davis McGrath LLC here in Chicago.

Michele Bridges, who has been with The John Marshall Law School since 1998 (after serving as staff director of the IP Section of the American Bar Association) continues as the Center's executive director.

Chinese IP Resource Center

Arthur Yuan

Dorothy Li

Working closely with the Center for Intellectual Property Law is our one-of-a-kind Chinese IP Resource Center. Executive Director Arthur Yuan (JD '04)—along with Dorothy Li, who heads the law school's Asian Alliances Program—has planned a number of special events and ongoing programs to serve U.S. Students and IP specialists as a window into the Chinese IP system and also to serve Chinese IP specialists as a forum for the international study and discussion of developing features of the Chinese IP system. Yuan and Li will be joined by Professor Benjamin Liu in expanding the Center's many activities.

Highlights of the Past Year

In addition to its outstanding JD and LLM degree programs, The John Marshall Law School is known for its outstanding CLE programs and lectures aimed at providing service to the local IP community. Its Annual Conference on Developments in Intellectual Property Law began in 1956 and remains one of the most popular CLE programs in Chicago. Our Annual "Ethics in the Practice of Intellectual Property Law" conference, approaching its fifth year, has quickly become another tradition among practicing IP attorneys in Chicago.

In addition, the 2010–2011 academic year featured a number of special events and educational programs. These included:

Graeme B. Dinwoodie

The Honorable Beverly W. Pattishall Distinguished Lecture in Trademark Law, featuring Professor Graeme B. Dinwoodie, Professor of Intellectual Property and Information Technology Law at the University of Oxford.

Donald R. Dunner

The Honorable Howard T. Markey Distinguished Lecture in Patent Law, featuring Donald R. Dunner of Finnegan Henderson Farabow Garrett & Dunner LLP, Washington, DC. Dunner is the preeminent patent lawyer and has argued more cases before the U.S. Court of Appeals for the Federal Circuit than any other litigator in the country. He will quickly tell you that he has a special tie to John Marshall—both of his daughters, Lisa Dunner and Jennifer Dunner, graduated from John Marshall.

Our Distinguished Professor Presentations in 2010–2011 included presentations by:

- Professor Rebecca Eisenberg, from the University of Michigan Law School
- Professor John Allison of McCombs School of Business, University of Texas at Austin
- Professor James Bessen, Boston University School of Law
- Professor Irene Calboli, Marquette University Law School
- Professor Ann Bartow, University of South Carolina School of Law (now at Pace University Law School)

The John Marshall Review of Intellectual Property Law hosted its 2nd Annual Symposium, with the theme of Biotechnology and Health-Related Issues in IP Law. The event drew a standing-room-only crowd. The keynote speaker was Dr. Ananda Chakrabarty, well-known for his role in the U.S. Supreme Court case *Diamond v. Chakrabarty,* which held that a live, man-made microorganism is patentable subject matter. Thirty years after this decision, Dr. Chakrabarty, now a distinguished university professor in the Department of Microbiology and Immunology at the University of Illinois at Chicago, is conducting research for multi-disease targeting drugs.

Marybeth Peters

Last but not least, we are very, very proud to have had the Honorable Marybeth Peters, immediate past U.S. Register of Copyrights, co-teach our JD and LLM course on International Copyright Law with Professor Doris Estelle Long. Marybeth is a favorite at John Marshall among our faculty and staff—and we were very excited to be able to "share" Marybeth and her vast knowledge of international copyright law and developments with our students. We hope to have her back next year!

Early Plans for 2011–2012

Although some plans are not yet finalized for our 2011–2012 events, we can tell you that we will sponsor our 56th Annual Conference on Developments in IP Law on Friday, February 24, 2012, and our Fifth Annual "Ethics in the Practice of Intellectual Property Law" program on Friday, April 27, 2012. **Mark your calendar** and plan to attend.

We also will sponsor several Distinguished Alumni Presentations during the fall. These include a talk by Kenneth R. Adamo (Kirkland & Ellis, Chicago) on September 27, 2011, and a presentation by Mary Squyres (Brinks Hofer Gilson & Lione, Chicago) on October 18, 2011.

Watch your mail—and our website—for additional information about these great programs.

PROTECTING "POOH Rights"

By **BRIAN EDWARD BANNER**

Enforcement of valuable trademark rights against another entity starts with ownership of those rights. The Trademark Trial and Appeal Board (Board) reaffirmed this point recently by granting a motion for summary judgment based on collateral estoppel regarding the ownership of the trademarks derived from Winnie-the-Pooh and other characters (hereinafter referred to as the "POOH works"). See *Stephen Slesinger Inc. v. Disney Enterprises Inc.* (Opposition 91179064 et. al., June 8, 2011). Recall that summary judgment is a method of disposing of cases in which there is no genuine dispute as to any material fact and the movant is entitled to judgment as a matter of law. Because its effect is to end the case, the moving party has the burden of showing the absence of evidence to support the nonmoving party's case and that the movant is entitled to judgment as a matter of law. The record must be viewed by the Board in a light favorable to the party opposing the summary judgment motion and all justifiable inferences are to be drawn in the non-movant's favor.

This dispute stems from poorly drafted transfer and contractual documents dated 1930, 1961, and 1983, where A.A. Milne (the creator of Winnie the Pooh) transferred in 1930 to Slesinger exclusive merchandising and other rights based on the POOH works in Canada and the United States. In 1961; Slesinger granted to Disney the exclusive rights it had acquired in the POOH works in the 1930 agreement. Finally in 1983, Milne's successors, Slesinger, and Disney signed an agreement revoking the 1930 and 1961 agreements in the attempt to resolve the parties' previous disputes (copyright and trademark misuse allegations) and to clarify their respective contractual arrangements. The parties have operated under the 1983 agreement and Disney has paid royalties to Slesinger for decades. The interpretation of the 1983 agreement is at the crux of the current dispute.

Slesinger contends that certain rights in the POOH works were reserved to it in the 1983 agreement. Disney strongly disagrees and contends that the 1983 agreement assigned all ownership in the POOH works to it, subject to the payment of ongoing royalties. After several oppositions against Slesinger applications and counter-claim cancellations against Disney's existing registrations were filed at the Board, the parties suspended the consolidated proceedings when Milne ex rel. Coyne sued Slesinger, Inc., in the U.S. District Court for the Central District of California in 2009, and Disney was named counter-defendant in that civil action.

The district court reviewed the several briefs supporting the cross-motions and then granted Disney's motion for summary judgment on several of Slesinger's counterclaims, and denied Slesinger's cross-motion for summary judgment in September 2009. In October 2009 it entered a final judgment concluding that Slesinger may not now claim infringement by Disney of any retained rights [since there were none], and dismissed with prejudice all of Slesinger's counterclaims against Disney on the merits. The parties agreed that no appeal would be filed.

Thereafter Disney moved for summary judgment in the Board consolidated opposition proceedings. The equitable defense of collateral estoppel states that once an issue is actually and necessarily determined by a court of competent jurisdiction, that determination is normally conclusive in a subsequent suit between the same parties in the prior litigation. For collateral estoppel to apply, the following four requirements must be established: (1) the issue in the later litigation must be identical to the issue involved in the prior litigation; (2) the issue must have been raised, litigated, and actually adjudged in the prior litigation; (3) the determination of the issue must have been necessary and essential to the resulting judgment in the prior litigation; and (4) the party precluded must have been fully represented in the prior litigation. Each of these factors were addressed and resolved in the Board's recent decision granting Disney's summary judgment motion based on collateral estoppel.

Slesinger failed in its attempt to convince the Board that the district court's judgment was not whether certain rights were licensed or assigned to Disney but was limited to its challenged uses of the POOH works by Disney resulting in likelihood of confusion. The Board studied the clear language of the court's final judgment, the stipulation of the parties that no appeal would be taken from that final judgment, the underlying facts that the district court had to consider in order to reach its conclusion that no factual issue remained and specifically the district court's finding that under the agreements and 50 years of operating under them, and agreed with the court that Slesinger had transferred all of its rights in the POOH works to Disney. Therefore, the Board dismissed the consolidated oppositions and cancellation proceedings with prejudice.

Brian Edward Banner (JD '74) is an adjunct professor of trademark and unfair competition law at the George Mason University School of Law in Arlington, Virginia.

Defining Prior Art after Patent Reform
Are You Ready for the New 102?

By JEFFERY M. DUNCAN

On September 16, 2011, President Obama signed into law the Leahy-Smith America Invents Act. Undoubtedly, this effects the biggest change in U.S. patent law since the 1952 Patent Act. The section representing the biggest departure from the old law is the new Section 102, namely the section that will define what is and what is not prior art. The full text of this section is included at the end of this note.

Overview and Effective Date

All of us in the patent field are accustomed to the current Section 102 with its seven parts (a)–(g), each of which defines a different category of prior art. The amendments to Section 102 would leave it with only four parts (a)–(d). In particular,

(a) defines only two categories of prior art, namely disclosures and prior filed patent applications;

(b) provides exceptions to (a);

(c) provides the status of "common ownership" for the product of joint research agreements; and

(d) defines when a patent or published application is effective as prior art.

I will discuss each of these below, but first note that the effective date of these changes will be for patent applications with an effective filing date after the date that is 18 months after passage, i.e., March 16, 2013. Consequently, practitioners will be given a full year and a half to get applications filed under the old scheme for prior art. Also, since the new law will only take effect for applications with an effective filing date after March 16, 2013, that means that the old law will be in place for the applications filed by then and the patents that issue therefrom. In other words, there will be patents that do not expire for another 21.5 years, whose novelty will be judged under the old Section 102.

Pre-Filing Disclosure: Section 102(a)(1) and Its Exceptions in (b)(1)

As with the old Section 102, the new Section 102(a) starts with "[a] person shall be entitled to a patent unless—". It then includes sections (1) and (2). Section (1) defines the first category of prior art with the following language:

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

The first change to note is that the critical date is the effective filing date of the claimed invention. The invention date is irrelevant. A second change to note is the new catchall phrase "otherwise available to the public." A third change to note is that the public use, on sale activity, or otherwise available to the public activity are not required to take place in the U.S. All are big changes.

The exceptions to 102(a)(1) are found in 102(b)(1)(A) and (B). Section 102(b)(1) starts with:

> A disclosure made one 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

Note that these exceptions will only apply to activities *one year or less before* the effective filing date of the application. Section 102(b)(1)(A) provides the first exception:

> 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;

This exception has been called the "personal grace period." In other words, if the inventor or someone gaining the information from him makes a disclosure, the inventor will have only one year to file a patent application. The big change is that this does *not* apply to disclosures by anyone who did not gain the information from the inventor, regardless of whether the invention occurred before the disclosure. To be clear, there will be no more "swearing behind" third-party references by showing an earlier invention date.

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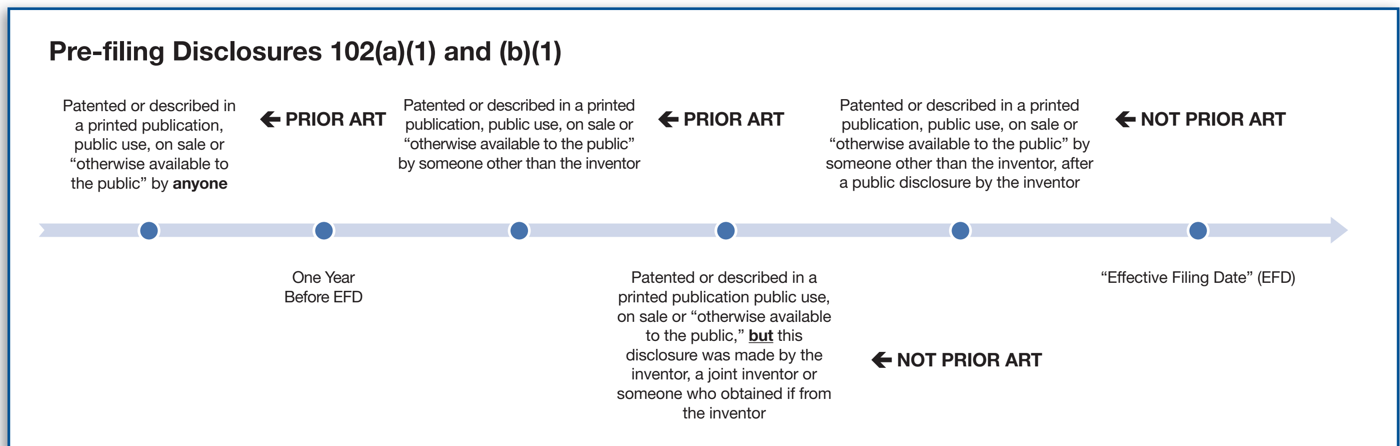
Section 102(b)(1)(B) provides the second exception:

> the subject matter disclosed had, before such disclosure, been publicly disclosed 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;

This exception would be used to remove a disclosure by a third party, so long as there had been a prior public disclosure by the inventor or by someone who gained the information from the inventor, and so long as both disclosures occurred one year or less before the effective filing date. Note that the disclosure by the inventor is required to be a public disclosure.

I have summarized 102(a)(1) and its two exceptions in this chart:



Thus, an on sale activity by the inventor might not qualify to invoke this exception.

Prior Patent Applications: Section 102(a)(2) and Its Exceptions in (b)(2)

Section 102(a)(2) defines the second category of prior art, namely prior filed patent applications, with the following language:

> (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.

Under this section, if a patent application has an effective filing date before the effective filing date of the claimed invention, names another inventor, and is ultimately published or issued, it will be prior art to the claimed invention for whatever it discloses. This is part of the "first inventor to file" system that the proponents of patent reform have sought for several years. There will be no recourse to an interference proceeding to prove prior inventorship. The first inventor to file an application will get the patent. Also note that "names another inventor" is taken to mean there is a difference in the "inventive entity." In other words, even if there is an overlap in one or more inventors, if the prior application and the second application do not name all of the same inventors, the prior application is prior art to the second application.

There are three exceptions found in 102(b)(2)(A), (B) and (C). Section (A) provides an exception when

> the subject matter disclosed was obtained directly or indirectly from the inventor or a joint inventor;

This is referred to as the "derivation" exception. If the prior application discloses information that was obtained from the inventor, that information will not be prior art. Note that while this section removes the information as prior art for what it discloses, it does not address the issue of who will be entitled to the claims if the two applications claim the same subject matter. Those issues are to be resolved in a newly created "derivation proceeding," the details of which are beyond the scope of this note.

Section 102(b)(2)(B) provides a second exception when

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

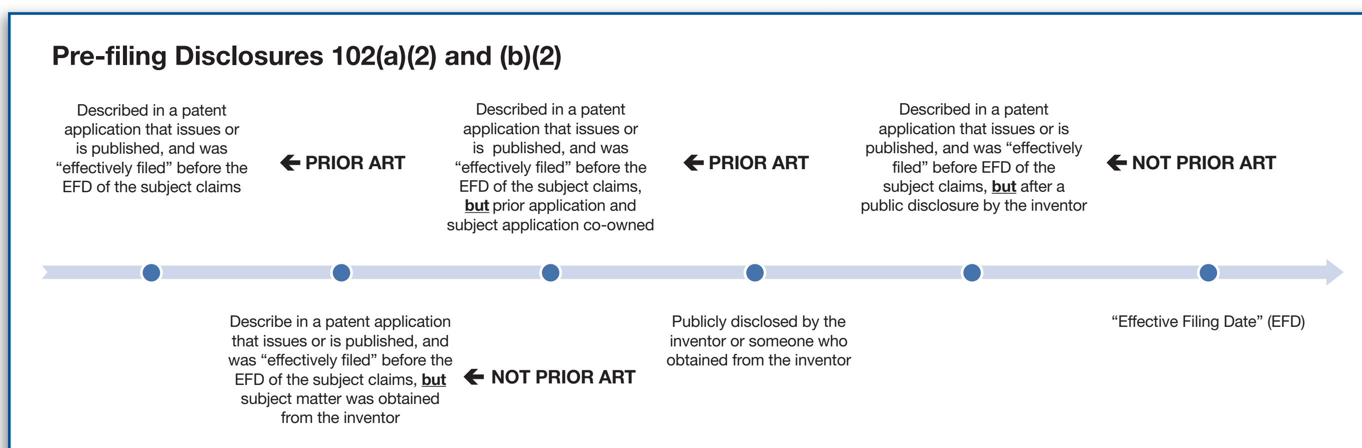
This is similar to the exception in Section 102(b)(1)(B) in that, so long as the inventor or someone who had obtained the information from the inventor had made a public disclosure before the effective filing date of the prior application, that subject matter common to the inventor's disclosure and the prior application would not be prior art. Note that there is an implicit time limit of one year before the claimed invention's effective filing date. This is because, if the inventor made a public disclosure before that time, it would by itself constitute prior art.

Section 102(b)(2)(C) provides the third exception when

> 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

Thus, if a co-worker files an application before the effective filing date of the claimed invention, the subject matter disclosed in the prior application will not be prior art, so long as both applications are owned, or subject to an obligation to assign by the time the second application is filed. Note that this is only an exception to 102(a)(2), namely for a prior filed application. Thus, if the application has published or issued before the effective filing date of the claimed invention, that published or issued application would still be prior art under 102(a)(1).

I have summarized 102(a)(2) and its three exceptions in this chart:



Common Ownership for the Product of Joint Research Agreements: Section 102(c)

This new Section 102(c), provides that, for the purposes of the exception of 102(b)(2)(C), subject matter developed pursuant to a joint research agreement will be considered to be commonly owned, and thus subject to the exception. This should sound familiar. The same provisions are currently in Section 103(c) and were put there by the CREATE Act of 2004. It is important to note that, as with the current 103(c), the joint research agreement must be in place before the effective filing date of the later application, the development must be within the scope of the agreement, and the application must include a reference to the agreement.

Effective Date for Prior Patent Applications: Section 102(d)

Section 102(a)(2) uses the language "effectively filed before the effective filing date of the claimed invention." Section 102(d) clarifies the phrase "effectively filed" to mean, under 102(d)(1), the actual filing date if no priority is claimed to a prior application; or, under 102(d)(2), if priority is claimed to an earlier filed U.S. or foreign application, the filing date of the first application in the priority chain that includes a description of the subject matter in question. Thus, each application in the priority chain will need to be reviewed to determine whether that subject matter was present or not.

Strategies and Conclusions

Again, we will have about 18 months before the new patent applications we file will be subject to this new scheme for prior art. Similar to the one experienced leading up to June 7, 1995, there will be, no doubt, a rush to get as many applications filed as possible before the effective date of this new Section 102.

With that said, I do not think it is too early to begin the transition to the new way of thinking that the new Section 102 should cause.

For one thing, our clients/employers need to examine their invention disclosure and application filing process to make sure there are no unnecessary delays in the system. In the worst-case scenario, a delay of one day could cost you the patent if someone filed the day before you filed. Consider the consequences to a law firm being at least arguably responsible for any delays.

Companies should also prepare a fool-proof tracking and recording system of all pre-filing disclosures by the inventor and by anyone in contact with the inventor. The date and all other details of any such disclosure will need to be preserved in the event one needs to submit evidence of a public disclosure to remove a reference by the exceptions in 102(b)1(A) or (b) or 102(b)(2)(B). Because this need could arise either during prosecution or enforcement litigation some years later, this evidence will need to be kept in a reliable way.

Another thing to keep in mind is that co-ownership of inventions will be even more important in order to keep collaborators from producing "colliding prior art." Without the ability to establish an earlier invention date, the only chance to keep collaborators from creating prior

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art against each other is to establish co-ownership before the second application is filed. This will be accomplished through assignments, employment agreements, agreements with contractors, and joint research agreements. With this new Section 102, it will be critical to have these in place with everyone before a second application is filed.

Clearly, big changes are here. My hope is that this overview of the new Section 102 has given the reader some things to think about and get the discussion started.

Jeffery M. Duncan is a shareholder and former chair of the Biotechnology and Pharmaceutical Group at Brinks Hofer Gilson & Lione in Chicago. Duncan joined the firm in 1984 upon graduating from the J. Reuben Clark Law School at Brigham Young University, and he has been a shareholder since 1990.

§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 in public use, on sale, or otherwise available 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 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 publicly disclosed 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 subsection (a)(2) if—

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

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

(c) COMMON OWNERSHIP UNDER JOINT RESEARCH AGREEMENTS.—Subject matter disclosed and a claimed invention shall be deemed to have been owned by the same person or subject to an obligation of assignment to the same person in applying the provisions of subsection (b)(2)(C) if—

(1) the subject matter disclosed was developed and the claimed invention was made by, or on behalf of, one or more parties to a joint research agreement that was in effect on or before the effective filing date of the claimed invention;

(2) the claimed invention was made as a result of activities undertaken within the scope of the joint research agreement; and

(3) the application for patent for the claimed invention discloses or is amended to disclose the names of the parties to the joint research agreement.

(d) PATENTS AND PUBLISHED APPLICATIONS EFFECTIVE AS PRIOR ART.—For purposes of determining whether a patent or application for patent is prior art to a claimed invention under subsection (a)(2), such patent or application shall be considered to have been effectively filed, with respect to any subject matter described in the patent or application—

(1) if paragraph (2) does not apply, as of the actual filing date of the patent or the application for patent; or

(2) if the patent or application for patent is entitled to claim a right of priority under Section 119, 365(a), or 365(b), or to claim the benefit of an earlier filing date under Section 120, 121, or 365(c), based upon 1 or more prior filed applications for patent, as of the filing date of the earliest such application that describes the subject matter.

Meeting the Challenges of the SHADOW INTERNET

By DORIS ESTELLE LONG

If history provides any useful lessons, not surprisingly, a new set of tools developed to support Middle Eastern freedom fighters may transform today's largely territorially grounded Internet into a truly vibrant cyberspace—and the latest enforcement headaches for trademark and copyright owners.

Internet 4.0

Between the mobile "shadow Internet" equipment reportedly being provided Middle Eastern rebels by the U.S. government and a new domain name registry that promises to eliminate the monopoly of earlier Internet protocols, we may be witnessing the birth pangs of "Internet 4.0." Beyond the collaboration of Internet 2.0 and the "cloud" of Internet 3.0 may lie a new digital network that has the promise of becoming a truly borderless communications media. This new network may still have geographically bounded end users, but its infrastructure will no longer be tied to fixed points of contact such as servers or controllable domain name registries.

Unbounded Cyberspace

The promise of such wide open territories of communication will be a bonanza for those seeking greater information access with fewer government controls. Perry Barlow's claim in the latter decades of the 20th century for an Internet that "does not lie within your borders" may well become a reality. But with such truly unbounded cyberspace comes the equally unbounded problem of a communications media that is even more impervious to legal controls than today's free-wheeling digital environment.

IP Laws and Technology

Intellectual property laws have always played a game of catch-up with technology. Since the development of photography in the 19th century, copyright has struggled to strike the appropriate balance between content control and reproductive availability. The appearance of a publicly accessible World Wide Web in the 1990s, with the rapid onset of a collaborative culture and the technology to share the results on a nearly instantaneous global basis, continues to roil

present policy debates. International initiatives directed toward the geographically locatable elements of the Internet play an increasingly prominent role. "Three strike" rules that prevent illegal file traders from accessing the Internet, and recent "seizures" of websites to eliminate pirate streaming video sites, rely on service providers as the active source of information and control for enforcement techniques. A critical assumption for these techniques is that service providers, and the servers that they use, are locatable and subject to the territorially bounded controls of governments. The development of a shadow Internet that eschews such geographically bounded infrastructures underscores how unstable, and ultimately ineffective, such enforcement efforts may soon become.

Mesh Network

The technological details of the new shadow Internet equipment being provided various Middle Eastern activists is a closely guarded secret. According to published reports in June, however, this shadow Internet consists of "mesh network" technology that transforms devices like laptops and cellphones into makeshift servers, creating an invisible wireless Web that operates without the need for centralized service

The shadow Internet consists of "mesh network" technology that transforms devices like laptops and cellphones into makeshift servers, creating an invisible wireless Web that operates without the need for centralized service providers.

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providers. The mobile shadow Internet of Middle East activists may currently be relatively small, but as the music industry learned with the advent of Napster, small technological advances can overturn established norms overnight. Furthermore, the erosion of geographically bounded infrastructure is not limited to the elimination of definable service providers. In fact, the most worrisome advances are those independent of physical infrastructure. Even the protocols for governing the registration of domain names have come under attack in recent months.

ICANN and gTLDs

The rules governing the international registration of domain names are created and administered by the Internet Corporation for Assigned Names and Numbers (ICANN). The success of ICANN's ability to regulate domain names is premised on the assumption that no desirable alternative address protocols exist. ICANN itself, however, has begun to undermine its control by establishing a new registry system that will allow the creation of a potentially unlimited number of unique Generic Top Level Domains (gTLDs). These gTLDs are represented by the portion of the domain name that appears after the "dot" and serve to limit the choices and registries available for present domain name registrants. Under the new system, a company that meets the technological and financial qualifications for administering a domain name registry can create and administer a gTLD composed of any terms it chooses, including, most significantly, a company name or trademark, such as .google or .nike. Unlike earlier gTLD roll outs, at least as currently planned, trademark owners will not be given presumptive rights to these new gTLDs.

Hash Tags

Dissatisfaction with ICANN's leadership has led to increasing threats to set up alternative registries outside ICANN's control. More problematic may be the increasing significance of hash tags on Twitter as methods for organizing information on the Internet. Such hash tags, symbolized by the use of "#" followed by a search term, such as #HarryPotter, are not officially created by Twitter, nor monitored by it. Yet they are increasingly being used to direct readers to competitive consumer information. With the increasing prominence of social media sites these nondomain name uses will become more pervasive and more problematic.

Conclusion

The ultimate loss of traditional content controls as Internet 4.0 emerges will put greater stress on end users as content providers seek the only remaining geographically viable targets. Such efforts are already underway with new consideration by ICANN of greater restrictions on what types of information registrants must provide to obtain a domain name. The old days of being able to register under a fake name and address may be over. Yet such a narrow focus threatens to forestall serious consideration of the broader issues presented by this new cyberspace. As opposed to playing catch-up, perhaps now is the time to get ahead of the technology curve and begin to create new techniques to deal with the promise and challenge of Internet 4.0. Workable digital licensing mechanisms for both copyright content and trademarks should be placed on the front burner, including evolving business models that treat streaming Internet sites like old time radio stations complete with collective license obligations for featured content. If we do not begin now to consider the issues of Internet 4.0, content owners, end users and the intellectual policy and practices used to manage them may be doomed to fall even further behind.

Doris Estelle Long is a professor of law and chair of the Intellectual Property, Information Technology and Privacy Group at The John Marshall Law School. She is an expert in international intellectual property law, and has lectured in the areas of intellectual property, e-commerce, culture, and technology at conferences throughout the United States and in 26 countries on five continents.

European Patent Practice Seminar

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October 27–28, 2011

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Seminar Agenda

Thursday, October 27, 2011

European Patent Practice Basics

8 a.m. **Registration**

8:30 a.m. The European Patent Convention, the Impact of the Revisions and the Changes Since Then—"A Walk through the EPC"
Some EP Case Law of Interest
EP Claim Drafting Specialties
Patent Filing Strategies
Computer-Implemented Inventions, Business Methods
Cost Saving in EP Cases

4:30 p.m. **Adjournment**

Friday, October 28, 2011

European Patent Practice—Focus on Litigation

9 a.m. Patent Infringement Litigation in Germany and Europe
Doctrine of Equivalents in Germany and the United Kingdom
Cross Border Injunctions
EU Enforcement Directive
International Patent Litigation
Outlook for Community Patent and the Unified Patent Court

4:30 p.m. **Adjournment**

Co-sponsored by

For more information and to register, visit ***http://events.jmls.edu/registration/node/27***

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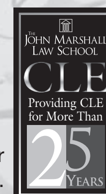

The Copyright **LEGACY** of **LEARNED HAND**

By **WILLIAM T. MCGRATH**

No one graduates from law school without hearing the name Learned Hand. He is one of those select few judges whose name is routinely appended to the end of the citation of any case he authored, as if to say "this is not a run-of-the-mill case I'm citing, it is a case written by the great Learned Hand." He shares this distinction with a select few in the judicial pantheon, such as Oliver Wendell Holmes or Benjamin Cardozo. It's hard to pin down exactly what makes Judge Hand so influential. Perhaps it is his longevity on the bench—he served from 1909 until he died in 1961. Perhaps it is his colorful, quotable legal prose. Having an interesting name undoubtedly adds to the mystique. "Learned" was actually his middle name. It was his mother's family name. Few law students know that his first name was Billings.

His opinions have had a tremendous influence on copyright law. In his era, music, publishing, and theater were concentrated in New York, so in his 50 years on the bench he heard numerous copyright cases both as a trial and an appellate judge.

Hand understood that copyright cases are not easily decided by bright-line rules. This was never more apparent than in cases where he was required to decide whether the defendant copied the plaintiff's "expression" (which, if substantial, would constitute infringement), or merely copied an unprotectable "idea." In one of his most famous copyright cases, *Nichols v. Universal Pictures,* 45 F.2d 119 (2d Cir. 1930), Hand articulated what later became famously known as the "abstractions test" as a guide to differentiating idea from expression in a work. "Upon any work, and especially upon a play, a great number of patterns of increasing generality will fit equally well, as more and more of the incident is left out. The last may be no more than the most general statement of what the play is about, …but there is a point in this series of abstractions where they are no longer protected, since otherwise the playwright could prevent the use of his ideas…." As Judge Easterbrook, chief judge of the Seventh Circuit, correctly pointed out in *Nash v. CBS, Inc.,* the so-called abstractions test is not a "test" at all, but rather a continuum from the most specific to the most general or abstract. It is the court's or jury's job to decide where along this spectrum the copied material lies. Acknowledging that there are no hard and fast rules by which to make this determination, Judge Hand stated, "Nobody has ever been able to fix that boundary, and nobody ever can."

Hand reiterated this theme 30 years later in his last copyright decision, decided just a year before his death. "The test for infringement of a copyright is of necessity vague… Obviously, no principle can be stated as to when an imitator has gone beyond copying the idea, and has borrowed its expression. Decisions must therefore inevitably be ad hoc." *Peter Pan Fabrics, Inc. v. Martin Weiner Corp.,* 274 F.2d 487 (2d Cir. 1960). Courts often look to Hand's abstraction analysis for guidance—by my count, it has been referred to in no less than 111 cases since Hand first articulated it in 1930.

Another recurring theme in Learned Hand's copyright jurisprudence is that, unlike a patented invention, a copyrighted work need not be novel. It is common for a copyright defendant to argue that there are prior works similar to the plaintiff's work and that somehow this diminishes the plaintiff's copyright. Judge Hand repeatedly debunked this argument, explaining that the existence of prior similar works is irrelevant to copyright protection, unless the plaintiff's work was actually copied from the prior work. Originality for purposes of copyright does not require novelty. Hand's view was that if there are public domain antecedents, the defendant is free to copy those; but if the defendant copies substantially from plaintiff, it is infringement despite the similar works in the public domain.

Hand first addressed this principle as a trial judge in the case of *Fisher v. Dillingham,* 298 F. 145 (S.D.N.Y. 1924). In this case, the well-known Broadway composer Jerome Kern was accused of copying an eight note passage, or "ostinato," from the refrain of a song that had been popular a few years earlier. Kern argued that the same ostinato had appeared in a prior public domain

Hand articulated what later became famously known as the "abstractions test" as a guide to differentiating idea from expression in a work.

"No plagiarist can excuse the wrong by showing how much of his work he did not pirate."

work. According to Hand, this was no defense. "Originality alone is the test of validity….[T]here is no reason in justice or law why [the defendant] should not be compelled to resort to the earlier works themselves, or why he should be free to use the composition of another, who himself has not borrowed." As a result, Kern was held liable and an injunction issued. Finding no real injury, however, the court awarded only minimal damages.

Hand's most well-known articulation of this principle came a decade later in *Sheldon v. Metro-Goldwyn Pictures Corp.,* 81 F.2d 49 (2d Cir. 1936). In a case involving a play, he took the defendant to task for "fill[ing] the record with earlier instances of the same dramatic incidents and devices." He then explained

> It is plain beyond peradventure that anticipation as such cannot invalidate a copyright. Borrowed the work must indeed not be, for a plagiarist is not himself *pro tanto* an 'author'; but if by some magic a man who had never known it were to compose anew Keats's Ode on a Grecian Urn, he would be an 'author,' and if he copyrighted it, others might not copy that poem, though they might of course copy Keats's.

He makes the same point in the *Nichols* case, mentioned above, and in *National Comics Publication v. Fawcett Publications,* 191 F.2d 594 (2d Cir. 1951), a case involving Superman comic strips ("a copyrighted 'work,' unlike a patent, demands no 'invention'").

Judge Hand had a firm understanding of the foundations of copyright law. He understood that copying need not be intentional in order to be infringing, and he often reminded us that even unconscious copying could lead to infringement ("… unconscious plagiarism is actionable quite as much as deliberate"). He recognized, in *Sheldon,* that substantial copying of the structure, theme, and incidents of a dramatic work could be infringement, even though the specific dialogue was not taken. In *Sheldon,* he enunciated one of his most quotable quotes to illustrate the point that a defendant cannot avoid infringement simply because he copied only part of the work and added other material that was not copied: "No plagiarist can excuse the wrong by showing how much of his work he did not pirate."

This is not to suggest that all of Hand's copyright jurisprudence favored plaintiffs. He was a firm believer in the defense of independent creation, as shown in *Arnstein v. Edward B. Marks,* 82 F.2d 275 (2d Cir. 1936), where he wrote "independent reproduction of a copyrighted musical work is not infringement; nothing short of plagiarism will serve." In *Nichols,* he found the similarities between two plays far too general to be infringement, and that undeveloped or stock characters were not protectable. "It follows that the less developed the characters, the less they can be copyrighted; that is the penalty an author must bear for marking them too indistinctively." After having decided several cases involving a composer named Ira Arnstein, who was a serial copyright litigator in the 1930s and '40s, Hand commented in a later case that "in copyright we have become accustomed to actions without a shadow of merit," and he complained that composers could not be disabused of the conviction that "the finest gossamers of similarity can be made to serve." *Rosen v. Loew's,* 162 F.2d 785 (2d Cir. 1947).

Learned Hand's status as a superstar judge is well deserved. We should continue to include his opinions in textbooks and treatises, and take special note of opinions he authored. A statement by the *Washington Post* more than 60 years ago remains true today: "His opinions command respect wherever our law extends, not because of his standing in the judicial hierarchy, but because of the clarity of thought and the cogency of the reasoning that shape them."

William T. McGrath is a member in the Chicago law firm of Davis McGrath LLC. He has practiced in the fields of intellectual property and business litigation since 1976. McGrath has been a member of the adjunct faculty at The John Marshall Law School since 1990, teaching Copyright Law and Practice and Copyright Litigation. In 2004, he became the associate director of the Center for Intellectual Property Law.

Supreme Court Renders Decision in *Stanford v. Roche*

By **STEVE S. CHANG**

On June 6, 2011, the U.S. Supreme Court rendered its opinion in *Stanford v. Roche Molecular Systems, Inc.*[1] At issue in this case was whether, under the Bayh-Dole Act,[2] federal contractors automatically own an invention made by their employee using federal funds, or whether a separate assignment from the employee is still needed to convey title to the inventions.

Majority Opinion

The majority opinion of the Court (Roberts, Scalia, Kennedy, Thomas, Alito, Sotomayor, and Kagan) held that the Bayh-Dole Act did not automatically vest title to the federal contractor, meaning a separate assignment is still needed. Justice Sotomayor also filed a concurring opinion, while Justices Breyer and Ginsburg dissented.

The majority began its analysis by noting that rights to an invention have always been traced back to the inventor. Even in situations where the inventor was an employee, the majority noted that unless there is an agreement to the contrary, an employer does not have rights to the employee's invention, and that "[i]n most circumstances, an inventor must expressly grant his rights in an invention to his employer if the employer is to obtain those rights." Slip Op., pp. 7–8.

To determine whether the circumstances here fit within the usual circumstances mentioned above, the majority noted that when Congress intended to divest inventors of ownership of their inventions, it has done so unambiguously. The majority cited as an example a portion of the U.S. Code dealing with nuclear material and atomic energy, where the laws state that ownership of such inventions "shall be vested in, and be the property of, the [Atomic Energy] Commission.'" Slip Op., p. 8.

The majority then noted that the Bayh-Dole Act did not contain such an unambiguous statement vesting rights of federally-sponsored inventions. One passage cited by *Stanford* states that contractors may "elect to retain title to any subject invention," with a definition of "subject invention" to mean "any invention *of the contractor* conceived or first actually reduced to practice in the performance of work under a funding agreement." 35 U.S.C. 202(a), (e) (*emphasis added*).

Stanford had taken the position that "of the contractor" referred to all inventions made by the contractor's employees, and that this election to retain title would mean that the contractor already had title. The majority disagreed, noting that such an interpretation would essentially render the "of the contractor" language meaningless. The majority interpreted this language to refer to an invention that the contractor otherwise obtained (e.g., via an assignment from the inventor), and that the contractor "retaining" the rights referred to the contractor keeping whatever rights it obtained from the inventor, in the disposition of rights between the federal agency and the contractor. Slip Op., p. 11.

The majority also found support in other provisions in the Act. For example, the majority noted that the Act allowed the federal agency to "grant requests for *retention* of rights by the inventor" in the event the contractor does not elect to retain title. Slip Op., p. 12 (*emphasis added*). The majority noted that the use of the term "retention" suggests that the rights still were held by the inventor.

Another example was that the Act did not provide any mechanism for anyone to challenge whether a particular invention was indeed developed using federal funds. The majority stated that such an omission would only make sense if the Act were read to only apply to inventions that the contractor had otherwise obtained from the inventor. Slip Op., p. 13.

Dissenting Opinion

In the dissent, Justices Breyer and Ginsburg noted that the majority's decision, which turned on the fact that Stanford's employee agreement simply stated that the employee would "agree to assign" inventions to the university, while the Cetus agreement also added "and do hereby assign," promulgates a "drafting trap for the unwary" that could frustrate the purpose of the Act by making the public pay twice for a government-sponsored invention (once to fund it, and again when buying the patented product from a third-party assignee not subject to the Act). Dissent, p. 8. Taking issue with such a trap, and its potential for frustrating the purpose of the Act, the dissenting

Justices preferred an alternative approach based in equity. They proposed treating both the Stanford and Cetus agreements as conveying equitable title only, and that the case should be remanded to the district court for a determination as to which of these two parties, in equity, should take title to the invention. Dissent, p. 7.

Concurring Opinion

Justice Sotomayor's concurring opinion simply stated that, although she shares the majority's reasoning and conclusion given the arguments that were presented and briefed, she also shares Justice Breyer's concern about the precedent behind the "drafting trap,"[3] and that she understood the majority opinion to permit reconsideration of arguments surrounding that precedent in a future case.

Takeaways

This case presented some difficult, and perhaps unfortunate, facts. The employee inventor signed a document that was placed before him when he first visited a third-party facility, and the document contained a clause that his employer would not have agreed to, and which could have been a breach of his own employee agreement with the employer. The first takeaway would be a general caution to ensure that employees do not sign any agreements that have not been fully vetted by Legal.

The second takeaway would be to note how the subtle difference between "agree to assign" and "do hereby assign" was pivotal in this case, and that it may be a good idea to include the "do hereby assign" language in employee agreements.

Steve S. Chang practices in the Washington, DC, office of Banner & Witcoff, Ltd., and is an adjunct professor at Georgetown University Law School, where he teaches IP Pretrial Litigation Skills.

The majority opinion held that the Bayh-Dole Act did not automatically vest title to the federal contractor, meaning a separate assignment is still needed.

Notes

1. No. 09-1159 (June 6, 2011).

2. 35 U.S.C. §200 et seq.

3. Which traces roots to a 1991 Federal Circuit opinion in *Filmtec Corp. v. Allied-Signal, Inc.,* 939 F.2d 1568 (Fed. Cir. 1991).

A Horse of a Different Color

MOTION PRACTICE IN THE FEDERAL CIRCUIT

By **ADAM G. KELLY**

To an inexperienced practitioner, motion practice before the United States Court of Appeals for the Federal Circuit is a horse of a different color when compared to motion practice before the district court. The main reason for this color difference is the Federal Circuit Rules, especially the rule governing motion practice—Federal Circuit Rule 27. Practitioners should carefully consider each of the requirements under Fed. Cir. R. 27 to ensure a smooth gallop though the appeal process.

Content and Timing of Motion

There are several common-sense requirements for a Federal Circuit motion. For example, a motion must include the court name, appropriate case caption, title, grounds for relief, legal argument, and counsel's signature.[1] The motion must also include proof of service and an affidavit, if necessary.[2] Although sometimes overlooked, the motion should additionally include the trial court opinion or trial exhibit if those materials are relevant to the relief sought.[3] So far, the horses look the same.

Yet, there are three other distinguishing requirements. First, the motion must contain a statement of consent or opposition.[4] This statement must reflect the movant's discussion with the other parties and whether any party will object to the motion or file a response. Of course, if an opposing party withholds consent when the motion is made and fails to file a response, then the Court will consider that party as having consented to the motion.[5] Second, the motion must contain a certificate of interest.[6] The purpose of a certificate of interest is for the Court to determine whether a judge should recuse herself from the appeal, due to some actual or potential conflict.[7] Third, the motion should contain a proposed order if the parties agree on the requested relief.[8] In some instances, a proposed order may not be necessary; for example, when an opposing party does not contest the motion.

As for when to file a motion, nearly all motions should be filed as soon as a movant determines that relief is needed. However, certain motions may have a specified due date. For example, a motion for reconsideration or a petition for rehearing of a dispositive order must be filed within 14 days of the date of filing the order, although if the United States is a party then the motion must be filed within 45 days.[9] In another example, a motion for extension of time to file a brief must be filed at least seven calendar days before the due date of the brief.[10] Finally, an appellee's motion to dismiss an appeal should be filed before the appellant's brief is filed.[11]

Timing and Content of Response

Due within eight days after service of the motion,[12] a response is required when the opposing party expressly intends to oppose the motion or when the motion incorrectly states or omits an opposing party's consent.[13] The Court prefers that a response follow the same organization as the motion.[14] The contents of the response should include the legal argument and grounds for denying the motion, along with whether the Court should limit the relief sought or modify of the proposed order.[15] For more complex situations, the response could include a request for affirmative relief, but the title of the response should accurately reflect this complexity.[16] The response should also include the opposing party's statement of consent or lack of opposition. Of course, an opposing party could simply refrain from responding to the motion, but such gamesmanship is not recommended.

Timing and Content of Reply

Due within five days after service of the response,[17] a reply should follow the same organization as the motion[18] and should effectively address the issues and legal argument raised in the response.[19] A reply that presents matters not related to the response is inappropriate.[20]

Length and Format

A motion and a response must not exceed 20 pages. Practitioners should be mindful that the page limit does not apply to the certificate of interest, supporting affidavits, proposed order, and proof of service.[21] The format of the motion should follow that of any garden-variety appellate

court motion with particular attention to requirements for binding, covers, paper size, line spacing, margins, reproduction, typeface, and type styles.[22]

Authority of the Clerk and the Court

Unlike clerks in many district courts, the clerk of the Federal Circuit is empowered to grant a variety of consented or unopposed motions.[23] Examples of motions falling within the clerk's authority include dismissal of an appeal, remand, consolidation of appeals, correction of a brief or other paper, substitution or withdrawal of counsel, and proceeding in *forma pauperis.*[24] For those motions falling outside of the clerk's authority, either an assigned motions judge or a panel of judges will decide the motion, depending upon the relief sought.[25]

Confidential Materials

Given that many cases appealed to the Federal Circuit are subject to a protective order, a movant who relies on confidential materials should become intimately familiar with the confidentiality provisions under Fed. Cir. R. 27(m). In situations involving confidential materials, a movant must file an original and three copies of two sets of motions, a confidential set and a non-confidential set.[26] For the confidential set, the movant must properly title the motion as "[Confidential]" and bracket or highlight the confidential information on each page containing such information.[27] For the non-confidential set, the movant must also properly title the motion as "[Non-Confidential]" and delete or redact the confidential information on each page containing such information with a legend at the top of each of those pages, indicating that confidential information has been redacted.[28] In addition, the movant must include an introductory paragraph at the beginning of the motion, preferably at the bottom of the table of contents, which identifies each page containing the confidential information and explains "the general nature of the confidential material that has been deleted."[29]

Filing

Although the Federal Circuit does not permit electronic filing, a movant may file a motion by facsimile.[30] The same applies for a respondent. Whichever the case, the filing party must indicate on the certificate of service that all parties were served by facsimile transmission and that the appropriate number of copies of the filed documents have been mailed to the clerk and the parties on the next business day.[31]

Service

The serving party must serve two copies of the non-confidential motion papers upon each of the parties in the appeal.[32] For those parties authorized under the protective order, the serving party must also serve two copies of the confidential motion papers. To avoid any service issues the serving party should craft their certificate(s) of service to properly reflect which parties are receiving which versions of the motion papers and indicate the appropriate number of copies.

In closing, those practitioners who actively learn and knowingly incorporate the requirements of Fed. Cir. R. 27 into their practice may not only elevate their advocacy level, but also avoid a regrettable situation where the practitioner gallops into the Federal Circuit's "Top Ten Reasons Why Motions Are Rejected."[33] In the end, practitioners may soon realize that motion practice in the Federal Circuit is a useful work horse, even if it is a slightly different color.

Practitioners should carefully consider each of the requirements under Fed. Cir. R. 27 to ensure a smooth gallop though the appeal process.

continued on next page

Adam G. Kelly received his JD from The John Marshall Law School and is a partner in the Chicago office of Loeb & Loeb LLP. He is a registered patent attorney and advises in all aspects of the patent lifecycle, ranging from procurement to enforcement to licensing. Kelly is admitted to practice before the Court of Appeals for the Federal Circuit and is a member of the Federal Trial Bar.

Notes

1. Fed. Cir. R. 27(a)(1), (2), (3), (4), and (6).
2. Fed. R. App. P. 25(d) and Fed. Cir. R. 27(a)(8) and (10).
3. Fed. Cir. R. 27(a)(2)(B).
4. Fed. Cir. R. 27(a)(5).
5. Fed. Cir. R. 27(a)(5); *see also* Fed. R. App. P. 27(a)(3)(A).
6. Fed. Cir. R. 27(a)(7); *see also* Fed. Cir. R. 47.4.
7. Fed. Cir. R. 47.4.
8. Fed. Cir. R. 27(a)(9).
9. Fed. Cir. R. 27(k) and 27(l).
10. Fed. Cir. R. 26(b)(1).
11. Fed. Cir. R. 27(f).
12. Fed. R. App. P. 27(a)(3).
13. Fed. Cir. R. 27(b).
14. Fed. Cir. R. 27(b). Please follow Fed. Cir. R. 27(a)(1), (2), (6), (7), (8), and (10).
15. Fed. Cir. R. 27(b)(1). The Court prohibits a party from incorporating a motion into a brief under Fed. Cir. R. 27(g), except as otherwise provided for in a motion to strike under Fed. Cir. R. 27(e) or a motion to dismiss or remand under Fed. Cir. R. 27(f).
16. Fed. R. App. P. 27(3)(B).
17. Fed. R. App. P. 27(a)(4).
18. Fed. Cir. R. 27(c)(1); *see also* Fed. Cir. R. 27(a)(1), (2), (6), (7), (8), and (10).
19. Fed. Cir. R. 27(c)(2).
20. Fed. R. App. P. 27(a)(4).
21. Fed. Cir. R. 27(d); see also Fed. Cir. R. 27(a)(7)-(10).
22. *See generally* Fed. R. App. P. 27(d)(1)(A)-(E).
23. Fed. Cir. R. 27(h).
24. Fed. Cir. R. 27(h)(1)-(14).
25. Federal Circuit Internal Operating Procedure (IOP) #2.
26. Fed. Cir. R. 27(m)(1). Confidential material will only be available to persons authorized under the protective order. After five years following the end of the proceedings, however, the Federal Circuit may require the parties to show cause why the motion papers should remain confidential. *See* Fed. Cir. R. 27(m)(3).
27. Fed. Cir. R. 27(m)(1)(A).
28. Fed. Cir. R. 27(m)(1)(B).
29. Fed. Cir. R. 27(m)(1)(B).
30. Fed. Cir. R. 25(a).
31. Fed. Cir. R. 25(a).
32. Fed. Cir. R. 27(m)(2).
33. http://www.cafc.uscourts.gov/top-tens/top-ten-reasons-why-motions-are-rejected.html

SOCIAL MEDIA Come to the IP Center

The Center for Intellectual Property Law is now on Facebook, LinkedIn, and Twitter. We are using social media to keep in contact with our alumni and to reach a broader IP law audience.

Our LinkedIn group has already proved to be a valuable networking resource for our alumni. The group also includes a number of practitioners who come to John Marshall for the outstanding IP educational events we sponsor.

Twitter has shown to be the best resource to share IP news and articles produced by our faculty and alumni. We also share relevant content personalizing the Center and reaching a wider audience than we ever imagined.

We are relatively new to social media, but we are seeing steady growth in all three avenues. We want to create a space for John Marshall IP alumni, faculty, and friends to keep in touch with the Center, each other, and all things IP.

We are always happy to promote—i.e. brag—about our alumni and faculty. In that spirit, we will use these resources to share with our audience any relevant articles, events, or other IP content prepared by our faculty and alumni.

Join, share, and participate:

Twitter @ CenterforIPLaw
LinkedIn @ Center for Intellectual Property at The John Marshall Law School
Facebook @ Center for Intellectual Property Law–JMLS

Student Profile

JAMES DeROUIN

My path to law school is somewhat unorthodox. I graduated from the University of Missouri in 2005 and decided to take a year off to work in a ski town in Colorado. After the ski season was over, I moved back to Missouri and worked for two years as an automation engineer. I soon decided that I wanted to take my career down a different path and decided to pursue a law degree.

I chose The John Marshall Law School because of its strong curriculum in intellectual property and its location in downtown Chicago. At John Marshall, I have been able to accomplish almost all the goals I set out for myself as I began my law school career. After completing my first year, I spent 11 weeks in Taiwan interning for a large semiconductor company. Upon returning to the States, I wrote my comment for *The Review of Intellectual Property Law* on inequitable conduct pleading standards in patent cases. That fall I also externed for McCracken and Frank, a local IP law firm in Chicago.

As my second year progressed, I was honored to receive the Homer Schneider Scholarship and the ABA/BNA Award for Excellence in the Study of Intellectual Property Law. In the spring semester, I was thrilled to contribute to a claim construction opinion while I interned for Chief Judge James F. Holderman in the United States District Court for the Northern District of Illinois. This summer I was given the opportunity to work as a summer associate for St. Onge Steward Johnston and Reens in Stamford, Connecticut.

Over the last two years these experiences have helped me to learn both in and outside of the classroom. I'm excited to return to Chicago this fall and complete my third year at John Marshall.

Alumni Profile

JOAQUIM EUGENIO GOULART

Partner, Dannemann Siemsen
Rio De Janeiro, Brazil

When I began studying for the LLM at John Marshall in 2001, I already worked with IP law in Brazil. Once I decided to go to the United States to expand my knowledge in this area of law, I had the opportunity to visit a number of U.S. law schools. This was extremely helpful in deciding where to pursue my LLM.

After visiting the top-ranked IP schools in the U.S., I was 100% certain that The John Marshall Law School was the best option. I was looking for a school where I could find real practitioners and, unlike many other law schools in the country, I did find them at John Marshall.

With my lifelong interest in IP law, I knew it was essential for my professional development to attend The John Marshall Law School with its world-recognized IP program. The school has an outstanding faculty, first-class facilities, all the right IP courses, and the needed resources and technology are available to students.

Looking back on my time in Chicago, I can certainly say that I was right in my decision to attend John Marshall. Having the opportunity to share professional experience in the IP area with the most well-known IP lawyers in the U.S. was a really outstanding experience.

I know without a doubt that my LLM degree in Intellectual Property Law from The John Marshal Law School helped me to become a partner at Dannemann Siemsen in Rio de Janeiro, Brazil, where, today, I chair the firm's Litigation Department.

PEOPLE NEWS

By **LAURA BETH MILLER**, *Brinks Hofer Gilson & Lione, JMLS Adjunct Professor*

In July 2011, **Hon. Carl Charneski**, former administrative law judge at the United States International Trade Commission (ITC), joined the Washington, DC, office of Chicago-based Brinks Hofer Gilson & Lione. Charneski will be working with IP adjunct professors **Laura Beth Miller** (chair of the firm's ITC practice group) and **Jeff Duncan**, and will round out the firm's cadre of experienced ITC attorneys who have served in roles in the Office of General Counsel, the Office of the Chairman, and the Office of Unfair Import Investigations.

While an administrative law judge at the ITC, Charneski handled Section 337 investigations covering patents, trademarks, and trade secrets in a wide range of high-tech industries, including flash memory, GPS, semi-conductors, digital TVs, digital cameras, smartphones, tablet technology, wind turbines, and ground-fault circuit interrupters. He also was a popular speaker on ITC practice and procedure and authored "The Role of the Office of the Administrative Law Judges Within the United States International Trade Commission," 8 J. Marshall Rev. of Intell. Prop. L. 216 (2009).

Charneski is looking forward to working with the Center for Intellectual Property Law and the Chinese IP Resource Center on projects that bring students, practitioners, scholars, and judges together to discuss issues relating to the transfer of IP rights and technology to and from the United States.

CHINESE IP RESOURCE CENTER

Update from **ARTHUR YUAN**
Executive Director of the Chinese Intellectual Property Resource Center (CIPRC)

First of all, it is great to be back in Chicago and it is my honor to serve my *alma mater* after six years in St. Louis, Missouri. Since joining the CIPRC last June, I have been busy defining and executing the goals of the CIPRC with guidance from Dorothy Li, Michele Bridges, Professor Richard Gruner, and Professor Bill McGrath.

As a part of the Center for Intellectual Property Law (CIPL), the CIPRC aims to provide an IP resource platform to American and Chinese IP practitioners and academics. The resource platforms currently offered include the CIPRC website (*chineseip.jmls.edu*), year-round programs and lectures in Chicago and in China, and internship opportunities for John Marshall students. The CIPRC website is currently divided into two sections. The English section features news, articles, and other information about Chinese intellectual property laws. The Chinese section is devoted to information about recent developments in American patent, trademark, copyright, and trade secret laws. We are also grateful to Judge Dongtao Li (LLM '04), a trial judge in the Beijing People's Court in Haidian District, who has agreed to contribute articles on the development of Chinese copyright law. Similarly, the year-round programs and lectures in Chicago will emphasize practical aspects of Chinese IP laws and practices, while lectures in China will focus on U.S. IP practices.

In addition to the resources above, the CIPRC has started to assist the CIPL to coordinate visiting short-term groups of SIPO examiners. With the assistance of the excellent IP adjunct faculty, the CIPRC began coordinating the training of Chinese patent attorneys (members of the All-China Patent Agents Association) last year. We hope to welcome more of these groups in the future to further the goals of The John Marshall Law School.

Dorothy Li and I have also been busy in Beijing and Shanghai, China. In the three trips we have had since last June, we cemented and established additional collaborations with Chinese universities, government entities, and legal communities. I also spoke at three Chinese law firms regarding U.S. patent prosecution practices, hoping to garner interest for our LLM degree and also internship opportunities for our students. Overall, we successfully placed six John Marshall students as summer interns in China and Taiwan: four at Chinese law firms, one at a Chinese legal research firm, and one at a Taiwanese semiconductor corporation. We hope to continue to be able to offer these opportunities to our students.

Please keep a watch for our upcoming activities and be sure to visit our website—*www.chineseip.jmls.edu*—for updated information.

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Center for Intellectual Property Law

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Like to Write?

Please submit short articles of interest to the intellectual property bar for future publication in the IP Center's *News Source*. A typical word count for an article in this newsletter would be 2,000–3,000 words. Send submissions to Michele Bridges at *6bridges@jmls.edu*.

REALLY Like to Write?

Our online *Review of Intellectual Property Law (RIPL)* is soliciting substantive articles on all aspects of patent, trademark, copyright, and trade secret law. *RIPL* is available online at *www.jmripl.com*. Articles should be submitted to *ripl@stu.jmls.edu*.

FALL 2011 LLM IP COURSE OFFERINGS

(Also available for CLE credit.)

Trial Advocacy for IP Attorneys
Chief Judge James F. Holderman
U.S. District Court, Northern District of Illinois

Administrative IP Protection at the US Border
Professor Benjamin Liu

Comparative & International Patent Law
John Richards
Ladas & Parry

Copyright Law & Practice (ONLINE)
William T. McGrath
Davis McGrath LLC

Copyright Litigation
William T. McGrath
Davis McGrath LLC

Entertainment Law
E. Leonard Rubin
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Financing the Development of IP
Beverly Berneman (LLM ’03)
Golan & Christie

International Trademark Law
Catherine Simmons-Gill

IP in Business Organizations
Professor Richard S. Gruner

Law of Patents
Lisa Carroll (JD ’98/LLM ’00)
Big Machines Inc.

Legal Writing for the IP Practice
Brendan Healey
The Tribune Co.
and Laura Rankin

Master Class on Patent Law & Practice in China
Dr. Lulin Gao
East IP

The Patent Clinic
Don Moyer

Patent Attorney Opinions
Arthur Yuan
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Partridge IP Law

The John Marshall Law School
Center for Intellectual Property Law

315 South Plymouth Court, Chicago, IL 60604

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2011–2012 EVENTS

SEPTEMBER 27, 2011

Distinguished Alumni Presentation
Kenneth R. Adamo, Kirkland & Ellis LLP, Chicago, Illinois
"The Federal Circuit and the United States Supreme Court: Strange Bedfellows in the Patent World?"
Noon–2 p.m., Room 503

OCTOBER 18, 2011

Distinguished Alumni Presentation
Mary Squyres, Brinks Hofer Gilson & Lione, Chicago, Illinois
"Trademarks and the Internet: From a Non-U.S. Perspective"
Noon–2 p.m., Room 503

OCTOBER 27–28, 2011

European Patent Practice Seminar
Room 1200 & 3East
Register online at *http://events.jmls.edu/registration/node/27*

NOVEMBER 7–8, 2011

JMLS/WIPO Advanced PCT Training

NOVEMBER 18, 2011

Distinguished Professor Presentation
Professor Timothy Holbrook, Emory University School of Law, Atlanta, Georgia
"Patent Law's Audience"
Noon–2 p.m., Room 503

FEBRUARY 24, 2012

Annual Conference on Developments in IP Law

APRIL 27, 2012

Annual Program on Ethics in the Practice of Intellectual Property Law