

Colorado Bar Association
INTELLECTUAL PROPERTY SECTION
NEWSLETTER

February 2009

Upcoming IP Section Events:

March IP Section Event

Evaluating Software Patents

Co-sponsored by Silicon Flatirons and the IP Section

March 19, 2009 - 3:00 PM - 8:00 PM

Wolf Law Building, University of Colorado at Boulder

Over the last several years, the Supreme Court and the Federal Circuit have taken a number of steps suggesting that the law governing software patents is still very much in flux. In terms of the scope of patent law's reach (Bilski) to applicable remedies (Ebay), the courts have taken seriously concerns about the state of the patent system and its impact on innovation the software and information technology sectors. At the same time, Congress--spurred by a coalition of IT firms--has considered a number of reform measures geared to address concerns that the patent system is rewarding bad patents and encouraging inefficient litigation.

At this conference, multiple panels of distinguished commentators will evaluate both the premises underlying the call for a fundamental reform--and, indeed, the possible abolishment of--software patents as well as some specific suggestions for changing how patents are granted and how patent litigation operates. In particular, panels will evaluate whether software patents should exist at all, whether patent litigation serves a constructive role in facilitating innovation and commercialization of new technologies, and whether patents play an important role in spurring the development of new technologies and enabling start-up firms to attract financing. The Conference will conclude with a roundtable of three leading commentators on the role of patents and innovation.

The Debate Over the Proper Scope of Patents

3:00pm - 4:10pm

- **John Duffy**
Professor of Law
George Washington University

- **Damien Geradin**
Professor of Competition Law and Economics
Tilburg University
- **Geoff Manne**
Director
LECG
- **Michael Meurer**
Professor of Law
Boston University
- **Pam Samuelson**
Professor of Law
University of California-Berkley

The Realities of Patent Litigation: A Search for Truth or Leverage for Patent Holders?

4:10pm - 5:10pm

- **Mark Chandler**
General Counsel
Cisco
- **Natalie Hanlon-Leh**
Partner
Faegre & Benson
Adjunct Faculty
University of Colorado
- **Mark Lemley**
William H. Neukom Professor of Law
Stanford University
- **John Posthumus**
Partner
Greenberg Traurig
- **Don Rosenberg**
General Counsel and Executive Vice President
Qualcomm

Patents, Start-up Companies, and Financing Decisions

5:20pm - 6:20pm

- **Michael Crawford**
Partner
Q Advisors
- **Jason Haislmaier**
Partner
Holme, Roberts & Owen
Adjunct Faculty
University of Colorado
- **Jason Mendelson**
Managing Director
Foundry Group

- **Sean O'Connor**
Associate Professor of Law
University of Washington
- **Bill Vobach**
Partner
Townsend and Townsend and Crew, LLP

Roundtable Discussion: Software Patents in Perspective

6:20pm - 7:00pm

- **John Duffy**
Professor of Law
George Washington University
- **Bart Eppenauer**
Associate General Counsel
Microsoft
- **Mark Lemley**
William H. Neukom Professor of Law
Stanford University
- **Michael Meurer**
Professor of Law
Boston University
- **Joshua Wright**
Professor of Law
George Mason University

Reception 7:00pm - 8:00pm

Sign-up: <http://www.silicon-flatirons.org/registration.php?id=486>

- General Admission - \$50
- Members of the IP Section of the Colorado Bar Association - \$25
- FCBA Members - \$25
- CU Alums - \$25
- CU/DU Law Students and Staff – Free

SAVE THE DATE:

**April IP Section Luncheon
Due Diligence Investigations
Tom Irving, Partner, Finnegan
April 2, 2009, 11:45 AM - 1:15 PM
Denver Chop House, Large Banquet Room**

The IP Section is pleased to announce that Tom Irving has agreed to present at the April 2nd Section Luncheon to discuss IP due diligence investigations, with a particular emphasis on issues relating to U.S. patent law. He will discuss best practices for conducting investigations, addressing a wide range of issues.

**April IP Section Luncheon
April 28, 2009, 11:45 AM - 1:15 PM**

Denver Chop House, Large Banquet Room

The IP Section is pleased to announce that Phil Johnson has agreed to present at the April 28th Section Luncheon. More details about this event will be announced soon.

Other IP Events:

**What Do You Mean the Rules Have Changed and I'm Now Vulnerable?
CSIA - February 17, 2009, 7:30 - 10 AM, Grand Hyatt Denver**

Complying with the Federal Rules of Civil Procedure (FRCP) as well as discovery requests are challenges that affect all organizations within all industries. These new procedures mean that failure to comply now has serious implications. CSIA and IBM as speakers with real-world experience discuss revisions to the FRCP and the business issues raised, outline steps to ensure business preparedness and answer specific questions regarding your business concerns. Certified Records Manager, Tom Reding, will share the when, where, what and how the rules have changed for evidence you will face in court and regulatory audits today. In addition, Tom will offer a practical, step-by-step approach to addressing these new and unexpected challenges including the people, process and technology aspects to the changes. Joining Tom will be Scott Ward, World-wide Director of Records Management for Ameriprise Financial Services. Scott will share the challenges and solutions he has experienced in addressing these issues at one of the nation's leading financial planning, asset management and insurance companies.

Cost: \$15 for CSIA Members; \$55 for Non-members; For more information and to sign-up, visit <http://www.csiaonline.com>.

**Proper Trademark Usage
International Trademark Association Roundtable
February 18, 2009, 12:00 PM – 2:00 PM
Townsend and Townsend and Crew LLP**

This Roundtable will cover such topics as: The factors that constitute proper trademark use; Top reasons why proper trademark use is so important; Managing your trademarks and how to ensure proper use; Challenges faced when ensuring proper trademark use; and Trademark use requirements. This Roundtable will also focus on various guidelines, symbols, legal aspects, evidence and more. INTA's Roundtables are the perfect vehicle to network and trade thoughts with your peers, compare and learn new strategies, and address common issues and challenges facing the trademark and intellectual property communities.

For more information and to sign-up, visit <http://www.inta.org> or contact the co-hosts Amy Weber(alweber@townsend.com) or Dan Ackerman (diackerman@townsend.com).

Report on the January IP Section Luncheon:

Strategic Intellectual Property Issues for Emerging Technology Companies

On January 20, 2009, over 80 attorneys and business people attended a special panel discussion on development of IP investment strategies in early stage companies. The discussion featured three panelists with extensive experience working with early stage companies. Richard Ogawa, IP Counsel for Khosla Ventures, provided rich insights into clean tech startups emerging from Silicon Valley. Ian Blasch, Managing Director of the Ventures Group at Micron, shared his knowledge of Micron's direct and passive investing in the startup area. And Bill Cadogan, Chairman of Mutual Capital Partners, related his experience working within startups, from inception to merger and acquisition. Townsend and Townsend and Crew's Michael Drapkin moderated the discussion; Greenberg Traurig's John Posthumus kicked off the event with introductions.

The panel focused its discussion on how IP can add value in different technology sectors and at different stages in a company's life cycle. A goal of the panel was also to provide insight, from those who invest in and purchase early stage companies, into the characteristics of IP (and Patents in particular) that consistently add value in both the short and longer term. The panelists began their discussion with perspectives on the state of venture capital during the economic downturn. They then addressed issues regarding intellectual property valuation for early stage companies. The panel also discussed issues regarding due diligence. In addition, the panelists each explained how IP can add real value to a startup. As the capital available to early stage companies becomes more scarce, the need to carefully craft IP investment strategies increases in importance. A video recording of the panel discussion is available at the CBA-CLE Website

Profiles of the Panelists:

Richard Ogawa, IP Counsel for Khosla Ventures. Richard crafts the IP strategy for many of the key portfolio companies of Khosla Ventures, the revolutionary Valley VC firm providing venture assistance, strategic advice, and capital to entrepreneurs. The firm focuses on breakthrough scientific work in clean technology, along with traditional venture areas like the Internet, computing, mobile, and silicon technology.

Ian Blasch, Managing Director of the Ventures Group at Micron. Ian oversees all of the direct investing and passive investing activities of Micron. Ian holds responsibilities for defining investment strategy and integrating the activities of Micron Ventures into Micron's business units. Ian was the CEO and founder of Tiqit Computer, the first company to integrate Windows XP into a handheld computer.

Bill Cadogan, Chairman of Mutual Capital Partners. Bill is the former CEO of ADC Telecom, taking it from a \$200 million revenue business to over \$3 billion during the course of his tenure as CEO. Bill has also sat on the boards of Siara (acquired by Redback for \$4.3 billion), Optivision (ultimately ONI, IPO), Excel Switching (acquired by Lucent for \$1 billion), Applied EPI (acquired by Veeco for \$100 million), Pentair, Ceridian, and Banta (Fortune 500 companies).

ANNOUNCEMENTS:

New Co-Editors of the Colorado Lawyer, Intellectual Property and Technology Law

In December 2008, the IP Section Leadership requested statements of interest for the Co-Editor positions from many attorneys all of whom were well qualified to act as Co-Editors. During the course of the Leadership's interviews of all of the candidates, two individuals clearly stood for their passion, energy and ideas for the position. The IP Section is pleased to announce that Steve Merker, a partner at Dorsey & Whitney and Bill Vobach, a partner at Townsend and Townsend & Crew are the new Co-Editors of The Colorado Lawyer. The Leadership expresses its gratitude to everyone who expressed an interest in participating. Below is an announcement from Bill and Steve regarding the submission process.

Article Submission Process for the IP and Technology Law Section of The Colorado Lawyer

The IP and Technology Law section of The Colorado Lawyer would like to increase the number of articles that it publishes on IP and technology law issues. To help potential authors better understand the article submission process, we wanted to outline some of the pertinent deadlines and issues that potential authors should keep in mind as they consider submitting articles.

In 2009, we expect to publish at least four articles in The Colorado Lawyer, while in future years we expect to publish at least six articles. We currently have a summary of the top IP cases being published in the March and April issues and a patent law article being published in the June issue. So, a trademark article and a copyright article are slotted for the remaining September and December issues.

If you would like to submit an article, we suggest that you contact us first to discuss the topic or provide an abstract. We also have article guidelines that we can send you that outline what The Colorado Lawyer likes to see in its articles. These guidelines are also available on The Colorado Lawyer web site: (<http://www.cobar.org/index.cfm/ID/20548>).

We will need to submit any selected article to the full-time staff of The Colorado Lawyer two months prior to the issue publication date. This allows the full-time editorial staff to do a final edit for publication. Therefore, we would need to receive completed articles a month prior to that submission date. That will allow us time to make suggested revisions to the article and for the author to act on those suggestions. For example, an article that is for publication in the September issue should be submitted to the section editors below by June 1, 2009.

If you should have any further questions about the submission process, please feel free to contact us Bill Vobach, Townsend and Townsend and Crew, LLP, 303-405-8534, wfvobach@townsend.com or Steve Merker, Dorsey and Whitney, LLP, 303-628-1514 merker.steve@dorsey.com.

Interested in Helping Intellectual Property Law Students?

The Denver University Sturm College of Law Intellectual Property Law Society (IPLS) is looking for volunteers to help with two projects in the upcoming spring semester.

1. Mentoring Program

The IPLS is hosting a mentoring program that matches students interested in intellectual property law with attorneys who practice within their area of interest. The IPLS is looking for 25-30 attorneys to volunteer to attend lunch or coffee with a matched student to discuss the practice area and career advice. Ideally, the meeting would occur in February or March. Following the one-on-one meetings, the IPLS will host a Saturday morning brunch in April so that the students have the opportunity to network with other mentors and gain greater insight into the practice of intellectual property law. Total time required is approximately five hours.

2. Resume Review Day

Because students interested in practicing intellectual property law often have specialized backgrounds, their resumes are tailored differently than students practicing in other areas. The IPLS is looking for attorneys who are willing to volunteer their time on February 21st from 1pm-4pm to review and assist students with their application materials. Total time required is approximately three hours.

For more information contact Steph Schonewald at SSchonewald09@law.du.edu or Rick Zelenka at RZelenka10@law.du.edu.

Call for Suggestions or Ideas

The IP Section Officers are also soliciting your suggestions and ideas for topics and speakers for our Luncheon programs for 2009. Please forward any comments you may have to John Posthumus at posthumusj@gtlaw.com.

IP Newsletter

Subject to editorial discretion and review, the IP Section newsletter is open to the submission of short articles and columns on IP topics of interest. If you are interested in contributing, please contact John Posthumus at posthumusj@gtlaw.com.

IP Section Website

Don't forget to check out the Colorado Bar Association website. Please refer to it often for updates on news and events.

<http://www.cobar.org/group/index.cfm?EntityID=PATENT>

The Colorado Bar Association has posted member directories for each practice section on-line. See ours at:

<http://www.cobar.org/directory/sections.cfm?section=PATENT>

Our contact at the Colorado Bar is Melissa Nicoletti, the Director of Sections and Committees. She can be reached at (303) 824-5321, or melissan@cobar.org.

Recently Filed U.S.D.C. Colorado Cases

CAPTION	TYPE	CASE NO.	JUDGE	FILING ATTORNEY(S) - Local
American Heritage Title Agency, Inc v. First American Corporation, The Et A	Trademark	09cv125	Robert E. Blackburn	Sundeep Kumar Addy Bartlit, Beck, Herman, Palenchar & Scott
B & R Plastics, Inc v. Illinois Industrial Tool, Inc	Patent	09cv127	Walker D. Miller	William W. Cochran Cochran, Freund & Young Erik G. Fischer Fischer & Fischer
Big O Tires, LLC v. Gaskin Enterprises, Inc et al	Trademark	09cv99	Philip A. Brimmer	Harold R. Bruno, III Robinson, Waters & O'Dorisio
Chevron Intellectual Property, LLC v. Trujillo	Trademark	09cv32	Christine M. Arguello	Donald A. Degnan Holland & Hart
Home Design Services, Inc. v. Madison Construction & Development, Inc., et al	Copyright	09228	Christine M. Arguello	Anthony M. Lawhon Parrish, Lawhon & Yarnell
Imerica Administrative Services Corporation v. Healthtran, LLC	Copyright	09cv44	Marcia S. Krieger	Leanne B. DeVos Sherman & Howard
MDM Group Associates, Inc v. Century 21 Action, Inc.	Copyright	09cv154	Walker D. Miller	Richard Thomas LiPuma LiPuma Law Associates, LLC
MDM Group Associates, Inc v. Colby	Copyright	09cv152	Robert E. Blackburn	Richard Thomas LiPuma LiPuma Law Associates, LLC
MDM Group Associates, Inc v. S&S Pence Investments, LLC	Copyright	09cv153	Walker D. Miller	Richard Thomas LiPuma LiPuma Law Associates, LLC
Otter Products, LLC v. Foam Plastics & Rubber Products, Corp., et al	Patent	09cv84	Wiley Y. Daniel	Erik G. Fischer Fischer & Fischer
Sharpshooter Spectrum Venture LLC v. Consentino	Trademark	09cv150	Walker D. Miller	Terrence Michael Wyles Oppedahl Patent Law Firm, LLC
Shop*tv, Inc v. Bed Bath & Beyond, Inc et al	Patent	09cv57	Robert E. Blackburn	John R. Posthumus Lucky Vidmar Greenberg Traurig
TI Training Corp v. Constable Group, Inc	Trademark	09cv123	Christine M. Arguello	Peter C. Lemire Leyendecker & Lemire, LLC
Universal Steel Buildings Corp et al v. Nationwide Wholesale Steel, Inc Et A	Trademark	09cv177	Robert E. Blackburn	K. Preston Oade, Jr. Holme Roberts & Owen
Water Pik, Inc. v. Hydro-Pik, Inc., et al	Trademark	09cv27	Wiley Y. Daniel	Charlene M. Krogh Robert M. Wasnofski, Jr. Dorsey & Whitney
Wine Master Cellars, LLC, v. CellarEdge Racking, Inc.	Patent	09cv218	Walker D. Miller	John R. Posthumus Wm. Alex Furman Greenberg Traurig

Please email John Posthumus at posthumusj@gtlaw.com with any interesting Colorado District Court IP decisions or IP news involving Colorado Companies (e.g., issued patents, trademark or copyrights).

JurisNotes (February 2009)

Copyright Cases

Gottlieb Development v. Paramount Pictures (S.D.N.Y. 12/29/08)

Use of pinball machine designs in movie was de minimis.

The court granted Paramount's motion to dismiss for failure to state a claim, concluding that Paramount's use of the pinball machine in the motion picture *What Women Want* was de minimis and therefore, not actionable. The scene featuring the "Silver Slugger" pinball machine lasted only 3.5 minutes and the machine appeared in the scene sporadically. More importantly, the pinball machine was always in the background. In addition, the machine was never mentioned and played no role in the plot. Further, the average lay observer would not be able to discern any distinctive elements of Gottlieb's designs. The trademark infringement claim also failed because Gottlieb alleged no facts to suggest that Paramount's use of its mark would likely cause consumer confusion, or that Paramount was motivated by ill intent to free ride on the goodwill associated with Gottlieb's mark.

Walton v. United States (Fed. Cir. 1/8/09)

Inmate was in "service" of U.S. when he created works.

The Court of Federal Claims dismissed Walton's complaint for lack of jurisdiction and the Federal Circuit affirmed. Walton was a federal prisoner seeking to recover from the United States for copyright infringement involving the government's use of calendars that Walton prepared as part of his assigned duties in prison. It was clear that while preparing his calendar, Walton was in the "service" of the United States. Walton developed and made the calendar at the direction of and with computers provided by the United States and was supervised by government employees in that work. Walton performed the work at a government facility and the government paid Walton modest compensation for his efforts. Pursuant to 28 U.S.C. §1498(b), Congress had not waived the government's sovereign immunity from such suits. As a result, the suit was properly dismissed for lack of jurisdiction.

UMG Recordings, Inc. v. Veoh Networks, Inc. (C.D.Cal. 12/29/08)

Software functions fell within scope of safe harbor.

UMG controls the rights to many copyrighted sound recordings and musical compositions. Veoh operates an Internet-based service that allows users to share videos with others, free of charge. UMG alleges that Veoh has benefitted from and is liable for infringement of its copyrights. Veoh has asserted an affirmative defense under the safe harbor provisions of the Digital Millennium Copyright Act ("DMCA"). The functions performed by Veoh are: 1) automatically creating Flash copies of video files uploaded by users; 2) automatically creating

copies of uploaded video files that are comprised of smaller "chunks" of the original file; 3) allowing users to access uploaded videos via streaming; and 4) allowing users to access uploaded videos by downloading whole video files. The court concluded that these four software functions at issue fell within the scope of the 17 U.S.C. §512(c) safe harbor because they were undertaken by reason of the storage at the direction of a user. It was undisputed that all of the involved software functions were directed toward facilitating access to materials stored at the direction of users. Further, it was clear that the statute extended to functions other than mere storage; it applied to infringement of copyright by reason of the storage at the direction of a user. When copyrighted content was displayed or distributed by Veoh, it was "as a result of" the fact that users uploaded the content to Veoh's servers to be accessed by other means. Congress clearly intended §512(c) to extend to functions directly involved in providing access to materials stored at the direction of a user.

Crane v. Poetic Products Ltd. (S.D.N.Y. 1/7/09)

No reasonable observer could find substantial similarity.

Crane is the author of *The Last Confession*, a fictional two-act play based on the historic events surrounding the succession and death of Pope John Paul I. Crane's play tells the story of the election of John Paul I as Pope, his time in the Vatican, his death, and the aftermath of that death in a series of flashbacks. Poetic holds a registered copyright for the work entitled *In God's Name: An Investigation into the Murder of Pope John Paul I*. This work is a factual investigation of the circumstances surrounding the death of Pope John Paul I in 1978. The book contains biographical details of the Pope's life, as well as extensive documentation of the financial and political corruption that plagued the Vatican in the 1970s. Crane seeks a declaratory judgment that his play does not infringe the copyright of Poetic's book. The court held that the theory that Pope John Paul I was murdered and the facts surrounding his death were not protectable elements of Poetic's book under copyright law. Aside from one example put forth by Poetic, the evidence showed that Crane not only had his own distinct style and wording, but his own distinct medium: a two-act fictional play. Aside from the one example and various historical quotations, the only substantial similarity in selection, coordination, and arrangement of expression between the two works was the timeline: both were presented in roughly chronological order, although Crane's story was told in a series of flashbacks. The thin copyright protection afforded to the selection, arrangement, and coordination of facts surely did not extend to the presentation of historical events in the order in which they took place. Further, a comparison of the two works' plot, theme, and total concept and feel demonstrated that they were not substantially similar.

Vogel v. Wolters Kluwer Health, Inc. (M.D.N.C. 12/30/08)

Claim for deceptive trade practices was preempted.

The court adopted the magistrate judge's recommendation that the court grant defendants' motion to dismiss. Vogel's false designation of origin claim was barred under the Dastar decision. Vogel's allegations amounted to claims of false authorship that had to be pursued under copyright law. In addition, Vogel's claim for unfair and deceptive trade practices under state law was preempted by the Copyright Act. Vogel's state law claim rested on the same conduct underlying the copyright claim: the alleged copying of material purportedly authored by Vogel and the distribution of medical textbooks containing this material. Moreover, the court lacked jurisdiction over defendant Trojanowski, as Vogel's claims did not arise out of activities in North Carolina that could be attributed to Trojanowski. Further, none of Trojanowski's accused activities were expressly aimed at North Carolina.

Embassy Software Corp. v. eCopy, Inc. (D.N.H. 1/13/09)

Registration obtained by dissolved corporation was valid.

The court denied eCopy's summary judgment motion in which eCopy argued that since the original Embassy entity had been administratively dissolved at the time it was registered as a claimant of the software program, the copyright registration was invalid. Without a valid registration, argued eCopy, the court lacked subject matter jurisdiction. However, eCopy's argument misapprehended New Hampshire corporation law, which provided that a corporation that had been administratively dissolved continued its corporate existence, but could only carry on business necessary to wind up its affairs. Thus, the old Embassy corporation did in fact exist, albeit with statutory limitations on its permissible conduct, at the time it was registered as the copyright claimant. Under New Hampshire law, the assignment to old Embassy and registration was at least presumptively valid.

Wilchombe v. TeeVee Toons, Inc. (11th Cir. 1/21/09)

Parties' conduct clearly created an implied license.

The trial court granted summary judgment in favor of TVT on Wilchombe's claim of copyright infringement and violations of the Lanham Act. The 11th Circuit affirmed, explaining that the trial court correctly found that the parties' conduct created an implied license. Wilchombe created the song for the album at Lil Jon's request and instructed Taylor to send it to Lil Jon for final mixing and inclusion on the album. When Wilchombe handed over the song, he never indicated that using the song would constitute copyright infringement. While Wilchombe maintained that he revoked the license when his attorney sent a cease and desist letter shortly after the album was released, this theory was never raised below before judgment was rendered. Accordingly, it was well within the trial court's discretion to deny the motion for reconsideration based on this and similar claims.

Taco Bell Corp. v. TBWA Chiat/Day, Inc. (9th Cir. 1/23/09)

Unclear what jury found on issue of independent creation.

The trial court entered judgment against Taco for breach of an implied contract for using a third-party's Chihuahua character in its advertising developed by TBWA. Taco sought indemnification from TBWA on the ground that the liability incurred by Taco in favor of the third-party was caused by TBWA. The 9th Circuit affirmed, noting that no inference of fault by TBWA could be drawn from the jury's verdict. The instructions left unclear what the jury determined on the issue of independent creation of the Chihuahua character. Further, TBWA was not a party to the implied contract between Taco and Wrench LLC and was unaware of its existence. TBWA had no knowledge of "Psycho Chihuahua" nor Taco's contact with Wrench before proposing a Chihuahua character for Taco's advertising in June 1997. Thus, the trial court properly found no obligation for TBWA to indemnify Taco.

MDY Industries v. Blizzard Entertainment, Inc. (D.Ariz. 1/28/09)

Program was sold to circumvent technological measure.

After a bench trial, the court concluded that MDY was liable under the Digital Millennium Copyright Act ("DMCA") and that Donnelly was personally liable for MDY's tortious interference, copyright infringement, and DMCA violations. The "Warden" program constituted a technological measure that effectively controlled access to the dynamic non-literal elements of the "World of Warcraft" game and such elements were protected by copyright law. The "Glider" bot circumvented Warden by avoiding and bypassing its detection features. MDY knowingly marketed Glider for use in circumventing Warden. Glider was made available despite the fact that it only had commercial significance as a bot that could circumvent Warden. Blizzard had not authorized the access that Glider enabled to the dynamic non-literal elements of the game.

Utopia Provider Systems v. Pro-Med Clinical Sys. (S.D.Fla. 2/2/09)

Medical charts did not qualify for copyright protection.

The court granted PMC's motion for partial summary judgment and denied Utopia's summary judgment motion. The essence of Utopia's complaint was that it held a valid copyright in a set of charts used by emergency room physicians and that PMC infringed that copyright. The court, however, ultimately concluded that Utopia's work did not qualify for copyright protection. The charts at issue contained blanks calling for information to be filled in with the patient's unique medical information. Thus, the charts were not truly a compilation of facts or data; rather, they were forms for the taking down of information. The charts making up Utopia's work were not the proper subject of copyright protection because they embodied Utopia's system for a physician's consultation with a patient.

Patent Cases

In re TS Tech USA Corp. (Fed. Cir. 12/29/08)

Too much weight given to plaintiff's choice of venue.

The trial court denied TST's motion to transfer venue. TST then petitioned for a writ of mandamus to direct the trial court to vacate its order and transfer the case. The Federal Circuit granted the petition, noting that the trial court gave too much weight to Lear Corporation's choice of venue under 5th Circuit law. In addition, the trial court ignored 5th Circuit precedent in assessing the cost of attendance for witnesses. Specifically, the trial court's order completely disregarded the 100-mile rule. Moreover, the trial court erred by reading out of its analysis the factor regarding the relative ease of access to sources of proof. Likewise, the trial court disregarded 5th Circuit precedent in analyzing the public interest in having localized interests decided at home.

Marcinkowska v. IMG Worldwide, Inc. (D.S.C. 12/29/08)

Hybrid tennis court was not "used" in the United States.

The court granted IMG's motion to dismiss for failure to state a claim on which relief could be granted. Marcinkowska alleged that IMG "used" her patent in the United States by maintaining a website that promoted the tennis exhibition in Spain, used depictions of the hybrid tennis court, promoted ticket sales in the United States to the foreign event, and allowed the download of photos and videos of the match. Marcinkowska also alleged that IMG used her patent by controlling the broadcast rights to the exhibition, promoting its own services through depictions of the hybrid tennis court, and receiving money from the exhibition. These allegations simply spread the term "use" too thin. The hybrid tennis court was not "used" in the United States, but rather was "used" in Spain and that use was broadcast in the United States. In the court's view, the playing surface had to be located in the United States for the surface to be "used" here.

Micron Technology, Inc. v. Rambus, Inc. (D.Del. 1/9/09)

Declaration of unenforceability was appropriate sanction.

The court held a bench trial on the issues of Rambus' alleged spoliation of evidence and unclean hands, as well as the appropriate sanction arising from these allegations. The record showed that as early as 1996, Rambus contemplated industry-wide adoption of its DRAM technology through an aggressive use of its intellectual property, characterized as its "patent minefield." It was apparent from the record that Rambus, from its inception, was prepared to

be an aggressive competitor. Its patent portfolio was considered a weapon to be used, as necessary, in Rambus' chosen theater of operations, the DRAM market. A duty to preserve potentially relevant evidence arose in December 1998 and any documents purged from that time forward were deemed to have been destroyed in bad faith. The appropriate sanction was to declare the patents unenforceable.

Sprint Communications Co. v. NuVox Comm., Inc. (D.Kan. 1/12/09)

Non-disclosures did not show inequitable conduct.

The court granted Sprint's motion to dismiss NuVox's counterclaim seeking a declaration that three of the patents-in-suit were unenforceable due to Sprint's inequitable conduct in failing to disclose certain information to the PTO. In essence, NuVox was claiming that Sprint should have disclosed information that was already available to the PTO. At the time Sprint submitted the continuation applications, the relevant rules provided that, in ruling on such application, the examiner considered all information previously considered concerning the parent application and that such information did not need to be resubmitted. In light of this, a party could not base an inequitable conduct claim on an applicant's failure to provide information already before the PTO in the parent application. Accordingly, NuVox's claim failed as a matter of law.

Transamerica Life Ins. v. Lincoln Nat'l. Life Ins. Co. (N.D.Iowa 1/8/09)

Court excludes evidence of pending reexamination.

The court granted in part and denied in part the parties' motions in limine. The court granted Lincoln's motion in limine to preclude evidence of the pending reexamination of the '201 patent at trial. The court agreed with other courts in concluding that evidence of incomplete reexamination proceedings was not admissible to prove invalidity of a patent. There was simply no good purpose for which such evidence could be offered. As to Transamerica's motion in limine to exclude the deposition testimony of Camp, the court could not determine at this point whether any of the challenged evidence was admissible. The court also precluded Transamerica from offering evidence or argument concerning alleged inadequacies of the PTO's examinations of business method patents generally or the '201 patent in particular and concerning whether such patents were favored or disfavored.

Haemonetics Corp. v. Baxter Healthcare Corp. (D.Mass. 1/7/09)

Expert's lost profits analysis was not pure speculation.

The court denied the motion to exclude Hoffman's expert report as it pertained to the analysis of lost profit damages. Defendant Fenwal, Inc. contended that Hoffman had failed to provide a

rigorous scientific analysis of what proportion of infringing sales would have gone to HC. In support of its contention, Fenwal pointed to Hoffman's conclusion that HC would have captured ninety percent of Fenwal's infringing sales. Hoffman explained that he came up with the percentage by starting with the assumption that, where a patent owner and infringer were the only suppliers in a market, the capture rate would be one hundred percent. To be conservative, Hoffman reduced the capture rate to ninety percent after taking into account his experience that there were always at least some customers of the infringer that would have been unwilling to buy from the patentee for reasons unrelated to the product itself. Such methodology was not pure speculation.

In re Certain Nitrile Gloves (ITC 1/15/09)

Reissue application improperly enlarged scope.

The ITC adopted the ALJ's final initial determination, which found no violation, and adopted his order construing the disputed claim terms. In the prior opinion, the ALJ found that while the vast majority of accused gloves infringed claims 1 and 17-19 of the '616 patent and that the domestic industry requirement was met, the asserted claims were invalid. Specifically, the ALJ found that when the patentees amended the claims through a reissue application filed more than two years after the grant of the original patent, they improperly enlarged the scope of the claims, rendering them invalid. The ALJ also found the claims invalid because the patentee filed a defective reissue declaration. The ITC agreed with the ALJ's reasoning, though it clarified the ALJ's discussion of the term "predetermined pressure."

A.G. Design & Assoc. v. Trainman Lantern Co. (W.D.Wash 1/23/09)

Issues of fact existed regarding false marking claim.

The court granted in part and denied in part AG's summary judgment motion. AG sought dismissal of certain of TLC's counterclaims, including its false marking counterclaim. AG argued that TLC had offered no evidence establishing the deceitful intent required by the relevant statute and that any evidence supporting deceitful intent had been rebutted. However, there was evidence showing that AG began marking its lanterns as "patent pending" as early as 1999, prior to actually applying for the patent in 2004. This fact was sufficient to support the inference that AG had knowledge of the mislabeling as early as 1999. However, the court did agree to determine the number of false marking violations that occurred between October 11, 2002 and May 11, 2004. The court agreed with AG that while the "patent pending" label was affixed at most to 15,000 lanterns between the dates in question, the "offense" occurred only one time as a continuous offense.

Powervip, Inc. v. Static Control Components, Inc. (W.D.Mich. 1/21/09)

Cross-license sufficed to subject parties to jurisdiction.

The court denied Static's motion to dismiss, as well as its alternative motion to transfer venue. Regarding the motion to dismiss, the court declined to follow the first-filed rule in this case. First, Future Graphics, LLC was not a nearly identical party to Powervip, but was instead one of its customers. Second, the decision to apply the rule was properly left to the North Carolina court, the court that first obtained jurisdiction. Concerning the issue of venue, the court ultimately concluded that the cross-license agreement between Static, on the one hand, and defendants Industrial Engineering & Development, Inc. ("IED") and Innovative Cartridge Technologies, Inc. ("ICT") on the other, sufficed to subject IED and ICT to jurisdiction in Michigan for purposes of satisfying the due process inquiry. The agreement was exclusive and contemplated an ongoing relationship. IED and ICT purposefully availed themselves of conducting business in Michigan.

Hi/fn, Inc. v. Dudas (N.D.Cal. 1/26/09)

Failure to pay maintenance fee was not unavoidable.

The court denied Hi/fn's summary judgment motion and granted the cross-motion for summary judgment filed by Dudas. Hi/fn argued that its failure to pay the maintenance fee in question before the expiration of the six-month grace period was unavoidable due to a docketing error and personnel change that caused miscommunication among the principals involved. The PTO found that Hi/fn had failed to meet its burden to sufficiently show that the docketing error was an unforeseeable, isolated event and thus, had failed to show that its failure to pay the fee, if caused by the docketing error, was unavoidable. Assuming that the docketing error was the cause of Hi/fn's failure to timely pay the maintenance fee, the court found that the PTO's decision was not arbitrary and capricious.

Trademark Cases

Medici Classics Productions v. Medici Group (S.D.N.Y. 12/19/08)

Given specialized submarket, risk of confusion was slight.

The court denied MCP's motion for a preliminary injunction, noting that the relevant factors did not weigh in favor of a finding that MCP's "Medici Classics" mark had gained distinction in the marketplace. MCP's advertising expenses were modest and there were no surveys linking the mark to performances by Jerome Rose in the minds of consumers. In addition, there were notable differences between the parties' marks extending beyond the differences in wording. The marks created a vastly different impression on the viewer, leading the court to conclude that confusion among prospective purchasers would be highly unlikely. While there was some overlap in the marketplace, MCP was in a highly specialized submarket since it was

distributing the work of a single performer. In contrast, MG offered a wide spectrum of classic and current artists.

In re Williams (TTAB not citable 12/30/08)

Potential purchasers would find combination incongruous.

Williams filed an application to register the mark "Hybrid Heave" for an energy storage and recovery system for active heave comprised primarily of a machine flywheel and a motor generator for generating electricity. The examining attorney refused registration on the basis of mere descriptiveness and the Board reversed. It was clear that the involved complex system employed multiple technologies. Therefore, while the term "hybrid" might literally describe the system because it incorporated multiple technologies, it provided little, if any, useful information. In addition, the relationship between "Heave," as used in the mark, and the identified goods was indirect at best. Potential purchasers would find the combination of "Hybrid" and "Heave" in the mark incongruous, if not nonsensical. Any attempt to make sense of the combination would require a multistage mental process.

In re Future First LLC (TTAB not citable 12/22/08)

No showing that term was common name for type of chair.

Future sought to register the mark "Banana Chair" for a chair. The examining attorney refused registration on the basis of mere descriptiveness and the Board reversed. The Board could not conclude from the evidence of record that the Office had met its burden of showing that the term "banana chair" was the common commercial name for a particular type of chair. In addition, the Board found that the term was not merely descriptive because, as the examining attorney argued, "Banana Chair" described the shape of the chair. Although the chair had a curved shape that could suggest the curve of a banana, the chair did not, in fact, look like a banana. Accordingly, the mark was not merely descriptive.

In re Clear Channel Outdoor, Inc. (TTAB not citable 12/18/08)

Two mental steps needed to connect mark and services.

Clear sought to register the mark "Taxi Entertainment Network" for rental of advertising space in broadcast media and preparing and placing ads in broadcast media for others. The examining attorney refused registration on the grounds of mere descriptiveness and due to a likelihood of confusion with the registered "Taxi" marks (one with a diamond design) for advertising agency and graphic art design services. The Board affirmed as to the latter basis, but reversed as to the former basis. Regarding the likelihood of confusion, the marks were similar in appearance, sound, connotation, and commercial impression. The evidence was sufficient to establish that registrant's advertising agency services encompassed Clear's

identified services. As to the issue of descriptiveness, it would take at least two mental steps to connect the mark with a significant feature of Clear's services.

AARP v. 200 Kelsey Associates, LLC (S.D.N.Y. 1/6/09)

Use of mark in commerce had been adequately alleged.

The court denied Kelsey's motion to dismiss, noting that the current dispute satisfied the case or controversy requirement. AARP alleged that Kelsey was actively seeking licensees to publish a magazine called "Modern Maturity" and was conducting extensive analysis of the publishing industry. While Kelsey also argued that dismissal was proper because it had not actually used the "Modern Maturity" mark in commerce, the court rejected this contention. AARP had alleged that Kelsey was actively preparing to launch the magazine. It was reasonable to infer that, in doing so, Kelsey had not only used the mark, but had done so through the channels of commerce. Thus, AARP had alleged facts giving rise to a reasonable inference that Kelsey had used the mark in commerce.

In re B. Gould Jewelry, Inc. (TTAB not citable 12/22/08)

Mark identified the designs used in applicant's jewelry.

Gould sought to register the mark "Charleston Gate" for jewelry. The examining attorney refused registration on the basis of mere descriptiveness and the Board affirmed. The examining attorney argued that the applied-for mark was merely descriptive of jewelry because the goods contained the designs of the famous gates of Charleston, South Carolina, or replications thereof. According to the examining attorney, Charleston was famous for the design of the hand-crafted gates built over centuries that dotted the city. The Board concluded that the term "Charleston Gate" identified the designs that Gould used in its jewelry. The evidence also established that relevant consumers would recognize the term as identifying those designs. Indeed, Gould's own marketing was based on this assumption.

In re Viwinco, Inc. (TTAB not citable 12/24/08)

Based on relevant factors, likelihood of confusion existed.

VI submitted an application to register the mark "Viwinco" for vinyl windows and doors (including replacement parts and accessories) and custom manufacture of windows and doors (including replacement parts and accessories). The examining attorney refused registration based on a likelihood of confusion with the registered mark "ViWinTech Windows & Doors A Quality Manufacturer of High Performance Vinyl Windows & Doors" and window design for vinyl windows and doors and parts for such goods. The Board affirmed the refusal to register, noting that VI's goods were identical to registrant's goods and that VI's services were closely related to registrant's goods. Both marks suggested vinyl windows and therefore had the

same connotation. Further, the marks were similar in appearance and pronunciation to the extent that they both began with the same syllables.

Osho Friends v. Osho Int'l. Foundation (TTAB not citable 1/13/09)

Primary significance of term was as a religious movement.

OIF filed applications to register the marks "Osho Active Meditations," "Osho Kundalini Mediation," "Osho Multiversity," and "Osho Meditation Resort" for conducting workshops, retreats, and courses concerning the teachings of the mystic Osho, as well as for spiritual counseling and meditations; "Osho Zen Tarot" and "Osho Transformation Tarot" for instructional books and playing cards for the game of Tarot, as well as for providing an online computer game; "Osho" and "Osho Nadabrahma Meditation" for the above listed educational services; and "Osho Times" for an online periodical relating to the teachings of the mystic Osho. Friends opposed registration of these marks and sought cancellation of OIF's registrations for similar marks. The Board ultimately held that the primary significance of the term "Osho" was as a religious movement. Thus, the term was generic in nature.

GoClear LLC v. Target Corp. (N.D.Cal. 1/22/09)

Party could not show predecessor's lawful use of mark.

The court granted in part and denied in part GCL's summary judgment motion on Target's counterclaims. While Target argued that it had superior rights to the mark "Clear X" by virtue of the use of the mark by a subsidiary, Target could not show that its predecessor lawfully used the mark. Target's predecessor sold the product associated with the mark in violation of specific provisions set forth in the Food, Drug and Cosmetic Act and consequently, Target could not rely on its predecessor's use of the mark to support its counterclaims seeking cancellation of GCL's registered "CleaRx" marks. The FDA had no record of any application by Target's predecessor for approval to sell its drug in interstate commerce. However, Target was not foreclosed from proving that the mark "The Clear Prescription," when used in connection with medicated skin lotion for treatment of acne, was descriptive.

Express Diagnostics Int'l., Inc. v. Tydings (N.D.Cal. 1/15/09)

Defendants failed to establish that term was generic.

The court granted in part and denied in part defendants' summary judgment motion. Defendants argued that the "DrugCheck" mark was unprotectable because it was either generic or descriptive and devoid of any secondary meaning. The proposed mark clearly indicated to relevant consumers that the purpose of the goods was to test or check for drugs. Even though the individual terms were generic, together they were descriptive of the product. In addition, evidence of defendants' own interest in the mark furthered the conclusion that, at

the very least, there were disputed issues of fact surrounding the mark's secondary meaning. Finally, there was insufficient evidence for a finding that EDI had acquiesced to defendants' use of the mark.

Domain Name Cases

Johansson v. Dare (WIPO 12/16/08)

Respondent played on complainant's fame to lure users.

Scarlett Johansson is a famous actress and celebrity who claims common law trademark rights in her name. Dare registered the "scarlettjohansson.com" domain name in April 2007. In August 2008, the domain name pointed to a site featuring a picture of Johansson with text enquiring if the visitor was "up to a threesome with Scarlett." The text went on to indicate that the "threesome" referred to a movie date with Johansson, the contest winner, and a friend of the winner. Further text explained that the site was aimed at promoting the United States release of Johansson's new movie, *Vicky, Cristina, Barcelona*. Johansson states that she never agreed to participate in the contest. The essence of Dare's position was that the posting of the "contest" in question on his website was a tongue-in-cheek exercise, which was intended to parody a typical Hollywood movie promotion in an interactive and humorous way. However, this explanation did not jive with the facts. The "contest" ran only for a few days in August 2008, while the domain name was registered by Dare as long ago as April 2007. Further, while Dare claimed to have received emails from an anonymous source offering him compensation to devise a promotional concept in support of the United States release of Johansson's new movie, that correspondence was allegedly received some sixteen months after Dare acquired the domain name. The false "contest" that Dare posted on his website in August 2008 therefore did not provide any explanation for the choice of a domain name that Dare appeared to have registered in April 2007. Moreover, Dare had provided no evidence of how the domain name was used in the period between April 2007 and early August 2008. Dare's claim that someone sent him an anonymous email offering him money to devise a promotional campaign for a movie seemed incredible. The panel noted that there was nothing on the site in question to make it clear that the site was not associated with Johansson. Dare had played on Johansson's famous reputation in order to lure Internet users to his website.

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