

Colorado Bar Association
INTELLECTUAL PROPERTY SECTION
NEWSLETTER

January 2009

Upcoming IP Section Events:

January Intellectual Property Section Luncheon
Strategic Intellectual Property Issues for Emerging Technology Companies
January 20, 2009, 11:30-1:15
CableLabs, Louisville, CO

As the capital available to early stage companies becomes more scarce, the need to carefully craft IP investment strategies increases in importance. The IP Section of the Colorado Bar Association is pleased to bring together a special Panel to discuss the development of IP investment strategies in early stage companies, with a focus on how IP can add value in different technology sectors and at different stages in a company's life cycle. The goal is 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 event will be a moderated Panel including:

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).

Cost: \$35 for IP Section Members and Silicon Flatirons Sponsors, \$45 for the General Public, and CU/DU Law Students are Free. Includes a catered lunch and parking. RSVP by calling (303) 860-1115 ext. 727 or by e-mailing lunches@cobar.org.

Cancellations and no-shows will be billed for the cost of the program. Checks can be sent to the Colorado Bar Association, 1900 Grant St., Suite 900, Denver, CO 80203. Also, please call or e-mail your RSVP when sending a check. Checks should be made payable to the CBA. If leaving a message, please spell your name, specify that you are attending the Intellectual Property Section January Luncheon, and leave your phone number.

**February IP Section Luncheon
February 11, 2009, 11:45 AM - 1:15 PM,
Denver Chop House, Large Banquet Room**

The IP Section is pleased to announce that former Judge Roderick McKelvie has agreed to present at the February IP Section Luncheon. Mr. McKelvie, who is currently a partner at Covington & Burling, has handled intellectual property and commercial matters at the trial and appellate level, including over 20 jury trials. From 1992 to 2002, he served as a United States District Court Judge for the District of Delaware. During those 10 years, he presided over more than 200 patent infringement cases, including more than 30 patent infringement trials. While on the bench and since his resignation he has worked to improve the procedures for presenting complex cases to juries, including having developed model jury instructions for patent infringement cases and the Federal Judicial Center's video for jurors, An Introduction to the Patent System. He is currently Chair of the Federal Circuit's ad hoc Committee on Model Jury Instructions. Mr. McKelvie will speak on current issues faced by the Court and parties in patent infringement cases.

Cost: \$35 for IP Section Members and CU/DU Law Students may attend for free. Reservations and cancellations for the monthly luncheon must be made prior to noon Tuesday, February 10, 2009. RSVP by calling (303) 860-1115 ext. 727 or by e-mailing lunches@cobar.org. When making your reservation, specify that you are attending the February IP Section Lunch, and include your name (and spelling), email address and phone number. Please specify beef, chicken or vegetarian for your lunch selection.

Cancellations after February 10, 2009 at Noon and no-shows will be billed for the cost of the program. Checks can be sent to the Colorado Bar Association, 1900 Grant St., Suite 900, Denver, CO 80203. Also, please call or e-mail your RSVP when sending a check. Checks should be made payable to the CBA.

**March IP Section Event - Silicon Flatirons Conference
Evaluating Software Patents
March 19, 2009 - 3:00 PM - 8:00 PM
Wolf Law Building, University of Colorado at Boulder**

The IP Section is pleased to co-sponsor this Silicon Flatirons Conference.

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.

Cost: \$25 for IP Section Members and CU/DU Law Students may attend for free. For more information and to sign-up, visit <http://www.silicon-flatirons.org>.

SAVE THE DATE:

April IP Section Luncheon
April 2, 2009, 11:45 AM - 1:15 PM
Denver Chop House, Large Banquet Room

The IP Section is pleased to announce that Mr. Thomas Irving has agreed to present at the April Section Luncheon. More details about this event will be announced soon.

Other IP Events:

Silicon Flatirons Conference
Antitrust Law for the New Administration
January 26, 2009 - 1:15 PM - 7:30 PM
Wolf Law Building, University of Colorado at Boulder

Antitrust law remains, as Robert Bork once put it, "at war with itself." In a recent episode, the war of words was quite literal, as the Justice Department and the Federal Trade Commission publicly sparred over the proper standards for the law of monopolization under the Sherman Act. Notably, the criticisms that Bork once leveled in the 1970s--that antitrust law viewed "big as bad," too quickly condemned vertical relationships, and used per se rules too liberally--are

no longer applicable. Nonetheless, over the last several years, culminating in its recent report on the state of monopolization law, the Department of Justice has suggested that concerns over "false positives" still counsel against aggressive antitrust enforcement and has, in exercising its oversight authority, displayed a high level of reticence in challenging mergers.

With a new administration taking office and the publication of the American Antitrust Institute (AAI) report on "The Next Antitrust Agenda: The American Antitrust Institute's Transition Report on Competition Policy to the 44th President of the United States", it is an opportune occasion to evaluate the state of antitrust law and practice. Just over one year ago, the Antitrust Modernization Commission evaluated the state of antitrust law and largely embraced the status quo, declining to call for substantial changes to the doctrines, institutions, or practices of antitrust enforcement. The AAI report, by contrast, highlights a series of issues that merit attention. In this conference, we will evaluate the issues at the foresight of antitrust policy, placing them in one of four categories: Monopolization, buyer power, and intellectual property; Merger review; Antitrust and regulated industries; and Strategic planning, institutional strategies, and toward a research agenda for competition policy.

To spur a thoughtful and engaged discussion around such issues, we will bring together a leading group of policymakers, academics, and practitioners for a one-day conference.

For more information and to sign-up, visit <http://www.silicon-flatirons.org>.

INTA Roundtable - Survey Evidence in Trademark Disputes
January 29, 2009 - Noon - 1 pm
Brownstein Hyatt Farber Schreck, LLP

This roundtable will cover such topics as reviewing and analyzing surveys from past trademark cases; finding out what is required in using surveys as evidence and learning strategies and techniques for developing proper surveys. This Roundtable is 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. Roundtable to be held at: Brownstein Hyatt Farber Schreck, LLP, 410 Seventeenth Street, Suite 2200, Denver, CO 80202-4432; Tel: 303-223-1100.

For more information, please contact Chris Parent (cparent@bhfs.com) and Martha Bauer (mbauer@bhfs.com).

The Boulder Denver New Technology February Meetup
February 3, 2009
Wolf Law Building, University of Colorado at Boulder

New Technology Meet-Ups regularly attract over 300 people to the CU Law School's Wittermyer Courtroom. During meetings, emerging businesses lead show-and-tell demonstrations of their new technology. Now over 1500 members and counting, the Boulder Denver New Technology Meet-up Group serves as a nerve center for area start-ups, attorneys, business people, investors, and other in the Front Range's entrepreneurial community. Silicon Flatirons co-sponsors the Meet-Up event, led by Robert Reich of local

venture-backed company Me.dium, which convenes the first Tuesday of each month. More information about the Meet-Up is available at the Meet-Up web-site, <http://www.meetup.com/bdnewtech/>.

Silicon Flatirons Conference

The Digital Broadband Migration: Imagining the Internet's Future

February 8, 2009 - 8:15 AM - 6:30 PM

February 9, 2009 - 9:00 AM - 1:30 PM

Wolf Law Building, University of Colorado at Boulder

The Internet's development has amazed even its early pioneers and its ability to confound skeptics suggests that calls for change should be taken with a grain of salt. At the same time, it seems difficult to imagine that the Internet's future will not feature any number of innovations that will change how it operates. Indeed, issues such as security, mobility, increased machine-to-machine communications, and the advent of real-time applications challenge some of the design principles of the current Internet. In any event, the network of the future will be shaped not merely by technological change, but also economics, the needs of users, and policy directives.

This conference will imagine the Internet's future, discuss its economic and social implications, and contrast different prescriptions for Internet policy. It will do so by bringing together a top flight group of academics, policymakers, and industry leaders to discuss these issues along four dimensions. First, we will evaluate the technological, economics, social, and policy challenges that are emerging on the horizon. Second, we will discuss the changing architecture of the Internet, the role of network management, and the significance of the transition away from an end-to-end architecture. The third panel will evaluate whether existing institutions--be they the Federal Trade Commission, the Federal Communications Commission; standard setting bodies like the Internet Engineering Task Force; self-regulatory bodies; or private contracting--are up to the task of overseeing Internet communications, including ensuring the reliable service delivery across different networks. The final panel will discuss the major changes in how the Internet serves consumers and how the market for Internet content is evolving. In all discussions, we will bring together the related technological, business, and policy themes that are shaping the Internet and the future of innovation in the information industries.

For more information and to sign-up, visit <http://www.silicon-flatirons.org>.

ANNOUNCEMENTS:

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. The following is a list of topics that we are considering for future programs. Please forward any comments you may have to John Posthumus at posthumusj@gtlaw.com:

1. International Patent Protection Panel
2. User Generated Content and IP Issues
3. Export Control
4. Colorado Federal District Court Judge: Viewpoint on Claim Construction Hearings
5. Mock Licensing Negotiation
6. The Use of Mock Juries and Trials
7. Electronic Discovery Issues in IP Cases
8. The Use of Surveys in Trademark Infringement and Dilution Litigation
9. Copyright Exhaustion

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
Big O Tires, LLC v. T&B Tire, Inc., et al.	Trademark Infringement (Lanham Act)	08cv2670	Walker D. Miller	Harold R. Bruno, III Robinson, Waters & O'Dorisio, PC
Big O Tires, LLC v. T&M Automotive Industries, Inc. et al.	Trademark Infringement	08cv2727	Wiley Y. Daniel	Harold R. Bruno, III Robinson, Waters & O'Dorisio, PC
Ceragenix Corporation v. Skinmedica, Inc	False Advertising	08cv2697	Arguello, Christine M	Glenn K. Beaton Gibson Dunn & Crutcher, LLP
Dphi, Inc. v. Mediatek, Inc.	Patent Infringement	08cv2675	Walker D. Miller	William D. Meyer Hutchinson, Black and Cook, LLC
Group Publishing, Inc. v. Mullins	Copyright Infringement	08cv2726	Marcia S. Krieger	Paul Cha Holme Roberts & Owens, LLP
Home Design Services, Inc. v. Stone Creek Homes, Inc., et al	Copyright Infringement	08cv2662	Marcia S. Krieger	Anthony M. Lawhon Parrish, Lawhon & Yarnell, PA
Nau Holdings, LLC et al. v. Dlorah, Inc.	Trademark Infringement (Lanham Act)	08cv2743	Zita L. Weinshienk	John D. Martin Martin, Lubitz & Hyman, LLC
QFA Royalties LLC et al v. Bratman, et al.	Trademark Infringement (Lanham Act)	08cv2814	Walker D. Miller	Suzanne E. Rauch Moye White, LLP
Sentek PLC v. Salz et al	Tradenark Infringement (Lanham Act)	08cv2755	Wiley Y. Daniel	John F. Walsh, III Hill & Robbins, P.C.
Sony BMG Music Entertainment et al. v. Estrada	Copyright Infringement	08cv2682	Phillip A. Brimmer	Shane R. Cross Holme Roberts & Owen, LLP

CAPTION	TYPE	CASE NO.	JUDGE	FILING ATTORNEY(S) - Local
Translogic Corporation v. Leavelle Carriers et al	Patent Infringement	08cv2789	Robert E. Blackburn	Paul Forrest Lewis Sherman & Howard LLC
Xylem Design v. Easy Pedestal, Inc.	Patent Infringement	08cv2740	Walker D. Miller	Erik G. Fischer Fischer & Fischer, LLP

Notes on Recent IP Decisions in Colorado

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 (January 2009)

Patent Cases

Netcraft Corp. v. eBay, Inc. (Fed. Cir. 12/9/08)

Trial court correctly construed claim limitation at issue.

The trial court granted summary judgment of non-infringement in favor of eBay and the Federal Circuit affirmed. Based on a reading of the common specification in its entirety, along with the cited prosecution history, the Federal Circuit concluded that the claim limitation "providing a communications link through equipment of the third party" required providing customers with Internet access. The specification consistently described the invention in terms of a third party providing Internet access to customers. The prosecution history lacked the clarity of the specification regarding the meaning of the claim term at issue, thereby rendering it less useful for claim construction purposes. As a result, the trial court's failure to consider the prosecution history was harmless error.

In re Certain Probe Card Assemblies (ITC 11/25/08)

Party not entitled to request general exclusion order.

The ITC instituted an investigation on behalf of FormFactor, Inc., which alleged that various respondents, including Micronics Japan Co., Ltd., MJC Electronics Corp., Phicom Corp., and Phiam Corp., had imported certain flash memory devices and products containing such devices that infringed various patents. The ALJ granted in part and denied in part the motion for partial summary judgment filed by respondents. The motion sought a determination that the relief being pursued by FormFactor, Inc. with respect to certain DRAM and NAND flash memory devices and products containing such devices based on infringement of the '485 patent was unavailable under recent Federal Circuit precedent. Specifically, respondents asserted that due to the [Kyocera Wireless](#) decision, there was no remedy available to FormFactor for any direct violation of the '485 patent. According to respondents, FormFactor only requested relief in the form of a limited exclusion order and did not specifically request

relief in the form of a general exclusion order. Respondents argued that under ITC precedent, a complainant could only seek a general exclusion order if it was expressly requested in the complaint. As a result, respondents asserted that the '485 patent should be terminated from this investigation. This was the only patent that FormFactor was relying on to exclude the importation of DRAM and NAND flash memory devices made outside of the United States by third-parties. The real issue here was whether FormFactor could request a general exclusion order for infringement of the '485 patent. The ALJ answered this question in the negative, finding that FormFactor had failed to request a general exclusion order in its complaint and had failed to promptly move for leave to amend the complaint when it determined the need for such a remedy. As a result, FormFactor was not entitled to request a general exclusion order in this matter.

QR Spex, Inc. v. Motorola, Inc. (C.D.Cal. 12/4/08)

No reasonable jury could find that eyewear infringed patent.

The court granted defendants' motion for partial summary judgment, finding that the accused eyewear did not infringe claim 1 of the '767 patent because the Bluetooth receivers in the Oakley eyewear were not embedded within the frame. The Bluetooth receivers in the accused eyewear were attached to the frames by clips, screws, posts, and ridges. The Bluetooth receivers could be easily removed or replaced and were not permanently set in the frame as claim 1 of the '767 patent required. Consequently, the Oakley eyewear did not literally infringe the '767 patent. Nor did the accused eyewear infringe claim 1 under the doctrine of equivalents. The eyewear at issue did not perform the same function in the same way as the eyewear claimed in the '767 patent. In addition, QR narrowed its claims during prosecution to claim only eyewear with a transceiver embedded in the frame.

Preci-Dip, SA v. Tri-Star Electronics Int'l., Inc. (N.D.Ill. 12/4/08)

Unfair competition claims were linked to infringement claim.

The court granted TSE's motion to dismiss pursuant to the first-to-file rule. The parties to this suit and the California suit were the same and it was clear that the unfair competition claims asserted in the present matter were inextricably linked to the infringement claim involved in the California suit. The unfair competition claims all arose from TSE's communications with Preci-Dip's customers about its alleged infringement of the '974 patent, the validity of which was at issue in both suits. Consequently, the issues involved in the two suits were the same. In addition, the court was not persuaded that TSE had filed the California action in bad faith. The fact that there were plausible interpretations of the '974 patent other than the one offered by Preci-Dip refuted its argument that TSE knew, from the face of the patent and the features of Preci-Dip's product, that its infringement claim was baseless. The fact that TSE sent a letter to Preci-Dip's customers did not impugn its motive for filing the California suit.

Sanofi-Synthelabo v. Apotex, Inc. (Fed. Cir. 12/12/08)

Only with hindsight would separation have been obvious.

After a bench trial was held, the lower court ruled that the '265 patent was valid and enforceable. The Federal Circuit affirmed, noting that the trial court correctly declined to find that the general statements in the involved prior art references stating that the compounds at issue consisted of enantiomers constituted an anticipating disclosure of the separated dextrorotatory enantiomer of PCR 4099. The knowledge that enantiomers could be separated was not anticipation of a specific enantiomer that had not been separated, identified, and characterized. Nor was there clear error in the findings of the trial court concerning the difficulty of the separation of these enantiomers. Only with hindsight knowledge that the dextrorotatory enantiomer had desirable properties could Apotex argue that it would have been obvious to select this particular racemate and undertake its separation.

Avocent Huntsville Corp. v. Aten Int'l. Co., Ltd. (Fed. Cir. 12/16/08)

Dismissal of claims for lack of jurisdiction was proper.

The trial court dismissed all of the claims for lack of personal jurisdiction and the Federal Circuit affirmed. Avocent primarily argued that AIC (a company based in Taiwan) was subject to personal jurisdiction in Alabama based on the alleged availability of various products for sale in the forum state. Avocent's complaint did not expressly identify AIC's U.S. subsidiaries or explain the relationship between these corporate entities. Instead, it merely alleged that AIC engaged in unspecified sales and marketing activity through various agents. However, the mere sale of products was not sufficient to establish specific personal jurisdiction in a declaratory judgment suit. Finally, the three letters at issue attributed to AIC in this case did not subject it to personal jurisdiction in Alabama.

Power Integrations v. Fairchild Semiconductor (D.Del. 12/12/08)

Worldwide sales damages included activities outside of U.S.

The court granted Fairchild's motion for remittitur and reduced the amount of damages awarded to Power by eighty-two percent. In this case, the jury clearly adopted the measure of damages proposed by Power's expert, Troxel. Troxel testified that his calculations were based on a worldwide sales measure of damages. The worldwide sales measure of damages encompassed Fairchild's activities outside the United States, which could not be considered infringing. In other words, the amount of damages proposed by Troxel and adopted by the jury was not actually rooted in Fairchild's infringing activity in the United States. However, evidence at trial showed that eighteen percent of the devices sold outside the United States were later imported into the United States by unnamed third-parties. Acceptance of this figure necessarily meant that eighty-two percent of the devices were not later imported, thereby requiring a reduction of the award in this amount.

Research in Motion Ltd. v. Motorola, Inc. (N.D.Tex. 12/11/08)

Defendant's conduct could clearly harm competition.

The court denied Motorola's motions to dismiss all of RIM's claims, as well as its alternative motion to bifurcate and stay the antitrust and contract claims. In addition, the court denied Motorola's motion to dismiss, stay, or transfer RIM's declaratory judgment claims. Regarding

the antitrust claim, all of the injuries alleged by RIM stemmed from Motorola's refusal to honor its promise to offer the patents on fair, reasonable, and nondiscriminatory terms. Assuming that the facts as alleged by RIM were true, it was clear that RIM had suffered injuries as a result of Motorola's conduct. Even if Motorola's conduct did not eliminate competition entirely, it had the power to harm it. The type of gate-keeping alleged by RIM caused exactly the kind of harm that antitrust laws were designed to prevent. RIM had properly pled harm to both itself and to competition.

Rentrop v. The Spectranetics Corp. (Fed. Cir. 12/18/08)

Defendant had waived its arguments based on KSR.

The trial court entered final judgment in favor of Rentrop based on a jury's verdict that found claim 1 of the '064 patent not invalid and infringed. After trial, the court considered and rejected TSC's defense of inequitable conduct and denied its motion for JMOL on infringement. The Federal Circuit affirmed, finding that TSC had waived its argument based on [KSR](#) because it did not bring this argument to the trial court's attention before entry of judgment. *KSR* was decided almost four months before the trial court entered judgment, giving TSC ample time to bring that decision to the trial court's attention. The Federal Circuit agreed with the trial court that sufficient evidence was presented to sustain the jury's finding that the accused products infringed claim 1 of the '064 patent. Neither was TSC entitled to reversal of the trial court's rejection of the inequitable conduct defense.

Diamonds.net LLC v. Idex Online, Ltd. (S.D.N.Y. 12/18/08)

An actual controversy as to patent's validity persisted.

The court denied Diamond's motion to dismiss Idex's invalidity counterclaim for lack of subject matter jurisdiction. In the particular circumstances of this case, an actual controversy as to the validity of the '178 patent persisted even after Diamond dismissed its infringement claim with prejudice and covenanted not to sue Idex for infringement of the '178 patent for any activities before February 20, 2008. Because the dispute extended beyond Diamond's initial infringement claim and the specific version of Idex's website implicated by that claim, the counterclaim continued to be supported by an actual controversy. The overlap between the parties' systems demonstrated the reasonableness of the contention that Idex was afraid of an ongoing infringement dispute with Diamond. Moreover, Idex planned to roll out its upgraded system in the United States in the near future. The primary impediment to Idex launching its upgraded site was the legal uncertainty created by the '178 patent.

Brown v. Toscano (S.D.Fla. 12/18/08)

Request to impose constructive trust was premature.

The court granted in part and denied in part Brown's motion to dismiss certain of Toscano's counterclaims. To the extent that the inventorship counterclaim requested the court to decide the correct inventorship relating to the second continuation application, it had to be dismissed for failure to state a claim. In addition, it was clear that a declaratory judgment as to the invalidity and enforceability of a pending patent application did not present a justiciable case or

controversy, as such a declaration would be an impermissible advisory opinion. Finally, the request to impose a constructive trust as to patent rights that might arise from the patent application and the second continuation application was premature because no such rights presently existed. Although a patent application could be a form of property, no patent rights would arise until the application matured into a patent.

Ricoh Co., Ltd. v. Quanta Computer, Inc. (Fed. Cir. 12/23/08)

Trial court erred in assessing contributory infringement.

The trial court granted summary judgment in favor of Quanta, finding that the asserted claims of the '109 patent were obvious, that the accused devices did not practice the methods of the asserted claims of the '955 patent, and that Ricoh failed to present evidence sufficient to create a fact issue as to either direct or indirect infringement of the '552 and '755 patents. Because the trial court applied erroneous standards for assessing contributory infringement and whether defendant Quanta Storage, Inc. induced infringement of the '552 and '755 patents, the Federal Circuit vacated the summary judgment of non-infringement. Regarding the issue of contributory infringement, remand was necessary to determine whether Quanta's drives contained components that had no substantial non-infringing use other than to practice the claimed methods.

Trademark Cases

Jeske v. Fenmore (C.D.Cal. 12/1/08)

Website was both interactive and commercial in nature.

The court denied Fenmore's motion to dismiss for lack of personal jurisdiction, noting that Fenmore's website was both interactive and commercial in nature. Through use of the site, Fenmore sought to solicit participants for her pageants, advertise the pageants, and promote the services related to operation of the pageants. In other words, Fenmore clearly used the site to conduct business operations. The ability to pay fees online also demonstrated the interactive nature of the site. Further, the site, via its entry form and online payment option, demonstrated that California was one of the solicited states. Fenmore's advertising of the various California titles connected to the pageants showed that Fenmore directed business to California. Finally, Jeske's claim for trademark infringement arose out of and related to Fenmore's forum-related activities.

In re LG Electronics, Inc. (TTAB not citable 11/20/08)

Addition of term did not distinguish involved marks.

LG applied to register the mark "BluRadiance" for domestic oven ranges, electric cooking ranges, and microwave ovens. The examining attorney refused registration based on a likelihood of confusion with the registered mark "Radiance" for gas stoves and the Board affirmed. The addition of the term "Blu" to the applied-for mark did not significantly change the

sound, appearance, meaning, or commercial impression of the mark. This term would simply suggest to many purchasers that "BluRadiance" was another product in the line of "Radiance" products from the same source. The similarities between the marks were clearly greater than their differences. In addition, the parties' goods were obviously related. Purchasers were likely to associate a gas stove for warming items and heating with a domestic cooking oven range. Thus, there was a likelihood of confusion in this case.

AAA v. Pacific Delight Tours, Inc. (TTAB not citable 11/19/08)

Relationship existed between goods and services.

Pacific holds a registration for the mark "China & Asia Tourbook" for arranging and conducting travel tours. AAA filed a petition to cancel Pacific's registration based on a likelihood of confusion with and dilution of its registered mark "TourBook" for books describing places of sightseeing interest and other travel information. AAA also filed a trademark application for "TourBook" for providing travel information via the Internet, which was refused registration in view of Pacific's registration. The Board granted AAA's petition to cancel on the basis of a likelihood of confusion, though finding that AAA had not shown that its mark was famous. The dominant portion of Pacific's mark was "Tourbook," which was identical to AAA's registered mark. There was also a relationship between AAA's books and Pacific's services.

Dress for Success Worldwide v. Dress 4 Success (S.D.N.Y. 12/5/08)

Any common law rights were extinguished by agreements.

The court granted DSW's motion for a preliminary injunction and denied D4's motion for a preliminary injunction. Ultimately, the court concluded that DSW was likely to succeed on the merits and that it would be irreparably harmed absent a preliminary injunction. While DSW conceded that D4 had pre-existing common law trademark rights in its "Dress 4 Success" mark, DSW's "Dress for Success" mark merited protection against D4's mark because the latter's common law rights did not survive the agreements at issue. In other words, the merger rule extinguished any common law rights that D4 might have had in its mark. Whatever common law rights that D4 possessed in its "Dress 4 Success" mark were extinguished when D4 signed the membership agreement and trademark licensing agreement with DSW. Thus, D4 could not overcome DSW's federally registered mark.

Framed Wall Art, LLC v. PME Holdings, LLC (D.Utah 12/12/08)

No showing that trade dress was consistent and uniform.

The court denied FWA's motion for a preliminary injunction. FWA had failed to establish that its trade dress had consistency and uniformity. Raymond, FWA's principal, testified that he did the antiquing depending on how he wanted it to look on any given picture. The frames were heavy wood and came in colors and stains that were currently popular. Allowing a customer to choose his or her frame did not lend itself to a finding that FWA had developed a unique or uniformly distinctive look. The products sold by FWA and PME (as well as those of a third-party) all appeared remarkably similar. FWA had not articulated or supported its claimed trade

dress with sufficient particularity. The trade dress claimed by FWA was so broad that it would effectively monopolize the market. Moreover, FWA had not shown that its trade dress had acquired secondary meaning.

H. Jay Spiegel & Associates, P.C. v. Spiegel (E.D.Va. 12/11/08)

Balance of harms clearly favored defendant, not plaintiff.

The court denied PC's motion for a preliminary injunction, explaining that the balance of harms favored Spiegel and that PC's likelihood of success on the merits was uncertain. The court did agree that Spiegel's use of the domain name "spiegellaw.com" posed some threat to the goodwill that PC had built up in its domain name. On balance, however, the court was not convinced that PC would be harmed to a significant extent during the pendency of this suit. A potential client searching for a patent attorney named "Spiegel" and finding the site of an attorney practicing employment law (defendant) would quickly realize the mistake. The actual possibility that potential clients would be confused in a way that led to serious harm to PC appeared low. Further, an injunction forbidding Spiegel from using the domain name presented a substantial likelihood of significant harm.

Ballet Tech Foundation v. Joyce Theater (TTAB citable 12/11/08)

Course of conduct between parties created implied license.

BTF filed a petition seeking to cancel JT's registrations (for the marks "Joyce," "Joyce Theater," and "Joyce Soho" for dance performance theaters and performance arts theater productions and "Joyce Theater Foundation" for charitable fundraising services) and also filed an opposition to JT's application to register the mark "Joyce" for charitable fundraising services. As grounds, BTF alleged that it, not JT, was the owner of the "Joyce" marks. The Board granted the petition for cancellation and sustained the opposition. According to the Board, BTF was the owner of the "Joyce" marks and JT was using the marks pursuant to an implied license. Further, the evidence showed that BTF ultimately controlled the nature and quality of the services rendered in connection with the marks. BTF's efforts in this regard were sufficient to support the licensing relationship.

In re Heeb Media, LLC (TTAB citable 11/26/08)

Party had not rebutted prima facie case of disparagement.

HM submitted an application to register the mark "Heeb" for clothing and conducting parties. The examining attorney refused registration on the ground that HM's mark was disparaging to a substantial composite of the referenced group, namely, Jewish people. The Board affirmed the refusal to register, noting that HM's own evidence showed that not all members of the relevant public found the term to be unobjectionable. On the contrary, the letters submitted by HM showed that some members of the relevant public found the term derogatory and suggested that there was a generational divide in the perception of this term. All of the dictionaries and online references characterized "Heeb" as a derogatory term. The fact that HM had good intentions with its use of the term did not obviate the fact that a substantial composite of the referenced group found the term objectionable.

In re Kaemark, Inc. (TTAB not citable 11/28/08)

Examining attorney's understanding of term was too broad.

Kaemark filed an application to register the mark "Luxe" for salon furniture. The examining attorney refused registration based on a likelihood of confusion with the registered mark "Luxe" for furniture. The Board reversed the refusal, explaining that the term "furniture" could not be read so broadly that it would encompass every possible item that could be used to furnish any possible type of business or industry. Because of the specialized nature of "salon furniture," which was more in the nature of equipment, the Board did not consider Kaemark's goods to be encompassed by the identification of "furniture" in the cited registration. Further, Kaemark's goods would be sold to those in the beauty-related industry, such as owners and operators of beauty salons. Such individuals were discriminating and careful purchasers.

In re BetaBatt, Inc. (TTAB citable 12/15/08)

Proposed mark was routinely used as abbreviation.

BetaBatt filed an application to register the mark "DEC" for batteries deriving power from nuclear decay processes, treatment of radioactive materials and/or porous substrates for use in the fabrication of such batteries, and consulting and technical advisory services relating to such treatment services and batteries. The examining attorney refused registration on the basis of mere descriptiveness and the Board affirmed. The evidence showed that "DEC" was routinely used as an abbreviation for the term "direct energy conversion." BetaBatt argued that there was no evidence that the everyday buyer of a battery used in connection with hearing aids or similar medical devices would know that "DEC" stood for "direct energy conversion." However, BetaBatt's description of goods was not limited to batteries used in connection with hearing aids or similar medical devices.

In re Barrie House Coffee Co., Inc. (TTAB not citable 12/18/08)

Purchasers would be able to distinguish marks.

Barrie submitted an application to register the mark "Mocca" for coffee beans. The examining attorney refused registration on the basis of mere descriptiveness and likelihood of confusion with the registered mark "Moca" and man design for coffee and coffee derivatives. The Board affirmed as to the first basis, but reversed as to the latter basis. Concerning the issue of a likelihood of confusion, the marks were different because the registered mark included the drawing of a stylized man. This absence of the drawing in Barrie's mark was not sufficient to distinguish it from registrant's mark. But in the Board's view, the differences between the marks outweighed the similarities. Purchasers would be able to distinguish the marks because the common elements were so highly descriptive that consumers would perceive "Mocca" and "Moca" as ordinary descriptive speech.

Visible Systems Corp. v. Unisys Corp. (1st Cir. 12/23/08)

Jury could have found a likelihood of reverse confusion.

A jury found in favor of VSC on its reverse confusion claim and the trial court issued a permanent injunction prohibiting Unisys from using the marks "3D Visible Enterprise," "3D-VE," or "Visible" in the United States in the enterprise modeling or enterprise architecture fields. The 1st Circuit affirmed, noting that the facts of this case rationally supported a finding of a likelihood of reverse confusion. While VSC presented no evidence of actual confusion at trial, the jury could have inferred actual reverse confusion from the company's decline in revenues from the sales of its software products. A jury could have concluded that the Unisys mark overcame VSC's marks. Further, there was testimony supporting the amount awarded by the jury. Finally, the evidence was insufficient to justify an accounting.

Copyright Cases

Fox v. Riverdeep, Inc. (E.D.Mich. 12/16/08)

Unclear if license was taken with notice of transfer.

The court denied the summary judgment motions filed by Riverdeep, Cash, and C*Ding, LLC. It was undisputed that Fox did not record his copyright in the software program at issue until July 2004, after Riverdeep had licensed the work to Cash in February 2004. The issue was whether Cash took her license without notice of Fox's ownership interest. Cash did not have constructive notice because Fox did not record his copyright before Cash entered into the license with Riverdeep. Whether Cash had actual or inquiry notice, however, was a question for the jury. The court rejected the laches argument put forth by Cash and C*Ding, as they had not shown undue prejudice as a result of Fox's delay. Finally, a fact issue existed as to whether Riverdeep induced or materially contributed to Cash's infringement.

Intervest Construction v. Canterbury Estate (11th Cir. 12/22/08)

No jury could have found floor plans substantially similar.

The trial court granted summary judgment in favor of Canterbury and the 11th Circuit affirmed. The facts showed that the trial court carefully compared the protectable aspects of the two floor plans at issue, thus focusing only on the narrow arrangement and coordination of otherwise standard architectural features. At the conclusion of its analysis identifying many dissimilarities in the two floor plans, the trial court ruled that at the level of protected expression, the differences between the designs were so significant that no reasonable, properly instructed jury could find the works substantially similar. Given that the plans at issue were protected by compilation copyrights that were "thin," the trial court correctly determined that the differences in the protectable expression were so significant that, as a matter of law, no reasonable jury could find the works substantially similar.

Gaylord v. United States (Fed. Cl. 12/16/08)

Use of sculpture in postal stamp was clearly a fair use.

The court ruled in favor of the United States, finding that while Gaylord was the sole copyright owner of the sculptural work known as "The Column," the United States Postal Service fairly

used the sculpture in the stamp. The photographer's skills resulted in a work that had a new and different character than "The Column" and thus, was a transformative work. The USPS further altered the expression of Gaylord's statues by making the color in the photo even grayer, creating a nearly monochromatic image. Therefore, the stamp was a transformative work, having a new and different character and expression than Gaylord's statues. In addition, while the USPS used a substantial part of Gaylord's work in the stamp, this fact was somewhat mitigated by the quality and importance of the statues to the stamp. Moreover, the stamp had little impact on the sculpture's potential market.

Domain Name Cases

La Societe des Bains v. Nathan (WIPO 11/14/08)

Respondent must have intended resulting confusion.

Nathan chose for the disputed domain name the prominent mark "Casino de Monaco," which invoked the famous casino in Monaco that had been operated by Bains since 1863. Having registered the subject domain name, Nathan then linked it to a site that was itself linked to casinos and other such facilities. Thus, Nathan had no rights or legitimate interests in the domain name. In addition, Bains succeeded in showing that Nathan had registered and used the domain name in bad faith. It was more probable than not that Nathan's intention in registering the domain name was to create confusion with the "Casino de Monaco" mark. The circumstances present here created confusion and Nathan must have intended this confusion, which resulted in commercial gain for him. Finally, bad faith was shown by Nathan's attempts to conceal his identity.

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