

INTELLECTUAL PROPERTY SECTION NEWSLETTER

March 2009

Upcoming IP Section Events:

March IP Section Event

Evaluating Software Patents

Co-sponsored by Silicon Flatirons

Conference and the IP Section

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

Wolf Law Building, University of Colorado at Boulder



Silicon Flatirons

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

UPCOMING EVENTS

- **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

UPCOMING EVENTS

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

UPCOMING EVENTS

- **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

April IP Section Luncheon

IP Due Diligence

Tom Irving, Partner,

Finnegan, Washington, D.C.

April 2, 2009, 11:45 AM - 1:15 PM

Denver Chop House, Large Banquet Room

FINNEGAN

Mr. Irving will 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, including how proceed on the following issues:

- (1) Who actually owns the intellectual property, and whether a 3rd party has a claim on it?
- (2) Will the claims of the IP be construed to literally cover the key technology to be acquired? How much extra breadth is there to combat the inevitable design-arounds?
- (3) Will those key claims that cover the key technology be sustained as valid? For example, were the key patents issued pre-KSR? Will they survive post-KSR? Should you be thinking reissue?
- (4) Are the key patents enforceable? What are the chances a court will find inequitable conduct and sink each key patent, exposing your client to attorney fees and possible antitrust liability? Is there anything that can be done to improve the situation if clouds arise from the investigation?

UPCOMING EVENTS

He will also address how to address resistance from the target, since the more they tell you, likely, the less your client will pay. Mr. Irving will discuss how to work around such intransigence including whether reps and warranties make sense.

Tom has more than 31 years of experience in the field of intellectual property law. He has served for more than 10 years as principal teacher of Kayton's PRG Chemical Patent Practice course. He has also originated and is teaching PRG's Orange Book and Due Diligence courses. Mr. Irving also presents analyses of Federal Circuit patent decisions for many diverse groups, including the Ohio State IP Institute, the Michigan IP Institute, the Houston IP Institute, the North Carolina IP bar, the Utah IP bar, the Missouri IP bar, the combined South and North Carolina IP bars, and the combined Oregon and Washington IP bars. Mr. Irving has also served as the keynote speaker on patent law developments at the annual meeting of the Intellectual Property Owners Association (IPO). He serves as a lecturer to the Chemistry Examination Department of the Patent Office of the State Intellectual Property Office (SIPO) of the People's Republic of China.

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, March 31, 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 April 2nd 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 March 31, 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.

April IP Section Luncheon
April 28, 2009,
11:45 AM - 1:15 PM
Denver Chop House, Large Banquet Room



LEO J. SHAPIRO & ASSOCIATES LLC

The IP Section is pleased to announce that nationally renowned trademark survey expert Phil Johnson of [Leo J. Shapiro Associates, LLC](http://www.leojshapiro.com) has agreed to present at the April 28th Section Luncheon. More details about this event will be announced soon.

UPCOMING EVENTS

Other IP Events:

Report on the February IP Section Luncheon:

Over 60 IP Section members were in attendance for the February IP Section lunch presentation by Roderick McKelvie, a former U.S. District Court Judge, District of Delaware, now a partner at Covington and Burling. Mr. McKelvie shared his insights into the conduct of patent infringement cases earned from 10 years on the federal bench, during which he presided over more than 200 patent infringement cases, including more than 30 patent trials. Mr. McKelvie personally enjoyed patent cases because they represented a very interesting intersection of science, business and law. Yet, Mr. McKelvie acknowledged that many other judges are not so keen on patent cases and patent litigators. He framed the remainder of his talk around the question, “Why do courts hate us and our cases?”

One answer offered by Mr. McKelvie is that patent cases are extremely hard-fought and contentious, and that parties often lack incentives to compromise. Lawyers often treat a trial court as merely the first stop on the journey to the “real resolution” which will take place at the Federal Circuit. Also, Mr. McKelvie noted the dearth of conflicting legal principles announced by the Federal Circuit, which make it difficult for the trial judge to determine what the law is, let alone how to properly apply it.

Mr. McKelvie recommended to the national patent litigation bar to make better use of local counsel by making sure that local counsel are actively involved in the litigation, even if they are not in the lead. Doing so, according to Mr. McKelvie, will alleviate the concerns by many judges that national patent litigators are disrespectful to the local practice and the local bar.

Mr. McKelvie also recounted several “war stories” from the bench. For example, in the wake of the Markman decision, and to some degree even today, judges struggle to fit claim construction within the context of the Federal Rules of Civil Procedure. It is unclear, for example, whether the claim construction process is more akin to trial or to summary judgment. A judge's view on the answer to this question will often inform the way in which that judge conducts the Markman proceedings. Also, judges are not always sure whether to construe claims earlier or later in the proceedings.

Mr. McKelvie underscored the fact that difficulty in explaining the underlying technology to the court and to the jurors is a key obstacle in efficient conduct of patent trials. To overcome this obstacle, Mr. McKelvie suggested educating the judge by each side submitting videos describing the technology. Also, the jury may be helped by allowing lawyers to use extensive transition statements that put the testimony in context.

A video replay of this event can be found at the Colorado-CLE website:

<http://www.cobar.org/cle/datadetail.cfm?productid=IP021109N>.

ANNOUNCEMENTS

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 I.P. CASES: U.S.D.C. of COLORADO

| CAPTION | TYPE | CASE NO. | JUDGE | FILING ATTORNEY(S) - Local |
|------------------------------------------------------|-----------|-----------|-----------------------|---------------------------------------------------------------------------------------------------------------------------------------|
| Asher v. Target Corporation | Patent | 1:09cv438 | Robert E. Blackburn | William W. Cochran Cochran, Freund & Young, LLC , Erik G. Fischer Fischer & Fischer, LLP |
| Asher v. Walgreen Co | Patent | 1:09cv457 | Christine M. Arguello | Erik G. Fischer Fischer & Fischer, LLP |
| Big O Tires, LLC v. C&M Enterprizes, Inc et al | Trademark | 1:09cv407 | Wiley Y. Daniel | Harold R. Bruno, III Robinson, Waters & O'Dorisio, P.C. |
| Big O Tires, LLC v. Tirecrafters, Inc et al | Trademark | 1:09cv406 | Christine M. Arguello | Harold R. Bruno, III Robinson, Waters & O'Dorisio, P.C. |
| Bill Good Marketing, Inc v. Gorillasoft, Inc | Trademark | 1:09cv428 | Christine M. Arguello | Brandee L. Caswell Faegre & Benson, LLP-Denver |
| Galderma Laboratories, LP et al v. Tolmar, Inc | Patent | 1:09cv452 | Wiley Y. Daniel | Robert Nolen Miller Perkins Coie LLP-Denver |
| Harmony, LLC v. Hillside Commercial Group, Inc et al | Trademark | 1:09cv313 | Richard P. Matsch | Katherine Lee Collins Luke Santangelo Santangelo Law Offices, P.C. |
| Hildebrand v. CTA Manufacturing Corp et al | Patent | 1:09cv444 | Robert E. Blackburn | Pro-se litigant |
| Hildebrand v. Jegs High Performance, Inc et al | Patent | 1:09cv349 | Robert E. Blackburn | Pro-se litigant |
| Home Design Services, Inc v. Gomez et al | Copyright | 1:09cv268 | Philip A. Brimmer | Anthony M. Lawhon Parrish, Lawhon & Yarnell, P.A |
| Infomedia, Inc v. Air-O-Matic Inc | Trademark | 1:09cv302 | Zita L. Weinshienk | Kevin Eugene Houchin Houchin & Associates, P.C. Misha J. Kerr Joel B. Rothman Seiden, Alder, Matthewman, & Bloch, P.A |

RECENTLY-FILED I.P. CASES: U.S.D.C. of COLORADO

| CAPTION | TYPE | CASE NO. | JUDGE | FILING ATTORNEY(S) - Local |
|----------------------------------------------------------------------------------------|-----------|-----------|-----------------------|---------------------------------------------------------------------------------------|
| International Debate Education Association v. National Center for Policy Analysis Et A | Trademark | 1:09cv310 | Christine M. Arguello | Timothy Paul Getzoff Holland & Hart, LLP-Boulder |
| RE/MAX International, Inc v. RSN Media, Inc et al | Trademark | 1:09cv387 | Christine M. Arguello | John R. Posthumus Gayle L. Strong Lucky Vidmar Greenberg Traurig, LLP-Denver |
| Shell v. American Family Rights Association et al | Copyright | 1:09cv309 | Marcia S. Krieger | Pro Se Litigant |
| Spyder Active Sports, Inc v. Bombardier Recreational Products, Inc | Trademark | 1:09cv383 | Robert E. Blackburn | Donald A. Degnan Holland & Hart, LLP-Boulder |
| Video Professor, Inc v. Montgomery | Trademark | 1:09cv417 | Robert E. Blackburn | Gregory C. Smith Fairfield & Woods, P.C. |

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).

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Copyright Cases

***KBL Corp. v. Arnouts* (S.D.N.Y. 2/7/09)**

No right existed to contribution among co-infringers.

The court granted defendants' motion to dismiss for failure to state a claim. KBL alleged that it was entitled to contribution from defendants for its expenses incurred in connection with two lawsuits. There was no basis to conclude that federal copyright law provided for a right to contribution among co-infringers. Likewise, there was no basis to conclude that federal courts had established a right to contribution for co-infringers through federal common law. In addition, KBL's effort to find a right to contribution in New York State law was unavailing. KBL could not use New York State common law as an end-around to make a claim for contribution that it could not make under the federal statutory scheme. Moreover, KBL could not state a claim for indemnification in this case because it was clear that KBL bore at least some fault for any infringement of Betz's copyrights.

***La Resolana Architects, PA v. Reno, Inc.* (10th Cir 2/17/09)**

Party failed to establish copying as a factual matter.

After a bench trial, judgment was entered in favor of Reno on all counts. The 10th Circuit affirmed, concluding that the trial court did not clearly err in determining that LRA failed to establish copying as a matter of fact. The trial court concluded that Reno never saw LRA's copyrighted plans. Even if LRA's evidence demonstrated a bare possibility that Reno had access to its copyrighted plans, a bare possibility was not sufficient to show access. The evidence in the record supported the trial court's factual findings, which, in turn, supported its conclusion that Reno did not have the requisite access. Moreover, the trial court did not err in finding that the plans at issue were not strikingly similar. There were major differences in the kitchen area, living room, master bath, roof slope, placement of doors, and plumbing placement, all of which affected traffic flow and articulation of space.

***Arista Records LLC v. Does 1-16* (N.D.N.Y. 2/18/09)**

Need for info trumped right to remain anonymous.

The court denied the Doe defendants' motion to quash the subpoena. The court previously gave permission for Arista to serve a subpoena on the State University of New York at Albany, seeking information sufficient to identify each Doe defendant. First, the court held that Arista had adequately pled that defendants distributed Arista's copyrighted works by merely setting forth the distribution allegation alone. Second, the court found that the discovery information sought by Arista was specific and reasonable. All of the information sought would reasonably facilitate Arista's efforts to serve process on the alleged offenders in order to bring suit against

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them. Third, there was clearly no alternative means to obtain the subpoenaed information. Finally, the Doe defendants had a minimal expectation of privacy and the need for disclosure outweighed their right to remain anonymous.

Fairview Dev. v. Aztex Custom Homebuilders (D.Ariz. 3/2/09)

Defendants were granted express license to use plans.

The court granted summary judgment in favor of Aztex, finding that Seidner initially owned the copyright of the architectural plans as the author. Regardless of whether Seidner granted an implied license by emailing Schmid the architectural plans, Seidner granted Aztex an express license by his May 10, 2005 letter. Fairview argued that Seidner believed that he was merely providing Schmid with a "transfer" letter that would satisfy the Town of Paradise Valley requirements for transferring a building permit application. However, Seidner testified that he viewed the letter as something more. As evidenced by the letter, Seidner's express language and willingness to work with Schmid in order to develop the custom home constituted an express license to use the plans through the completion of the project. Finally, Seidner did not rescind the license within a reasonable time.

Metal Morphosis, Inc. v. Acorn Media Publishing (N.D.Ga. 3/4/09)

Degree of inspiration was slight, but originality shown.

The court granted in part Acorn's motion to dismiss and for an award of attorney fees. Acorn argued that Metal did not have a valid copyright because its bird's nest pendant lacked originality. To be sure, Metal's creation struck one as a generic bird's nest. But in nature, nests could be deeper, wider, narrower, could be arranged neatly or in a less symmetrical fashion, and could have several, few, or no eggs. The layout of twigs used in Metal's pendant might have been rather obvious, but it was also somewhat unnatural. Atop the twigs were three eggs, two that were off white and one that was more lavender. Although the degree of inspiration was slight, it met the originality threshold. Therefore, Metal's original expression of a bird's nest was copyrightable. Because Metal had sufficiently alleged copying, Acorn's request for fees ancillary to the infringement claim had to be denied.

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Patent Cases

Daw Industries, Inc. v. Proteor Holdings, S.A. (S.D.Cal. 2/3/09)

Party did not waive patent invalidity claim in release.

The court denied Proteor's motion for partial summary judgment. Proteor contended that Daw's invalidity contentions and its antitrust counterclaim predicated on patent abuse were barred by release and waiver. However, throughout the agreement at issue, the parties referred to the prior litigation as involving a dispute over the exclusive distributorship contract between them and nothing more. Further, Daw did not begin producing the allegedly infringing product until May 2007, almost two years after the parties entered into the agreement and general release. Even if Daw had knowledge that the patent was invalid, it would not have had standing at the time to bring a claim challenging the validity of the patent. Thus, Daw had not released such a claim.

Revolution Eyewear, Inc. v. Aspex Eyewear, Inc. (Fed.Cir. 2/13/09)

Despite covenant not to sue, actual controversy existed.

After Revolution filed a covenant not to sue with its motion to dismiss, the trial court dismissed Revolution's claims and Aspex's counterclaims. Aspex appealed the dismissal of its counterclaims and the Federal Circuit reversed and remanded. Aspex argued that an actual controversy still existed because it did not intend to change its design and the covenant did not extend to future sales of products of the same structure. Aspex maintained that it had the right to make and sell the disputed eyewear products because the '913 patent was invalid or unenforceable. The planned activity was not speculative, as Aspex already had in storage a quantity of the product that it sold before and wished to sell again. Revolution offered no covenant on the current products and thereby preserved this controversy at a level of sufficient immediacy and reality to allow Aspex to pursue its counterclaims.

Meyer Intellectual Properties Ltd. v. Bodum, Inc. (N.D.Ill. 2/11/09)

No basis offered for raising good faith belief defense.

The court granted Meyer's motion for summary judgment on the issue of Bodum's liability for patent infringement. Meyer supplied ample evidence of active steps taken by Bodum to encourage direct infringement of Meyer's patents. Bodum argued that its good faith belief in the invalidity of Meyer's patents prevented Meyer from demonstrating a prima facie case of inducement and negated any liability on Bodum's part. However, Bodum had failed to provide proper support for its contention that it had such a good faith belief. Only inadmissible hearsay formed the purported predicate for the declaration of Perez, Bodum's current president. Even if Bodum had a good faith belief in the invalidity of Meyer's patents, that belief surely took form

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well before Perez began his transition. In short, Perez simply could not possess the requisite personal knowledge.

Honeywell Int'l., Inc. v. Acer America Corp. (E.D.Tex. 2/5/09)

Party entitled to discovery of extraterritorial activities.

The court granted Honeywell's motion to compel discovery from defendant Chunghwa Picture Tubes ("CPT"). Honeywell argued that it was entitled to discovery related to the products accused in its patent infringement contentions and all reasonably similar products. There was no bright-line rule that discovery was permanently limited to the goods specifically accused in a party's patent infringement contentions. Further, Honeywell had shown that the information it was seeking was not publicly available. In addition, Honeywell had shown that the products for which it sought discovery likely operated in a manner reasonably similar to the infringement theory contained in its patent infringement contentions. Finally, the court ruled that Honeywell was entitled to discovery regarding CPT's extraterritorial activities.

Nelson v. K2, Inc. (W.D.Wash. 2/5/09)

Use of surveys did not suggest experimentation.

The court granted K2's summary judgment motion, ultimately concluding that the '522 patent was invalid because Nelson sold skis made in accordance with its claims more than a year before the effective filing date of the patent application. The court rejected Nelson's assertion that the sales in question were primarily for the purpose of experimentation. In both transactions, the skis were conveyed to apparent strangers; there was no provision for Nelson's subsequent involvement in the assessment of the product. Thus, it could not reasonably be asserted that Nelson's use of the invention during the relevant timeframe was experimental. Nelson relied heavily on the fact that ski recipients were given a consumer questionnaire. But typical commercial sales activities, such as the inclusion of consumer surveys with the product, were insufficient to establish an experimental relationship.

Edmunds Holding Co. v. Autobyte, Inc. (D.Del. 2/20/09)

Controversy was merely speculative and one-sided.

The court granted Autobyte's motion to dismiss for lack of subject matter jurisdiction. EHC argued that Autobyte's public statements and pattern of litigation against sales leads companies, including EHC customers, manifested Autobyte's intent to enforce its rights against EHC and therefore, constituted facts sufficient to show the existence of an actual controversy between the parties. However, the court found that Autobyte's suits against sales leads companies and Autobyte's stated general intent to enforce its rights, without more, were not sufficient to demonstrate the existence of a real controversy between the parties. None of the facts adduced

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by EHC established that Autobyte believed that EHC was infringing the '517 patent. Even if never communicated to the alleged infringer, such belief was fundamental to the existence of a real controversy between the parties.

In re Certain Semiconductor Integrated Circuits (ITC 2/18/09)

No preclusive effect to vacated judgment of invalidity.

The ALJ previously denied respondents' motion for summary determination; the ITC reached the same conclusion, but modified the initial determination. Respondents argued that complainants were precluded from re-litigating the '335 patent since a judgment of invalidity had issued in a prior case. The court in that matter later vacated its judgment on request of the parties as part of a settlement agreement. The ITC found that the facts weighed in favor of not granting preclusive effect to the vacated judgment in the case at hand. Third-party Atmel Corp. entered into a settlement with complainant Agere Systems, Inc. in which it was granted a license to practice the '335 patent in exchange for significant consideration. Applying issue preclusion here would destroy the negotiated settlement reached by Atmel and Agere.

Baum Research and Dev. Co. v. Univ. of Mass. (W.D.Mich. 2/20/09)

Absence of instruction raised enablement issue.

The court granted in part and denied in part Baum's motion for summary judgment of infringement and invalidity of the '861 patent. University asserted that the specification of the '861 patent was insufficient to enable claim 1. The '861 patent contained no programming code or other instruction regarding how to coordinate the servo motors to ensure that the bat and ball were struck in the "sacred" impact position. This absence of instruction, coupled with the testimonial evidence, raised a legitimate question as to whether the '861 patent taught those skilled in the art how to make and use the full scope of the claimed invention without undue experimentation. In addition, Baum had failed to demonstrate the absence of a genuine factual issue regarding the best mode.

Activision Publishing v. Gibson Guitar Corp. (C.D.Cal. 2/26/09)

Guitar Hero controllers did not make "musical sounds."

The court denied Gibson's motion for reconsideration of the claim construction order and granted Activision's motion for summary judgment. No reasonable person of ordinary skill in the relevant arts would interpret the '405 patent as covering interactive video games. As Activision correctly observed, the claims on their face excluded instruments that only produced musical sounds by processing their instrument audio signals. Further, whatever constituted a "musical sound," it had to be more than what the accused infringing products could make. It was clear to any reasonable reader that the term "musical sounds" had a narrower meaning than that proposed

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by Gibson's expert. Musical sounds had to have more articulable characteristics than a button's clack or the thud produced from striking plastic. Summary judgment was also proper because the controllers sent only digital signals.

Monolithic Power Systems v. O2 Micro Int'l. Ltd. (Fed. Cir. 3/5/09)

No abuse of discretion in appointment of expert.

A jury found all asserted claims of O2's '722 patent obvious. Because the trial court did not abuse its discretion in appointing an expert and because there was no error in the trial court's denial of O2's motion for judgment as a matter of law on obviousness, the Federal Circuit affirmed. The Federal Circuit detected no denial or encumbrance of O2's jury demand or [7th Amendment](#) rights via the trial court's appointment of an independent expert. The Federal Circuit perceived no abuse of discretion in this case where the trial court was confronted by what it viewed as an unusually complex case and what appeared to be starkly conflicting expert testimony.

Nartron Corp. v. Schukra U.S.A., Inc. (Fed. Cir. 3/5/09)

Individual's contribution to invention was insignificant.

The trial court granted summary judgment of dismissal of Nartron's patent infringement complaint due to its failure to join an alleged co-inventor of the '748 patent as a plaintiff. Because Benson, the alleged co-inventor, provided only an insignificant contribution to the invention of claim 11 of the '748 patent by contributing an "extender," the Federal Circuit reversed the grant of summary judgment and remanded for further proceedings. The contribution of the extender was insignificant when measured against the full dimension of the invention of claim 11, not just because it was in the prior art, but because it was part of existing automobile seats. Therefore, including the extender as part of the claimed invention was merely the basic exercise of ordinary skill in the art. Accordingly, Benson's contribution did not make him a co-inventor of the subject matter of claim 11.

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Trademark Cases

Homes & Land Affiliates v. Home & Loans Mag. (M.D.Fla. 2/4/09)

Promotional efforts had strengthened weak marks.

The court granted in part and denied in part HLA's motion for partial summary judgment. HLA's promotional efforts had strengthened its otherwise weak marks and the incontestable status of HLA's marks provided weight to its argument that the marks were strong (with the exception of the "HomesandLand.com" mark). However, the evidence established widespread third-party use of the word "Homes" in real estate listing magazines and websites. Overall, the court did not find that HLA's marks were particularly strong. Though Magazine's addition of a stylized chimney, door, and roof in its mark created some dissimilarity between the marks, the overall impression created by the similarities weighed strongly in favor of a finding of a likelihood of confusion. The parties' goods and services were virtually identical and there was overlap in the parties' distribution outlets.

Heisman Trophy Trust v. Smack Apparel Co. (S.D.N.Y. 1/23/09)

Facts did not support nominative fair use defense.

The court granted Trust's motion for a preliminary injunction, noting that Trust's "Heisman" marks were strong. The presentation of the award received a large amount of media attention each year and the "Heisman" marks were licensed to a variety of companies for the purpose of promoting the award. Trust's marks and Smack's approximation of them were very similar. Smack used the same font as used by Trust's licensees and as appeared on Trust's website. The alterations that Smack had made to the word "Heisman" on its shirts did not sufficiently distinguish Smack's reference to "Heisman" from the mark itself. Smack's shirts were also in close competitive proximity to the "Heisman" candidacy shirts produced by licensee Reebok International Ltd. Finally, it was likely that Trust would succeed in proving that Smack could not invoke the nominative fair use defense.

Scentsy, Inc. v. Performance Manufacturing, Inc. (D.Idaho 2/9/09)

Likelihood of success shown as to trade dress claim.

The court granted Scentsy's motion for a preliminary injunction and granted in part and denied in part defendants' motion to dismiss. As to Scentsy's motion for a preliminary injunction, Scentsy had demonstrated a likelihood of success on the merits of its trade dress infringement claim. The products at issue were strikingly similar in color, shape, size, and texture. Scentsy's warmers and fragrance bars appeared to carry identifying features and PMI's decision to market products with the same identifying features was telling in terms of the secondary meaning element. There were many other possible colors, designs, sizes, and packaging options from which PMI could

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choose. By selling products with little or no difference to Scentsy's products, PMI arguably sought to benefit from the source identifying features of Scentsy's products.

DeVry, Inc. v. U. of Medicine and Health Sciences (N.D.Ill. 2/3/09)

Fact issues existed as to defendant's fair use defense.

The court denied University's motion to dismiss the complaint for failure to state a claim. Contrary to University's arguments, its fair use defense was not the type of impenetrable defense that could defeat a complaint at the motion to dismiss stage. While University argued that its use of the phrase "Founded by Dr. Robert Ross" on its stationary and its campus entrance sign was descriptive, whether a specific use was other than as a mark was a fact specific determination that the court was not prepared to make at this early stage. University also argued that the statements contained in its brochure and in correspondence that Dr. Robert Ross was the founder and former owner of Ross University School of Medicine were not trademark or service mark uses, but were instead nominative fair uses. Again, fact issues existed that would need to be addressed at a later time.

In re Jibjab Media, Inc. (TTAB not citable 2/4/09)

Mark would be viewed as scandalous by general public.

Jibjab filed an application to register the "A-Hole Patrol" mark for an online social club that screened jokes submitted by users to control offensive and inappropriate content. The examining attorney refused registration on the ground that the mark consisted of or comprised immoral or scandalous matter; the Board affirmed the refusal to register. The Board rejected Jibjab's contention that "A-Hole" was a sanitized substitute for the more common term (omitted due to email scanning concerns). The meaning of this more common term was vulgar and would be seen as scandalous to a substantial composite of the general population. While "A-Hole" was a less vulgar term, the evidence was insufficient to support a finding that "A-Hole" itself was a non-vulgar term. Accordingly, this term would be viewed as scandalous.

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Domain Name Cases

Dakota Alert, Inc. v. WinterHaven, Inc. (NAF 1/21/09)

Even if not authorized reseller, party's use was bona fide.

Dakota made no allegations that consumers could not in fact purchase legitimate "Dakota Alert" products at the disputed domain name. It appeared to the panel that WHI was reselling genuine "Dakota Alert" products. It was a hotly contested issue as to whether WHI was an authorized reseller of Dakota's products, but the panel found it unnecessary to reach a conclusion on this question. WHI was not holding itself out as being Dakota and was not representing itself in a way that would lead consumers to believe that they were purchasing products directly from Dakota. There was no evidence that WHI had engaged in any bait-and-switch. In addition, after receiving Dakota's cease and desist letter, WHI placed a disclaimer on its website, which clearly indicated that it was not a part of Dakota. This was indicative of a bona fide offering of goods or services.

California Farm Bureau Federation v. Sokol (NAF 2/2/09)

Party had been commonly known by domain name.

The facts showed that in the 1980s, Sokol's client, Gibbons, had operated a store under the name "The California Country Furniture Store." Gibbons was, at some point, commonly known by the disputed domain name, even though this use may have subsequently ceased. However, Gibbons' use of the name to describe his decorating style had been maintained. Declarations from three of Gibbons' clients made clear that Gibbons had consistently referred to his style of decorating as "California Country" since 1984. There were also magazine articles that supported this contention. At some stage, Gibbons did have the intention of using the domain name with his interior design business. Thus, Gibbons had provided sufficient evidence to show that he had made demonstrable preparations to use the domain name in connection with a bona fide offering.

IVECO S.p.A. v. Zeppelin Trading Co. Ltd. (WIPO 2/3/09)

Domain name accurately described party's business.

The dispute between the parties focused on Zeppelin's status as an unauthorized or unofficial dealer in Iveco's products. Iveco appeared to contend that the lack of authorization by it was fatal to Zeppelin's bona fides. It was clear that Zeppelin was offering genuine Iveco brand parts in connection with the disputed domain name. Further, Zeppelin's website clearly stated that it was an independent dealer in genuine Iveco products. Iveco's suggestion that Zeppelin did not "need" the domain name was, in the panel's view, unduly restrictive and unrealistic. On the evidence before the panel, the subject domain name accurately described the business operated

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by Zeppelin. Therefore, the panel concluded that Zeppelin had demonstrated that it had rights or legitimate interests in the disputed domain name.

Volvo Trademark Holding AB v. White (WIPO 2/10/09)

Site did not suggest association with complainant.

VTH contended that White was nothing more than an unauthorized reseller of "Volvo" spare parts. However, White's website did not misrepresent any association with VTH. Instead, the site represented nothing other than what appeared to be true: that White offered for sale parts for "Volvo" vehicles. On balance, the site did not have an appearance suggesting that it was likely to be mistaken for an official or authorized site of VTH. It was most unlikely that anyone would have been misled by the site even before the disclaimer was added. While VTH asserted that the site was using copyrighted photos of "Volvo" vehicles, it would seem wholly out of proportion to strip White of a domain name, that he had apparently been using for more than ten years without objection from VTH, on the basis of alleged copyright infringement on one page of the site.

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Trademark Paralegal

Trademark paralegal with 17 years of experience. I can assist you with USPTO filings and with creation and upkeep of your docket. I have worked in firms in Denver but currently would prefer to work on a contract basis. References available. Call Jennifer Rothschild at 303-850-9297. (expires 06/09)

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