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Starbucks May Owe Mexico for Coffee Cup Images

Until recently, Starbucks was selling coffee mugs depicting pre-Hispanic images, including the Aztec calendar stone and the Pyramid of the Moon located in Teotihuacan. However, the coffee chain has removed the mugs from store shelves pending discussions with the Mexican government. According to Mexico, the country is owed intellectual property

Reissue Improper When Amendment Only Adds Narrower Claims

The Board of Patent Appeals and Interferences (BPAI) recently decided that the presentation of a narrower claim in a reissue application still containing all of the original patent claims is not correctible under 35 U.S.C. § 251. The decision was based on Ex Parte Tanaka, where an applicant filed a reissue application that included the addition of a single dependent claim. The examiner reviewing the application reasoned that Tanaka's reissue application did not satisfy § 251 because the patentee could not allege that the patent was wholly or partly inoperative or invalid as a result of the patentee claiming more or less than he had the right to claim. The BPAI affirmed stating "...the original claims, which are drafted using the open-ended 'comprising' language, would cover the invention as now presented in claim 16. It is only if the Appellant were to assert that claim 1 is overly broad or otherwise inoperative or invalid that the original claims may not fully cover the invention now presented in reissue claim 16." See details [here](#).

Your Patent May Be Worth More Than You Realize

Patent term adjustments (PTA) scored big when the U.S. Court of Appeals for the Federal Circuit labeled the USPTO's [35 U.S.C. § 154](#) interpretation as counter-statutory. Under § 154, a patent term concludes twenty years from the application date unless a PTA guarantee applies. Since 2004, the USPTO has construed § 154's clauses A and B (the "conflicting" guarantees) into a greater-of-A-or-B rubric.

rights for the mugs depicting the pre-Hispanic images, and the government archaeological agency will decide whether Starbucks owes any fees. Conversely, Starbucks believes it made a good faith effort to offer payment and obtain permits.

[More.](#)

Wikipedia Citations in Patents Increases

Back in 2006, Business week published an article titled "Kicking Wiki Out of the Patent Office." According to the article, the USPTO had removed Wikipedia from the list of accepted sources examiners could use to determine a patent's validity. Removal of the website was based on the fact that the information provided by the website could be altered by anyone. However, recent statistics indicate that examiners and applicants continue to cite the website. According to Patent Librarian Michael White, 809 U.S. patent applications issued in 2009 had at least one reference to a

In [Wyeth v. Kappos](#) (Fed. Cir. 2009), the Court discarded this rubric for an A-and-B-less-overlap formula by giving plain and ordinary meaning to the terms "overlap" and "period of delay." Under the Court's formula, Wyeth received around an additional 8 months on their patent terms. Current applications should receive term extensions based on the Court's formula. However, because recently issued patents may have fallen under the shortened rubric, patent attorney consultation is highly recommended regarding the length of your patent term - your patent may be worth more than you realize.

Florida judges, lawyers must 'unfriend' on Facebook

Florida's judges and lawyers should no longer "friend" each other on Facebook, the popular social networking site, according to a ruling from the state's Judicial Ethics Advisory Committee. At least one South Florida judge warned her pals with a Facebook status update that they could be "unfriended," and the ruling has prompted others to do the same. The committee ruled Nov. 17 that online "friendships" could create the impression that lawyers are in a special position to influence their judge friends. [See story.](#)

Microsoft petitions CAFC to Rehear i4i Case

On January 8, 2010, three days before an injunction affecting Microsoft 2007 was to become effective, Microsoft filed a petition asking the Court of Appeals for a panel rehearing and a rehearing en banc. The petition is in response to a three judge panel's decision to uphold a \$290 million damages award against Microsoft for violating i4i LP's document formatting patent. The patent in question, U.S. Patent No. 5,787,449, is directed toward an improved method for editing documents containing markup languages like XML, and since 2003, Microsoft Word has included XML editing capabilities. The Court of Appeals gave Microsoft until January 11, 2010 to comply with a permanent injunction requiring the company to remove

Wikipedia article. This represents a 59% increase from 2008. However, as pointed out by Patently-O, the 809 patents issued with Wikipedia references make up only 0.5% of all patents issued in 2009. See details [here](#).

the claimed technology from Microsoft Word 2007. In its petition, Microsoft argues that the December 22, 2009 decision conflicts with precedents governing trial procedure and the determination of damages. Click [here](#) for more.

Bankruptcy and IP Licensing:

Bankruptcy affects both licensors and licensees regardless of which label a company receives from a licensing contract. Understanding your options (such as a debtor/licensor choosing to retain licensing rights or a debtor/licensee assuming a contract) under the Bankruptcy Code leads to successful IP management. Further, the Bankruptcy code treats specific IP categories differently. For instance, although [11 U.S.C. § 365\(n\)](#) governs "executory contracts under which the debtor is the licensor of a right to intellectual property," the Bankruptcy Code's definition of "intellectual property" omits trademarks, service marks, and trade dress. (see [11 U.S.C. § 101\(35A\)](#)). Preventive measures that secure your investments in intangible assets before your contractors go bankrupt may help your company avoid a loss. Creative contract drafting (e.g. turning a technology license into a contract for services using that technology) and perfecting your security interests in those contracts are among the active IP practices that could prevent an asset loss.

New Developments from ICANN Regarding Global Top-Level Domain Registration

Businesses with marks to protect should be monitoring recent developments by the Internet Corporation for Assigned Names and Numbers (ICANN) regarding domain name registration. Specifically, ICANN has been moving forward with steps that could allow virtually any new top-level domain name to be made available for registration. As a result of the eventual opening of additional domain namespaces, businesses need to be aware of the coming potential for trademark issues, including infringement, domain squatting, and competitor registration of generic terms.

While not yet complete, ICANN released model rules for top-level domain name registration for comment in December. On December 18th, ICANN published a [draft model](#) for expressions of interest and pre-registration of new generic top-level domains. Among other requirements, the proposed model requires entities to deposit \$55,000 U.S. per domain to be eligible for registration in the first round. Additionally, ICANN released recommendations from the Special Trademark Issues (STI) team that present an alternate rights protection model to that previously proposed. ICANN is accepting input on the draft model until January 27th, 2010 and on the STI [recommendations](#) until January 26th, 2010.

For advice regarding the proposed rules or if interested in making comments to ICANN, please

contact us for more information.

Another Big Win for RFG and the Leading Lady Defendants

On November 16, 2009, the Supreme Court denied the Petition for a Writ of Certiorari that was filed by Plaintiffs Line Rothman and Glamourmom LLC (Sup. Ct. Case No. 09-304), and moreover upheld the jury verdict and the Federal Circuit's ruling in favor of Defendants. See *Rothman v. Target Corp.*, 556 F.3d 1310 (2009). In 2007, RFG successfully represented Defendants Leading Lady Companies, et al. at trial, where a jury found that the claims of U.S. Patent No. 6,855,029 (for a nursing garment with invisible breast support for nursing mothers) were invalid due to obviousness and anticipation and that Plaintiffs committed inequitable conduct in their dealings with the USPTO in obtaining the '029 patent. The jury also found that Defendant Motherswear Int., who was represented in-part by RFG, did not infringe the asserted claims of the '029 patent. On appeal in 2008-2009, RFG again successfully represented the Leading Lady Defendants where the Federal Circuit upheld the jury verdict on invalidity and non-infringement.

RFG Firm News

Sr. Trademark Attorney John Beard has joined Rader, Fishman & Grauer. Mr. Beard, who was a partner leading the Global Brand Management practice at Faegre & Benson in Minneapolis, will relocate to join our Washington DC office. John Beard is a great addition to our trademark team and will result in a significant contribution to the team's capabilities. See John's biography [here](#).

RFG Associate Brian Dutton served as a panelist at the USPTO BPAI Ex Parte Appeals Rules Roundtable on January 20, 2010. See the presentation slides [here](#).

The 2010 West Michigan Corporate IP Roundtable event will be held at Western Michigan University in Kalamazoo, MI on Friday, March 6th. Click [here](#) to see the invitation. Please contact iproundtable@raderfishman.com with questions.

University of Michigan spin-off HandyLab, Inc., was purchased by Becton Dickinson for \$275 million. Located in Ann Arbor, HandyLab makes molecular diagnostic systems for clinical sample preparation, nucleic acid extraction, microfluidic real-time PCR amplification and detection. Rader Fishman & Grauer assisted HandyLab in connection with certain IP aspects of the transaction. [See details](#).

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