

IPLS PROCEEDINGS

STATE BAR OF MICHIGAN

2008 Intellectual Property Spring Seminar

By Denise M. Glassmeyer

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The 2008 Spring Seminar promises to provide attendees with a practical one-day tune-up no matter where your particular area of interest in IP law lies. The 2008 Spring Seminar will be held on March 17, from 9:00 a.m. - 4:00 p.m at the Kellogg Center in East Lansing, Michigan .

This year's seminar is under the moderation of IPLS council member David Wisz. The IPLS council has planned a seminar that will bring in speakers from the United States Patent and Trademark Office on a variety of timely topics, such as available updates on patent rule changes and *KSR* compliance standards in patent examination at the USPTO, as well as updates on TTAB rules and discovery under the new trademark rules. The morning sessions also feature speakers on the 10 most common mistakes encountered in filing and prosecuting patents and the 10 most common mistakes at the TTAB.

We will also be examining IP practice in the Pacific Rim with Tom Moga of Butzel Long and the preparation of opinions of council after the *Seagate* decision with Mike Brennan of Harness, Dickey, and Pierce. After lunch (included in the seminar), the afternoon session will feature a roundtable discussion on IP litigation in Michigan state courts with retired Court of Appeals Judge and former Circuit Court Judge Jessica Cooper along with practitioners Todd Mendel of Barris Sott Denn & Driker PLLC, Detroit, and Steven Susser of Young & Susser PC, Southfield.

Kevin Gasiewski of Brooks Kushman PC, Southfield, will address the topic, "What Every Patent Lawyer Needs to Know to Avoid Malpractice in the Trademark Area." The mid-afternoon sessions include "PTO Rule-Making from a Practitioner's Perspective," presented by Stephan Kunin of Oblon Spivak, and "Trade Secrets in the Digital Age," presented by R. Mark Halligan of Lovells LLP, Chicago, IL.

The final sessions for the 2008 Spring Seminar will be offered by Damian Porcari of Ford Global Technologies, addressing "Enforcement of Design Patents on Auto Parts before the ITC," and by Carol A. Romej of Butzel Long, Bloomfield Hills, who will discuss electronic discovery and how to conduct discovery to get the information needed.

The seminar is being organized and coordinated by the Institute for Continuing Legal Education. Those interested in registering can find information on the forms already mailed to them or by going to the ICLE website at www.ICLE.org.

Denise M. Glassmeyer is a shareholder with the law firm Young Basile P.C., in Troy, Michigan. Ms. Glassmeyer's practice focuses on patent prosecution with special emphasis on domestic and foreign patent prosecution in chemical, mechanical arts, materials applications, and IP portfolio development.

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State Bar of Michigan

Meeting with the Japanese Patent Office Members

By Kevin MacKenzie

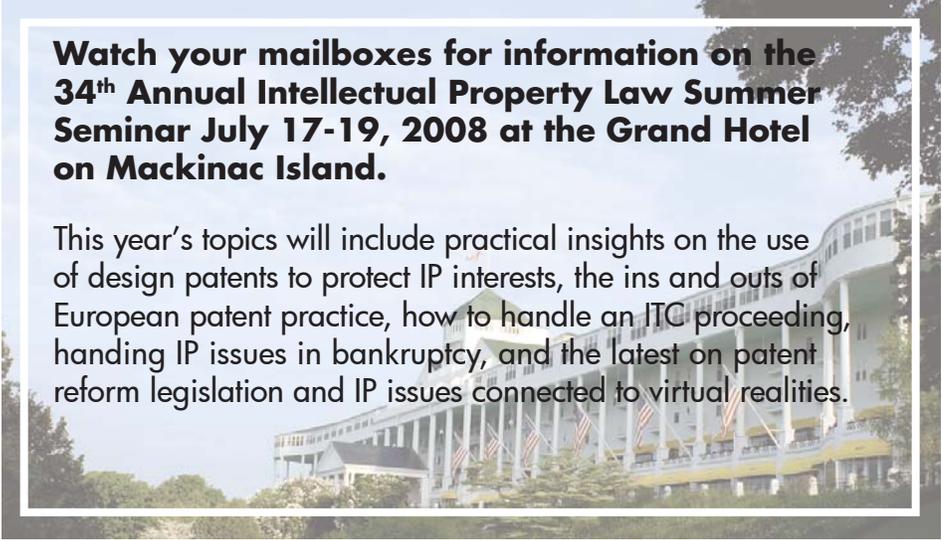
As a member of the IPL Section of the State Bar, I represented the State Bar at a meeting of representatives of various U.S. bars and members of the Japanese Patent Office at the U.S./JPO Liaison meeting in Washington, D.C. Various topics of interest to both the U.S. and Japanese Patent Offices and practitioners were discussed. One topic of interest that was discussed was PCT supplemental searches (SIS). The PCT assembly approved the introduction of a new system of supplementary international searches that allows applicants the option to request, in addition to a main international search, one or more supplementary searches that may be carried out by the various international authorities other than the ISA, which carries out the main international search. The system is intended to allow for a more complete overview of the prior art in the international phase and in particular, to include documents in languages that may not be searched effectively by the ISA. The various ISAs are free to decide whether to provide a supplementary search service and to regulate under what conditions the searches may be performed. The amendments to the PCT regulations that establish the supplementary international search system will enter into force on January 1, 2009. The supplementary international searches will not only apply to applications filed after that date, but also to pending applications which would still be practical with regard to the time limits involved. Japan has indicated they will not perform SIS searches, as they believe the primary searching authority is in the best position to conduct a search. Additionally, the Japanese representatives believe that its obligation to perform searches and conduct an examination for which it is the ISA is the primary task of the Japanese Patent Office and should take priority over supplementary searches which may never be examined in Japan.

Additionally, the Japanese representatives of the JPO discussed changes to the patent rules in Japan. Relevant changes include the provision that after a rejection is received, one cannot change the claims to change the subject matter to a different invention with different technical features. Additionally, Japan has adopted a new divisional procedure allowing filing of divisional applications within 30 days of a decision to grant a patent or a decision of refusal. Further, the revision of the Japanese Patent Act changed the time limit for submitting Japanese translation documents. The new time limit to submit a Japanese translation of an application filed in the English language has been changed to one year and two months from the filing date. The filing date includes the time from the priority date for an application filed with a priority claim.

Also discussed was a common application format with respect to the filing of patent applications within the trilateral offices. Various section titles and the presentation order were discussed based on results obtained from working groups in both Washington, D.C. and Tokyo. The section titles may include similar titles and orders as in the commonly used PCT format. Additionally, the Japanese delegation has proposed a common citation list format for documenting patent literature, as well as non-patent literature. A common formatted Information Disclosure Statement would provide efficiencies when filing in multiple offices and would allow the various offices to process similar documents. The various parties felt that it would

be likely that a common application format would be available in the near future and would likely be approved by the trilateral offices.

Also of interest to practitioners in both offices was a discussion concerning the status of the Patent Prosecution Highway. The Patent Prosecution Highway may be used when an application is prosecuted in a first office and results in allowed claims. One may request a Patent Prosecution Highway examination and provide prosecution history documents of the first office to the second office. The claims must sufficiently correspond to the allowed claims in the first office and will result in an accelerated examination that will include an additional search and examination by the second office. The Japanese representatives of the Patent Office provided various metrics of the Patent Prosecution Highway between the Japanese and U.S. Patent Offices and indicated a period from the request from a patent prosecution history examination to a first office action was approximately two to three months in both the Japanese and U.S. Patent Offices. The pilot project of the Patent Prosecution Highway is set to expire on January 3, 2008, after which time it will be determined how to fully implement the program. Practitioners wishing to accelerate examination in both the U.S. and Japan when having a prior examination and allowance in either of the countries may wish to request examination under the Patent Prosecution Highway. ?



Watch your mailboxes for information on the 34th Annual Intellectual Property Law Summer Seminar July 17-19, 2008 at the Grand Hotel on Mackinac Island.

This year's topics will include practical insights on the use of design patents to protect IP interests, the ins and outs of European patent practice, how to handle an ITC proceeding, handling IP issues in bankruptcy, and the latest on patent reform legislation and IP issues connected to virtual realities.

Submissions to IPLS Section

Articles of interest to the membership are actively solicited for publication on the IPLS website. If you have recently researched a topic of interest to our membership, please consider a submission.

Submission deadlines:

- April 15, 2008 for the May 2008 issue
- August 10, 2008 for the September 2008 issue

Submissions should be sent to:

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Where do we get our information?

The Internet has opened up a world of opportunity to locate just about any type of information you can imagine. A couple of links you may find interesting and helpful to your practice are:

- <http://www.state.gov/ml/a/ips> - Freedom of Information Act (FOIA): All agencies of the U.S. Government are required to disclose records upon receiving a written request, except those records that are protected from disclosure pursuant to nine exemptions and three exclusions.
- http://www.sensorypublishing.com/bills_pending.html - Bills pending in Congress that relate to patent, trademark, and copyright laws.

Section Calendar

March 17, 2008

IPLS Meeting and Spring Seminar
Kellogg Center, East Lansing

April 10, 2008

Council Meeting at 9:30 a.m.*

May 8, 2008

Council Meeting at 9:30 a.m.*

June 12, 2008

Council Meeting at 9:30 a.m.*

July 17-19, 2008

33rd Annual Intellectual Property Law Summer Institute
Grand Hotel, Mackinac Island
registration and event details at www.icle.org

July 19, 2008

Annual Meeting,
including election of council members and officers, 8 a.m.
Grand Hotel, Mackinac Island

* Contact a council member for the meeting location.

View from the Chair

By Laura Slenzak

My view from the chair is solemn. In the space of two weeks, two of my dear lawyer friends died. One was Kim Cahill. Kim had a small law practice together with her mother and younger sister. You may recall that Kim was president of the State Bar of Michigan last year. She was president of the Women Lawyers Association of Michigan the year before me. She served in the State Bar Representative Assembly, the Macomb County Bar Association, and so many other civic and community organizations that you might wonder how—and why—she did it. I would turn that question around: Why don't more of us do the same?

Another friend who died was Al Cawley. Al and I attended night law school together, and like most of our classmates, it was a change of career. Unlike me, however, Al had already had several careers. He led his company in the Tet Offensive in Vietnam. He owned his own business. And then he went to law school. Al might not have had the public name recognition that Kim had, but anyone who knew Al knew that Al, too, was always giving of his time and talent to those around him. He even gave his liver to someone, and lived another eight years!

Both Kim and Al were great role models, and both left their own indelible mark on me and this world. You can, too, through serving others.

Maybe you tell yourself you are too busy to volunteer your time and talents to school boards, sports coaching, men-

toring young adults through programs like Big Brothers/Sisters and Youth Assistance, your local school or church youth group or club, a domestic violence shelter, or a senior center. There are so many choices and so much need. Maybe you tell yourself that you surely can't provide pro bono legal services because you are "only a patent attorney."

The current scandal over the City of Detroit police firing/text-messaging settlement brings shame to the entire legal profession. I don't care where you are on the political spectrum, the fact that it is a handful of lawyers (the mayor, the prosecutors, the defense counsel, the list goes on and on) mired in this scandal merely provides fodder for those who choose to paint all lawyers with the same tarring brush. Please, every chance you get, do what you can to help improve the public image of our profession. You never know what will end up being your indelible mark on the world. I think we'd all prefer to have it be the things that Kim and Al gave to us. 

Laura M. Slenzak is senior intellectual property counsel with Siemens, in Auburn Hills, Michigan. Ms. Slenzak's practice focuses on technology portfolio strategy and litigation management for Siemens' Automotive, Transportation and Building Systems operating companies. Ms. Slenzak is the 2007-2008 chair of the Intellectual Property Law Section of the State Bar of Michigan.

Newly Redesigned SBM e-Journal Allows Readers to Directly Access Practice Area Summaries

The State Bar of Michigan free daily online publication, *e-Journal*, has been newly redesigned with enhanced features. Readers can now directly access the opinions and practice area summaries they are interested in without sorting through the entire edition.

This new customization feature will make reading faster and easier. Current subscribers should choose the "Manage Your Subscription" link in the upper right-hand corner of the *e-Journal* to make their practice area selections.

The *e-Journal*, sent daily to more than 16,000 subscribers, is one of the most popular services provided by the State

Bar. It summarizes all opinions as they are released from the Michigan Supreme Court, Michigan Court of Appeals (published and unpublished), the U.S. Sixth Circuit Court of Appeals (published), and selected U.S. District Courts.

Apart from case summaries, the publication also contains legal news and updates, public policy, classifieds, calendar of events, and fields of practice listings. To sign up for the *e-Journal*, please visit www.michbar.org/publications/signup.cfm.

A Plea for Local Rules in Patent Cases

By William G. Abbatt and Robert C.J. Tuttle¹

Few aspects of enforcing patent rights are perfect. But opportunities exist for changing the picture. By adopting local rules in patent cases, there is an opportunity to (1) decrease transactional costs associated with patent enforcement, and (2) reduce uncertainty in the rights of the patent holder and the public, while providing an easier route for resolving challenges to the validity of improperly issued patents. One factor leading to increased costs of patent² litigation was reported to be discovery abuse by overzealous and unrestrained lawyers. Not much has changed since the Advisory Commission on Patent Law Reform presented its Report to the Secretary of Commerce in August 1992. Adoption of strict controls over discovery was suggested as “the most dramatic single step that could be taken to reduce litigation costs.” *Id.*

Some of the factors that lead to cost increases and delay have been reported to include:

- suboptimal control over discovery, and reluctance to impose sanctions, enter protective orders, and hold substantive conferences at an early stage; and
- reluctance to schedule early, firm trial dates and promptly decide motions and render opinions.³

Accordingly, we recommend that Michigan federal district courts consider adopting local rules or require that case management orders be used in patent cases.⁴

Background

Several federal district courts have formally adopted specialized local rules governing the conduct of patent litigation in that district. They include the Northern and Eastern Districts of California, Eastern and Northern Texas, Northern Georgia and Western Pennsylvania.⁵ Apparently, these districts appreciate that patent cases are often quite complex and deserve special procedures to encourage the just, cost-effective, yet prompt resolution of such matters. If adopted, such local patent rules might offer more certainty concerning scheduling and the way in which patent cases will be invigilated.

Features of Local Rules

Some of the features of local patent rules that have been adopted elsewhere and used by various judges around the country include:

- A procedure requiring the initial production of documents and other evidence by all parties relating to the *validity* of the patent(s) at issue.

- A procedure for the initial production of documents and other evidence (including ediscovery exchanges) by the defendant/accused infringer bearing on *infringement*, e.g., technical information relating to the composition, structure, and/or *modus operandi* of the products or methods that stand accused. In a typical case, this might include documents and other evidence touching on methods of achieving a given result, such as steps used in the implementation of software on a computer for the making of a product.
- A timetable laying out when the parties must assert their respective *positions* concerning the product(s) or method(s) accused of infringement and invalidity contentions. More comments on this feature appear below.
- Procedures for *construing the claims* asserted in the patents at issue, including a predetermined briefing schedule.

Default Protective Order

To ensure that a party’s confidential information is protected, the local rules could include a default protective order. One benefit is that such a rule may tend to reduce the costs associated with litigation because it avoids what may be an excessive amount of time otherwise spent on negotiation sometimes seen in patent litigation, to draft a protective order in which all parties concur. If one or more parties do not negotiate in good faith, they may use this time to slow the pace and escalate the costs of litigation.

Timetable for Infringement Contentions

The Federal Rules of Civil Procedure call for a reasonable investigation to be made by a plaintiff before he files a patent infringement lawsuit. But there is no requirement that all accused products or methods be analyzed in detail before bringing suit. Depending on the technology, such a pre-filing investigation might be cost-prohibitive and deny access to the court by individual or small-entity patent owners that may have scarce means.

There should arguably be no requirement in the local rules for patent cases that plaintiff state its contentions concerning accused methods or products until plaintiff has had a chance to review the defendant’s confidential technical information or product specifications or product. Such

Continued on next page

information may not be publicly available and may solely lie in defendant's custody. Thus, both parties can be afforded the same access to information before forming difficult-to-reverse legal positions in a particular case.

Chart Format for Disputed Claim Terms

The local rules could mandate a format for the identification of all claim terms that the parties believe must be construed by the court to adjudicate the dispute. A model chart for example, might require the parties to list the terms at issue, their respective proposed construction of those terms, and the intrinsic evidence supporting the proposed interpretations. A related rule might mandate that the chart not contain any legal argument.

Discovery of Experts

Proposed local patent rules might include a timetable that specifies when expert witness disclosures are to be made and when the depositions of experts should occur. It may be appropriate to specify those dates based on when the court rules on claim construction. This may then avoid circumstances in which an expert report might require change based on an unexpected claim construction ruling. This would save the parties time and expense by avoiding the need to submit further expert reports and to take more depositions.

Scheduling Order Template

The proposed local patent rules might provide in an Appendix a model scheduling order that incorporates all the timetables specified elsewhere in the local rules. Such an order would provide for greater certainty in case management. The bench and bar would then know when certain events

will occur, including trial. Such an order might also have the beneficial effect of reducing or avoiding disputes between the parties over a form of the order, thereby avoiding additional costs and unnecessary delay.

Experience in other jurisdictions has shown that these among other topics have presented improvement in that they have tended to reduce the cost of patent litigation and promoted a quicker resolution of the dispute.



Endnotes

- 1 Bill Abbatt and Bob Tuttle are Shareholders in Brooks Kushman P.C., Southfield, MI. 2 The Advisory Commission on Patent Law Reform, p. 79 (August 1992).
- 3 Myrick, *Overview of Considerations and Approaches to Delay Reduction and Cost Control in Intellectual Property Litigation*, presented to the ABA/PCT Law Section Annual Spring Educational Program, "Patent, Trademark, and Copyright Law: Litigation and Corporate Practice," 1991.
- 4 The views expressed herein recently have been forwarded to the Local Rules Advisory Committee of the U.S.D.C. (E.D. Mich.)
- 5 Pricewaterhouse Coopers recently studied damages awards in patent and trademark cases. The survey considered 25 cases filed in the Federal District Court for the Eastern District of Michigan that were decided between 1996-2006. Seventeen were decided on summary judgment, and 8 were tried. Plaintiff won 3 times, and lost 22 times. Thus, plaintiff won thrice in 25 tries (12%). How these cases fared on appeal was not reported. Concluding that the lowest win rate nationwide for plaintiffs occurred in the Eastern District of Michigan, the study noted that the Western District of Wisconsin was the most favorably disposed to plaintiffs, with a win rate of 63% overall. The survey observed that "carefully choosing the right . . . venue . . . has never been more important to achieving success in IP litigation." A copy of the report can be obtained from kathryn.oliver@us.pwc.com.



Back copies of *IPLS Proceedings*
can be found at
<http://www.michbar.org/ip/archive.cfm>

Computer Geek Tips and Tricks

By Charles A. Bieneman

Contrary to popular belief, the term “macro” refers to something entirely unrelated to my expected girth following the holidays. In fact, in the world of Microsoft Office products (Word, Excel, etc.), a “macro” is a handy feature that allows you to create shortcuts for multi-step tasks that you perform repetitively. For example, you may have a sentence, a phrase, a case name, etc., that you type over and over again. Select the macro, e.g., by a simple key stroke that you have chosen, and Microsoft Office will automatically execute your pre-defined tasks, such as typing a phrase. As intellectual property lawyers, we all have many tasks we perform over and over again—especially in Microsoft Word—making macros a handy tool indeed.

Many software applications are integrated with Microsoft Office products (such as Word) to make use of macros. If you’re a patent attorney, you spend a lot of time reading content generated by macros, because all of the form paragraphs from the MPEP that examiners love to include (whether they make contextual sense or not) are generated from Word macros. And many practitioners, whether they know it or not, use applications that use macros to generate templates and forms for filing patent applications, Office Action responses, and the like. However, using pre-packaged template generators, copying old documents, etc., can only take you so far.

If you are like me, you have a lot of standard language that you include in patent applications, Office Action responses, and other kinds of documents—like agreements—that can quite usefully be stored and retrieved via macros. Have standard language you use when making an amendment you consider to be purely formal? Include it in a macro, and then include it in your Office Action response at the press of a button. Have several standard warranty provisions that you like to include in license agreements, depending on the situation? Include them in a macro, and then pick and choose which provisions to include in an agreement at the press of a button. You get the idea. On my desk I have a list of keystrokes corresponding to macros I have created and use frequently, drastically reducing my time to create several types of documents.

Here’s how to create a macro in Microsoft Word 2003 (I, along with most of you, haven’t yet used Office 2007). Go to the “Tools” menu, select “Macro,” and then select “Record

New Macro” from the sub-menu that pops up. A dialog box entitled “Record New Macro” should appear. This dialog allows you to name your macro (e.g., “warranty_best_efforts”), choose a place to store it (I generally accept the default), and assign keyboard or toolbar shortcuts that you can later use to access your macro. I usually select a keyboard shortcut, generally in combination with the ALT key. If you click on the “Keyboard” icon, the “Customize Keyboard” dialog box will appear. Note that if you select a key sequence that is in use (e.g., CTRL-P), the dialog box will inform you (e.g., that CTRL-P is already assigned to the “Print” function). Needless to say, it is probably a bad idea to override any key sequences included in Word by default.

Once you close the “Customize Keyboard” dialog box, you may begin recording your macro. That is, perform in Word whatever tasks you wish to preserve as your macro, e.g., entering text, formatting, etc. When finished, click the

“Stop” button (the small square) on the macro toolbar that will have popped up. You can also pause recording of the macro if you like.

When you create a macro, Microsoft Office is creating source code behind the scenes. The lay user can simply ignore this code, although it may be of interest to note that Microsoft Office products have taken a lot of flak over the years because they include features conducive to hackers wishing to spread computer viruses and other nasty programs. These features can be quite useful, but even many technically sophisticated users don’t think to use them. Macros—little programs that run within Microsoft Office applications—are a good example of such a feature. They’re there, and they’re here to stay, so you might as well use them.

One more bonus tip—Microsoft has a list of keyboard shortcuts built into Windows at <http://support.microsoft.com/kb/126449>. This is a handy reference, even if some of these shortcuts will be familiar to you. ?

As intellectual property lawyers, we all have many tasks we perform over and over again—especially in Microsoft Word—making macros a handy tool indeed.

Charles A. Bieneman is a partner with Rader, Fishman & Grauer PLLC in Bloomfield Hills, Michigan. Mr. Bieneman’s practice focuses on protecting and licensing intellectual property related to computer software. Mr. Bieneman can be reached at (248)594-0648 or cab@raderfishman.com.



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