

Legal Updates & News

Bulletins

Intellectual Property Quarterly Newsletter

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Note from the Editors

In this issue of Morrison & Foerster's Intellectual Property Quarterly Newsletter, we focus on important issues related to innovation by "clean and green-tech" companies. We discuss what clean and green-tech companies can do to protect their technology, and how they can use their IP to attract and maximize investment dollars. A companion article discusses rapid advances in biofuels and strategies for protecting biofuel feedstock inventions.

We also address two interesting legal issues that arise in a world where innovation occurs rapidly and where information is often disseminated via the internet. We discuss some benefits of pursuing "utility model" protection rather than patent protection, and we analyze a recent Federal Circuit decision that assessed whether a paper posted on an FTP server constitutes a "printed publication" for prior art purposes.

We also provide our recurring features, the eBay Scorecard and news and Notes on Patent Reexaminations. In the Reexamination article, we examine two recent Federal Circuit decisions that address contradictory validity determinations by a district court and the PTO.

We hope you find Morrison & Foerster's Intellectual Property Quarterly Newsletter useful in following recent developments in intellectual property law.

Maximizing Patent Opportunities and Funding in Clean and Green-Tech Start-ups

One of the cornerstones in building a viable new business is the technology and protection of rights to the

entity's intellectual creations. What do investors in clean and green technologies want to know about intellectual property issues, and what can an entrepreneur in this field do to maximize valuation?

[Click here to read the full text of this article.](#)

Protecting Inventions Involving Biofuel Feedstock

In the near future, biofuel feedstock patents have the potential to dominate the biofuel patent landscape by covering the most cost-effective means of production. Going forward, expensive pretreatment processes will be eliminated by backing pretreatment technology upstream into feedstock plants. As more and more cost-saving technology is engineered into the already price-significant feedstock, the economics of biofuel production will crown feedstock patent portfolios as some of the most valuable in the biofuel patent landscape.

[Click here to read the full text of this article.](#)

Reexamination v. Litigation: Which Controls?

The *Translogic* cases suggest an answer to the question: "What happens to a judgment of infringement when the claims are later rejected in reexamination?" The cases — which are not yet over — appear to show that a finding of invalidity in the Patent Office can trump a validity finding and an infringement judgment from a district court. These proceedings provide a rare window into the interplay between judicial and administrative approaches to patents and claim construction. They also raise questions about the nature of appellate review, and how the patent system interacts with the Constitutional requirements of the Seventh Amendment reexamination clause and the Article II Appointments clause. The timeline of procedural events — although complicated, illustrates the significant substantive issues.

[Click here to read the full text of this article.](#)

Utility Models – A Useful Alternative to Patents

In many countries the time required to secure patent protection often exceeds two years. By the time a patent issues, the protected technology may be obsolete and the marketplace may have moved on to a new and different technology. Fortunately, several countries provide a quick and effective solution to this problem in the form of "utility model" protection, enabling IP owners to secure protection in a matter of months rather than years.

[Click here to read the full text of this article.](#)

eBay Scorecard

We began tracking application of the *eBay* decision in the Spring 2007 inaugural edition of our Intellectual Property Quarterly Newsletter, and this fourth installment of the "eBay Scorecard" is current through December 31, 2007. It was a slow quarter for application of the *eBay* framework; courts considered the issue just four times in published decisions, and granted injunctions in all four cases.

	Plaintiff Practices Invention?		Infringing Use Limited to Minor Component?		Injunction Would Cause Public Harm?	
	Y	N	Y	N	Y	N
Total						

(Oct. 1, 2007 through Dec. 31, 2007)						
Injunctions Granted (4)	2	0	0	1	0	3
Injunctions Denied (0)	0	0	0	0	0	1
Cumulative Total						
(May 15, 2006 through Dec. 31, 2008)						
Injunctions Granted (30)	19	1	0	5	0	20
Injunctions Denied (8)	1	5	2	2	4	1

Printed Publications in the Computer Age: The Federal Circuit Addresses FTP Servers in SRI

In *SRI International, Inc. v. Internet Security Systems, Inc.*, 511 F.3d 1186 (Fed. Cir. Jan 8, 2008), the Federal Circuit recently reviewed its previous case law on the printed publication requirement of 35 U.S.C. § 102(b). The *SRI* decision indicates that making an otherwise relevant prior art reference openly accessible to individuals via the Internet does not necessarily qualify the reference as a printed publication. This holding is notable because it suggests that *intent* may now be a factor in determining whether a publication is publicly accessible, while providing pointed commentary from the Federal Circuit on its own printed publication precedent.

[Click here to read the full text of this article.](#)

IP Practice News

Awards and Accolades:

- In January, we were named one of only three finalists in the IP category for 2007's **Litigation Department of the Year** by *The American Lawyer*. This bi-annual feature is the most widely recognized ranking of litigation departments at major law firms in the United States. The department as a whole received "Honorable Mention" in this prestigious annual assessment.
- **Rachel Krevans**, was named one of the California Lawyer Attorneys of the Year ("CLAY") by *California Lawyer* magazine in February 2008, receiving the only award given in the IP category.
- **Ms. Krevans** also is featured on the cover of the March edition of the *The American Lawyer*. The cover story is on patent litigation in the Eastern District of Texas, and features Morrison & Foerster's watershed defense jury verdict in *Forgent v. Echostar*.
- **Louise Stoupe**, a partner in our Tokyo office, has been designated a finalist in the *IP Law & Business* "Top IP People Under 45" survey.
- The American Intellectual Property Law Association ('AIPLA') elected **Jim Pooley** as President of the 17,000-member group. The AIPLA is the largest voluntary association of IP lawyers in the United States.

From the Docket

Intercontinental Trade Secrets Case Catches Attention

(Applied Materials v. Advanced Micro-Fabrication Equipment)

As reported in *IP Law 360* and *Salon.com* last October, Applied Materials filed this suit for misappropriation of trade secrets among other causes of action, against Shanghai-based start-up and Morrison & Foerster client, **AMEC**. The case alleges that certain former employees of Applied Materials misappropriated trade secrets when they formed AMEC upon returning to China. AMEC is a newcomer to the semiconductor equipment space, and its first products use plasma etching and chemical vapor deposition to build chips — a market presently dominated by Applied. Recently, the firm twice successfully defended against Applied's motions for

emergency orders seeking expedited discovery. The defense team on this matter consists of **Harold McElhinny, Marc Peters, Ken Kuwayti, Mark Danis, Amir Weinberg, and Matt Ahn.**

Firm Sues Nine Top Auto Manufacturers in MHL TEK Matter

In *MHL Tek v. Nissan, et al.*, we represent MHL Tek and its owners, the inventors of a pioneering system for continuously monitoring tire pressure while a vehicle is in motion. In July 2007, the firm filed the initial action in the Eastern District of Texas asserting three of MHL Tek's tire pressure monitoring system patents against nine automakers: Nissan, Subaru, BMW, Porsche, Volkswagen, Audi, Kia, Hyundai, and Isuzu, and is investigating adding two more manufacturers as defendants. Due to substantial safety concerns associated with under-inflated tires, as reflected in the Ford Explorer/Firestone litigation, federal legislation now mandates that all passenger vehicles be equipped with a tire pressure monitoring system. Given the public safety concerns and the huge market potential of these systems, this matter is sure to be closely watched in the automobile manufacturing industry. Our clients are represented by **David Doyle, Richard Kim, Katherine Parker, and Aramide Fields.**

Morrison & Foerster Helps Thought Leaders Lay Groundwork for Future Success

Some of the world's most pioneering organizations rely on Morrison & Foerster's IP practice. Biomimicry is an emerging area of science that studies nature's best ideas and then imitates these designs and processes to solve human problems. Morrison & Foerster works with the Biomimicry Institute and the Biomimicry Guild to develop and implement their intellectual property strategy including patents, trademarks, and trade secrets. Attorneys supporting these organizations include **Gladys Monroy, Tessa Schwartz, Susan Mac Cormac, Charlene Kon, Pamela Pasti, and Jonathan Glass.**

Multi-Media: Look. Listen. Learn.

Morrison and Foerster's IP Group is much more than the articles presented above. With this edition of the Quarterly Newsletter, we introduce our Multi-Media section. Included in it are links to webinars, presentations, discussions, as well as articles written by our attorneys and about our attorneys. This is a sample of how our attorneys are engaged and involved in the practice of law, and how that practice shapes businesses, trends and communities.

Articles

[Business Method Patents in Danger?](#) (pdf)

By Greg Reilly and Eric Acker
January, 2008

[Taming Texas](#) (pdf)

By Nate Raymond, reporter for ALM Media
March, 2008

The cover article for the March issue of *The American Lawyer*, this article features Rachel Krevans and addresses the Eastern District of Texas's rise in prominence for patent litigation trials and the firm's victory in *Forgent v Echostar*.

Speaking Engagements

January, 2008

CEO Roundtable, attended by David Doyle and Eric Acker, Partners, San Diego Office.

"Changes in Patent System, January 2008," [click here for a transcript of this meeting](#) (pdf). Reprinted from *The Daily Transcript*, January 31, 2008, Vol. 123. No. 23. Used with permission.

Webinars and Podcasts

[The N-Data Consent Decree: Standards Setting and Fair Play \(1 hr. 26 min.: 37.28 MB\)](#) (mp3)

Presented by Sean Gates, Karl Kramer, Penny Preovolos
February, 2008

Slides: [Click for PDF Slides](#)