

# INTELLECTUAL PROPERTY SECTION NEWSLETTER

## ***“OPEN SOURCE: WHAT EVERY IP LAWYER NEEDS TO KNOW ABOUT THIS CONTROVERSIAL LICENSING PARADIGM”***

***Friday, November 19, 2004***

***Presented by***

**Jason H. Wilson, Willenken Wilson Loh & Stris LLP, Los Angeles  
Richard C. Hsu, Townsend and Townsend and Crew LLP, Palo Alto  
Michael M. Krieger, Willenken Wilson Loh & Stris LLP, Los Angeles**

Open source (OS) is a development and licensing paradigm now deployed enough to threaten proprietary software companies such as Microsoft. But despite OS's benefits, it also brings perils to those not adept at its licensing mechanisms, from programmer to general counsel. Meanwhile, in March 2003 SCO injected real litigation risk into the Linux/OS world with SCO v. IBM, and augmented user concerns in 2004 by suing Daimler Chrysler and AutoZone.

The panel will address what OS is, litigation risk to companies using OS software, and OS licensing under the GNU GPL and other agreements.

Jason H. Wilson, a partner in Willenken Wilson Loh & Stris LLP (Los Angeles), has extensive experience litigating and trying patent and other technology matters during the past 17 years. He frequently writes and speaks on issues of trial and litigation assessment in technology cases. He previously was at Morgan Lewis & Bockius. Jason is a graduate of Pomona College (B.A.), Harvard Law School (J.D. cum laude), and clerked for the 9th Circuit, first for Judge O'Scannlain and two years later for Judge Tang.

Richard C. Hsu, a partner and Chair of the Technology Licensing Practice at Townsend and Townsend and Crew LLP (Palo Alto). With extensive experience in licensing, development, acquisitions, service and other partnering agreements for a variety of industries, Mr. Hsu also provides strategic intellectual property advice and advises clients on innovative business strategies. A frequent lecturer on licensing and intellectual property issues, Mr. Hsu co-authored a book on patents (Fairmont Press 1997) and has written for the New York Times, as well as legal and technology publication. He holds a B.S. from Caltech and J.D. from Columbia.

Michael M. Krieger has practiced technology law for nearly 20 years, focusing on preventive and strategic litigation issues. Involved in cryptology, technology transfer, Internet and open source issues since they emerged, he has assisted clients ranging from startups to international corporations. Michael graduated Caltech (B.S.) and UCLA (Ph.D.) in mathematics and then spent 10 years on the MIT and UCLA faculties prior to earning a J.D. at UCLA. He practices law with Willenken Wilson Loh & Stris llp, specializing in technology litigation.

## Monthly Luncheon

- Date:** Friday, November 19, 2004
- Location:** **Faegre & Benson, LLP**  
**3200 Wells Fargo Center**  
**1700 Lincoln Street**  
**Denver, CO 80203**
- Time:** 11:45 a.m. to 1:30 p.m.
- Cost:** **\$15.00** (including lunch)  
at the door or in advance  
(make checks payable to CBA)
- Menu:** Southwest Roast Beef or  
DC Chicken Salad on Steakhouse  
Rye or Tuna on Olive Ciabatta,  
bakery chips, fresh baked sweet  
and seasonal fruit
- CLE:** 1 Hour General Credit  
(applied for)

Reservations must be made by **Wednesday, November 17, 2004 at 5:00 p.m.** To make a reservation, contact Deb Camp at Faegre & Benson, LLP at **303.607.3701** or by e-mail at **dcamp@faegre.com**.

Please provide your name (and spelling), phone number and menu choice. Payment should be made at check-in at the meeting to the Colorado Bar Association. **Cancellations after 5:00 p.m., Wednesday, November 17, 2004, and no-shows will be billed for the cost of the luncheon.**

## ANNOUNCEMENTS

J. Mark Smith has agreed to be our liaison with the CBA's Legislative Policy Committee. Please let Mark know if you have any thoughts, concerns, proposals, etc. regarding state legislative matters. Mark's contact information

is Pendleton, Friedberg, Wilson & Hennessey, P.C., 1875 Lawrence Street, Tenth Floor, Denver, CO 80202-1898, [msmith@penberg.com](mailto:msmith@penberg.com), (303) 839-1204.

## UPCOMING SPEAKERS

December 16, 2004  
Dr. Lindsay Moore, KLM, Inc.  
Topic: The Difference Between a Trademark and a Brand

## UPCOMING EVENTS

April 28 & 29, 2005  
**3<sup>rd</sup> Annual Rocky Mountain Intellectual Property Institute**  
**MARK YOUR CALENDARS NOW!!!!!!!!!!!!!!**

[Lawyers' Trip to China-April 14 to April 28, 2005](#)

Meet with law firms in Beijing, Shanghai, and Chengdu; attend lectures on China's commercial laws and foreign investment laws by experienced lawyers and law professors, and join in discussions with law professors and law students. The "Lawyers' Trip to China," is an opportunity for Colorado lawyers to gain an understanding of the Chinese commercial laws and practice, establish business contact with local lawyers and build cooperative relationship. This "legal exchange" with the focus on China's commercial laws is being organized and led by Lily Williams, President of ACM International Corp., and former lawyer in Shanghai, China. Approximately 16 hours of CLE will be offered. The 14 days' trip also includes sightseeing activities and a visit to a tea plantation in rural area of western China, exciting adventures for you to understand Chinese culture and local people. For more detailed information, please contact Lily Williams by e-mail: [acm-lily@earthlink.net](mailto:acm-lily@earthlink.net), or call (720) 842-0420.

## JurisNotes

**Patent - ND Ill - Patent containing mere germ of an idea invalid for lack of enablement.** Anoto AB v. Sekendur (10/22/04)

Anato sued Sekendur for declaratory judgment. The court granted Anato's summary judgment motion and denied Sekendur's summary judgment motion.

Sekendur holds the '434 patent for a digitizer and absolute position determination device for indicating the instantaneous position and movement of a stylus on a device. Sekendur alleged in his counterclaim that Anato infringed the '434 patent either directly, by inducement, or contributorily. All products using Anato technology include the Anato Dot Pattern and/or an Anato-Programmed Processor. Anato licenses the Anato Dot Pattern to its paper customers who print the pattern on paper. Anato provides the Anato Processing Algorithm for inclusion within the processors of digital pens supplied by Anato pen partners. Thus, each Anato-Enabled pen product includes an Anato-Programmed Processor.

The court noted that Sekendur's unsupported assertions of fact and conclusory statements were not competent evidence for purposes of creating a material dispute of fact. Although Sekendur was appearing pro se, in light of his apparent sophistication and experience, he was entitled to limited leniency regarding compliance with rules and procedures. Ultimately, the court ruled that Anato's summary judgment motions should be granted on the ground that Sekendur miserably failed to comply with [Local Rule 56.1](#). Nevertheless, as an alternative basis for granting summary judgment, the court did its best to parse the record for evidence in support of Sekendur's position. The court, however, was unable to discover any evidence demonstrating the existence of a material dispute of fact. As to Anato's motion for summary judgment of non-infringement, Sekendur was deemed to have

admitted certain of Anato's assertions by failing to adequately rebut them. In the end, it was clear that the accused devices did not infringe the '434 patent. Concerning Anato's motion for summary judgment of invalidity for lack of enablement, the court concluded that the '434 patent constituted nothing more than the mere "germ" of an idea. It was undisputed that it would take multiple years measured in person working hours to produce a functioning prototype of the claimed invention. Sekendur's own expert testified that it would take four person-years of effort to do so. Another factor weighing in favor of a ruling of undue experimentation was the fact that the '434 patent did not disclose the operation of its "processing means," which was the heart of the invention. The processing means processed the printed code and translated it into precise coordinates. Each claim of the patent required a "processing means" for receiving and processing the output signal to determine an absolute coordinate. The '434 patent contained no details whatsoever about how the "processing means" functioned.

**Trademark - D Colo - No evidence that conduct was expressly aimed at forum.** Impact Productions, Inc. v. Impact Prod., LLC (10/18/04)

IPI sued IPL for trademark infringement and the court granted IPL's motion to dismiss for lack of personal jurisdiction and improper venue.

IPI is a Colorado corporation, while IPL is a New Jersey company. IPI is in the business of organizing exhibitions for entertainment purposes, providing multimedia presentations, and offering promotional advice for conventions and trade shows. IPI alleged that it began using the "Impact Productions" mark in commerce in March 1997 and filed its application to register the mark with the PTO that same year. The application was granted and the mark was registered to IPI in 2001. IPL is also in the business of special event planning. IPL alleged that it had used the "Impact Productions" mark since 1996. IPL first learned of IPI in 2001 and sent it a cease and desist letter. In 2002, IPL

sought to resolve the dispute by petitioning the TTAB to cancel IPI's trademark registration and IPI responded by filing this action. In 2001, IPL produced a dinner and awards presentation at an international conference hosted in Arizona. In the course of planning this event, IPL had numerous phone, letter, and email contacts with Colorado employees of Primedia Business Exhibitions, the organizer of the event. A flyer that mentioned IPL was distributed throughout the country, including to some Colorado residents.

IPI asserted that IPL was subject to specific jurisdiction in Colorado. Specifically, IPI contended that IPL purposefully directed activities at Colorado under the [Calder](#) effects test. However, IPI's reliance on the effects test foundered on the requirement that it demonstrate IPL committed acts expressly aimed at Colorado, as none of the asserted actions by IPL, considered singly or in combination, made this showing. That IPL may have infringed on IPI's mark outside of Colorado and did so knowing that IPI was a Colorado resident and that this infringement would have effects in Colorado was not sufficient to prove "express aiming" at Colorado under the *Calder* test. IPI had to present "something more" than the injuries it allegedly suffered as a result of IPL's out-of-forum infringement in order to make a prima facie showing that IPL expressly targeted Colorado through its conduct. IPI neither alleged nor produced evidence that IPL acted wrongfully or unreasonably in seeking to protect what it viewed as its common law trademark rights through the cease and desist letter and the TTAB petition. Further, the other contacts cited by IPI, consisting of IPL's contacts with the forum through its association with Primedia and the 2002 event, were random, fortuitous, or attenuated contacts. For example, it was merely fortuitous that some of the Primedia employees IPL dealt with were located in Colorado. It was undisputed that IPL had no involvement in Primedia's distribution of the flyer. As a result, IPL was not subject to specific jurisdiction in this forum.

*Copyright - ND Ill - No preemption: plaintiffs were not photographed with their authority.*

**Leto v. RCA Corp.** (10/25/04)

Dean and Rhonda Leto (collectively "the Letos") sued RCA, Wal-Mart Stores, Inc., and Sears, Roebuck and Co. (collectively "RCA") for publicity rights violations and related claims. The court previously [granted](#) the Letos' motion to remand. The court denied RCA's motion to reconsider that order.

In 2000, the Letos, a brother and sister, went to Kings Island Amusement Park in Ohio, where they rode a roller coaster together. In 2001, the Letos discovered that a photograph of them riding the roller coaster was being used on the packaging of certain RCA televisions offered for sale at Wal-Mart and Sears stores in Illinois and Arizona. The Letos filed a complaint in Illinois state court, alleging that RCA's use of their likenesses without written consent violated the [Illinois Right of Publicity Act](#) and constituted a common law tort of misappropriation. RCA then removed the case to federal court on the basis of complete preemption by the [Copyright Act](#). The court previously found that the Letos claims were not completely preempted and remanded the case to the state court.

RCA argued that the court erred in finding that the work giving rise to the Letos claims did not fall within the subject matter of copyright. Courts had repeatedly identified the "work" giving rise to a right of publicity claim as the plaintiff's persona. "Persona" appeared to be a catch-all term encompassing various types of "work" plaintiffs sought to protect with right of publicity claims. Once a persona was fixed in a tangible form, such as a photo, it could fall within the scope of copyright. However, a persona did not automatically fall within the scope of copyright just because it had been captured in tangible form. In this case, the Letos' personas were not fixed for the purpose of copyright preemption unless they gave their authority for their likenesses to be recorded in tangible form. There was no evidence that the Letos were photographed with their authority.

Moreover, the Letos did not claim any ownership rights in the photo at issue. Accordingly, the Letos claims were not completely preempted, leaving it for the state court to determine whether RCA's preemption defense applied.

Copyright 2004 by JurisNotes.com, Inc. No claim to copyright as to original U.S. government work. Reprinted with permission from JurisNotes.com, Inc., Editor: Margie S. Schweitzer, J.D.; email [Margie@JurisNotes.com](mailto:Margie@JurisNotes.com); phone 503-763-8717; fax 503-763-8718

## CLASSIFIED ADVERTISING

*Classified advertisements are printed by the IP Section free of charge. Ads may be submitted on disk, via e-mail, or by fax. Submit your ad to Debbi Camp at Faegre & Benson, LLP, 3200 Wells Fargo Center, 1700 Lincoln Street, Denver, Colorado 80203; via e-mail to [dcamp@faegre.com](mailto:dcamp@faegre.com); or fax to 303-607-3600.*

### Employment Opportunities

#### **Faegre & Benson, LLP**

##### **Patent Associate - Denver**

- Description: Faegre & Benson LLP has an opening in its Denver Office for a Patent Associate with one or more years experience. An Electrical Engineering or Software background preferred. All candidates should have excellent academic credentials, strong writing skills and professional recommendations.

When applying for a lawyer position, please send a cover letter, resume, and a copy of your law school transcript to the address or fax below, or apply online at [www.faegrebenson.com](http://www.faegrebenson.com).

Amy Schneider  
Recruiting Specialist  
Faegre & Benson LLP  
1700 Lincoln Street  
Denver, CO 80203-4532  
FAX # 303-607-3600

##### **Intellectual Property Associate - Denver**

- Description: Faegre & Benson LLP is seeking to hire an associate with two or more years of experience to work with the Firm's Denver Intellectual Property

Group. Candidates should have excellent academic credentials, strong writing skills and professional recommendations, as well as practical experience in the following areas: solid technology based commercial contract and agreement experience within a law firm and/or in-house legal environment with a publicly traded company. Job responsibilities will require handling of all aspects of reviewing, drafting and negotiating a broad range of domestic and international complex commercial transactions and agreements involving technology, including, software development and license agreements, joint development agreements, technology transfer agreements, consulting agreements, e-commerce agreements, web development and hosting agreements, data sharing agreements, complex procurement agreements, product distribution agreements, sponsorship agreements and various types of patent, trademark and copyright licenses. Please send resume and law school transcript to the attention of Amy Schneider, Recruiting Coordinator, Faegre & Benson LLP, 3200 Wells Fargo Center, 1700 Lincoln Street, Denver, CO 80203. Written inquiries only.

#### **Townsend and Townsend and Crew LLP**

A Full-Service Intellectual Property Law Firm  
[www.townsend.com](http://www.townsend.com)

##### **Patent Litigation Associate, Denver, Colorado**

Townsend and Townsend and Crew LLP, one of the premiere Intellectual Property law firms in the United States, is looking for a first or second year attorney for a patent litigation position in our Denver, Colorado office. Ideal candidate should have experience in patent litigation with excellent academic background in electrical or mechanical engineering. Excellent writing, interpersonal and communication skills are

required. Salary and benefits are highly competitive. Please send a resume and cover letter to: Lindy Van der Reis, Esq. Manager of Recruitment and Professional Development Townsend and Townsend and Crew LLP, 2 Embarcadero Center, 8th Floor San Francisco, CA 94111 [mhv@townsend.com](mailto:mhv@townsend.com)

### **Johns Manville**

The Intellectual Property Counsel will provide active and strategic IP Legal Services to JM Business Units. To support JM Innovative Growth by identifying opportunities and executing creative and effective actions to protect JM innovations and capture their financial value.

This position will interface with entire global JM organization as necessary, with a principle focus in a single Business Unit and strategic area. Initial proposed primary assignment to Building Insulation Division. Will be primary contact for all IP-related matters for the Business Unit for approximately 50% of time, and have flexibility to handle other matters as directed for remainder. Reports to Associate General Counsel ;V Intellectual Property with no direct reports.

The specific key responsibilities include:  
 Developing specific IP strategies for technologies in the assigned business.  
 Invention Development and Patent Procurement in primary area, and other areas as assigned.  
 Interface with outside attorneys and law firms on specific matters.  
 Disclosure and Development Agreements in assigned areas, and other areas.  
 Advise and counsel to Business Units regarding all initial IP issues in assigned area, including portfolio management and decisions relating to the portfolio.

B.S. or M.S. Chemical or Mechanical Engineering

J.D. from American Bar Association Law School

Admitted to a State Bar, and Licensed to practice before the USPTO

-A minimum of 5 years of solid IP legal experience.

-Experience in evaluation and selection among dozens of concepts for potential patentability, numerous times.

-Direct experience in development of draft patent applications from minimal initial disclosures.

-Original drafting and prosecution through granting of at least 50 patent applications, and associated foreign counterparts.

-Complete investigation and authorship of at least 10 formal opinions of patentability, infringement or validity.

-Substantial experience in the drafting and primary negotiation of Disclosure and Development Agreements.

-Direct management and teamwork with outside IP Counsel on varied projects.

-Developing and presenting educational seminars and presentations on IP and legal topics.

-Excellent communication and organizational skills, and demonstrated self-motivation and internal drive is required.

-Must demonstrate creativity in approaching and prioritizing subjects and issues is crucial to success in this position. A keen awareness of value drivers and business direction in a large organization

-Personal leadership personality traits to drive solutions to completion is required.

- Prior direct management of world-wide outside counsel is a definite plus.

Please apply at [www.jm.com](http://www.jm.com)

Career Opportunities

**Heimbecher & Assoc., LLC** seeks a mid-level intellectual property associate. The ideal candidate will have two-four years of experience in patent prosecution with an emphasis on drafting mechanical and some electrical patent applications. Strong academic

credentials are preferred. Must be registered with the USPTO and a member of the Colorado Bar. Send cover letter and resume via fax to 303.985.0651 or via email to maria@heimbecher.com. No agencies please.

The Salt Lake City office of **Holme Roberts & Owen LLP**, seeks a mid-level intellectual property associate. The ideal candidate will have three-four years of experience in patent prosecution with an emphasis in writing software and networking patent applications. Strong academic credentials and an undergraduate degree in either computer science or EE is preferred. Must be registered with the USPTO. Apply online at [www.hro.com](http://www.hro.com) or email your resume to wilsonan@hro.com. No agencies please. EOE.

**Klaas, Law, O'Meara & Malkin, P.C.**, a 7-attorney Denver, Colorado IP firm with a large prosecution practice, seeks ME and EE patent attorneys with 2+ years patent prosecution experience. Mail or fax resume, references, and writing samples in confidence to William P. O'Meara, Klaas, Law, O'Meara & Malkin, P.C., 1999 Broadway, Suite 2225, Denver, Colorado 80202; Fax 303-297-2266.

### Services Offered

**Patent Attorney** seeks overflow and contract patent preparation and prosecution work. Specializing in the mechanical and material science arts. Experience in law firms with top national intellectual property law practices. Flat fee or reasonable hourly rates. Kurt Leyendecker, 9241 S. Lark Sparrow Drive, Highlands Ranch, CO 80126. 303.921.9536. Fax 303.683.8393. Kurt@Leyendeckerlaw.com.

**Patent Agent** with 20 years technical experience seeks overflow patent work. Technical experience: Biochemistry degree from Harvard, MS in Physics from Naval

Postgraduate School, former chief Engineer of nuclear warship, startup management, four years as independent IT consultant with multiple Fortune 100 clients, author of 2 issued and 5 pending patents in IT field. Brian Galvin, 5701 Tinnin Rd NW, Albuquerque, NM 87107. (505) 341-9439. bgalvin5@comcast.net

**Patent Attorney** with 12 years patent law plus 15 years engineering experience seeks overflow or contract work. Specializing in software, computer, and electrical arts patent preparation and prosecution. Reasonable hourly or fixed price rates. Member CO, AZ, USPTO bars. Bruce E. Hayden, P.O. Box 205, Dillon, Colorado 80435. 303-526-2671/ 602-403-7678 /bhayden@copatlaw.com/@ieee.org/@highdown.com.

**Patent Attorney** with 20+ years chemical, mechanical and design experience seeks overflow or contract work – prosecution, opinions, etc. U.S. Naval Academy grad with M.S., Chem.; corporate and firm experience. Reasonable hourly rates for excellent service. Member D.C. and CA bars, Registered USPTO. James K. Poole, P.O. Box 925, Loveland, CO 80539. Tel. (970) 472-5061, FAX (970) 472-5041.

**All Language Alliance, Inc.** provides accurate legal, technical, medical and financial translation services. Court certified interpreters are available for depositions and trials. Please visit [www.languagealliance.com](http://www.languagealliance.com) for additional information. Call 303-470-9555 to request a free copy of A Lawyer's Guide to Cross-Cultural Depositions."

**Intellectual Property Litigator** with over 20 years experience in complex commercial and intellectual property litigation seeks contract work. Analysis, research, pleadings, briefs, trial preparation materials. Carole Jeffery, The Forum at Cherry Creek, 425 So. Cherry Street, Suite 920, Denver, CO 80246. (303) 322-2116.



**Patent Attorney** seeks overflow work. University of Michigan Law School 1977, PTO-1984. Patent applications, amendments, inventor counseling, infringement analysis, etc. Experience in large corporation and law firms. Member of CO and TX Bars. Henry L. Smith, Jr., 9273 S. Cornell Circle, Highlands Ranch, CO 80130-4141. Phone/fax 303-346-5045.

**Patent Attorney** with 10 years patent and 7 years computer design experience seeks overflow or contract patent work. Electrical Engineering and Software (double major) degree from Carnegie Mellon University. Specializing in software and digital hardware patent prep. and pros. in telecommunications, computing and other electrical arts. Reasonable hourly rates and flat fees. Member CO, IL, USPTO bars. Mark A. Thomas, 10138 South Cottoncreek Drive, Highlands Ranch, CO 80130. 303-470-3838 (Office) and 303-470-3837 (Fax). Mark\_Thomas@comcast.net.

**Global Connections** provides high quality translation and interpretation services in all major languages. We offer ATA accredited translators specializing in legal (patents, trademarks and copyrights), technical, engineering, medical, telecommunications, marketing and financial translations. We also offer Court Certified interpreters for hearings, depositions, meetings, trials, etc. For more information, please contact Global Connections, 9400 E. Iliff Avenue, Suite 62, Denver, CO 80231. Ph.: (303) 750-7611; Fax: (303) 750-7689; Email: trans@gconnections.com

**Trademark Attorney** with 10 years' experience managing large international and domestic portfolios for major corporations seeks contract work or part-time position. Registered to practice in Colorado and California. Lisa K. Levine, 9 Mourning Dove Lane, Littleton, CO 80127. (720) 981-8782, levinelaw@ix.netcom.com.

**ONLINE CLE COURSE: CROSS-CULTURAL DEPOSITIONS** Attorneys in

Colorado, Arizona, California, Missouri, Montana, and New York can receive 1 general/ethics credit hour for taking the online CLE course, [A Lawyer's Guide to Cross-Cultural Depositions](#). For details please visit [www.languagealliance.com/white-paper](http://www.languagealliance.com/white-paper) or call (303) 470-9555.

**Patent Agent** (BSEE/MSA), fluent in English, French and Italian, who has extensive international experience in computer software engineering, software quality assurance, and complex business procedures, seeks to affiliate with a Denver area law firm which has a substantial patent practice in these areas and is interested in growing its international practice. Please contact Roberto Ruschena at (303) 220-9575 or (720) 771-7774; or e-mail at: robertoruschena@mho.co.