

THE UMBRELLA[®]

by CARSTENS & CAHOON, LLP



Dedicated to Protecting Ideas.[®]

SPRING 2014 / VOL. 7, ISSUE 1

THE UMBRELLA[®]. AN INTELLECTUAL PROPERTY LAW UPDATE.

INSIDE THIS ISSUE:

The Highway Goes Global.....	1
There You Go Infringing on My Patent Again!.....	2
Is Your Invention Really New?: Summarizing Novelty Under the New U.S. Patent Law.....	2
Practical IP Practices for Corporate Clients.....	3
Firm Updates.....	3
Professional Profile.....	4

The Highway Goes Global



Colin P. Cahoon

Partner

Followers of our newsletter are familiar with the evolution of the Patent Prosecution Highway (“PPH”), from bilateral agreements providing for the acceleration of a patent examination in the office of second filing after the office of first filing finds allowable subject matter, to PCT PPH which allows the same acceleration based on a favorable examination in the international stage.

Now, the PPH evolution continues with the new Global Patent Prosecution Highway (“GPPH”), providing applicants with another cost and time saving tool for the management of global patent prosecution.

As previously reported, the PPH program was developed to promote fast-track patent examination procedures and allow patent offices from around the world to take advantage of work already done by other offices. The PPH was one of the initiatives undertaken by the USPTO to help with the always-increasing load of patent examinations.

The PPH program as initially constructed involves bilateral agreements between other patent offices that provided for the fast-tracking of an application in a second country when the patent office in the first country has found allowable claims. This “standard” model of the PPH involves a one-way relationship between an application filed in an office of first filing and an application filed in an office of second filing. As long as one claim is allowed in the office of first filing, the application filed in the office of second filing can be advanced out of turn. This office of first and second filing relationship made the first iteration of the PPH a one-way road with not many off ramps.



Continue reading this article at www.cclaw.com/umbrella

There You Go Infringing on My Patent Again!



Shaukat A. Karjeker

Partner

Have you ever taken someone to court, based on ongoing offending activities of that person, won the case, and then found he/she was once again engaging in “the same” offensive activity? If so, you are probably aware that a Court Order is enforceable through a “Contempt Action” to prevent the person from engaging in the activity. Well, assume you own a patent, and a competitor infringes that patent – an

ongoing tortious activity. Assume further that you sue the competitor in Federal District Court for patent infringement. And, during litigation, the competitor concedes the product it makes and markets infringes (some of) the patent claims. The district court issues an Order with an injunction enjoining the competitor from engaging in any further infringing activity, such as marketing or making the infringing product.

Later, to your surprised chagrin, the competitor starts selling a “slightly altered” version of the product! What to do? File a contempt action, and try to enforce the Court Order against the “new” product? That is exactly what patent owner Proveris did in filing a contempt action against Innovasystems. On Proveris’ motion for summary judgment of contempt and for sanctions, the district court found in favor of Proveris, and enjoined further making and marketing of the new product, but Innovasystems appealed. The Appellate Court’s opinion provides guidelines as to how a district court should analyze a contempt action, when the “new product” is represented as being “altered” from the original one that infringed.

The Appellate Court reviewed the appeal that Innovasystems filed, and looked at these two issues:

- Firstly, what are the standards the District Court should apply when deciding on a contempt action relating to patent infringement, where the product is asserted to be altered?

- Secondly, can the defendant Innovasystems raise a defense of invalidity of certain patent claims that it had previously conceded that it infringed, on grounds that an interpretation of those claims that Proveris urges for purposes of its charge of infringement, renders them invalid?

Continue reading this article at:
www.cclaw.com/umbrella



Is Your Invention Really New?: Summarizing Novelty Under the New U.S. Patent Law



Brandon V. Zuniga

Associate

In a race, it goes without saying that the first person to pass the finish line wins. But, what would happen if the location of the finish line were suddenly moved back? To a certain extent, that is exactly what has happened to U.S. patent applicants. On March 16, 2013, the U.S. transitioned from a first-to-invent patent system to a first-to-file patent system.

Now imagine that in addition to the finish line being moved back, runners are told that the rules of the race have changed. In particular, the bases for disqualification, say, false starts and inappropriate contact, have been modified. In light of the new definition of “novelty” under U.S. patent law, it is as though both the location of the finish line has moved and the rules for running the race have been modified.

If innovators wish to remain competitive in the race to obtain patents, it is important to understand exactly where the finish line for patents is located and the types of activities that can disqualify an otherwise patentable invention. Stated another way, it is essential for innovators to understand how the legal concept of novelty has been changed by new patent laws.

The Old Rules

In order to understand how the new law has changed the definition of novelty, it is useful to briefly review what the law was. The following is a paraphrase of old 35 U.S.C. § 102(a), (b) and (e).

A patent applicant’s invention is unpatentable if:

(a) Prior Art

Before the applicant invented the invention, someone else

(1) in the *United States*

(A) *knew* the invention, or

(B) *used* the invention, or

(2) in *any country*

(A) *patented* the invention, or

(B) *described* the invention in a *printed publication*.

(e) Patents and Patent Applications

Before the applicant invented the invention, someone else described it.

Continue reading this article at:
www.cclaw.com/umbrella



Practical IP Practices for Corporate Clients



William M.
Imwalle

Of Counsel

Internal Review of Competitor Published Patent Applications and Issued Patents

Imagine the embarrassment of having an email discovered during litigation where one of your employees exclaims that your new product probably infringes a competitor's patent he has only just perused. Of course, it is sound

business practice for companies to routinely review their competitors' published patent applications and issued patents. Armed with this information, your company can make strategic business decisions. However, your company should take steps to avoid creating potentially harmful documents, emails and other correspondence that could be used against it in litigation.

If your company has personnel involved in (a) reviewing the competitors' published patent applications and issued patents and/or (b) monitoring the prosecution of a competitor's patent application, then be sure to implement some simple policies on how to document and report the findings and concerns. Those policies should also address which individuals are to receive such reports and communications. Finally, the policy should sensitize the employees responsible for the reviews about the risks of poorly worded and premature assessments about risk.

Once in litigation, an accused infringer will be required to produce many internal documents that are relevant to the issues that are raised in the lawsuit. Accordingly, internal reports or correspondence of an accused infringer that discuss the patent-in-suit will likely be subject to discovery requests from the patent holder. Once such a document is identified as being responsive to a discovery request, whether a hard copy or in electronic format, the accused infringer will be required to produce the document unless the court determines the document is either privileged attorney-client communication or attorney work product. Written statements such as, "we infringe this patent" or "let's copy what they are doing," should clearly be avoided. So, too, should statements about the relative strength of a competitor's patent or the potential negative impact a patent may have.

Continue reading this article at:
www.cclaw.com/umbrella



Firm Updates

AWARDS

> Carstens & Cahoon, LLP made the Dallas Business Journal's list of Top Patent Law Firms 2013, based on the number of patent attorneys as well as number of patents applied for and issued in 2012.

> Partners David Carstens, Colin Cahoon, and Vincent Allen were voted by their peers to D Magazine's Best Lawyers in Dallas 2014. Look for them in the May edition of D Magazine.

NEW MEMBERS

> Carstens & Cahoon, LLP is pleased to announce that Stephen Liu has joined the firm as an associate. Mr. Liu practices intellectual property law with an emphasis on patent prosecution and trademarks. Mr. Liu received his undergraduate degree in chemical engineering from the University of Texas at Austin and his law degree from Southern Methodist University. Mr. Liu is currently pursuing a second baccalaureate degree in electrical engineering from The University of Texas at Dallas as he continues working with the firm.

> Bill Imwalle has joined the firm as Of Counsel. Mr. Imwalle brings over 23 years of experience practicing law, including over 19 years spent as an in-house intellectual property attorney for one of the world's largest oil field services companies as well as the Department of Energy. Mr. Imwalle has extensive experience managing U.S. and foreign patent preparation as well as complex patent infringement litigation and trade secret misappropriation litigation involving numerous technologies. Mr. Imwalle is currently admitted to the Louisiana State Bar and the United States Patent & Trademark Office.

> Carstens & Cahoon, LLP is pleased to announce that Austin Teng has joined the firm as a Patent Agent. Mr. Teng worked with the firm as a law clerk in 2013 and will become an associate upon graduation from SMU Law this May. Mr. Teng also has extensive experience in software engineering, having spent several years at Siemens Industry.

Keep up with the latest Carstens & Cahoon, LLP news by following us on our social media pages.



CARSTENS & CAHOON, LLP

Attorneys And Counselors

13760 Noel Road | Suite 900 | Dallas, TX 75240
T: 972.367.2001 | F: 972.367.2002 | www.cclaw.com

PRESORTED
FIRST-CLASS MAIL
U.S. POSTAGE PAID
ADDISON, TX
PERMIT NO 444

THE UMBRELLA®

The Umbrella® is published periodically by the law firm of Carstens & Cahoon, LLP to inform readers of recent developments in intellectual property. For more information, please visit www.cclaw.com. This publication is not intended to be used as a substitute for legal advice or opinions. It is not intended to create an attorney-client relationship or to indicate that such a relationship exists between Carstens & Cahoon, LLP and the recipient of this publication, but is provided merely as a courtesy to inform the recipient about recent developments in the law.

For more information, please contact the editor, Vincent Allen at (972) 367-2001 or email him at allen@cclaw.com.



© 2014 Carstens & Cahoon, LLP. All rights reserved.

Professional Profile



Brandon V.
Zuniga

Associate

Brandon Zuniga practices in the area of intellectual property law, including patents, trademarks, trade secrets, and copyrights. He is a registered patent attorney with the U.S. Patent & Trademark Office and a member of the State Bar of Texas.

Since beginning his law career in Boston, Mr. Zuniga has prosecuted patents covering a wide range of technologies in the realms of food products, oil production, manufacturing, sustainable energy, medical devices, and biotechnology. Brandon also served as a judicial intern for the United States Court of Appeals for the First Circuit. His responsibilities involved drafting bench memoranda and making recommendations to the judge. In addition, Brandon represented indigent clients in a year-long civil litigation clinic covering housing, employment, and disability law.

Experience as a process engineer prior to law school has given Mr. Zuniga an inside perspective and enhanced ability to understand and protect a client's intellectual property. He designed

processes and equipment on multi-billion dollar projects for some of the world's largest oil and gas companies. Projects ranged from distillation columns, utilities, and offsite equipment for oil refineries to reverse osmosis, ultra-filtration, and solar evaporation ponds for wastewater.

With a B.S. in Chemical Engineering from Rice University, Mr. Zuniga ventured into the snow to obtain his J.D. from the Boston University School of Law, where he completed a concentration in Intellectual Property with honors. During law school, he served as a note editor for the Public Interest Law Journal and treasurer of the Intellectual Property Law Society. He also received the Dean's Award in Trade Secrets & Restrictive Covenants. Mr. Zuniga's article, entitled Lessons from the Federal Circuit: Avoiding Unpatentability for Life Science Inventions, was published in the Journal of the Patent and Trademark Office Society.

A member of the American Intellectual Property Law Association, Dallas Bar Association, American Bar Association, and American Chemical Society, Mr. Zuniga is also dedicated to the community. Many hours have been spent serving patients at the Texas Children's hospital and mentoring underprivileged children. Outside of the office, Mr. Zuniga enjoys traveling and foreign languages, strategy games, bicycling, sailing, and playing a variety of instruments.