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Review of Developments in Intellectual Property Law

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Supreme Court Expands Declaratory Judgment Jurisdiction: *MedImmune*'s Impact for Licensees

On January 9, 2007, the U.S. Supreme Court issued an 8-1 decision in *MedImmune v. Genentech* (Case No. 05-608) and set in motion a sea change of the law of declaratory judgment jurisdiction in patent cases. In the patent context, declaratory judgment jurisdiction allows a putative infringer to clarify its rights by bringing a pre-emptive lawsuit to settle whether it infringes any valid patent claim. Prior to the Supreme Court's *MedImmune* decision, the Federal Circuit required the putative infringer to have "a reasonable apprehension on the part of the declaratory judgment plaintiff that it will face an infringement suit" before a court could exercise jurisdiction over the case. Although *MedImmune* dealt only with the question of whether entering into a license would estop the licensee from bringing a declaratory judgment lawsuit, it has already had far more extensive ramifications. In fact, in just the past few months since the decision, the Federal Circuit has relied upon *MedImmune* to sweep away over a decade of its own precedent.

The *MedImmune* case dealt with a relatively narrow question, whether a licensee would be required to breach its license before bringing a declaratory judgment action on patent infringement issues. The Court decided it did not, and thereby shifted substantial power from licensors to licensees. Under well-established Federal Circuit precedent, a non-breaching licensee could

continued on p. 2

Crafting the Cease and Desist Letter: *MedImmune*'s Impact on the Patent Owner

Your company's long-awaited patent will issue shortly and management has asked you to advise them on the best way to exploit the new patent. Here is your dilemma. On one hand, you want your competitors to be informed of your patent so that they might sign up as royalty paying licensees or alternatively, they will stop making infringing products. On the other hand, you do not want to get involved in a protracted and expensive patent litigation because one or more competitors take offensive action by filing a declaratory judgment ("DJ") action. You need to craft a "cease and desist" letter that provides the necessary notice of your patent, but avoids unplanned litigation.

Providing Notice Is Important

Stopping or deterring infringing sales and/or generating royalties are important; however, providing notice of a recently-issued patent has two additional benefits. Both relate to patent damages in litigation. Proper notice can avoid forfeiture of past damages and also possibly enhance, by a factor of three, a damages award.

A. § 287(a) Damages Notice

When a "patented article" is involved, 35 U.S.C. § 287(a) limits the amount of damages the patent owner can recover to those acts of infringement that occurred after the patent owner gave the alleged infringer notice of infringement. The statute permits either constructive notice, which is accomplished by physically marking the article with the patent number, or with actual notice. The requirement of actual notice is designed to assure that the accused infringer knew of the adverse patent and the alleged infringement during the

continued on p. 6

Inside this issue:

MedImmune v. Genentech: Supreme Court Expands Declaratory Judgment Jurisdiction

continued from p. 1

not bring a declaratory judgment action. Instead, the licensee had to choose the lesser of two evils: either comply with the terms of a license agreement and forego any challenge to a patent, even if it felt the patent was not infringed, invalid, or unenforceable, or breach the license and expose itself to potentially trebled damages and attorney's fees.

The *MedImmune* district court and Federal Circuit had applied that well-established Federal Circuit precedent in finding that they lacked subject matter jurisdiction over the declaratory judgment action. The Federal Circuit applied the two-pronged test for whether a court could exercise jurisdiction over a declaratory judgment action brought by any potential infringer, whether a licensee or not:

> [T]here must be both (1) a reasonable apprehension on the part of the declaratory judgment plaintiff that it will face an infringement suit; and (2) present activity by the declaratory judgment plaintiff which could constitute infringement, or concrete steps taken with the intent to conduct such activity.

MedImmune, Inc. v. Genentech, Inc., 427 F.3d 958, 964 (Fed. Cir. 2005), *citing MedImmune, Inc. v. Centocor, Inc.*, 409 F.3d 1376 (Fed. Cir. 2005), From that test, the Federal Circuit had determined that a licensee could never satisfy the first prong of the jurisdictional test without breaching its license. Both the district court and the Federal Circuit relied heavily upon *Gen-Probe Inc. v. Vysis, Inc.*, 359 F.3d 1376 (Fed. Cir. 2004), which had distinguished Supreme Court precedent and determined that a license, unless materially breached, obliterated any reasonable apprehension of a lawsuit because it constituted a promise not to sue. That is, although public policy favors removing invalid patents from the books, the Federal Circuit had found a countervailing public interest in avoiding "the inequality when the patent owner, having contracted away its right to sue, is in continuing risk of attack on the patent whenever the licensee chooses – for example, if the product achieves commercial success – while the licensee can preserve its license and royalty rate if the attack fails." Thus, the lower courts dismissed MedImmune's declaratory judgment action for lack of subject matter jurisdiction.

The Supreme Court reversed the Federal Circuit decision and found that the Declaratory Judgment Act permitted licensees to challenge the licensed patent. In doing so, the Court discarded recent Federal Circuit cases and relied primarily upon *Altvater v. Freeman*, 319 U.S. 359 (1943). In footnote 11 of the opinion, the Court indicated that the Federal Circuit "reasonable apprehension of suit" test applied below "conflicts" with Supreme Court precedent and would "contradict" those cases, including *Altvater.*

In *Altvater*, patent licensors had sued their licensees to enforce territorial restrictions in the license; the licensees, who had paid royalties "under protest," filed declaratory judgment counterclaims for patent invalidity. The licensors argued that there was no jurisdiction over the counterclaims because the issue was merely academic as long as licensees continued to pay royalties. The Court rejected that argument, stating, "The fact that royalties were being paid did not make this a 'difference or dispute of a hypothetical or abstract character,'" and therefore the dispute was not outside the Article III jurisdiction of Federal courts. 319 U.S. at 364. Although the Federal Circuit (in *Gen-Probe*) had distinguished *Altvater* on the bases that it involved the compulsion of an injunction and counterclaims, not an originally

snippets

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brought declaratory judgment action, the Court rejected those distinctions. Instead, it returned to its 1940s jurisprudence and found that the coercion of treble damages and a potential injunction was sufficient to support jurisdiction.

The Court also discounted Genentech's argument that permitting MedImmune to challenge the validity of the licensed patents would fundamentally alter the bargain that the parties had made. Genentech argued based on the common law rule that a party to a contract cannot reap the benefits of that contract while challenging its validity. The Court found, however, that MedImmune was not challenging the validity of the contract, it was challenging the validity of the licensed patents. First, the Court stated, "Promising to pay royalties on patents that have not been held invalid does not amount to a promise not to seek a holding of their invalidity." From there, the Court determined that MedImmune was not repudiating the contract. "Rather, it [was] asserting that the contract, properly interpreted, [did] not prevent it from challenging the patents, and [did] not require the payment of royalties because the patents do not cover its products and are invalid." In reaching that conclusion, the *MedImmune* Court ignored the reality that most patent licenses include a provision exempting the licensee from continued payment upon a final finding of invalidity of the licensed patent. As a result, challenging the validity of a licensed patent almost always constitutes a challenge to the merits of the contract itself. Thus, the Supreme Court decided that federal courts would have jurisdiction to consider declaratory judgment actions brought by patent licensees.

The Supreme Court's decision included only two positive points for licensors. First, it left open the possibility that the district court might find on remand that the language of the agreement or the common law rule would preclude MedImmune's suit. However, the Court decided that such an argument could only be raised on the merits of a declaratory judgment action, not as a challenge to subject matter jurisdiction. Thus, it did not extinguish completely the possibility that a licensee might ultimately be prevented from obtaining declaratory judgment relief by a well-crafted agreement. Second, Justice Thomas dissented from the Court's decision. Justice Thomas's reasoning followed the course established by the Federal Circuit's precedent, rejected in footnote 11. One key point in his reasoning was that even a declaratory judgment of invalidity would not automatically relieve a licensee of its duty to pay royalties. Due to the language of the license agreement, Justice Thomas determined that

> MedImmune's prayer for declaratory relief can be reasonably understood as seeking an advisory opinion about an affirmative defense it might use in some future litigation. MedImmune wants to know whether, if it decides to breach its license agreement with Genentech, and if Genentech sues it for patent infringement, it will have a successful affirmative defense.

MedImmune, Inc. v. Genentech, Inc., 127 S. Ct. 764, 780 (U.S., 2007). On that basis, he asserted that the advisory opinion would be beyond a Federal court's jurisdiction.

Taken by itself, the *MedImmune* decision is a substantial expansion of declaratory judgment jurisdiction. After entering into licenses, most licensors and licensees believed that Federal Circuit precedent provided them repose for the term of the license. That remains true for licensees, but licensors now have no guarantee that the licensee will not challenge the validity of the patents, and thereby seek to circumvent payment under any license. Indeed, other than the (often very considerable) disincentive of the payment of fees and costs required to challenge a patent, there is little reason for a licensee not to seek to escape the burden of license fees on a blockbuster product. At a minimum, the *MedImmune* decision allows a licensee to re-evaluate whether it will challenge a patent with far greater knowledge of the market after a portion of the license term has passed.

The *MedImmune* decision has had far greater ramifications than suggested by its holding, however. The Federal Circuit has seized on the language of footnote 11 to expand declaratory judgment jurisdiction exponentially. First, in *SanDisk Corp. v. STMicroelectronics NV,* decided on March 26, 2007, the court applied the *MedImmune* decision to find jurisdiction arising from license negotiations, even when there was an express indication of no intent to sue. Next, in *Teva Pharms. USA, Inc. v. Novartis Pharms. Corp.*, decided by a wholly different panel four days later, the court applied *MedImmune* to find jurisdiction over ANDA declaratory judgment litigation when Orange Book-listed patents had not been asserted against the ANDA filing. Through those two cases, the Federal Circuit has made it clear that its former "reasonable-apprehension-of-suit" test is dead, to be replaced with extremely broad declaratory judgment jurisdiction available in almost every circumstance in which the patentee could bring a lawsuit for patent infringement.

In *SanDisk*, the court found declaratory judgment jurisdiction was proper when the parties had engaged in, and appeared to be still engaged in, friendly cross-licensing negotiations regarding flash memory
continued on p. 4

MedImmune v. Genentech: Supreme Court Expands Declaratory Judgment Jurisdiction

continued from p. 3

patents. ST had initiated the negotiations, but had repeatedly indicated that it sought friendly negotiations and had even informed SanDisk during a negotiating session that it had "absolutely no plan whatsoever to sue SanDisk" when it provided its infringement analysis. Despite those assurances, the Federal Circuit held

> [W]here a patentee asserts rights under a patent based on certain identified ongoing or planned activity of another party, and where that [second] party contends that it has the right to engage in the accused activity without a license, an Article III case or controversy will arise and the [second] party need not risk a suit for patent infringement by engaging in the identified activity before seeking a declaration of its legal rights.

SanDisk Corp. v. STMicroelectronics, Inc., 2007 U.S. App. LEXIS 7029 (Fed. Cir. 2007). The *SanDisk* court identified ST's seeking of royalties, based on reverse engineering of SanDisk's products and a comparison to ST's patent claims, and SanDisk's denial of any obligation to pay, as facts sufficient to establish declaratory judgment jurisdiction. The court did not view ST's indication of its lack of intent to sue as an ameliorating fact; to the contrary, it accused ST of "engaging in the kinds of 'scare-the-customer-and-run tactics' that the Declaratory Judgment Act was intended to obviate." Indeed, the court made that accusation even though negotiations appeared to be still ongoing.

Writing separately to discuss the practical effect of the majority's decision, Judge Bryson indicated just how far that decision could be stretched:

> [I]t would appear that under the court's standard virtually any invitation to take a paid license relating to the prospective licensee's activities would give rise to an Article III case or controversy if the prospective licensee elects to assert that its conduct does not fall within the scope of the patent. Indeed, as the court makes clear, even a representation by the patentee that it does not propose to file suit against the prospective licensee will not suffice to avoid the risk that the patentee will face a declaratory judgment action. And if there is any uncertainty on that score, all the prospective licensee has to do in order to dispel any doubt is to inquire of the patentee whether the patentee believes its activities are within the scope of the patent. If the patentee says "no," it will have made a damaging admission that will make it very hard ever to litigate the issue, and thus will effectively end its licensing efforts. If it says "yes" or equivocates, it will have satisfied the court's test and will have set itself up for a declaratory judgment lawsuit.

Id. Judge Bryson also dismissed the majority's cryptic suggestion that ST could have avoided declaratory judgment jurisdiction by entering into a confidentiality agreement with SanDisk prior to negotiations. As he noted, no potential licensee who wants to maintain the possibility of declaratory judgment jurisdiction would be willing to enter into such an agreement, and would have no incentive to do so. Thus, *SanDisk* appears to make declaratory judgment jurisdiction available to a potential licensee whenever a patentee raises the possibility of a patent license.

Following right on the heels of the *SanDisk* decision, a different panel of the Federal Circuit allowed a generic drug company to bring a declaratory judgment action on unasserted (but Orange Book-listed) patents in

snippets

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Teva Pharms. USA, Inc. v. Novartis Pharms. Corp. In *Teva*, the court made it clear that it believed that *MedImmune* not only criticized the then-existing "reasonable apprehension of suit" test for declaratory judgment jurisdiction, but actually overruled it. Thus, the court looked at all of the circumstances to determine whether any potential injury to Teva was of "sufficient immediacy and reality to warrant the issuance of a declaratory judgment."

In *Teva*, Novartis had listed five patents in the Orange Book in relation to Famvir®, one on the basic drug compound and four on methods of use of the compound. After Teva filed an Abbreviated New Drug Application ("ANDA") to market a generic analogue of Famvir®, Novartis brought a lawsuit against Teva on only the patent on the active ingredient. Teva then filed a declaratory judgment action in an attempt to establish that it would not infringe any valid claims of the four method patents.

The majority identified four circumstances as establishing declaratory judgment jurisdiction: Novartis's listing of patents in the Orange Book, Teva's certification that it did not believe it infringed any valid claim of the listed patents, the statutory scheme that governs ANDAs, and Novartis's filing suit on the patent on the active ingredient in Famvir®. The court found that those four circumstances would create declaratory judgment jurisdiction as a matter of law. From the language and reasoning of the case, however, it appeared that not all four circumstances were required for declaratory judgment jurisdiction to exist. In discussing Teva's certification, which created a cause of action for Novartis, the court reasoned, "It logically follows that if such an action creates a justiciable controversy for one party, the same action should create a justiciable declaratory judgment controversy for the opposing party." Indeed, Senior Judge Friedman wrote separately to emphasize that he did not believe that any further analysis was needed past the first two circumstances. Once a patentee lists one or more patents in the Orange Book and an ANDA filer certifies that it does not believe it infringes any valid claim of those patents, declaratory judgment jurisdiction exists in his eyes.

The trend demonstrated by the Supreme Court's *MedImmune* decision and the Federal Circuit's application of that decision in *SanDisk* and *Teva* is clear: a patentee has very little ability to prevent potential infringers from invoking declaratory judgment jurisdiction. In the licensing context, such jurisdiction appears to exist as soon as negotiations begin and survives even the execution of a license. In the pharmaceutical field, the situation is even more difficult for patent owners; a generic drug company appears to be able to bring a declaratory judgment action on any generic drug it wishes to bring to market before the expiration of all Orange Book-listed patents. As a result, the federal courts may soon see an explosion of declaratory judgment cases from disgruntled and unsuccessful licensees and generic drug companies.

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Crafting the Cease and Desist Letter: *MedImmune*'s Impact on the Patent Owner

continued from p. 1

period in which its liability accrues. *SRI Int'l, Inc. v. Advanced Tech. Labs., Inc.*, 127 F.3d 1462, 1470 (Fed. Cir. 1997).

Actual notice that easily satisfies the statutory requirement is filing an infringement action in federal court. Damages begin to accrue immediately after filing. Absent such a lawsuit, problems with notice arise when other forms of communication are used to notify an accused infringer, specifically the ubiquitous "cease and desist" letter. The Federal Circuit, in *Amsted Indus. Inc. v. Buckeye Steel Castings Co.*, provided guidance as to the statutory requirement of actual notice, stating that mere "notice of the patent's existence or ownership" is not "notice of the infringement," and as such would be insufficient to comply with § 287(a). *Amsted Indus. Inc.*, 24 F.3d 178, at 187 (Fed. Cir.1994). The court concluded that "affirmative communication [to the alleged infringer] of a specific charge of infringement by a specific accused product or device" is required to comply with § 287(a). *Id.*

Defendants have tried to escape early notification by alleging lack of notice because the patent owner did not use the word "infringement," or that they invited the accused infringer to study the patent and to make their own determination of infringement, or that an offer to negotiate a license was made. These arguments failed. Indeed, arguing that notice was insufficient without an unqualified charge of infringement and a threat of suit was squarely addressed in *SRI Int'l, Inc. v. Advanced Tech. Lab.*, 127 F.3d 1462 (Fed. Cir. 1997). In *SRI*, the Federal Circuit stated that "[informing the alleged infringer] of the identity of the patent and the activity that is believed to be an infringement, accompanied by a proposal to abate the infringement, whether by license or otherwise" complies with the actual notice requirement of § 287(a). *Id.* at 1470. In other words, as long as the communication from the patent owner provides sufficient specificity regarding its belief that the recipient may be an infringer, the statutory requirement of actual notice is met. Thus, the requirement of "a specific charge of infringement" set forth in *Amsted* does not mean the patentee must make an "unqualified charge of infringement." *Id.*

Also, it is critically important that the entity providing the notice is the actual title owner of the patent at issue. This was recently addressed in *Lans v. Digital Equipment Corp.*, 252 F.3d 1320 (Fed. Cir. 2001), where the court adopted a bright line test that the notice must be an affirmative act by the actual patent owner. In doing so, the court rejected the application of "agency" or "control" principles to determine whether, notice by an affiliate, was sufficient. (*see also U.S. Philips Corp. v. Iwasaki Elec., Ltd.*, 2006 U.S. Dist. LEXIS 71276, 11-14 (D.N.Y. 2006) (a letter signed by a European parent company was found to be insufficient notice of a patent owned by the U.S. affiliate).

B. Willfulness Notice

Under 35 U.S.C. § 284, "court[s] may increase the damages [for patent infringement] up to three times the amount found or assessed." Although the statute does not state when such an increase is available, courts typically award enhanced damages upon a finding of willful infringement. Moreover, under 35 U.S.C. § 285, "court[s] in exceptional cases may award reasonable attorney fees to the prevailing party," and the Federal Circuit "has confirmed that a finding of willful infringement may qualify a case as exceptional under § 285." *Knorr-Bremse Systeme Fuer Nutzfahrzeuge GmbH v. Dana Corp.*, 383 F.3d 1337, 1347 (Fed. Cir. 2004). Thus, a showing of willfulness on the part of the alleged infringer can substantially improve a patent owner's damages award. Under the law of willful infringement, actual

snippets

Thus, the test for finding an actual controversy is a pragmatic one and cannot turn on whether the parties use polite terms in dealing with one another or engage in more bellicose saber rattling.

notice of another's patent rights triggers an affirmative duty of due care to avoid infringement. In contrast, constructive notice, as by marking a product with a patent number, is insufficient to trigger this duty. Once a patent owner established that a potential infringer has actual notice of its patent rights, a court must determine whether the potential infringer has satisfied its duty of due care to avoid infringement based on a totality of circumstances. *Id.* at 1342. Prior to the Federal Circuit's ruling in *Knorr-Bremse*, a major factor in that totality of circumstances determination was whether the potential infringer obtained competent legal advice from counsel. *Id.* at 1343. However, in *Knorr-Bremse*, the Federal Circuit found that court may not draw an adverse inference based on the potential infringer's failure to obtain competent legal advice. *Id.* at 1345-46. As such, patent owners may now need evidence of a potential infringer's willfulness that goes beyond a failure to obtain competent legal advice.

The standard for actual notice in a willful infringement context is much lower than what is required to trigger damages under 35 U.S.C. § 287(a). Actual notice requires that a patent must exist and one must have knowledge of it. Although direct communication in the form of written correspondence, such as a "cease and desist" letter, provides notice, even an informal conversation will suffice, such as a conversation with an alleged infringer's employees at a trade show or from a phone call with an alleged infringer. Indeed, even a general communication discussing a patent owner's rights without reference to the actual patents is sufficient to satisfy the actual notice requirement.

Indirect notice will also work. For example, a potential infringer may obtain actual notice from (1) the patent owner's advertising materials, such as displays at trade shows or product literature that refers to an issued patent, (2) through communication with a third party that has knowledge of the patent rights, or (3) during a review of literature relating to patents, such as the Official Gazette of the United States Patent and Trademark Office or trade journals.
In some cases, actual notice is found based on circumstantial evidence. For example, when a potential infringer cites the issued patent during the prior prosecution of its own patents, even though those patents were not directly related to the allegedly infringing product, or where evidence shows the potential infringer was aware of the product covered by the issued patent and also actively participated in the prosecution of a related foreign patent covering the product.

Providing notice that satisfies 35 U.S.C. § 287(a) clearly will satisfy that required under the law of willful infringement, thus maximizing the recovery of possible damages.

Be Wary of the DJ

Unless your company has an unlimited litigation budget, then you must consider the affects of providing too much (or the wrong type) of notice to an alleged infringer. A wrongly worded "cease & desist" letter can trigger the "actual controversy" doctrine allowing your competitor to assert DJ jurisdiction under 28 U.S.C. § 2201. Not only will you find yourself in an unwanted patent litigation, but you also may end up defending invalidity and unenforceability allegations in a venue that favors your competitor.

In general, the presence of an actual controversy within the meaning of the statute depends on whether the facts alleged, under all the circumstances, show that there is a substantial controversy between parties having adverse legal interests of sufficient immediacy and reality to warrant the issuance of a DJ. The Federal Circuit had developed a two-part inquiry to determine whether there is an actual controversy in suits requesting a declaration of patent non-infringement or invalidity. *EMC Corp. v. Norand Corp.*, 89 F.3d 807 (Fed. Cir. 1996). First, the plaintiff must actually produce or be prepared to produce an allegedly infringing product. Second, the patent owner's conduct must have created an objectively "reasonable apprehension" on the part of the plaintiff that the patent owner will initiate suit if the activity in question continues. This second prong, however, was recently rejected by the Supreme Court in *MedImmune v. Genentech*, 127 U.S. 764 (2007), in favor of a determination as to "whether the facts alleged, under all circumstances, show that there is a substantial controversy, between the parties having an adverse legal interests, of sufficient immediacy and reality to warrant the issuance of a declaratory judgment." *Id.* at 771. Moreover, the Court, relying on Article III of the Constitution, further required that the controversy must include an injury-in-fact. *Id.* In two very recent decisions, the Federal Circuit has followed *MedImmune* and dropped its "reasonable apprehension" test. In *Sandisk v. STMicroelectronics*, the Federal Circuit examined all the facts, including licensing meetings where ST presented a detailed infringement analysis, and concluded that a "substantial controversy" existed. Fed. Cir. Case No. 05-1300 3/26/07. Likewise, in *Teva v. Novartis* the Court found "a present injury sufficient for a justiciable controversy" existed based on Novartis suing Teva on one of its five patents listed in the Orange Book. Fed. Cir. Case No. 065-1181 3/30/07.

These recent cases clearly indicate that creating a substantial controversy does not require an express charge of infringement to a putative infringer and a threat of suit; rather, a substantial controversy may be
continued on p. 8

Crafting the Cease and Desist Letter: *MedImmune*'s Impact on the Patent Owner

continued from p. 7

triggered by subtler conduct if that conduct rises to a level sufficient to indicate intent on the part of the patent owner to enforce its patent. However, a patent owner's offer of a license, without more, is insufficient to establish the predicate for DJ jurisdiction. Looming in the background of any negotiation is the possibility of a lawsuit. Indeed, no patent owner would open negotiations by assuring the opposition that he does not intend to enforce his patent rights under any circumstances. The threat of enforcement is the entire source of the patent owner's bargaining power. But when the patent owner takes steps that create a reasonable apprehension that he will seek redress through the courts, the alleged infringer is not required to "bet the farm" and wait for the patent owner to decide when and where to sue, but can take the initiative and seek declaratory relief. Thus, the test for finding an actual controversy is a pragmatic one and cannot turn on whether the parties use polite terms in dealing with one another or engage in more bellicose saber rattling. The Court will look to the substance rather than form because in many instances the parties are sensitive to the prospect of a DJ action and couch their exchanges in terms designed either to create or defeat DJ jurisdiction.

Walking the Line

The challenge then is to draft a "cease and desist" letter to provide "actual notice" for maximizing damages, but that avoids creating an "actual controversy" that can lead to an unwanted DJ action. The Federal Circuit indicates this is possible.

The criteria for actual notice under § 287(a) are not coextensive with the criteria for filing a declaratory judgment action. These statutory purposes are distinct, serve different policies, and are governed by different laws. The requirement of actual notice under § 287(a) is designed to assure that the recipient knew of the adverse patent during the period in which liability accrues, when constructive notice by marking is absent. Actual notice may be achieved without creating a case of actual controversy in terms of 28 U.S.C. § 2201. *SRI Int'l, Inc.* at 1470. With this in mind, here are some guidelines to follow in preparing "cease and desist" letters to your competitors:

• Identify your patent clearly by number and issue date, and always enclose a copy. State that the competitor "might be interested in learning about the patent."
• Identify the suspect product(s) by make and model without making reference directly to your patent - do not use the "I" word. Use language such as "we believe your company manufactures and/or sells the model XXX widget."
• Do not accuse the competitor of infringement either directly or indirectly. Instead consider asking the competitor to "evaluate the relevance of the patent to its products." Likewise, make vague references that the competitor "may wish to investigate" whether its products are "covered by" or "fall within" the patent.
• Do not threaten litigation or give ultimatums. Do not mention filing suit in Federal Court, let alone that you will file in a particular venue. Likewise, do not cite to case law, the patent statute or other legal authorities.
• Do not explicitly request damages. Instead suggest that you would like "an accounting of past sales if they determine that the patent is relevant to their products."
• Offer to negotiate a license under the patent.

Although the above suggestions may help to avoid a DJ lawsuit, you must still take into account your company's past actions in dealing with such matters. Despite the wording of the "cease and desist" letter, past aggressive and litigious behavior towards competitors may cause a court to agree that there indeed exists a "substantial controversy."

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E-Discovery FAQ Part I

On December 1, 2006, proposed amendments to the Federal Rules of Civil Procedure relating to electronic discovery went into effect. In this first part of a two-part series, we provide a brief FAQ regarding the impact of the amendments on pre-litigation planning. Part Two will address the conduct of discovery in both future and existing litigation.

Q: Do the amendments apply to my existing case?

A. While the amendments apply to each case filed on or after December 1, 2006, they are also to be implemented to the extent practicable in existing cases.

Q. Can you summarize the amendments for me?

A. The amendments have created a "new" and distinct category of information to be addressed during discovery: "electronically-stored information" or "ESI." Although ESI has been a major part of discovery in the past 20 years, and both litigants and courts have dealt with ESI within the scope of the pre-existing rules (indeed some jurisdictions have implemented their own specific local ESI rules), the Rules Committee has now officially separated ESI, in large part to recognize that "[ESI] has important differences from information recorded on paper." Report of the Civil Rules Advisory Committee to the Committee on Rules of Practice and Procedure of the Judicial Conference of the United States at 18 (May 27, 2005), available at http://www.uscourts.gov/rules/Reports/CV5-2005.pdf.

Q. So exactly what is ESI?

A. When the concept of electronically stored information arises, most people tend to think of e-mail, word processing documents and spreadsheets. However, many people fail to consider the full range of either types of documents or sources for those documents. Table 1 lists examples of traditional types and sources of documents, as well as some that may not originally come to mind.

Table 1 : Types and Sources of ESI

Types of ESI	Sources of ESI
Word processing documents	Network drives
E-Mail	Personal computer hard drives
Spreadsheets	Portable Media
Databases	CD/DVD
Media files (video/audio files, etc.)	Portable hard drives
Voice mail	CF/SD/MMC cards
Temporary files	USB drives
Fragmentary files	Current backup media
	Tapes
	Zip disks
	Legacy media[ii]

The rules contemplate two types of ESI: accessible and inaccessible. The majority of discovery will focus on accessible ESI, while the parties have more leeway to object to the review and/or production of inaccessible ESI. Inaccessible data is typically limited to that data which is intended purely for disaster recovery purposes, or is associated with outdated software to which a company no longer has access.

Q. Why does ESI need its own category?

A. Among the issues that make ESI unique are: (1) the volume of ESI, (2) the dynamic nature of ESI (*e.g.* the ability to alter files), (3) the fact that ESI often contains "metadata," or data about data, (4) the fact that ESI may only be useful when tied to a particular piece of software or computer system, (5) difficulties in dealing with deletion or destruction of ESI, and (6) the sheer cost of reviews and productions.

Q. Do the amendments clarify my obligations with respect to ESI production?

A. Not really. While the rules do provide some specific procedures, the drafting of the amended rules left something to be desired, namely certainty. The amendments use language such as "reasonably accessible," "undue burden or cost," "good cause," and "good faith routine operation," without providing any guidance as to the definition or parameters of these terms. Thus, we are likely to see a continually growing body of inconsistent and far-ranging case law, building on the seminal *Zubulake* line of cases, attempting to address these issues. However, there are steps any litigant can take to provide evidence that its actions were taken in good faith – the linchpin of the sanctions analysis.

Q. So what is the first thing I should do as a result of the new rules?

A. Please see Table 2 on Page 11 for a general outline of steps to take in addressing ESI discovery. First, we recommend that

continued on p. 10

E-Discovery FAQ

continued from p. 9

in-house counsel take the time to learn about their company's ESI, in terms of sources, volumes, and procedures - conduct an IT audit. We also recommend that outside counsel take the time now to learn their clients' systems. The more pre-planning that is done, the lower the overall costs are likely to be in the long run, and the better able a company will be to make an ESI production without either inadvertently producing privileged documents or running afoul of the sanctions provisions of the rules.

In addition, companies should ensure that they have a comprehensive records management policy (lovingly known as the document retention policy) in place. The existence of a valid policy, entered into for valid reasons, and which is effectively policed, will provide evidence of good faith behavior in the event a litigant is faced with a motion for sanctions for spoliation of ESI. Unfortunately, it is inadvisable to attempt to provide, for lack of a better word, a "stock" document retention policy. Due to the unique needs and capacities of each given business, there is simply no useful "one size fits all" policy.

Among the primary considerations in-house counsel should scrutinize when drafting or revising the document retention/destruction plan are:

1. Are there any existing policies within the organization, and if so, are they still in effect or appropriate?
2. What are the controlling regulatory requirements (U.S., international, and in the home jurisdiction of the company if outside the U.S.) with respect to document retention?
3. What types of information should be covered, and what are the appropriate methods for dealing with each type of information - should there be a central repository for management meeting minutes; should there be a specific policy on the use of e-mail?
4. How long should each type of information be retained?
5. Who is in charge of overseeing implementation of the policy? IT? Legal?
6. Who is in charge of policing the policy?
7. What are the provisions for suspending various aspects of the policy in the event of a litigation hold?

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A party that does not elect to implement a litigation hold will not be able to avail itself of the safe harbor provisions of Rule 37 in response to a sanctions motion.

Policing of the policy will be of primary importance in the context of a sanctions motion. The persons/departments with primary responsibility for implementation and enforcement of the policy should document all steps taken to police the policy, especially in the event of a litigation hold in order to place the litigant in the best possible position for obtaining safe harbor from sanctions.

Q. Now I've been sued, or I'm about to file a lawsuit. What do I need to do?

A. A party's duty to preserve documents arises as soon as the party knows or should know about litigation, or if litigation is reasonably anticipated in the future. Thus, a litigation hold should be put in place as soon as possible after a party becomes reasonably certain that litigation is on the horizon. A party that does not elect to implement a litigation hold will not be able to avail itself of the safe harbor provisions of Rule 37 in response to a sanctions motion. Parties should periodically reissue the litigation hold to all relevant employees so that new employees are also aware of it, or so that employees identified through discovery as having relevant information are aware of it.

In implementing a litigation hold, parties should address the following:

1. Identify the "key players" – this list should be as comprehensive as possible; late identification of persons who the litigant should have been aware were relevant to the issues of the case at the onset of litigation will be factored against the litigant in future sanctions motions.
2. Contact IT personnel about the litigation hold.
3. Organize a team of point persons in each department to oversee compliance with the litigation hold.
4. Document the steps taken to implement and police the litigation hold.

In Part II of this article, we will address issues related to the conduct of discovery, including the initial case management conference, forms for production of ESI, cost-shifting, inadvertent disclosure of privilege, and sanctions.

Table 2: Practice Pointers for Handling ESI Discovery
1. Conduct an IT audit: Get to know your IT infrastructure, including key personnel who can assist with locating and identifying electronically stored information.
2. Develop or update your document retention policy: If you don't already have a document retention policy, implement one immediately; if you do, make sure it effectively addresses the rules changes. Retention policies should be governed by a rule of reasonableness–one size does not fit all. Any policy should contain procedures for cessation of document destruction in view of anticipated litigation ("the litigation hold").
3. Ensure compliance with the document retention policy: Once a retention policy is in place, conduct and document regular compliance checks. Your retention policy is only as good as its enforcement.
4. Develop a plan of action for future litigation: Because the new rules provide limited time to ascertain the location of any relevant information, prepare a plan that uses point personnel in each department to act as discovery liaisons. The plan should also identify the location of all of the company's ESI.
5. Properly implement litigation holds: Once litigation is anticipated or occurs, put in place a litigation hold immediately that directs relevant employees not to destroy information. Consider deactivating automatic destruction routines such as cyclic backups. Reissue the hold periodically so that new employees are aware of it. For key players in the litigation, set up meetings to discuss the litigation hold directly with them.

Table 3: Selected Additional Resources
• The Sedona Guidelines: Best Practices Recommendations & Principles for Addressing Electronic Document Production (Jul. 2005), available at www.thesedonaconference.org
• The Sedona Guidelines: Best Practices & Commentary for Managing Information & Records in the Electronic Age (Sep. 2005), available at www.thesedonaconference.org.
• Brian R. Harris, Caveat Sender: What Else Is Attached to Your E-Mail?, snippets, vol. 2, issues 1 and 2, available at mbhb.com/snippets
• ISO Standard 15489-1, Information and documentation – Records management – Part 1: General (1st ed. Sep. 15, 2001)
• ISO Technical Report ISO/TR 15489-2, Information and documentation – Records management – Part 2: Guidelines (1st ed. Sep. 15, 2001)
• The *Zubulake v. UBS Warburg LLC* line of cases: 217 F.R.D. 309 (S.D.N.Y. May 13, 2003); 230 F.R.D. 290 (S.D.N.Y. May 13, 2003); 216 F.R.D. 280 (S.D.N.Y. Jul 24, 2003); 2003 U.S. Dist. LEXIS 18771 (S.D.N.Y. Oct 22, 2003); 229 F.R.D. 422 (S.D.N.Y. Jul 20, 2004); 231 F.R.D. 159 (S.D.N.Y. Feb 03, 2005); 382 F.Supp.2d 536 (S.D.N.Y. Mar 16, 2005).

Endnotes:

i This article was adapted from a continuing legal education seminar entitled "ESI: Electronically Stored Information, e-Docs and Forensics in the 'New' e-Discovery Era," presented at the offices of McDonnell Boehnen Hulbert & Berghoff LLP on November 1, 2006 and subsequently to the Association of Patent Law Firms on February 8, 2007. The presentation materials and a recording of the APLF presentation are available at http://www.mbhb.com/snippets/.

ii Legacy data is ESI created by older systems no longer in use, and which typically cannot be easily read by existing systems.

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Trademark Infringement by Web Page Metadata

Over the last fifteen years, the Internet has evolved from an academic curiosity to a gold rush-style boom town to a vital part of the economy. As commerce on the Internet has grown in importance and diversity, trademark doctrines have adapted to address the various uses of marks on the Internet. This article explores one such use: the use of trademarks in web page metadata.

Even the most casual Internet user knows that a Web page consists generally of text, images and hyperlinks displayed in a Web browser. However, this data is just the tip of the iceberg; a Web page also includes a host of invisible information embedded in the HTML that codes for the page. This "metadata" can identify, for example, a description of the page, relevant keywords, and text set off as titles and section headings. Notably, in the late '90s and early '00s, search engines relied heavily on metadata to find and rank pages in their search results. Web page authors soon learned that the inclusion of trademarks in metadata could vastly improve placement in search results, and therefore bring more Web traffic and more revenue.

The seminal case addressing the use of another's mark in Web page metadata is *Brookfield Communications v. West Coast Entertainment*, 174 F.3d 1036 (9th Cir. 1999). Brookfield was the maker of "MovieBuff" movie database software. West Coast, a video rental store chain, used Brookfield's trademark "moviebuff" in metadata on its moviebuff.com Web page, which also included a movie database. The Ninth Circuit noted that a finding of trademark infringement requires a likelihood of confusion by consumers, and that once a consumer arrived at West Coast's site, he or she would not be confused as to the source of the services advertised by the site. Instead of relying on confusion at the time of sale, the court recast the inquiry to focus on "initial interest confusion"—that is, whether a user would be confused when initially accessing the page. In determining whether there existed initial interest confusion, the court simplified the traditional multi-factor

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Courts have carved out a fair use defense, which allows the nominative use of a mark in metadata to identify and catalog a Web page. To qualify for the nominative fair use defense, the product or service related to the mark must not be readily identifiable without the use of the mark, only so much of the mark may be used as necessary to reasonably identify the product or service, and the user must do nothing to suggest sponsorship or endorsement by the mark holder.

likelihood of confusion test and honed in on the similarity of the marks, the relatedness of the products and services the marks accompany, and the parties' simultaneous use of the Internet for advertising. The court analogized to a roadside billboard leading consumers off of the highway to a competitor's store with a false promise of the mark holder's goods, and found that the defendants misappropriated the plaintiff's goodwill by diverting consumers to its site by using the mark.

Courts have widely followed *Brookfield* to find trademark infringement based on initial interest confusion in cases where they detect "free riding" by a Web page owner on another's mark in order to draw traffic. For example, when Tdata used its competitor ATP's marks in its web page metadata to pull consumers to Tdata's web site, the court held on summary judgment that Tdata's use infringed. *Tdata v. Aircraft Technical Publishers*, 411 F. Supp. 2d 901 (S.D. Ohio, 2006). In *Flow Control Industries v. AMHI*, 278 F. Supp. 2d 1193 (W.D. Wash. 2003), the defendant used the SKOFLO mark in its metadata "in such a way as to divert people looking for SKOFLO products to the A&H website, thereby improperly benefiting from the goodwill that plaintiff developed in its mark."

The Tenth Circuit relied on initial interest confusion to hold that an unauthorized reseller of tanning lotions infringed a lotion maker's mark when it included the mark on its Web site and in its metadata. *Australian Gold v. Advanced Technology Systems*, 436 F.3d 1228 (10th Cir. 2006). Similarly, sellers of grey market flea control preparations could not lawfully use the ADVANTAGE mark in their web page metadata. *Bayer Healthcare v. Nagrom*, 2004 U.S. Dist. LEXIS 19454 (D. Kan. 2004). All in all, at least seven circuits have explicitly relied upon the initial interest confusion doctrine, and none have discredited it. Nevertheless, courts differ wildly on the exact form the initial interest confusion analysis is to take. Some import it into the confusion and/or intent factors or use it as a separate factor of the traditional multi-factor test; others develop separate multi-factor balancing tests; and still others forego in-depth analysis, apparently implying that any use of a mark in metadata is likely to cause initial interest confusion. The usual remedy is injunctive relief; for monetary damages, the necessary showing of damage caused by actual confusion may be too difficult for plaintiffs to prove. *See, e.g., Oyster Software v. Forms Processing*, 2001 U.S. Dist. LEXIS 22520 (N.D. Cal. 2001).

There are, however, many situations in which use of a mark in metadata may not infringe. Courts have carved out a fair use defense, which allows the nominative use of a mark in metadata to identify and catalog a Web page. To qualify for the nominative fair use defense, the product or service related to the mark must not be readily identifiable without the use of the mark, only so much of the mark may be used as necessary to reasonably identify the product or service, and the user must do nothing to suggest sponsorship or endorsement by the mark holder. When former Playmate of the Year Terri Welles used "playboy" and "playmate" in the metadata on her Web site, the use was fair; however, she could not use the "PMOY '81" motif in the wallpaper of the page. *Playboy Enterprises v. Welles*, 279 F.3d 796 (9th Cir. 2002).

Nominative fair use may also be available to users selling replacement parts for marked goods, advertising an affiliation with the mark owner, or using a Web page to criticize the marked goods or services. See, *e.g., Bihari v. Gross*, 119 F. Supp. 2d 309 (S.D.N.Y. 2000); *Trans Union LLC v. Credit Research, Inc.*, 142 F. Supp. 2d 1029 (N.D. Ill. 2001); *Bijur Lubricating v. Devco Corp.*, 332 F. Supp. 2d 722 (D.N.J. 2004). However, courts will police overuse of the mark. For example, while a Web site criticizing a competitor's actions could lawfully use the competitor's mark, the court held that using it seventy-five times as a keyword was outside the bounds of nominative fair use. *J.K. Harris & Co. v. Kassel*, 2002 U.S. Dist. LEXIS 7862 (N.D. Cal. 2002). Courts appear to look chiefly for whether the accused infringer was acting in good faith or rather trying to unfairly benefit from the mark.

While courts appear comfortable with the initial interest confusion doctrine as applied to trademark use in metadata, commentators are far less so. The main purpose of trademark law is to protect consumers from confusion, and in cases of initial interest confusion, the consumer is likely confused only for an instant, if at all. In effect, a finding of infringement by initial interest confusion arguably gives the mark holder a broader, more purely property-like right than the Lanham Act contemplates. In situations where real damage is done to the value of the mark, dilution may be a more appropriate tool to provide relief. The billboard metaphor upon which the doctrine is largely based is also imperfect. Commentators have argued that use of a competitor's mark in metadata is not strictly analogous to luring consumers off of the highway because in the Internet context it is much less difficult to reverse the error; a single mouse click will return the consumer to the search results. A more fitting analogy may be competing products placed together on a shelf; consumers can easily jump back and forth between products to compare prices and features. Forbidding Internet advertisers from making their sites more easily searchable using competitors' marks may make it much more difficult for consumers to find product information in order to make an intelligent purchasing decision, thereby reducing competition, harming consumers and hindering the societal benefits provided by trademark law. See generally Jennifer E. Rothman, *Initial Interest Confusion: Standing at the Crossroads of Trademark Law*, 27 Cardozo L. Rev. 105 (2005); Michael Grynberg, *The Road Not Taken: Initial Interest Confusion, Consumer Search Costs, and the Challenge of the Internet*, 28 Seattle Univ. L. Rev. 97 (2004).

Even as similar cases are still wending their way through the courts, the use of metadata to manipulate search results appears to be on the wane. Most major search engines have greatly reduced the weight given to metadata in ranking search results, in no small part to stop manipulation by unscrupulous operators. Even though the facts of the metadata cases soon may not directly apply, their holdings remain instructive. In the metadata context, earlier cases set forth a seemingly rigid set of rules, and later cases used good faith and fairness ideals to provide an outlet for some, if not all, socially beneficial uses. When dealing with the rapidly-changing realities of the Internet, courts will likely continue to rely on the twin pillars of doctrinal rigidity and equitable flexibility to balance certainty with fairness in their results.

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mbhb News:
New Faces!

MBHB is proud to announce that Michael H. Baniak, Michael D. Gannon, Christina L. Brown, and Gary E. Hood have joined as partners, along with patent agent Steven B. Courtright. All are from the Baniak Pine & Gannon law firm.

Michael H. Baniak is a leading IP trial attorney, having handled more than 150 lawsuits involving patents, trademarks, trade secrets, copyright, and unfair competition. His work also includes patent, trademark, and copyright prosecution, licensing, and counseling. Mr. Baniak has taught Patent Law and Copyright Law courses at Northwestern University School of Law since 1986. He holds a J.D. from Indiana University School of Law and a B.S. in Physics from the University of Dayton.

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