

PIPLA NEWS

The official newsletter of the Pittsburgh Intellectual Property Law Association

RALPH CINDRICH TO SPEAK AT JANUARY PIPLA MEETING

The Program Committee is excited to announce that Mr. Ralph E. Cindrich will address the PIPLA membership on January 21st at the Engineer's Society. Mr. Cindrich, a licensed attorney, founded Cindrich & Co. Athlete Management, in 1977 after retiring from the NFL following a pro career with the New England Patriots and the Houston Oilers. Since then, the fifth-round draft pick from the University of Pittsburgh, has made *The Sporting News*' "100 Most Powerful" list stating that he is "one of the Top 100 Most Powerful people in all of sports, one of the most influential agents in the NFL." His other accolades include recognition from the USA Today, Pro Football Weekly, The Denver Post, The Chicago Times, The Dallas Morning News and others.

In 2006, Cindrich and Co. merged with DeBartolo Sports and Entertainment to become one of the nation's most powerful and influential athlete management and hospitality companies, headquartered in Tampa with regional offices in Pittsburgh, Los Angeles, and Columbus.

The January meeting will begin with cocktails at 5:00 p.m. and dinner at 5:45 p.m. followed by Mr. Cindrich's remarks on representing sports and media clients.

U.S. CHAMBER OF COMMERCE ISSUES SUGGESTIONS FOR PTO IMPROVEMENT

Matt Johnson, Jones Day

On December 23rd, the U.S. Chamber of Commerce released its "Recommendations for Consideration by the Incoming Administration Regarding the U.S. Patent and Trademark Office" detailing issues faced by the Office and a number of suggestions to the incoming Obama

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administration. Among challenges faced by the PTO in 2009 are a 750,000-application backlog awaiting a first action that continues to worsen; the possible increase in PTO responsibilities by Congress through patent reform legislation; and directing more than 9,000 employees, many with less than five years examining experience, in an information technology-driven work environment.

	Budget (\$ millions)	Patent Examiners	New Applications Filed	Total Backlog	Average Pendency Time (in months)
1988	\$144	1,540	148,000	268,000	20
1998	\$567	2,590	240,000	481,000	24
2008	\$1,915	5,960	463,700	750,600	32

The Chamber's report notes the dramatic changes that have befallen the Office over the last 20 years and that "despite the best efforts of the PTO's patent examination and support staffs, prevailing perceptions within the patent community are that the quality of patents issued is declining at a precipitous rate." The report describes a number of proposals that include:

Improving Patent Quality

The Chamber of Commerce lists a number of ideas for improving patent quality. Among these, the report suggests pre-search and/or pre-first-action interview opportunities between examiners and applicants as well as fee incentives for participation in these programs. A pre-search interview may give an examiner a better idea of the background of the invention, differences between the invention and known prior art, and important features of the claims and how the claims relate to the invention. A pre-first-action interview would give the applicant an opportunity to review prior art discovered in an initial search by the examiner. The interview would allow both sides to discuss their thoughts on the patentability of the claims with actual art in hand. Additionally, the applicant would be given the opportunity to abandon the application at this point with a refund of some or all of the examination fees.

The Chamber report also discusses internal Office examination quality metrics and their transparency to the public. It is currently understood that the PTO focuses mainly on allowed applications and whether allowed claims should have been rejected. The report suggests a new quality metric that includes a review of both allowed applications and advanced rejections with a focus of the quality of prior art and application of case law without striving for an artificial allowance rate. The report posits that “[s]uch focus harms applicants by removing or delaying patent rights and apparently stifles business and the economy.” In developing a new quality measurement standard, the “PTO should work with the user community to create a new quality metric that better reflects the overall quality of U.S. patents.”

Additional suggestions for quality improvement include: increased examiner training, expansion of the peer-to-patent program, a review of restriction practice, improved prior art search tools, and better enforcement of 35 U.S.C. § 112 requiring that claims be adequately supported by the specification.

Providing Adequate Resources

The report also makes suggestions for providing adequate search and examination resources to deal with the ever increasing application backlog. The report notes that from 1991-2003 over \$750

million in fees was withheld from the PTO and diverted to other agencies through appropriation bills, which limited hiring “resulting in a critical deficiency of experienced, well-trained examiners today.” In addition to a strong suggestion of refraining from any additional fee diversion, the Chamber’s report suggests raising fees as necessary to facilitate more hiring and training. The report cites an apparent willingness of applicants to pay such increased fees if tangible benefits in examination quality and application pendency are achieved.

Reforming the Examiner Production System

The U.S. Chamber of Commerce report is also highly critical of the current PTO policies regarding examiner productivity. Currently, examiners are rated in part based on a production score, where credits are given for first Office actions and disposals through allowance, abandonment, or Requests for Continued Examination (RCEs). Examiners are expected to garner a certain number of credits each bi-week based on the Examiner’s experience and technology area. The report is critical of the current production system in that it has remained largely unchanged over the last 40 years despite huge changes in the technology being examined as well as the technology available to examiners for searching and other examination tasks.

The report makes a number of suggestions including reexamination of production goals for each Office art unit based on the complexity of the technology being examined. The report also suggests reducing the credit for continuation applications while offering more time for examining new cases. The report further states that the Office should more aggressively leverage the work done in companion applications in other countries, relying more heavily on search reports and Office actions from other IP entities as main sources of prior art to be applied.

Other Suggestions

The Chamber of Commerce details a number of other ideas throughout its 34 page article. Other suggestions include improving the timeliness of administrative actions, strengthening the PTO’s relationship with the user community, enhancing

organizational management, appointing a well-qualified undersecretary and director, improving examiner retention, deferred examination, and others. The full article may be retrieved from the U.S. Chamber of Commerce's Global Intellectual Property Center website at:

<http://www.theglobalipcenter.com>

USPTO ANNOUNCES DELAY OF EFFECTIVE AND APPLICABILITY DATES OF NEW BPAI RULES

In the December 10, 2008, Federal Register, the USPTO published an announcement noting that the final rules relating to practice before the Board of Patent Appeals and Interferences (BPAI) in ex parte appeals will not take effect on December 10 as originally scheduled. New effective and applicability dates will be identified in a subsequent announcement.

In the interim, the USPTO will continue to accept appeal briefs in either the current format or the new format.

NEWS AND NOTES

Ryan J. Miller Named as an Associate at The Webb Law Firm

Ryan J. Miller has recently been promoted to associate at The Webb Law Firm. In 2004, Mr. Miller joined The Webb Law Firm as a patent agent with B.S. degrees in electrical engineering and economics from Duke University. Mr. Miller received his J.D. degree Cum Laude from the Duquesne University School of Law, where he was a member of the Duquesne University Law Review. Earlier in his career he served as a patent examiner for the United States Patent and Trademark Office. Working in an analytical art unit that specialized in medical imaging and digital watermarking, he was responsible for researching patent applications in the art of image processing to ensure that applications and claimed inventions met applicable patent statutes and rules in all phases of patent prosecution.

Mr. Miller holds B.S. degrees (2002) in electrical engineering and economics from Duke University, as well as a J.D. (2008) from Duquesne University School of Law. He is a member of the Pennsylvania bar and is registered to practice before the U.S. Patent and Trademark Office.

Daniel H. Brean Joins The Webb Law Firm as an Associate

Additionally, Daniel H. Brean has recently joined The Webb Law Firm. Formerly the Lead Articles Editor of the Pittsburgh Journal of Technology Law and Policy, his works of legal scholarship have been published in leading intellectual property and technology law journals in the United States. He has also been cited as an authority on design protection in a recent report by the Congressional Research Service, a Federal Agency designed to educate and assist members and committees of Congress in their legislative duties.

Mr. Brean holds a B.S. degree (2005) in physics from Carnegie Mellon University, as well as a J.D. (2008) from the University of Pittsburgh. He is a registered member of the Pennsylvania bar and is registered to practice before the U.S. Patent and Trademark Office.

TRADEMARK FUN

2009 TRADEMARK EXPOS SET FOR MAY 8-9

The USPTO is bringing back the Trademark Expo after a 10-year hiatus to illustrate the value of protecting brand names in the increasingly competitive global marketplace. The Trademark Expo will focus on educating the public about the value and important role trademarks play in our society and the global marketplace. The USPTO will also be showcasing its new campus and the impact of the electronic filing and processing of trademark applications.

The Expo will include themed displays, company booths, costumed characters and much more. Exhibit themes could include, but are not limited to: celebrity trademarks, trademarks identifying products often subject to counterfeit, unusual trademarks (sound, scent, color, configurations, motion marks, etc.), certification trademarks,

trademarks commonly mistaken as generic, the breadth of trademarks used by one source, the evolution of certain trademarks, people behind the names of trademarks, 100 year old trademarks, and interesting stories about trademarks and their creation.

The expo will be held at the USPTO's headquarters in Alexandria, Virginia, at 600 Dulany Street, Alexandria VA. It is a two-day event that will be held from on Friday, May 8 and Saturday May 9 from 9 a.m. to 5 p.m. The event will be free and open to the public.

USPTO TRADEMARK SOUNDEX

The USPTO website includes a collection of over 100 trademarked sounds on its Kids' Pages that teach future IP gurus that trademarks may encompass more than just drawings that can be captured on paper. The collection includes many readily recognizable recordings and blasts from the past.

Popular entries include the NBC Entertainment Chimes, the AOL "You've Got Mail" effect, the ESPN SportsCenter six note intro, Homer Simpson's "Doh!", the LUCASFILM Entertainment THX logo theme, and many others.

Check them out at:

<http://www.uspto.gov/go/kids/kidsound.html>

THE CUTTING EDGE

In The Cutting Edge, we break down the best of the best pending patent applications and recent patent grants to give you a preview of the next great invention that is coming soon to your neighborhood. For example...

Method for Introducing a Powdered Substance into a Nostril

(U.S. Patent No. 6,811,543)

A trans-European group from Denmark and Spain has recently patented a method for introducing a powdered or particulate substance to a mucous membrane in a nostril. The patented method is considered very useful for application of a substance or vaccine against allergic reactions, an

antihistamine, or "a suitable dose of any kind of a suitable type of an active substance."

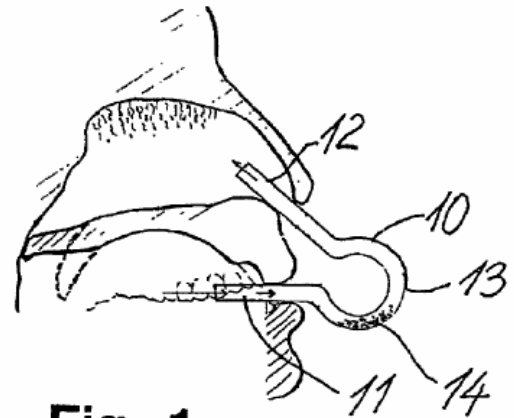


Fig. 1

The patented method utilizes a straw type member which is inserted simultaneously into the nose and mouth. The powdered substance may then be disbursed to the nasal cavity by blowing into the mouth-end of the straw. The invention takes advantage of a biological mechanism where:

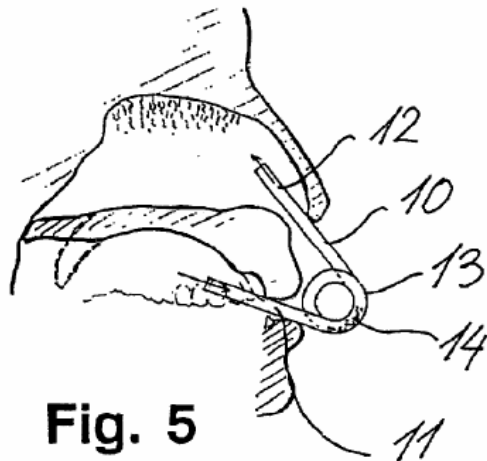
a user will automatically close the connection between the nostrils and the throat by the uvula when blowing. Therefore, the powdered or particulate substance is substantially prevented from penetrating into the user's trachea and gullet. Therefore, by using the method according to the invention almost the total amount of the substance blown into the nostril is applied to the mucous membrane within the nostril.

In a preferred embodiment the applicator straw contains a reservoir where the powdered substance may reside in preparation for application. This reservoir may also act as an air restriction, encouraging a user to blow hard enough to achieve a proper and even dispersion of the powdered substance to the mucous membranes in the nostril.

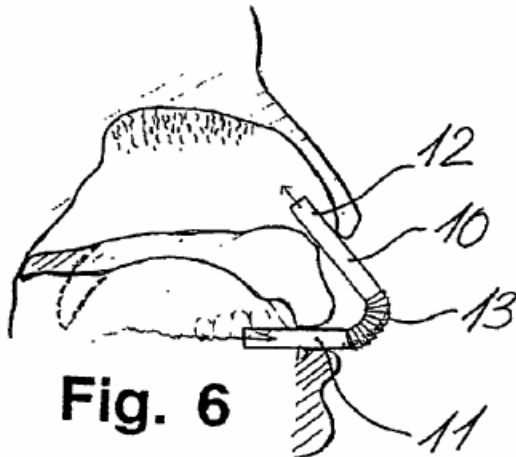
The patent details a number of straw configurations that promise to offer marked improvement in powdered substance – nostril application.

FROM THE NEWSLETTER COMMITTEE

We hope you've enjoyed this issue of the 2008/2009 PIPLA News, an informative and hopefully entertaining look at the goings on in IP law. We invite our entire readership to contribute to this endeavor with articles, announcements, and job postings of your own. If you have something you would like included in PIPLA News or have questions about how you can contribute, please contact Matt Johnson at 412-394-9524 or at mwjohnson@jonesday.com.

**Fig. 5**

The Loop-De-Loop

**Fig. 6**

The Bendy Straw

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