



## CALENDAR

### SAVE THE DATE

----February 28, 2014----

Mock Oral Argument (CLE)  
followed by the  
Second Annual Intellectual  
Property Gala Honoring  
Members of the Judiciary

*with special musical guest  
--De Novo--*

High Museum of Art  
Atlanta, GA  
4pm – 10pm (hard stop)  
(click [here](#) for registration)

----September 18-21, 2014----

The 20th Annual IP Institute  
Omni Amelia Island Resort

contact Brad Groff,  
IP Section Chair-Elect  
at  
[bgroff@gardnergroff.com](mailto:bgroff@gardnergroff.com)  
for more information

----October 13, 2014----

The CIP CUP®  
2014 Charity Golf Event

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GA Lawyers for the Arts  
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## Message from the Chair

Dear IP Section Members:

We have started 2014 with a flurry of Section activities. The start of the calendar year, however, finds us more than halfway through the Bar year. Thus, we are simultaneously sprinting to the finish line and preparing to take our places for next year's race.

The Section hosted two official events in January. The Litigation Committee hosted a panel discussion on January 21<sup>st</sup> regarding accounting experts in intellectual property litigation. Several accounting experts discussed a variety of relevant topics, including how to optimize their role in intellectual property litigation. The panel included Ronen Arad of PWC; Michael Blake of Habif, Arogeti and Wynne; and Denise T. Dauphin of the AEA Group.

The Philanthropy and Community Outreach Committee participated in hosting a presentation by Sue Purvis of the United States Patent and Trademark Office on January 22<sup>nd</sup>. Ms. Purvis discussed the patent pro bono initiative and its implementation across the country. About twenty Section members and members of the pro bono community attended her presentation.

Behind the scenes, the Section has been equally active. We are hard at work preparing for the 2014 Intellectual Property Gala honoring the Judiciary, which will be held at the High Museum on



February 28<sup>th</sup>. We will begin the event at 4:00 with a mock oral argument before Chief Judge Rader and Judge Prost of the U.S. Court of Appeals for the Federal Circuit. For purposes of the oral argument, the AIPLA is kindly allowing us to use the problem from the past Giles Sutherland Rich Memorial Moot Court Competition. Jeff Blake of Merchant & Gould and Courtland Reichman of McKool Smith will argue on behalf of the appellant and appellee, and Courtney S. Alexander of Finnegan Henderson will moderate. Following the oral argument, we will begin a cocktail reception at 5:30, sponsored by Robins, Kaplan, Miller & Ciresi. We will follow the cocktail hour with a seated dinner and entertainment, which will begin at 6:30. While Chief Judge Rader and his band De Novo provide musical entertainment, self-guided tours are available for the High Museum's exhibit: *Go West! Art of the American Frontier from the Buffalo Bill Center of the West*. Invitations have

been sent to members of the federal judiciary, and we expect a number of federal judges to join us for the evening. Registration for the mock oral argument and CLE credit and for the cocktail hour and dinner is now open at the IP Section website. The cost for the CLE is \$35.00. The cost for the cocktail reception and dinner is \$100.00 per plate or \$1,000.00 for a table for 10. Additional sponsors for the event include the Atlanta Bar IP Section, the Atlanta IP Inn of Court, Finnegan Henderson, Kilpatrick Townsend, McKool Smith, Merchant and Gould, Alston & Bird, and King & Spalding. If you are interested in sponsoring the event, please let me know. Additional details are available on the IP Section website under the Special Events tab.

At the Gala we will recognize the federal judiciary, but we will also announce the winner of our first Section scholarship. The scholarship will be awarded to a student attending a Georgia law school who has shown an affinity for intellectual property. The scholarship will be awarded in honor of Section Treasurer Brent Bellows' wife, Dr. Amy Bennett Bellows, who passed away suddenly in November. A scholarship for a deserving student seems a fitting way for the Section to honor Amy, who had a lifelong commitment to education.

We have already received a number of applications for the scholarship. However, if you know of deserving students, please encourage them to apply. You can contact either Brent Bellows or me for additional details.

In addition to planning for the 2014 Intellectual Property Gala and the scholarship, we continued to work on various Committee events. We are also beginning to formalize the details for the next IP Institute. The IP Institute will be held September 18-21, 2014 at the Omni Amelia Island Plantation Resort in Amelia Island, Florida. Please save these dates on your calendar and make plans now to attend.

As we are over halfway through the Bar year, we now announce the new nominees for officer positions. Suzanne Werner of Alston & Bird has been nominated as Section Treasurer, Brent Bellows as Section Secretary, Lauren Fernandez as Section Vice-Chair, and George Medlock as Chair-Elect. You will receive a ballot in March that includes these qualified nominees. Current Chair-Elect Brad Groff will assume the role of Section Chair in June without election, in accordance with the Section by-laws.

Further with regard to the Section by-laws, we will be providing revised by-laws to the Section membership soon

for a final membership vote. The revisions have been in progress for several years, and we would like to finalize them soon. Please watch for an announcement regarding a meeting of the full membership of the Section to allow a vote on the new by-laws. In the meantime, if you have any questions, please contact either Brad Groff or me.

The Section keeps a number of volunteers very busy – the officers, the committee chairs, and committee members. We continue to run as fast as we can to meet the needs of the Section. This work is aided greatly by Derrick Stanley, the Section Liaison at the Georgia Bar. When you see Derrick or Section officers, committee chairs, or committee members, please thank them for all they do. Finally, please join us as we sprint to the finish of the Bar year -- register for the Gala, vote for the new officers, consider the new by-laws, plan to attend the 2014 IP Institute, and watch for various committee events. We look forward to your involvement.

Tina Williams McKeon  
Kilpatrick Townsend  
Section Chair

## COMMITTEE NEWS

### PATENT COMMITTEE

Please save the date for the Patent Committee's next event on April 22, 2014, which will take place at the offices of Alston & Bird. Stay tuned for more details in the coming weeks. The Patent Committee will also be holding a committee meeting in February. If you have signed up as a committee member, please be on the lookout for an invitation to the committee meeting via e-mail. If you have not signed up as a committee

member and wish to do so, please reach out to the committee co-chairs.

### NETWORKING COMMITTEE

The Networking Committee will host another section social this spring. The date and details will be provided in next month's newsletter. In keeping with the other events this year, we're sure to have a great turnout so you won't want to miss it!

### COPYRIGHT COMMITTEE

The Copyright Committee is tentatively planning an event for March. Please look for details to be released soon, and we look forward to seeing you at the event!

### LITIGATION COMMITTEE

Earlier this month, the Litigation Committee of the Intellectual Property Section hosted a luncheon event, titled Working with IP Litigation Damages Experts. Co-Chairs of the Litigation

Committee, Jonathan Olinger and David Lilenfeld, introduced and moderated the panel of experts, which consisted of Denise Dauphin of the AEA Group, Ronen Arad of PricewaterhouseCoopers LLP and Michael Blake of Habif, Arogeti & Wynne, LLP.

The panelists discussed the types of damages experts needed in intellectual property cases and their recommended timing for becoming involved in a case. Best practices surrounding expert reports and depositions, as well as recent case law that has impacted their work, were also covered by the group. The event concluded with a discussion about damages unique to trademark cases, as well as how experts find starting points for damages when there are no appropriate comparators.

We look forward to seeing you at the next Litigation Committee event in June 2014.

#### **PHILANTHROPY/OUTREACH COMMITTEE**

On January 22, 2014, Sue Purvis of the USPTO's Office of Innovation Development met with representatives from the IP Section, Georgia Lawyers for the Arts, the Federal Circuit Bar Association, Georgia State University's Law School, and other interested lawyers and organizations, to discuss current efforts

to form Georgia's Patent Pro Bono Program.

Ms. Purvis has given similar presentations to groups across the US, and has provided assistance to numerous bar organizations and other local IP law groups wishing to form Patent Pro Bono Programs. These programs are for inventors and small businesses that have good quality inventions, but lack the financial resources to retain a patent attorney or agent to assist them in securing patent rights.

A number of bar associations have already formed these programs, including Minnesota (admission of clients began June 2011), Colorado (August 2012), California (October 2012), Washington DC (October 2012), Texas (April 2013); Ohio / Western Pennsylvania / Eastern Pennsylvania / Delaware / Boston / New England (September and October 2013); and New York City metropolitan area (November 2013). Through these pro bono programs, financially under-resourced individuals and businesses receive professionally prepared patent applications, and assistance with the patent process. The goal is to have a patent issued that the individual or small business can use to start, grow or improve their business.

We will keep you updated on our continued efforts to make these pro bono programs a reality for deserving inventors across Georgia. In the meantime, if you are interested in becoming involved with this exciting initiative, please contact Jim Johnson or Rivka Monheit.

#### **IN-HOUSE / LICENSING COMMITTEE & TRADEMARK COMMITTEE**

The Trademark Committee and In-House Counsel Licensing Committee are planning to host a CLE covering Policing and Enforcing Trademarks on Social Media in April, 2014, followed again by social hour at which in-house, outside, large and small law firm counsel can connect. We are looking for sponsors and participants, so please watch for future reports. Please let Alison Danaceau know if you would like to join the Trademark Committee, which meets monthly, or in-house counsel sub-committee, which meets quarterly. The more the merrier!

#### **YOUNG LEADERSHIP DEVELOPMENT COMMITTEE**

The YLD Committee wishes everyone a very Happy New Year, and hopes that Members will stay tuned for the details of upcoming social and networking events in 2014.

### **SAVE THE DATE FOR THE 20th ANNUAL IP INSTITUTE!**



Following up on our last newsletter about "new directions" for our Sections 2014 Intellectual Property Institute, our planning committee is pleased to announce that the 20<sup>th</sup> Annual IP Institute will be held September 18-21, 2014 at the Omni Amelia Island Resort. Details to follow in the coming months, but mark your calendars now and plan to attend! Please contact Brad Groff, IP Section Chair-Elect ([bgroff@gardnergroff.com](mailto:bgroff@gardnergroff.com)) with speaker requests, program topic ideas, and for sponsorship information.

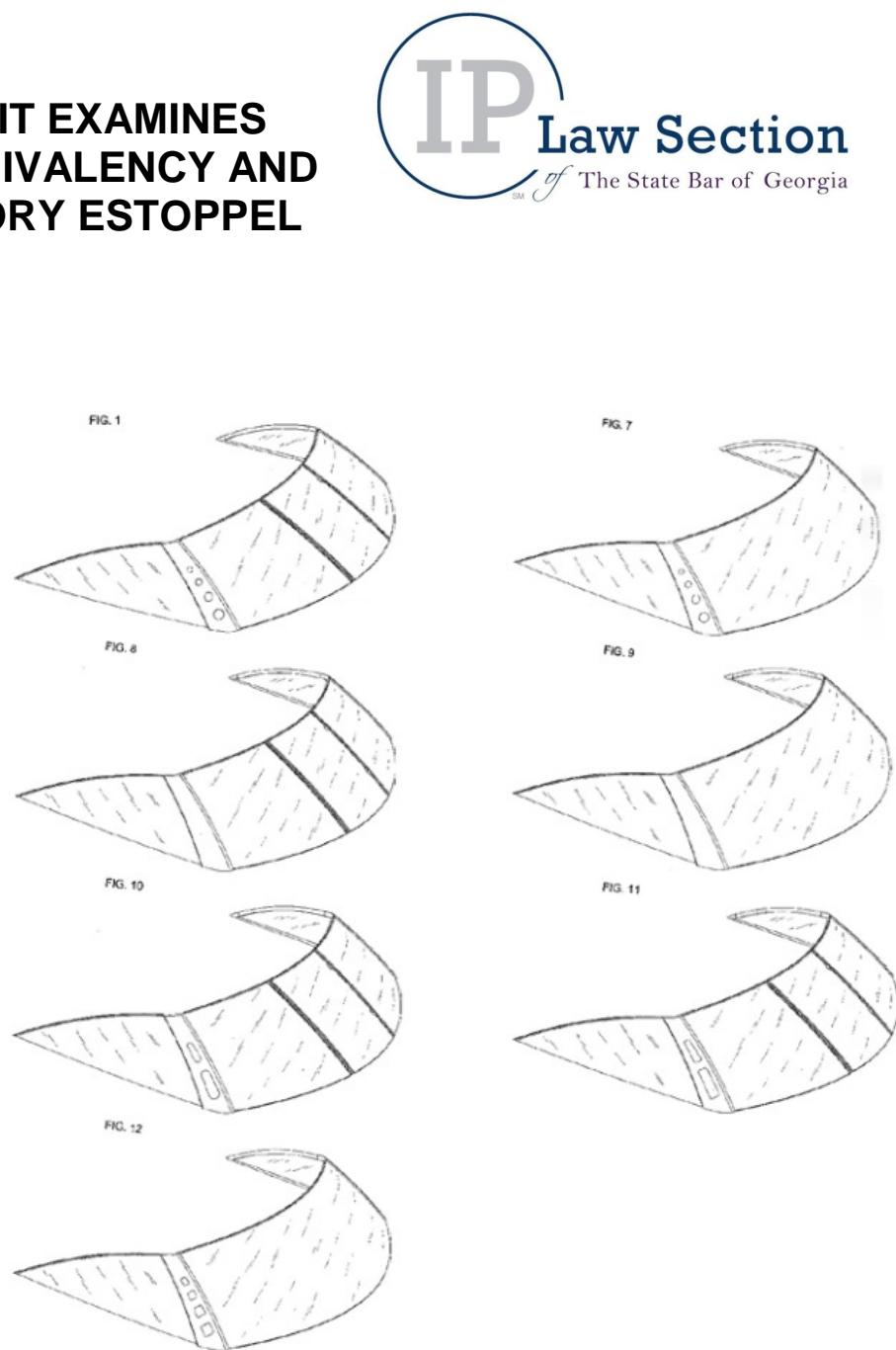
## Member Case Note:

# THE FEDERAL CIRCUIT EXAMINES DESIGN PATENT EQUIVALENCY AND PROSECUTION HISTORY ESTOPPEL

BY CLARK A. D. WILSON

In an issue of first impression for the Federal Circuit Court of Appeals, the court ruled in *Pacific Coast Marine v. Malibu Boats, LLC* (January 8, 2014) that prosecution history estoppel applies to equivalents of design patents that have been amended, as it does to utility patents. In this case, Pacific Coast filed a design patent application claiming an ornamental "marine windshield with a frame, a tapered corner post with vent holes and without said vent holes, and with a hatch and without said hatch, as shown and described." This application included the figures shown to the right, embodying different designs with varying vent hole configurations as well as embodiments with and without a hatch on the front of the windshield.

During examination of this application, the patent examiner issued a restriction requirement asserting that there were five patentably distinct groups of designs: "(1) four circular holes and a hatch (figure 1); (2) four circular or square holes and no hatch (figures 7 & 12); (3) no holes and a hatch (figure 8); (4) no holes and no hatch (figure 9); and (5) two oval or rectangular holes and a hatch (figures 10 & 11)." In response, the applicant elected to prosecute group 1, embodying figure 1 with four vent holes and a hatch, and amended the claim to recite "a marine windshield with a frame, and a pair of tapered corner posts." As a result, the language "with vent holes and without said vent holes, and with a hatch and without said hatch"

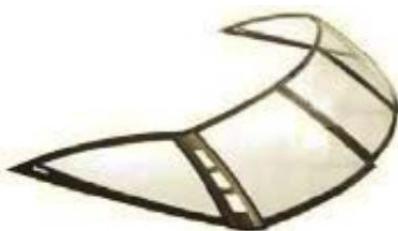


was deleted and figures 7-12 were cancelled. Thus, the newly amended claim and the remaining figures embodied a windshield with four circular holes on the corner post and a hatch on the front. This application issued as design patent D555,070. The applicant also filed a divisional application for the embodiment with no holes in the corner post, which issued as D569,782. The remaining embodiments were not

pursued in any further divisional applications.

Pacific Coast subsequently sued Malibu Boats in the Middle District of Florida alleging that the Malibu Boats' windshield having three trapezoidal holes on the corner post (shown below) infringed the D555,070 patent based on the doctrine of equivalents. The district court granted summary judgment of non-infringement based on prosecution

history estoppel by reasoning that “during prosecution, the applicant had surrendered the designs reflected in the canceled figures.” The district court explained that although “the accused design has one fewer vent hole than the embodiment...the accused design is still clearly within the territory surrendered between the original claim and the amended claim.” On appeal, Pacific Coast asked the Federal Circuit to determine “whether the presumption of prosecution history estoppel precludes a patentee from asserting infringement against an alleged equivalent of an amended design patent claim.”



The Federal Circuit began by explaining that for design patents, “the concepts of literal infringement and equivalents infringement are intertwined.” Specifically, while utility patent infringement requires a literal identity, infringement of a design patent can apply to “the patented design, or any colorable imitation thereof,” which is a standard that itself inherently involves the concept of equivalents. And, prosecution history estoppel can still apply to design patents. Any bar to infringement of a design patent based on prosecution history estoppel will be determined by: (1) whether there was a surrender; (2) whether it was for reasons of patentability; and (3) whether the accused design is within the scope of the surrender.

Pacific Coast, it was determined by the Federal Circuit, did surrender claim scope during prosecution. Specifically, Pacific Coast surrendered the embodiments showing corner posts with two holes and no holes by cancelling the

figures that showed these designs. Thus, the D555,070 claim was limited to a windshield with four holes in the corner post, and colorable imitations thereof. It did not matter that the surrender was through a cancellation rather than an amendment. Because design patents are defined by figures rather than language, the applicant narrowed the scope of the original application and thus surrendered subject matter by cancelling the figures depicting the unelected embodiments and removing the relevant claim language describing those same configurations.

Additionally, these unelected embodiments were surrendered for purposes of patentability. According to *Festo*, “estoppel arises when an amendment is made to secure the patent and the amendment narrows the patent’s scope,” such that “a narrowing amendment made to satisfy any requirement of the Patent Act may give rise to an estoppel...even if it was for some purpose other than avoiding prior art.”<sup>i</sup> Because design patent claims are defined by figures rather than language, Pacific Coast surrendered several embodiments, thus narrowing the patent’s scope, to overcome the restriction requirement in order to secure the patent.

The accused Malibu Boats design, however, was not within the scope of the surrendered embodiments. The Federal Circuit explained that “claiming different designs does not necessarily suggest that the territory between those designs is also claimed.” And, Pacific Coast never claimed a design with “zero to four holes.” Moreover, Pacific Coast neither submitted nor surrendered a design with three holes similar to the accused Malibu Boats windshield. And, by electing the issued embodiment showing a figure with four holes in the corner post, Pacific Coast simply surrendered embodiments with two holes on the corner post. For these reasons, the Federal Circuit

concluded that the accused Malibu Boats design was not within the scope of the surrender, therefore, prosecution history estoppel did not preclude Pacific Coast’s claim of infringement. This issue has been remanded to the District Court for further proceedings.

Accordingly, design patent equivalency can be affected by prosecution history estoppel. However, design patents present their own wrinkles. To expand the scope of equivalency, consider pursuing claims for a variety of different embodiments and ensuring their protection, if necessary, through divisional applications. Regarding infringement analysis, evaluate whether any equivalents of unclaimed embodiments have been surrendered or if they are outside the scope of the surrender, and thus unaffected by prosecution history estoppel.

<sup>i</sup> *Festo Corp. v. Shoketsu Kinzoku Kabushiki Co.*, 535 U.S. 722, 736 (2002).



**Clark A. D. Wilson** is a Partner at Gardner Groff Greenwald & Villanueva PC. His practice focuses exclusively on patent and trademark matters. Clark maintains a blog: [MedicalDevicePatentCounsel.com](http://MedicalDevicePatentCounsel.com), and can be reached at cwilson@gardnergroff.com



## UPCOMING EVENTS

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**Lauren Fernandez - Secretary**  
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