



## CALENDAR

**October 21, 2014**

**2014 Georgia State University IP  
Community Service Award  
Luncheon**

GSU State Ballroom  
(click [here](#) for more info)

**November 10, 2014**

**In-House/Tm Committee CLE:  
“Everything You Ever Needed or  
Wanted to Know about  
Franchising IP”**

Georgia Bar Building  
Conference Room A  
4pm–8pm  
(more info to come)

**November 11, 2014**

**Litigation Committee to Host a  
Lunch-and-Learn CLE on  
e-Discovery Issues**

(more info to come)

**December 6, 2014**

**YLD-IP Community Project**

9am–noon  
(more info to come)

**December 8, 2014**

**Patent Committee to Host a CLE  
on Section 101 Patentability**

(more info to come)

**January 9, 2015**

**Litigation Committee to  
Host Trademark CLE at GA State  
Bar’s Mid-Year Meeting,  
Followed by IP Section Lunch  
and Annual Business Meeting**

Marriott Marquis  
9am–noon  
(more info to come)

**March 26, 2015**

**Third Annual Intellectual  
Property Gala**

Atlanta’s High Museum of Art



## Message from the Chair

Dear IP Section Members:

The leaves changing color and the cool days of autumn remind me that time passes quickly. The first quarter of the 2014–15 bar year is already behind us, and our IP Section has made productive use of that time.

Thanks to everyone who attended our open house and signed up to help with one of our IP Section committees. Our committees are actively planning and holding programs already, but it’s not too late for you to get involved. Contact information for our Committee Chairs is on the Section website at <http://georgiaip.org/about-us/>. And check our IP Section calendar at <http://georgiaip.org/events/> for upcoming programs and events.

Our 20<sup>th</sup> annual IP Institute was a tremendous success. The programs and speakers this year were just fantastic. Making the Institute solely IP-focused allowed us to present more in-depth topics relevant to our section members’ practices. And we were privileged to have an awesome slate of speakers, including three Federal Circuit judges (including the Chief Judge), Chief Judge Thrash from the Northern District of Georgia, Chief Administrative Judge Smith of the US PTO’s PTAB, and Chief Administrative



Law Judge Bullock of the US International Trade Commission. We also had great speakers from law firms, corporations and academia, from Atlanta, Washington DC, Palo Alto, and elsewhere.

Amelia Island was a beautiful and convenient site for our Institute, and the weather even cooperated with some rain Saturday afternoon to give us a good excuse to come in from the beach and watch a little football. It was great to catch up with many old friends and to make some new ones at the receptions and dinner. If you did not make it to this year’s IP Institute, you missed a great experience. It’s also a great value for your CLE budget. Plans are already underway for next year’s IP Institute, and I hope you will be a part of it.

*See Message, Page 2*

*Message*, continued from Page 1

Our IP Section is also hard at work on one of the biggest new initiatives in the IP field in recent memory—the nationwide patent pro bono program initiated by the America Invents Act (<http://www.uspto.gov/inventors/proseprobono/index.jsp>). Our IP Section Liaison for the AIA Pro Bono Project, Rivka Monheit, has been instrumental in helping coordinate local efforts to launch the program in Georgia, including a pledge drive to secure matching funds from the US PTO. Our IP Section has committed to support this program and we hope you will too.

We're also launching a new annual sponsorship program for the IP Section. In years past, the Section has solicited sponsorships for programs like the IP Institute and the Gala on an event-by-

event basis. Since we are such an active section, there are many other events throughout the year presenting opportunities for sponsor involvement and recognition. So beginning with the 2015 calendar year, we will be offering annual sponsorship opportunities covering the IP Institute, the Gala, and other IP Section events. Please contact the IP Section's Special Events Chair, Virginia Carron, for more information.

Looking forward to upcoming events, watch your email for announcements about our annual IP Section holiday party. We are also planning a morning CLE program followed by an IP Section luncheon at the State Bar Mid-Year Meeting on January 9, 2015. The luncheon at the Mid-Year will serve as our Section's annual business meeting, and allow us to review the year's progress and plan for

the future. The annual Gala and Judges Dinner, always a highlight of the year, is scheduled for March 26, 2015 at the High Museum. Watch your inboxes for more details to follow on these and other upcoming IP Section events.

In closing, I'd like to say thanks to our IP Section's Executive Committee and everyone working on our many committees for all of your work on the Section's behalf. It's my honor to serve as your IP Section Chair this year, but it takes a group of energetic and talented people to keep something this big moving forward. Keep up the good work y'all!

Brad Groff, IP Section Chair  
Gardner Groff Greenwald &  
Villanueva, PC  
bgroff@gardnergroff.com  
770-984-2300

## Committee News

### SPECIAL EVENTS COMMITTEE

The Special Events Committee reminds you to save the date for the IP Section's Annual Gala at Atlanta's High Museum on March 26, 2015. We are pleased to announce that judges from the Court of Appeals for the Federal Circuit are planning to join us for this year's Gala, which will include a reception, dinner, and one hour trial CLE. Stay tuned for more details regarding this popular event!

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

The In-House/Licensing and Trademark Committees will host a joint CLE event, along with the Georgia Bar Franchise Section, titled "Everything You Ever Needed or Wanted to Know about Franchising Intellectual Property:

Trade Dress Basics for Franchisors and Franchisees" on November 10, 2014, from 4:00pm–8:00pm, in Conference Room A of the Georgia Bar Building, with a cocktail reception to follow. If you have any questions, please contact Alison Danaceau via her email at [adanaceau@brawwlaw.com](mailto:adanaceau@brawwlaw.com). Please watch for the announcement, and we hope to see you there!

### TRADEMARK COMMITTEE

The Trademark Committee hosted a one hour Lunch and Learn CLE, entitled "Navigating the Madrid Protocol," on October 7, 2014 at the Bar Center. Our featured speaker was Lynne Beresford, former Commissioner for Trademarks at the USPTO, 2011 IP Hall of Fame inductee, and current member of the Board of Advisors to the International Intellectual Property Institute. Ms. Beresford shared insights gleaned from

her instrumental role in implementing the Madrid Protocol in the United States, including her successful efforts to establish the Internet Corporation for Assigned Names and Numbers (ICANN).

The Committee would like to thank all who attended (turnout was excellent, with over fifty attendees), and especially Ms. Beresford, for helping to make this event a success. Stay tuned for further details on upcoming programs, and we look forward to seeing you at future events!

### LITIGATION COMMITTEE

The Litigation Committee will host a Lunch and Learn CLE event on November 11, 2014. Exact details will be forthcoming, but the general topic will be e-discovery issues commonly faced by today's IP litigators.

See *Litigation*, Page 3

*Litigation*, continued from Page 2

We also will host a three hour CLE during the State Bar's Mid-Year meeting at the Marriott Marquis from 9am until noon on January 9, 2015. This CLE will focus on trademark protection, and we are working to develop content that will appeal to non-IP and IP attorneys alike. Following the CLE presentation, the IP Section will host a luncheon and hold its annual business meeting. Please stay tuned for more details, and we look forward to seeing you at the events!

### PATENT COMMITTEE

The Patent Committee would like to thank everyone who attended the August meeting to discuss plans and ideas for the upcoming bar year. We have scheduled a CLE event for December 8, 2014, and are developing a CLE event that will focus on issues relating to patentable subject matter under 35 U.S.C. § 101. Please stay tuned for more details, and feel free to reach out to the committee's co-chairs if you are interested in participating in this or any other future events. We look forward to seeing you in December.

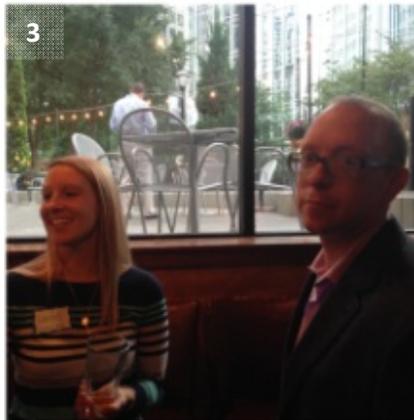
### COPYRIGHT COMMITTEE

The Copyright Committee is currently planning a CLE event for April or May of 2015. Please stay tuned for further details, and feel free to reach out to the Committee Chair, Katie Bates, if you are interested in becoming involved.

### YLD COMMITTEE

The YLD Committee is excited to join the Section's Pro Bono Committee and the IP Section's membership in working to implement the AIA Pro Bono Inventor Assistance Program in Georgia. Be sure to save the date for our upcoming YLD-IP Community Service Project, which will be held on December 6, 2014, from 9am–12:30pm. We will be participating in the Saturday Lawyer Program at the Atlanta Volunteer Lawyers Foundation. Please stay tuned for more details.

In other news, the YLD Committee hosted a Happy Hour Social on October 14, 2014 at Shout in Midtown. As you can see from the photos below, a good time was had by all. We thank everyone who attended, and look forward to seeing you at future events!



### YLD Happy Hour Social, October 14, 2014, at Shout in Midtown

*Clockwise, from top left:* 1. (l-r) Gayatry Nair, Pinky Herao, Zain Kapadia, Lauren Brenner, A. Jarrod Jenkins, Tim Callery. 2. Sonia Lakhany and Tiffany Logan (YLD Co-Chairs). 3. Lauren Brenner and Andrew Strickland.

## A Special Note on Georgia's Inventor Assistance Program Rivka Monheit, AIA Pro Bono Chair



Since early 2013, the IP Section of the State Bar of Georgia has been working with various attorneys and organizations, including the Georgia Lawyers for the Arts ("GLA") and the IP Section of the Atlanta Bar, to create an America Invents Act (AIA) Inventor Assistance Program in Georgia. The AIA requires the formation of programs to help solo inventors and small businesses find patent agents and attorneys to file patents on a pro bono basis, and we want to make Georgia's program an example for all.

Launching a Patent Prosecution program requires long-term financial commitments from the entire state. In September, Georgia's Inventor Assistance Program organizers met with Jennifer McDowell of the USPTO, who provided valuable information regarding the organization process, and reminded the Program organizers that time was of the essence if Georgia hoped to implement its AIA-mandated program by the end of the year, as called for by President Obama's Executive Action 7: Patent Pro Bono and Pro Se Assistance ([http://www.uspto.gov/patents/init\\_events/executive\\_actions.jsp#heading-8](http://www.uspto.gov/patents/init_events/executive_actions.jsp#heading-8)). The Program organizers also were advised that although the USPTO could provide funding to support Georgia's new program, such funding could only be maximized by securing matching contributions from local partners. To take full advantage of the opportunity for federal assistance, the Program organizers would need to quickly secure pledges from Georgia's legal IP community.

Fortunately, the Program organizers are no strangers to helping low-income Georgia residents find legal representation. This is particularly true for GLA, which since 1975 has focused on connecting artists and non-profit arts organizations with volunteer attorneys for arts-related issues. As GLA Director of Operations and newly-appointed Patent Administrator David Mayer has observed, "Patents are a logical extension of GLA's current mission of fostering intellectual property growth in Georgia."

The Program organizers quickly initiated a campaign to raise matching funds from local sources. We are extremely proud to report that, thanks to the generous assistance of local firms and practitioners, this campaign was successful. Together with the matching donation pledged by the USPTO, the outstanding financial commitment provided by Georgia's local IP community will provide the funding necessary to launch the Georgia PATENTS (*Pro bono Assistance and Training for Entrepreneurs and New, Talented, Solo inventors*) program before the end of the year, and maintain its operations. This new program joins several other Inventor Assistance Programs already implemented across the country, with a mission of providing free patent prosecution services to small start up businesses, and solo inventors with a household income of less than 300% of the poverty level. Please join us in offering very special thanks to the following partners, who have contributed generously to make this program a reality:

### **Founding Partners—\$5,000 for five years**

Alston & Bird  
Troutman Sanders  
IP Section of the Georgia Bar

### **Founding Benefactors—\$3,000 for five years**

Finnegan, Henderson, Farabow, Garrett &  
Dunner, LLP  
Smith, Gambrell & Russell  
IP Section of the Atlanta Bar

### **Founding Supporters—\$1,500 for five years**

Kilpatrick Townsend  
Meunier Carlin & Curfman  
Pabst Patent Group LLP  
Sutherland Asbill & Brennan

### **Founding Participants—\$1,000**

Gardner Groff Greenwald & Villanueva, PC  
Technology Section of the Georgia Bar

See *Inventor Assistance Program*, Page 5

*Inventor Assistance Program*, continued from Page 4

We are incredibly fortunate to enjoy such strong financial support. But ultimately, the success of Georgia's Inventor Assistance Program will also depend upon the contributions of the individual attorneys and patent agents who are willing to commit their time and expertise to help deserving Georgia inventors secure patent protection for their inventions. The Program organizers are hopeful that by the end of 2015, at least 60% of all Georgia registered patent attorneys and agents will have signed up to volunteer with the program. Such a commitment will be crucial to sustaining a meaningful Inventor Assistance Program. As Patent Administrator David Mayer has observed, "Unlike current GLA cases that can sometimes be handled in an afternoon, patent prosecution matters may linger for years. We don't know what the demand for this program will be, but we would rather have an overwhelming number of registered patent attorneys and agents signed up to take cases than have a backlog of inventors needing patent prosecution assistance."

GLA plans to run seminars and special outreach programming to make sure inventors are aware of the steps necessary to secure patent rights. Such programs are meant to ensure that inventors enrolling in Georgia's Inventor Assistance Program possess a baseline understanding of the patenting process, and have filed for a provisional patent, which will streamline the process and allow for the most effective utilization of the time and efforts of our volunteer patent attorneys and agents.

Founding sponsorship opportunities are still available, and GLA will launch a portal for patent agents and attorneys to register soon. For questions regarding the program, please contact Meredith Ragains, GLA Executive Director, or David Mayer, Patent Administrator, at either [gla@glarts.org](mailto:gla@glarts.org) or 404-873-3911, or Rivka Monheit, AIA Pro Bono Chair at the IP Section of the State Bar of Georgia, at either [Rivka@pabstpatent.com](mailto:Rivka@pabstpatent.com) or 404-879-2152. We hope that many of you will take the opportunity to participate in the development and implementation of Georgia's first Pro Bono Inventor Assistance Program!

## Recap: the 20<sup>th</sup> Annual IP Institute

The Committee would like to thank everyone who attended the 20<sup>th</sup> Annual IP Institute, and especially the judges, panelists, moderators, and support personnel who helped to make this year's event such a success. As our Section Chair Brad Groff mentioned in his introductory message, this year's programming focused exclusively upon IP-related topics relevant to our section members' practices.

### **The Main Event—Mock Oral Argument Before Federal Circuit Judges**

The event's IP-specific focus is perhaps best evidenced by the Institute's main event, a mock oral argument before a panel of judges from the United States Court of Appeals for the Federal Circuit that included Chief Judge Sharon Prost, Judge Kimberly Moore, and Judge Richard Taranto. Emory Law Professor Timothy Holbrook moderated, and Section members (and local IP attorneys) Holly Hawkins Saporito (Alston & Bird) and Jeffrey A. Freeman (Finnegan) presented the opposing arguments in a (See *Institute Recap*, Page 6)



(L–R) Judge Richard Taranto, Jeffrey Freeman, Chief Judge Sharon Prost, Judge Kimberly Moore, Professor Timothy Holbrook, and Holly Saporito pause for a photo following the Mock Oral Argument.

Continued from *Institute Recap*, Page 5

fictional appeal from summary judgment in an infringement case involving a gene patent. The Judges posed challenging questions that provided insights into some of the unique issues regarding such patents, treated attendees to some advice regarding appellate practice and feedback concerning the arguments presented by Ms. Saporito and Mr. Freeman, and took the time to answer some questions from the audience. It was a fantastic event, and the Section extends special thanks to Judges Prost, Moore, and Taranto for agreeing to participate, to Holly Saporito and Jeffrey Freeman for their excellent arguments, and to Professor Holbrook for moderating.

## IP-Specific Panel Discussions

This year's emphasis on IP-specific programming is also evident from the Institute's panel discussions. For example,

- Mercer School of Law Professor David Hricik summarizes his panel, entitled *Ethical Issues in IP Law*, as follows —“My panel discussed the ethical issues that now-dominant alternative fee agreements create, combining the perspectives of long-time in-house counsel, a private practice patent practitioner, and an expert in legal ethics. The result? A lively discussion that included an earnest conversation about the need for trust and communication when utilizing these arrangements, particularly flat fee arrangements, and some insights into how to avoid common problems in all fee agreements. Among other things, the audience learned that in-house counsel are wary of giving outside counsel billable-hour based projects in the final quarter of the year, when their incentive might be to meet annual billable quotas, not the client's best interest. The audience also heard about the frustrations of both senior outside counsel and in-house counsel about less-than-compelling billing statements. In today's environment, 'worked on matter' will not do.”



(L–R) Jason Rosenberg (Alston & Bird), Prof. Timothy Holbrook (Emory Law), Jim Johnson (Sutherland), and Allen Yee (The Coca-Cola Company), discuss trademark-related IP issues during a panel entitled *A Matter of Perspective: Current Trademark Issues Examined From the Academic, In-House, and Private Practice Viewpoints*.

- Networking Chair Clark Wilson (Merchant & Gould) summarizes his panel, entitled *Strategies and Tactics in Post-Grant Proceedings*, as follows —“My panel included the Honorable James D. Smith, Chief Administrative Judge of the USPTO Patent Trial & Appeal Board, and Kevin Greenleaf, an expert in Post-Grant proceedings and attorney at Dentons US LLP in Palo Alto, California. Chief Judge Smith explained that although the USPTO had initially budgeted for 300 new IPR cases each year, they have now received over 2,000 over the past 3 years. The panelists agreed that effective post-grant advocacy should focus on one or a few strong arguments rather than offering a variety of optional arguments, and that patentees should utilize preliminary responses to focus on arguments that invalidate the post-grant application filed rather than arguing the validity of their patent. The panelists disagreed on how to make amendments, with Judge Smith asking patentees to go on record as saying that their proposed amendment was allowable in view of known prior art, and Mr. Greenleaf arguing that this request was burdensome. Finally, both panelists discussed the ongoing evaluation of the claim construction standard in post-grant proceedings, Broadest Reasonable Interpretation vs. *Phillips*, and suggested that the audience pay attention to this issue.
- YLD Co-Chair Sonia Lakhany, (Bodker Ramsey Andrews Winograd & Wildstein) summarizes her panel, entitled *Techniques and Tips for Licensing IP*, as follows —“The speakers were Lauren Fernandez (FOCUS Brands), John W.

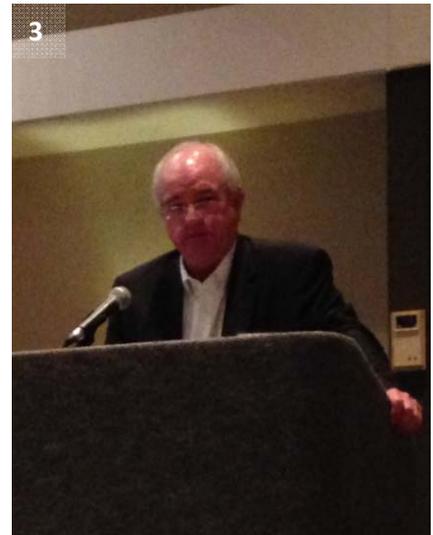
See *Institute Recap*, Page 7

Continued from *Institute Recap*, Page 6

Greenwald (Gardner, Groff, Greenwald, & Villanueva), and Matthew H. Smith (Innovolt, Inc.). The panel was well attended, with the discussion focusing on innovative ways to approach matters involving IP licensing. The speakers provided real-world examples to illustrate the concepts at issue, including a discussion of IP licensing agreements between Cinnabon, Burger King, and Taco Bell. The audience was quite engaged, and the panelists fielded a number of questions concerning IP licensing issues, including those surrounding product placements in television shows and movies.”

## Going Forward

The IP Section is committed to providing even more IP-focused content at next year’s IP Institute, and we sincerely hope you are able to join us there!



### 20<sup>th</sup> Annual IP Institute, September 18–20, 2014 at the Omni Amelia Island Resort

*Clockwise, from top left:* 1. (l–r) Panelists Barbara Murphy (Foster, Murphy, Altman & Nickel, Washington, D.C.), Cono Carrano (Akin Gump Strauss Hauer & Feld, Washington, D.C.), Chief Judge Charles Bullock of the U.S. International Trade Commission, and moderator Andy Strickland (Finnegan) present a panel discussion entitled *Recent Developments at the ITC*. 2. The Omni Resort’s pool and beach area, seen from a guest room. 3. Chief Judge Thomas Thrash of the U.S. District Court for the Northern District of Georgia provides advice on successful persuasive advocacy, based on a comparison of Brutus and Mark Antony’s speeches from Shakespeare’s *Julius Caesar*. 4. Professor Timothy Holbrook summarizes the case at bar at Saturday’s Mock Appellate Argument before Chief Judge Sharon Prost, Judge Kimberly Moore, and Judge Richard Taranto, of the U.S. Court of Appeals for the Federal Circuit.

## **20<sup>th</sup> Annual IP Institute—Special Thanks to Our Sponsors**

As a final note, the Committee recognizes that the 20<sup>th</sup> Annual IP Institute was made possible by the generous support of our sponsors. The Committee takes this opportunity to extend its special thanks for their contributions, and looks forward to working with them to host more exciting programs and events in the future.

### **Sponsors for the 20<sup>th</sup> Annual IP Institute**

**Finnegan, Henderson, Farabow, Garrett & Dunner, LLP**

**Alston & Bird LLP**

**Conway MacKenzie Inc.**

**Baker & Hostetler**

**Gardner Groff Greenwald & Villanueva, PC**

**Habif, Arogeti & Wynne, LLP**

**King & Spalding LLP**

**Kilpatrick Townsend & Stockton LLP**

**Knowles Intellectual Property Strategies**

**Robbins Geller Rudman & Dowd LLP**

**Smith Risley Tempel Santos LLC**

**Sutherland Asbill & Brennan LLP**

**Corsearch**

**FairValue Advisors, LLC**

**Lilenfeld PC**

**Thomas Horstemeyer LLP**

**Thomson CompuMark**



## Upcoming Events

----October 21, 2014----

**2014 Ga. State Univ.  
IP Community Service  
Award Luncheon**

Ga. State University ballroom  
(click [here](#) for more information)

----December 6, 2014----

**YLD-IP Community Project**

9am-noon (more info to come)

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on Section 101 Patentability**

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State Bar Mid-Year Meeting  
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----March 26, 2015----

**Third Annual Intellectual  
Property Gala Honoring  
Members of the Judiciary**

Atlanta High Museum of Art  
(more info to come)

## 2014-2015 IP Section Executive Committee



From left – Clark Wilson, Katie Bates, Chris Glass, Arvind Reddy, Alan White, Lauren Fernandez, Brad Groff, George Medlock, Jim Johnson, Virginia Carron, Rich Miller, and David Lilienfeld. *Not pictured* - Brent Bellows, Suzanne Werner, Alison Danaceau, Jonathan Olinger, Matt Smith, Joe Staley, Rivka Monheit, Sonia Lakhany, and Tiffany Logan.

## LEADERSHIP

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Gardner Groff Greenwald & Villanueva

**Lauren Fernandez – Chair Elect**

Focus Brands

**Brent R. Bellows – Vice Chair**

Knowles IP Strategies

**Suzanne Werner – Secretary**

Alston & Bird

**Jim Johnson – Treasurer**

Sutherland

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Ballard Spahr

**Arvind Reddy – Patent**

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**Alison Danaceau – Trademark**

Bodker, Ramsey, Andrews, Winograd  
& Wildstein

**Katie Bates – Copyright**

King and Spalding

**David Lilienfeld – Litigation**

Lilienfeld PC

**Jonathan Olinger – Litigation**

Kilpatrick Townsend & Stockton

**Matt Smith – In-House/Licensing**

Innovolt, Inc.

**Joe Staley – In-House/Licensing**

Kids II

**Rivka Monheit – AIA Pro Bono**

Pabst Patent Group

**Virginia Carron – Special Events**

Finnegan, Henderson, Farabow,  
Garrett & Dunner

**Clark Wilson – Networking**

Merchant & Gould

**Sonia Lakhany – YLD Liaison**

Bodker, Ramsey, Andrews, Winograd  
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**Tiffany Logan – YLD Liaison**

Parks IP Law

**Chris Glass – Website & Podcasting**

Troutman Sanders

**Alan White – Newsletter**