

# insight

A RATNERPRESTIA PUBLICATION

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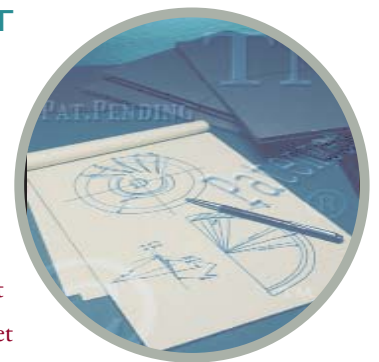
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## A PROPERLY DRAFTED JOINT RESEARCH AGREEMENT WILL KO SECRET PRIOR ART

BY: ROBERT P. SEITTER

Secret prior art exists and until recently it punished joint developers who combined their expertise in joint research arrangements. Last December Congress addressed this hardship and enacted the Cooperative Research and Technology Enhancement Act (CREATE) to provide a safe harbor against secret prior art for those willing to share their confidential information in a joint research project. Understanding the advantages of CREATE while guarding against unwanted consequences is key to reaping its benefits.

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## THREE SHAREHOLDERS, INCLUDING CO-FOUNDING PRINCIPAL, ALLAN RATNER, TRANSITION TO OF COUNSEL



**Allan Ratner**, a co-founding principal of RatnerPrestia, has retired as shareholder effective at the end of the firm's fiscal year in January 2005. "Allan has been instrumental since the firm's founding, twenty three years ago, in the firm's growth and development into the prominent position it enjoys today," according to the firm's co-founder, Paul Prestia.

While Allan enjoys and has a substantial clientele in trademark practice, his forte is in computers and computer-related law. Many of those he trained and his mentees in that field have become prominent themselves in computer-related intellectual property law practice.

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## SECRET PRIOR ART

In *OddzOn Products v. Just Toys, Inc.*, 43 USPQ2d 1641 (Fed Cir 1997), the Court of Appeals for the Federal Circuit (CAFC) held that a confidential disclosure from one party, X, to another party, Y, was prior art against Y for determining whether Y's related and subsequent invention is patentable under the obviousness standard of 35 U.S.C. §103. The CAFC also explained that although X's confidential disclosure was prior art to Y, it was not prior art against the rest of the world.

*OddzOn* also instructs that if Y files a patent application for his subsequent invention, Y's failure to disclose X's confidential information to the Patent and Trademark Office (PTO) could be a breach of an applicant's duty of candor and good faith. Such a breach would of course render the patent unenforceable and put Y at risk for an alleged infringer's attorney's fees in an unsuccessful infringement litigation. X's duty to disclose to the PTO may also conflict with X's duty to Y not to disclose Y's confidential information.

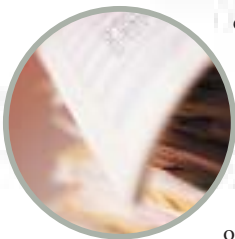
Be careful. Pre-patent filing investigations should inquire about disclosures from third parties and any associated agreements related thereto.

## SECRET PRIOR ART DOES NOT APPLY TO INTERNAL DISCLOSURES

In 1984 Congress amended 35 U.S.C. §103 so that disclosures among a company's employees and others obligated to assign inventions to the company did not constitute prior art under the §103 obviousness test - a safe harbor for the company. But *OddzOn* makes clear that disclosures among the employees of two different companies collaborating in a research project still constituted prior art.

## CREATE: SECRET PRIOR ART DOES NOT APPLY TO JOINT RESEARCH

In December, 2004, Congress enacted CREATE and extended the 1984 safe harbor to X and Y while they are cooperating under a Joint Research Agreement (JRA), defined as a "written contract, grant, or cooperative agreement entered into by two or more persons or entities for the performance of experimental, developmental, or research work"



(35 U.S.C. §103 (c)(3)). By virtue of CREATE, X's disclosures to Y and Y's to X are not §103 prior art to the recipient if (1) a claimed invention was made by the parties to a JRA that was in effect on or before the claimed invention was made, (2) the invention was made as a result of activities undertaken within the scope of the JRA, and (3) the patent application discloses the names of the parties to the JRA.

## CONTROVERSY: THE PTO'S INTERIM RULES

The PTO's Interim Rules implementing CREATE take the position that if X's confidential disclosure to Y is the subject of a pending patent application and if Y's subsequent invention is not patentably distinct from X's patent claims, Y's application is still not patentable under the doctrine of "Obviousness Type Double Patenting".

Obviousness type double patenting is curable in the PTO by filing a terminal disclaimer signed by both X and Y wherein Y must agree that Y's patent will expire on the same day as X's. The controversy begins. X and Y may also be required to agree that they will not separately enforce or license the two patents. Think of it this way: X may be agreeing to an encumbrance on his patent because of a minor improvement to his patented technology.

## NONDISCLOSURE AGREEMENTS IN CONTEMPLATION OF A JOINT RESEARCH ARRANGEMENT

CREATE does not apply to Nondisclosure Agreements (NDA) in the usual situations, i.e., where a joint development effort is not contemplated.

When an NDA is in contemplation of a research collaboration, CREATE's benefits may inure to the parties if the NDA is carefully drafted. The House Committee Report (H.R.REP. NO. 108-425) makes it clear that the proscribed JRA need not be a single document, but can be a series of agreements. When drafting this type of NDA, it would be prudent to carefully define, as the purpose of the information exchange, the evaluation of the parties' background information to determine the extent to which the existing technology is viable enough to continue a collaborative effort. It would also be prudent to restrict the use of the exchanged information for that evaluation.



Although there has not yet been any judicial interpretation, such a carefully drafted NDA can be the first in a series of agreements that comprise the proscribed JRA.

There are numerous advantages to effecting an early JRA date. First, the parties have the §103 prior art safe harbor. Second, because the confidential information being exchanged is not §103 prior art, there is no need to submit the exchanged information to the PTO as relevant prior art in subsequently filed patent applications. Typically, the parties will wish to maintain the confidentiality of some of the exchanged information. By not having to submit it to the PTO its confidentiality is preserved.

Third, it eliminates the need for an administrative effort to catalogue all exchanged information and format it for submission in subsequent patent applications. That effort, even if practically achieved, can be an expensive burden that adds nothing to the outcome of the research effort. Fourth, it avoids the adverse consequences of an inadvertent failure to cite a confidential disclosure as relevant prior art.

## JOINT RESEARCH AGREEMENTS

JRAs require new considerations after CREATE. The usual clauses and considerations still apply. Depending on the business objectives of the parties, ownership of background and developed technology and patents will be addressed, and, licenses or cross-licenses may be granted.

But be careful. JRAs usually require the parties to cooperate with each other and use their best efforts to procure patents. Poorly drafted clauses could be interpreted to mean that the parties are giving each other a prior approval to file patent applications. Consider a JRA where ownership of developed inventions belongs to the party whose employee made the invention. If Y's employee made an invention that impacts X's business, X may not want that application filed.

If the PTO's Interim Rules survive the rule making process intact, poorly drafted clauses could be interpreted to provide prior approval for filing terminal disclaimers. If X has a pending patent application for background technology, he could be

obligated to sign a terminal disclaimer encumbering his background patent with an obligation to license and enforce it with Y's subsequent patent for a minor improvement.

## AN EXIT STRATEGY

Finally, every JRA needs an exit strategy to address a failing arrangement. When the parties terminate the JRA: Who owns the developed technology and associated patents? What licenses or cross licenses survive termination?

If the effort has been a true failure, these questions are probably moot. On the other hand, suppose X wants to continue a post termination development effort on his own. Does the exit strategy defined in the JRA work for X? If not, consider a Termination Agreement that addresses the issues. Failure to do so could severely impair the value of any subsequent breakthrough invention X makes.

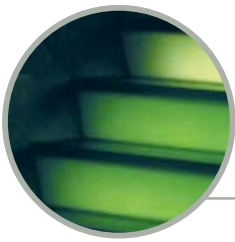
All of the exchanged confidential information and all of the developed technology are prior art to X - or are they? If X can get ownership of the developed technology (including an obligation on all inventors to assign their rights), the safe harbor provided by the 1984 Amendment to 35 U.S.C. §103 will be available to solve X's prior art problems.



## CONCLUSION

The terms of a JRA directly depend on the business objectives of the parties. The number of these objectives and implementing plans are too numerous to meaningfully address here. Consider the issues and negotiate the best arrangement with the additional considerations Congress CREATED.

WE NOTE HERE THAT CREATE RAISES NUMEROUS QUESTIONS AND ISSUES TOO COMPLEX TO ADDRESS IN A SHORT ARTICLE. LOOK FOR FURTHER INFORMATION FROM RATNERPRESTIA INCLUDING DISCUSSIONS AND PRACTICE TIP SEMINARS ON THIS SUBJECT IN THE FUTURE.



## RP ON THE MOVE

**Rex A. Donnelly, IV** and **Jack J. Jankovitz** have become Shareholders of the firm. Rex, who operates out of the firm's Delaware office, spent over nine years in research and development and as an environmental coordinator for DuPont's titanium dioxide business. He was also involved in the reorganization of DuPont's trademark portfolio. Jack practices



in the firm's main Valley Forge office and gained diverse experience in the art of radio communication and navigation, having spent over 20 years as an engineer and consultant working on aircraft navigation, radar, ECM, GPS and other communication systems.

Jack joined RatnerPrestia after receiving his Juris Doctor, Cum Laude, from Temple University School of Law. With the firm, he focuses on patent preparation and prosecution of high-tech inventions in the electrical, electronic and computer fields. Rex



Donnelly received his Juris Doctor, Cum Laude, from Widener University School of Law. He enjoys a well-rounded practice that includes client counseling, litigation, and preparation and prosecution of domestic and foreign patents, trademarks, and copyrights. Rex chairs the firm's trademark practice group and oversees all trademark matters handled by the firm's Wilmington office, including several thousand foreign and domestic marks from the portfolios of a number of corporate clients. Rex is also a co-chair of the firm's litigation practice group.



**Christopher Dervishian** has rejoined RatnerPrestia in the Valley Forge office. Chris had left the firm and served as in-house counsel for a start-up company for which he continues to serve as outside counsel. He had also been associated with a large general practice firm in Philadelphia before returning to RatnerPrestia. Chris has prepared and prosecuted many United States and international

patent applications in the electrical, electronics, and software arts, has drafted opinions regarding patentability and infringement, and is experienced in counseling clients regarding high-tech transactions.

Chris graduated Cum Laude with a J.D. from the Widener University School of Law. He earned his Bachelor of Science degree in electrical engineering from Lehigh University and his Master of Science degree in electrical engineering from the University of Southern California. Chris is admitted to the Pennsylvania Bar, to the U.S. District Court for the Eastern District of Pennsylvania, and is registered to practice before the U.S. Patent and Trademark Office.

**James Abruzzo** and **Phillip Gonzalez** have joined the firm as Associates in the Valley Forge office. Both joined RatnerPrestia after previously working for the firm as summer associates and earning their Juris Doctor degrees from Seton Hall University School of Law.



James, whose experience includes working with a subsidiary of a multi-national corporation as an Applications Engineer and thereafter as a Process Control Engineer in the Catalytic Systems Division of Johnson Matthey, will focus his practice with the firm on patent preparation and prosecution of U.S. patent applications, particularly in the areas of chemicals, pharmaceuticals, biotechnology, and materials. He will also assist in the preparation of opinions of counsel and provide support for due diligence transactional studies and litigation. Phillip has six years of experience as a research chemist for a joint venture between Johnson & Johnson and Merck & Co and also drafted patent applications, responded to office actions,



and participated in market clearance authorization reviews with the corporation's large in-house patent group. His practice will include patent prosecution in the Life Sciences field as well as opinions of counsel and litigation support.

At Seton Hall, Phillip served as vice-president of the law school's Intellectual Property Law Association and graduated Magna Cum Laude. He has a B.S. in Biochemistry from Lehigh University and an M.S. in Pharmaceutical Regulatory Affairs from Temple University's School of Pharmacy. Phillip is a member of the American Intellectual Property Law Association and the American Association of Pharmaceutical Scientists. James was a member of the Corporate Law Association at Seton Hall and graduated from Villanova University with a B.S. in Chemical Engineering and a Minor in Chemistry with a business concentration. He is a member of the American Bar Association and the Paterson Chapter of Phi Alpha Delta Law Fraternity International.

**Brett J. Rosen** has joined the firm as a Patent Agent and **Deborah M. Grove**, Ph.D. as a Scientific Advisor in the Valley Forge office. Brett concentrates his practice on the preparation and prosecution of patent applications related to the Mechanical Arts and gained industry experience as a Senior Design Engineer for Motorola's Broadband Communications Sector (BCS). He contributes more than seven years Mechanical Engineering experience. Deborah, who joined RatnerPrestia after working



as a researcher in the university and corporate sectors, is presently working toward her patent agent registration and brings an in-depth and broad understanding of physics, mathematics, electrical engineering and acoustics to her patent practice.



Brett received his M.B.A. with a Finance concentration from Villanova University and his bachelor's degree in Mechanical Engineering from the University of Pittsburgh. He is a registered Patent Agent admitted to practice before the United States Patent and Trademark Office. Deborah graduated from The Pennsylvania State University with a Ph.D. in Acoustics and holds a bachelor's degree in Physics from The State University of New York College at Fredonia and a bachelor's degree in Electrical Engineering from the State University of New York at Buffalo.

OF COUNSEL TRANSITIONS  
CONTINUED FROM FRONT PAGE

Allan is a past President of The Philadelphia Intellectual Property Law Association. With other attorneys at RatnerPrestia, he was lead author for the chapter on Noninfringement, Invalidity and Unenforceability in the text, *Electronic and Software Patents - Law and Practice*, published by The Bureau of National Affairs, Inc. and is now revising the chapter for a second edition. He has also authored many other articles and participated in numerous professional association programs on computer intellectual property law. Kenneth Nigon, the firm's present Electronics Practice Group Manager, noted that it was under Allan's leadership that RatnerPrestia's Electronics Practice Group became a cornerstone of the firm.

Although Allan had stepped down from the firm's Executive Committee two years ago, he has continued to play an active role in the firm's development and continues to do so. As "Of Counsel" to the firm, he is now actively available to old and new clients for consultation and advice and for supervision and oversight of other attorneys in both the computer-related, business method, Internet and trademark aspects of the firm's intellectual property law practice.

Allan graduated from the Bronx High School of Science in New York City and obtained his electrical engineering degree from Rensselaer Polytechnic Institute. He graduated from the University of Pennsylvania Law School before becoming a member of the Pennsylvania Bar. Early in his career, he was trained and mentored by Virgil Woodcock, one of the founding partners of Woodcock Washburn.

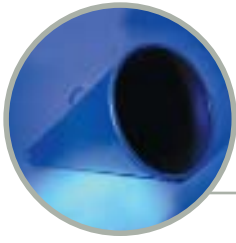
Allan then began his fulltime intellectual property career, first in the patent department of Schlumberger, Inc. and then as Patent Counsel at a leading computer company. He was in private practice in Philadelphia and its suburbs before joining Paul Prestia in 1981 to form Ratner & Prestia.



Joining Allan in a shift are **Jim Simmons** and **Costas Krikelis**, who are also moving to Of Counsel in the Allentown and Wilmington, DE offices respectively, following their retirement as Shareholders in January 2005.

"We thank Jim and Costas for their contributions both to client work and to firm development, and particularly for their assistance in training and mentoring," Paul added.

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# ANNOUNCING

**Benjamin E. Leace**, Shareholder and member of the management committee of RatnerPrestia, appeared Monday, February 28 on the weekly television show, "Law Journal." Attorney Christopher Naughton, a former prosecutor with over twenty years of experience in broadcasting legal issues on television and radio, plans and moderates this award winning law program, which provides in-depth discussion on a variety of specific legal issues. The program is regularly broadcast every Monday for one hour at 8 p.m. in the Philadelphia/Lehigh Valley/Western NJ market.



Ben appeared on Law Journal to discuss, "Patent Infringement, Protection & Litigation," which covered such issues as "sham" patent lawsuits, patents issued on narrow improvement/variation, reduction in standards in patentability, shakedown lawsuits, patent "thickets" and protecting patents in litigation/arbitration/mediation, including injunctive relief.



RatnerPrestia represented the global engineering and manufacturing company, ITT Industries, in the Intellectual Property aspects of the company's recent acquisition of Eastman Kodak's remote sensing business. This effort included a

high-tech due diligence investigation and negotiation of a complex Intellectual Property Agreement. **Bob Seitter**, Chair of RatnerPrestia's IP Business Transactions Department, noted that "ITT's \$725 million investment is a strategic move into the growing satellite imaging market that utilized our high-tech expertise and long experience in the complexities of IP business transactions." The attorneys in RatnerPrestia's IP Business Transactions Department have considerable experience in complex transactions and wide ranging technical expertise necessary in developing due diligence issues and strategic solutions. This experience helps to formulate strategies and achieve results that drive the client's business objectives.

■ Bob's article, "Intangible Assets Create Wealth, But Be Careful," appeared in the March 2005 Intellectual Property Supplement to the *Philadelphia Business Journal*. That article focused on the high value of intangible assets and the need for careful due diligence. To view the full text of this article, visit the IP Library on our firm website ([www.ratnerprestia.com](http://www.ratnerprestia.com)) under Bylined Publications.

**Barbara A. Foley**, the Executive Director and member of the Management Committee at RatnerPrestia, has been elected as one of the Regional Officers of The Association of Legal Administrators (ALA). Formed in 1971, ALA provides support to professionals involved in the management of law firms, corporate legal departments and government legal agencies. Barbara will serve as the Regional Education officer for Region 1 of the Association, which covers New England, the Middle Atlantic States and Eastern Canada and includes over 2,000 members. Associated with ALA for 15 years, Barbara has held a number of offices, including local chapter President and Chair of the Association's national retreat for members involved in intellectual property.



## OF COUNSEL TRANSITIONS CONTINUED FROM PAGE 5



Jim's retirement follows a long and successful professional career as both in-house and outside patent counsel. He joined the firm after taking early retirement from Air Products & Chemicals, Inc., and has been a Shareholder for several years. In 1991, Costas retired from Dupont where he spent over 25 years as a patent attorney in a corporate business unit to enter private practice with the firm Breneman, Georges & Krikelis. In 1997 he joined RatnerPrestia, establishing the firm's Wilmington, DE office.

Ratner & Prestia (now RatnerPrestia) hired its first associate in 1982 and has since become known for its steady growth rate and steadily increasing prominence in the intellectual property law field. It now has over thirty attorneys and patent agents in its offices in Valley Forge, Wilmington and Allentown. Paul added to his earlier comments, that the firm expects to enjoy the personal and professional relationship it has with Allan, Jim and Costas for many years to come.



# SPEAKER'S FORUM

**Jacques Etkowicz** of RatnerPrestia was among a panel of speakers at the recent Partnering in Patents XI Seminar held at the Marriott Crystal Forum in Arlington, Virginia on Wednesday, October 13, 2004. Topics discussed included “Obviousness Rejections” and “Appeal Practice.” Jacques’s presentation, along with co-presenter Christian Bauer, a RatnerPrestia Associate, focused on joint PTO/Patent Bar



practice tips and pet peeves. The seminar was sponsored by the United States Patent and Trademark Office Electrical Technology Centers and The American Intellectual Property Law Association’s Electronic and Computer Law Committee.

**Benjamin E. Leace**, Shareholder and member of the management committee of RatnerPrestia, along with Martin J. Black of Dechert LLP and Jon L. Roberts of Roberts, Abokhair & Mardula, LLC, spoke at the prestigious Technion-Israel Institute of Technology in Haifa, Israel on Wednesday, November 11 in a panel presentation titled “How to Turn Your Research into Shekels, Dollars, Euros, and Yen...for You.” The discussion focused on the protection of intellectual property and enforcement of intellectual property rights in the international marketplace.

**Joshua L. Cohen**, Shareholder of RatnerPrestia, was invited to be a co-panelist at November’s regional meeting of the Product Development and Management Association (PDMA). In his presentation, “IP Protection: Implications for Life Cycle Management,” Josh shared strategies for protecting intellectual property at each stage of a product’s life cycle.



**Christopher J. Dervishian** spoke at the Computer Practice Committee meeting of the Philadelphia Intellectual Property Law Association (PIPLA) on February 17, 2005. Chris’s presentation identified the risks associated with using open source software, including the possible loss of patent and intellectual property rights, and provided guidance for managing those risks.



In New York on January 14th **Harrie Samaras**, Leader of RatnerPrestia’s Dispute Resolution Group, planned and moderated a program on Alternative Dispute Resolution for the New York Intellectual Property Law Association with panel members Peter L. Michaelson, Esq. and David W. Plant, Esq. (two veteran intellectual property neutrals), and Robert B. Whitney, Esq. (Assistant General Counsel of Air Products and Chemicals, Inc.). The program was titled “Mediation in Intellectual Property Cases: Practice Pointers From all Perspectives.” The topics discussed included: selling the client on mediation, getting the right people to participate, investigating the parties’ interests, and preparing both your client and the mediator for mediation.

On January 12th in Washington D.C., Harrie participated in Federal Contracting Institute’s, Intellectual Property Rights under Federal Transactions. This course provided an in-depth understanding of the issues impacting ownership of intellectual property under federal contracts, grants, cooperative agreements and other transactions.

On January 27, **Paul Prestia** coordinated and moderated a plenary session at the mid-winter meeting of the American Intellectual Property Law Association. The theme of the Plenary session was preparing for potential conflicts before they happen.



# INSIGHT...

## INTO BUSINESS APPROACHES TO DISPUTE RESOLUTION



### HOW DO YOU WANT YOUR ADR ADMINISTERED?

Suppose your company finds itself involved in a dispute that has not been resolved by negotiation between business persons or counsel. Or, your company is in the process of negotiating an agreement and the parties are considering alternatives to litigation (e.g., mediation, arbitration) for resolving future disputes. No matter how a company ends up pursuing an alternative dispute resolution (“ADR”) process, the parties should consider how they want the ADR process administered. The typical options to choose from are “administered” ADR and “non-administered” or “ad hoc” ADR. These options will be considered here for arbitration, but they apply in similar respects if parties choose mediation, or some other ADR process.

**Administered ADR:** Administered ADR can occur under the auspices of a court or a private ADR provider like the American Arbitration Association (“AAA”) or World Intellectual Property Organization (“WIPO”). This discussion will focus on private institutions. The principal functions offered by such institutions are to:

- provide a set of rules or procedures to guide the parties through the arbitration process;
- provide administrative staff who manage the case from beginning to end;
- provide lists of neutrals (compiled from a pre-approved roster of neutrals) from which the parties may choose their arbitrator(s);
- appoint the arbitrator; if the parties have not done so in accordance with the prescribed rules;
- decide conflict-of-interest issues that arise involving the arbitrator;
- determine arbitrator fees, bill the parties for the fees, and collect the fees;
- schedule hearings;
- provide hearing facilities;
- serve as the interface between the parties before the neutral is selected and between the parties and the neutral thereafter;
- handle paperwork and distribute documents; and
- provide non-substantive review of awards.

Also, some international institutions such as WIPO provide parties with translation and interpretation services. To render all of these services, the administering institution usually charges a fee for its services in addition to the fees the parties pay for the neutral. Those administering charges typically are related to the amount in dispute, but the rates of individual institutions vary.

There are hundreds of institutions worldwide offering ADR services, so care should be taken in selecting an ADR provider. Parties should not assume that “rules are rules” and that any set of rules applied to both parties are satisfactory. Some institutions are operating under rules which are not

artfully drawn or which may be geared towards a particular trade or industry, rather than the particular needs of the parties. Another consideration is whether the institution is equipped to supervise effectively the arbitration process to avoid negating the reason that the parties selected institutional arbitration over ad hoc proceedings.

**Ad Hoc or Non-administered ADR:** Non- or party-administered arbitration often occurs under the terms of an ADR agreement or provision (e.g., in a license) that pre-selects a neutral or provides the basis for selecting a neutral and calls for the selected neutral to administer the proceeding in accordance with the agreement. One option available to parties proceeding ad hoc, is that they negotiate a complete set of rules establishing procedures which fit precisely the particular needs presented by an existing dispute and/or anticipated by future disputes. This approach can require considerable time and expense without yielding proportional benefits. Non-administered ADR, however, may also involve an ADR institution like the CPR Institute for Dispute Resolution ("CPR") and its rules. CPR provides a set of rules and, for a fee, they will nominate arbitrators from their roster of pre-approved candidates and assist the parties in selecting an arbitrator panel.

Other options available to parties wishing to proceed ad hoc are to: (i) use generally accepted rules such as those of AAA, CPR or UNCITRAL (United Nations Commission on International Trade Law) and, in the case of AAA, excising from the rules any provisions requiring administration of the arbitration by AAA; (ii) proceed as in (i) but either before the arbitration panel is constituted or after, tailor the rules to fit the parties' own needs; or (iii) simply insert an ad hoc provision copied from another contract. The third approach is not recommended because it may result in unintended procedural and substantive consequences arising from the fact that the parties may not be aware of all the facts and circumstances underlying the negotiated provision or the legal implications of certain aspects of it.

Properly structured, ad hoc arbitration can be less expensive than institutional arbitration. Ad hoc arbitration places more of a burden on the arbitrator(s), and to some extent upon the parties, to organize and administer the arbitration in an effective manner. A principal difference between proceeding under UNCITRAL or CPR rules, rather than the rules of an administering institution (e.g., WIPO) is the absence of case management support, which many consider a substantial detriment. That perceived deficiency can be an advantage to others in that the arbitration and the parties are not burdened with the costs and expenses accompanying institutional arbitrations. Another consideration in choosing the ad hoc approach is that its effectiveness may be dependent upon the willingness of the parties to agree to procedures at a time when they are already in dispute. That disadvantage can be mitigated if the parties adopt well recognized rules, modifying them if necessary, to meet their particular needs.

Regardless of whether you proceed with administered or non-administered arbitration, take the time to read the rules that you have chosen to govern the arbitration proceeding.

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You have choices and we're here to help you make the best ones.

*Harrie Samaras*  
*RatnerPrestia's Dispute Resolution Group Leader*

## TRAINING SESSION

SUPPORT STAFF TRAINING: AN "INVESTMENT" IN MARKETING AND MORALE

In this growing field of intellectual property, attorneys and the staff who support them share a common goal: to produce quality work product for the firm's diverse clientele. Furthermore, attorneys and managers also share a common goal: to provide an environment in which these staffers can learn and thrive. The latter is a key component in maintaining a staff with a high level of skill and proficiency. Therefore, the path to accomplishing both goals was clear and the firm has reintroduced its highly successful Support Staff Training course.

This training spanned over a seven week period and, contrary to the previous course launched in 2001, combined both introductory and advanced topics of intellectual property law. Collectively, from both managers and senior level attorneys, dozens of hours have gone into the development of these one hour per week interactive lectures. A training session of this nature, one that hones in on core-competencies expected from a newly hired support staff employee as well as polishes and develops the more advanced skills of an experienced one, is the firm's investment in its staff.



So why make an "investment" that requires such a large firm commitment? Not only will this investment focus on encouraging the staff to feel valued and integral in the final work product, helping them to provide unmatched support, but will also empower them with the knowledge and confidence necessary in sustaining the firm's exceptional reputation. An additional benefit of the course is the generation of firm marketers outside of the workplace, a point stressed by the firm's Executive Director, Barb Foley and course instructors, Josh Cohen and Jonathan Spadt. In a field such as Intellectual Property Law, where there exists a multitude of technical aspects, it is valuable to have a detail-oriented staff armed with the knowledge needed to interact with clients on a daily basis as well as any prospective clients interested in what the firm can provide. "It is almost impossible to over-emphasize the importance of quality staff," noted Jonathan.

Through this training session all common goals are realized, making this "investment" win/win. Clients benefit from the quality of work they receive, attorneys and managers can rest assure that the firm is supported by, and will retain, a fast growing team of competent individuals, and the staff is confident that their outstanding efforts are acknowledged, valued, and indispensable.

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Instructors Jonathan Spadt (shown left) and Josh Cohen, two Shareholders of the firm, spent roughly 3 hours of preparation time before instructing each weekly session of about 25 support staff.

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RatnerPrestia specializes in patent, trademark, and copyright matters and realizes an obligation to keep its clients, and others, informed in those areas. The articles in this newsletter are intended to provide only a brief, general overview of each subject and are not necessarily the opinion of this firm. Nothing herein should be construed as legal advice. RatnerPrestia recommends that readers seek specific information and/or legal advice on particular matters of concern.

Insight is published by RatnerPrestia. The firm welcomes your articles, ideas for articles, comments, and suggestions.

Please contact Jonathan H. Spadt, the editor, at our Valley Forge Office.

Email: [insight@ratnerprestia.com](mailto:insight@ratnerprestia.com) • [www.ratnerprestia.com](http://www.ratnerprestia.com)

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**VALLEY FORGE**  
SUITE 301  
ONE WESTLAKES, BERWYN  
P.O. BOX 980  
VALLEY FORGE, PA 19482  
PH (610) 407 0700  
FX (610) 407 0701

**WILMINGTON**  
SUITE 1100, NEMOURS BUILDING  
1007 ORANGE STREET  
P.O. BOX 1596  
WILMINGTON, DE 19899  
PH (302) 778 2500  
FX (302) 778 2600

**ALLENTOWN**  
SUITE 265  
COMMERCE CORPORATE CENTER  
5100 TILGHMAN STREET  
ALLENTOWN, PA 18104  
PH (610) 530 8100  
FX (610) 530 8200