

insight

A RATNERPRESTIA PUBLICATION

VOLUME 18 NUMBER 3 WINTER 2008

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PRACTICAL STRATEGIES FOR PROACTIVE RISK MANAGEMENT: PATENT OPPOSITIONS IN EUROPE AND ELSEWHERE

BY: JOSHUA COHEN

Managing risk is a critical function of all business concerns. This is certainly true in the realm of intellectual property, where new product and technology offerings pose a risk of infringing rights of others. A prospective risk will provoke defensive risk management measures when it matures into an asserted business threat. But it is better to anticipate and sidestep that risk before it matures into a business threat—proactive risk management is the preferred course.

Several tools facilitate proactive risk management in the IP context. One such tool—the patent opposition—allows parties to challenge suspect patent rights after they are granted.

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COMPULSORY PATENT LICENSING: WHAT'S THE ROYALTY?

BY: BRETT ROSEN

The Court of Appeals for the Federal Circuit (Federal Circuit), in a footnote and with reliance on judicial precedent, has sanctioned post judgment infringement after denying injunctive relief by ordering an infringer to pay an ongoing royalty. The patent statute provides no guidance with respect to how that ongoing royalty should be determined and the Federal Circuit has offered no such guidance. Instead, the Federal Circuit has strongly urged the parties to negotiate their own royalty for post trial infringement.

Prior to the Supreme Court's 2006 decision in *eBay v. MercExchange*, a patent owner in a successful patent infringement action obtained injunctive relief almost as a matter of

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PRACTICAL STRATEGIES FOR PROACTIVE RISK MANAGEMENT

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Recognizing the motivation of interested parties to uncover strong bases to challenge such patent rights, oppositions effectively provide them an opportunity to participate in a final stage of the patent examination process.

The European Patent Office (EPO) is one of several patent examination authorities that provide for opposition proceedings. Oppositions filed in the EPO can challenge the validity of claims of a granted European patent based on novelty—or inventive step—destroying prior art. They can also establish that subject matter has been added to the European patent impermissibly or that its disclosure is insufficient.

EPO oppositions provide an effective tool for proactive risk management. They may have one of three outcomes—the patent may be upheld as granted, it may be amended to distinguish prior art or to correct deficiencies, or it may be revoked entirely. EPO oppositions often result in the amendment or revocation of granted patent claims. In fact, the outcome most severe to the patentee—revocation—occurs in over one-third of all oppositions.

Additionally, the EPO opposition procedure is a centralized process for challenging European patents on a regional level. The EPO is unique in that it is a centralized patent examination authority that grants patents that take effect in all selected European countries. It also provides a centralized opposition proceeding—any party can oppose a European patent within 9 months after it is granted. A successful EPO opposition therefore impacts the patentees' rights in every selected European country.

The use of EPO oppositions for proactive risk management therefore confers significant advantages, especially when contrasted with the business threat posed by an unopposed European patent:

- One regional EPO opposition can obviate the need to later invalidate a European patent at the national level in each selected country. If no opposition is filed, however, the validity of a European patent must be challenged under the laws of the selected European countries.
- Significant differences among the laws of European countries drive up the cost of patent challenges in each European country. A strategy employed in one country may not be appropriate or successful in another.
- Outcomes of litigations in each European country are restricted to that country. Invalidation of a European patent in France for example will not affect its validity in Germany.

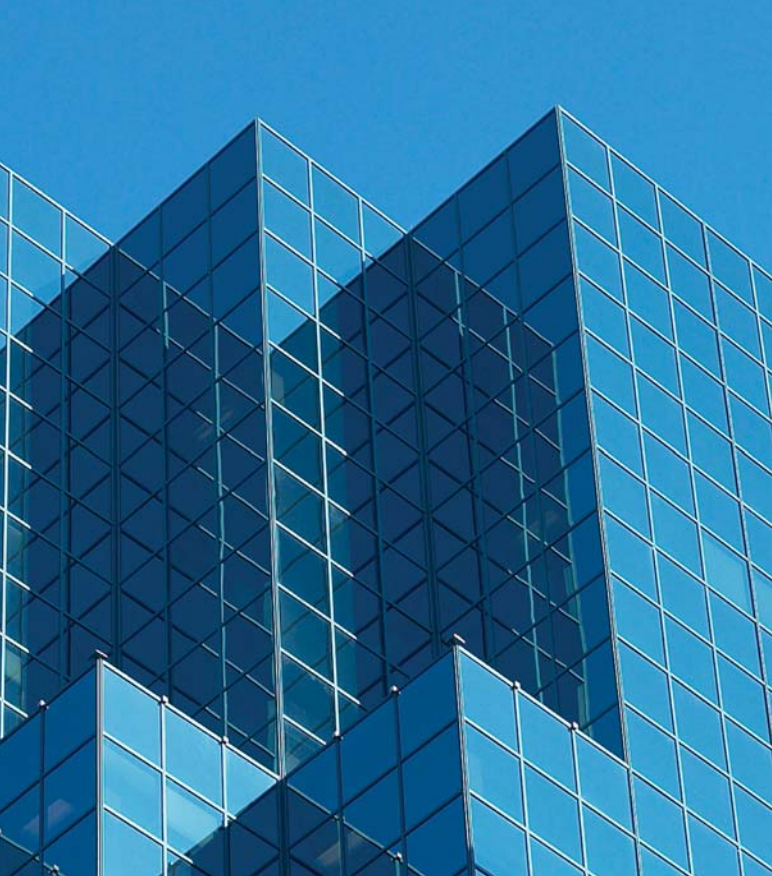
Though EPO oppositions provide an opportunity to challenge European patents in a regional proceeding, only a small percentage of European patents—about 5 percent—are opposed. Put simply, the EPO opposition is a powerful yet underutilized tool for proactive risk management.

When EPO oppositions are adopted as a risk management tool, they should be tailored to meet predetermined objectives. A three-phase framework has proven to be especially effective. It includes (1) a targeted monitoring regimen that identifies European patents and applications that pose an actual or prospective risk, (2) a focused search that finds key prior art relevant to a patent selected for opposition, and (3) a strong opposition including grounds tailored to achieve specific risk management objectives.

TARGETED MONITORING REGIMEN

Targeted monitoring identifies those European patents and pending patent applications that may pose a risk to current and prospective commercial activities. It should be designed to identify patent properties that are owned by known competitors, that name inventors prolific in the relevant field, that are classified in the technology area of interest, and that are related to previously identified patents of interest.





the proposed U.S. opposition system, although procedural details of the proposed U.S. system remain controversial. Japan, China and other major countries' patent systems have included various forms of either pre- or post-grant opposition procedures for some time but the EPO system seems to have avoided some of the disadvantages of other systems. The only precedent for an opposition procedure in the U.S. has been the U.S. *Inter Partes* Reexamination system, instituted in 1999. That system has not been widely used. Critics of that system usually focus on the procedural limitations it imposes on the parties during reexamination and later in litigation and on the inefficiency of the U.S. Patent Office in administering the system.

Asserted business threats prompt defensive risk management measures, but they also distract businesses from profit-oriented activities, require late-stage technology shifts, and frustrate established business plans. But proactive risk management in the arena of intellectual property can avoid or reduce risks before they mature into asserted threats. Thoughtful EPO opposition strategies—such as those developed using the three-phase framework outlined in this article—have proven successful in confronting the risks posed by European patent rights. Those strategies also provide a powerful tool for proactive risk management in other jurisdictions where patent oppositions are now (or are soon-to-be) available. ■

FOCUSED PRIOR ART SEARCH

If a patent is targeted for opposition, a focused search is performed to identify prior art establishing that the invention claimed in the patent lacks novelty or inventive step. That search should target the key features relied upon by the EPO examiner for patentability. Those features may be found in a so-called “characterizing clause” of the claims, which separately recites the features that purportedly distinguish the claimed invention from the prior art. Key features are also revealed in the written communications between the patent applicant and the EPO examiner. Using such key features as a guide, focused search guidelines are prepared for use by a search professional having relevant experience and technological expertise.

STRONG OPPOSITION GROUNDS

To prepare an effective EPO opposition, it is important to follow a strategy that can best accomplish specific risk management objectives, whether those objectives are to revoke the European patent entirely, to force amendment of the patent claims in a particular way, or to attack specific claims of the European patent. This requires an understanding of the objectives, the substantive and procedural laws of the EPO, and the technology claimed in the European patent. It is also important to confer with European counsel, especially for opposition grounds that challenge the European patent on formal matters such as added subject matter and insufficiency of disclosure.

An opposition system like that of the EPO is not yet available in the United States, but such a system appears inevitable. Recent proposed legislation included an opposition system in which a party would be able to request the U.S. Patent Office to cancel or amend a granted patent. The EPO opposition system served as a model for

“To prepare an effective EPO opposition, it is important to follow a strategy that can best accomplish specific risk management objectives...”

COMPULSORY PATENT LICENSING

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routine. In *eBay*, the Court unanimously rejected the routine entry of permanent injunctions in patent cases and held that district courts should apply the traditional four factor test applied in every other type of case. These factors are (1) irreparable injury, (2) inadequate remedy at law (e.g. inadequacy of money damages), (3) balance of hardships between the parties, and (4) the public interest.

A review of post *eBay* decisions reveals that in most cases where the successful patentee and infringer were competitors, permanent injunctions were granted. With some minor exceptions, in those cases where the successful patentee and infringer were not competitors, permanent injunctions were denied. The courts are focusing on the irreparable injury factor.

What then is the successful patent owner entitled to if injunctive relief is denied? An ongoing royalty? Another lawsuit? What then is the dilemma facing the infringer who must choose between either voluntarily discontinuing infringement (some have done so) or continuing the infringement with an uncertain ongoing royalty?

Title 35 of the U.S. Code contains no explicit authority for the courts to order an ongoing royalty or a compulsory license for future infringement. There is no statutory prescription or legislative history that provides a guide as to how an ongoing royalty should be determined.

In at least one district court decision, the court presumed it had the power to condone future infringement of the patent owner's rights by ordering the infringer to pay a proscribed ongoing royalty for future infringement. The Federal Circuit has affirmed this presumption and has raised, but not answered, a thorny question: how will the ongoing royalty be determined?

In *Paice v. Toyota Motor Corporation*, an action in the Eastern District of Texas, the Texas court denied injunctive relief to *Paice*, the successful patentee, and imposed an ongoing royalty that allows Toyota to continue practicing the *Paice* invention after the conclusion of the litigation. The Texas court found that the ongoing royalty for future infringement was the same royalty found by the jury to be a reasonable royalty for past infringement.

On appeal, *Paice* argued, inter alia, that the district court did not have the statutory authority to issue an order granting a compulsory license for post-judgment infringement. In a 2007 decision, with a concurrence by Judge Rader, the Federal Circuit disposed of *Paice*'s arguments and affirmed the court's authority to fashion a remedy imposing an ongoing royalty for future infringement.

Footnote 13 in the majority decision distinguished between an ongoing royalty and a compulsory license. According to the majority, an "ongoing royalty" is "an equitable remedy" and is limited to one defendant with "no implied authority in the court's order ... for any other auto manufacturer" to so infringe the patent, whereas a compulsory license "implies that anyone who meets certain criteria has congressional authority to use that which is licensed." Footnote 13's definition of a "compulsory license" is based on Copyright law at 17 U.S.C. 115, "Scope of exclusive rights in nondramatic musical

works: Compulsory license for making and distributing phonorecords."

The *Paice* majority went on to cite the Federal Circuit's 1985 decision in *Shatterproof Glass v. Libbey-Owens Ford* as precedent for the court's authority to order an ongoing royalty for future infringement. In *Shatterproof*, the Federal Circuit implicitly condoned the district court's authority to grant a "compulsory license" (the *Shatterproof* court's words). In *Paice*, the Federal Circuit noted that in *Shatterproof*, there was "no dispute as to the district court's authority to craft such a remedy." In *Shatterproof*, however, neither the parties nor the court questioned the court's authority to set a post-judgment royalty. The parties in *Shatterproof* only appealed with respect to the amount which was set at the same rate as the pre-verdict royalty.

In the Federal Circuit's *Shatterproof* decision there is no discussion of the court's authority nor of the district court's method of determining the compulsory license royalty. The *Shatterproof* court simply affirmed that authority and held that the trial court was not clearly erroneous and had not abused its discretion in setting the amount of the "compulsory license" royalty.

In further support of the court's authority to order an ongoing royalty in a patent case, the *Paice* majority relied on the Supreme Court's antitrust decision in *United States v. Glaxo*. In *Glaxo* the Court condoned compulsory licensing as a remedy to "cure the ill effects of the illegal conduct" of the patentee. In contrast, the patentee in *Paice* was a victim of patent infringement and had not performed any illegal act, thus, there were no ill effects to cure.

In *Paice*, the Federal Circuit held that "Under some circumstances, awarding an ongoing royalty for patent infringement in lieu of an injunction may be appropriate." The court did not explain those circumstances.

The Federal Circuit remanded *Paice* to the district court for an explanation of how the ongoing royalty was determined. The majority suggested that the district court "may take additional evidence if necessary to account for any additional economic factors arising out of the imposition of an ongoing royalty." These additional economic factors were not explained.

In his concurrence Judge Rader noted that "pre-suit and post judgment acts of infringement are distinct, and may warrant different royalty rates given the change in the parties' legal relationship and other factors." Indeed the parties' legal relationship has changed. The defendant's future infringement would now appear to be willful and that logically implicates treble damages and attorney's fees under 35 U.S.C. 284 and 285. The "other factors" were not explained.

The *Paice* majority noted that "the district court may wish to allow the parties to negotiate a license amongst themselves regarding future use of the patented invention before imposing an ongoing royalty." Judge Rader's concurrence advises that the "trial court's discretion should not reach so far as to deny the parties a formal opportunity to set the terms of a royalty on their own."

Judicially created compulsory licensing is here. What is not here is any Congressional or judicial guidance regarding the determination of an appropriate royalty for that license.

As noted, 35 U.S.C. 284 and 285 might well be implicated in determining the amount of the ongoing royalty. Judicial interpretation of these statutory provisions shows that courts will enhance damages up to three times and award attorneys fees in cases where the infringer acted willfully.

In its 2008 decision in *Amado v. Microsoft*, the Federal Circuit considered whether treble damages was a factor in setting the ongoing royalty. In *Amado*, the district court awarded a royalty of \$0.04 for pre-verdict infringement and stayed an injunction pending appeal. The Federal Circuit affirmed the district court's decision and, on remand, the district court applied the willfulness factor, trebled the pre-verdict royalty and awarded a royalty of \$0.12 for infringement during the appeal.

Amado went back to the Federal Circuit and, in early 2008, that court held that "willfulness is not the inquiry when infringement is permitted" and that "trebling the amount the jury found to be a reasonable royalty, began with a faulty premise, because as we have noted, that damages award was based on pre-verdict infringement." *Amado* provides no other guidance regarding the method of determining the ongoing royalty.

Per *Amado*, starting with the pre-verdict royalty is a faulty premise. In *Shatterproof*, however, the Federal Circuit, with no discussion, affirmed an ongoing royalty rate that was the same as the pre-verdict royalty rate.

Confusion abounds. Patent litigants now face complex issues that will undermine settlement negotiations and put the parties back before the court. Until the courts decide the other factors that bear on the amount of a post-verdict or post-judgment royalty, the parties lack the tools to negotiate it. Stay tuned. ■

“There is no statutory prescription or legislative history that provides a guide as to how an ongoing royalty should be determined.”



Stephen D. Harper

RatnerPrestia is pleased to announce that **Stephen D. Harper**, Ph.D. joins the firm's Chemical, Biotechnology, Pharmaceutical and Materials Patent Prosecution Group as Counsel. Steve has over twenty years of intellectual property law experience, having most recently served as Chief Patent Counsel for Henkel of America, Inc., where he managed Henkel's U.S. patent department and provided patent support and counseling to several of Henkel's business units.



Zachary Fansler

Zachary Fansler and **Andrew Koopman** join the firm after earning their Juris Doctorates from Temple University Beasley School of Law. At Temple, Zach served as the student Bar Association President and the President of the Intellectual Property Law Society. Zach was also a two time member of Temple's Intellectual Property Moot Court team. Andrew Koopman was the Vice President of the Intellectual Property Law Society at Temple and served as a staff writer for the Temple International and Comparative Law Journal. Andrew was also a member of Temple's Intellectual Property Moot Court team.



Andrew Koopman

ANNOUNCING



Paul Prestia



Chris Rothe

"Generic Versions of Biologics: The Problem and a Possible Solution," **Paul Prestia's** September Column in *The Legal Intelligencer*, was republished in the IPO Daily News, the online publication of the Intellectual Property Owners Association.

Chris Rothe recently published an article titled "Patents in Structural Engineering" in the November, 2008 issue of STRUCTURE® Magazine. STRUCTURE® is a joint publication of the National Council of Structural Engineers Associations (NCSEA), the Structural Engineering Institute of the American Society of Civil Engineers (ASCE), and the Council of American Structural Engineers (CASE). The article is the second in a series of articles Chris is contributing to the magazine's Legal Perspectives section.



Harrie Samaras



Lauren Schmidt

RatnerPrestia is pleased to announce that **Chris** has been honored as a 2008 Pennsylvania Rising Star for Intellectual Property Law by *Law & Politics* magazine. Pennsylvania Rising Stars are published in *Super Lawyers — Rising Stars Edition* magazine and *Philadelphia Magazine*.

Harrie Samaras and **Lauren Schmidt** Published, "When is a Settlement Settled?" in the October 27, 2008 Litigation Supplement to *The Legal Intelligencer*. The article discussed how to determine when a settlement is reached, how a party may upset a settlement, and what recourse is available when one party backs out of a settlement agreement.



Joy Mulholland



Robert Esposito

Joy Mulholland served as a finalist judge for Temple University's 11th Annual Innovative Idea Competition. The competition was sponsored by the Innovation and Entrepreneurship Institute at the Fox School of Business. For more information on the winning ideas, you can visit <http://sbm.temple.edu/iei/idea.html>.

Robert Esposito's paper, entitled "Parallel Architecture Implementation of a Reliable (k,n) Image Sharing Scheme" was accepted to The 14th IEEE International Conference on Parallel and Distributed Systems.



Ben Leace



Jacques Etkowicz

The Early Fall Venture Forum of Mid-Atlantic Diamond Ventures was sponsored by RatnerPrestia in September and held at the Merion Cricket Club in Haverford, PA. The venture forum featured presentations by six early stage science and technology companies from the mid-atlantic region. RatnerPrestia attorney **Ben Leace** hosted the presentations and introduced each company.

Jacques Etkowicz was recently appointed as Vice Chair of the Electronic and Computer Law Committee of the American Intellectual Property Law Association (AIPLA).



Ken Nigon



Chris Lewis



Peter Zacharias



Stephen Weed



Robert P. Seitter



Jonathan H. Spadt



Chris Dervishian



Joshua L. Cohen

Ken Nigon will be speaking at the AUTM 2009 Annual Meeting February 12–14, 2009 in a workshop entitled “You Can’t Patent That, Can you?” addressing the patentability of business methods.

On December 12, **Ken Nigon** co-presented a webinar for the American Intellectual Property Law Association (AIPLA), entitled “How to Protect Your Process Inventions After Bilski”. In *Re Bilski* is not limited to Business Method patents and its broad guidance on process claims affects all technical disciplines. In this presentation, participants learned the key elements of the majority opinion, concurring opinion and three dissenting opinions. Participants also learned some practical tips for drafting patent-eligible process claims.

On November 18, **Harrie Samaras** presented, “Strategies and Current Trends for Policing, Enforcing and Resolving Disputes about Intellectual Assets” at the American Institute of Chemical Engineers (AIChE) Annual Meeting in Philadelphia.

On November 18, **Chris Lewis** presented, “Strategies and Current Trends for Protecting Intellectual Assets in the Face of Recent Developments; Is the ‘Patent Office’ Becoming the ‘Rejection Office?’” at the American Institute of Chemical Engineers (AIChE) Annual Meeting in Philadelphia.

On November 13, RatnerPrestia shareholders **Robert P. Seitter** and **Jonathan H. Spadt** spoke to the 21st Century America-Korea-China Leaders Society, where they presented an overview of Joint Venture and Joint Development Agreements with an emphasis on such arrangements with foreign entities.

Jacques L. Etkowicz, was among a panel of speakers at the “Nuts & Bolts” program held at Temple University in November. Nuts & Bolts is a job fair for Temple Law students, which gives them a chance to learn about the day-to-day life of legal professionals from fifteen different concentrations of law.

Jacques, along with **Peter Zacharias**, presented “Pet Peeves of the Patent Bar and USPTO in The Prosecution of Patent Applications” during the 15th Annual “Partnering in Patents” Seminar held at the United States Patent and Trademark Office (USPTO) in October.

Stephen Weed and **Peter Zacharias** spoke at the 15th Annual “Partnering in Patents” Seminar at the USPTO on October 22nd, 2008. The program, which is sponsored by the Electrical Group of the USPTO and the Electronic and Computer Law Committee of the American Intellectual Property Law Association (AIPLA), provides for an exchange of information between the USPTO and the Patent Bar.

Robert Seitter recently spoke at the Current Issues in Complex IP Licensing Seminar presented by Law Seminars International in Philadelphia. Bob presented current issues and trends in international licensing transactions, including US Export Control Regulations, European Union Trade Regulation and China’s new Monopoly Law.

RatnerPrestia recently hosted members of the Delaware Valley Chapter of the Association of Corporate Counsel (DELVACCA) for a CLE accredited Seminar titled, “What Every GC Should Know About IP”. RatnerPrestia Shareholders **Chris Dervishian**, **Rex Donnelly**, **Chris Lewis**, and **Robert Seitter** covered recent IP trends and issues that directly affect Corporate Counsel. Also joining RatnerPrestia attorneys on the panel were Michele Pilotte, Associate General Counsel of Johnson Matthey, and Alex Plache, Senior IP Counsel for Saint-Gobain Corporation.

Joshua L. Cohen recently presented a lecture about IP strategies to graduate and undergraduate students enrolled in Lehigh University’s Integrated Product Development (IPD) program. The lecture, which was broadcast to students located around the country, discussed strategies for promoting product differentiation, principles of comprehensive IP protection, and best practices for integrating IP strategies into product development efforts.

TRADEMARK CORNER...



10TH CIRCUIT APPLIES MEDIMMUNE TO TRADEMARK DISPUTE

By: Rex Donnelly

Trademark owners who are parties in TTAB proceedings, or are the recipients or senders of cease and desist letters, should know that the Supreme Court's decision in *MedImmune* has changed the landscape and lowered the bar for declaratory judgment (DJ) jurisdiction for trademarks as well as patents.

Last July, the U.S. Court of Appeals for the 10th Circuit issued a decision in *Surefoot LC v. Sure Foot Corporation*, 531 F.3d 1236 (10th Cir. 2008), an appeal from the United States District Court for the District of Utah, adopting for the first time in a trademark case the standard articulated by the U.S. Supreme Court in *MedImmune, Inc. v. Genentech, Inc.*, 549 U.S. 118, 127 S. Ct. 764, 166 L. Ed. 2d 604 (2007), which was a patent case. *MedImmune* overturned the body of Federal Circuit caselaw holding that "a reasonable apprehension of imminent suit" was required to bring a declaratory judgment action involving intellectual property claims. In *MedImmune*, the Supreme Court held that *MedImmune, Inc.* did not have to cease payment of royalties pursuant to a license agreement (thus creating a breach that would have provided a reasonable apprehension of suit) prior to bringing a declaratory judgment action seeking invalidation of the patent on which the royalty was due. The 10th Circuit *Surefoot* decision marks the first time the *MedImmune* rationale has been applied in a trademark DJ action.

The plaintiff in *Surefoot* had been embroiled for several years in a dispute over use and registration of its **SURE FOOT** trademark. The defendant in *Surefoot* had previously asserted trademark rights in the mark **SURE FOOT**, both in correspondence with the plaintiff, and in numerous TTAB proceedings. In light of the long history and pending TTAB matters without specific threats of further litigation, the Utah District Court ruled that the plaintiff did not have a reasonable basis to fear imminent litigation, and dismissed its declaratory judgment action. The 10th Circuit Court of Appeals reversed and remanded.

The 10th Circuit held that *MedImmune* abolished the "reasonable apprehension of suit" test not only for patent cases and for cases in which the parties had a privity relationship pursuant to a licensing agreement, but also for trademark cases in which no such relationship exists. The Court found the salient question to be "whether the facts alleged, under all the circumstances, show that there is a substantial controversy, between parties having adverse legal interests, of sufficient immediacy and reality to warrant the issuance of a declaratory judgment."

The Court looked at the five pending TTAB oppositions filed by the defendant, combined with an extensive history of interactions between the parties in which the defendant expressly and repeatedly suggested historical and continuing infringing activity by the plaintiff, and found that a substantial controversy existed. The Court emphasized that the District Court's power to accept jurisdiction was not the same as answering the discretionary question of whether the District Court *should* entertain that jurisdiction. As a result, the Court of Appeals remanded the case to the District Court to decide, based upon equitable factors, whether to exercise its jurisdiction.

The Court underscored that it had no need to "pass on what *MedImmune* means to a case where the only indicia of a live infringement controversy is the existence of a single TTAB opposition proceeding, or perhaps a single cease and desist letter." Instead, the Court emphasized that its decision was based on the specific facts of the case. Nonetheless, unlike patent infringement cease and desist letters, which prior to *MedImmune* typically attempted to avoid a DJ action by cautiously recommending a license rather than accusing anyone of outright infringement, trademark cease and desist letters historically have almost always alleged infringement and demanded that the infringement stop. Thus, trademark cease and desist letters have historically carried with them a greater likelihood of resulting in a DJ action.

The change brought by the *Surefoot* decision may be that a TTAB defendant who has not only registered or attempted to register a mark, but is also actually using the mark in question, may wish to consider filing a DJ action in Federal Court to resolve the issue of use and registration in a single proceeding. Particularly where the TTAB decision may not resolve all of the issues between the parties, or where the TTAB defendant believes that TTAB plaintiff has grossly overstated the scope of its trademark protection to the extent that it may be able to recover costs, the TTAB defendant may wish to consider a DJ action as an alternative forum or as a means to foster a settlement. TTAB plaintiffs hoping to avoid some of the costs and formalities of district court litigation by confining the dispute to the TTAB may wish to consider whether the risk of a DJ action in an unfriendly forum counsels filing a lawsuit in the forum of its own choice before the defendant files first. If the parties wish to have the matter decided by the TTAB alone, they can then reach an agreement to suspend or withdraw without prejudice the district court action and not to file a DJ action at least until the TTAB renders its decision.

Bex Donnelly
Managing Shareholder of RatnerPrestia's Trademark Center,
located in Wilmington, Delaware.

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with an attorney. Comments on insight® and suggestions for future articles may be submitted to the editor, Christopher A. Rothe, Esquire, at our Valley Forge Office.

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