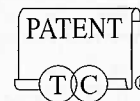


INSIGHT[®]



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20th Anniversary Issue 2001

This newsletter is provided with our compliments. Its purpose is to inform our readers of developments within the firm and in the legal field of intellectual property law. We invite your comments, questions, and opinions.

20 Years - An Epoch for the Patent System and for R&P

by Paul Prestia and Allan Ratner

When we formed Ratner & Prestia, merging our two solo practices in 1981, patents were disdained by many economists and many courts. The U.S. had lost its competitive edge in the international economy. Rampant inflation had driven the prime rate over 20% and law firms were satisfied if attorneys booked 1400 billable hours per year.

Oh, how times changed from 1981 to 2001. As we celebrate the twentieth anniversary of the firm, we now have three offices and over thirty attorneys and patent agents, many of whom are recognized leaders in their profession. And as we grew, intellectual property became one of the hottest areas of the law. How it all happened makes for an interesting perspective.

Whether seen as cause or effect, the Reagan era ushered in a renewed U.S. commitment to commercial and industrial innovation and leadership.

An important aspect of that devel-

opment was the rediscovery of the patent system. Designed, according to the Constitution, "to promote the progress of science and useful arts," the patent system had fallen out of favor because of the perception that it fostered monopolies. Monopolies, in any form, were anathema under the prevailing wisdom of the 60's and 70's.

This changed as businesses recognized that innovation was necessary to compete in the international marketplace, that innovation required investment, and that the best way to protect that investment

was the patent system. At the same time, Congress too saw the light. Patents had fallen in disrepute and were commonly invalidated by hostile courts, a problem exacerbated by the disparate treatment of patents in different regional courts of appeal.

To remedy this, Congress, in 1982, established a new Federal Circuit Court of Appeals to hear all patent appeals. Since then, this Court has assiduously tried to develop a more uniform and more predictable application of patent law.

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Ratner & Prestia Celebrates its 20th Anniversary

The associates of Ratner & Prestia recently surprised Paul Prestia and Allan Ratner with a luncheon in their honor as the firm celebrates its 20th anniversary year. Eighty-three employees of the firm were involved in planning the event and were charged with the momentous task



Paul and Allan are all smiles in front of over 80 employees at their surprise celebratory luncheon.

of keeping the secret from Paul and Allan for nearly two months.

Jonathan Spadt, a senior associate, developed the idea for this celebration during a brainstorming ses-

sion for 20th anniversary plans. "We wanted them to know that their incredible commitment to the development of the firm and its lawyers

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Support Staff Training Our Secret to Safeguarding "Human" Intellectual Property

by *Barbara A. Foley, Executive Director*

Law firms across the nation are faced with the challenge of recruiting and retaining experienced secretarial and support staff members, and the Philadelphia region is no exception. Employers are having difficulty retaining good support staff and this difficulty is not always due to the employers' failing. With the plethora of job opportunities being touted by recruiters and over the Internet, it is easy for employees to get derailed during rough times and leave for what they perceive to be a better opportunity. The time and money spent during the recruitment search and hiring process is only the beginning of a process leading to a loss of efficiency during the new employee spool-up period.

R&P recognizes the value and critical importance of informed and well-trained administrative assistants and legal support staff. We have hired wisely and are fortunate to be staffed with an abundance of talented administrative assistants. Unfortunately, talent alone is not enough - particularly in our specialized and evolving field of intellectual property law. Administrative staff not only needs to master (and hopefully exceed) specific core competencies, but they also need to stay abreast of changes in the law and how those changes may affect their daily tasks.

To empower its staff with the confidence to produce quality work product, R&P saw a need for training and education to provide a higher level of assistance to our attorneys, and ultimately to the value provided to our clients. It was clear the onus was on us to provide that training. That being said, we embarked on our journey to develop and provide to all our support staff a value-generating training program.

The firm developed, and remains committed to, a long-range development program. Formulating the actual program is only a primary task. Providing continuing education

and training to staff meant commitment from the lawyers and experienced staff members who are qualified to train. One component of our program is a support staff introductory training course in intellectual property law. This course is mandatory for all staff and covers the gamut of IP Law, from who can actually apply for a patent, to trademark protection and procedural issues relating to the firm's litigation matters. Two of our shareholders on the committee share the responsibility of teaching this course, which is offered several times a year in five, one-hour sessions. A second, advanced course is also in place that is similar in structure and opened to all support staff on a voluntary basis.

There are numerous components to R&P's support staff training program other than the two courses mentioned above. One in particular, the establishment of core competencies, is particularly noteworthy. The firm has identified core competencies that must be mastered by administrative assistants in order to provide appropriate support to R&P's attorneys. These competencies are specific to our practice area and go far beyond the employer expectations normally seen on evaluation forms. Prior to beginning our mandatory "Introductory IP Course," each new staff member is given the core competency form for review and made aware of the firm's expectations. During that staff member's first evaluation the form is used to identify deficiencies and areas where increased training may be needed. Not forgetting our advanced support staff, we have developed training and defined advanced competencies to be achieved.

As part of their first day orientation, new administrative assistants receive a one-hour informational Intellectual Property Introduction

given by a senior associate. They receive a binder of sample forms which gives them quick, easy access to a broad library of information along with a glossary of terms specifically relating to intellectual property. The training program also has a strong mentoring component which gives new support staff direct access to an experienced staff member for questions, concerns and on the spot training.

The development and implementation of our support staff program was a win/win situation. The staff, the attorneys and the firm and its clients are all beneficiaries of this program. ■

Paul F. Prestia Named Chair of AIPLA Fellows

Paul Prestia has been appointed Chair of The Fellows of the American Intellectual Property Law Association. The AIPLA Fellows was established to assist the Association with scholarly, educational research, and informational projects. At the time it was established, Paul was one of twenty senior Association members named as Charter Fellows. Criteria for selection as a Fellow of the AIPLA include prominence within the intellectual property profession, learned contributions to the profession and observance of the highest standards of ethical conduct. The American Intellectual Property Law Association is a national organization of intellectual property lawyers with over twelve thousand members. ■

R&P Celebrates

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does not go unnoticed by the associates," commented Jonathan.

The celebratory luncheon was a huge success. The associates, support staff, management team, and Paul and Allan's fellow shareholders presented them with personalized gifts marking the occasion. Capping the shock of the surprise was the presence of many of Paul and Allan's family members, including

Allan's 2-year old granddaughter, Olivia, who made the trip from San Francisco to see her grandfather be honored for his decades of hard work.

The champagne toast that kicked off the event summed up its significance. The honesty, wisdom, and vision displayed by the founding shareholders has led to the development of one of the premiere intellectual property law firms in the country. "A surprise luncheon in Paul and Allan's honor is the least

we could offer to show our respect and gratitude," said Jonathan in his opening toast. "These two men have created an environment that has us, today, committed to Allan and Paul's vision made 20 years ago," concluded Jonathan.

In 20 years, Ratner & Prestia has become the second largest intellectual property law firm in the Philadelphia region. The firm has grown steadily at a rate of about 20% per year, and the plans are to continue on that growth pattern. ■

R&P Announce Daniel N. Calder and Kevin W. Goldstein as Shareholders

Ratner & Prestia is pleased to announce that Daniel N. Calder and Kevin W. Goldstein have become shareholders in the Firm.

Daniel N. Calder has over twenty-five years of experience in the corporate and private practices of intellectual property law. Dan's practice encompasses all phases of intellectual property law, including involvement in large multi-party patent litigation. Before becoming an attorney, he was an electrical design engineer with Boeing Company, Vertol Division. He is a member of the American Bar Association, Corporate Counsel Subcommittee of Litigation Section and American Intellectual Property Law Association. Dan is a graduate of the University of Toledo School of Law and holds a Bachelor of Science degree in electrical engineering from Pennsylvania State University. He is resident in the Valley Forge office.



Daniel N. Calder

Kevin W. Goldstein practices in all areas of intellectual property law, including patent and trademark litigation. His technical experience includes working as a Senior Control System Design Engineer with Boeing Company, and as an Engineer in a research laboratory with the United



Kevin W. Goldstein

States Department of the Navy. Kevin is a member of the American, Pennsylvania, Delaware, and New Jersey Bar Associations. He is the Vice Chair of the Delaware State Bar Association, Intellectual Property Section. He was also a member of the Delaware State Bar Association Intellectual Property Section subcommittee responsible for drafting revisions to the Delaware State Trademark Act. Kevin is a member of the American Helicopter Society, and is active in Philadelphia Volunteer Lawyers for the Arts. He is a cum laude graduate of Widener University School of Law. He holds a Bachelor of Science degree in mechanical and aerospace engineering from Rensselaer Polytechnic Institute where he also graduated cum laude. Kevin divides his time between the Valley Forge and the Wilmington offices.

"Dan and Kevin have shown they will be great contributors to the continued success of Ratner & Prestia and to the professional environment and personal culture of the firm. We welcome them as shareholders and, on a personal basis, as partners," says Paul Prestia, Chair of the Firm's Executive Committee. ■

20 years

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While the first objective has been achieved, the hoped for predictability continues to be elusive.

That Court has, however, elevated the value of patents by its willingness in appropriate situations to validate large damage awards. This coincided with industry's developing awareness of patents as the key to justifying and protecting the large investments required for innovation, the notoriously uncertain offspring of expensive research and development.

This economic and legal environment at least facilitated, and more likely fostered, explosive advances in the 80's and 90's in technologies ranging from software to molecular biology, and from medical devices, which make dangerous surgery unnecessary, to manufacturing techniques by which micro-miniature products can be produced with incredible accuracy.

All of this had its effect on the practice of law, particularly patent law as it was known in 1981, and intellectual property law as it is known today.

As we entered the new millennium, intellectual property (and intellectual property law) was the darling of the new economy.

The impact of these factors in the firm's 20 year life span, on the practice of law generally, and on Ratner & Prestia specifically, has been dramatic. Shortly after we began our combined practice in December 1981, the firm hired its first associate

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and by 1983 we had two associates. Since then, many more attorneys and staff members joined the firm, most of who remain as vital parts of the firm. Beginning with Andrew Ney in 1989, others joined us as shareholders, including Kenneth Nigon and Kevin Casey in 1991. Ken brought with him extensive experience in industry and Kevin joined the firm fresh from two years as law clerk at the Court of Appeals for The Federal Circuit, for the late Judge (and subsequently Chief Judge) Helen Neiss. Subsequent shareholders include Benjamin Leace, Christopher Lewis and Lawrence Ashery, all of whom began with the firm while still in law school.

In a similar way, the firm's staff also grew to accommodate the increasingly sophisticated nature of IP practice and the technology necessary to that practice. From a single stand-alone word processor in 1981, we proceeded to a system based on a collection of personal computers from 1983 to 1989, and then to a client-server network, on which we now have over a hundred workstations.

Whole departments, such as docketing and foreign filing, are devoted to aspects of law office practice unique to intellectual property law.

Managing such administrative staff long ago became a full-time

job, one that is ably handled by our Executive Director, Barbara Foley. With our Executive Committee, she manages our family of eighty plus employees.

With the 1997 additions of a Wilmington office, headed by Costas Krikelis, a former du Pont attorney, and an Allentown office headed by Jim Simmons, a former attorney at Air Products and Chemicals, and with the move of its principal office to the present location in the Westlakes Office Complex along U.S. Route 202 in Berwyn, R&P continues its original vision as a metropolitan firm in a suburban environment.

But the growth and development of Ratner & Prestia has not occurred in a vacuum. In 1981, only one large general firm in Philadelphia (a firm of about 50 lawyers, at that time one of the largest in the city) had a patent group. Now a number of general law firms in Philadelphia, or with offices in Philadelphia, have hundreds of attorneys and all include intellectual property among their fields of practice. Obviously, the burgeoning interest in, and importance of, patents in the last 20 years has not gone unnoticed. Law practice itself has changed. Lawsuits with teams of attorneys on each side are not uncommon. New attorneys in some firms are paid well over \$100,000 per year. But this intense activity comes with a price. Billable hour requirements in

these firms commonly exceed 1900 hours, with some attorneys often reporting over 2200 billable hours per year.

It is in this marketplace that Ratner & Prestia of 2001 competes - and thrives — while distancing ourselves from the billable hour requirements and billing rates of larger firms. From the beginning, we have fostered a firm culture which recognizes the contributions and the interdependency of all attorneys and staff. Our focus on professional growth has also enabled us to develop a technical expertise which serves a largely technically sophisticated clientele. This is illustrated by the fact that R&P's major clients are typically among the leaders in product lines such as consumer electronics, pharmaceuticals, and biomedical devices and R&P is being called upon to participate in increasingly complex business transactions and litigation.

Perhaps the most gratifying aspect of this retrospective is that we have the opportunity to assist and to be depended upon by clients such as these as they compete in the brave new world of the new millennium. We look forward, with confidence, to that competition as well, and to new challenges in technology and in legal practice.

If the past is prologue to the future, the next twenty years should be very interesting. ■

RATNER & PRESTIA: The First 20 Years

December
1981

Paul Prestia and Allan Ratner merge their two solo practices. Ratner & Prestia opens its doors during a tremulous era for the U.S. economy with a single stand-alone word processor.

Early
1980s

The patent system is rediscovered as the U.S. renews its commitment to commercial and industrial innovation.

Corporations recognize innovation as a necessity to compete in the international marketplace.

1982

Congress establishes Federal Circuit Court of Appeals to hear all patent appeals.

1983

Ratner & Prestia begin its rapid growth with 2 full-time associates.

1997

Firm opens offices in Wilmington, Delaware and Allentown to accommodate clients' needs.

2001

Twenty years later, Ratner & Prestia has grown to 80 plus employees and over 30 attorneys and patent agents.

Speaker's Forum

- Ratner & Prestia shareholders, Kenneth N. Nigon and Joshua L. Cohen, were faculty members at the "Patent Prosecution Basic Training" CLE program held August 16 through 18 in Crystal City, Arlington, Virginia. Ken and Josh conducted a "Claims Drafting Workshop," designed to provide new practitioners with practical instruction in drafting patent claims, including specific claim drafting tips that apply to particular technologies. Approximately 150 people attended the seminar. The American Intellectual Property Law Association (AIPLA) is a 12,000 member, national bar association constituted primarily of intellectual property lawyers in private and corporate practice, in government service, and in the academic community. Many of Ratner & Prestia's attorneys, patent agents and scientific advisors are actively engaged in the activities and governance of AIPLA.
- W. Mark Mullineaux, a shareholder with Ratner & Prestia, and Robert E. Rosenthal of Duane Morris & Heckscher, recently spoke at a roundtable program entitled, "The Role of Attorney Opinions in Patent Litigation." The roundtable was held on October 25 in the law offices of Duane, Morris & Heckscher in Philadelphia. The program was organized by the Intellectual Property Litigation Committee of the American Bar Association Section of Litigation.
- Jonathan H. Spadt, an associate in the Valley Forge office of Ratner & Prestia, recently spoke on patents and their role in e-commerce at a seminar hosted by the Pennsylvania Bar Institute. The focus of the seminar was current issues in Intellectual Property Law & E-Commerce. Jonathan was joined on the panel by Robert E. Rosenthal, a partner in the Intellectual Prop-

erty Department of Duane, Morris & Heckscher LLP; Michael A. Bromberg, Associate General Counsel of Unisys Corporation; and Barry L. Cohen of Thorp Reed & Armstrong LLP.

- Jacques L. Etkowicz spoke at the recent Mississippi Bar's Annual Meeting held on July 9-14 in Sandestin, Florida. Jacques was among several other panelists who participated in the seminar entitled, "Intellectual Property Issues for the Business Lawyer." Jacques' presentation covered the hot topic of business method patents, including the requirements and benefits.
- Paul Prestia was a guest speaker and panelist at the recent Association of Bioscience Financial Officers conference held on June 7 in Boston. Paul was one of several panel members who discussed recent biotech licensing deals, including a discussion of trends and how biotech companies might gauge their relative power in the current licensing deal marketplace and then leverage that power to its fullest advantage. The seminar was entitled, "Technology and Product Licensing: The Shifting Balance of Power."
- W. Mark Mullineaux and Robert E. Rosenthal of Duane Morris & Heckscher spoke at a roundtable program entitled, "Means Plus Function Claims" which was held this past summer in Philadelphia. The roundtable discussions included topics such as identifying means plus function claims, interpreting means plus function language, equivalency and Federal rule changes. The program was organized by the Intellectual Property Litigation Committee of the American Bar Association Section of Litigation. ■

Announcing

- R&P WELCOMES NEW ASSOCIATES PATRICIA A. MARRUCHELLA, STEVEN E. BACH and HOANG STEVE NGO

Ratner & Prestia announces that Patricia Ann Marruchella has joined the firm as an associate in the Valley Forge office. Formerly with Rhone-Poulenc Rorer (now Aventis), Patricia will concentrate her practice in all areas of intellectual property law, including patent procurement and counseling in the field of biotechnology and pharmaceuticals. Patricia is a member of the Pennsylvania Bar Association, American Intellectual Property Law Association and the American Bar Association. She is a cum laude graduate of the Widener University School of Law (J.D.) and a graduate of St. Joseph's University (B.S. Biology).



Patricia Marruchella

Steven E. Bach has joined the firm as an associate in the Valley Forge office. Steve will concentrate his practice in all areas of intellectual property law, particularly in patent procurement and counseling in the field of mechanical engineering. Prior to joining Ratner & Prestia, he maintained his own private practice during which time, he drafted and prosecuted patent applications in a wide variety of electronic, electro-mechanical, semiconductor, mechanical, complex mechanical process, soft-



Steven E. Bach

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Announcing

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ware, and internet business methods arts. He also provided counseling on copyright infringement, as well as patentability opinions. Before establishing his own firm, Steve was employed by Lockheed Martin Corporation as a Senior Quality Engineer where he was responsible for classified programs such as the Aegis Radar System, transmissions for the Bradley fighting vehicle, submarine radar systems, submarine communication systems and aircraft controls. Steve is registered to practice before the United States Patent and Trademark Office.

Hoang Steve Ngo has joined the firm as an Associate. Steve will concentrate his practice in all areas of intellectual property, particularly in the field of biotechnology. Steve has practiced patent law in the biochemical, chemical and mechanical disciplines since 1999. His experience includes three years of medical research as a research technologist/assistant at Massachusetts General Hospital

and The University of Texas Southwestern Medical Center. Prior to joining Ratner & Prestia, Steve was an attorney with



Paul & Paul in Philadelphia. He currently is attending John Hopkins University Graduate School. He expects to receive his Masters Degree in biotechnology in 2003. Steve will be resident in the Valley Forge office.

• ELLEN E. ANDERSEN JOINS R&P AS SCIENTIFIC ADVISOR

Ellen E. Andersen has joined the firm as a Scientific Advisor. Ellen's technical experience includes ensuring the operability of mechanical, structural, hydraulic, and electrical systems in support of Submarine Escape and Rescue. For nine years, she

was a Senior Program Engineer with the Department of the Navy specializing in Submarine Closures and Hull Outfitting. She is resident in the Valley Forge office.

Ellen is a member of the Philadelphia Intellectual Property Law Association, the American Intellectual Property



Ellen E. Andersen

Law Association, and the American Bar Association (Intellectual Property Law Section). She is also a member of the Benjamin Franklin American Inn of Court, and the Temple University Intellectual Property Law Society. Ellen received her Bachelor of Science degree in Mechanical Engineering from Widener University, and expects to receive her Juris Doctor from Temple University in May 2002. ■

Ratner & Prestia 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. R & P recommends that readers seek specific information and/or legal advice on particular matters of concern.

INSIGHT is published by Ratner & Prestia. The firm welcomes your articles, ideas for articles, comments, and suggestions. Please contact Jonathan H. Spadt, the editor, at our offices:

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