

Computer Law News

A Publication of the Minnesota State Bar Association Computer Law Section

Spring 2004

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Report From the Chair

By: *Chris Schulte*

I am happy to report that the Section, through its committees, has been very active since last fall. Our two Noon-time CLE co-chairs, Steven Lieske and Chris Hilberg, have been very active this year, lining up several interesting speakers. In November Tim Krsul, of Oppenheimer, Wolff and Donnelly, spoke on the topic of "Insurance Coverage in the Age of Computers". In March Steven and Chris hosted Patty Elias and Bruce McPheeters of Lawson Software to discuss the topic of "Complex Software License Negotiations Between Licensors and Licensees".



Our law student outreach program is also well under way under the leadership of Shelly Gilbertson and Colleen Schmid. So far they have met with law students at Hamline and the University of Minnesota, and are planning events for William Mitchell and St. Thomas. Apparently, the pizza they offered was a big draw!

Jim Blomquist continues to play a major role in the Section. Jim has taken over the chair position of the Case Law Committee and every meeting he comes prepared with a report of current cases in the Technology industry. He is also active as co-chair of the nominations committee and the Technology Roundtable. Thank you to Jim for his continuing devotion to the Section!

I should also note that Carolyn Sandberg has agreed to take primary responsibility for this year's Nomination Committee, along with Jim and John Taft (another stalwart of the Section). She and her committee will prepare a proposed slate of candidates for election at our annual meeting on May 25, 2004. Carolyn has been a tireless advocate for our Section, and her efforts in regard to preparing the slate for election are greatly appreciated.

Our Annual Meeting, set for May 25th, is in the planning stages. Kate Andresen, Section Vice Chair, has agreed to handle this effort. More information will be sent as it is available, but please reserve the date on your calendar.

Kate will also chair the Annual Computer Law Institute to be held this year on September 9, 2004. If you would like to be involved with the planning for this annual event, please contact her at kaandresen@locklaw.com.

Finally, our newest committee, the Technology Roundtable, has taken flight. Our capable co-chairs of this committee, Jim Blomquist, Dan Tysver and Gary Weinstein, have apparently recreated the halcyon days of monthly discussions on topics of interest in the Computer Law field. Look for future meeting announcements and please feel free to attend if you have the time.

We still have openings for anyone interested in chairing a committee. Our open positions are the Legislative and Web Site committees. I invite anyone interested in taking charge of one of these positions to contact me as soon as possible at cschulte@meagher.com.

Also, please consider attending one of our monthly Council meetings. We meet every second Tuesday of the month at 11:30 a.m. in the MSBA offices, 3rd floor of City Center. Lunch is served at the meeting.

Finally, I should note that on December 5, 2003 the Board of Governors approved our Section's Amended Bylaws. Accordingly, a Council member who misses three Council meetings in a row without an excuse will lose their position on the Council. Therefore, Council members are urged to inform me (the Chair) if they cannot make a scheduled Council meeting.

If you have any questions or comments about the Section please contact me at cschulte@meagher.com or 612-338-0661. I hope to see you at the Annual Meeting!



2004 Schedule of Events

5-10-04	Annual CLE Meeting	MSBA Headquarters, City Center For further information, contact Kate Andresen at 612-339-6900
5-25-04	Annual Meeting	4:30 at Midland Hills Country Club, St. Paul For further information, contact Kate Andresen at 612-339-6900
9-09-04	Annual Computer Law Institute	MN CLE Conference Center For further information, contact Kate Andresen at 612-339-6900
6-09-04	MSBA Convention	Duluth

Editor's Report

By: Dianne Plunkett Latham

After five years as Editor, this will be my last issue as Editor of the *Computer Law News*. Both my husband and I are now retired from the Medtronic Patent Counsel, and we hope to do a bit more travel. It has been a pleasure and an honor to be a member of the MSBA Computer Law Section. I still recall the meeting at which Steve Davidson nominated me to the Section Council in 1986. Having served in the Section offices of Treasurer, Secretary, Vice Chair and Chair, I have been privileged to make many friends and to participate in the evolution of technology and law. I want to thank the many members who so graciously gave of their time when I called upon them for an article, speaker or other Section task. I especially want to thank John Sumner, who gave me my initial training in computer law as his law clerk at Honeywell so many years ago. Having opportunity for mentoring by members such as John, Steve, and many others, is perhaps one of the greatest benefits of MSBA Section membership. In addition to participating in the MSBA Computer Law Section, I was doubly blessed by being elected President of the Minnesota Intellectual Property Law Association (MIPLA). I owe a debt of gratitude to both organizations for expanding my insight into technology law, and can truly say that in serving, you receive much more than you give. I urge all to participate to the fullest in your chosen professional organizations. Dan and I look forward to seeing many of you at future MSBA and MIPLA events.

Newsletter Submissions – Please e-mail your newsletter submissions to our new Editor, Damien A. Riehl at driehl@jllolaw.com 651-290-6525. These can include articles,

photographs, committee reports, CLE notices and other information of interest to the members of the Computer Law Section. A great slate of officers has been nominated for 2004-2005. Please support them to the fullest when you are called upon to contribute.



Thank You Mary Kempton-The December 2003 newsletter was the first produced by our new Section Services Coordinator, Mary Kempton. Mary did an outstanding job and newsletter production went very smoothly. Mary made an extra effort to call the sixteen Section members who did not have an e-mail address listed with the MSBA. We now have only seven, out of 260 members, who do not have e-mail, or less than 3%. This is very likely the lowest in the MSBA, and a great decrease since 1999, when 30% of our membership offered no e-mail address. Only one member declined to give the MSBA his e-mail address. Because we have so few members without e-mail, we are no longer having the newsletter printed commercially. For the seven members without e-mail, Mary copies the newsletter at the MSBA and mails it from there, which saves the Computer Law Section a small amount of cost, and eliminates the need to publish in multiples of 4 pages. Our newsletter, first published electronically for the spring issue of 2000, has been a great success, thanks to its many contributors. Please continue to give it your active support.



Treasurer's Report

By: Thomas Sheran

The latest MSBA Report dated 3/26/04 covers the period ending February 29, 2004. The February beginning balance was \$7,514.76. During the month of February the Section received \$25 in income and incurred \$313.53 in expenses. The balance in the section's account at the end of February was \$7,201.23.

MSBA



Meeting Notice

Computer Law Section Annual Meeting

Tuesday, May 25, 2004

4:30 p.m. – 6:30 p.m.

**Midland Hills Country Club
2001 Fulham Street, St. Paul**

***Come to the Annual Meeting
and enjoy food, fun and conversation
with old friends and new ones!***

Agenda:

- 4:30 p.m. Annual Meeting and election of Officers & Council
- 5:30 p.m. CLE - "Current Cases Of Interest To Computer Lawyers"
Speaker: **James Blomquist, Felhaber, Larson, Fenlon & Vogt, P.A.**
(1.0 hour Standard CLE credit to be applied for)

Refreshments will be served, and there will be a cash bar.

There is no cost to attend the Annual Meeting. If you cannot attend, you may still vote in the election. Please see the attached ballot for details.

Computer Law Section Meeting Minutes

September 9, 2003

Attendees: Chris Schulte – Chair, Katheryn Andresen – Vice Chair, Christine Brick – Secretary, Thomas Sheran – Treasurer, Daniel Tysver – Past Chair, James A. Blomquist, Carla Condiff-Schaumann, Shelly Gilbertson, Barbara Grahn, Charles E. Johnson, Steven Lieske, Dianne Plunkett Latham, Kendra Richgels, Carolyn M. Sandberg, Sandra Sedo, Colleen Schmid, John P. Sumner, Gary Weinstein, Alan Oh, Julie Finch, and Kari Wangenstein. Renee Anderson – MSBA Staff

Call to Order: The Chair called the meeting to order at 11:40 a.m.

Introductions: The attendees did introductions.

Minutes: There were no minutes from the June 2003 Annual Meeting

Treasurer's Report: The balance from June 2003, was approximately \$4,000.

2003-2004 Structure: Keep the same meeting structure 11:30-12:30 every Second Tuesday. Skip December.

2003-2004 Goals: Maintain the quality of the section. Obtain full counsel participation (through chairing and participating in committees) and seek non-council participation for transition into 2004.

2003 –2204 Committee Chairs: Noontime CLE – Steven Lieske and Tom Sheran; Contracts – Gary Weinstein and Jen Salyers; Computer Law Institute – Kate Andresen; Newsletter - Dianne Plunkett Latham, co-chair position open ; Case Law- Open; Legislative – Julie Finch; Elections – John Sumner; Law Student Outreach – Colleen Schmid and Shelly Gilbertson; Bylaws – open

CLI: Annual CLI October 30, 2003

Old Business: 1. Open Council Membership Slots – Verify Chris Hildberg's Interest. Bill Hefner is a council member but need to verify interest. Action – Chris will talk with Bill and Chris to determine interest

2. Internet Committee – The Internet Committee was dissolved. Should The Computer Law Section add a new Committee to deal with Internet Issues? Action – New Committee to be formed with Gary Weinstein, Jim Blomquist, Dan Tysver, and Barb Grahn serving as chairs.

3. Website committee – Current and Potential Activities include: Post newsletters, monitor chat capabilities, posting materials like Presentation Materials. Action - Need to find a committee chair.

Committee Updates: 1. Newsletter – Dianne Plunkett Latham – deadline November 1st. Committee Chairs to send reports to Dianne. Case Law Material to be sent by Jim to Dianne. Meeting Minutes – Kate to send March minutes to Dianne. Looking for a co-chair. Looking for Articles.

2. Bylaws – Get the amended Bylaws to the Board of Governors before the December Board Meeting, Jim Blomquist to forward to Christine Brick who will work with the MSBA to obtain Board Approval.

Meeting Adjourned at 12:30 to discuss Case Law – Case Law discussion to be led by Jim Blomquist.

Christine Brick, *Secretary*

October 14, 2003

Attendees: Chris Schulte – Chair, Christine Brick – Secretary, Thomas Sheran – Treasurer, Daniel Tysver – Past Chair, Frank Farrell, John Sumner, Jim Blomquist, Jen Salyers, Colleen Schmid, Larry Thomas, Gary Weinstein, Carolyn Sandberg, Julie Finch, Kendra Richgels, Dianne Plunkett Latham, Bill Hefner, Steve Buckingham, Larry Thomas, John Taft, Carla Condiff-Schaumann and Steven Lieske Non-Council Delegates Attending – Damien Riehl; Alfons Bauer; John Thomas; Brad Bolin; Mark McNeill and Sonya Southward. Renee Anderson – MSBA Staff

Call to Order: The Chair called the meeting to order at 11:45 a.m.

Introductions: The non-council attendees did introductions.

Minutes: September Minutes will be approved at the November meeting.

Treasurer's Report: The balance from August 2003 was \$9,232.95.

Noontime CLE's: The next noontime CLE is scheduled for November.

Contracts Committee: Discussed their 2003-2004 Plan: 1. Plug in to informal roundtable series. Take 2 or 3 during

year and get involved in the planning (introductory, intermediate and advanced).

2. Work with Computer law Institute to fit a contracts topic in the October 2004 CLI.

3. Work with the noontime CLE group.

Case Law Committee: Currently there is no chair for the Case law Committee. Jim Blomquist pulled some cases for review and discussion, distributed them during the meeting.

Legislative Update: Julie Finch committee chair will discuss her legislation updates at the end of this meeting.

Computer Law Institute: CLI October 30, 2003. Jason Lewis will not be present and Tom Heffelfinger will take his place. Carolyn Sandberg will be the moderator.

Law Student Outreach: Colleen Schmid and Shelly Gilbertson met with Christine Brick, previous Law Student Outreach Committee Chair regarding tips on reaching out to the law schools. Shelly made contact with St. Thomas. Colleen Schmid and Shelly Gilbertson will reach out to the other law schools this week.

Internet Committee: Dan Tysver reported that there is ambiguity as to who they are, what they do, etc. His understanding is to plan roundtables and brown bags separate from the monthly meeting. Agreed to grow informal group and continue to report on monthly activities.

Website: Bill Hefner discussed the activities of the website committee chair.

Newsletter: Dianne Plunkett Latham reported that she is looking for committee reports and still looking for an assistant. In addition, Dianne is looking for articles.

Old Business: 1. Open Council Membership Slots
Chris Hilberg was nominated for council membership. Motion was approved. Bill Hefner has agreed to be a member, his membership is now consistent with the roster.

New Business: Julie Finch announced Hamline and University of Minnesota are looking for Moot Court judges.

Meeting Adjourned at 12:25 to discuss pending Legislation – discussion led by Julie Finch.

Christine Brick, *Secretary*

November 11, 2003

Attendees: Chris Schulte – Chair, Kate Andresen, Vice President, Christine Brick – Secretary, Daniel Tysver - Past

Chair, John Thomas, Ron Marmo, Dan Tysver, Jim Blomquist, Jen Salyers, Michael Luzum, Gary Weinstein, Carla Condiff-Schaumann, Carolyn Sandberg, Brad Bolin, Chip Brink, Steven Lieske, LaVern Pritchard, John Thomas, and Chris Hilberg. Renee Anderson – MSBA Staff

Call to Order: The Chair called the meeting to order at 11:40 a.m.

Minutes: September Minutes approved. October Minutes need to change reference to Vance Opperman to Jason Lewis with change the October Minutes have been approved.

Treasurer's Report: The treasurer was not present to report.

Noon-time CLE's: November 20th a noon-time CLE will be held Timothy Krsul will be presenting on Insurance Coverage in the Age of Computers. In discussions with presenters for a February and late spring noontime CLE.

Contracts Committee: Working with Noon-time CLE to determine a topic and plan a noontime CLE on a contracts issue.

Case Law Committee: Currently there is no chair for the Case law Committee. Jim Blomquist discussed two cases briefly.

Legislative Update: Committee Chair, Julie Finch, was not present.

Computer Law Institute: CLI was held October 30, 2003. Highest attendance in the last four years – 145 attendees. Not many evaluations returned but of those returned received very positive feedback, particularly around the debate. Suggestion that the food be moved to earlier in the event next year as many attendees leave early. Kate Andresen will be planning next year's CLI. Suggestion that the food networking session traditionally conducted at the end of the CLI be moved to a faculty lunch. Carla will look into ensuring thank-you notes are sent to the presenters.

Law Student Outreach: Colleen Schmid and Shelly Gilbertson are planning some law school events. February 3rd University of MN Law School and February 7th Career Service Day at Hamline. Anyone interested in participating should contact Chris Schulte, Colleen Schmid or Shelly Gilbertson.

Internet Committee: Jim Blomquist will serve as the Chair of the Committee. Plan to host a round-table once a month, tentatively the first Tuesday of every month – will start next month (December). December meeting will focus on

the Digital Millennium Copyright Act (Access Decisions – Lexmark Case). Future Ideas – Open Source, Shrink Wrap Licenses controlling ability to do reverse engineering – enforceable right?

Website: Bill Hefner is reviewing the status of the website and will provide a report in January.

Newsletter: Dianne Plunkett Latham reported that she is looking for articles. Damien Riehl will be co-chairing the Newsletter Committee with Dianne.

Old Business: No Old Business.

New Business: There will be no meeting in December.

Meeting Adjourned at 12:10.

Christine Brick, *Secretary*

January 13, 2004

Attendees: Chris Schulte – Chair, Kate Andresen, Vice President, Christine Brick – Secretary, Tom Sheran, Treasurer, Daniel Tysver - Past Chair, Brad Bolin, Roger Belfay, Gary Weinstein, Brian Batzli, Charles Johnson, Julie Finch, Jen Salyers, Shelly Gilbertson, Colleen Schmid, Jim Blomquist, Kendra Richgels, Carla Condiff-Schaumann, Kristin Longley, David Burns, and Frank Farrell. Renee Anderson – MSBA Staff

Call to Order: The Chair called the meeting to order at 11:40 a.m.

Minutes: November Minutes approved.

Treasurer's Report: Balance \$8546.00

Noon-time CLE's: Chris Hilberg and Steve were absent but in contact with Chris Schulte they indicated that they are starting to plan another noon-time CLE to be held this quarter or next. It was also noted that the last event had a good turnout.

Contracts Committee: Committee Chairs met last week and planning a round-table and will be in touch with Steve re: Noon-time CLE assistance.

Case Law Committee: Currently there is no chair for the Case law Committee. Jim Blomquist will discuss cases at the close of the meeting.

Legislative Update: No Report.

Computer Law Institute: Kate Andresen will have a report next month.

Law Student Outreach: Colleen Schmid is planning a Hamline Career Event Saturday Feb 7, 12-1:30 promoting the Computer Law Section and would like a volunteer to represent the committee this day as well as a University of Minnesota SIPLA engagement and would like to coordinate 2-3 speakers for this event. The University of Minnesota event is scheduled for Tuesday February 23rd from 12:00 to 1:15. Colleen is looking for volunteers for both events. Shelly Gilbertson is planning some law school events. Shelly Gilbertson will set up similar events for William Mitchell and St. Thomas. Motion to spend up to \$500 for law student outreach events. Motion approved. Jen Salyers volunteered for the University of Minnesota event. Ideas re: incentives for students' involvement in the Section were discussed.

Technology Roundtable Discussion Syndicate: The syndicate chairs will be gathering after this meeting to put together the February Session. For the December session there was a good turnout (about 20-30 participants), the topic was Digital Millennium Copyright Act (DMCA).

Website: No Report.

Newsletter: Dianne Plunkett Latham reported that she is looking for articles. Damien Riehl will be co-chairing the Newsletter Committee with Dianne.

Old Business: No Old Business.

New Business: The MSBA contacted Chris Schulte to see if we were interested in giving a CLE at the 2004 Duluth MSBA convention (June 9-11). There was group consensus that we should not present a CLE at this event.

The annual meeting is generally in May or June. Inquiry as to whether we should present a program at this event. Potential speakers and subjects were discussed. Jim Blomquist would strongly encourage a program but suggests that it not run more than an hour, we may consider even applying for a CLE credit. Potential program topics discussed include Trademark litigation, Trademark and use of Internet Identity, Internet Jurisdiction and Electronic Discovery. Kate Andresen suggested an Internet membership survey to determine topic interest for this event as well as the 2004 CLI and noontime CLE's and roundtables. Kate will develop the survey and organize distribution. Chris Schulte will co-chair the annual meeting planning committee and is soliciting co-chairs.

Introductions: All attendees announced themselves and their firm, corporation, or school affiliation.

Meeting Adjourned at 12:30 to discuss Case Law, which was distributed by Jim Blomquist.

Christine Brick, *Secretary*

February 10, 2004

Attendees: Chris Schulte – Chair, Kate Andresen, Vice President, Tom Sheran, Treasurer, Daniel Tysver - Past Chair, Charles Johnson, Jen Salyers, Colleen Schmid (by phone), Jim Blomquist, Sandra Sedo, Damien Riehl, John Taft, Miguel Azar, Chip Brink, Steven Lieske, Allen Chu, John Sumner, Carolyn Sandberg and Kari Wangensteen. Renee Anderson – MSBA Staff

Call to Order: The Chair called the meeting to order at 11:40 a.m.

Secretary Report: January minutes reviewed and approved.

Treasurer's Report: Balance as of December 31, 2003 is \$7917.00 (\$3,000 increase over the six-month period.) The biggest expense was the newsletter charge greater than \$600.00. Jim Blomquist questioned why this charge is so high and Renee Anderson answered that \$340 was for the standard \$20/per page formatting charge on the 17-page document and that there was a charge for 12 hours of MSBA staff time at a rate of \$22/per hour.

Noontime CLE's: Steve Lieske indicated that they have scheduled the next noon-time CLE to be held on Tuesday, March 2, 2004. Chris Hilberg is in charge of this CLE and the notices have already been sent out. The guest speaker is from Lawson Software.

Contracts: Jen Salyers reported that the committee has identified a topic for a roundtable discussion and will coordinate with the Noon-time CLE and Technology Roundtable committees.

Case Law: Jim Blomquist reported on a recent case, in particular two on Non-compete Agreements (Inter-Tel and West cases.)

Legislative Update: Julie Finch was not present.

Computer Law Institute: Kate Andresen is meeting with Liz Misiaveg-Patel to start the coordination of the CLI. Kate also spoke with Steve Davidson on the possibility of him being a keynote speaker for the CLI. Carolyn Sandberg raised an issue with the date of the CLI versus MINN CLE's Intellectual Property Institute currently booked for the 7th and 8th of October. Sandra Sedo pointed out that this is the same issue from two years ago and when addressed at that time, the response from MINN CLE was that the two seminars are targeted at different audiences. Carolyn

proposed sending a notice to MINN CLE voicing the council's concern over this conflict. Kate Andresen agreed to address the issue again with Liz Misavig-Patel and to schedule a joint meeting with Liz, Kate, Chris Schulte and Frank Harris (MINN CLE.) Kate still needs to create the survey of the Computer Law Section to determine the split in practice for members.

Law Student Outreach: Colleen Schmid attended the Hamline Career Event Saturday Feb 7, 12-1:30 and manned a table promoting the section. Colleen also attended a University of Minnesota SIPLA engagement and was joined by Jen Salyers and Tim Penny. The attendance was approximately 50 students and the section paid for 20 pizzas. Colleen indicated that Shelly Gilbertson is in charge of similar events for William Mitchell and St. Thomas. Carolyn Sandberg indicated that she's attending a Hamline SIPLA event on February 13, 2004 and will promote the section as well.

Technology Roundtable Discussion Syndicate: Jim Blomquist reported that the February 3, 2004 roundtable also had a good turnout. The TRDS is giving up their time slot for March to the Noon-time CLE committee, but will be planning the next session for April.

Website: Bill Hefner was not present. Chris Schulte will contact Bill and try to resolve the website issues prior to the next council meeting.

Newsletter: Chris Schulte reported that Dianne Plunkett Latham wanted everyone to know the next deadline is April 1, 2004. She also needs the January minutes and Kate Andresen agreed to provide them. Damien Riehl indicated there are only five people still not receiving the newsletter by email. See also Treasurer's report.

Annual Meeting: Kate Andresen reported that the annual meeting will be on May 25, 2004. The committee is still open to venues and possible topics for the speaker. Kate spoke with Steve Davidson about being the speaker for the meeting. Jim Blomquist suggested that whomever the speaker is, that they present a 30-minute substantive topic, relevant to the section. Kate reported that she had considered as one venue perhaps the Weisman Art museum. Kari Wangensteen and Steve Lieske both volunteered to assist with the annual meeting.

Nominations: Carolyn Sandberg, John Taft and Jim Blomquist agreed to chair the committee again. They have drafted a proposed nominations form, which includes a section on indicating an interest in one of the council's committees.

Old Business: The proposed bylaws changes were

approved by the MSBA Board of Governors on December 5, 2003. This means the new rule that absent council members with three unexcused absences may be removed from the council. An excused absence simply requires informing the chair.

New Business: No new business.

Meeting Adjourned at 12:40.

Kate Andresen for Christine Brick, *Secretary*

March 9, 2004

Attendees: Chris Schulte – Chair, Kate Andresen, Vice President, Tom Sheran, Treasurer, Daniel Tysver - Past Chair, Carolyn Sandberg, Carla Condiff-Schauman (by phone), Jim Blomquist, John Taft, Steven Lieske, Dave Burns, Kristin Langley, Frank Farrell, Shelly Gilbertson, John Thomas, Gary Weinstein, Chris Hilberg, Kendra Richgels and Andy Ehard. Renee Anderson - MSBA Staff

Call to Order: The Chair called the meeting to order at 11:44 a.m.

Secretary: February minutes reviewed, corrected to add Carolyn Sandberg's name and approved.

Treasurer: Balance as of January 31, 2004 is \$7514.00 The biggest expense was the meeting charges and the monies for the student outreach program.

Noontime CLE's: Chris Hilberg was in charge of the March noontime CLE that was well attended. The guest speakers were from Lawson Software and they spoke on negotiating software licenses. The committee would like to do another noontime CLE on possibly software revenue recognition. They will work with the annual meeting committee to perhaps select the speaker for the annual meeting.

Contracts: Gary Weinstein reported that the committee would like to coordinate a roundtable discussion or noontime CLE with the focus on contract issues. Gary believes the next round table which is on escrow issues is contract related. The committee feels their obligations have been met this year through topics handled by the noontime CLE and the roundtable discussion groups.

Case Law: Jim Blomquist reported on recent cases with the most significant being the Bangoura case. Tom Sheran added there is a Minnesota case in front of Judge Peterson on a private injury case spin-off of the Microsoft cases under an indirect purchaser anti-trust charge.

Legislative Update: Julie Finch resigned as chair.

Computer Law Institute: Kate Andresen and Chris Schulte

spoke with Liz Misiaveg-Patel and Jeff Johnson about the scheduling conflict between the CLI and Minn CLE's IP Institute. Jeff and Liz apologized for the conflict and had not realized it may be issue. They agreed that future IP Institutes would be scheduled in September to allow the CLI to continue to be offered in October. For this year only, due to the scheduling conflict, the CLI will be held September 9, 2004. Kate asked for volunteers for the committee, which will meet on Monday, April 12, 2004. The following members volunteered: Gary Weinstein, Jim Blomquist, Kendra Richgels, John Thomas, and Carla Condiff-Schauman.

Law Student Outreach: Colleen Schmid reported that the outreach events at the University of Minnesota and Hamline law schools are completed. Shelly met with the William Mitchell SIPLA group, which was also well attended. Carolyn Sandberg attended Hamline's SIPLA event on February 13, 2004 and promoted the section. Colleen will attend the St. Thomas event scheduled for March 10, 2004.

Technology Roundtable Discussion Syndicate: Jim Blomquist reported that the TRDS's next roundtable is the first week of April. On May 4, 2004, there will be a roundtable on escrow agreements – led by Jen Salyers.

Website: Chris Schulte met with Bill Hefner and Chris will be updating the website and suggests removing the chat room component.

Newsletter: Chris Schulte reported that Dianne Plunkett Latham is still looking for additional articles for the April 1, 2004 deadline for the next newsletter.

Annual Meeting: Kate Andresen will work with the Nominations committee to ensure the notice of the annual meeting is sent out timely.

Nominations: Carolyn Sandberg reported that she is sending by email an interest indicator to be used in drafting the nominations slate. The email will allow for section members to indicate if they are interested in specific committees. Charlie Johnson is also a committee member. The committee is meeting the first week of April. Chris Schulte will provide five years worth of minutes for the committees review.

Old Business: No old business.

New Business: No new business.

Meeting Adjourned at 12:30.

Kate Andresen for Christine Brick, *Secretary*

Committee Reports

Nominations Committee Report

By: Carolyn Sandberg, John Taft, Jim Blomquist

OFFICERS:

- Chair:** Katheryn A. Andresen **Vice Chair:** Christine M. Brick
 Secretary: Thomas R. Sheran **Treasurer:** Kari J. Wangensteen

Immediate Past Chair: Christopher J. Schulte

SECTION COUNCIL MEMBERS:

- | | | |
|--|--|--|
| <input type="checkbox"/> Miguel Azar | <input type="checkbox"/> Michelle Gilbertson | <input type="checkbox"/> Damien Riehl |
| <input type="checkbox"/> James A. Blomquist | <input type="checkbox"/> Barbara Grahn | <input type="checkbox"/> Jenny C. Salyers |
| <input type="checkbox"/> Charles P. Brink | <input type="checkbox"/> Christopher Hilberg | <input type="checkbox"/> Carolyn M. Sandberg |
| <input type="checkbox"/> Stephen W. Buckingham | <input type="checkbox"/> Charles A. Johnson | <input type="checkbox"/> Colleen M. Schmid |
| <input type="checkbox"/> John J. Carney | <input type="checkbox"/> Steven C. Lieske | <input type="checkbox"/> John P. Sumner |
| <input type="checkbox"/> Carla Condiff Schaumann | <input type="checkbox"/> Ronald P. Marmo | <input type="checkbox"/> John A. Taft |
| <input type="checkbox"/> Frank s. Farrell, Jr. | <input type="checkbox"/> Kendra L. Richgels | <input type="checkbox"/> Daniel A. Tysver |
| | | <input type="checkbox"/> Gary S. Weinstein |

Law Student Outreach Committee Report

By: Michelle Gilbertson

Since February 2004, the Law Student Outreach Committee of the Computer Law Section has participated in activities with all four local law schools. These activities have ranged from providing speakers on a variety of topics to participating in Career Services Day activities.

On February 3, 2004 the Law Student Outreach Committee put on a Career Panel Discussion at the University of Minnesota Law School. Three attorneys spoke. Colleen Schmid spoke regarding working as in-house counsel at UnitedHealth Group, Tim Kenny of Fulbright & Jaworski spoke regarding working in a large law firm and Jennifer Salyers of Bonnabeau, Salyers, Stites & Doe spoke about working in a small law firm. On February 7, 2004, Colleen Schmid participated in the Hamline Law School Career Services Day by providing information on the Computer Law Section and discussing many computer law issues with Hamline students. On February 24, 2004, the Law Student Outreach Committee provided a speaker, refreshments and facilitated a discussion for the William Mitchell Student Intellectual Property Law Association

(SIPLA). Jim Larson from Merchant and Gould spoke regarding the recent Festo decision. Shelly Gilbertson and Jim Larson then facilitated a general discussion with SIPLA members concerning a wide range of topics ranging from the in-house v. law firm perspective, to the value of professional associations. Finally, on March 10, 2004, Shelly Gilbertson and Kendra Rubbright of the Computer Law Committee, in coordination with the St. Thomas career services office, spoke to St. Thomas students regarding benefits of MSBA membership and the computer law section.

Noon CLE Committee Report

By: Chris Hilberg

The first event of the year was on 11/20/03, "Insurance Coverage In The Age Of Computers", with presenter Timothy Krsul. The second CLE was on March 2, 2004, "Complex Software License Negotiations Between Licensors and Licensees." Presenters Bruce McPheeters and Patty Elias of Lawson Software joined over fifty attendees and discussed the various sticking points of a standard software license. The lively discussion illustrated the contentious areas of such agreements and the advantageous positions for both the licensor and the licensee.

Current Cases

By: James Blomquist

January 2004

Smart Text v. Interland [USDC Kansas 12/19/03] Website Hosting; Forum Selection; Arbitration.

The Court will let a jury decide if there was an agreement to arbitrate. Corporate acquirer Interland bought certain “accounts” from Interliant, a web hosting company, including the Smart Text account. Problems arose when Interland tried to move the websites to its servers. Smart Text had simply a verbal agreement with Interliant to host its website, although such website was Smart Text’s primary source of sales and revenue. Smart Text sued the web host for damages. Interland sought to compel arbitration and/or transfer the case from Kansas to Georgia. The Court held that under the Federal Arbitration Act if there are genuine issues of material fact regarding whether the parties agreed to arbitrate, then the court looks to a jury to decide that issue. The Court also held that SmartText’s silence in response to Interland’s e-mail offer is not acceptance of that offer.

Visa v. JSL [U.S.C.A. 9, 12/22/03] Domain Name; Trademark Dilution.

The Court of Appeals for the Ninth Circuit dissolved the injunction issued by the District Court and remanded on the issue of whether Defendant’s *evisa.com* violated Plaintiff’s trademark rights. The District Court had issued its injunction prior to the U.S. Supreme Court decision in *Moseley v. V. Secret* (123 S. Ct. 1115, 2003), which held that the Federal Trademark Dilution Act requires proof of actual dilution.

1-800 Contacts v. When U.com and Vision Direct [USDC NY, 12/23/03] Pop-up Ads; Trademark.

The Federal Court in New York held that When U’s pop-up ads violated 1-800/Contacts’ trademark rights and issued an injunction. In two similar prior cases in other jurisdictions, the courts had ruled in favor of When U, but one of those decisions (U-Haul in USDC, Virginia) is under appeal. When U gives away screen saver software on the Internet. Persons installing the screen saver software must agree to accept When U’s pop-up ads, which then appear whenever the user visits websites. Thus, for example, when a user visits the U-Haul website, the When U software



could display a pop-up ad for a competing trailer rental company. The pop-ups are not always for direct competitors. The judge in the U-Haul case held that there was no trademark infringement since the computer user has consented to the pop-up ads by downloading When U’s screen saver. The New York Court, however, found there was trademark infringement since the Court felt the user was likely to be confused as to the origin of the pop-up ads.

Federal Cartridge and Alliant Tech Systems v. Remington [USDC MN, 12/31/03] Trademark, Declaratory Judgment, First to File.

This trademark dispute involves Federal’s trademarks in “GOLD DOT” and “GOLD MEDAL” and Remington’s attempt to market a new line of ammunition using “GOLD BOX.” Federal sent a cease and desist letter whereupon Remington quickly filed suit in federal court for declaratory judgment in its home state of North Carolina. Before Remington could serve process, however, Federal filed and served its suit for trademark infringement in the U.S. District Court in Minnesota. Federal then asked the Minnesota Court to enjoin the action in North Carolina. Judge Ann D. Montgomery held that the Minnesota action would be stayed pending a decision by the North Carolina Federal Court as to the “first-filed” rule of judicial economy. Judge Montgomery held that although there was some authority supporting the date of service, most courts looked to the date of filing in evaluating the first-filed issue. Judge Montgomery went on to note that the first-filed rule is not to be applied in the Eighth Circuit if there are “compelling circumstances” to support its abrogation. In the Eighth Circuit two such red flags would be that the first filer had prior notice the other party was considering legal action, or that the first filer seeks a declaratory judgment. Judge Montgomery refused to enjoin the North Carolina proceeding, and instead stayed the matter pending a decision as to proper location by the North Carolina Court.

February 2004

Assessment Technologies v. Wiredata [CA 7, 11/25/03 350 F.3d 640] Database; Copyright.

Judge Posner is at it again. The database information at issue involved real estate, property owner information and

assessment data maintained by municipalities in Wisconsin. The plaintiff, Assessment Technologies, developed a computer program called "Market Drive" used by many independent contractor tax assessors hired by municipalities. The assessors would use the Market Drive program to enter the raw assessment data and the program would then automatically allocate the data to 456 fields grouped into 34 master categories. All the data would then be stored in a database and the tax officials at the municipality could use various means of accessing the database to view the data in the file.

A company owned by Multiple Listing Services, Inc. desired to obtain some basic property information for use by real estate brokers. The company sought to obtain the information based on the state "open records" law, but certain municipalities refused to provide the information asserting an exception under the law for copyrighted materials. The MLS company had sued in order to force disclosure of the information, and then Assessment Technologies sued Wiredata alleging copyright infringement and theft of trade secrets. Judge Posner indicated it would not be necessary to rule on the trade secret issue, but noted that it is hard to see how there could be a trade secret when the database was freely distributed in demo versions.

Judge Posner summed up the case as follows: "This case is about the attempt of a copyright owner to use copyright law to block access to data that not only are neither copyrightable nor copyrighted, but were not created or obtained by the copyright owner." This case is a "must read." Judge Posner discusses the concept of copyright misuse and notes that "legal protection of databases as such . . . cannot take the form of copyright . . ." The Judge also notes that the Zeidenberg precedent is irrelevant since the defendant here is not bound by any contract.

Fraser v. Nationwide [CA 3, 12/10/03] Electronic Communications Privacy Act; Employer Search of Employee E-mail.

The background to this case involves a fairly highly compensated insurance agent who lost his job for apparent lack of loyalty. After termination he accepted work for a competitor, which violated a loyalty clause and caused him to forfeit several hundred thousand dollars of deferred compensation. The employer attempted to justify the firing based upon evidence in his e-mails and the employee argued that the search of his e-mail gave him a claim for damages under the ECPA. The Court discussed the issue of whether the employer's search of the e-mail account violated Title I of the ECPA, which prohibits "intercepts" of electronic communications. The Court stated "every circuit court to have considered the matter has held that an "intercept"

under the ECPA must occur contemporaneously with the transmission." Thus, the Court held that there was no "intercept" since in this case the e-mail was stored. With regard to the employee claim that the e-mail search violated Title II of the ECPA regarding Stored Communications, the Court held that the employer was protected under the service provider exception within the statute since the employer provided the e-mail service.

Inter-Tel, Inc. v. CA Communications [USDC MN 12/29/03] Employee Non-Compete; Trade Secret.

This is another "must read" case. Plaintiff acquired a company by purchase of assets, and received assignments of non-competes. The defendant employees succeeded in obtaining summary judgment on most claims but the Court held that there was a genuine issue of material fact on claims regarding unfair competition, misappropriation of trade secrets and tortious interference with customer contracts. Perhaps most noteworthy is the holding that if an employee covenant not to compete fails to contain a provision specifically allowing for assignment then the covenant cannot be enforced by an assignee.

West Publishing v. Stanley [USDC MN 1/7/04] Non-Compete; Personal Jurisdiction/Venue.

The defendant Stanley was one of the cofounders of FindLaw. West acquired FindLaw in January 2001 and hired Stanley as a vice president. Stanley signed an employment agreement with restrictive covenants that included a two-year covenant as well as forum selection and choice of law provisions specifying litigation in California under California law. In April 2003, Stanley executed a Separation Agreement, which paid him the equivalent of one year's salary in exchange for covenants not to compete nor solicit West employees, and Stanley released any claims against West. Interestingly, the Separation Agreement did not contain either a choice of law or forum selection clause. About a week later, Stanley sent a letter to West indicating that he might choose to violate the Separation Agreement and, therefore, West might want to escrow any payments he had coming. The next day Stanley started a competing business. But a week later, Stanley's attorney sent a letter to West assuring West that it was understood the Separation Agreement was binding and that Stanley was not intending to rescind it.

After a few months when West realized that Stanley was competing, Stanley's attorney claimed that the restrictive covenants were unenforceable as a matter of law and would not be honored by Stanley. West then sued in Nevada where Stanley's competing corporation was formed, but Stanley objected to jurisdiction and venue. Stanley then commenced his own action in California seeking declaratory

judgment as to the parties' rights under the Separation Agreement. West then voluntarily dismissed the Nevada action and commenced the action in Minnesota on November 3, 2003. The Minnesota Federal Court found that it had personal jurisdiction over Stanley given that he had sold his business to a Minnesota company, entered into an employment relationship with a Minnesota company and made multiple visits to Minnesota. The Court went on to hold that Minnesota law would govern the Separation Agreement, and the Court issued a preliminary injunction prohibiting Stanley from pursuing a competing business through November 15, 2004.

Kalmes Farms v. J-Star Industries [USDC MN 1/16/04] UCC Sales, Warranty, Exclusive Remedies, Limitation of Liability.

The facts involve the sale of silo equipment to a farmer. The farmer alleged the equipment was defective causing the silage to go bad and that caused loss to his cattle herd. The seller alleged various contractual limitations, as well as asserting the "economic loss doctrine" prohibiting economic losses that arise out of commercial transactions being recovered under tort theories. The economic loss doctrine in Minnesota is now impacted by Minnesota Statute Section 604.10, which allows recovery in tort as well as contract so long as the transaction is not a sale of goods between merchants. The Court held that a farmer is not a "merchant in goods of the kind" relying in part upon a recent Eighth Circuit Court decision in *Holden Farms* (347 F.3d 1055). Essentially, with regard to the contract limitation defenses, the Court ruled against the seller because the key clauses relied upon by the seller was not disclosed to the buyer until after the sale occurred.

March 2004

Bangoura v. The Washington Post [Canada: 2004-01-27] Ontario, Canada Superior Court 03-CV-247461CM1 URL: <http://www.canlii.org/on/cas/onsc/2004/2004onsc10181.html> Jurisdiction/Venue – website.

A Canadian citizen claimed he was defamed by articles appearing in the *Washington Post*. The Canadian Court asserted jurisdiction over the *Washington Post* due in part to the fact that the Post website could be viewed in Canada. The Court cited the Australian Court decision in *Dow Jones v. Gutnick*.

American Online v. Pasioka [Florida; 1/29/04] Forum selection clause in contract.

A class action suit was brought against AOL in Florida alleging consumer issues with regard to problems of AOL members canceling their subscriptions. AOL attempted to

dismiss the case based upon the forum selection clause in its membership agreement. The Court refused to honor the forum selection clause.

K-tel v. Tristar [USDC MN 1/29/04] Court order refusing Summary Judgment—UCC Implied Warranty.

K-tel's related company in Germany purchased BUNBLASTER exercise equipment for sale in Europe. The equipment was defective. K-tel and its German company sued in state Court in Minnesota. The defendant removed to federal Court and then sought to obtain summary judgment. It is interesting to note that the sales agreement apparently failed to disclaim the implied warranty of merchantability. Also, the Court held that K-tel had standing to assert the warranty claims because Minnesota law extends the UCC implied warranties not only to purchasers but to any person who may reasonably be expected to be affected by the goods.

Cardenas v. Prudential [USDC MN, 1/30/04] Court Order regarding Pre trial discovery—Privilege and Work Product.

At issue were materials from performance reviews involving in-house attorneys, including not only supervisor materials, but also self-assessments. The Court ordered that some of the materials were discoverable. In particular, the Court noted that "work product" typically involves items prepared in anticipation of litigation and not items made after the litigation is complete. On the issue of attorney/client privilege, the Court noted that for in-house counsel the privilege applies only if the communication's primary purpose is to gain or provide legal advice rather than a business purpose.

Lyon Financial v. Reno Sparks Assoc. of Realtors [USDC MN, 2/4/04] Venue, Forum Selection.

This case involved equipment leases, which had been assigned by the lessor. The equipment lease contained a forum selection clause allowing the lessor or its assignee to choose the forum. The Court held that such clause did give Minnesota Courts jurisdiction over an out-of-state defendant, but the Court transferred the action to Nevada based upon convenience and interests of justice.

In re Stuart E. Gale -Attorney Discipline—Improper Notarization.

The attorney paid \$1,657 in costs plus suffered a public reprimand based on notarizing his daughter-in-law's signature on a mortgage when in fact the daughter-in-law did not appear before the notary nor did she in any way personally acknowledge the signature. Apparently, the attorney's son signed his wife's name telling the attorney – father that the wife had authorized him to sign for her.

April 2004

Inquiry Management Systems Ltd. v. Berkshire [USDC Southern District, New York; 2/26/2004] DMCA – Password – Circumvention.

Although I have not obtained a copy of the opinion in this case, I have seen a number of news articles. The plaintiff apparently sued under the Computer Fraud and Abuse Act portion of the DMCA arguing that the defendant circumvented a security system protecting copyrighted data, when it used a password to access a database on the plaintiff's website. Judge Naomi Buchwald held that the defendant's conduct may have been improper, but the "anti-circumvention provision in the law did not target this sort of activity."

SL Montevideo Technology, Inc. v. Eaton Aerospace [USDC MN; 3/2/2004] Trade Secrets; Personal Jurisdiction.

The Court's Order on March 2004 by Judge Kyle denied the Defendant's motion to dismiss for lack of personal jurisdiction. The Court held that there are sufficient minimum contacts despite the limited physical contacts. The Court's previous Order on November 24, 2003 details the interesting factual background. Essentially the parties had been negotiating from 1994 through the year 2000, but had no written contract or confidentiality agreement signed before 2000. When the parties did finally sign the confidentiality agreement in the year 2000, that document specifically acknowledged that there had been a previous exchange of proprietary information and the parties agreed to treat that information in accordance with the confidentiality agreement. However, by that time, apparently, the defendant had already shared the proprietary information with a third party, which used that information to enter into competition with the plaintiff. This case clearly illustrates the importance of protecting proprietary information with a written confidentiality agreement.

Lucas Nursery and Landscaping v. Grosse [USCA Sixth; 3/5/04] Electronic Citation 2004 FED App. 0071P. Domain Name – ACPA.

Grosse established a website using the domain name "*lucasnursery.com*" on which she detailed her complaints against Lucas Nursery for its allegedly bad service. Lucas sued under the ACPA. The District Court granted summary judgment to the defendant and the Sixth Circuit Court of Appeals affirmed finding insufficient showing of "bad faith." The Court of Appeals noted that the practice of informing fellow consumers of one's experience with a particular vendor is surely not inconsistent with the ideals of the ACPA. A separate news story indicated that the

defendant spent close to \$20,000.00 in legal fees defending herself.

Winthrop Resources Corporation v. Eaton Hydraulics [USCA Eighth; 3/11/2004] Computer Lease Default Damages.

The computer lessor recovered nearly \$4.5 million in damages, costs, disbursements and attorney's fees. The original lessee was Vickers, Inc., which entered into the lease agreements in 1997. Eaton thereafter acquired Vickers and attempted to get the equipment lessor to substitute Eaton's "standard form" for the lease. The lessor refused and, in 2001, sued for breach of the lease based on failure to meet numerous payment obligations and other obligations under the lease. On April 23, 2002, the District Court granted the lessor summary judgment noting that Eaton did not dispute that it had breached the lease. Apparently Eaton had not taken the case seriously up to that point. Thereafter they raised a variety of contentions, which were rejected as not being timely. The moral of this story is that the courts really do enforce those onerous, obnoxious lease provisions.

Louis Kemp v. Tyson Seafood Group and Bumble Bee Seafoods, Inc. [USDC MN; 3/30/2004] Trademark / Concurrent Use Issues.

This case does not appear to establish significant new legal principles. However, the case illustrates the potential mess that can result from consent judgments and concurrent use. The case began with competing attempts for declaratory judgment regarding use of the "Louis Kemp" name between Louis Kemp and Bumble Bee. In March 2001, the Court denied summary judgment to both parties and, in May, the parties stipulated to a Consent Judgment based in part upon a prior bankruptcy proceeding establishing limited rights in use of the "Louis Kemp" name regarding imitation seafood. The Court refused to enjoin Bumble Bee from using the Louis Kemp trademark in connection with a smoked salmon product line, but further held that Kemp could use his personal name with regard to a line of wild rice products.

Infringement Licensing, a Practical Approach

By: Frank S. Farrell*, Moore, Hansen & Sumner, PLLP

Infringement licensing is the process of attempting to generate revenue by licensing intellectual property to an organization or individual who is arguably infringing the owner's intellectual property rights. This article is focused on licensing patents, but much of this information is applicable to licensing other forms of intellectual property.

There are many myths about infringement licensing. The most dangerous myth goes something like "Once you have an issued patent, and a plausible infringement argument, licensing revenue will follow". The following is based on the University of Houston Law Center's analysis of reported U.S. patent cases in the year 2002. When issues of validity were litigated, the patent owner had their patents declared invalid in more than 40% of the cases. When issues of infringement were litigated, the patent owner lost in 70% of the cases.

In the author's view there are three cardinal rules in infringement licensing. Those rules are:

1. Pick your battleground, don't let the battle ground pick you.
2. Do your homework.
3. Have realistic financial expectations.

Choosing Your Battle Ground

When it was enacted in 1934, the Declaratory Judgment Act created a new remedy. After its enactment, this new remedy found almost immediate application in patent disputes. Simply stated, a potential defendant in a patent infringement suit may, under appropriate circumstances, be allowed to take the initiative and file an action requesting a court declare that the patent in question is not being infringed or that the patent is invalid. This presents obvious problems for the patent holder. A patent holder who finds itself on the wrong end of a declaratory judgment suit will, in effect, be the defendant and not the plaintiff, and will in all likelihood be required to litigate in a venue that is at best, inconvenient.



In addition to the requirement that the Declaratory Judgment Action have a federal question (i.e. the patent dispute), the Declaratory Judgment Act also requires that there be an actual controversy between the Parties 28 U.S.C § 2201. The "actual controversy" language in the Declaratory Judgment Act has been problematic and often litigated over the years. In the case of *B.P. Chemicals Ltd. v. Union Carbide Corp.* 4 Fed.3d 975, 977, 28 U.S.P.Q 2d 1124-1126 (Fed. Cir. 1993) The Courts stated that "the purpose

of the Act is to enable a person who is reasonably at legal risk because of an unresolved dispute, to obtain judicial resolution of that dispute without having to await the commencement of legal action by the other side. It accommodates the practical situation wherein the interest of one side to the dispute may be served by delay in taking legal action. However, the controversy must be actual, not hypothetical or upon certain prospective occurrence...There must be a definite and concrete dispute between the Parties, appropriate to immediate and definitive determination of their legal rights."

Cases where the Courts have found a sufficient charge of infringement to support a Declaratory Judgment Action are numerous. Facts and circumstances which have been held sufficient to sustain a Declaratory Judgment action have included: (1) A history of litigation between the Parties *Interdynamics Inc. v. Firma Wolfe*, 698 Fed.2d 157, 217 U.S.P.Q. 117 (3rd Cir. 1982); and, (2) Threats or statements to customers, *Societe Day Conditionnement v. Hunter Engineering*, 655 Fed.2d 938, 210 U.S.P.Q. 344, (9th Cir. 1981); and (3) Commencing a Patent Infringement Suit Against a Customer, *Joseph Bancroft & Sons v. Spanaize Co. of America*, 268 Fed.2d 522, 122 U.S.P.Q. 110, (2nd Cir. 1959); and (4) A General Announcement in a Trade Publication that a Company Owned "1600 patents in a field and had virtual control over the industry and would sue all infringers," *A Federal Telephone and Radio v. Associated Tel and Tel.*, 169 Fed.2d 1012, 78 U.S.P.Q. 1, (3rd Cir. 1948); and (5) an opinion of infringement by Counsel for the patent owner, *A Hawley Prod. Co. v. U.S. Trunk Co.*, 259 Fed.2d 69, 118 U.S.P.Q 424, (1st Cir. 1958), and (6) Assertions of infringement made during licensing negotiations, *Millipore Corp. v. Universities Patent, Inc.*, 682 Fed. Supp. 227, 4

U.S.P.Q.2d 1946 (D. Del. 1987); and (6) Suits filed in other countries on analogous foreign patents *BASF Corp. vs. PPG Industries*, 23 U.S.P.Q.2d 1193 (D. N.J. 1991)

The cases finding an insufficient charge of infringement to sustain the Declaratory Judgment Action are also numerous. Cases that have held the fact pattern insufficient to sustain a Declaratory Judgment action have included: (1) a patent owner telephoning the other Party and requesting of a sample of their product so the patent owner can determine whether there was an infringement *American Needle and Novelty Co. v. Shuchuessler Knitting Mills, Inc.*, 379 Fed.2d, 376, 154 U.S.P.Q. 128 (7th Cir. 1967); and (2) a case where the potential infringer contacted the patent owner submitting product information and requesting a confirmation from the patent owner that the product would not infringe, with the patent owner refusing to provide that information, *International Harvester Co. v. Deere & Co.* 623 Fed.2d, 1207, 206 U.S.P.Q. 722 (7th Cir. 1980), and (3) statements made by a patent owner that the other Party is infringing its patents, when those statements were made in the course of negotiations involving a possible purchase by the patent owner of the other Party's assets, *Solenoid Devices, Inc. v. Led Ex, Inc.* 375 Fed.2d 444, 153 U.S.P.Q. 327, (Fed. Cir. 1967); and (4) a case where the patent owner had stated at a business conference that it would maintain its exclusive position by enforcing its patents against other companies developing competing products, refused to license its patent to the other party, which caused the other party's business partner to withdraw financial support for their product development. *Cygnus Therapeutic Systems v. Alza Corp.*, 92 Fed.3d 1153 (Fed. Cir. 1996).

The most helpful case in this area is *SRI International, Inc. v. Advanced Technology Laboratories, Inc.*, 127 Fed.3d 1462, 44 U.S.P.Q.2d 1422 (Fed. Cir. 1997). In that case the Federal Circuit held that the patent owner's letter offering a license was sufficient notice for purposes of the patent marking statute but was insufficient to sustain a Declaratory Judgment action. In that case the Courts stated: "The criteria for actual notice under §287(a) are not co-extensive with the criteria for filing a Declaratory Judgment Action. These statutory purposes are distinct, served different policy, and are governed by different laws. The requirement of actual notice under §287(a) is designed to ensure that the recipient knew of the adverse patent during the period in which liability accrues, when constructive notice by marking is absent. Actual notice may be achieved without creating a case of actual controversy in terms of 28 U.S.C. §2201 i.e. (The Declaratory Judgment Act)."

The previously cited case law, although somewhat confusing, does offer clear guidance to anyone attempting to license their patents to potential infringers.

When dealing with potential infringers in cases where litigation has not been commenced, the patent owner should always do the following:

- (1) When you initially contact the potential infringer, always attach complete copies of any patents you think are being infringed.
- (2) Always make a clear offer to license.
- (3) Never directly threaten litigation.
- (4) Only discuss infringement in general terms.
- (5) Never disclose infringement analysis information to the potential licensee.

By providing copies of the patent, you are putting the other party on notice without running risk of a declaratory judgment action. Putting them on notice then puts you in a position in the future to argue that any infringement from that point forward was willful. Making a very clear offer to license should enable you to successfully argue that there is not at that point and time actual controversy between the parties, but that you are simply attempting to negotiate a business deal. In fact, in all contacts prior to litigation, I would say nothing more than you had viewed product X and you think that the other party "may" require a license to the XYZ Patent. Avoid setting deadlines, because that can be viewed as an implied threat. If you need to specify a time frame, "requesting" a response by a specified date is certainly more advisable than "demanding" a response by a specified date. Avoid the topic of litigation whenever possible. This is not only in any documents you send, but in the course of negotiations with the other side. Avoiding controversial topics can often be difficult especially when dealing with lawyers but I would follow the first rule of sales, which is "always circle back to the business deal".

Do Your Homework

It is always advisable to obtain as much hard information about potential infringement claims, as soon as possible in this process. This will involve at least the following:

- (1) Identify all patents that are being infringed.
- (2) Map all independent claims of the patents identified in step 1.
- (3) Obtain the file histories of the identified patents.
- (4) Attempt to identify validity and prior art problems with the identified patent.
- (5) Attempt to identify chain of title problems.
- (6) If possible, obtain the infringing articles for analysis.

The claim map is your primary infringement analysis tool and those maps should be carefully drafted to ensure that all the required elements of the independent claims are clearly identified.

A file history should be obtained and read carefully, particularly in light of the information contained in the claims map. Particular attention should be paid to information in the file history which resulted in restriction or narrowing the claims in of the patent.

Process patents can be a particularly problematic area. If it at all possible it is best to obtain as much information about the process being practiced by the potential infringer before putting them on notice. Once notice has been given, it will be more difficult to obtain that information. You should also be aware of the Process Patent Amendments Act of 1988. That Act designates the importation, sale or use of a product made by a patented process as infringing acts under United States Law, even if the manufacturing is done outside of the United States. There are a number of limitations and conditions in the Process Patent Amendments Acts of 1988. The infringement provisions will not apply to foreign manufacturers who do not themselves import the alleged infringing product into the United States. Liability will only arise under that Act if the importation, sale or use occurs during the process patent's term. Liability will not extend to importation, sale or use prior to the date the U.S. patent actually issued, or before the Process Patent Amendments Act became effective.

Information regarding related foreign patents and patent applications should also be identified and analyzed. Understanding the scope of protection outside of the United States is important information, and can be very helpful in licensing negotiations.

Have Realistic Financial Expectations

It is important for the patent owner to understand what their potential claim for damages would be in litigation in order to make a reasonable and realistic demand in licensing negotiations.

Generally speaking in patent infringement matters, the appropriate measure of compensatory damages will be either: (1) lost profits; or (2) an established royalty; or (3) a reasonable royalty. Which of these three is the appropriate measure of damages will depend largely on the facts and circumstances of any individual case.

For a patent owner to have a legitimate claim for lost profits, the patent owner must establish a factual basis for causation. This means that the patent owner must prove

that but for the infringer's improper acts the owner would have: (1) made greater sales; and /or (2) been able to charge higher prices; and/or (3) incurred lower expenses. Causation need only be proved as a reasonable probability and inferences can be drawn that the patent owner's sales would be equal in quantity to the sales of the infringer if there are very limited number of suppliers for the product in question. Causation will be more difficult to prove when the patent in question only covers an improvement or a small part of the product sold by the infringer.

It should also be noted that the Federal Circuit has established a foreseeability requirement in addition to that of causation. *A Rite-Hite Corp v. Kelley Co., Inc.*, 56 Fed.3d 1538, 35 U.S.P.Q.2d 1065, (Fed. Cir.1995). In that case the court stated: "We believe that...the balance between full compensation, which is the meaning that the Supreme Court has attributed to the statute, and the reasonable limits of liability encompassed by general principles of law can best be viewed in terms of reasonable, objective foreseeability. If a particular injury was or should have been reasonably foreseeable by an infringing competitor in the relevant market, broadly defined, that injury is generally compensable absent a persuasive reason to the contrary. Here, the court determined that Rite-Hite's lost sales of the ADL-100, a product that reasonably competed with the infringing product, were reasonably foreseeable. We agree with that conclusion. Being responsible for lost sales of the competitive product is surely foreseeable; such losses constitute the full compensation set forth by Congress, as interpreted by the Supreme Court, while staying within the traditional meaning of proximate cause. Such lost sales should therefore clearly be compensable."

Although it may not be realistic in a licensing negotiation to expect that the license fee will be as high as a potential award of lost profits would be in the event of litigation, if the patent owner does have a legitimate claim for lost profits, it does put them in a position to claim a higher license fee then they would otherwise be able to.

Established royalty refers to a measure of damages, which is based on the royalty rate paid by prior actual licensees for acts comparable to those engaged in by the infringer. An established royalty rate may only be established based on licenses freely negotiated and paid for, and it generally needs to be a case where there are multiple licensees. Any license fees agreed to under threat of suit, or in settlement of litigation, generally will not be considered to determine an established royalty. The existence of an established royalty will usually set the minimum recovery by the patent owner but it does not necessarily establish the maximum potential recovery by the owner. However, the existence of an established royalty will preclude the patent owner from recovering a greater sum of damages for list profits,

based on the theory that an owner who exploits its patent by nonexclusive licenses with an established rate, cannot then logically complain of lost sales in its capacity as manufacturer seller. The possibility of an established royalty calculation is something all potential licensors should be cognizant of in cases where they are considering granting multiple nonexclusive licenses. In short, what you agree to today can have substantial effect on what you may recover from other licensees in the future.

The most likely royalty calculation you will be required to make for purposes of preparing for licensing negotiations, is to calculate what would be a "reasonable royalty". A reasonable royalty for use of a patented invention has been defined as the amount, which would have been set in hypothetical negotiation between a willing patent owner and a willing potential licensor. In determining this license rate the Courts will consider a variety of factors or categories of evidence. Factors, which will be considered in determining a reasonable royalty, are as follows:

1. Royalties received by the patent owner for the licensing of the patent involved from other licensees.
2. Royalty rates paid by the licensee for use of other patents comparable to the patent in question.
3. The nature and scope of the license, exclusive versus non-exclusive, restrictions in terms of territory or restrictions with regard to whom the products may be sold.
4. The patent owner's policy with regard to using the patent to maintain a monopoly by not licensing to other third parties or the granting of limited or specialized license to design to preserve that monopoly.
5. The commercial relationship between the patent owner and the licensee within the same line of business.
6. The effects of selling the patented products have in promoting the sales of other products sold by the licensee.
7. The duration of the patent and the term of the license.
8. How the profitability of the patented product including its commercial success in popularity.
9. The commercial advantages obtained by practicing the patented invention over the prior art.
10. The benefits to those who have used the invention.

11. The extent to which the infringer has made use of the invention and the value of that use.
12. The portion of the profit or the selling price of the patented product that may be customary in that particular business to allow for the use of the invention or similar inventions.
13. The portion of the profit that should be credited to the invention as opposed to non-patented elements of the product.
14. The opinion testimony of qualified experts.
15. The amount that the patent owner and the infringer would have agreed upon if both had been reasonably and voluntarily trying to reach an agreement.---In other words, what would a prudent licensee be willing to pay as a royalty to enable it to still make a reasonable profit and been acceptable by a prudent patent owner willing to grant such a license.

Conclusion

If litigation becomes necessary, the patent owner should do what it can to ensure that litigation takes place in a venue and with Defendants selected by the Owner. The patent owner should analyze infringement, validity and enforceability issues as early in the licensing process as possible. Finally the patent owner should have a good understanding of what its likely measure of compensatory damages would be in the event of infringement litigation when it enters into negotiations.

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Trademark Clearance Strategies Under the Madrid Protocol in the U.S.

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Introduction

For over a hundred years numerous countries around the globe have participated in an international system for registering trademarks, which provided both cost savings and administrative ease. This system, known as *The Madrid Agreement Concerning The International Registration of Marks* (the Madrid Agreement), dates from 1891. In principle, it facilitates the process of obtaining trademark protection in member countries through a single trademark application. However, the single application is not subject to substantive trademark law. It only provides a mechanism for filing in multiple countries. Each country retains the right to refuse an application based on its own trademark law and practice.

Many countries have historically been hesitant to apply for membership to the Madrid Agreement, because the rules of the Madrid Agreement are very strict (e.g. filings only in French language). Therefore, in 1996 some requirements were relaxed via the *Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks* (the Madrid Protocol). Accordingly, numerous additional countries applied and obtained membership in the Madrid Protocol.

The U.S. eventually acceded to the Madrid Protocol on August 2, 2003 which became effective in the United States as of November 2, 2003. As a result, 62 countries are now members of the Madrid Protocol¹. For a U.S. applicant, it is now easier to file trademark applications in the countries, which are members of the Madrid Protocol. At the same time, foreign applicants residing in these countries can now more easily claim trademark protection in the U.S. It is important to note, however, that an applicant who chooses an International Application (rather than several national applications) applies for a bundle of trademarks in the designated countries. This approach is unlike the European Community Trademark system in which the applicant obtains one trademark registration, which enjoys protection in several countries.²

Mechanics of Filing an International Application from the U.S.

In general, an American applicant who chooses the Madrid Protocol files for an International Trademark with the USPTO.³ The applicant “designates” countries in which protection is sought. The USPTO then certifies and forwards the application to the International Bureau of the World Intellectual Property Organization (WIPO) in Geneva, Switzerland (IB). The IB examines only some formal requirements — it does not examine the application regarding substantive requirements such as genericness, descriptiveness or prior rights. Nevertheless, the filing procedure for a problem-free trademark in all the designated countries will be handled by the International Bureau. The advantage is that a foreign national representative need not be nominated.

Important Considerations for Filing an International Application

In order to file an International Trademark Application, the following considerations are important:

A. Basis for an International Application

An International Trademark Application must be based on one or more national (American) trademark applications or registrations (called: Basic Application(s)/Registration(s)). The application must be filed in the name of the same owner as the Basic Application/Registration. The identification of goods cannot exceed that listed in the basic application.

B. Claiming Priority

If the applicant wants to claim priority, an international application has to be filed within 6 months after the date of application at the Office of Origin. In other words, a designation for protection under an International Application must be made within six months from the date the U.S. applicant filed the application for protection in the U.S. at the USPTO. Otherwise, an application can be filed at any time (and will not enjoy any priority before its own

registration date at the IB).

C. U.S. Patent and Trademark Office Filing Fees

The U.S. fees for certifying and forwarding the application to the IB are \$100 per class based on a single-basic application or registration or \$150 per class based on more than one basic application or registration.

D. International Bureau Filing Fees

The IB also charges fees⁴: There is a basic fee⁵ (653 Francs⁶ for a word-mark; 903 Francs⁷ when the reproduction of the mark is in color), an additional supplementary fee for each class of goods and services beyond three classes (73 Francs⁸ for each class), and an additional complementary fee for the designation of each designated contracting state (73 Francs). However, the contracting states are allowed to charge individual fees⁹ instead of the supplementary or complementary fee. The individual fees can vary widely: *e.g.* Germany charges no individual fees, whereas Japan charges 600 Francs¹⁰ for the first two classes. IB provides a fee calculator which one can easily calculate the filing fees.¹¹

Advantages of the Madrid Protocol

A trademark application filed under the Protocol has several advantages. First, an applicant need only file one application instead of retaining and giving instructions to numerous national experts. This can represent a large savings in expert fees, especially in the case of countries, which do not charge individual fees.¹² Second, correspondence between the applicant and the USPTO and IB is only in English. As a result, an applicant will not be required to undertake considerable translation costs of the goods or services descriptions. Further, applicants need not sign a power of attorney for the representatives in each country. And finally, an applicant is not faced with paying fees in multiple currencies; the IB deals with Francs only.

European Community Trademark or International Trademark?

Clients often want to know whether they should file a CTM or an International trademark application. As with most things, there is no one answer. Each system has its own advantages.

Under several scenarios, a CTM filing would be cheaper. It presently costs 2,075 EURO¹³ for 15 countries. However,

if there is one absolute or relative grounds-based problem in one country the entire application is in jeopardy.

In contrast, under the Protocol, a problem in one country affects the trademark in that country only. But a Protocol-based registration has its own vulnerability in that a problem (*e.g.* cancellation, amending identification of goods) with the basic application or registration will cancel the international trademark if it occurs within the first five years of registration.

Furthermore, many non-U.S. countries require use of a trademark in order to defend the trademark in an adversarial proceeding. If the trademark is not used within a certain time period it can be cancelled in a cancellation action and it cannot be used as the basis for an opposition. Use of a CTM in one CTM-country is sufficient to defend the CTM registration or to claim rights in an opposition. Under the Protocol, however, the applicant must prove use in each country at issue.

Impact of International Registrations on U.S. Clearance

The effect the Madrid Protocol will have on clearing a mark in the U.S. is not certain. To some degree, foreign applicants with business in the U.S. have always sought to protect their trademarks domestically. One could argue that the volume may not change, just the basis for the registration (the new "Section 66(a)" filing basis, based on an International Registration) will change.

However, it may be that a flood of new trademark applications will appear – trademarks, which are based on foreign trademark rules, which allow for very broad descriptions of goods and services. These descriptions will of course be subject to the U.S. standards, which require a much more specific and narrow identification of goods and recitation of services. Nevertheless, for a time before these applications are examined and amended they will appear on search reports.

A. How and Where U.S. Practitioners will see Madrid Data

Foreign Applicants within a Madrid Protocol country who seek a trademark registration in the U.S. will designate the U.S. as an extension of protection at their home country's national trademark office. The national office will forward the information to WIP in Geneva. At this time the data is placed on the WIPO International Register ("IR"). WIPO then sends the application information to the USPTO. The USPTO enters the application data into its own database of applications and registrations.

A party searching trademarks in the U.S., therefore, will see “Section 66(a)” applications based on a foreign trademark application or registration, which were filed under the Madrid Protocol. So far, it would appear that the USPTO would only publish that data which it requires for any application, much like those filed under the Paris Convention (44(d) and (e)). The USPTO will require WIPO to translate non-English applications to English.

B. *How This Differs From Europe*

It appears that the USPTO’s decision to include Madrid Protocol data differs from other countries. For example, Germany’s Trademark Office’s public database only includes data from national filings – a party clearing a mark in Germany must not only search the German Trademark Office database, but also separately search both the CTM and WIPO IR databases.

Here, by contrast, Americans can simply search the USPTO database. All International Registrations designating the U.S. will be contained in the database. The data is set forth in a special section of the trademark application record in the USPTO database labeled “Madrid Protocol Information”. This section contains fields, which indicate the applications IR number, IR registration date and the date upon which priority (if any) is claimed by virtue of a national basic application.

C. *Primary Reason to Search the IR — the Blackout Period*

It appears that a gap in time exists between the time a request for extension of protection in the U.S. is filed with WIPO and the time it actually appears on the USPTO database. This gap ranges from two weeks to two months. This represents a serious blackout period, which could jeopardize the integrity of a clearance effort in the U.S. In other words, an applicant conducting a clearance search may not find any previously registered or pending applications on the USPTO database; nevertheless, a blocking (identical) application may be wending its way through the WIPO process with a claim of priority of six months previous. Such an application, when it appears on the USPTO database, will act as a bar to registration to the U.S. application. Disappointment may not be the only problem for the client — significant funds spent on rolling out a new brand could be lost under such a scenario.

D. *Another Reason to Check the IR — Clues Germaine to the Risk Assessment*

As most trained in the art of clearance in the U.S. would agree, search reports often contain clues which help the practitioner estimate risks on behalf of a client. This is due to the rather unique nature of U.S. trademark law and its common law rights-based trademarks. A common example of how federal trademark data does not provide the entire risk picture is the fact that an abandoned application or registration at the USPTO does not necessarily equate to abandonment in the marketplace, and rights may therefore still exist under the common law. Thus, finding the same reference and owner later in a search report under a state registry or common law source can be very valuable in determining clearance.

The IR may similarly provide clues for clearance purposes. It is doubtful that the USPTO will include information on the Madrid Application as to other designated countries and refusals offered by those countries. Thus, checking the full record at WIPO may be advisable. For example, a look at the IR data may reveal that an applicant has used its mark for years in only a few countries, but recently it has started a major worldwide registration campaign. Or the IR data may reveal that the applicant has had refusals in numerous other countries, which may reveal the existence of an aggressive third party markholder. Thus, the IR may provide additional clues in a clearance search such that the client can be better informed of risk, or can undertake further investigation based on that information.

E. *Tips On How to Check the IR*

- Several sources exist to obtain further IR data. First is WIPO itself. WIPO provides a very simple search engine over the Internet called “Madrid Express”.¹⁴ This data is very limited, however, and not preferable for an in-depth study of the marks at issue.
- WIPO also provides its data through a CD-ROM format called ROMARIN. However, this is a subscription service that only publishes the CD a few times a year.
- The most current information can be found through several private search firm services such as Thomson and Thomson, CCH Corsearch, NameProtect, Trademark.com and AvantIQ.

- A brief review of the data from each provider reveals that formats can differ, and some include more data than others. AvantIQ has been a leader in Europe for offering the most complete information in this regard. Saegis, offered by Thomson and Thomson appears to follow AvantIQ in completeness and understandability of the data as well.
- For example, WIPO uses codes for each field, which can be confusing for American searchers. By contrast, the private search services replace the field code numbers with titles. Thus, using one of these companies will be advantageous for that reason as well.

⁴ The entire schedule of fees can be found at: www.wipo.int/madrid/en/fees/sched.htm.

⁵ The IB is located in Geneva/Switzerland. Therefore, the Official Fees are in Swiss Francs (Francs).

⁶ Approximately \$490.

⁷ Approximately \$685.

⁸ Approximately \$55.

⁹ The entire List of Individual Fees are located at: <http://www.wipo.int/madrid/en/fees/doc/individ.doc>.

¹⁰ Approximately \$455.

¹¹ The Fee Calculator is found at: <http://www.wipo.int/madrid/feecal/FirstStep>; For an incoming application, the USPTO will charge \$345.

¹² Only 73 Francs (about \$55) each class.

¹³ Approximately \$2,440 (filing and registration) plus attorney fees.

¹⁴ This search function is found at www.wipo.int/Madrid/en/services/guest_access.html.

Notes

¹ A list of all member states of the Madrid Agreement or Madrid Protocol can be found at <http://www.wipo.int/treaties/documents/english/word/g-mdrd-m.doc>.

² Hence, the Madrid system is quite different than the European Community Trademark system.

³ United States Patent and Trademark Office.

Calling All Addresses!

If you received a hard copy of this issue instead of a copy via the Internet, it means that the MSBA does not have your e-mail address. Less than 3% of our members still receive this newsletter via the quaint 'snail mail' method. Don't be left behind! Newsletters sent via e-mail arrive one to two weeks earlier than those sent via surface mail. Submit your e-mail address to the MSBA by contacting Rosanne Thompson at:

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Miller, D'Alemberte to Highlight MSBA Convention

Harvard Law School Professor Arthur Miller and former ABA President and Florida State Law School Professor Talbot "Sandy" D'Alemberte will be among the highlights of the 2004 MSBA Convention June 9-11, 2004, in Duluth.

On Friday morning, June 11, Professor Miller will moderate a panel of Minnesota state and federal judges, journalists, public officials and lawyers discussing "High Profile Cases and the Public's Perception of the Legal System." Miller's skill engaging panel members is familiar to many Minnesota lawyers who have enjoyed his thought-provoking performances at previous conventions. The event is sponsored by West.

Professor D'Alemberte has agreed to keynote the Thursday luncheon with remarks tentatively captioned "deTocqueville, Atticus Finch, and Pro Bono." With a career spanning service as a practicing lawyer, a legislator, law school dean, and university president — all in the state of Florida — Professor D'Alemberte is uniquely qualified to address his topic, including comments on Florida's experience with mandatory reporting of lawyers' pro bono service and the significant increase in pro bono service that has resulted.

While the Convention is designed to appeal to all lawyers, new and recently admitted lawyers will find special appeal in the free "New Lawyer Boot Camp" being offered for CLE credit Wednesday afternoon. Running from 2:00 to 5:00 p.m., the interactive "Boot Camp" sessions will range over "How to Start a Successful Firm and Grow a Successful Practice," "Evidence: Getting Yours In — and Keeping Them Out," and "Family Law Basics: Answers to Questions

Everyone Will Ask You." New lawyers can register for the Convention at a special reduced rate and the "Boot Camp" is included at no charge.

Additional opportunities for CLE during the Convention will range across practice areas and include sessions on such hot topics as "Reinstating the Death Penalty and Addressing Wrongful Convictions," "Mistakes Twin Cities Lawyers Make in Outstate Courts," and "Tribal Courts and the New Full Faith and Credit Rule." The Public Law Section will offer a session on "The International Practice of Public Law." Additional sessions are offered covering military law, animal law, elimination of bias, balancing law practice and personal life, alternative dispute resolution, real property law, and the impact on Minnesota's criminal justice system of the 1994 Scales decision.

Highlights of the Friday General Assembly meeting are expected to include consideration of a proposed alternative governance structure for the MSBA, issues in multijurisdictional practice and conflicts screening, and whether MSBA should take a position — and, if so, what position? — on such hot button issues as the definition of marriage and proposed restoration of the death penalty.

Additional opportunities for networking, recreation, and generally having a good time with fellow lawyers, judges, and their families will fill out this year's Convention on the shores of beautiful Lake Superior. A registration form is printed so act now to reserve your space for "Lighting the Way to the Future."

Reprinted from the April 2004 issue of "Bench & Bar of Minnesota".

Mark Your Calendar

Annual Computer Law Institute
Thursday, Sept. 9, 2004
Minnesota CLE Conference Center.

The keynote speaker will be Patty Sefcik-Hernan from the U.S. Department of Commerce. She is the Acting Deputy Assistant Secretary of the International Trade Administration, and she will discuss the U.S. position on technology regulation and goals for new regulation. Other keynote speakers include Stephen J. Davidson, Chair of Leonard Street & Deinard's Intellectual Property and Information Technology Law Department. Mr. Davidson will speak on the practical realities of open source vs. proprietary software. For further information, contact Kate Andresen at 612-339-6900.

MSBA Computer Law Section

Newsletter Article Guidelines

Subject Matter – Submit any articles of interest to the members of the Computer Law Section, as for example, recent issues on technology licensing, patents, copyright, trademark or Internet technology. Articles previously published in other publications are acceptable, if current. Preference is given to local authors.

Article Length – Articles of 3,500 words or less, but not more than 5,000 words, are preferred as the newsletter is limited to approximately 24 pages.

Article Format – Microsoft Word is preferred. Please contact the Editor before any other format is used. E-Mail submissions are preferred, although a disk or CD ROM is acceptable. Avoid the style of law reviews, CLE materials or legal briefs. A journalistic style is preferred. The structure of the article should include a “catchy” lead, followed by a “thesis paragraph” that tersely states the gist of the article. The exposition of the topic should then follow, with a summary at the conclusion.

Footnotes – Keep footnotes to a maximum of 25, as this is not a law review style publication. If footnotes are used, they should fall at the end of the article, not at the end of each page. All footnotes should be in the form prescribed by the *Uniform System of Citations*. Footnotes should be limited to citing specific authorities; ‘string’ citations and discursive notes are discouraged. The author is responsible for ensuring the completeness and accuracy of all references and citations. Article information and footnotes are not checked for accuracy.

Footer – Footers should contain only page numbers, not other information such as a date stamp, or an internal document number.

Copyright Notice – A Copyright notice is unnecessary. If the author wishes to include one, it should be placed at the end of the article, not on each page.

Title and By-Line – The article should include both a title and a by-line. The by-line should include both the author’s name and firm affiliation. It is not necessary to include any additional author biographical information. Keep any author practice areas, experience, etc., in the endnotes to a minimum.

Photographs – Photographs of article authors and Section events are encouraged. They may be in black and white or in color. Digital photographs are preferred, although prints are acceptable. If digital photographs are submitted, please e-mail them at the highest resolution available on your system. Submitting photographs on disk or on CD ROM is acceptable.

Graphs and Charts – The use of graphs and charts should be kept to a minimum. They are very difficult, if possible at all, to input into the MSBA’s Pagemaker software. Often graphs and charts must be recreated manually, substantially delaying the formatting set-up time and increasing cost.

Submission Deadline – The Computer Law Section Newsletter is published twice a year in December and in May. Submission deadlines are about 4 weeks prior to publication and are published in the Calendar of Events for the previous issue.

Distribution – The newsletter is distributed via e-mail. Those members without an e-mail address are sent a hard copy through the US mail, which is copied in-house at the MSBA.

Questions – 2004-2005 Editor, Damien A. Riehl at driehl@jllolaw.com 651-290-6525.

Computer Law Section New Member/Committee/Officer Interest Form

Enclosed is my check in the amount of \$35 payable to the MSBA. (Send to Section Services, c/o MSBA, 600 Nicollet Mall, Suite 380, Minneapolis MN 55402.)

I am a current Computer Law Section member. The following information is address change information only. Address information can be faxed to 612/333-4927; or e-mailed to mkempton@statebar.gen.mn.us.

Name _____

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If you are interested in joining one of the following committees for 2004-2005, or are willing to be considered for an officer or committee chair, please check below and send to Computer Law Section Chair.

	Chair	Join
<input type="checkbox"/> Annual Meeting	_____	_____
<input type="checkbox"/> Technology Law Institute	_____	_____
<input type="checkbox"/> Case Law Reports	_____	_____
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<input type="checkbox"/> Legislative Liaison	_____	_____

I would like to participate in the Section in the following ways:

___ Speak at a CLE ___ Contribute an article to the Newsletter

___ Other: _____

Check any of the following officer positions you would consider in the future:

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