GERMESHAUSEN CENTER
NEWSLETTER

FRANKLIN PIERCE LAW CENTER'S INTELLECTUAL PROPERTY NEWSLETTER

FALL 2000

IN THIS ISSUE:

USPTO Director Q. Todd Dickinson 2
Notable Happenings 3
Abandonment of U.S. Patent Application 4
Expanding *Chakrabarty* 5
Lawyer-In-Residence J.C. "Koos" Rasser 6
Visiting Scholar: Maria Cernobrovciuc 8
Property Protection in the Republic of Moldova 9
Legal Problems of Museum Administration 11
From the Editor 13
A Mother to the Nations Edythe Bowlby 15
Calendar 16

FPLC Welcomes New Dean John D. Hutson



Douglas J. Wood, Chairman of the Board of Trustees, appointed John D. Hutson as Dean of FPLC effective July 2000. He succeeds Richard A. Hesse who has served as interim dean following the death of Dean Eric Neisser in November 1999.

Hutson holds the rank of Rear Admiral, USN (ret.) and most recently served as Judge Advocate General (JAG) of the U.S. Department of the Navy where he was responsible for advising senior government leaders on legal issues regarding the environment, ethics, international law, and criminal law. Hutson has previously served as the head of the Naval Justice School and as a Navy liaison to the U.S. Congress.

"John Hutson brings to the Law Center a wealth of experience as an educator, a practicing lawyer and a manager. His work in the international legal community fits well with the Law Center's function as a global legal institution and as a participant in 'rule of law' projects in China and Russia" says Hesse.

"I am thrilled to be at Franklin Pierce Law Center" says Hutson. "It is a tremendous opportunity because it is not only a school that is already doing many things very well, but also has all the pieces in place to get even better. All the components, faculty, staff, administration and trustees, are eager to make a giant leap forward. I want to be a part of that."

The FPLC community extends a warm welcome to Dean Hutson and his family. ◆

PROFILE

Doug Wood

by Suzanne F. Saunders '01



When Doug Wood talks about Franklin Pierce Law Center, he speaks of community, vision and … a bull breeding farm?

Doug Wood, class of '76 and the current chair of the FPLC Board of Trustees, smiles as he describes the early years when the Law Center was located on Mountain Road and once served as a bull breeding farm. The "barn," as it is nostalgically referred to, was somehow converted to a girl's finishing school and subsequently became the site of the only law school in New Hampshire.

In the early years, FPLC was located on Mountain Road and maintained its farm-like ambiance. It was not uncommon to see a cow meander by as students learned the elements of a contract or principles embodied in our Constitution. In the warm months, fly strips hung from the rafters. The first FPLC class learned the law in a uniquely New Hampshire setting. Doug laughed as he told of the time he and his fellow classmate, Arnie Karanko, now President of a U.S. subsidiary of a large Finnish pharmaceutical company,

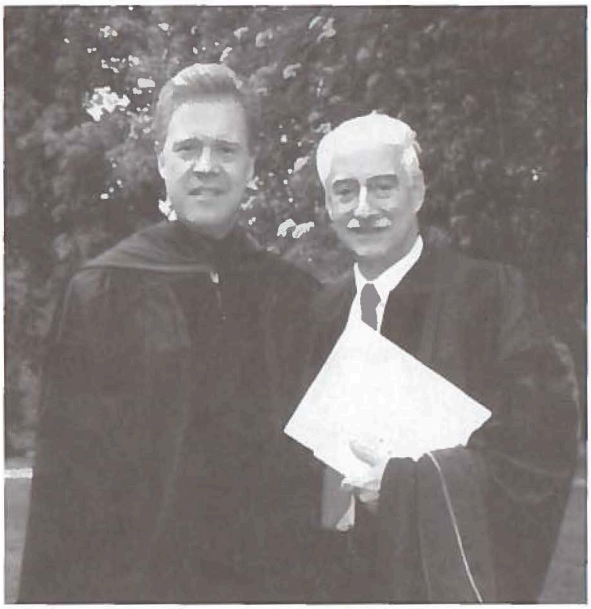
See WOOD page 7

VISIT THE FRANKLIN PIERCE LAW CENTER IP MALL AT: www.ipmall.fplc.edu

"One of the Internet's best sites devoted to intellectual property." — **The Internet Lawyer, May 2000**

USPTO Director Q. Todd Dickinson Delivers Commencement Address

Q. Todd Dickinson, Under Secretary of Commerce for Intellectual Property and Director of the U.S. Patent and Trademark Office, addressed the class of 2000 at graduation, held May 20, 2000. The faculty and student presentations were given by Professor William O. Hennessy and Franciscus Ladejola-Diaba of New York, NY. The Law Center awarded 123 Juris Doctor (JD) degrees, 31 Master of Laws (LLM) degrees, 32 Master of Intellectual Property (MIP) degrees, and 24 joint JD/MIP degrees.



In addition to managing the U.S. Patent and Trademark Office (USPTO) operations, Mr. Dickinson serves as principal policy advisor to the Clinton administration and Congress on all domestic and international intellectual property matters. He also serves as co-chair of the National Intellectual Property Law Enforcement Coordination Council which coordinates domestic and international intellectual property enforcement issues.

Under Mr. Dickinson's leadership, the USPTO is implementing the most sweeping reforms in patent law in over a half-century, and is being restructured into a performance-based operation. Dickinson also initiated a program making more than two million patents and all registered trademark and patent applications freely available on the Internet.

Mr. Dickinson has also implemented electronic filing of trademark and patent applications and established the Office of Independent Inventor Programs and the Office of Quality Management. He worked previously for the Philadelphia-based firm of Deschert, Price and Rhoads and served as chief counsel for intellectual property and technology at Sun Company. A native of Pennsylvania, Dickinson holds a BS degree in Chemistry from Allegheny College and a JD from the University of Pittsburgh School of Law. He is a member of the bars of Pennsylvania, California and Illinois.

"The world has changed far more in the past 100 years than in any other century in history. The reason is not political or economic, but technological" said Dickinson, quoting eminent physicist Stephen Hawking. "Reflecting upon the transitions we have seen in the Patent Office certainly reinforces that reality" continued Dickinson. "At the start of the last century, fully one-third of all patent applications filed in our Patent Office concerned one particular transportation technology, very important at the time: bicycle technology. Today, in our office, we routinely examine patent applications in such areas as gene fragments, bio-informatics, combinatorial chemistry and methods for using the Internet which were unthinkable even 10 years ago."

In his closing remarks to the graduating class, Dickinson said, "A lawyer's role in society does not come without accountability. When called to a higher purpose, as we are, we are also vested with greater responsibilities. Our ethical obligations, to our clients and the system, and our adherence to them, must be above reproach. Too often our colleagues ignore or repress these obligations in the heat of the day. Resist that temptation. Commit yourself to your community. This institution has been at the forefront of the possibility. Remember you have chosen a noble profession, it is up to you to choose a noble path." ◆

Published by the Kenneth J. Germeshausen Center for the Law of Innovation and Entrepreneurship

Editor:
Karl Jorda

Student Editors:
Matt McCloskey '01
Terri Zaino '01

Administrative Editor:
Carol Ruh

Editorial Assistants:
Chretien Risley '02
Suzanne Saunders '01

Photographer:
Saul Zackson, Ph. D '01

Created in 1985 through the generosity of Kenneth J. and Pauline Germeshausen, the Germeshausen Center is the umbrella organization for Franklin Pierce Law Center's specialization and policy studies in the legal protection, management, and transfer of intellectual property, especially as they relate to the commercialization of technology.

The Germeshausen Center Newsletter is published three times a year for alumni/ae, students and friends of Franklin Pierce Law Center. Our readers are encouraged to send news, photos, comments or letters to:

Carol Ruh
Franklin Pierce Law Center
2 White Street
Concord, NH 03301 USA
cruh@fplc.edu

FPLC DEDICATES MAIN BUILDING TO ROBERT M. VILES

On April 28, 2000 a ceremony was held at FPLC, naming the main building of the school after Robert M. Viles. A granite plaque was installed near the building's front entrance in memory of the former FPLC Co-founder, President, and Dean. Interim Dean Richard A. Hesse, and alumni Steven McCann '76 of Washington, DC and Douglas J. Wood '76, Chairman of the Board of Trustees, spoke at the afternoon presentation. An inscribed granite plaque installed in front of the brick building was also unveiled. Viles served as Dean and President of FPLC for over 25 years. He died August 1999 in a swimming accident off the coast of France. While at FPLC, Viles helped develop the school's reputation in IP law, an area in which it has been ranked in the top five nationally for the last nine years.

❖

STUDENT LES CHAPTER ANNUAL SYMPOSIUM A SUCCESS

The Law Center's Student Chapter of the Licensing Executives Society (LES) held its 4th Annual "Challenges in Licensing and Intellectual Property Management" Symposium on Saturday, March 25, 2000. The conference, of over 130 participants, was kicked off with an elegant reception on Friday night at the New Hampshire Historical Society. Speakers for the symposium included: Ed Hendrick of Sagebrush Communications; Jeffrey Mobley of the Idaho National Environmental and Engineering Laboratory; Dave Bjornstead of Oak Ridge National Laboratory's Center for Energy and Environmental Analysis; Laurie Hughes with the American Society of Composers, Authors and Publishers (ASCAP); Lance Klass of Porterfield's Fine Art Licensing; and John Erickson of Hewlett Packard Laboratories. The speakers were dynamic and covered a broad variety of topics, and all of them addressed the issue of ethics in the profession. The speakers were very impressed with the student involvement at FPLC. As a career-planning tool, the networking opportunities and insight into dynamic, challenging and rewarding careers for JD graduates as licensing professionals were invaluable. Chairperson Bo Spessard and his committee are to be commended for the outstanding organizing job they did for the event.

❖

FPLC AUTHORS COMPLETE NEW BOOK

Mary Sheffer, Assistant Dean for Career Services and Externship Director, and Sophie Sparrow, Director and Professor of Legal Writing, have completed a new book, **The Lawyer as Supervisor, Manager and Motivator.** The book was published by the National Association for Law Placement (NALP). NALP is composed of Career Services directors from virtually all law schools as well as the Recruiting Directors of most of the major law firms in the country. The authors intend that the book serve as a guide and resource for attorneys who want to become more effective supervisors, managers and motivators. The book includes chapters on key skills and strategies needed by effective managers along with key principals of effective motivation. In addition, the appendices present checklists and sample forms, an article on nonverbal communication, and an extensive list of resources, including on-line resources.

❖

PROFESSOR THOMAS FIELD TAPES COPYRIGHT PROGRAM

Professor Thomas Field recently taped a short program to be televised by the Health and Sciences Network (HTSM), a division of Primedia. Workplace Learning of Carrolton, TX. Entitled "Copyright and the Internet," it is part of the company's *In Focus* series. The program, which is used to introduce primarily nurses to the copyright basics, focuses on the protection of email and web pages. A printout of his web discussion "Copyright on the Internet," was also distributed as a supplement.

See NOTABLES page 14

U.S. News and World Report Ranks FPLC

U.S. News and World Report graduate school rankings placed FPLC among the third tier (up from last year's fourth tier ranking), and rated FPLC third among all law schools for IP. FPLC has consistently placed among the top 5 law schools in the IP specialty area, and has placed number one in 1997, 1998 and 1999. According to Professor William O. Hennessey, Director of Graduate Programs in IP at the Law Center, "A growing number of the country's most distinguished and endowed law schools are focusing heavily on developing their intellectual property programs." The rankings for 174 accredited law schools are based on a weighted average of several factors that include such metrics as reputation, selectivity, placement success, and faculty resources. "For a small independent law school like Franklin Pierce Law Center," continues Hennessey, "the competition from schools such as UC-Berkeley and George Washington University is actually helping us improve the quality of our programs overall." The Law Center's IP program now includes more than 50 courses in IP for students enrolled in the Juris Doctor (JD), Master of Intellectual Property (MIP) and new Master of Laws in Intellectual Property (LLM) degree programs. ◆

Exactly When Does a U.S. Patent Application Become Abandoned?

by Matt McCloskey '01

Joe Hopeful has developed a perpetual motion machine that, apparently, really works. Joe approaches Patent Practitioner with hope of getting a patent on the machine. Notwithstanding the violation of the second law of thermodynamics, Patent Practitioner files an application for the invention, and the 'performance-based' U.S. Patent and Trademark Office (PTO) grants a filing date. Hopeful Joe then approaches Big Corporation with the idea of assigning the rights to the perpetual motion machine to them and thus becoming a millionaire. One of Joe's key bargaining chips is that he has patent "pending" status on his invention. Assuming that the PTO rightly rejects all claims to Joe's invention in the first Office Action, when exactly does Joe's application become abandoned? Should Patent Practitioner inform Joe that Joe can legally say to Big Corporation that the patent application is still pending for six months after the Office Action mailing date? The answer is, of course, no . . . and yes.

The controlling authorities for abandonment for failure to prosecute an application are 35 U.S.C. § 133 and 37 C.F.R. §§ 1.134-1.137. Specifically, § 133, Time for Prosecuting Application, reads:

> Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Director in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Director that such delay was unavoidable.

The test of unavoidable delay is the "reasonably prudent person" test set by the D.C. Circuit in *In re Mattullath* , (38 App. D.C. 497, 514-15 (D.C. Cir. 1912)), as quoted in MPEP § 711.03(c)(2), Unavoidable Delay:

> The word 'unavoidable' . . . is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in their relation to their most important business. It permits them in the exercise of this care to rely upon the ordinary and trustworthy agencies of mail and telegraph, worthy and reliable employees, and such other means and instrumentalities as are usually employed in such important business. If unexpectedly, or through the unforeseen fault or imperfection of these agencies and instrumentalities, there occurs a failure, it may properly be said to be unavoidable, all other conditions of promptness in its rectification being present.

As a matter of procedure, the Commissioner of the PTO has directed the examining corps to shorten all response periods. Thus, the application after the shortened response period "has a unique status: it may or may not have been abandoned . . . depending on later events (the filing of an extension and response)." 4 CHISUM ON PATENTS P.11.03(2)(b)(v) (1996). This potential for conditional abandonment produces the conundrum: when exactly does an application become abandoned?

Resulting from this "elasticity" in the regulations, the abandonment status of an application for failure to respond by a shortened statutory period is conditional on the filing of an extension petition under 37 C.F.R. § 1.136 (along with the appropriate fee) and an appropriate response. In the event that a petition (along with the appropriate fee) and an appropriate response are not timely filed, the application becomes abandoned on midnight of the last day of the shortened statutory period. If this is so, a practitioner might ask, then why does the PTO send a notice of abandonment months after the shortened statutory period has expired? This PTO practice is explained by § 711.04(a) of the MPEP:

> The files of abandoned applications are pulled and forwarded to the Files Repository on a biweekly basis 1 month after the full 6-month statutory period has expired. However, the date of abandonment is after midnight of the date on which the set shortened statutory period, including any extensions under 37 C.F.R. 1.136, expired. Although the abandoned files are not pulled until the maximum permissible period for which an extension of time under 37 C.F.R. 1.136(a) plus one month has expired, the date of the abandonment is after midnight of the date the period for reply actually expired. This date is normally the end of the 3 month shortened statutory period.

Because the abandonment as an operation of law fails to conveniently make itself known to the practitioner, some might construe abandonment to have occurred immediately prior to notice (i.e., agency procedure) received from the PTO. (Interestingly, the one PTO Notice of Abandonment that the author has examined failed to state the date of abandonment; it stated only that the application was abandoned.) This PTO practice is designed this way ostensibly because an application may be revived through an essentially *pro forma* pro-

See PATENT page 13

Matt McCloskey ('01) from Northern CA, has a BS (Agricultural Engineering) from California Polytechnic State University, is a registered patent agent, and plans to practice IP law in New England.

Anything Under the Sun or Anything But the Sun?: Utility Patent Protection for Plants. Expanding *Chakrabarty* Beyond its Limits?

by Jeanne Andrea Di Grazio (LLM '00)

On January 19, 2000, the Court of Appeals for the Federal Circuit held that seeds and seed-grown plants are within the purview of 35 U.S.C. § 101. Thus, an inventor may obtain utility patent protection for seeds and seed-grown plants. (*Pioneer Hi-Bred Int'l, Inc. v. J.E.M. AG Supply, Inc.*, 200 F.3d 1374 (Fed. Cir. 2000)). The Federal Circuit affirmed the trial court decision which had followed the reasoning of the landmark case, *Diamond v. Chakrabarty*, 447 U.S. 303 (1980)(holding that a man-made microorganism invented to degrade multiple components of crude oil was within the scope of utility patent protection). While *Chakrabarty* proved to be both a pioneering and controversial case, *Pioneer* may be following in its footsteps.

The dispute in *Pioneer*, involved a patent infringement of the plaintiff's (Pioneer Inc.) sexually reproducing corn plants. (33 F. Supp. 2d 794 (N.D. Iowa 1999)). Defendants, J.E.M. AG Supply, Inc. (doing business as "Farm Advantage") had been accused of infringing Pioneer's patents by "making, using, and selling, or offering for sale" Pioneer's patents at issue. (*Id.* at 795). Farm Advantage argued that Pioneer's patent was invalid because § 101 did not include within its purview sexually reproducing plants. Instead, the appropriate means of protection for said subject matter could only be the Plant Variety Protection Act of 1970 (hereinafter "PVPA"), 7 U.S.C. § 2321 *et seq.*

However, both the trial court and Federal Circuit disagreed with *Farm Advantage*. Affirming the trial court, the Federal Circuit asserted that there is no legal basis for excluding living matter from the scope of § 101, as *Chakrabarty* held twenty years ago. The Federal Circuit concluded that the PVPA did not remove plants from the utility patent statute, as Farm Advantage had tried to argue. Rather, the court stated that "it is not unusual for more than one statute to apply to a legal or property interest." (200 F.3d 1374 at 1378). Thus, the court resolved the issue of whether sexually reproducing plants fell within 101's broad scope in favor of Pioneer.

The scope of § 101 has become less of a mechanical issue in light of *Chakrabarty*. Prior to *Chakrabarty* courts had been reluctant to expand 101's purview beyond a narrow and well-defined range of subject matters. *See, e.g., Gottschalk v. Benson*, 409 U.S. 63 (1972)(reversing the Court of Customs and Patent Appeals and holding that the conversion from decimals into binary coded decimals was not a process within the meaning of § 101 and thus not patentable); *see also, Parker v. Flook*, 437 U.S. 584 (1978)(holding that a method for calculating an alarm limit was not patentable subject matter because it was akin to attempting to patent a formula). Post *Chakrabarty*, courts have been more lenient in terms of subject matter patentable under § 101. *See, e.g., Diamond v. Diehr*, 450 U.S. 175 (1981)(finding that an application of the Arrhenius equation to calculate the natural log of the cure time for synthetic rubber was patentable subject matter because it involved the application of an algorithm to an output that could be the subject matter of a patent); *AT&T Corp. v. Excel Communications, Inc.*, 172 F.3d 1352 (Fed. Cir. 1999)(holding a method claim valid that used an algorithm to produce a useful result which was that of a primary interexchange carrier indicator).

Thus, § 101's scope is typically not a stumbling block to patentability. In fact, business methods are patentable subject matter within § 101. *See State Street Bank & Trust Co. v. Signature Financial Group, Inc.*, 149 F.3d 1368 (Fed. Cir. 1998). Furthermore, e-commerce business patents can be patentable subject matter as well. In roughly the span of one year, e-commerce filings rose 101% and the number of business methods patents issued is expected to double within the next couple of years.

However, the issue of § 101's scope may not be as clear-cut as the post *Chakrabarty* trend implies. Patents on living matter have always ignited an inferno of controversy that is likely to continue on into the twenty-first century. A case on point is *Moore v. Regents of the University of California*, (793 P.2d 479 (Cal. 1990)(*in banc*)) (Mosk, J., dissenting). In *Moore*, a patient with a rare leukemia had been made an unwitting donor from whom a cell line had been derived using his tis-

See CHAKRABARTY page 15



Jeanne Andrea Di Grazio (LLM '00) received a JD from Widener University School of Law, a BS (Physics and French) from Dickinson College, and an MA (Physics) from Bryn Mawr College. She plans to practice patent, licensing, and antitrust law.

Distinguished Lawyer-In-Residence: J.C. "Koos" Rasser

by Matt McCloskey '01

For those of us still in law school who have not traveled outside of the U.S., the question often arises as to how we can gain an international perspective on intellectual property law. I recently gained some international IP perspective, interviewing an IP attorney with an extensive international background, J.C. ("Koos") Rasser. At the time of our interview, Koos was visiting Franklin Pierce Law Center as the Distinguished Lawyer-in-Residence for the Spring of 2000.

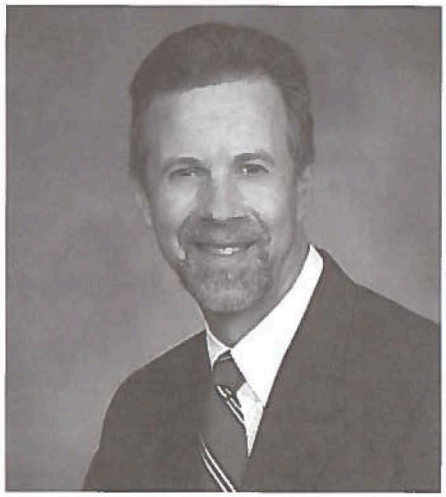
For a bit of background, Koos was born and raised in the Netherlands. After obtaining his PhD in Chemical Engineering from Delft Technical University in 1977, he joined Proctor and Gamble at the company's European Technical Center in Brussels, Belgium, where he worked for three years as a Product and Process Development Engineer. In 1980 Koos transferred to Proctor and Gamble's Patent Division in Cincinnati, and was admitted to practice before the USPTO in 1983. In 1984 he obtained his law degree from Chase College of Law, and was admitted to the Ohio Bar the same year. In 1984, Koos returned to Brussels, eventually becoming Proctor and Gamble's Manager of Patents for Europe in 1986. After returning to Cincinnati in 1990, he was appointed to the position of Chief Patent Counsel in 1992. His current title is Vice President and General Counsel, Patents, Proctor and Gamble Worldwide. Some of Mr. Rasser's outside activities include membership in the National Patent Board (founding member), IPO (member Board of Directors) and the ACPC (member executive committee).

During our interview, Koos described details of European patent law and the European Patent Convention (EPC). Koos also discussed the influential role that U.S. IP law has in Europe, and additionally told me about the increasing role that licensing plays in patent law.

Regarding IP law in Europe, and in particular patent law, change occurs more slowly than in the U.S.. Treaties that govern the member states of the European Community are structured in such a way as to slow any modification of existing statutes. The European Treaties, including the European Patent Convention (EPC), can only be amended by another treaty. Because the EPC is a treaty, it cannot be amended in a substantive way unless all of the member states get a buy-in from their national parliaments.

In addition to the slow response imposed by the structure of the treaties, the uniform interpretation of European IP law is impeded by a history that often saw neighboring members' states at war with each other. Although the member nations of the European Community countries abide by the text of the EPC for their patent statutes, there have been cases where the same patent is held in infringement actions to be invalid in one country and valid in another. This disparity, Koos explained, is due to a long history in Europe of conflict. What would IP law, and law in general be like here in the U.S. if each State had been warring with its neighbor 100 years ago? Would there be disparities in the courts of different States in patent infringement cases? Would a New Hampshire company find its patents *de facto* unenforceable in Maine?

As an example of the slow rate of change in European patent law, Koos pointed out that the U.S. recognizes business method patents almost overnight because of *State Street Bank & Trust, Co. v. Signature Financial Group, Inc.*, 149 F.3d 1368 (Fed.Cir. 1998). This single decision by the Federal Circuit explicitly incorporated into U.S. patent law the business method as patentable subject matter. Japan has quickly followed suit and also has recognized the patentability of business methods. However, the European Community is only now beginning the



debate on this type of patent. The European business community is reluctant to accept the patent protection for business methods. Koos believes the European business community's main argument against business method patents sounds like the same argument propounded here in the U.S a few years ago against software patents, namely that innovation will be stifled. As was the case with software patents, if the business method is trivial, then no one will pay attention to it, be affected by it, or it will be easy to work around the claims.

Koos views *State Street* as standing for, in addition to the acceptance of business method patents, a much broader proposition. The *State Street* holding regarding business methods as subject matter might lead some to overlook the fact that the CAFC, quoting the Supreme Court in *Diamond v. Chakrabarty*, 447 U.S. 303 (1980), considers patentable subject matter in the U.S. to constitute "everything under the sun made by man." (*State Street*, 149 F.3d at 1373 (citing *Diamond v. Chakrabarty*, 447 U.S. at 309)).

We then discussed a hotly debated area of patentability, specifically the patentability of inventions including human

See RASSER page 14

WOOD from page 1

became the school's official painters adorned with bow ties and painted the "barn, harassed future students as they came in for interviews in the early years, and entertained the students who milled about the school. Armed with a paintbrush and sporting their bow ties, Doug attended classes instructed by then-Professor Dick Hesse, Professor Tom Field, Robert Rines and the late Bob Viles. "You couldn't avoid anybody. You got them all no matter what."

Doug thinks Concord, New Hampshire is the ideal place to learn the law. "Despite the cows, Concord, New Hampshire was, and continues to be, a unique and beautiful environment to learn in." With no upper class to guide them, Doug said he and his fellow classmates looked to Professor Joe Dickinson for guidance. Even though Professor Dickinson was not officially a member of Doug's class, "Joe was the unofficial upper class guru." Eventually, FPLC acquired the White Street building and students not only learned the law but continued to hone their painting skills as well, helping Bob Viles paint the new classrooms.

By the time Doug graduated, FPLC was a fully accredited institution. Having the distinguished experience of being a member of the first graduating class, Doug described the communal, close atmosphere at FPLC, one he wishes to preserve.

Doug received his BA in Political Science from the University of Rhode Island. Upon graduation from FPLC, Professor Field and then-Dean Viles encouraged him to attend New York University School of Law where he studied trade regulation and earned a LLM in 1997. He then applied for jobs in New York and landed a plum job with Abeles, Clark & Osterberg, a boutique IP litigation firm. There, Doug worked on litigation defense for record companies and represented record labels for high profile entertainers such as Barbara Streisand, Alabama, and Lynyrd Skynyrd. "Back in those days," Doug explained, "I found myself working in a real entertainment law firm, with all the glitter and famous performers that went along with that kind of practice. It was all very heady." Doug worked as an associate assisting partners, Bob Osterberg and John Clark, from trademark infringement to defending rock stars in property damage suits arising from over zealous partying. Doug recalled fondly one of his most compelling cases for the British comedy group, Monty Python. (*Gilliam v. ABC*, 538 F.2d 14 (S.D.N.Y. 1976)). In that case, Monty Python licensed television broadcasting company ABC to air Monty Python's Flying Circus. When ABC spliced the footage, they cut up the humor, impairing the creative genius of the show. Terry Gilliam led his fellow comedians and sued ABC, arguing for the application of the European theory of *droit morale* or "the moral right" not to ruin the integrity of the underlying work by poor editing. The firm won the case and to this day it is one of the only cases in American jurisprudence that adopted the European concept of moral rights, largely "foreign" to U.S. IP principles. In another case, Doug assisted the partners in the defense of Bootsy Collins and the Rubberband in a trademark infringement case. "Bootsy was doing rap before rap was rap," commented Doug.

But within a year, Doug realized that the glitter world of rock and roll was not his thing. "It was just too difficult representing clients who rarely listened to what you told them to do or who harbored a real hatred for lawyers, particularly if they represented the artists' record labels." So he sent his resume to countless traditional IP firms in New York and in September 1997 landed a job with Hall, Dickler, Lawler, Kent & Howley. In his first few years he continued to be an IP litigator, but became fascinated with the firm's specialty in representing advertising agencies and advertisers. By 1980 he left litigation and switched to the advertising and marketing aspects of the firm's practice, working primarily for Felix Kent. Some of Doug's responsibilities included review and negotiation of production contracts and media purchases, and insuring that the content of an ad was truthful and did not infringe the rights of third parties. Additionally, Doug handled a lot of celebrity talent contracts and endorsements. He is now a named partner and the Executive Partner of the firm (now Hall Dickler Kent Goldstein & Wood LLP). Today, he focuses his practice strictly on advertising and marketing law, both in the U.S. and overseas. He has authored two books on the specialty, written countless columns, lectured throughout the world, and is now working with FPLC Professor Susan Richey on a book about advertising and marketing law for the Practicing Law Institute. In recent years his practice has taken a particular focus on advertising and marketing issues relating to the Internet. In 1998, he founded the Global Advertising Lawyers Alliance, a network of specialists in over 40 countries.

Doug has been a member of the FPLC Board of Directors since 1995. His vision of the Law Center is to expand all curricula and educational programs while at the same time preserving FPLC's unique learning environment as well as its preeminent reputation in IP, both at the JD and LLM levels. Doug said the Board not only wants FPLC to continue to be recognized as a premier IP law school but also as a competitive general legal educational institution committed to innovative programs like the school's clinics, community lawyering, and education law initiatives. "The challenge is to monitor the growth of the institution so that it does not impair its extraordinary learning environment."

He is also a strong believer in having students participate in the operations of the school, citing the fact that recently student luncheons with prospective dean candidates insured that the administration, from the top down, understands the needs of the student body. He was particularly pleased that *U.S. News and World Report* recently elevated FPLC to a third tier law school. Now he's set the Board's target, with the help of the administration, faculty, staff, and students, to break into the second tier. Doug describes the role of the Board of Trustees as a sounding board for the institution, not as an overseer of the school's day-to-day operations.

Doug's affinity for his law school was apparent throughout my conversation with him and inspired me to think of my relationship with Franklin Pierce in terms of life long after graduation rather than only for the duration of my legal education. "Your responsibility to the success of the institution doesn't end when you get your degree. Every graduate has an obligation to see that the inspiration of the school's founder, Bob Rines, and the team he and Bob Viles put together in 1973, remains a central part of the fundamentals of the school." ◆

Suzanne Saunders ('01) from NH has an AA (Chemical Dependency Studies), a BA (Political Science), and an MA (Human Services) all from Keene State College, Keene, NH , and plans to practice public interest law in New England.

Visiting Scholar: Maria Cernobrovciuc

by Terri Zaino '01

Maria Cernobrovciuc came to FPLC as a Visiting Scholar of the Contemporary Issues Fellowship Program of the Bureau of Education and Cultural Affairs of the U.S. Department of State from February to June 2000 to further her research in the field of IP. The Contemporary Issues Fellowship Program is administered by the International Research and Exchange Board (IREX). She is Head of the International Cooperation Department at the State Agency on Industrial Property Protection of the Republic of Moldova (Moldovan Patent Office). The Moldovan Patent Office was established in 1992 and has been growing into a full service IP office since then. Moldova is one of the newest republics in the world, and is situated between Ukraine and Romania and has a population of approximately 4.5 million people.

The objectives of her research at the Law Center were directly related to the strengthening of capabilities of the IP administration in the Republic of Moldova by improving the management procedures, administrative, legal and information services.

Ms. Cernobrovciuc's educational background includes a degree in English from the Pedagogical Institute from Beltsy, Moldova, and an advanced degree in French from Second Courses of Foreign Languages, Kiev, Ukraine. Prior to attending Franklin Pierce, Ms. Cernobrovciuc had completed several other international courses in the field of IP including: Chisinau Patent Courses, Certificate with specialization as Patent Counselor in Industrial Property Protection; Russian Institute of Intellectual Property from Moscow, Diploma with specialization in legal protection and usage of IP; State University of the Republic of Moldova, Student of the Law Department; University Robert Schuman from Strasbourg Intensive Basic Course in Industrial Property in Europe; Queen Mary and Westfield College from London Course "Enforcement of Intellectual Property Rights"; and National Institute of Agricultural Botany, Cambridge, UK Training Program Agricultural Supply Trade Commercialization. Following her attendance at Franklin Pierce she attended the USPTO Visiting Scholar Program 2000 and the WIPO/ USPTO Academy on Enforcement of Intellectual Property Rights in Washington, D.C.

Ms. Cernobrovciuc's professional experience includes: Head (and formerly Deputy Head and Chief Expert) of International Cooperation Department State Agency on Industrial Property Protection of the Republic of Moldova; Chisinau Technical College, Lecturer of the English language; and Kamenka Russian School No.2, Teacher of the English language. Additionally Ms. Cernobrovciuc represented the State Agency on Industrial Property Protection and the Republic of Moldova at different meetings of the WIPO Standing Committees, WTO TRIPS Councils, and have participated in numerous bilateral consultations with foreign partners, prepared various training agendas for seminars in the field of IP protection, as well as other activities related to these issues.

The main objectives of Ms. Cernobrovciuc's requested research and training in the U.S. relating to her thorough studies and analysis of its IP protection system were realized with generous assistance and valuable cooperation of the faculty and staff of Franklin Pierce Law Center. Namely Ms. Cernobrovciuc's wants to thank her research adviser, Professor Chris Blank; Professors Dick Hesse, Tom Field, Bill Murphy and Susan Richey; Professor Bill Hennessey, Director of Graduate Programs; Professor Karl Jorda,



Director of the Germeshausen Center; and Pilar Silva, Foreign Students Adviser. She thanks them and other representatives of the Law Center who offered her the opportunity to attend several IP courses, as well as giving her their ideas and suggestions on solving different issues related to her research proposal, and by making her stay at Franklin Pierce Law Center so productive and pleasant. "I also highly appreciated the kind cooperation of Mrs. Lynne M. Blank, Counselor at Law, and Mr. William A, Grimes, Counselor at Law, BGB Legal Services, PLLC, Patents, Copyright & Trademark who offered me the opportunity to have a real acquaintance with practical issues of patent attorney's practice before the US Patent and Trademark Office. It was really a rewarding experience for me to be here to collaborate with all these extraordinary people."

Ms. Cernobrovciuc continues, "I am sure the realization of the planned objectives and implementation of the research results will lead to the improvement of the IP protection system in the Republic of Moldova, by improving the management procedures, the administrative, legal and information

See CERNOBROVCIUC page 10

Terri Zaino ('01) from Londonderry, NH has a BS (Marine Engineering Systems) from the U.S. Merchant Marine Academy and an ME (Nuclear Engineering) from the University of Virginia. She plans to practice IP law in Boston, MA.

Overview of Intellectual Property Protection in the Republic of Moldova

by Maria Cernobrovciuc

The Republic of Moldova has taken important steps for the protection of IP because the efficiency of the state, economic, and scientific-technical policy is determined to a considerable extent by the acting system of IP protection. It namely influences and represents the source of growth of intellectual potential, development of highly intensive technologies, and prosperity of the country. The adoption of scientific achievements in industry aiming for the improvement of the life standards of the people and the development of the economy and trade are determined to a great extent by the acting system of IP protection. There are two agencies in our country dealing with the IP protection: the State Agency on Industrial Property Protection of the Republic of Moldova (AGEPI), and the State Agency on Copyright and Neighboring Rights.

The State Agency on Industrial Property Protection (AGEPI) is a specialized governmental institution that defines a transparent and efficient policy in industrial property protection catering to domestic and foreign natural and legal persons in equal measure. The AGEPI was established by the Presidential Decree of May 25, 1992 and, at present, is a self-financing office under the government of the Republic of Moldova. Intensification of market reforms, formations of markets, commercialization of services in the field of IP protection, and prevention of import of patentable products stipulated the elaboration of legal state guarantees. These guarantees are required to determine the responsibilities for the infringement of exclusive rights of owners of IP, promote stable functioning of small and medium enterprises, and to curtail information leak of the most valued scientific and technical achievements.

The rights of IP are recognized and protected on the territory of the Republic of Moldova on the basis of the Constitution of the Republic of Moldova and several IP laws. The IP laws include protection of copyrights and neighboring rights, patents for inventions, trademarks and appellations of origin, and protection for industrial designs, new varieties of plants, and of the topographies of integrated circuits. All the laws are harmonized with the requirements of the international agreements in the field of industrial property protection.

Particular importance for the legal protection of IP is also apparent in the Moldavian laws on property, limitation of monopoly activity and development of competition, franchising, foreign investments, as well as the Civil Code, the Administrative Minor Offence Code, the Criminal Code etc. These laws and Codes not only expand the legal actions, but also increase the IP protection level in the Republic of Moldova.

The Government of Moldova has taken important steps for the protection of IP. The country's overall strategy is to make IP protection in the Republic of Moldova consistent with norms established by other countries parties to international treaties. At present, The Republic of Moldova is a State member to 20 international treaties, conventions and agreements in the realm of IP protection. This membership integrates the Republic of Moldova into the world system of IP protection, enhances its own national system of protection, facilitates the harmonization of national legislation with that of other states, entitles it to participate in the works of international meetings, conferences, exhibitions, creating at the same time multiple possibilities for regional and international cooperation in this domain.

Being aligned with the rules of international law standards, the Republic of Moldova has joined the following international conventions, agreements and treaties in the field of intellectual property protection:

- Convention establishing World Intellectual Property Organization (WIPO), 1991
- Paris Convention for the Protection of Industrial Property, 1991
- Patent Cooperation Treaty (PCT), 1991
- Madrid Agreement concerning International Registration of Marks, 1991
- Protocol related to the Madrid Agreement concerning the International Registration of Marks (1989), 1997
- Hague Agreement concerning the International Deposit of Industrial Designs, 1994
- Budapest Treaty on the International Recognition of the Deposit of Microorganisms for the Purposes of Patent Procedure, 1991
- Nairobi Treaty on the Protection of the Olympic Symbol, 1991
- Trademark Law Treaty (TLT), 1996
- Eurasian Patent Convention, 1996
- International Convention for the Protection of New Varieties of Plants, 1998
- Strasbourg Agreement concerning the International Patent Classification, 1998
- Locarno Agreement establishing an International Classification for Industrial Designs, 1997
- Vienna Agreement establishing an International Classification of the Figurative Elements of Marks, 1997
- Nice Agreement on the International Classification of Goods and Services for the Purpose of the Registration of Marks, 1997
-Berne Convention for the Protection of Literary and Artistic Works, 1995
-Rome Convention on the Protection of Rights of Performers, Producers of Phonograms and Broadcasting Organizations, 1995
-WIPO Copyright Treaty (WCT), 1998
-WIPO Performances and Phonograms Treaty , January 1998

See OVERVIEW page 10

OVERVIEW from page 9

The Government of Moldova applied for accession to the General Agreement on Tariffs and Trade in November 1993. There was no activity in this regard, however, until the first meeting of the WTO Accession Working Party in June 1997. From that time on, Moldova's dialogue with its trading partners on the protection of IP has taken place primarily in the context of WTO accession. As part of this process, and in order to provide maximum transparency with regard to its legislation, Moldova has submitted copies of its IPR laws to members of the Working Party. In mid-1999 it also submitted to members of the Working Party a checklist comparing, paragraph by paragraph, TRIPS requirements and its own legislation. The checklist was circulated to members of Moldova's Working Party by the WTO Secretariat (document WT/ACC/MOL/21).

Review of the legal texts and of this checklist by members of the WTO Working Party on the Accession of Moldova (including the U.S.) demonstrated that Moldavian laws had been brought into substantial compliance with TRIPS requirements. The review also identified a few areas in which full conformity had not yet been achieved, and the Moldavian authorities initiated immediately action to bring Moldavian legislation rapidly into full compliance. The Republic of Moldova is thus continuing to respond to international comment on the adequacy of its laws on IP protection. It is committed to ensuring that all of its legislation is fully consistent with TRIPS by the time it accedes to WTO.

The Republic of Moldova is undertaking every possible measure to enforce the rights of the owners of IP rights. All the laws in force on the protection of IP objects have articles stipulating the sanctions for infringement of the rights of IP owners.

The drafts of Civil Code, Criminal Code and Customs Code contain new sanctions for the violation of the rights of IP owners.

In the area of copyrights, there have been few cases brought to court by copyright owners. During 1996-1999 some 40 cases of copyright infringement were put before the courts by the State Agency for Copyrights. Most of them were resolved to the benefit of the rights owner. Cases were brought by foreign publishing houses (i.e. "Terra Fantastica" of Saint Petersburg) and by local authors. Cases have involved illegal use of recordings of performances, illicit use of video tape recordings, and, on numerous occasions, illicit commercialization of audio-visual tapes. Fines have been levied in amounts up to $10,000. In cases in which offenders have repeated the offence, further prosecution has been through the criminal courts. Nonetheless, as mentioned above, it is recognized that stiffer penalties are required, and the new draft Civil Code and draft amendments to the Criminal Code call for larger penalties. The draft Criminal Code will allow imprisonment up to five years for convicted offenders.

Court proceedings have been facilitated by the approval in November 1998 by the Supreme Court of Justice of the Decision "On the Practice of Application by the Courts of Some Provisions of the Legislation on Copyrights and Neighboring Rights".

In the area of industrial property, 154 appeals have been filed with the Commission of Appeal of the State Agency on Industrial Property Protection (AGEPI) since 1994, of which 59 were examined during 1999. Out of the 59 appeals, 20 were satisfied and 34 were rejected. The remaining appeals have been submitted for re-examination. There is no exact information on the cases currently being adjudicated in the courts.

The Government of Moldova believes that, generally, sufficient possibilities for effective enforcement by IP owners of their rights exist in Moldova. It recognizes, however, that further improvement is needed, especially in certain areas. It is fully committed to bringing about those improvements with all possible endeavors.

The system of legal protection of the rights of owners of IP is becoming stronger. The judicial practice shows that the mechanism of examination of patent disputes and appeals filed by applicants, patent owners and third parties is in the stage of formation and the legislation in force often satisfies the requests of owners of titles of protection when speaking about disagreements and guarantees.

At present the Republic of Moldova has a complete and efficient legislative basis which includes necessary rules for according and assuring protection in the field of IP. For more efficient protection, AGEPI has presented to the Government a series of amendments to the Administrative Minor Offence Code, and amendments to the Law on Enterprises and Entrepreneurs, the latter aiming at the exclusion of possible divergences between the owners of firm names and the owners of registered trademarks.

The Government of the Republic of Moldova is undertaking important measures for training in this field the customs officers, representatives of legal authorities, representatives of prosecutor's offices, economic police, courts, etc.

Although, we have made great achievements in improving our IP enforcement, we still have many problems to solve. However, we are confident that we will develop our IP enforcement system and that will have great success through communicating with international experts, accumulating good experience, and establishing sophisticated methods to solve various problems. ◆

CERNOBROVCIUC from page 8

services in the field of IP, and will contribute to the promotion of wider awareness of the role of the IP among the judiciary, academic, industrial and commercial circles within the country and thus will strengthen the country's capacity to mobilize the IP system on behalf of trade and technological development. Although, great achievements were made in the improvement of our IP protection system, still there are many problems that should be solved, and I shall do my best to assist for development and enforcement of IP system. However, I am confident that the cooperation in the field of IP protection between the United States of America and the Republic of Moldova will be enlarged and deepen for the benefit of both countries." ◆

Legal Problems of Museum Administration

by James M. Crowley '01

The American Association of Museums (AAM) is an organization composed of museums from across the country. The primary goal of the AAM is to help the museum community fulfill its responsibilities to a diverse public. The AAM accomplishes this task by providing museums and cultural institutions with current information on areas of critical importance such as tax policy, funding, copyright, cultural property, and education. The association also works with museums to develop and articulate standard policies and practices involved in museum management.

At the end of March, the AAM and the Smithsonian Institution cosponsored a continuing legal education seminar with the American Law Institute-American Bar Association (ALI-ABA). The seminar was held in Boston and was designed to provide people who work closely with museums, including directors, administrators, trustees, lawyers, and staff members, greater understanding of the relevant legal problems. Although discussions of these questions began from a legal perspective, matters of policy were introduced and examined, and common themes emerged. Among the most significant themes were ideas that addressed the museum's place as a social institution.

The moral and social obligations that museums face sometimes conflict with their legal obligations regarding its role as a business entity. Recently, the Museum of Modern Art found itself caught between these two extremes when it held an exhibition featuring the work of German artist Egon Schiele. All the works in the exhibition were on loan from the Leopold Foundation in Vienna, Austria. Near the end of the exhibition, the museum received letters from two families that asserted ownership rights concerning two different paintings on display. Each family claimed the paintings were misappropriated from their relatives in the late 30's by the Nazi Party. The families demanded that the museum immediately return the paintings to the rightful heirs rather than the Leopold Foundation at the end of the exhibit as planned.

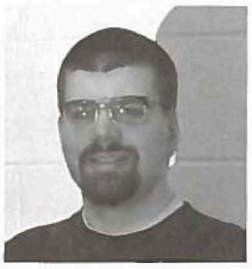
Museums are extremely sympathetic to issues concerning misappropriated art. No museum would knowingly exhibit stolen art. However, in this case, the Museum of Modern Art felt contractually obligated as a borrower to return the paintings to the donor at the close of the exhibit. The museum was clear that its position was in no way a reflection on the merits of the claims asserted by the parties. Instead, its position was motivated by concern over the detrimental effect any return or forced seizure of the paintings could have on subsequent donations from other countries to the museum community. In addition, the museum did not feel that it was the proper forum in which to pass final judgement on the families' factual and legal claims.

Issues concerning artwork misappropriated by the Nazi Party during World War II have received greater attention over the last several years. It has become increasingly clear that each party should address allegations of Nazi looting in a swift and efficient manner. And, although questions of ownership can be complex and emotional, museums can ease this process by investigating the background of works that they plan to exhibit or purchase, as well as by developing a thorough knowledge of their current collections. Many museums are in the process of cataloging and filling in historical gaps for works that date back to the years 1938-1945. To address this problem, the AAM has developed guidelines concerning unlawfully appropriated objects from the Nazi era. These guidelines also urge greater transparency and easier access to information for the public, in addition to increased vigilance on the part of museums. Labeling works with questionable histories and posting current information on the Internet are some ways museums can fulfill their fiduciary duties. The guidelines recommend that if future claims of unlawful appropriation arise, museums should waive certain defenses and push for a more amicable result through arbitration or mediation.

Another area in which museums strive to balance their duties as social institutions with their purpose as business entities concerns the acquisition and display of Native American materials. Many museums want to protect these items for the benefit of society at large. Since many of these pieces were created as items for everyday use and are made of fragile materials; storage and safekeeping in a carefully controlled museum environment may be the only way to ensure these objects survive. However, these items often have strong religious and cultural value to the Native American people.

Many members of these cultures feel that the museum community has not shown enough sensitivity to their beliefs. There are disagreements as to the storage, cleaning and maintenance of these objects. For instance, some items never intended to be shown together during religious ceremonies are inadvertently displayed jointly in museums. Also, some cultures forbid the mixing of male and female objects. These instances bolster the feeling among Native American communities that

See MUSEUM page 14



James M. Crowley ('01) from St. Louis, MO has a BA (Art History) from Drake University. He is interested in practicing copyright, trademark and art law.

IDEA®

The Journal of Law and Technology

CALL FOR PAPERS AND COMMENTS

IDEA: The Journal of Law and Technology welcomes intellectual property related articles and comments that offer novel, timely, practical or controversial viewpoints. Authors in the legal, business, scientific, corporate and technological disciplines are encouraged to submit their intellectual property related articles and comments for possible publication. Preferred topics of interest include domestic and international patent, copyright, trademark, trade secret, unfair competition and other related intellectual property issues.

For general questions of style, follow *The Bluebook: A Uniform System Of Citation* (16th ed. 1996) and *The Chicago Manual Of Style* (14th ed. 1993). Footnotes should include parallel citations to the *United States Patent Quarterly*. Articles are not limited in length. Comments, as opposed to articles, may be informal, without footnotes, and should be less than ten pages. All submissions will be reviewed, and if accepted, will be published as soon as the publication schedule permits.

Please send submissions via e-mail or on a 3-1/2 inch disk in one of the following formats: Microsoft® Word (preferred), WordPerfect®, or Rich Text Format (RTF). Graphics should be submitted in Visio or PowerPoint format. Materials submitted for consideration will not be returned. Please forward your submissions and/or questions to:

IDEA: The Journal of Law and Technology
Franklin Pierce Law Center
2 White Street
Concord, New Hampshire 03301 U.S.A.
e-mail: IDEA@fplc.edu
Tel: (603) 228-1541 ext. 1178
Fax: (603) 224-3342
www.IDEA.fplc.edu

IDEA: The Journal of Law and Technology

SUBSCRIPTION FORM

Subscribers must renew their subscriptions each calendar year. Please inform your subscription agency if applicable.

Please check the type of subscription requested:

- ☐ Domestic $68
- ☐ Foreign $79
- ☐ Domestic Student $25 School: _____ Exp. Grad. Date: _____
  (Proof of current student status required with payment.)

Method of payment:

Check - Enclosed for $_____. (Please make checks payable to Franklin Pierce Law Center - IDEA).

Credit Card - Please charge my credit card in the amount of $_____.

☐ Visa ☐ Master Card ☐ American Express ☐ Other _____

Credit Card # _____ Expiration Date: _____

Signature: _____

Name/Title: _____

Company/Firm: _____

Address: _____

_____

City, State, Zip: _____

Telephone: (_____)_____-_____ Fax: (_____)_____-_____

Please mail or fax a copy of this form to the address listed above.

FROM THE EDITOR

The Fall 1992 issue of this Newsletter carried my initial list of "Credos — Insights — Truisms" on IPRs. Since then this list has been expanded, polished and updated and as such deserves to be republished. It has served me well, in talks and discussions in developing countries, as a vehicle to convey important messages about the nature and importance of IPRs.

CREDOS • INSIGHTS • PREMISES • TRUISMS
about
Intellectual Property Rights and Technology Transfer

- The defense of intellectual property rights today is the new frontier as were the human rights yesterday.
- An effective IP system is indispensable to technological development which leads to economic growth and social welfare.
- An IP system should be part of a country's infrastructure from the outset rather than something that one thinks about after reaching a fairly advanced stage of development (Robert Sherwood).
- There are no viable alternatives to the present patent system which is the only system "that is compatible with the system of market economy" (Professor Carlos Fernandez-Novoa).
- There is solid correlation between the quantity of investments that can be attracted and the quality of the patent system (Professor Mansfield).
- Of the four incentives provided by a patent system, namely, to invent, to disclose, to "invent around" and to invest, the incentive to invest is the most important. (Judge Giles Rich)
- An IP system does benefit nationals, not just foreign corporations; after all there is genius and creativity everywhere but they need nurture.
- A patent and other IP are property and are not and cannot be monopolies (a patent does not take from the public and give to the individual; on the contrary, it takes from the individual and gives to the public).
- "Everything under the sun made by man is patentable" (U.S. Supreme Court in the *Chakrabarty* decision); hence, there should virtually be no exclusions of subject matter from patentability.
- Subject matter that is viewed as too important to be protected (e.g. pharmaceuticals) is, on the contrary, "too important not to be protected" (Professor Thomas Field).
- Some countries have gold, some have oil — and some have technology and those that have gold and oil do not consider them part of the "common heritage of mankind" and accordingly give them away for free (Naboth Mvere, former Controller of IP, Zimbabwe).
- The duration of a patent should be no shorter than 20 years from filing and preferably 25 years or more or provide for patent term restoration to compensate for regulatory and other delays.
- Lead times for commercializing inventions have become longer in all areas and not just the pharmaceutical area and hence conventional periods of three or four years till lapsing or compulsory licensing and short patent terms are badly out of step with present realities.
- Patents and trade secrets are not mutually exclusive but complementary; they "dovetail" (U.S. Supreme Court in the *Bonito Boats* decision); thus, the question is not whether to patent or to padlock but rather what to patent and what to keep a trade secret and whether it is best to patent and to padlock, i.e. expoit the overlap.
- "Trade secret law and patent law have coexisted in this country for over one hundred years..... the extension of trade secret protection (even) to clearly patentable inventions does not conflict with the patent policy of disclosure." (U.S. Supreme Court in the *Kewanee Oil* decision).
- Multiple forms of protection can and should be utilized and integrated by exploiting the overlap between the various IP categories, especially in modern fields of technology; this provides fall-back positions, achieves synergistic effects and thus optimizes exclusivity (Professor Jay Dratler).
- Technology transfers, licensing and investments are ever so much easier to carry out and accomplish via patents and other IPRs as vehicles or bases.
- Importation of technology leads not only to export of products but also to export of adapted, improved technology (reverse technology transfer).
- The days when technology transferors took advantage of transferees (in developing countries) are gone, the realization having taken hold that the only viable license is one that results from a win/win approach and passes the fairness test.◆

Karl F. Jorda
David Rines Professor of IP Law and Industrial Innovation
Director, Kenneth J. Germeshausen Center for the
Law of Innovation and Entrepreneurship

PATENT from page 4

cess; the PTO postpones the notification of abandonment until there is no longer a pro forma way to revive the application. As explained by the Court of Claims and Customs Appeals (CCPA), "Abandonment takes place by operation of law for failure to reply to an Office Action or timely pay the issue fee, not by operation of the mailing of a Notice of Abandonment." *(Lorenz v. Finkel*, 333 F.2d 885, 889-90, 142 USPQ 26, 29-30 (CCPA 1964)).

In conclusion, failure to respond to an Office Action within a set shortened statutory period results in abandonment of the application, unless a petition (with fee) under 37 C.F.R. § 136(a) and an appropriate response under 37 C.F.R. § 135 are filed. The abandonment occurs at midnight of the last day of the shortened statutory period. However, the abandonment status can be vacated by means of the extension under 37 C.F.R. § 136(a) up to the six-month maximum period allowed by 35 U.S.C. § 133. ◆

MUSEUM from page 11

museums are not the proper places to house these articles.

The Native American Grave Protection and Repatriation Act (NAGPRA) allows Native American tribes to request the return of certain types of cultural property from third parties. These items must meet the statutorily defined requirements of "sacred object" and "objects of culture patrimony" set forth in the act. In addition, NAGPRA is only available to federally recognized Native American tribes. Despite these limitations, the reach of NAGPRA is still broad enough to be an area of concern for any institution that displays Native American objects. As in the area of unlawfully appropriated Nazi loot, the AAM urges any disputes between museums and members of the Native American community to be addressed in a direct and amicable manner. Museums should strive to set up informal arrangements that would resolve any conflicts, rather than risk giving up their collections.

The acquisition of other archeological antiquities is also the subject of evolving ethical and business standards. Many countries protect their cultural property by enacting restrictions on the exportation of this type of property from their borders. The AAM believes that the museum community should not take part in any practice that encourages any illicit trade or traffic of archeological materials, and has developed a Code of Ethics for Museums setting forth principles that apply in this area. Acquisition of these materials for a museum's collection creates a presumption of rightful ownership, care and documentation of behalf of the museum under the Code of Ethics. Any competing claims of ownership are to be handled openly and respectfully. All museums supplement these minimum requirements by developing individual policies in this area including diligent investigation and documentation.

It was stressed at the seminar that museums have the key role in maintaining the integrity and philosophy of their missions. The movement toward greater transparency and accountability regarding current policies and practices reinforces museums' credibility and their standing in society as a whole. Whether large or small, these areas concern all museums. Therefore, the burdens of care and diligence are shared equally among all institutions. Through seminars such as this one, the American Association of Museums helps those associated with museums to meet the challenges and opportunities they face now and in the future. ◆

NOTABLES from page 3



A delegation of managers (pictured above with Professor Jorda) from SINOPEC (China Petro-Chemical Corporation) of Beijing, China visited the Law Center Spring '00 for a series of lectures by Professors Karl Jorda and William Murphy on corporate IP management. Another similar delegation is coming to FPLC in Spring '01.

RASSER from page 6

genes. Koos believes that denying patentability is not the answer to any moral questions raised by these types of genetic inventions. The proper means would be for Congress or the legislative bodies of respective countries to pass laws stating how these new inventions should be used. Human insulin made by bacteria is tremendously beneficial yet it would be proscribed under a patent regime banning any type of human genetic makeup.

We finished our conversation by Koos describing his work at Proctor and Gamble. Koos explained that licensing of technology has recently been added to the traditional pursuits of innovation and producing superior products for the customer. Until relatively recently, Proctor and Gamble did not license its technologies except in advantageous cross-licensing situations that were the only means of accessing the desirable technologies of other companies. Now, however, in a move to aggressively encourage continuous product improvement, the CEO of Proctor and Gamble has directed the company to license its patents either five years from date of patent issue or three years from date the product is launched under that patent, whichever is earliest. In this way, Proctor and Gamble will be forced by competition to constantly improve and optimize the product lines. As a result, the Proctor and Gamble patent department is now heavily involved with licensing the company's patents. Koos recommends that because of this trend of increased licensing, law students should study licensing in law school. ◆

Editor's Note: This summer, Koos Rasser joined the law firm of Howrey Simon Arnold and White (Washington D.C.). In early 2001 he will be opening the firm's office in London.

Edythe Bowlby
A Mother to the Nations

by Timothy Moalusi (MIP '00) and Keitseng Monyatsi (MIP '00)

Our coming to the U.S. was filled with both excitement and anxiety. We were excited because we were coming to gain new knowledge to develop ourselves. The anxiety was due to the fact that we were in a foreign land with a different environment and culture. The first week was a hectic one as we searched for apartments, and also homesickness started to creep in. However, one Saturday afternoon while walking from the Law Center, we met this lady who greeted us with a great smile and introduced herself to us as Mrs. Edythe Bowlby. She went on to invite us to her house. We accepted the invitation with reluctance, and little did we know that this was going to be the beginning of the greatest friendship we had in Concord.

Throughout our stay in Concord, NH, Mrs. Bowlby became like a mother to us. She became supportive to us in so many ways. She helped us to know and understand so many things about the American culture, and especially life in Concord. This greatly helped us to easily integrate to life in Concord. Whenever we needed to go shopping or do any other things that required us to be out of Concord, Mrs. Bowlby always offered to drive us. She indeed made our stay enjoyable by taking us to places of interest like the beaches in Maine, the Concord Dam, and many surrounding towns of Concord.

It can truly be said that our stay in Concord was never the same after meeting Mrs. Bowlby. She provided the love, warmth, and support that a true mother gives to her children. We will greatly miss her. ◆



Timothy Moalusi (MIP '00) and Keitseng Monyatsi (MIP '00) are both citizens of Botswana and both received a BA (Commerce) from the University of Botswana. They are Assistant Registration Officers in the Republic of Botswana's Industrial Property Section of the Registrar of Companies.

CHAKRABARTY from page 5

sue and blood samples. The patient's physician and research assistant had obtained a patent on the cell line that ultimately proved to be very lucrative. The patient sued his physician for breach of fiduciary duty, lack of informed consent, and conversion. The patient lost on the conversion claim. Justice Mosk dissented from the majority on two major points, sounding his concern about granting property rights in living matter. Justice Mosk stated that "every individual has a legally protectible property interest in his own body and its products" and commented further that "our society acknowledges a profound ethical imperative to respect the human body as the physical and temporal expression of the unique human persona." (793 P.2d at 515. (Mosk, J., dissenting)).

While *Moore* was not entirely about patents, the dissenting opinion reflects one prevailing angst over granting patents involving living subject matter. These concerns will continue to exist as we proceed further along with biotechnology and even with respect to patents involving plant life. Some even question whether *Pioneer* extended *Chakrabarty* beyond its limits. *Chakrabarty* concerned a product of human ingenuity, a man-made microorganism that did not exist naturally but instead that had to be manipulated through human intervention. Some argue that granting utility patent protection to plants could run dangerously close to the prohibition of patenting natural phenomena. Thus, the issues raised by the grant of utility patent protection to plants are numerous and controversial.

In dealing with controversial patent issues, one needs to consider the purpose behind the patent laws, the constitutional purpose being that of promoting the sciences and the useful arts. The patent laws exist in large part to encourage inventors to come forward with their inventions with the ultimate objective of enriching the public domain when the patent expires. The patent laws promote a robust public domain so that other useful arts may be generated for the further benefit of the public. As the Federal Circuit observed in *Pioneer*, there can exist multiple forms of intellectual property protection for the same subject matter because the various intellectual property laws serve different ends.

The debates and the controversies will inevitably continue. However, if we wish to harvest the benefits of a rich and thriving public domain and promote the progress of the sciences and the useful arts, we must be willing to sow seeds of controversy. ◆

CALENDAR

BASIC PCT SEMINAR
April, 2001

EIGHTH IP SYSTEM MAJOR PROBLEMS CONFERENCE
Spring, 2001

MEDIATION SKILLS FOR IP & COMMERCIAL DISPUTES
May 21-25, 2001

TENTH ANNUAL ADVANCED LICENSING INSTITUTE
July 16-20, 2001

For more information visit our web site at: www.fplc.edu
All events held at Franklin Pierce Law Center, in Concord, NH



Franklin Pierce Law Center
2 White Street
Concord, New Hampshire
03301 USA

Non-Profit Org.
U.S. POSTAGE
PAID
PERMIT No. 749
Concord, NH
03301