FRANKLIN PIERCE LAW CENTER
GERMESHAUSEN CENTER NEWSLETTER • *Winter 2003*

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PIERCE LAW REDESIGNS GRADUATE IP LAW DEGREE PROGRAMS

PIERCE LAW recently announced significant changes in its graduate IP law degree programs. The masters level programs in IP law have been expanded to include additional courses in commerce and technology.

"We will now offer two areas of concentration, Intellectual Property or Commerce and Technology," says Vice Dean Keith Harrison. "Both tracks, however, will have a great deal of overlapping coursework."

"These curriculum changes will also affect the program titles," according to Harrison. "Effective January 1, 2003, Pierce Law's Master of Intellectual Property degree program (MIP) will be entitled a Master of Intellectual Property, Commerce and Technology, and the Master of Laws in Intellectual Property degree program (LLM) will be entitled a Master of Laws in Intellectual Property, Commerce and Technology," explains Harrison.

"These two names more fully describe the wide array of coursework that our graduates pursue to earn this degree," says Harrison.

"Pierce Law has long been recognized as the academic leader in the area of intellectual property," explains Harrison. "Our educational programs have kept pace with the changing world of commerce and technology as they relate to intellectual property."

PORTRAIT: PROFESSOR DAVID PLANT

BY TROY WATTS (JD '03)

"I BELIEVE that one of the virtues of mediation is that neither party has to walk away thinking it gave up anything. Win/win is the virtue of mediation, not win/lose or lose/lose, which is often the result of litigation. The parties, if they are permitted to build their own solution, should each walk away thinking, 'I gained.' That is the virtue of mediation." *David Plant, speaking during the March 29, 1996 Conference on Mediation in Geneva, Switzerland.*

David Plant is "retired." Wiling away the hours of each day, he divides his ample time between his twin passions of deep-sea fishing and golf, with extended forays into international travel. With a full career and numerous accomplishments behind him, Mr. Plant is finally, and deservedly, winding down. *Right.*



PROFESSOR DAVID PLANT

Upon meeting Mr. Plant, one *is* hard-pressed to find that they aren't in the presence of a contentedly retired gentleman-lawyer. However, even a cursory review of Mr. Plant's recent travails (to say nothing of those past), belie the meaning of retirement, were he golfing, he'd be on the PGA tour, and if fishing, whales would be his quarry. The international travel, however, is a

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PIERCE LAW
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IP FACULTY ACTIVITIES

Research Professor **Nermien Al-Ali** presented a lecture at a professional development meeting of the Boston chapter of the Special Libraries Association in Boston on October 28. She outlined and explained knowledge management as it pertains to ideas, innovation process, research, and IP rights of an organization. A new book written by Professor Al-Ali, entitled *Comprehensive Intellectual Capital Management*, was recently published by John Wiley & Sons (ISBN 0-471-27506-9). For more information, visit her website at: www.ipmall.info/hosted_resources/al-ali/home.htm. for more information about the publication. "This book speaks to every person in the ICM (intellectual capital management) chain, the inventor, market manager, patent attorney, finance manger, IA manger, research manager, business manager, production manager…" She teaches a course on ICM as a business management approach for the management of human capital, knowledge and IP in the new economy. It is the first course of its kind to be offered at a U.S. law school.

Professor **Bill Hennessey** presented a paper on "Patent Protection for Computer Software" at the October 7 annual meeting of the International Association for the Advancement of Teaching and Research in IP in New Delhi, India. He later joined a delegation from the USPTO and US Department of Justice in Chengdu and Wuhan, China, where he spoke to Chinese judges and government officials on "Civil Remedies for Infringement of Copyright and Trademark in the U.S." Professor **Hennessey** also participated in a symposium on "IP Protection for Agricultural Biotechnology" at the World Bank-funded Yangling Agricultural Research Park in Shaanxi, China on November 3-4. He gave lectures at seminars sponsored by the United Nations Development Program in Wenzhou and Guangzhou, China for Chinese brand owners. He also lectured on "Current Trends in Brand Management" and "Trademark Enforcement."

A new coursebook, entitled *International and Comparative Patent Law*, written by **Hennessey** in collaboration with Graeme B. Dinwoodie and Shira Perlmutter and published by Matthew Bender (ISBN 0-8205-5468-5) is now available. The authors hope it will enable instructors to provide, and students to enjoy, an even more detailed analysis of the patent and trade secret issues with which we must now contend in a global environment.

In the IP arena, Pierce Law welcomes Visiting Professor **Karen Hersey**, a former senior counsel for IP at MIT where she represented MIT's interests on IP matters with U.S. government agencies and advised MIT on appropriate positions for non-profit organizations with respect to various tax-related and regulatory matters. She publishes widely in the area of IP law as it impacts institutions of higher education. Professor Hersey is a past president of the Association of University Technology managers (AUTM). Professor Hersey offers courses at Pierce Law dealing with technology transfer for non-profit organizations and IP management in universities.

Professor **Karl Jorda** gave a talk on "IP Valuation and Technology Transfer" at the 2002 Seoul International IP Conference of the Korean LES and AIPPI associations in Seoul, Korea on October 12-14. **Jorda** also spoke on "Harmonization of the International Patent System," at a symposium on "Patent Law, Social Policy and Public Interest: The Search for a Balanced Global System," held on November 7 at the Cardozo School of Law in New York. **Jorda** was recently reappointed for a third two-year term as the American member to the 20-member Confidentiality Commission of the Organization for the Prohibition of Chemical Weapons (OPCW), headquartered in The Hague. Professor **Jorda** was recently elected a life member of the New York Intellectual Property Law Association (NYIPLA). Life members are those of long standing who have achieved distinction by reason of professional service.

Adjunct Professor **Glen Secor** presented two papers entitled "The Good, the Bad, and the Ugly: Evaluating the Digital Millennium Copyright Act Four Years Out" and "Can the Fair Use of Digital Works Be Automated?" at the 3rd International Law and Technology Conference of the International Association of Science and Technology for Development (ISTED) held November 6-8 in Cambridge, MA. The conference was an international forum for lawyers, computer scientists, and engineers interested in understanding the latest developments and implications of technology in the field of law.

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Created in 1985 through the generosity of Kenneth J. and Pauline Germeshausen, the Germeshausen Center is the umbrella organization for Pierce Law 's specialization and policy studies in the legal protection, management, and transfer of intellectual property, especially relating to the commercialization of technology. The Germeshausen Center Newsletter is published three times a year for alumni/ae, students and friends of Pierce Law.

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NOTABLE HAPPENINGS...

ANOTHER SUCCESSFUL SIPLA SYMPOSIUM

The Student Intellectual Property Law Association (SIPLA) held its Second Annual Intellectual Property Symposium at Pierce Law on November 2, 2002. The symposium was sponsored by SIPLA to promote an open dialogue of current issues in IP and how these issues will affect the practice of IP in the future.

Ms. Janda Carter, patent prosecutor from Frost Brown Todd, LLC, Cincinnati, OH, presented a talk on "New Trends in Patent Prosecution." The scope of her presentation was the nature of lexicography in patent prosecution. Bob Abrahamsen, (JD '97), Wolf, Greenfield & Sack, Boston, MA, spoke about "Managing Patent Litigation for Success." Pierce Law Adjunct Professor Glen Secor, presented a paper on "Digital Rights Management and Fair Use." The final speaker of the day was Eric Eldred, the named party in the recent U.S. Supreme Court case of *Eldred v. Ashcroft*. Mr. Eldred presented an overview of the arguments that his legal team presented before the Supreme Court on October 9, 2002. His case concerned the constitutionality of the 1998 Sonny Bono Copyright Term Extension Act. An opinion from the Supreme Court is expected sometime in early 2003.

CHINESE SIPO DELEGATION VISITS PIERCE LAW IP LIBRARY

A delegation from the State Intellectual Property Office of the Peoples Republic of China (SIPO) and local patent administrators visited the Pierce Law IP Library on November 4, 2002 while touring the U.S. for two weeks to gather data on patent information. The visits by the group included law firms, enterprises, law schools, and Patent, Trademark Depository Libraries. The tour began in New York and ended in Los Angeles.

IP Librarian Professor Jon Cavicchi spoke about IP education at Pierce Law, the IP Library and patent searching based on his Mining Patent Information in the New Millennium course. The group was favorably impressed. The group agreed with Professor Cavicchi that patent searching has grown to include intellectual asset management and that opportunities for software solutions to be used with corporations are needed. The group was escorted and translation assistance was provided by three Pierce Law students: Jinsheng Mao, Peng Zhang and Xuefei Zhang.

Vice Dean Keith Harrison and the delegation exchanged gifts and thanks. This was a successful exchange as yet another part of our relationships with China. The Pierce-Tsinghua China Intellectual Property Summer Institute (CHIPSI) is the first program offering ABA-accredited courses in IP law in China. The first annual CHIPSI program was held in June and July, 2002 at the School of Law, Tsinghua University, in Beijing and at Jiaotong University in Xi'an, China. Students enrolled in up to 6 credits of coursework in International Intellectual Property Law, Intellectual Property Law of China, Chinese Legal System, and IP in Mergers and Acquisitions. The five-week program includes trips to courts, government intellectual property agencies, and cultural excursions.

The Delegation included:

Mr. Zhang Xiyi, Director General of Planning and Development Department of SIPO

Mr. Liu Zhong Xiang, Senior Official of Planning and Development Department

Mr. Zhang Haiyang, Program Administrator of International Cooperation Department

Mr. Song Peixian, Director General of IP Office of Shanxi Province

Mr. Liao Bin, Director General of IP Office of Ningxia Autonomous Region

Mr. Zhang Qinghua, Director of IP Office of Henan Province

Ms. Zhang Songru, Deputy Director of IP Office of Guangdong Province

Mr. Wei Zhengchuan, Senior Official of IP Office of Zhejiang Province

Ms. Wang Shurong, Senior Official of IP Office of Inner Mongolia Autonomous Region



CHINESE DELEGATION - PICTURED HERE WITH PIERCE LAW FOREIGN STUDENT ADVISOR PILAR SILVA (FRONT ROW), VICE DEAN KEITH HARRISON AND IP LIBRARIAN JON CAVICCHI (BACK ROW)

IP MALL—WHAT'S NEW

- Pierce Law's IP Mall (www.IPMall.info) will act as the host site for the IP Section of the New Hampshire Bar Association. The site serves New Hampshire attorneys and law firms, as well as Pierce Law faculty and alumni.

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THE IP AUDIT

BY NANCY B. DELAIN (JD '03)

INTELLECTUAL ASSETS

IN 2001, the stocks of many technology companies that do their primary business on the internet (dot-coms) crashed. Dot-coms went bankrupt in droves, and investors lost a lot of money. As a result, investment dollars are now harder for small companies to attract. We now live in an economy based not on agrarian activities or industrial strength but on knowledge. The knowledge economy demands that companies manage the knowledge contained within their purviews. The knowledge—the collective intellectual understanding of everyone who works for the company—contained within a company is its intellectual capital. Intellectual capital makes up approximately 80% of the value of the S&P Fortune 500 companies. Nermien Al-Ali, *Comprehensive Intellectual Capital Management*, John Wiley & Sons, ISBN 0-471-27506-9, quoting Karl Erik Sveiby, *The New Organizational Wealth: Managing and Measuring Intangible Resources*, Berrett-Koehler Publishers, 1997, pp. 6-7. However, the accounting books of these companies do not reflect these assets; they are "hidden resources." *Id.* "Book values of publicly traded companies mainly reflect the value of tangible and capital assets of the company.... This is hardly an accurate reflection of the intangible assets as [good will] is created to balance the books following an acquisition. The market value of a company reflects the value of a hidden resource that is recognized and valued by the market...." *Id.* If a company fails to account for 80% of its assets on its ledger books, that company cannot provide an accurate value for possible investors or partners. Therefore, a company must account for those intangible assets that do not appear on the ledger books. It does so through an IP audit.

THE IP AUDIT

One traditional definition of an IP audit is "a cataloging of a company's IP assets." Ron Corbett, Symposium: Exploring Emerging Issues: New Intellectual Property, Information Technology, And Security In Borderlesss Commerce: IP Strategies For Start-up Ecommerce Companies In The Post-dot-bomb Era, 8 Tex. Wesleyan L. Rev. 643, 645 (2002). Such a cataloguing is necessary for a company to meet its due-diligence requirements for mergers, acquisitions, or other transfers. Today, an IP audit is seen not only as a balance sheet for intangible assets but also, more importantly, as a self-evaluation in which a company constantly and consistently engages to determine the value of its own assets, determine how to best capitalize on those assets, and to keep abreast of the changing values of its assets in the face of the ever-changing economic and legal ecosphere.

Each IP audit should focus on four key areas. First, the auditor needs to identify all the IP assets within the company being audited. Second, the auditor must identify any problems that exist with the IP ownership. Third, the auditor must identify any defects in title or enforceability of the company's IP. Finally, the auditor must identify any unprotected IP assets.

In identifying all of the IP assets of a company, an auditor focuses on "...identifying the IP subject matter, how it works, and how it is manifested in the company." Corbett at 652. Different types of companies stress different types of IP, depending on the company's purpose. An artistically based company will have copyright protection that should be in place, but may have very few, if any, patentable inventions or trade secrets. A technology-based or manufacturing company, on the other hand, will probably rely heavily on patent and trade secret protection and less on copyright protection. All companies are likely to have logos and other trademark items.

In identifying problems that exist with IP ownership, the auditor attempts to trace the chain of ownership of IP back to its creation by one of the company's employees. The auditor also looks for assignment agreements from employees, former employees, contractors, and others who may have rights in the IP if not assigned. This is true in patents, where, in the U.S., the inventor owns all rights to "... exclude others [including the company if the patent is not specifically assigned to the company] from making, using, offering for sale, or selling the invention throughout the United States or importing the invention into the United States, and, if the invention is a process, of the right to exclude others from using, offering for sale or selling throughout the United States, or importing into the United States, products made by that process, referring to the specification for the particulars thereof." 35 U.S.C.A. 154. It is also true in copyrights, where independent contractors and consultants retain copyright to materials fixed in a tangible medium unless otherwise agreed. Also, new hires can present a problem with IP ownership if they are in violation of previous employers' noncompete/nondisclosure contracts if they assign to the company the rights to any new inventions. Hence, the IP auditor must investigate the employees' prior noncompete/nondisclosure agreements.

Often, copyright and trademark protection may be based only on common law because the owner fails to register the IP with the appropriate agency. Or, an inventor may invoke a statutory bar of the patent law inadvertently and render his invention unpatentable. This can cause problems down the road for the company when it tries to enforce its IP rights. Ultimately, lack of registration can lessen the value of the IP itself. The auditor must identify any of these problems and bring them to the company's attention. The company then may wish to remedy a problem if it can. The auditor should also identify any issues with recording of licensing or change in ownership of IP. A company's failure to record such changes can result in a second licensee taking priority over the company

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- Decisions of the Commissioner of the U.S. Patent & Trademark Office—Web exclusive
- Weekly Compilation of Presidential Documents is a compilation of presidential documents which contain IP keywords 1995-2002
- The Field Patents: Before helping launch Pierce Law in 1973, Professor Tom Field examined patents (alkene polymers). He handled a caseload of approximately 300 applications. The Mall offers 25 sample patents issued by Professor Field. For more detail on the life and times of Professor Field go to http://www.piercelaw.edu/tfield/TGF.htm.
- Adjunct Professor Bryan Harris of European Union Law has published two books on Pierce Law's IP Mall: *Constitutional Law of the European Union* at http://www.ipmall.info/hosted_resources/harris_conlaw.asm and *Intellectual Property Law in the European Union* at http://www.ipmall.info/hosted_resources/harris_iplaw.asm.

TRADEMARK CONFERENCE

On October 4, Commissioner for Trademarks Anne H. Chasser of the U.S. Patent & Trademark Office (USPTO) was the key speaker at a half-day conference entitled "Electronic Trademark Registration Practice: What Every Trademark Lawyer Needs to Know." She talked about the e-government initiatives planed or currently underway at the USPTO. In addition, USPTO TEAS Project Manager Craig K. Morris presented a live Internet presentation on the USPTO's award-winning Web facilities. Michael A. Albert, Partner, and Carole A. Boelitz, Associate of Wolf, Greenfield & Sacks, Boston, addressed some of the many issues raised by electronic trademark practice.

GUEST LECTURER

R.K. Gupta, Head of the Intellectual Property Management Division of the Council of Scientific and Industrial Research (CSIR) of

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A LANDMARK PATENT LAW DECISION

BY TAHIRA JAYASURIYA (JD '03)

THE U.S. SUPREME COURT handed down a landmark patent law decision in May 2002. In *Festo Corporation v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd., et al.*, the Court, in a unanimous decision, vacated and remanded a Federal Circuit Court of Appeals decision and affirmed the place of the doctrine of equivalents (DOE) in patent law, possibly broadening the scope of protection afforded to some patentees.

The DOE allows a patentee to claim small or trivial alterations to a disclosed invention that were not captured in an original patent but that are still within the scope of the claims. However, prosecution history estoppel arises when claims are narrowed during patent prosecution in order to obtain a patent and, accordingly, surrendered subject matter may not be recaptured even if it is equivalent to matter expressly claimed.

The Federal Circuit had previously held in *Festo Corporation. v. Shoketsu Kinzoku Kogyo Kabushiki Co. Ltd.* that a patentee's infringement action under the DOE is barred for *all* elements in a claim that had been limited during prosecution *regardless* of the reason for the narrowing amendment. Under the ruling, a patentee was estopped from bringing an infringement action under the DOE no matter how closely related an element of a competing patent might be to the patentee's narrowed claims.

The lower court ruling apparently sought to support the policy that the public must have adequate notice of subject matter protected by patents in "full, clear, concise and exact terms" consistent with the requirements of the patent statute.

Several prominent cases addressing the DOE and the role of prosecution history estoppel provide insight into the background and significance of the Supreme Court's *Festo* ruling.

In *Graver Tank & Mfg. Co. v. Linde Air Products,* the Supreme Court held that despite lack of literal infringement, interchanging manganese for magnesium in a flux constituted infringement under the DOE where manganese and magnesium were known in the art to be interchangeable. Under this ruling, a patentee was able to invoke the DOE to proceed against the producer of a different device if that device performed substantially the same function in substantially the same way in order to obtain the same result as patentee's device.

In *Pennwalt Corp. v. Durand-Wayland, Inc.,* the Federal Circuit established the all-elements rule whereby every element must exist literally or equivalently to sustain an infringement claim under the DOE—there is no consideration for the invention as a whole in determining equivalence. Accordingly, in this case the defendant's fruit-sorter was found not to infringe either literally or equivalently on the plaintiff's claimed fruit-sorters, where the defendant's devices were operationally the same but the internal functions were found to be substantially different.

Additionally, in *Warner-Jenkinson Co. v. Hilton Davis Chemical Co.*, the Supreme Court ruled that to determine whether estoppel or the DOE is applicable, a court must look at limitations made during prosecution on an element-by-element basis to determine the scope of the claimed subject matter. In *Warner-Jenkinson,* the patentee's protected invention provided for a pH lower limit of 6.0 and the alleged infringer's invention provided for a pH lower limit of 5.0. In ruling against the patentee, the Supreme Court indicated its concern that competitors have notice of the scope of subject matter protected by patents.

In the recent *Festo* ruling, the Supreme Court held that while prosecution history estoppel does apply to subject matter surrendered during prosecution—that is, subject matter narrowed for patentability reasons and for amendments that affect the scope of the patent—it is not a *per se* bar to a claim under the DOE. Estoppel must be analyzed on an element-by-element basis to determine what territory the applicant actually surrendered and why. The Supreme Court's *Festo* decision clarifies the scope of the doctrine of equivalents and of a patent owner's rights.



Tahira Jayasuriya (JD '03) received her BA in Biology from Beaver College. Tahira is a registered patent agent and plans to practice patent law in the New England or Midwest region.

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as first licensee if the company fails to provide notice via registration. In patents, this notice has a 90-day lookback period. Proper registration also ensures that full remedies are available in the event of infringment by another. Failure to properly register and police IP may result in the complete loss of IP rights.

An auditor should identify those IP assets which are entitled to more protection than the asset currently has. In some cases, such as in patents, key protection can be lost forever if the company postpones the decision to pursue the registration for too long. This is often a problem in that the invention, while it could be perfectly patentable, has hit the statutory bar in the patent law because the inventor disclosed or used the invention in public more than one year before the company applied for the patent. Or, an inventor may regard her invention as perfectly obvious when it is actually patentable. The auditor can also identify valuable trade secrets that the company should protect more carefully than it does.

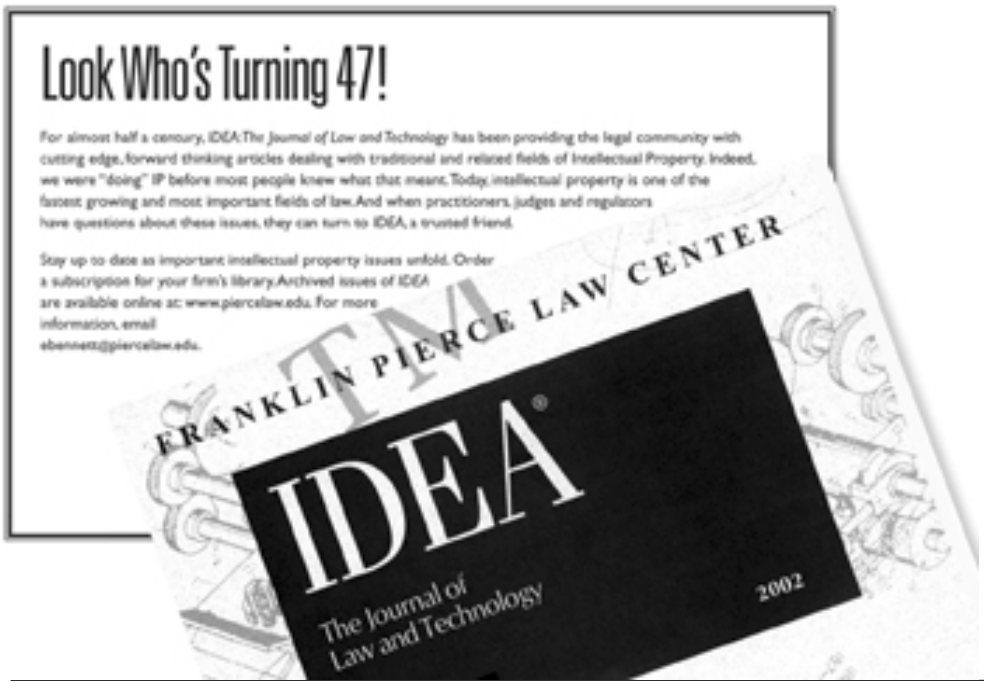
To perform the audit, the auditor should first notify everyone who may be involved that the audit is about to take place. She then interviews the technical, legal, managerial, and human resources people to collect information on "...licenses, research and development reports, employee and contractor confidentiality and assignment agreements, and employee invention disclosure statements." Corbett at 656. She then documents the status of copyrights, patents and trademarks.

The auditor develops an IP database which contains, at a minimum, "...owner of the IP asset, class of asset, the inventors or authors, when the asset was created or acquired, the asset's status (e.g., pending or issued patent, registered copyright, trademarks, domain names), on-going maintenance issues (e.g., payment of maintenance fees for patents, collection or payment of licensing fees), and the expiration or renewal date of the asset." Corbett at 656-657. This database enables the company to determine exactly what its IP assets are and also to determine the status of each asset.

After the database has been developed, the auditor and a committee within the company analyze the IP and determine what action to take as to each piece of IP. The committee and the auditor also identify mechanisms that the company should use to identify and protect each new piece of IP that the company develops or otherwise acquires.

Hiring and exit agreements are a key piece of IP management. The auditor should determine whether the company's noncompete/nondisclosure agreements are signed by all new hires, contractors and others who come into possession of sensitive company IP information. She and the committee also needs to determine whether those agreements are sufficient to meet the company's goals. Exit agreements need to stress the importance of obligations not to disclose trade secrets to future employers or directly compete against the company. Upper-level management also needs to examine the results of the IP audit to determine whether and how each piece of IP fits into the current company goals.

The IP audit is a necessary and important management tool in today's knowledge economy. Indeed, it is the only way to assess the true value of a company, and it is the only way for a company to maintain and grow its intangible assets. Gone are the days when the corporation was valued at the price of its real and personal property. Today, managers and investors need to have a good understanding of the intangible side of the business as well as the tangible side. The IP audit is the way for them to get a grip on reality. ■





Nancy B. Delain (JD '03) is from New York. She has an AB in Biological Sciences from Smith College and an MS in Technical Writing from Renselaer Polytechnic Institute and plans to practice IP law upon graduation.

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India, discussed with students "Intellectual Property Developments in India," on October 18 at Pierce Law.

CHAT PARTNERS



CHAT PARTNERS - FROM LEFT TO RIGHT ARE: HYUK J. KWON (JD'04), RUTH KIMBALL, CHI-TUNG CHEN (MIP '03).

Pierce Law hosts a chat partner program that matches international students for whom English is a second language (ESL) with volunteers who are native speakers of English. Volunteers include students, faculty and staff—even family members of students who have the time and inclination to help an ESL student improve his or her English language skills.

The partners meet once a week, or as agreed, in an informal and casual setting to practice English pronunciation, listening skills, writing skills and learn about American culture. In reverse, the volunteer makes a friend from another country and learns about that student's culture. It is very rewarding and sometimes leads to lifetime friendships.

So, if you are walking down the halls of Pierce Law and come upon a gathering of 2, 3 or more people, as in the picture shown above, you might be watching a chat partner group in action. The photo shows Ruth Kimball, Pierce Law Alumni & Advancement, Administrative Assistant chatting with students Hyuk Jung Kwon (JD '04) from Korea and Chi-Tung Chen (MIP '03) from Taiwan.

THE IMPORTANCE OF INTELLECTUAL PROPERTY IN JAMAICA

BY KEACHEA N. DIXON (JD '04)

JAMAICA IS RICH in cultural expressions. The Jamaican people are creative, innovative, and inventive, yet they have not appreciated the value of intellectual property (IP) until now. Jamaica seems to be more focused on tangibles like tourism, natural resources and agriculture than on intangibles such as IP. However, IP law is an important area of interest globally, and Jamaicans do not want to be left behind. As a result, Jamaicans who are experts in the area of IP are working to make the country more aware of how important it is to include IP rights as part of the economic sector. The growing importance of IP is demonstrated by the number of articles written in the last two years in Jamaica's local papers. However, much work remains to be done to educate its citizens.

HISTORY AND GROWTH OF INTELLECTUAL PROPERTY LAW IN JAMAICA

Jamaica's IP laws and administration have seen substantial growth in the last decade though part of it lags behind. Jamaica became independent from the United Kingdom (UK) in 1962. Prior to that date, the country had little time, resources and expertise to dedicate to the development of IP. The patent law, which was written in 1857 and amended in 1975, is currently outdated. Foga Daley & Co., *IP Regime in Jamaica, Patent Law* <http://www.fogadaley.com/> (last updated Nov. 22, 2002). However, there is a draft patent design bill, created in 2000, which would repeal the current law. *Id.*

Jamaica's patent law is not as developed and utilized as its other IP Laws. Local inventors do not actively patent their inventions. Patent protection in Jamaica is mainly utilized by multinational corporations, which need to ensure that their inventions are protected in the markets they distribute. Dianne Daley, *A reaction to the pan shocker*, The Sunday Gleaner 9C (April 21, 2002). Jamaican inventors are more concerned with getting an invention marketed and sold, thus avoiding the high legal fees and costs associated with acquiring a patent and the time it takes to receive protection. *Id.* Hence, Jamaican inventors have yet to appreciate the value of having the sole right to use, sell or license their inventions to others. They are dissuaded by the three years it takes to process a local patent from the filing of the application to the granting of the patent. Dianne Daley, Click Here: Publications, *Patent Protection in Jamaica*, 2 LawBrieflet 1 (July 2002) <http://www.fogadaley.com>.

Patent protection in Jamaica lasts for fourteen years and is renewable for an additional seven years. Peter Goldson, *Jamaica*, in *Intellectual Property World Desk Reference: A Guide to Practice by Country, State and Province*, Jamaica – 1 (Thomas M.S. Hemnes ed., Press 2000). There are no working requirements, annuity, or other payments required for the maintenance of a patent. *Id.* It is therefore easier and more attractive to inventors with international patents than it is to the local inventor.

In contrast, the Jamaican Trademark Act of 1999 was formulated to meet the country's obligations under the World Trade Organization TRIPS Agreement and the USA/Jamaica Bilateral Agreement on Intellectual Property Rights. Foga Daley & Co., *IP Regime in Jamaica, Trademark Law* <http://www.fogadaley.com/> (last updated Nov. 22, 2002). The Trade Marks Act and the Trade Mark Rules of 1958 were the regulatory trademark law until September 2, 2001 when they were replaced by the Trade Mark Act of 1999 and the Trade Mark Rules of 2001. *Id.* Trademark protection originally lasted for a term of seven years with a renewal term of fourteen years. It currently lasts for an initial term of ten

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years and is renewable for ten years. Foga Daley & Co. <http://www.fogadaley.com/>; Goldson, *Jamaica* at Jamaica – 3. The trademark law now includes the protection of service marks, collective marks, and multinational corporations' well-known marks. The trademark law also protects international organizations' emblems, and allows for multi-class application, which was not available prior to 2001. *See* Foga Daley & Co. <http://www.fogadaley.com/>; Goldson, *Jamaica* at Jamaica – 3. Available remedies under the Trademark Act include injunction, forfeiture or destruction of infringing items, damages, and an accounting of profits. Foga Daley & Co. <http://www.fogadaley.com/>.

Arguably, music is the heart and soul of the Jamaican people. As a result, the copyright law of Jamaica has experienced a more dynamic growth than the other areas of IP over the years. The Jamaican music industry's lobbying techniques molded the copyright laws of the country. The first copyright law was passed in 1913. Foga Daley & Co., *IP Regime in Jamaica, Copyright Law* <http://www.fogadaley.com/> (last updated Nov. 22, 2002). The law was updated in 1993 and amended in 1999. *Id*. There was an attempt to update the law in 1977, but the Jamaican music industry successfully lobbied against the change and it was tabled. *Id*. The Copyright Act of 1993 and 1999 does not have a statutory requirement for registration, the duration of protection is life of the author plus fifty years, and both moral and economic rights are recognized. Peter Goldson, *Jamaica*, in *Intellectual Property World Desk Reference: A Guide to Practice by Country, State and Province*, Jamaica – 2 (Thomas M.S. Hemnes ed., Press 2000). Protection for anonymous or pseudonymous work is fifty years after the work is initially made public, and for sound recording or film it is fifty years after the work is made or after it is made public, whichever is later. *Id*.

The implementation of the new copyright law resulted in an upsurge of collecting societies. Prior to the current law and for over fifty years the Performing Right Society (PRS) (UK) was the only collecting society in Jamaica. ReggaeFusionJamaica, *Copyright in Jamaica, Copyright Protection* <http://www.reggaefusion.com/Resources/Copyright.html> (last updated Nov. 22, 2002). PRS was succeeded by the Jamaica Association of Composers, Authors and Publishers (JACAP). JACAP was established in 1998. It administers the public performance rights of authors, composers and music publishers. JACAP licenses the music, the fees for which are turned over as royalties to the individuals who own the copyright in the music. JACAP, *What is JACAP* <http://www.utech.edu.jm/cariculture/Jamaica/Musicians/JACAP/index.htm> (last updated Nov. 22, 2002). Between 1995 and 2000, three other collective societies were formed: the Jamaican Musical Rights Administration Society (JMRAS), the Jamaican Copyright Licensing Agency (JAMCOPY), and the Jamaican Performers Administration Society (JPAS). *See* Dianne Daley, *Copyright law and administration in Jamaica*, 113 Copyright World 21, 22 (2001).

Prior to 2001, the administration of Jamaica's intellectual property rights (IPRs) was carried out by several government ministries and agencies. Currently, however, Jamaican IP is administered by The Jamaican Intellectual Property Office (JIPO), which is a statutory agency of the Ministry of Industry Commerce & Technology. *See* The Jamaica Intellectual Property Office, *Early Administration Of Intellectual Property (IP) Legislation* (Ministry of Industry, Commerce & Technology 2002). JIPO is responsible for the administration of IPRs, in particular the trademarks, geographical indications, industrial designs, copyright and related rights, patents, new plant varieties and layout designs rights; to advise the Minister with the IP portfolio on matters relevant to the administration of the IP laws; and to promote the development of IPRs. The Jamaica Intellectual Property Office, *Responsibility & Objectives of the Jamaica Intellectual Property Office* (Ministry of Industry, Commerce & Technology 2002).

PROTECT OR REGRET

Jamaica is a member of the Berne Convention, the Rome Convention, the Agreement on Trade Related aspects of Intellectual Property (TRIPS), World Intellectual Property Organization (WIPO) Performances and Phonograms Treaty (WPPT), WIPO Copyright Treaty (WCT) and the Jamaica/USA Bilateral Agreement on the Protection and Enforcement of Intellectual Property Rights. *See* The Jamaica Intellectual Property Office, *Jamaica's International IP Obligations* (Ministry of Industry, Commerce & Technology 2002). Though Jamaica is attempting to comply with its requirements under the treaties, one great obstacle to compliance is the dearth of professionals with knowledge and experience in IP. Regardless of the difficulties, Jamaicans must evaluate their approach to IPRs because they cannot afford to ignore protection of their IP at home or in any country in which they plan to do business. Original and creative work is ongoing in the country that is not being protected. For instance, though the copyright law was updated in 1993 and there are four collecting societies in operation, neither the artist nor the industry is well educated about copyright issues. *See* Tony Laing, *Intellectual Property, Cultural Industries IPC, JPAS & JAMAICA'S GDP* <http://www.ejaj.org/articles/2001/06/001.html>; *See e.g.* Bounty Killer Entertainment, *Round One - You Don't Have To Like Me, But You Will Respect Me* <http://www.bountykiller.com/nodoubtsuebounty.htm>(discussing how the artist never received any lump sum or royalty payment for his contribution to the famous song "Hey Baby"). Many local artists do not receive royalties from the television and radio stations, discotheques, restaurants, nightclubs or collecting societies locally for their live and fixed performances. *Id*. Even local artists who have received international recognition such as Beenie

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Man, Shaggy, Sean Paul and Shabba Ranks, do not receive royalties from the Jamaican media houses. The income generated from the Jamaican copyright industry could contribute substantially to the GDP of the country. In 2001, the United States' Copyright Industry contributed $535.1 billion to its economy, which accounted for 5.24% of its GDP. *See* International Intellectual Property Alliance, *IIPA Economic Study Reveals Copyright Industries Remain a Driving Force in the U.S. Economy, U.S. Copyright Industries Continues to Lead the Economy in Job Growth, Contribution to the GDP and Foreign Sales/Exports* <http://www.iipa.com/pressreleases/2002_ Apr22_SIWEK.pdf>. If Jamaica could realize a portion of this from its copyright industry, the country could meet its economic goals more quickly than its current estimates.

Jamaica is making strides in raising its citizens' awareness of the importance of IPRs. However, there is still work to be done. If the country does not protect its IP, it will continue to lose money from lost trade opportunities or someone else protecting local IP interests. *See cf.* Dianne Daley, *A reaction to the pan shocker*, The Sunday Gleaner 9C (April 21, 2002) (discussing the matters surrounding Trinidad's steelpan being patented by two Americans); *See* USTR, *2002 Special 301 Report, Priority Watch List, Jamaica* <http://www.ustr.gov/reports/2002/special301-pwl.htm> (accessed Nov. 9, 2002). With the assistance of WIPO and dedicated local IP attorneys, the Jamaican Government is strengthening the human resources and the institutional infrastructure for the advancement of IPRs.

Keachea N. Dixon (JD '04) holds a BA from the University of Toronto in International Development Studies, specializing in Economics and Political Science. Upon graduation, Keachea intends to practice in the field of intellectual property.



STUDENT PROFILE: OLGA KRAUSS

BY MICHAEL DIRKSEN (JD '04)

INTELLECTUAL PROPERTY in Mexico began to accelerate after the North American Free Trade Agreement (NAFTA) was signed in 1993. Much of the internal success of Mexican IP is due to the vision and drive of a vanguard that presently graces the halls of Pierce Law. Her name is Olga Krauss and this is her story.

Olga grew up and attended school in "paradise." Her paradise is Colima, Mexico. Colima is located roughly 300 miles west of Mexico City and the largest active volcano in Mexico dominates its landscape. The explosive nature of the volcano must have shared its qualities with Olga. She is an educator, a student, and an author with explosive ideas and an uncanny ability to shape the landscape in which she resides.



OLGA KRAUSS (LLM "03)

Olga earned her law degree and a master's degree in criminology from the University of Colima, School of Law. Since graduation, she has authored numerous papers including "Civil Responsibility on the Matter of Intellectual Property: The Payment of Damages on the Offense Known as Piracy in the Context of NAFTA" and "The Relation Between Intellectual Property and the University System: The Case of the University of Colima." She has been selected to participate in numerous international conferences in Hungary, Greece and in Switzerland where she was chosen by the United Nations as the Mexican representative to the World Intellectual Property Organization (WIPO). On top of these accomplishments, she is a founding member of the Mexican Bar Association and is a partner in the law firm of Rodriguez, Krauss & Associates.

Olga matriculated at Pierce Law to gain an LLM and is currently in her second semester. She was able to attend Pierce Law by obtaining a scholarship from the Ministry of Education in Mexico. The Mexican government does not make this process "user friendly" and Olga admitted that she was surprised when she was accepted. She mentioned that it is a "dream to come here" and study in one of the premier IP environments in the United States.

Olga has been a professor at the University of Colima, School of Law for over ten years where she is the Director of the Intellectual Property Department. Before coming to Pierce Law, Olga was developing classes for educators and faculty alike to learn more about IP. She wants to spread the word and create awareness of the raw power that IP contains. Olga recognized that much of the IP at the University was being squandered and she decided to put an end to the waste. Presently, the University of Colima is the only University in Mexico that requires law students to take a course in IP.

Intellectual property in Mexico is controlled by two separate entities: The Industrial Property Institute that manages the patent and trademark realms and the Industrial Copyright Institute that controls the copyright sector. According to Olga, copyright law is used very effectively in Mexico as this anecdote explains. Olga was introduced to an amateur photographer who had taken a photograph of the volcano in Colima during an eruption. The photographer had taken his film to be developed at a local developing studio. The photograph was of stunning quality and the person who developed the film stole the photographers's negative and began selling the picture as their own. Olga counseled this photographer and was able to gain satisfaction for the photographer on the claim of copyright infringement against the developer.

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reality. The widespread acceptance and practice of Alternative Dispute Resolution (ADR) is the Holy Grail, and he is still in hot pursuit of it.

To meet and converse with Mr. Plant is to understand his pivotal role in the ripening of a practice whose time has come: ADR, and particularly ADR in the IP context. Mr. Plant's compassionate yet no-nonsense demeanor suggest the influence of his solid Midwestern upbringing rather than a persona sharpened upon the hard edges of a New York City practice where he has spent the bulk of his career. One gets the sense that Mr. Plant's conception of ADR is, in many ways, about creativity and vision, and being able to share the options born of this type of thinking with the client. The fact that ADR and David Plant discovered one-another, and that his accomplishments in this field are vast, seems to make good cosmic sense. The man *is* truly the mission.

In both speaking with Mr. Plant and reviewing his writings, there is a clear sense that ADR is no longer merely a viable alternative, but rather a preferred one, especially within the IP fold. In choosing mediation over other forms of dispute resolution, Mr. Plant believes that value may be bettered created and preserved. In contrast to traditional adversarial proceedings, ADR enables the participants to take control of the process, creating a solution that is more likely to result in a win-win transaction. Such a departure from the formality of legal pleadings found in traditional litigation enables participants in ADR to craft solutions that better deal with their real interests and needs. This is of particular value to IP disputes, because mediation typically affords better opportunities to both preserve old relationships among the participants more effectively than either litigation or arbitration, and to foster new and creative ones. Mr. Plant believes that an inherent quality of mediation is that it turns adversaries into partners. Other than the exceptions where immediate injunctive relief is required, where a party perceives the need for a precedent, or where a party is unwilling to negotiate or to do so in good faith, Mr. Plant believes that virtually all IP disputes may be suitably mediated.

Wresting an interview from an intelligent and unassuming overachieving-type can be difficult. Mr. Plant's answers are straight–forward, and his eye for the occasional ambiguous question, ahem, *keen*. Further complicating the matter, the author's attention was largely disrupted by an interest in exploring Mr. Plant, *the person*, rather than Mr. Plant, *the career*. Pierce Law's own Professor Karl Jorda admonished, however: "Don't let him (David) off the

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The University of Colima is Mexico's national center of compact disc production and produces copies of cd's containing everything from legislative and teaching material to biotech information. Olga stated that too many Mexican professors and academics are stuck in the "publish or perish" mentality as they have yet to realize the strength that patent protection can bring them. Recently, though, Olga has been instructing inventors, professors and others on the importance and availability of patents. She mentioned that Mexicans have a natural inventive nature about them and they are always tinkering with items to make them work better. Until Olga began to profess the benefits of protecting their inventions, few people realized that this could be done.

Olga has devised an interesting system by which she disseminates information regarding IP to her peers. She has consulted with the Deans of the University system in Mexico to explain the importance of IP education in Mexico. These consultations with the leaders of the University system are the headwaters for her working theory of "trickle down IP." This is a theory where she tells as many people as possible about IP in the hopes that they in turn will tell others about IP. In a nation that is still forming its IP structure, and where people are perhaps not as familiar with the concept as in other nations, this system spreads the word about IP as fast as any.

The Mexican business climate after NAFTA has been growing with incredible speed. Olga stated that "NAFTA is everything" to Mexico, that it created an open economy and that NAFTA has helped grow the economy all over the country. The benefits of NAFTA to Mexican businesses are seen in every aspect of the economy. This more powerful economy and the drive to secure IP will enable steady growth for years to come.

Her plans upon graduation are to return to the University of Colima with newfound ideas, plans and methods that can be shared to grow the area of IP even more. She has found the teaching environment at Pierce Law enjoyable and she wants to bring some of that environment back to Colima as well. She appreciates the openness of the professors and the more relaxed nature of the educational atmosphere. In Mexico, the professors are not as approachable as they are here and she feels that the Pierce Law approach facilitates a better approach to teaching and learning. The Socratic method is also something that she appreciates because it "encourages creativity in the students" in and out of class. The legal system in Mexico is "standardized" to a degree where attorneys follow forms instead of using their intellect to solve problems. She wants to bring back some of this atmosphere to Colima because "it's great when you can get a student to think differently" about a subject.

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hook easily. There's a good story there." And indeed, when regarding Mr. Plant, one finds both career and character well in tune with one another, affirming the genuine sincerity and success he has shown and continues to show in spreading the ADR gospel throughout the worldwide legal community. Too often litigation remains the only option. Mr. Plant believes that ADR is a value worth pursuing. Such a conclusion, forged within the fires of many fruitful years of serious practice, is a strong indication that ADR is one of the more evolved iteratives available in the pursuit of applying the highest legal principles to real-world situations. Mr. Plant's devotion to thinking outside the traditional legal box bodes well for the future of the profession.

Mr. Plant was born in 1931 and has specialized in intellectual property as a member of Fish & Neave in New York City since 1957. Mr. Plant received both his engineering and law degrees from Cornell University, and is a member of a myriad of bars, including the New York Bar, the U.S. Supreme Court, several U.S. Federal courts and the U.S. Patent and Trademark Office. Mr. Plant is also former Chair of the ADR Committee of the American Intellectual Property Law Association (AIPLA) and is on the World Intellectual Property Organization (WIPO) Panel of Neutrals. In addition, he is a frequent speaker at IP conferences the world over. Currently, Mr. Plant is also an adjunct professor at Pierce Law, where he teaches Negotiation for Intellectual Property Business Matters.

Troy Watts (JD '03) holds a BA in English from the University of Colorado. After a seven-year tenure competing in international alpine skiing, he decided to get serious with the books, and in particular, the law. Upon graduation, Troy plans to practice real estate law in the mountains of New Hampshire.



ICANN: A TRADEMARK OWNER'S QUICK ANSWER TO A BIG PROBLEM

BY DEBORAH MITCHELL (JD '04)

MORE AND MORE businesses are realizing that e-commerce is not just for business-to-business commerce anymore. In order to stay competitive in today's technical society businesses must be able to contact, service, and support consumers on-line. Some trademark holders, who didn't feel the winds of change, woke up to find that not only had their beloved trademarks been registered, they were registered in the all too precious, .com, .net, and .org, top-level domain fields. Fear not, trademark holders, for all hope is not lost. It appears that relief can be obtained in an efficient, cost effective manner, and it usually favors those seeking to protect their intellectual property rights.

The Internet Corporation for Assigned Domain Names and Numbers (ICANN) approved the Uniform Domain Name Dispute Resolution Policy (UDRP), which went into effect on December 1, 1999. The UDRP was initially intended to address only the most offensive cases, like cyber-squatting. However, since its launch, the UDRP has evolved into the settler of all sorts of domain name disputes.

Why is the availability of ICANN so significant, when protection already exists under the Federal Trademark Dilution Act and the Anticybersquatting Consumer Protection Act? There are several answers. ICANN is more cost effective, it circumvents some of the problematic issues that arise when using federal law to resolve domain name disputes, and has traditionally favored trademark holders. Furthermore, a trademark holder can still pursue any available federal claims instead of, or in addition to, the ICANN procedure.

ICANN is by far the quickest of the available options for those "non-early bird" trademark holders who didn't "get their worm." Once a claim is submitted, the domain name holder will be notified within three calendar days, and has only twenty days from the commencement of the proceedings in which to respond. Once an arbitrator is appointed they will have fourteen days to submit a decision. ICANN, *Uniform Domain Name Dispute Resolution Policy*, (Aug. 26, 1999), <http://www.icann.org/dndr/udrp/uniform-rules.htm> (accessed Oct. 13, 2002), [hereinafter ICANN Rules]. Usually, the entire process is completed in less than two months. If a trademark owner were confined to seeking relief in federal courts, it could take three times as long to reach a resolution. A primary concern of UDRP drafters was achieving results with speed, one they seem to have successfully accomplished.

This added speed is much more likely to benefit the complainant who can put their "ducks in a row" before filing than the respondent who must jump onto ICANN's fast moving train. One-third of UDRP cases result in a default judgment to the complainant, because of the respondent's failure to defend. It has been speculated that the speed of the process might be partially responsible. This works in favor of the trademark holder, whereas a respondent that fails to defend only wins 2% of the time, compared to 15% when the respondent asserts his right to the contested domain name. Dr. Milton Mueller, *Rough Justice: An Analysis of ICANN's Uniform Dispute Resolution Policy,* <http://dcc.syr.edu/roughjustice.htm> (accessed October 14, 2002). A failure to respond has even been seen as an indication of bad faith in some cases. *See*, *AFC Enters. V. Max Mktg.*, Case No. D2000-0975 (WIPO Oct. 12, 2000); *Mars Inc. v. Vanilla, Ltd.*, Case No. D2000-0586 (WIPO Sept. 1, 2000).

Another benefit of ICANN's policy is that it is comparatively inexpensive. There are five approved dispute resolution service providers (DSRPs). Costs vary by organization, but all

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DRSPs remain much cheaper then traditional litigation. For example, arbitration through the World Intellectual Property Organization, involving six to ten disputed domain names, would cost $2,000 U.S. Dollars. WIPO Arbitration and Mediation Center, *Schedule of Fees under the ICANN Policy*, <http://arbiter.wipo.int/domains/fees/index.html> (accessed Oct. 14, 2002). In traditional litigation a plaintiff might not make it to discovery on $2,000 U.S. dollars. Furthermore, the time saved could have significant financial benefits. A business that is able to move forward with its business plans, engage in e-commerce, or abruptly prevent consumer confusion can realize substantial gains above and beyond any saved expenditures.

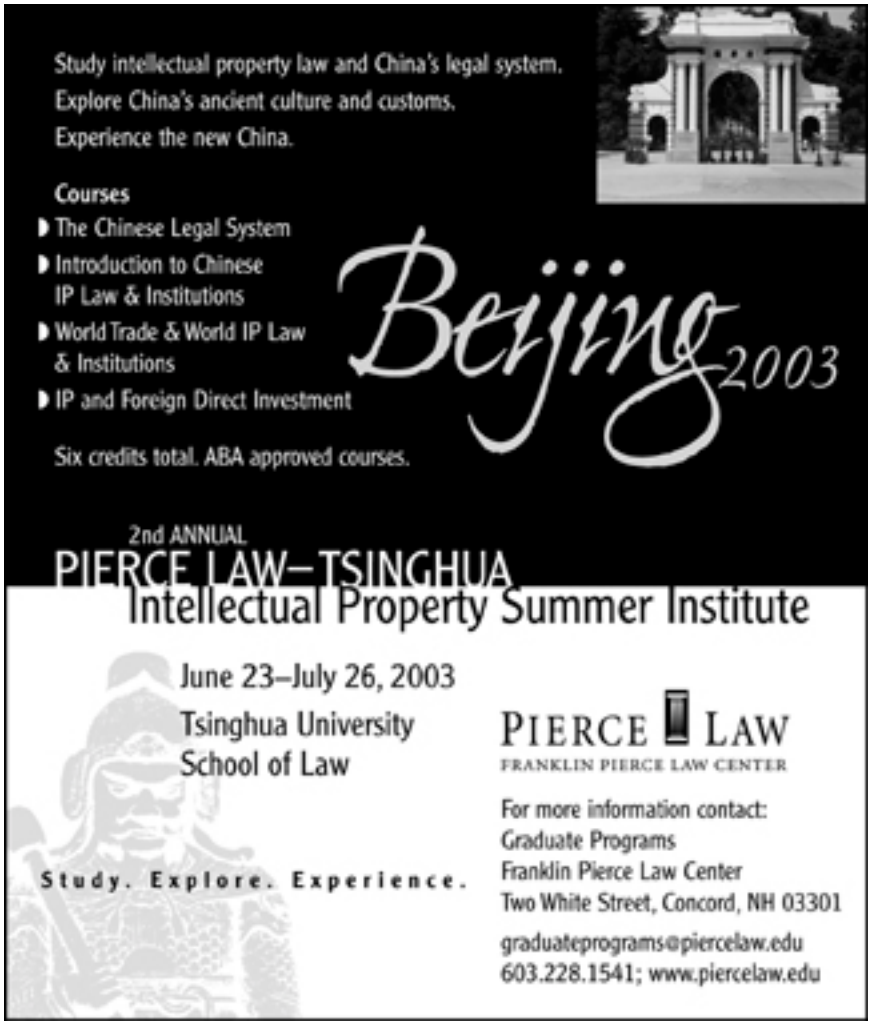
ICANN, when establishing the UDRP, recognized that domain names are global in nature and managed to effectively circumvent the traditional jurisdictional, enforcement, and choice of law concerns that would arise if proceeding under federal law, like those often experienced in e-commerce disputes. The UDRP is founded upon contract law, where all parties registering a domain name consent to the use of ICANN's arbitration dispute system. It is also unique in its ability to effectively enforce its decisions. ICANN does not rely on courts to enforce its judgments, whereas the only relief it grants is the cancellation and transfer of domain names under its direct control. Once a decision is made the arbitrator's decision is final. The only remaining option a respondent has to reclaim its domain name is to file a lawsuit against the trademark owner. *See* Laurence R. Helfer, Graeme B. Dinwoodie, *Designing Non-National Systems: The Case of the Uniform Domain Name Dispute Resolution Policy*, 43 Wm and Mary L. Rev. 141, (Oct. 2001).

Lastly, and most importantly, as ICANN has developed and expanded, it has done so in favor of trademark owners. As of October 4, 2002, of the 9,877 disputed domain names that reached disposition by decision, 7,733 resulted in transfer and 53 resulted in cancellation. Respondents prevailed only 15% of the time. ICANN, *Statistical Summary of Proceedings Under Uniform Domain Name Dispute Resolution Policy*, <http://www.icann.org/udrp/proceedings-stat.htm.> (accessed Oct. 14, 2002).

In order for a claimant to prevail, the following three elements must exist: 1) the domain name is identical or confusingly similar to the complainant's trademark or service mark; and 2) the domain name holder has no rights or a legitimate interest in the domain name; and 3) the domain name has been registered and is being used in bad faith. ICANN, *Uniform Domain Name Dispute Resolution Policy*, (Aug. 26, 1999), <http://www.icann.org/dndr/udrp/uniform-rules.htm.>(accessed Oct. 14, 2002). Arbitrators have traditionally stretched these elements in favor of Trademark holders.

This "stretching" has been seen in all three elements. The first element was extended further than the elastic on a wonder bra, when a panel found Bodacious-tatas.com to be confusingly similar to the trademark Tata & Sons. *Tata Sons Limited v. D & V Enterprises* (WIPO Case No. D2000-0479). In another dispute, where an arbitration panel found that the respondent had a legitimate interest in the domain name, the panel still ordered the domain name transferred, indicating a willingness to go beyond finding a legitimate interest to a determination that "some rights are better or more legitimate than others." *Excelentisimo*

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Ayuntamiento de Barcelona v. Barcelona.com Inc., WIPO Case No. D2000-0505 (August 4, 2000).

Finally, this stretching in favor of trademark holders has also been seen in the third element, the requirement of bad faith. It seems that whenever the panel looks for bad faith, they find it. In a decision concerning the domain name crew.com, absent of any bad faith per se, the panelists established a "preclusion" doctrine such that prior registration of a name constitutes bad faith, merely because it prevents the Trademark holder from having the name. A later panel denounced using "preclusion" to establish bad faith, reasoning that previous panels had erred in concluding that the mere registration of the mark, was evidence of an attempt to prevent the legitimate owner of a registered or common law trademark from obtaining a "corresponding domain name." *Bruce Springsteen v. Jeff Burgar and Bruce Springsteen Club*, 2001 WL 1705212 (UDRP-ARB Dec.) Case No. D2000-1532. Despite heavy criticism, this type of reasoning is still seen. In *Gardner's Super Markets Inc. v. Ambassa Holdings, Inc.*, 2002 UDRP Lexis 436, June 14, 2002, bad faith was found partially because the respondent had knowledge of the complainant's use of the mark. The panel concluded the respondent's use of the mark in a domain name was disrupting complainant's business by preventing him from reflecting his mark in a corresponding domain name.

Arbitrators and panelists have also been reluctant to accept fair use defenses. A prime example of this may be found in, *Preston Gates & Ellis, LLP v. defaultdata.com and Brian Wick*, 2002 UDRP Lexis 96, February 13, 2002. After several unsuccessful attempts to avoid the transfer or cancellation of a domain name in prior UDRP proceedings, in *Preston*, Brian Wick shifted from his usual unsuccessful claims of parody to a 1st Amendment argument that the

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From the Editor

A NEW IP ACADEMY IN SINGAPORE

BY KARL F. JORDA

IF YOU HAVEN'T HEARD of Singapore's IP Academy, don't worry, you will. It's a new star that has risen and will soon shine brightly in the firmament of IP education and training institutions. Having witnessed its official launch on January 28, 2003, I have no doubt that it will indeed become a world-class IP teaching institute, not only for Singapore but also the whole ASEAN region and beyond. And Franklin Pierce Law Center (Pierce Law) may get to play a role in this "Endeavour." (A beautiful replica of the famous sailing ship "Endeavour" was the memento for the participants in the Academy's launch.)

As was noted in the Summer 2002 issue of this Newsletter, a Singaporean delegation visited Pierce Law on July 2, 2002. The delegation, a high-caliber Academy Development Team, included the Chairman of the Intellectual Property Office of Singapore (IPOS) Professor Hang Chang Chieh; the IPOS Director-General, Ms. Liew Woon Yin; the Assistant Director, Ministry of Law, Mr. Poon King Wang and Ms. Rose H. Ramli, Head, IPOS Knowledge Management Department. Due to our "considerable experience in IP education, especially in areas beyond pure IP law," they wanted to meet with us for "some exchange of ideas" in connection with their plans for establishing an IP academy.



SENIOR MINISTER OF STATE, HO PENG KEE

Email from Ms. Ramli, dated October 9, 2002 gave a progress report on developments in planning the Academy in terms of key personnel appointments, organizational structure and types of programs. It also spoke of an "official launch in March 2003." However, already in a missive, dated December 26, 2002, Ms. Ramli informed me that their Academy was ready to be launched on January 28, 2003 and they "were hoping (I) could pop by." And pop by I did; and I'm so very happy I did.

The Academy's inauguration was held in the Ocean Ballroom of Singapore's Pan Pacific Hotel at 10 a.m. on Tuesday, January 28, 2003. Over 100 invited guests from academia, government and industry of Singapore and other countries, namely Australia, Great Britain and Taiwan, were in attendance. Apparently, I was the only American.

It was a fairly brief but very moving and memorable ceremony with addresses by Professor Hang, describing the Academy's mission, and by the Senior Minister of State for Law and Home Affairs, Professor Ho Peng Kee, giving the keynote speech as the Guest of Honor. Among other things, he expressed his belief that "the IP Academy will play a catalytic role as (it) expands the frontiers of Singapore's pioneering efforts in IP." A ceremonious unveiling of the Academy's banner, emblazoned stylistically "IP Academy - Empowering

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PICTURED, FROM L TO R: PROFESSOR HELLMUT SCHUTTE, DEAN, INSEAD (ASIA CAMPUS); MR. LIEW HENG SAN, PERMANENT SECRETARY, MINISTRY OF LAW, SINGAPORE; PROFESSOR CC HANG, CHAIRMAN, IPA BOARD OF GOVERNORS; PROFESSOR HO PENG KEE, SENIOR MINISTER OF STATE FOR LAW & HOME AFFAIRS; MS. LIEW WOON YIN, DIRECTOR-GENERAL, IPOS; PROFESSOR KARL JORDA; PROFESSOR PHILIP GRIFFITH, FACULTY OF LAW, UNIVERSITY OF TECHNOLOGY SYDNEY.

the Intellect" and signing of a number of MOUs (Memoranda of Understanding) between IPA and various partner institutions followed. A reception then concluded the festivities.

Professor Gerald Dworkin, Emeritus Professor of Law, King's College, University of London and, I might add, a good friend of Bob Rines, our founder, participated very visibly as a dignitary. He had been in Singapore for some time as a consultant to the Academy Development Team. Singapore still derives considerable assistance and guidance from Great Britain but Australia also plays a significant role in Singapore. And Professor Philip Griffith, Faculty of Law, University of Technology, Sydney, is a frequent visitor in Singapore and of course also attended the inauguration.

I am very thankful for the gracious invitation to the Academy's launch and especially the splendid hospitality extended to me during my visit. After arriving Sunday, January 26, in the morning via San Francisco and Hong Kong, I was invited to join Ms. Ramli, Mr. Wang and Ms. Isabel Chng, Legal Counsel IPOS for a twilight stroll through and a Japanese dinner at the Esplanade. On Monday, January 27, it was a breakfast meeting "to discuss potential collaboration" at my hotel, the Pan Pacific, where I and other foreign invitees were put up, with Professor Loy Wee Loon, on assignment from the Faculty of Law of the National University of Singapore to the Academy as its new Deputy Director, Ms. Liew, Ms. Ramli and Professor Dworkin. And lastly on Tuesday evening I was invited to join a group consisting of Ms. Liew, Ms. Loy and her family, Ms. Ramli, Professor Griffith and Mr. And Mrs. Malcolm Royal (Mr. Royal being the President of FICPI (International Federation of IP Counsels)) for dinner in celebration of the Academy's successful launch earlier in the day.

As regards cooperation and for starters, the Academy would like us to field a lecturer on IP valuation in the near future. And Ms. Chng has questions about the Hilmer Doctrine in U.S. Patent Law & Practice, that she would like us to clarify for her.

Now what is Singapore's new IP Academy all about? The invitation letter to the launch of the Academy has this to say about the new Academy:

"As Singapore moves towards an innovation-driven economy, it has become increasingly important that people and organizations have the skills to manage their innovation process and maximize their creative capacities. Companies are also finding that proper intellectual asset management can help them secure their market positions and boost their company value. To address the need for IP skills, the IP Academy will be set up to help nurture a critical base of expertise.

The IP Academy is an independent institution that provides continuing education and executive programmes for our researchers, businessmen and professionals in the areas of IP protection, exploitation and management, so that they can compete successfully in the global marketplace. The IP skills gained will include IP portfolio management, marketing and branding know-how, and IP valuation. The IP Academy will also be a focal point for thought leadership and research programmes that will keep Singapore at the forefront of IP developments and enhance Singapore's reputation as an IP Hub.

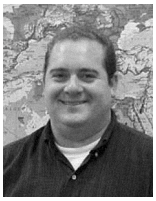
The IP Academy is a national initiative that is supported by IPOS, MinLaw (Ministry of Law) and MTI (Ministry of Trade & Industry). It will work in partnership with our institutions of higher learning, research institutes, professional bodies and members of industry."

More particularly, according to Academy literature, "(to) be the focal point of education and research in the field of

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PROFILE, from page 10

Olga has a self-described "natural charm" and a complete disregard for rejection, so she plans on taking her ideas to whoever will listen in Mexico. In a burgeoning IP environment like Mexico is experiencing now, there is the need for risk takers who can bounce back from adversity and Olga is just the woman for that job. Her educational experiences, titanic drive and international flare combine to form a person who has the ability to create a functional IP structure within Mexico.



Michael Dirksen (JD '04) holds a BA in Biology from St. John's University. He is originally from Shoreview, MN. Upon graduation, Michael plans to practice patent law in the Midwest.

ICANN, from page 12

use of the mark was necessary to identify the subject matter being criticized. This argument failed as well.

ICANN's arbitration process is not without controversy. In addition to being criticized for being too pro-business, there are also claims that the UDRP lacks legitimacy, has uncontrolled choice of law, inconsistent interpretations, and violates due process and 1st Amendment rights. For a thorough analysis of these criticisms see, Elizabeth G. Thornburg, *Fast Cheap and Out of Control: Lessons from the ICANN Dispute Resolution Process*, 6 J. Small & Emerging Bus. L. 191 (Spring 2002). Despite these criticisms one thing is certain. If you are trademark holder looking to protect your intellectual property rights or enter the cyber-marketplace, ICANN remains a much-welcomed ally.

Deborah Mitchell (JD '04) holds a BA in Political Science. She plans to practice in the areas of Trademark, Anti-Trust, & Telecommunications. She plans upon practicing law "wherever the road may lead."



ACADEMY, from page 14

Intellectual Property (IP)", is its vision and "(t)o broaden and deepen knowledge and capabilities in IP creation, protection, exploitation and management", is its mission.

And the following are its programs and services:

A. CERTIFICATION COURSES

"The 'Graduate Certificate in Intellectual Property Law' course is jointly conducted with the Faculty of Law, National University of Singapore. It is the foundation course in IP law. Successful completion of this course is a statutory pre-requisite for admission as a registered patent agent in Singapore.

The 'Graduate Certificate in Patent Drafting and Interpretation' course is jointly conducted with the Faculty of Law, University of Technology, Sydney, to complement the practical training which patent agent trainees undergo in their internship."

B. EXECUTIVE TRAINING COURSES

"The 'IP Engineer Training' course is designed to 'convert' a research scientist/ engineer into an 'IP engineer'—one savvy in the IP law regime and armed with some of the key tools (eg. patent mapping) to help develop an organisation's IP blueprint which will chart the directions for research (and hence resource allocation), IP portfolio planning, IPR defence strategy etc. for the organization.

The course on 'IP Law in the Chinese Economic Zones: Convergence and Divergence' aims to provide IP professionals with a working knowledge of the IP laws in China, Hongkong, Macau and Taiwan."

The certification and executive training courses are designed for lawyers, patent agents, trademark agents, technology transfer brokers, licensing and franchising brokers, IP portfolio, managers, investment bankers, venture capitalists, market strategists, technology intelligence agents, R&D project directors and IP engineers.

C. LEADERSHIP PROGRAMS

The Academy will also feature "Thought-leadership Programmes," as follows:

"A research project to study the economic impact of copyright in Singapore. This study will form part of an international project initiated by the World Intellectual Property Organization (WIPO) to track the impact made by the copyright industries on the economy in various countries.

The 'IP Roundtable' series, jointly organized with the Intellectual Property Office of Singapore, provides a forum for IP professionals to discuss emerging issues in IP law."

This is quite an ambitious but also auspicious project that Singapore is embarking on and the drivers behind this Academy project are to be commended for their initiative and endeavors. I am very confident that Singapore's new IP Academy will become a mecca for IP education and training in the region. Here's wishing "Endeavour" smooth sailing on her voyage!



Karl F. Jorda, David Rines Professor of Intellectual Property Law & Industrial Innovation, Director, Kenneth J. Germeshausen Center for the Law of Innovation & Entrepreneurship, Franklin Pierce Law Center, Concord, NH

FRANKLIN PIERCE LAW CENTER
GERMESHAUSEN CENTER • *Calendar of Events*

April 25-26, 2003
BASIC PATENT COOPERATION TREATY (PCT) SEMINAR FOR PATENT ATTORNEYS, PATENT AGENTS AND PATENT ADMINISTRATORS
Courtyard Marriott, Concord, NH
www.piercelaw.edu/TreatySem/treatsem.htm

May 19-23, 2003
MEDIATION SKILLS FOR IP & COMMERCIAL DISPUTES
Pierce Law, Concord, NH
www.piercelaw.edu/ipb/ipsi00broch.htm

June 23-July 26, 2003
INTELLECTUAL PROPERTY SUMMER INSTITUTE AT TSINGHUA UNIVERSITY SCHOOL OF LAW
Beijing, China
www.piercelaw.edu/ipb/CHIPSI/ChipsiIndex.htm

May 19-July 18, 2003
INTELLECTUAL PROPERTY SUMMER INSTITUTE
Pierce Law, Concord, NH
www.piercelaw.edu/ipb/ipsi00broch.htm

July 14-18, 2003
TWELFTH ANNUAL ADVANCED LICENSING INSTITUTE
Pierce Law, Concord, NH
www.piercelaw.edu/ali/ali.htm

The Germeshausen Newsletter can now be accessed at: www.piercelaw/news/pubs/Germindex.htm

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