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Prior Use Defense to Patent Infringement Deserves A Second Look

By Paul B. Milcetic and David B. Hoffman

Although the American Inventors Protection Act of 1999 can provide a complete defense to patent infringement in some circumstances, accused infringers have so far shied away from it because of the real and perceived shortcomings associated with raising it. Given the unique advantages that the defense can provide, however, accused infringers should give serious consideration to interposing the defense whenever there is a good faith basis for it, especially if current proposals to expand the defense are successful.

I. Introduction

The American Inventor's Protection Act, enacted in 1999 ("AIPA"),¹ was intended to provide a unique defense to patent infringement which would have potentially significant effects on patent litigation. The AIPA creates a personal, non-transferable, and yet complete defense to infringement for those who use patented methods of "doing or conducting

business." Under the Act, anyone using such a patented method is not liable for infringement so long as the use (a) began in "good faith" more than one year before the patent's earliest priority date and (b) became "commercial" in nature before that priority date, even if the use was entirely secret.²

During the six years since the passage of the AIPA, however, no reported decision indicates that the defense has been raised, and therefore no court has been asked to address the scope or contours of the AIPA.

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consideration to
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Why haven't more defendants taken advantage of the Act's offer of immunity against patent infringement liability? More than likely, many defendants have chosen not to assert the defense

because of various risks and limitations associated with it, both real and perceived.

II. Limitations of the Prior Use Defense

An accused infringer who asserts the defense faces the very real risk that the patentee's chances of recovering attorney fees will be substantially increased if the defense is unsuccessful. Under the Act, if an accused infringer pleads the prior use defense and the patentee nevertheless prevails, then the Court *must* "find the case exceptional for the purpose of awarding attorney fees" if the accused infringer "fails to demonstrate a reasonable basis for asserting the defense."³ Defendants who assert the defense had better be sure there is good reason to do so.

In addition to the increased risk of being saddled with the opposing party's attorney fees, an accused infringer must also carry a relatively heavy burden of proof. The Act requires that the defense be established by clear and convincing evidence.⁴ A defendant asserting the defense thus faces the same burden of proof as one attempting to invalidate a patent.

But the most important reason for the defense's lack of popularity is that it is perceived as limited to absolving only defendants who practice patented methods for providing financial services implemented in computer software. Apparently, this perception arose because Congress passed the AIPA in response to the *State Street Bank* decision,⁵ in which the Federal Circuit held that "business methods," including methods that implement financial

services in computer software, are patentable subject matter.

However, it is by no means clear that the phrase "methods of doing or conducting business," as used in the Act, encompasses only software related methods for providing financial services. In fact, there is evidence, albeit inconclusive, suggesting that the phrase "methods of conducting or doing business" not only encompasses patented software-related methods, but also patented manufacturing methods. The text of the AIPA itself appears to contemplate that the defense may apply to methods for producing "useful end products."⁶ And from the legislative history of the Act, a committee report from the House of Representatives broadly states that an invention is a "method" within the meaning of the AIPA if

The defense can significantly attenuate any perceived equities that patentees may otherwise enjoy in patent litigation.

"it is used in connection with the production of a useful *end-product* or service and is or *could have been* claimed in the form of a business process or method."⁷ This and other evidence have led some commentators to observe that the Act's prior use defense may apply to methods other than those that provide financial services implemented in software.⁸

III. Some Advantages of the Prior Use Defense

Given that no court has definitely limited the scope of the prior use defense to software

inventions in the financial services field, accused infringers should consider asserting the defense whenever there is a reasonable basis for doing so because it offers definite advantages.

The defense can significantly attenuate any perceived equities that patentees may otherwise enjoy in patent litigation. Rightly or wrongly, patentees often enter the courtroom, especially before juries, with the aura of an innovator. When a defendant's first line of defense is non-infringement, the fact finder is asked to determine whether or not the accused infringer has used or profited from the patentee's invention, and not whether the accused infringer might also be an innovator in its own right. By contrast, assertion of AIPA's prior use defense places the accused infringer's potentially innovative activities front and center.

Furthermore, although the prior use defense must be established by "clear and convincing evidence," that burden may be relatively easy to satisfy because, where the defense exists at all, the accused infringer would normally have evidence of the prior use within his or her custody or control. Furthermore, unlike the defense of invalidity for anticipation or obviousness, the prior use defense may be supported by evidence of activities that are secret and that were never made public. Thus, activities of the accused infringer that could not qualify as evidence supporting the invalidation of a patent would nevertheless qualify to make out a prior use defense.

IV. The Future of the Prior Use Defense

Currently proposed changes to the Act could make this defense more popular. This year's proposed overhaul of the patent statutes, H.R. 2795, also known as the "Patent Act of 2005," includes provisions that would considerably expand the scope of the prior use defense. The revisions would explicitly expand the defense to protect the practice of *all* varieties of patented inventions, and not just "methods of doing

and conducting business."⁹ In addition, the updated statute would eliminate the requirement that the purportedly infringing use have been reduced to practice at least one year before the filing date and commercialized before the filing date of the patent. Instead, under the proposed changes to the AIPA, the prior use defense can be established as long as the use began any time before the filing of the patent.¹⁰ This proposed expansion of the defense has been vigorously opposed by

numerous observers, some of whom have declared that the revision would "vitiating the value of patents."¹¹

In summary, although accused infringers have not enthusiastically embraced the prior use defense since its enactment six years ago, its popularity may soon increase. The prior use defense merits consideration, particularly if the current proposals to expand it are enacted.



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LL.M. in Trial Advocacy from the Temple University School of Law and a B.A. in Computer Science from Rutgers University. Paul is registered to practice before the U.S. Patent and Trademark Office.



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¹ 35 U.S.C. §273 (2005).

² 35 U.S.C. §273(a)(3)-(b).

³ 35 U.S.C. §273(b).

⁴ 35 U.S.C. §273(b)(4).

⁵ *State St. Bank & Trust Co. v. Signature Fin. Group, Inc.*, 149 F.3d 1368 (Fed. Cir. 1998).

⁶ 35 U.S.C. §273(b)(2).

⁷ H.R. report No. 106-287 at 46, (emphasis supplied).

⁸ Donald S. Chisum, CHISUM ON PATENTS §16.03[4], 2004 Cumulative Supplement.

⁹ See H.R. 2795, Sec. 9(b)(1)(A)(i), (b)(2)(A)(i). In the meantime, it is possible that a patentee could assert that the mere proposal to change the language suggests that the statute in its present form does not go beyond software related methods for providing financial services.

¹⁰ See *id.* at Sec. 9(b)(2)(A)(ii).

¹¹ See, e.g., *Comments by the Association of American Universities, The American Council on Education, The Association of American Medical Colleges, and The Council on Government Relations*, June 23, 2005. Available at <http://www.acenet.edu/AM/Template.cfm?Section=Home&TEMPLATE=/CM/ContentDisplay.cfm&CONTENTID=10758>.

Salazar v. Procter & Gamble: Mum's the Word?

By Lynn Morreale and Stephen Timmins

The number of patent infringement suits is reported to be rising. As more and more patent holders seek to enforce patent rights, it becomes increasingly important to those who procure patents to understand the circumstances by which statements made during patent procurement may be held against them—or not. The recent decision *Salazar v. Procter & Gamble Co.*, 414 F.3d 1342 (Fed. Cir. 2005), provides further guidance in the often murky waters of proper claim interpretation, claim scope disavowal, and prosecution history estoppel.

In the day to day challenge of patent procurement practice, the practitioner must be keenly aware of how her statements, or the lack thereof, may later impact the scope to be accorded to patent claims. *Salazar* provides guidance to the practitioner facing a situation that is fairly common, namely, the question of whether to respond to an examiner's statements in a Reasons for Allowance.

The issue specifically addressed in *Salazar* was whether "unilateral statements of an examiner in stating reasons for allowance can create a clear and unambiguous disavowal of claim scope and give rise to prosecution history estoppel." In short, the answer is apparently not. The dissent, however, demonstrates that reasonable minds may still differ on this issue, and at least one member of the Federal Circuit would have reached the opposite conclusion.

Background

Salazar sued P&G for infringement of U.S. patent No. 5,535,474 ("the 474 patent") for a toothbrush having polishing rods that clean and polish the teeth and stimulator rods that stimulate the gums during brushing. The district court granted P&G's motion for summary judgment of no infringement, literally or under the doctrine of equivalents ("DOE"), because its toothbrushes do not include the "elastic" feature recited by claim 1. The district court construed the term "elastic" to exclude nylon from the claim scope.

The district court's claim construction of "elastic" was based upon the patent examiner's stated Reasons for Allowance:

Claim 7 now incorporates previously held allowable subject matter ... *Although the patent to Clemens appears to have the recited structure, Clemens' 'rods' 22 are made of nylon, which is not considered 'elastic'. Obviously the 'rods' of Clemens are flexible, but are not considered to be 'elastic' as recited by the claim.*

The patent applicant never responded to the examiner's remarks. There was no other discussion on the record by the applicant or the examiner of the term "elastic". Based upon the statements in the Reasons for Allowance, however, the district court found that the claims must be interpreted to exclude nylon from their scope.

The Decision

The Federal Circuit reversed.

Finding that "the examiner's unilateral remarks did not alter the scope of the claim," the Court "refuse[d] to create a rule or presumption" that the applicant may disavow claim scope merely by its silence:

This court has recognized that an Examiner's Statement of Reasons for Allowance 'will not necessarily limit a claim.' (citation omitted). Consequently, an applicant's silence regarding statements made by the examiner during prosecution, without more, cannot amount to a 'clear and unmistakable disavowal' of claim scope (citations omitted) ... After all, the applicant has disavowed nothing.

Interestingly, the Court noted that the regulations in force during the prosecution of the patent application expressly provided that failure to provide a statement commenting on the reasons for allowance "shall not" give rise to any implication that the applicant agreed with or acquiesced in the reasoning of the examiner. Although this regulation has since been amended and no longer

An applicant's silence in response to an examiner's characterization of a ... claim term ... does not necessarily reflect the applicant's ... acquiescence thereto.

includes this provision,¹ the Court nonetheless concluded that "the

law precludes drawing inferences from an applicant's decision to decline comment on an Examiner's Statement of Reasons for Allowance", citing a lack of case law supporting P&G's contrary position.

The Court also reversed the holding that prosecution history barred infringement under the DOE. Noting that the claim language was not altered in response to the remarks in the Statement for Reasons of Allowance, the Court found that the examiner's unilateral remarks did not show a surrender of claimed subject matter that could not be recaptured under the DOE:

[T]his court finds that the examiner's unilateral remarks did not alter the scope of the claim. ... An examiner's statement cannot amend a claim.

The Federal Circuit vacated the grant of summary judgment and remanded.

Judge Bryson dissented, noting that the specification stated that bristles are composed of "conventional bristle material such as nylon" while the stimulator rods were said to be "of an elastic material, typically rubber or rubber substitute." Thus, it was reasonable for the examiner to conclude that the applicant

intended "elastic" to exclude nylon.

Further, while agreeing with the general proposition that an applicant is not obligated to respond to an examiner's claim characterization, the dissent noted the examiner's statements "related directly to the ground on which the patent was issued" and "indicates how a person of ordinary skill in the art" (i.e., the examiner) would understand the term. According to Judge Bryson,

[w]hen an applicant sits idly while an examiner explains that he understands particular claim language to have a particular meaning and only regards the invention as patentable based on that meaning, the applicant should face a heavy burden in later challenging the examiner's interpretation,

citing *Torpharm, Inc. v. Ranbaxy Pharma., Inc.*, 336 F.3d 1322, 1330 (Fed. Cir. 2003) and *Elkay Manuf. Co. v. Ebco Manuf. Co.*, 192 F.3d 973, 979 (Fed. Cir. 1999). He concluded:

[I]n light of the central importance of the examiner's understanding of the meaning of the term to his decision to allow the claims, the absence of any indication that the patentee intended the claim term to be broader supports the district court's conclusion.

The Take Home Lesson: Silence May Be Golden?

- An applicant's silence in response to an examiner's characterization of a claim or claim term in a Reason for Allowance does not necessarily reflect the applicant's agreement or acquiescence thereto. Nor will silence necessarily result in any presumption of the same, although the effect of the new regulation may still leave room for argument.²

- Claim scope disavowal is more likely to be found when the prosecution history reflects:

- a) an understanding of both the examiner and applicant that a claim term has a narrower or different meaning from its ordinary definition; and/or

- b) statements in the specification or made during prosecution that indicate that the prior art teaches subject matter that differs from the claims. If you do respond to the examiner's characterization, either via argument or amendment, you may disavow claim scope.

Therefore, when facing a *Salazar* situation of your own, it may be useful to keep in mind Mark Twain's words: "No one has a finer command of language than the person who keeps his mouth shut."

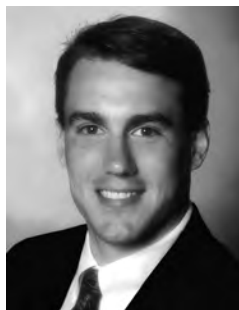
¹ See 37 C.F.R. § 1.104(e) (2003).

² It is interesting to note that the new regulation, Rule 104(e), now says only that the applicant "may" comment; the removal of the no-implication-of-agreement for failure to comment leaves open the possibility that *Salazar* might have been decided differently if the new regulation were in effect. Moreover, the new regulation says that if the applicant does comment, the failure of the examiner to reply carries no particular meaning. These two things suggest that there might be implication if an applicant does not comment on reasons for allowance.



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Warning: Be An Advocate but Take Care When Alleging “Advantages”

By Thomas S. Kim

Three recent decisions finding commercially important pharmaceutical patents unenforceable due to inequitable conduct – two from the Federal Circuit and one from a district court – underscore the need to take extra care when arguing surprising or unexpected results to gain allowance of patent claims from the U.S. Patent and Trademark Office (USPTO).

Purdue Pharma v. Endo Pharmaceuticals

In *Purdue Pharma L.P. v. Endo Pharmaceuticals*, 410 F.3d 690 (Fed. Cir. 2005), the Federal Circuit affirmed the lower court’s finding that the asserted patents on controlled release oxycodone were unenforceable due to inequitable conduct. This finding was based on Purdue’s arguments to the USPTO touting the alleged “surprising results” of its four-fold range of oxycodone dosage over existing eight-fold ranges for

other opioids. The results were based on scientific “insight” and not scientific proof, but Purdue never disclosed this to the USPTO.

Purdue argued that the basis for its “surprising results” allegations was not material because Purdue had never stated that the results derived from clinical tests and because clinical testing, or scientific proof, is not a requirement for patentability. The court rejected these arguments noting that the language used by Purdue

court noted that Purdue had repeatedly referred to its four-fold range as a “result;” had frequently noted the “clinical significance” of its discovery; and had continually compared the dosage range of its claimed oxycodone formulation to prior art formulations in concise, quantitative terms. The court concluded that, in the absence of any statements indicating the true origin of its “surprising discovery,” Purdue’s arguments to the USPTO provided enough suggestion that clinical tests had been performed so that Purdue’s failure to tell the USPTO that the discovery was based on “insight,” and not scientific proof, was a failure to disclose material information.

The court found that Purdue’s inability to prove scientifically the accuracy of its statements supported a finding of intent to deceive, despite finding that Purdue likely had the belief that it

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clearly inferred that its discovery was based on clinical studies. The

had discovered the “surprising results” it alleged. Accordingly, the court affirmed the trial court’s finding of materiality and intent.

Aventis Pharma S.A. v. Amphastar Pharmaceuticals, Inc.

In *Aventis Pharma S.A., et al. v. Amphastar Pharmaceuticals, Inc.*, 2005 U.S. Dist. LEXIS 12510 (C.D. Cal.2005), Aventis asserted that Amphastar and Teva Pharmaceuticals USA infringed the 618 patent directed to low molecular weight heparins. The district court held the 618 patent unenforceable due to inequitable conduct.

In response to rejections by the USPTO, Aventis had argued, including in two separate declarations, that its formulations had significantly improved half-lives as compared to the formulations of the cited prior art. Adventis failed, however, to disclose that the comparisons were between a 40 mg dose of the formulation in the 618 patent versus a 60 mg dose of the formulation in the cited art (half-life of 4.36 hours in 618 patent versus 3.33 hours in the prior art). Aventis also apparently failed to disclose that the half-lives for the claimed formulation vs. the prior art formulation, when both tested at a dose of 60 mg, were similar (3.70 hours in

the 618 patent vs. 3.33 hours in cited art). Aventis defended its failure to disclose the different doses on several grounds, including that the comparison it made was actually favorable to the prior art, since the prior art reference used a higher 60 mg dose versus Aventis’ 40 mg dose. The court found all arguments unpersuasive, especially considering the closeness of the 60 mg-to-60 mg comparison, and found high materiality.

The court found an intent to deceive based on the high level of materiality and lack of persuasive arguments for the failure to have disclosed the disparate dosages. The court ruled that Aventis committed inequitable conduct by failing to disclose the disparate dosages to the Patent Office.

Pharmacia Corp. v. Par Pharmaceutical

Finally, in *Pharmacia Corp. et al. v. Par Pharmaceutical, Inc.*, 417 F.3d 1369 (Fed. Cir. 2005), the Federal Circuit affirmed a district court’s ruling that Pharmacia’s 368 patent, covering the glaucoma medication Xalatan®, was unenforceable due to inequitable conduct.

During prosecution of the 368 patent, claims covering the “17-phenyl compound” were rejected as obvious over the prior art Ueno

patent which disclosed a group of compounds including the 17-phenyl compound. Pharmacia argued that the Ueno patent actually preferred the “20-ethyl compound” and did not appreciate the benefits of phenyl-substituted compounds, such as the 17-phenyl compound. Pharmacia submitted a declaration stating that, at a dose of 5mg, the 17-phenyl compound shows a statistically significant decrease in intraocular pressure [IOP], while the 20-ethyl compound does not. The declaration also stated that, even at doses of 45ug, the 20-ethyl compound does not cause a statistically significant decrease in IOP.

This latter statement conflicted with an article co-authored by the declarant which was not submitted to the USPTO. Further, the declarant had never tested a 5mg dose of the 20-ethyl compound. In affirming the district court’s finding of inequitable conduct, the Federal Circuit agreed that intent to deceive could be inferred because of the high materiality of the misleading declaration and statements and the failure to submit the directly conflicting article.

These decisions underscore the caution one must exercise when presenting any arguments of advantages of a claimed invention to prior art.



Tom Kim is an associate at the firm, specializing in patent prosecution and counseling. He received his B.S. in Chemistry from Georgia Institute of Technology, his M.S. in Biochemistry from the University of Illinois, and his J.D. from Washington University. Tom is registered to practice before the U.S. Patent and Trademark Office.

On July 12, 2005, the Court of Appeals for the Federal Circuit issued its highly anticipated decision in *Phillips v. AWH Corp.* The Court's *en banc* decision addresses the procedure by which patent claims are to be interpreted, including the tools to be used, such as the "intrinsic evidence" (the patent specification itself and its prosecution history) and the "extrinsic evidence" (such as dictionaries and expert testimony). We share the following "Ode to Phillips" sent to us by a friend of the firm.

Claim Construction – A Poetic Farce

By John L. Smith, Ph.D.

When trying to make out the hard words, of the contested claims in a suit
It's now better to look to the inside, than to rely on low-hanging fruit.

For three years we've been using the big books, to help us know what the words mean
Starting now, we'll refer to the other words, that are used front, back, and in between.

Said J. Linn in 2002 "Use all of the sources you have (as long as your quarters hold out)
Don't worry that they might be extrinsic, they're the best for avoidance of doubt."

In *Phillips*, J. Bryson decided, that they had earlier been much too frank
In using the tomes for defining the words, at least said nine of twelve *en banc*.

The Court has now held that the meaning is best, sensed from specification
Than from the outside extrinsic sources, no matter what their education.

We can use all the claims, because they're intrinsic, and so is the history
But don't dare to consult Webster (or Britannica); they can no longer resolve any mystery.

If experts are so unreliable, if they shouldn't be heard from at all,
It's hard to imagine the path, by which the court now can best make the call.

Unless judges become geeks or scientists, they may have a challenge ahead
How will they get some understanding, of what the words meant that were said?

I guess we'll need to construct us an android, which can best represent from the start
What words inventors used meant, when heard by "one of skill in the art."

John Smith is Sr. Vice-President and CTO of Fovioptics, Inc. in Santa Clara, CA and has testified on the state of the art at Markman hearings. His poem is reprinted with his permission and does not necessarily represent the views of Woodcock Washburn LLP – but we love it!

Woodcock Washburn Expands to Atlanta

Woodcock Washburn is pleased to announce its expansion to the Southeast! Partner Wendy Choi and Of Counsel Larry Aaronson have moved to Atlanta to open our new office. Christopher M. Arena has joined the new office as partner, and Eduardo M. Carreras has joined the office as Of Counsel. All four of these lawyers bring experience as in-house corporate counsel to their positions.

Wendy Choi focuses her practice on complex patent prosecution for clients in the chemical, pharmaceutical, medical devices, and biotechnology industries. Prior to joining Woodcock Washburn, Wendy served as senior patent counsel for Rohm & Haas, a Philadelphia-based chemicals manufacturer, where she was responsible for developing and implementing IP strategy for the corporation's polymers line of business.

Larry Aaronson is primarily involved in patent procurement, portfolio management and client counseling in the electrical engineering and computer science areas. He returned to Woodcock Washburn, where he was an associate from 1997 to 2000, after serving as in-house counsel for Motorola's Broadband Communications Sector.

Chris Arena was previously Chief Intellectual Property Counsel for Cingular Wireless where he was responsible for all aspects of intellectual property for Cingular, including counseling, mergers and acquisitions, litigation, patent and trademark preparation and prosecution. He was formerly Chief Patent Counsel with BellSouth Corp. and a founding officer of the BellSouth IP Group of companies.

Ed Carreras is the former Chief Intellectual Property Counsel of The Coca-Cola Company where he managed the patent and trademark functions and a team of eleven attorneys.

Contact information for the new office is:

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Chambers USA: Woodcock #1 IP Firm in Pennsylvania

For the third year in a row, Woodcock Washburn has been recognized as the top firm for intellectual property in Pennsylvania in the Chambers USA Guide to America's Leading Business Lawyers 2005. Additionally, partners Dale Heist, John Donohue, Dianne Elderkin, and Steve Rocci were singled out as leading intellectual property attorneys in the state.

Woodcock Partners Named Pennsylvania "Superlawyers"

For a second year in a row, a number of Woodcock partners - John P. Donohue, Jr., Michael P. Dunnam, Dianne B. Elderkin, Dale M. Heist, Gary H. Levin, Lynn A. Malinoski, Lynn B. Morreale, Barbara L. Mullin, Henrik D. Parker, Steven J. Rocci, and Steven B. Samuels - have been named Pennsylvania Super Lawyers for 2005. The "SuperLawyer" distinction is bestowed on only five percent of Pennsylvania lawyers. In addition, Dianne Elderkin was named a Top 50 Pennsylvania Female Super Lawyer.

The Best Lawyers In America

Woodcock Washburn is pleased to announce that eight of its attorneys have been listed among The Best Lawyers in America 2005-2006®. The honorees are partners John Donohue, Dianne Elderkin, Dale Heist, Gary Levin, Lynn Malinoski, Rik Parker, Steve Rocci, and Steve Samuels.

Published by Woodward/White, Inc., The Best Lawyers in America is widely regarded as the leading referral guide to the legal profession in the United States. The Best Lawyers lists are compiled through an exhaustive peer-review survey in which thousands of top lawyers in the country confidentially evaluate their peers.

Official Results Are In

Woodcock Recognized as a “Best Place to Work”

The Philadelphia Business Journal named Woodcock Washburn as one of its Best Places to Work in the Philadelphia region. Woodcock was selected as one of fifteen winning firms and companies in the Philadelphia region, from among hundreds of entrants. Winners were selected on the basis of online surveys completed by employees. Common themes among top companies focused on work-life balance; respect and caring for employees; recognition of accomplishments; feeling empowered; good teamwork and commitment to community.

Team Woodcock (East) is Fast

In an unprecedented show of speed Team Woodcock tied with Hecker Brown for first place in the Philadelphia Bar Association’s 26th annual charity run. Official results show that Woodcock tied for first in a field of 45 teams!

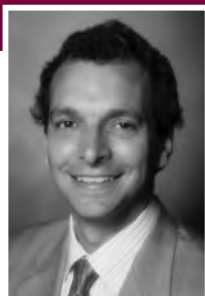
Team anchor and age group winner Jane Inglese beat her closest competition by 3 minutes with a time of 19:53. Dave Marcus turned in a blistering 20:42, and the rest of the team - Tom Kim, Leslie Aberman, Joe Lucci, and Steve Timmins - all came in under 24:07.



Pictured left to right: David L. Marcus, Jane E. Inglese, Joseph Lucci, Stephen C. Timmins, Leslie E. Aberman

Woodcock Washburn Announces New Partner, Of Counsel & Associates

New Partner



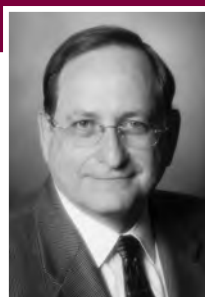
Christopher M. Arena

carena@woodcock.com

Christopher M. Arena joins Woodcock's Atlanta Office, specializing in counseling, mergers and acquisitions, litigation, patent and trademark prosecution. Prior to joining Woodcock, he was Chief Intellectual Property Counsel for Cingular Wireless.

Before that, Chris was Chief Patent Counsel with BellSouth Corp. and a founding officer of the BellSouth IP Group of companies. Chris earned his J.D. from George Mason University and his B.S.E.E. from the University of Notre Dame. He is licensed to practice in Pennsylvania and before the United States Patent and Trademark Office.

New Of Counsel



Eduardo M. Carreras

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Eduardo M. Carreras joins Woodcock's Atlanta Office. He is the former Chief Intellectual Property Counsel of the Coca-Cola Company, where he managed the patent and trademark functions. Ed earned

his J.D. from the University of Miami. He also earned a M.Sc. in aeronautical engineering from the Air Force Institute of Technology and a B.S. in mechanical engineering from the University of Miami. He is licensed to practice in Florida and Georgia and before the United States Patent and Trademark Office.



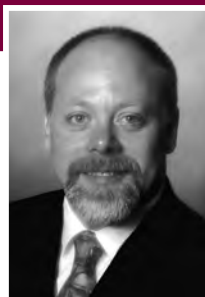
Michele K. Herman

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Michele K. Herman has rejoined Woodcock Washburn, in its Seattle Office, after having left in 1997 to join Microsoft. At Microsoft, Michele initially held the title of Corporate Attorney, Patent Department, where she supported the Consumer Platforms Division. Subsequently, Michele formed and led a legal team specializing in industry stan-

dards-related issues, and was made Senior Director of Intellectual Property Strategy. By the time of her departure from Microsoft, Michele was Associate General Counsel in Microsoft's Intellectual Property and Licensing Group. At Woodcock Washburn, Michele specializes in legal matters relating to industry standards and open source software. Michele earned her BSEE and JD degrees from Rutgers University.

New Associates



Scott E. Scioli

scioli@woodcock.com

Scott E. Scioli joins the firm as an associate in the Philadelphia office. Scott is a 2005 graduate of Rutgers School of Law-Camden. He graduated with high honors and maintained the highest grade point average in the evening division and has recently taken the Pennsylvania Bar exam. He received his B.S. in Microbiology from Michigan State

University in 1979 and in 1980 earned his B.S. in Food Science and Human Nutrition from Michigan State. Scott also earned an M.S. in Food Science and Technology from the University of Nebraska.

While pursuing his J.D. degree, Scott worked at Woodcock Washburn as a scientific advisor. Scott has recently taken the Pennsylvania Bar exam and is registered to practice before the United States Patent and Trademark office.



Loretta W. Weathers

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Loretta W. Weathers joins Woodcock as a 2004 *cum laude* graduate of the University of Pennsylvania Law School. She received her B.S. with *high honors* in Physics from Michigan State University and completed graduate studies in Plasma Physics at MIT. Loretta was also a research assistant at the National Superconducting Cyclotron

Laboratory in Michigan and a Quality Systems Manager at Blue Ridge Pressure Castings in Pennsylvania.

Loretta just completed a one year clerkship with Judge Raymond C. Clevenger III for the Court of Appeals for the Federal Circuit in Washington D.C. Loretta is admitted to practice in Pennsylvania and the Federal Circuit. She is also registered to practice before the United States Patent and Trademark Office.



Stephanie A. Barbosa

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Stephanie A. Barbosa is a 2005 graduate of Rutgers School of Law–Camden. Stephanie graduated with highest honors and maintained the highest grade point average of all students, day or evening. She received a Ph.D. in Organic Chemistry from the University of Pennsylvania and a B.A. in Chemistry from Rutgers University. While pursuing her

degrees, Stephanie worked at a number of academic institutions and corporations in the Philadelphia region. For two years prior to law school and during her first year of law school, Stephanie was a research investigator at Bristol-Myers Squibb.

Stephanie has recently taken the Pennsylvania Bar exam and is registered to practice before the United States Patent and Trademark Office. She is also a certified mediator for New Jersey courts.



Bryan T. Giles

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Bryan T. Giles is a 2005 graduate of Temple University's James E. Beasley School of Law. He received his B.S. in Electrical Engineering from Drexel University. After receiving his undergraduate degree, he was a field engineer for Northrop Grumman and

then went on to be a manufacturing engineer for Ford Motor Company. Immediately prior to law school, Bryan was a current product/team leader for Philips Medical Systems.

Bryan has recently taken the Pennsylvania Bar exam.



Sergio F. Chung

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Sergio F. Chung is a 2005 graduate of Boston University School of Law. He received a B.S. in Mechanical Engineering from the Massachusetts Institute of Technology. While at MIT, Sergio was a

research assistant in the Civil Engineering Department, and, for three years before law school, he was an associate at a prior art search firm in Boston.

Sergio has recently taken the Pennsylvania Bar exam.

Woodcock Washburn Welcomes Summer Associates



Woodcock Washburn welcomed eight Summer Associates to the firm this summer. Pictured with firm founder Robert B Washburn are:

(seated from left to right) **Sean C. Brock**, BA, Biology; Florida State University, 1996; Ph.D., Microbiology and Immunology; Vanderbilt University of Medicine, 2003; JD candidate, University of Tennessee, 2007; **Joshua C. Sanders**, BS, Chemistry; Merrimack College, 1999; MS, Chemistry; University of Virginia, 2002; JD candidate, Villanova University of Law, 2006.

(standing from left to right) **Ruben H. Munoz**, BS, Chemical Engineering; Louisiana State University, 1994; MS, Mechanical Engineering; Louisiana State University, 1997; JD candidate, University of Pennsylvania, 2007; **John F. Murphy**, BS, Chemical Engineering; Cornell University, 1999; MS and Ph.D., Chemical Engineering; California Institute of Technology, 2001; JD candidate, Harvard Law School, 2007; **Robert B. Washburn**; **Hilary A. Reinhardt**, BS, Computer Engineering; University of Cincinnati, 2003; JD candidate, Indiana University, 2006; **Jake W. Soumis**, BS, Mechanical Engineering; University of Michigan, 2003; JD Candidate, Franklin Pierce Law Center, 2006; **Michael A. Koptiw, Jr.**, BS and MS Electrical Engineering; Stevens Institute of Technology, 1999; JD candidate, Rutgers School of Law–Camden, 2006.

(not pictured) **Andy M. Han**, BS, Mechanical Engineering; University of Washington; MS, Electrical Engineering; San Jose State University; MBA, University of California— Berkeley; JD candidate, Seattle University School of Law, 2007.



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