



Intellectual Property Law Section

State Bar of Texas

Spring 2013

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Update From The Chair

By Scott Breedlove

Welcome to our Section's latest newsletter!



Scott Breedlove

Our newsletter has become a valuable tool to help the Texas IP bar stay connected. In that vein, it would do us well to remember those who have contributed greatly to the bar and have passed away recently. So in this issue of the newsletter, we honor Genie Hansen, Bill Shull, and Loren Helmreich. We can find much inspiration in these lives well-lived.

This newsletter will also report on our latest CLE program, the Advanced Intellectual Property Course held in Austin on February 14-15. Vice Chair Kristin Jordan Harkins was the Course Director for this advanced program, which was preceded by a February

13 half-day workshop focusing on strategy under the AIA. And in conjunction with the program, the Women in IP Committee hosted The Third Annual Women in IP Law Breakfast, featuring guest speaker Linda Bray Chanow, Executive Director of the Center for Women in Law at the University of Texas School of Law.

Coming up next month we have our State Bar Annual Meeting IP program in Dallas. I'm particularly excited to see who will receive the Inventor of the Year Award and the Women and Minorities Scholarships at the business meeting luncheon. It is always fun to learn about the recipients' backgrounds and to hear from them directly. And now for the big announcement: at the Annual Meeting this year, we will give the Section's first Lifetime Achievement Award! Don't miss the CLE program or the ticketed lunch meeting this summer. Chair Elect Paul Morico has put together a quality event.

And patent litigators, don't miss the

Advanced Patent Litigation Seminar, which this year will be in July in the mountains around Albuquerque. Bring your family on this trip. You will appreciate the speakers that Shannon Bates and Steve Malin have lined up, and your family will appreciate everything else.

Finally, to the meat of the newsletter. In this edition, Greg Hasley explains the Patent Office's new professional conduct rules and highlights differences with the Texas disciplinary rules; and Peter Corcoran looks at revealing appellate statistics that provide insight into Eastern District patent litigation. Good stuff all around.

Now, a question to end on: Are you active on a committee yet? Log in to <http://texasbarilaw.org/committees>. Adios!



Mark Your Calendar

The State Bar of Texas Annual Meeting will be held at the Hilton Anatole Hotel in Dallas on June 20-21, 2013. For more information, go to www.texasbarcle.com.

State Bar of Texas Intellectual Property Law Section

- A full day CLE will be held during the State Bar of Texas Annual Meeting at the Hilton Anatole Hotel in Dallas on June 21, 2013. The annual business meeting and awards presentation will be held during the luncheon. A reception will be held the prior evening on June 20, 2013.

- The 9th Annual Advanced Patent Litigation CLE will be held on July 25-26, 2013 at the Hyatt Regency Tamaya Resort and Spa in Santa Ana Pueblo, New Mexico.

For more information regarding the IP Law Section CLE events, go to www.texasbarcle.com.

Austin Intellectual Property Law Association

- The May CLE lunch will be held at the Westwood Country Club in Austin on May 21, 2013 beginning at 11:30 a.m.
- The June CLE lunch will be held at the Westwood Country Club in Austin on June 18, 2013 beginning at 11:30 a.m.

For more information, go to www.austin-ipla.org.

The American Intellectual Property Law Association 2013 Spring Meeting will be held at The Westin in Seattle, Washington on May 1-3, 2013. For more information, go to www.aipla.org.

The International Trademark Association will host its 135th Annual Meeting at the Omni Dallas Hotel and Dallas Convention Center in Dallas on May 4-8, 2013. For more information, go to www.inta.org.



In The Section

In Memoriam

William Erwin “Bill” Shull, a beloved and respected member of the Houston Intellectual Property community, passed away on January 2, 2013. Bill graduated from the University of Houston, Bates School of Law in 1977. He then began his career as an IP attorney with Butler Binion, where he made partner. Bill was a founding partner of Conley, Rose & Tayon, where he practiced until 1993. Bill then joined Halliburton and served as its Chief Patent Counsel for nearly 20 years. Bill will be remembered for his professionalism and contributions to the Houston IP community. He warmly engaged others with his gentle spirit and keen sense of humor. Those fortunate to have worked with Bill will forever cherish his friendship.

Eugenia “Genie” Hansen, respected member of the Dallas IP bar, passed away on October 29, 2012. Genie held bachelor's and master's degrees in biochemistry from Texas A&M University, and she graduated from the University of Houston, Bates School of Law in 1984. Genie began her career as an IP attorney with Richards, Medlock & Andrews, which later merged with Sidley, Austin, Brown & Wood, where she was a partner. In 2005, Genie partnered with Scott Hemingway to form the IP boutique of Hemingway and Hansen in

Dallas.

Genie was involved in many different professional organizations, where she was an effective leader, role model, mentor, and friend to many in the profession. She had an unwavering passion and commitment to the State Bar IP Section, where she served in nearly every leadership role, including Chair of the Section. Genie will be remembered for her selflessness, quiet strength, innovative mind, and passion for excellence. Those who had the privilege of knowing Genie will never forget her many contributions.

Loren George Helmreich, respected member of the Houston IP bar, age 62, passed away on January 1, 2013, at the age of 62. Loren was born in Bay City, Michigan to Erwin and Betty Helmreich. He was a graduate of [General Motors](#) Institute in Flint, Michigan with a degree in mechanical engineering, and received his law degree from Detroit College of Law. At the time of his death, Loren was practicing Intellectual Property Law at the firm of Streets and Steel. Loren will be missed by his colleagues in the IP bar.

If you know of an intellectual property lawyer who recently passed away and would like to submit a one or two paragraph “In Memoriam” article for publication in the newsletter, please email your submission for consideration to Newsletter@texasbariplaw.org.

Texas Inventor of the Year Nominations

The 2013 Texas Inventor of the Year will be recognized at the IP Law Section lunch during the Annual Meeting of the State Bar of Texas in Dallas on June 21, 2013. Please use the attached form, which includes five sections, to submit nominations for the 2013 Texas Inventor of the Year. Nominations are due by May 15, 2013. The Inventor Recognition Committee will select the winner based primarily upon the responses in Section III.

Call for Submissions

The IP Section Newsletter is a great way to get published! The Newsletter Committee welcomes the submission of articles for potential publication in upcoming editions of the IP Law Section Newsletter, as well as any information regarding IP-related meetings and CLE events. If you are interested in submitting an article to be considered for publication or add an event to the calendar, please email your submission to Newsletter@texasbariplaw.org.

Article Submission Guidelines:

STYLE: Journalistic, such as a magazine article, in contrast to scholarly, such as a law review article. We want articles that are current, interesting, enjoyable to read, and based on your opinion or analysis.

LENGTH: 1-5 pages, single spaced.

FOOTNOTES AND ENDNOTES: Please refrain! If you must point the reader to a particular case, proposed legislation, Internet site, or credit another author, please use internal citations.

PERSONAL INFO: Please provide a one-paragraph bio and a photograph, or

approval to use a photo from your company or firm website.

If you have any questions, please contact Indranil Chowdhury, Newsletter Officer, at ichowdhury@cgiplaw.com.

Section Member Profiles

The State Bar of Texas Intellectual Property Law Section has over 2000 members and the Newsletter Committee is eager to get to know each of you! To this end, each newsletter will publish the profiles of one or two members providing information on where the member works, their practice area, interests and other fun facts! If you are interested in being profiled, send an email to the Newsletter Committee at Newsletter@texasbariplaw.org and we will email you a questionnaire.

26th Annual Advanced Intellectual Property Law Course Report

The 26th Annual Advanced Intellectual Property Law Course was held February 14-15, 2013 in Austin at the Four Seasons Hotel. We were fortunate to have solid CLE sessions from which to choose, and below are reports on three of the CLE presentations:

Section 101 Challenges in Patent Litigation:

Mr. Thomas M. Morrow of Yetter Coleman outlined the variety of issues which currently surround § 101 jurisprudence. Two Supreme Court cases have been heard in the past three years and one more has been granted cert. The discussion noted that historically, courts have decided §102, 103 and 112 issues before considering § 101. However, recently multiple trial courts have considered § 101 issues as an initial inquiry.

Current jurisprudence is generally centered on defining the exceptions to patentable subject matter, e.g., what constitutes a law of nature, mental process, or abstract idea. The presentation discussed cases addressing these areas and concluded that the law continues to be open for interpretation. Mr. Morrow provided strategies and practice pointers to address the current landscape.

High Stakes for Trade Secret Theft:

Mr. Andrew Yung of Yung Keithly, LLP gave a presentation on the current legal framework for handling trade secret theft. This included discussing methods of how misappropriation may occur and remedies after misappropriation has been shown. Texas-specific laws and the federal Economic Espionage Act were discussed along with recent case law on these topics. Tips and strategies regarding obtaining competitive intelligence were also provided.

Ethical Considerations in Practice Before the PTO in Prosecution and Post Grant Proceedings:

Mr. William Covey from the USPTO provided an excellent presentation on current happenings within the Office of Enrollment and Discipline of the Patent Office. A discussion of the recently proposed updates to the USPTO Rules of Professional Conduct, which harmonize the PTO rules with the ABA model rules, was provided. It was noted that OED was not trying to significantly modify procedures for practice in front of the Patent Office, nor were they adding continuing legal education reporting requirements or adding bar fee requirements. Rather, the USPTO is undertaking efforts to update rules and practice expectations to reflect changing circumstances which have come about with the passage of time and the advent of new technology.



Nathan Rees is an attorney with Fulbright & Jaworski. Mr. Rees generally handles patent prosecution matters in the electrical and mechanical arts and also specializes in handling reexamination and other post-grant proceeding matters. Mr. Rees is also the current chair of the Patent

Legislation/USPTO practice committee of the SBOT IP section.

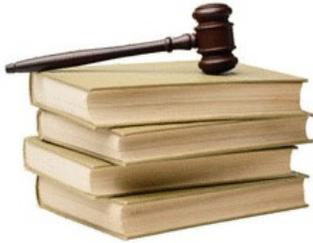
The above article expresses the view of the author and not necessarily that of the State Bar of Texas IP Law Section.



The Water Cooler

Attorneys On The Move

Are you moving from one firm or corporation to another and would like your friends and colleagues in the intellectual property bar to know about your move? Then send an email to Newsletter@texasbariplaw.org.



Practice Points

USPTO Adopts New Rules of Professional Conduct

By Gregory M. Hasley and Jennifer A. Hasley

The United States Patent and Trademark Office announced the adoption of a new set of professional conduct rules for lawyers and agents that practice before the USPTO. The USPTO Rules of Professional Conduct (“USPTO Rules”), which take effect on May 3, 2013, are based upon the American Bar Association’s Model Rules of Professional Conduct (“Model Rules”). The USPTO’s stated goal is to bring the standards of ethical practice into closer conformity with state ethical rules, at least as much as possible given that each state tends to modify the Model Rules. While the adoption of these rules has generally been viewed as a positive step, there have been several criticisms of the new USPTO Rules. Also, since there are significant differences between the Texas Disciplinary Rules of Professional Conduct (“Texas Rules”) and the Model Rules, Texas patent lawyers must consider two distinct sets of professional conduct rules for guidance.

One advantage of adopting the new rules is that while the USPTO Rules, the Model Rules, and the Texas Rules are all somewhat different, they do have the same basic format and similar numbering systems. The USPTO Rules are generally of the form 11.xxx, where the xxx is comparable to the

Texas Rules and the Model Rules numbers. For example, USPTO Rule 11.102, Texas Rule 1.02, and Model Rule 1.2 are all comparable rules related to scope of representation. There are some Texas Rules that do not line up directly, but for the most part, the numbering is consistent. While this formatting is not perfect, it does allow a Texas patent lawyer to quickly compare the obligations under the different sets of rules.

An advantage cited by the USPTO is that adoption of the USPTO Rules provides a large body of state case law and opinions written by disciplinary authorities for the states that have adopted the Model Rules. The USPTO also directs practitioners to the Model Rules comments for useful information on how to interpret the USPTO Rules. While this may be perceived as a valued benefit, the USPTO has made clear that the comments to the Model Rules and other jurisdictions’ interpretations of their counterparts to the Model Rules are not binding precedent for the USPTO Rules. The USPTO expects that its own precedent will be developed over time.

Despite the similarities between the USPTO Rules and the Model Rules, the USPTO did make many changes to address the nuances of practicing before the USPTO. Initially, the USPTO did not adopt rules that are specific to other practice areas such as criminal or family law. Also, rules that may be controversial to some, such as the Model Rule 1.8(j) regarding sexual relations with clients rule and Model Rule 1.2(b) regarding non-endorsement of client’s views, have been eliminated.

Another major difference between the Model Rules and the USPTO Rules is that the USPTO Rules are directed to both lawyers and patent agents. The USPTO Rules use the term “practitioner” throughout in lieu of the term “lawyer.” Under USPTO Rule 11.1,

practitioner is specifically defined to include non-lawyer patent agents. This² leads to an awkwardness in many rules. For example, USPTO Rule 11.504(a) says “a practitioner or law firm shall not share legal fees with a non-practitioner” except in certain circumstances. To the extent this rule suggests that patent lawyers can share fees with patent agents (who would not be excluded by this rule), the counterpart Model Rule 5.4 and Texas Rule 5.04 make clear that “a lawyer or law firm shall not share legal fees with a non-lawyer” which would specifically exclude patent agents. Similarly, 11.504(b) and (d) prohibit formation of partnerships and professional corporations with non-practitioners (again not excluding patent agents), while the Model Rule and Texas Rule counterparts make clear that the prohibition extends to all “non-lawyers” which would include patent agents.

The blurred distinction between practitioner and lawyer also complicates the traditional conflicts of interest and imputation of conflicts analysis of law firms. Conflicts for patent agents might be analyzed as a non-lawyer conflict under the Texas Rules or Model Rules, both of which impute conflicts only from lawyer to lawyer (see example Model Rule 1.10 and Texas Rule 1.06(f)). But, under USPTO Rule 11.110, a patent agent’s conflicts are imputed to the lawyers and other agents in a firm. While in many circumstances the results may work out the same, Texas patent lawyers should take special care to analyze potential conflicts involving patent agents, and additional client notice, waivers, etc. may be required depending upon the circumstances.

The major public complaint about the new USPTO Rules relates to an exception to confidentiality of information found in USPTO Rule 11.106. Rule 11.106(a) prohibits a practitioner from revealing information related to the representation, unless the client has given informed consent or the disclosure is impliedly authorized in order to carry out the representation. Rule 11.106(b) provides a list of specific circumstances in which a practitioner may disclose information related to the representation. These two provisions closely match the Model Rule 1.6, except additional permissive exceptions have been added to allow disclosure to prevent or rectify a client’s inequitable conduct before the USPTO. Texas Rule 1.05, the comparable Texas confidentiality rule, while structured differently and more specifically detailed, has the same general prohibition with enumerated exceptions when the lawyer may disclose confidential information.

The USPTO Rule deviates from the Model rule by adding provision (c) which requires that “a practitioner shall disclose to the Office information necessary to comply with applicable duty of disclosure provisions.”

That is, duty to disclose solidly trumps client confidentiality. The Model Rule has no such provision requiring disclosure of confidential information and generally recognizes the paramount importance of confidentiality in the lawyer client relationship.

The Texas Rule 1.05(e) similarly provides a mandatory disclosure of confidential information for Texas lawyers, but is this mandatory obligation is limited to information

The USPTO Rules of Professional Conduct, which take effect on May 3, 2013, are based upon the American Bar Association’s Model Rules of Professional Conduct. The USPTO’s stated goal is to bring the standards of ethical practice into closer conformity with state ethical rules...

clearly establishing that a client “is likely to commit a criminal or fraudulent act that is likely to result in death or substantial bodily harm to a person.” That is, the USPTO Rules roughly equate the duty of disclosure to the death or substantial bodily harm of the Texas Rule.

Responding to the numerous critical comments of this new mandatory disclosure requirement, the USPTO argued that this addition is not a change from the current USPTO Code of Professional Responsibility (USPTO Code). Despite this argument, the USPTO Code Section 10.57 specifically deals with client confidential information and has no mandatory requirement. The USPTO correctly points out that USPTO Code 10.23(c)(10) does say it is a violation to knowingly violate the duty of disclosure, but at best, this indicates a conflict in the USPTO Code. There was clearly no exception to confidentiality that require a mandatory disclosure.

The USPTO also suggests that in some circumstances, USPTO 11.116 allows for a practitioner to withdraw as a solution to the situation when a practitioner learns of information from one client that might be relevant to the duty to disclose in another client’s application. Rule 11.116 does set out circumstances that allow withdrawal, but there is nothing specific regarding obtaining confidential information from one client that is relevant to the duty to disclose in another client’s case. Also, it is not at all clear that a withdrawal satisfies a practitioner’s duty to disclose information obtained during the representation. Hopefully, the USPTO will clarify at some point whether withdrawal can satisfy the duty of disclosure. Interestingly,

the comments to Texas Rule 1.05(e) specifically state that withdrawal of the attorney satisfies the mandatory disclosure requirement.

The USPTO [client confidentiality] Rule deviates from the Model rule by adding provision (c) which requires that “a practitioner shall disclose to the Office information necessary to comply with applicable duty of disclosure provisions.” That is, duty to disclose solidly trumps client confidentiality.

One other anomaly in the USPTO Rules allows a practitioner to take an interest in a patent or patent application to satisfy his fee. USPTO Rule 11.108(i)(3) says that in a patent case or a proceeding before the Office, the practitioner may “take an interest in the patent or patent application as part of or all of his or her fee.” There is no direct

counterpart to this rule in the Model Rules or the Texas Rules. While one might argue that under certain circumstances spelled out in Texas Rule 1.08(a), this type of arrangement may be allowed, it seems to be a particularly bad idea given the potential for conflict with the client. There is certainly concern that the standard practitioner's engagement letter could add a provision assigning a patent application upon non-payment of bills, which would be allowable under this provision, but potentially damaging to the reputation of practitioners in general.

As is generally well known to Texas attorneys, there are substantial differences between the Texas Rules and the Model Rules. These differences are carried over into the USPTO Rules. In certain circumstances, the Texas Rules are more permissive than the USPTO Rules. For example, in the realm of conflicts, the Texas Rules more broadly permits waiver of conflicts. In other circumstances, the Texas Rules can be more narrow than the USPTO Rules. For example, the Texas Rules on advertising (the 700 series) are particularly

more narrow and detailed. One particular example of a narrow Texas Rule is the prohibition on use of trade names that is specifically allowable under the USPTO Rules. While there may be significant jurisdictional issues with regard to whether state ethics laws can be applied to a purely patent practice, the safest path for a Texas patent attorney confronted with conflicting rules is to generally subscribe to the more restrictive rule.

Despite these criticisms and differences from the Texas Rules, the USPTO's adoption of the new USPTO Rules seems to be a generally favorable occurrence. Each practitioner should take the time to review the new rules which are available at 78 Fed. Reg. 20180 (Apr. 3, 2013).



Greg Hasley and Jennifer Hasley are attorneys with Hasley Scarano, L.L.P. Greg has a general intellectual property practice that includes prosecution, litigation, and transactional matters. Jennifer is a former assistant disciplinary counsel for the State Bar of Texas and her current practice includes legal malpractice and defending attorneys in disciplinary cases.



The above article expresses the view of the author and not necessarily that of the State Bar of Texas IP Law Section.

A Statistical Review of Patent Appeals from the Eastern District of Texas to the Federal Circuit

Peter J. Corcoran, III

This study, first presented at the Eastern District of Texas Bench and Bar Conference on October 26, 2012, examines the trends of patent appeals and mandamus petitions from the U.S. District Court for the Eastern District of Texas to the U.S. Court of

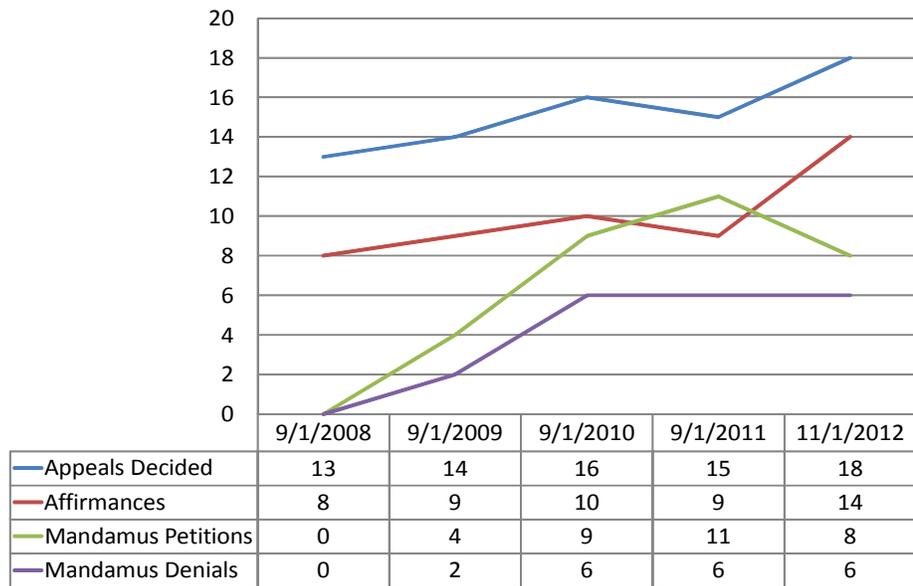
Appeals for the Federal Circuit from September 1, 2008 to November 1, 2012. The study's timeframe begins before the U.S. Court of Appeals for the Fifth Circuit issued *In re Volkswagen of America, Inc.*, 545 F.3d 304, 315 (5th Cir. 2008) (en banc), defining the venue transfer standards for the Fifth Circuit under 28 U.S.C. § 1404(a). Tables 1 to 7 provide the study's objective data, collected using Westlaw® to search for all patent appeals and mandamus petitions from the Eastern District of Texas to the Federal Circuit during the study's timeframe.

Table 1 provides the yearly number of decided patent appeals from the Eastern District of Texas to the Federal Circuit from September 1, 2008 to November 1, 2012. It also provides the yearly number of affirmances and mandamus denials. As seen, the number of patent appeals has steadily risen from thirteen to eighteen appeals. The number of affirmances also rose from eight to fourteen during the same timeframe as the overall number of appeals has increased, resulting in a 62% to 78% affirmance rate during the study's timeframe. The gap between the number of appeals decided and the number of affirmances includes the number of affirmances-in-part/reversals-in-part and full reversals.

Table 1 also shows a decreasing number of mandamus petitions to the Federal Circuit seeking reversal of orders denying motions to transfer venue from the Eastern District of Texas. The table also shows an increasing denial rate of such petitions during the study's timeframe. Until 2011, the number of petitions steadily rose from zero to eleven petitions after the Federal Circuit issued *In re TS Tech*, 551 F.3d 1315 (Fed. Cir. 2008), relying on the Fifth Circuit's venue transfer standards in *In re Volkswagen*. Since September 1, 2011, the number of mandamus petitions decreased to eight petitions, while the number of mandamus

denials since September 1, 2010 held steady at six. From September 1, 2008 to September 1, 2010, the number of mandamus denials rose commensurate with the number of petitions filed, resulting in a 50% to 67% denial rate. In 2011, the Federal Circuit denied 55% of the mandamus petitions filed, while also denying 75% of the petitions filed up to November 1, 2012.

Eastern District of Texas Patent Appeals and Mandamus Petitions in the Federal Circuit 2008-2012



The data in Table 2 shows that by November 1, 2012, the number of plaintiff wins equaled the number of defendant wins at the Federal Circuit. This data includes the number of affirmances, affirmances-in-part, and

Table 1

reversals that favor Eastern District of Texas plaintiffs and defendants. From September 1, 2008 to September 1, 2011, defendants led plaintiffs in the number of victories at the Federal Circuit.

Eastern District of Texas Plaintiff and Defendant Wins in the Federal Circuit 2008-2012

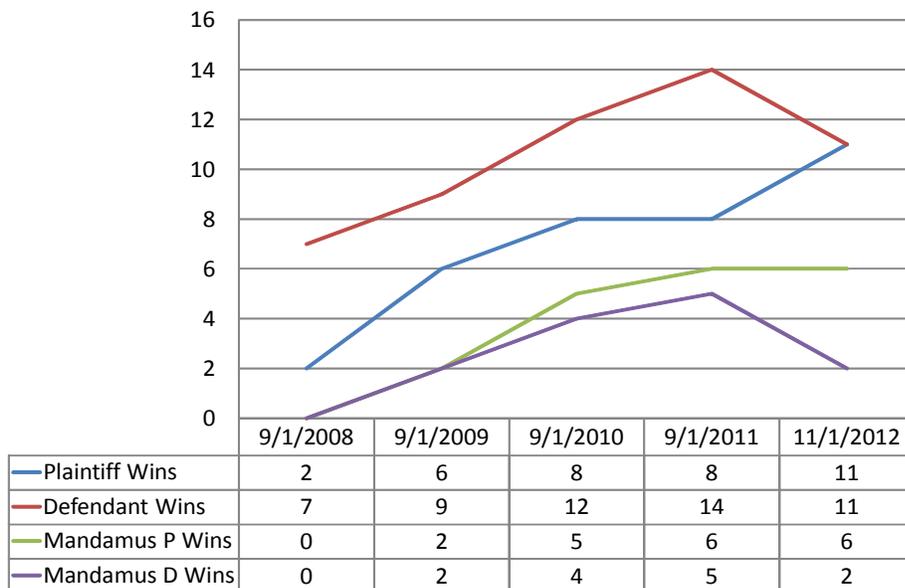


Table 2

Table 2 also shows the yearly number of plaintiff and defendant wins for mandamus petitions to the Federal Circuit during the study's timeframe. The number of plaintiff wins (mandamus denials) and defendant wins (mandamus grants) steadily increased from September 1, 2008 to September 1, 2011, commensurate with the number of petitions filed during that time. During the same timeframe, the number of plaintiff wins

outpaced the number of defendant wins. During 2011 and 2012, the number of plaintiff wins held steady at six, while the number of defendant wins decreased from five to two.

Table 3 provides the ratio of Federal Circuit affirmances under Federal Rule of Appellate Procedure 36 of Eastern District of Texas final judgments from September 1, 2008 to November 1, 2012. Rule 36 affirmances are summary affirmances of lower tribunal final judgments without a written opinion. The Federal Circuit affirms a district court's final judgment under Rule 36 only when the three members of the

Federal Circuit FRAP 36 Affirmances of Eastern District of Texas Patent Appeals 2008-2012

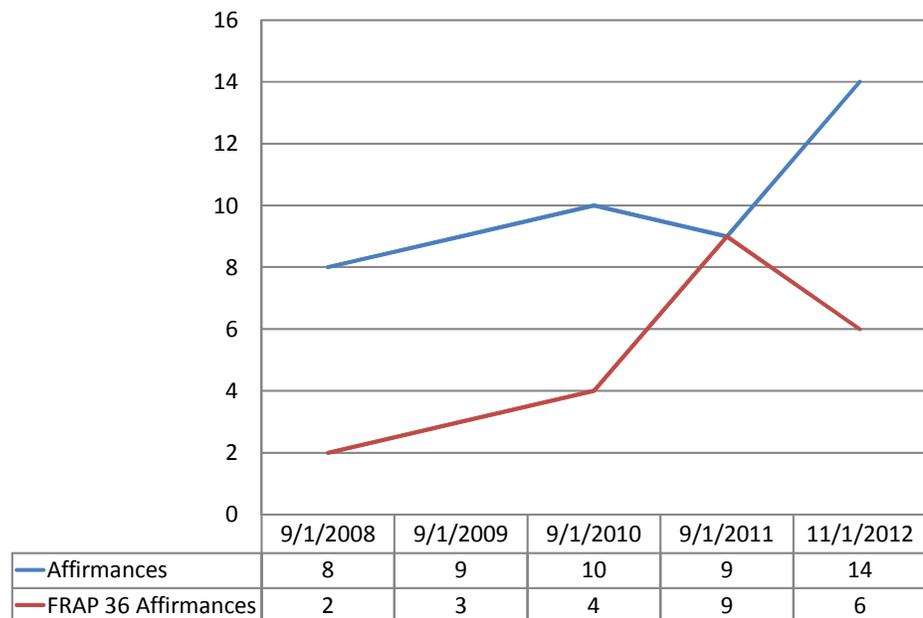


Table 3

appellate panel unanimously agree that the court adequately disposed of the issues appealed and that no further opinion is necessary. From September 1, 2011 to November 1, 2012, the ratio of Rule 36 affirmances was 43%. The ratio of Rule 36 affirmances, however, steadily increased to 100% between September 1, 2010 and September 1, 2011.

Federal Circuit Affirmances of Issues Appealed from the Eastern District of Texas 2008-2012

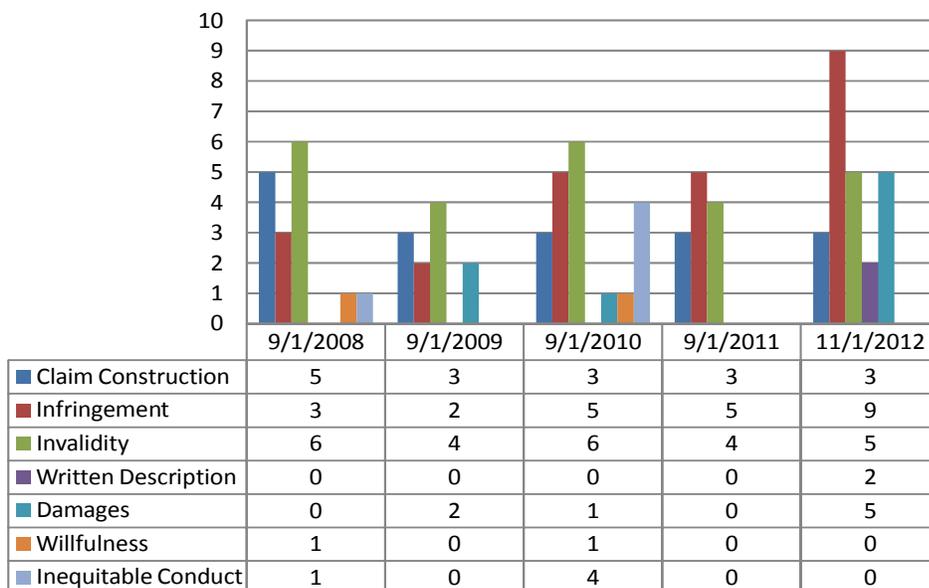


Table 4

Table 4 shows the number of Federal Circuit affirmances by issue appealed from the Eastern District of Texas during the study's timeframe. These issues include claim construction, infringement, invalidity, written description,

damages, willfulness, and inequitable conduct. As seen, the Federal Circuit affirmed an increasing number of infringement issues and affirmed a somewhat constant number of claim construction and invalidity issues from September 1, 2008 to November 1, 2012. The number of Federal Circuit affirmances of written description, damages, willfulness, and inequitable conduct issues varied over the study's timeframe.

Federal Circuit Reversals of Issues Appealed from the Eastern District of Texas 2008-2012

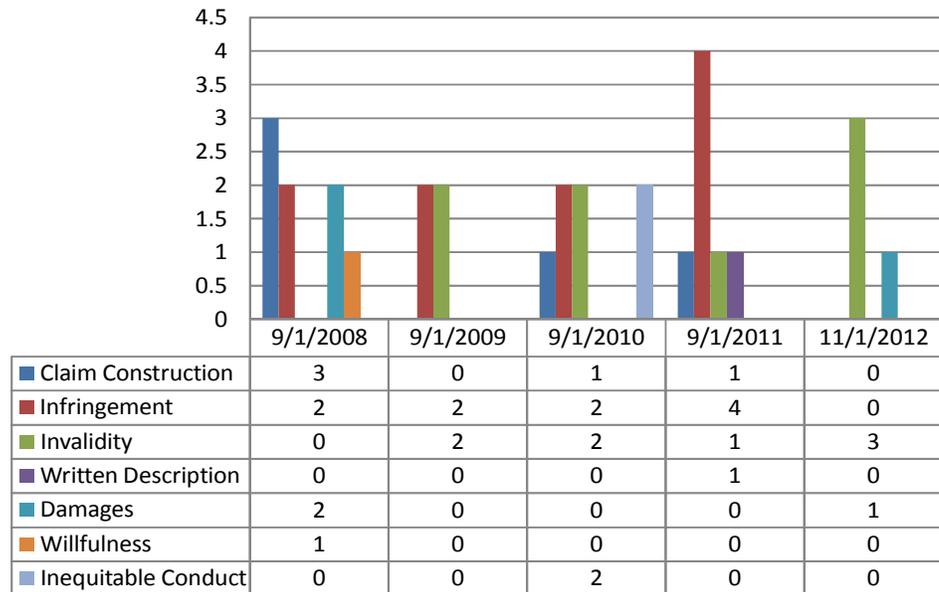


Table 5

Table 5 provides the number of Federal Circuit reversals of the same issues shown in Table 4. As seen, the Federal Circuit reversed an increasing number of

infringement issues until September 1, 2011, while the Court reversed no infringement issues between September 1, 2011 and November 1, 2012. The number of invalidity issues reversed also increased, while the

number of claim construction reversals decreased over the study's timeframe. The number of reversals of written description, damages, willfulness, and inequitable conduct issues varied over the same timeframe. A disparity between Tables 4 and 5 appears to exist; however, the overall number of Federal Circuit affirmances of patent issues was two to three times greater than the number of reversals during the

Federal Circuit Affirmances of Eastern District of Texas Judges 2008-2012

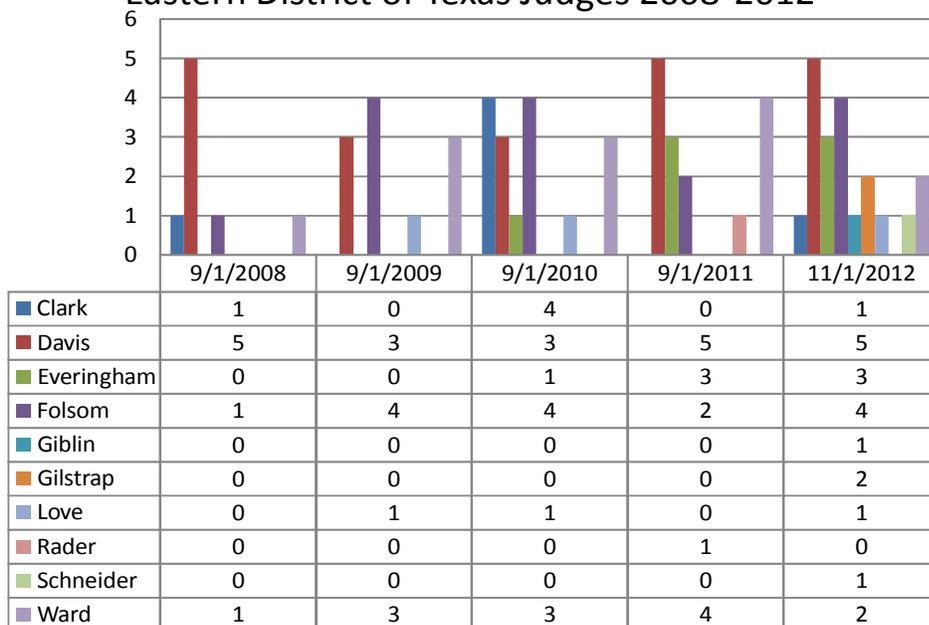


Table 6

study's timeframe.

Table 6 shows the number of affirmances (including Rule 36 affirmances and mandamus denials) of Eastern District of Texas judges between September 1, 2008 and November 1, 2012. Chief Judge Davis had nineteen affirmances, retired Chief Judge Folsom had fifteen affirmances, and retired Judge Ward had thirteen affirmances. Federal Circuit Chief Judge Rader also appears in Table 6 with one affirmance resulting from his sitting by designation in the district in 2010.

Table 7 provides the number of Federal Circuit reversals (including mandamus grants) of Eastern District of Texas judges between September 1, 2008 and November 1, 2012. The number of affirmances in Table 6 outnumbers the number of reversals in Table 7. Some of the mandamus grants resulted from venue transfer orders that relied on both pre-In re Volkswagen and pre-In re TS Tech standards for venue transfer. Since September 1, 2011, the number of mandamus grants has decreased, as shown in Table 2, as venue transfer orders have applied recent Federal Circuit caselaw.

Conclusion

This study provides objective data regarding patent appeals from the Eastern District of Texas to the Federal Circuit. The reader can draw his or her own conclusions from the data. The author will provide updates to

Federal Circuit Reversals of Eastern District of Texas Judges 2008-2012

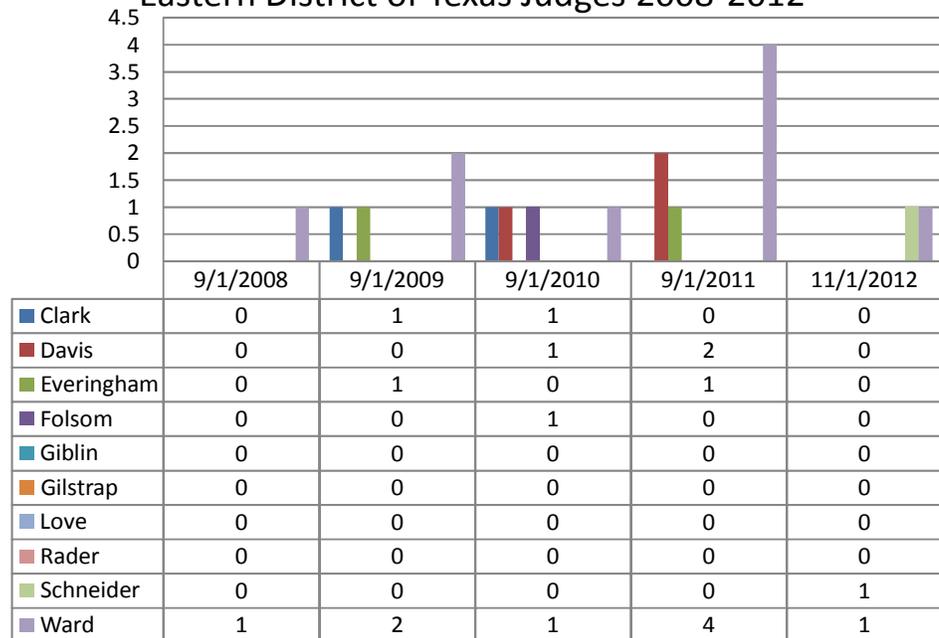


Table 7

this data as the patent docket in the Eastern District of Texas evolves.



Peter Corcoran is a senior associate in the Intellectual Property Practice Group of Winston & Strawn LLP in Houston, Texas. Mr. Corcoran has practiced patent law since 1995 when he first became a patent examiner at the U.S. Patent and Trademark Office. Since then, Mr. Corcoran has focused his practice on all phases of patent law, including patent litigation, trials, appeals, licensing, and prosecution. Mr. Corcoran served as a law clerk to Chief Judge Rader of the U.S. Court of Appeals for the Federal Circuit and retired Chief Judge Folsom of the U.S. District Court for the Eastern District of Texas. Mr. Corcoran holds master's degrees in electrical engineering and intellectual property law and has applied his education and experience towards best serving clients in all technology areas, but especially in the electrical, computer, and software areas. Mr. Corcoran is also a Commander in the U.S. Navy Reserves and has proudly served this great country for over twenty-five years.

The above article expresses the views of the author and not that of Winston & Strawn LLP, its clients, or the State Bar of Texas IP Law Section.

State Bar of Texas, Intellectual Property Law Section

2013 INVENTOR OF THE YEAR

Nomination form

The 2013 Texas Inventor of the Year will be recognized at the Annual Meeting of the State Bar of Texas (SBOT) in Dallas on June 20-21, 2013.

Please use this form, which includes five sections, to submit nominations for the 2013 Inventor of the Year. The Inventor Recognition Committee of the Intellectual Property Law Section (IPLS) of the SBOT will select the winner based primarily upon the responses in Section III. Please insert additional space below, or append additional pages, as needed.

In cooperation with the Austin Intellectual Property Law Association, nominations for inventors from Central Texas will also be considered for the inventor of the year award presented by the Austin IPLA. Please indicate in the background information if you would like your nominee to also be considered for the Austin IPLA award.

Section I. General Instructions

1. Each nomination should be submitted as a single electronic file (e.g., using PDF or Zip format).
2. All nominations are **due by May 15, 2013**. Also, nominators must be IPLS members. Any member may make any number of nominations. Nominations of clients and employees are accepted and encouraged.
3. Please submit all nominations via email to Michelle LeCointe:
michelle.lecointe@bakerbotts.com (Phone: 512-322-2580).

Section II. Background Information

1. Nominee:

Name, business affiliation, and address of nominated inventor:

SBOT - IPLS - Texas Inventor of the Year - 2013 Nomination Form

Year of birth (if known):

2. Either (a) attach a current resume for the nominee, or (b) list the educational accomplishments, career positions, current professional memberships (including offices held), and the nominee's prior awards.

3. List all of the nominee's U.S. patents by number and title (a database printout is sufficient). (Note: only a copy of the patent(s) described in Section III should be attached.)

Section III. Invention(s) forming the Basis of the Nomination

Please append one or more pages with the following information:

1. **Information on the U.S. patent(s) for which the nomination is being made:**

Identify the U.S. patent or patents for which the nomination is being made. Include a detailed description and a brief history of the invention(s). *All nominations must be based on inventions having at least one United States patent.* The committee will consider a nomination based on an invention covered by an existing or even an expired patent.

Append copies of the patent(s) describing the invention(s). Additional visual aids may also be included.

2. **Known litigation, interference, or other proceedings:** Identify any known litigation, interference, or other proceeding that involves or involved the invention(s) or patent(s). The committee will not consider inventions based on patents (a) currently in litigation, re-

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examination, reissue, and interference proceedings, or (b) that have been held unenforceable or invalid.

3. Describe the specific contribution of the invention(s) to society.

4. **Describe the impact the invention has had on Texas commerce.** All nominations must be based on inventions that have significantly impacted the Texas economy. More general impact on the US or world economy may be described, but specific effects on Texas should be included in some fashion.

Section IV. Nominator(s) (Please insert additional space as needed)

1. Name and address of each IPLS member who is nominating the named inventor, including business affiliation.

Name #1:

Bus. Affiliation:

Address:

Email:

Name #2:

Bus. Affiliation:

Address:

Email:

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2. Date of submission of this nomination:

3. Signature(s) of Nominator(s)

Section V. Appendices

Please append copies of the patent(s) describing the invention(s), a current resume (or similar) for the nominee, and any visual aids or other supplementary information below.