

NEWS

Baker Botts New York Hosts Continuing Legal Education Seminar November 10

Maximizing IP Portfolio Value And The Impact Of Knorr-Bremse

Join our New York IP Department on Wednesday, November 10, 2004 for a two-hour seminar providing a comprehensive start-to-finish approach to maximizing profits and minimizing litigation exposure through strategic management of your IP portfolio, as well as an analysis of the recent and important *en banc* decision of the Court of Appeals for the Federal Circuit regarding willful infringement in *Knorr-Bremse v.*

Dana. The presentation will focus on obtaining, managing, and asserting IP assets so as to maximize return on the substantial investment that they represent, as well as on how September's *en banc* decision of the Federal Circuit in *Knorr-Bremse* may affect your strategies with regard to third party patents. Baker Botts IP Department lawyers will draw on their extensive experience providing strategies for effectively and efficiently acquiring and managing IP rights, and for turning these rights into revenue through targeted licensing and litigation programs. They will also discuss the still-important substantive value of patent opinion letters following the Federal Circuit's significant procedural changes, as set forth in the *Knorr-Bremse* decision, to the law of willful infringement and enhanced damages.

Attendees will earn 2.0 hours of New York State CLE credit, including 0.5 hours of ethics credit. The seminar presentation will be followed by a cocktail reception. The seminar will run from 4:00 p.m. to 6:00 p.m., followed by the cocktail reception, at our Midtown New York offices. Please [click here](#) or contact [Toni Gilbert](#) for more information about this CLE opportunity.

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IP SPOTLIGHT: Appellate Representation

[David Wille](#) is a partner resident in the Dallas office. Mr. Wille handles all aspects of intellectual property law including counseling, litigation, portfolio management, opposition, and licensing. He has particular experience handling appellate matters before the Court of Appeals for the Federal Circuit. Most recently, Mr. Wille argued and won a decision before the CAFC in support of an earlier ruling in a patent interference matter. The case addressed the issue of whether laboratory testing of a software business method invention satisfied the requirements for reduction to

BREAKING NEWS

Federal Circuit's *Knorr-Bremse* Decision Marks Significant Changes In Willful Infringement Law, But Patent Opinions Of Counsel May Remain As Important As Ever

by Robert Scheinfeld and John Spaccorotella



[Robert Scheinfeld](#)

[John Spaccorotella](#)

On September 13, 2004, in a [decision](#) that marks a sea-change in the law of willful infringement in a patent case, the United States Court of Appeals for the Federal Circuit overruled its own prior precedents that had allowed adverse inferences to be drawn against those who failed to obtain or produce opinions of counsel condoning the alleged infringing activity. The *en banc* Federal Circuit held for the first time, in an appeal in *Knorr-Bremse Systeme Fuer Nutzfahrzeuge v. Dana Corp.*, that an alleged infringer's failure to obtain or produce a favorable opinion of counsel does not create an adverse inference that an opinion of counsel may have been unfavorable and/or consequently that the alleged infringer behaved improperly.¹

Although the Federal Circuit pointedly reiterated and re-endorsed its prior holdings stating that willful infringement is to be determined by considering the totality of the circumstances, now, in light of *Knorr-Bremse*, this issue will be determined without any adverse inference or presumption that the unproduced or unobtained opinion of counsel may have indicated that infringement was likely.

This article is a substantial reprint of an article appearing in the September 22nd Edition of the New York Law Journal

[Please click here to read the full article.]

MGM v. Grokster: Peer-to-Peer Software Companies Are Free To Operate (For Now)

by David Bell

practice. He has also handled appeals of various other patent matters before the CAFC.

Additionally, Mr. Wille represents clients in a variety of different industries, but has devoted significant time recently to helping clients in the financial services, software and consulting industries protect their software and business methods using patents. In these industries, where traditional intellectual property protection was not previously emphasized, Mr. Wille educates companies on the importance of a formalized and well-managed intellectual property protection program.

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[David Bell](#)

On August 19, 2004, the Ninth Circuit Court of Appeals [ruled](#) that certain online file-sharing software companies are not liable for copyright infringement committed by users of the software. This decision represents another significant obstacle to film and music companies' efforts to combat illegal file sharing on the Internet.¹ Although the result of this case, and other recent precedent relating to file sharing networks, is probably legally "correct" under existing law, it nonetheless poses harsh effects for copyright-owning companies experiencing massive piracy.

[Please click here to read the full article.]

Chamberlain v. Skylink: Federal Circuit Provides Potentially-Controversial Relief From Stringent Digital Millennium Copyright Act Provisions

by Patrick Porter



[Patrick Porter](#)

In a closely watched case concerning the United States Digital Millennium Copyright Act ("DMCA"), the U.S. Court of Appeals for the Federal Circuit has recently affirmed a district court's summary judgment ruling in favor of a manufacturer of a universal garage door opener whose transmitter was able to bypass the access control software used on a competitor's garage door opener. In this case, [Chamberlain Group, Inc. v. Skylink Techs., Inc.](#), No. 04-1118, 2004 WL 1932660 (Fed. Cir. Aug. 31, 2004) (slip op.), the court affirmed that the use of the universal transmitter manufactured by the defendant, Skylink Technologies, was not in violation of the anti-trafficking provisions of the DMCA.

[Please click here to read the full article.]

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