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WHEALAN TO LEAD IP TO NEW HEIGHTS

GW Law’s Intellectual Property Program took a leap forward in May with the appointment of John Whealan as the school’s inaugural associate dean for intellectual property law studies.

By Jamie L. Freedman

A leading figure in Washington’s IP community for nearly two decades, John M. Whealan comes to the Law School from the U.S. Patent and Trademark Office, where he served as deputy general counsel for intellectual property law and solicitor since 2001.

Whealan’s wide-ranging experience in IP policy and litigation spans all three branches of government. “Early in my law career, I was fortunate to clerk for two judges, and I spent the past year serving as counsel to the U.S. Senate Judiciary Committee, where I worked primarily on the Patent Reform Act,” Whealan says. “My diversified career has given me a unique perspective on IP law.”

Growing up in Eastchester, N.Y., Whealan originally did not plan to study law, instead earning a graduate degree in electrical engineering while working for two years as a design engineer for General Electric.

He then was accepted to Harvard Law School, where his career began to take shape.

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JOHN DUFFY ON PATENT ELIGIBILITY

On May 8, Professor John F. Duffy presented oral argument before the U.S. Court of Appeals for the Federal Circuit in In re Bilski, an en banc case that many believe will have a significant impact on the scope of patentable subject matter under Section 101 of the Patent Statute.

The Bilski case presents the issue whether an allegedly new and non-obvious method for hedging costs may be the subject of a patent. The Patent and Trademark Office ruled that such
“In those days, Harvard did not offer patent law classes, but I landed my first summer job at a patent firm and really enjoyed it, since it combines my love of law, science, and technology. The fields are exciting on their own, but when you put them together, I don’t think there’s any better job.”

Whealan worked for a New York patent law firm for a year, and then clerked for Judge James T. Turner of the U.S. Court of Federal Claims and Judge Randall R. Rader (J.D. ’78) of the U.S. Court of Appeals for the Federal Circuit. He then spent three years as a staff attorney at the U.S. International Trade Commission, where he litigated several Section 337 investigations involving IP matters. He says he was then encouraged by friends with whom he clerked to join the U.S. Patent and Trademark Office, which he did in 1996. After a short time, he was appointed acting deputy solicitor, responsible for overseeing all patent cases, and, eventually, solicitor. During his tenure at the USPTO, Whealan argued approximately 30 cases before the Federal Circuit (he was ultimately 30 cases before the Federal Circuit. He then spent three years as a staff attorney at the U.S. International Trade Commission, where he litigated several Section 337 investigations involving IP matters. He says he was then encouraged by friends with whom he clerked to join the U.S. Patent and Trademark Office, which he did in 1996. After a short time, he was appointed acting deputy solicitor, responsible for overseeing all patent cases, and, eventually, solicitor. During his tenure at the USPTO, Whealan argued approximately 30 cases before the Federal Circuit (he was ultimately responsible for briefing more than 300 cases) and assisted the U.S. solicitor general on nearly every IP case heard by the Supreme Court since 2000.

“Over the past decade, the Supreme Court has taken on an increasing number of patent cases,” Whealan says. “Patent law has become a much more important field. Four hundred thousand patent applications were filed at the USPTO last year. We’re not as much of a manufacturing economy or service economy anymore; we’re an intellectual economy and patents have become a bigger, mainstream part of it.”

A highlight of Whealan’s career was helping Senator Judiciary Committee Chairman Patrick Leahy draft the U.S. Patent Reform Act of 2007, characterized by many as the most significant piece of patent legislation in the last 50 years.

Whealan is optimistic his new appointment will be rewarding for him as well as the Law School. “It’s a multifaceted, one-of-a-kind job overseeing a vibrant program. GW Law has a unique place in the IP law community. Both academically and policy-wise, our faculty is second to none,” Whealan says. “When you work with great people you like and respect, there’s a lot of synergy.”

Dean Frederick M. Lawrence, who created the new deanship, says he is the “point person for the programmatic side of the IP program” and other great people at GW, and was glad to join them here.”

No stranger to academia, Whealan served for the past decade as an adjunct professor of law at The Franklin Pierce Law Center and also taught courses at George Mason University.

“WHEN YOU WORK WITH GREAT PEOPLE YOU LIKE AND RESPECT, THERE’S A LOT OF SYNERGY.”

Associate Dean John M. Whealan

Dean Whealan

School of Law and Chicago-Kent College of Law. He calls GW “a fun place to be” and lauds the University’s location in the heart of Washington. “I don’t think I would have taken this job anywhere else,” he states. “Everything is here, from Congress and the Supreme Court to the Federal Circuit and the Patent Office. From the early days of my career, I felt that if I was going to practice IP law, I wanted to do it in D.C.”

Whealan, who lives with his wife and 10-year-old daughter in Takoma Park, Md., also appreciates Washington’s extensive Metrorail system. “I’ve been legally blind since birth, so I always make it a point to live in cities with good public transportation,” he says.

Drawing on strengths and identifying areas of opportunity, Whealan hopes to lead GW’s century-old IP program to even greater heights. “I feel very fortunate and look forward to what the next decade brings.”
Indian Project and USPTO Train India Patent Examiners

GW Law is active in a modernizing India.

For the first time, GW Law’s India Project has joined forces with the U.S. Patent and Trademark Office (USPTO) to train Indian patent examiners.

A team including Associate Dean John Whealan; Raj Davé (L.L.M. ’03); Dominic Keating, attaché for intellectual property (IPR) issues at the U.S. Embassy, New Delhi; and Seema Rao, a patent supervisor with the USPTO, traveled to India in August to train patent examiners in the Chennai and Calcutta Indian Patent Offices. The team also gave a lecture to students at Rajiv Gandhi School of IP Law, Indian Institute of Technology, Kharagpur, with whom GW has an agreement for joint collaboration.

The India Project regularly leads a delegation to the subcontinent in February each year. The trip planned for the last week of February 2009 will cover all aspects of IP including patents, copyright, trademarks, and data protection. This year’s delegation will include Judge Randall R. Rader (J.D. ’73), Judge Xiuping Ou of China, and Dean Whealan, among others.

A limited number of representatives from private companies and law firms are invited to join the delegation. Inquiries can be directed to John Whealan at jwhealan@law.gwu.edu. Additional information about the GW India Project can be found at www.law.gwu.edu/academics/India+Project/India+Project+Overview.htm.

[JOHN DUFFY ON PATENT ELIGIBILITY ]

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a method was not patent eligible, and Bilski’s appeal from the agency’s ruling was originally argued on October 1 before a three-judge panel of the court. Before a panel decision was rendered, however, the court issued an order setting the case for en banc considering and inviting additional briefing on five issues identified by the court, including the question whether the court should overrule its decade-old precedent in State Street Bank & Trust Co. v. Signature Financial Group, Inc., 149 F.3d 1368 (Federal Circuit 1998). Because of the en banc order, the case is expected to give the Federal Circuit a general opportunity to reconsider its jurisprudence on patentable subject matter, and the court’s ultimate decision in the case is likely to affect the standards for patenting a range of inventions, including those in the software, business, financial, and biotechnology areas.

Although more than 30 amicus briefs were filed, Duffy was one of only two attorneys selected by the court to present arguments on behalf of amici. William Lee, managing partner at Wilmer-Hale, presented amicus arguments on behalf of Bank of America and other financial entities. Lee argued that the Federal Circuit should overrule its State Street decision and hold business methods as well as software implementing such methods to be mental steps that cannot be patented. Duffy presented arguments on behalf of Regulatory Data Corporation, which is an exclusive licensee to patent rights owned by the Wall Street investment bank Goldman Sachs. He argued that the court should adhere to State Street and that modern business methods were technological processes that fall within both the statutory language enacted by Congress and the judicially created standards for patenting set forth in Supreme Court and Federal Circuit decisions. The amicus presentations at the en banc hearing tended to underscore the importance of the case to the financial industry.

Asian Visitors Welcomed at Law School

On June 7, GW Law hosted a reception for three distinguished groups of Asian visitors: a group of Chinese and Taiwanese visitors studying IP law led by Andy Sun (M.C.L. ’85) of the Asia Pacific Law Institute; a group of Japanese visitors studying IP law led by Professor Tami of the University of Tokyo; and a group of trainees from Korea’s Judicial Research and Training Institute who participated in a one-week course on international business law sponsored by GW Law.
Examining Copyright in the Digital Age

This summer, GW’s IP Program and its Creative and Innovative Economy Center (CIEC) launched a new symposium series to foster thought, scholarship, and debate on the future of creativity in the digital age. Examining the opportunities and threats that face the creators of intellectual property, this program explores solutions that help the creative and business communities reach new levels of artistic and commercial achievement.

Protecting and licensing music rights in an increasingly digital world was the focus of the series’ inaugural symposium on June 18. More than 100 scholars, government representatives, copyright owners, and advocacy groups gathered in GW Law’s Jacob Burns Moot Court Room to debate the role of performing rights organizations, maintaining markets for artists who depend on copyrights, and simplifying user access to digital, copyrighted material.

At the symposium:
• Robert P. Merges, the Wilson, Sonsini, Goodrich, and Rosarti Professor of Law and Technology at UC Berkeley, warned that proposed changes to the music and copyright system would restructure the role of performing rights organizations and potentially render them useless. Such an action would risk a songwriter’s ability to earn a living from performance, limiting potential creative growth.
• U.S. Register of Copyrights Marybeth Peters (J.D. ’71) provided commentary noting that the Copyright Office is exploring new “mechanisms for clearance” but is largely not distracted by “theoretical threats” to copyright.
• GW Pravel Professional Lecturer in Intellectual Property Law Ralph Oman said, “Congress risks gumming up a licensing mechanism that helped songwriters earn a living for over a century.”
• Grammy Award-winning songwriter and respected independent music publisher Dennis Morgan commented, “The performing rights system set up under United States copyright law has made it possible for generations of songwriters to pursue their craft and create music that is now recognized as a significant part of American culture. I have never seen a proposal for a new system that would improve on the one working so well for us today.”

The symposia and research presented are cosponsored by Broadcast Music Inc. (BMI). BMI is an American performing rights organization representing more than 375,000 songwriters, composers, and music publishers, and a catalog of more than 6.5 million musical works. Event information is available at www.newcopyrightera.org.
GW Professor Examines World’s Most Popular Song

Professor Robert Brauneis has spent a good deal of time in the last two years conducting research in six archives across the United States, looking into the history of “Happy Birthday to You,” the best-known and most frequently sung song in the world. Many people, including Justice Breyer in his dissent in the Supreme Court case of Eldred v. Ashcroft, have portrayed the song as an unoriginal work that is hardly worthy of copyright protection, but assume nonetheless that it remains under copyright. Yet Brauneis’s research reveals that assumption to be false.

The song that became “Happy Birthday to You,” originally written in 1893 with different lyrics and titled “Good Morning to All,” was the product of intense creative labor, undertaken with copyright protection in mind. “Happy Birthday to You,” however, is almost certainly no longer under copyright, due to a lack of evidence about who wrote the words, defective copyright notice, and a failure to file a proper renewal application.

Interesting facts uncovered by Professor Brauneis include:
• “Happy Birthday to You” generates an estimated $2 million per year for its putative owner, Warner/Chappell Music, Inc. In the 1990s, the song’s performing rights revenues amounted to more than one percent of all distributions made by the performing rights organization American Society of Composers, Authors, and Publishers, even though ASCAP had several million songs in its repertoire at the time.
• In the late 1930s, a company later bought by Warner/Chappell got a probate court to sell it a one-eighth interest in the song for $25, at a time when the song was already generating thousands of dollars in income.
• The composer of the “Happy Birthday to You” melody, Mildred Hill, was an underappreciated composer and musicologist who, among other things, almost certainly wrote a pseudonymous article on African-American music that inspired Antonin Dvorak to compose his famous symphony Aus der Neuen Welt (From the New World).

Professor Brauneis also argues that there are policy lessons to be drawn from the history of the song. That history, he says, demonstrates that changes are needed to overcome collective action barriers to mounting challenges to copyright validity. It also shows that a long, unitary copyright term could benefit from a doctrine of prescription and from a number of changes in Copyright Office recordkeeping.

ABC News, the Canadian Broadcasting Corporation, and others have taken note of Professor Brauneis’s findings and have produced stories on the song featuring interviews with him. His article draft, “Copyright and the World’s Most Popular Song,” is available at http://ssrn.com/abstract=1111624.

He has also published online more than two hundred previously unpublished documents relating to the history of the song, available at http://docs.law.gwu.edu/facweb/rbrauneis/happybirthday.htm.

Federal Circuit Bar Journal Moves to GW

On July 1, the Federal Circuit Bar Journal (FCBJ) officially moved to GW. The FCBJ is the official journal for the Federal Circuit Bar Association and the U.S. Court of Appeals for the Federal Circuit. A national quarterly publication, it carries a subscriber base of more than 3,000 judges, professors, attorneys, and law students.

The FCBJ is charged with providing meaningful, insightful, and timely coverage of issues within the jurisdiction of the Federal Circuit. As a result, the FCBJ routinely publishes articles concerning patents, trademarks, government contracts, international trade, personnel appeals, veterans appeals, vaccination disputes, and environmental and natural resources. GW Law currently offers several courses that are directly related to the jurisdiction of the Federal Circuit and thus the subject matter published in the FCBJ.

This year will be one of transition for the publication in that it will have members from both GW and George Mason University School of Law. The senior editorial board will be led by GMU students with Editor-in-Chief Timothy Shirk, who will graduate in 2009. This summer, 30 rising 2L GW students were selected to be on the FCBJ. Next year, and for the years that follow, the FCBJ will consist solely of GW students and will be housed at the Law School. Its two principal GW faculty advisors are Associate Dean John Whealan and Professor Joshua Schwartz.

The FCBJ also has a group of advisory board members consisting primarily of leading practitioners in the various areas of the Federal Circuit’s jurisdiction. FCBJ editorial staff members are able to collaborate with practicing attorneys to gain valuable insight into complex journal topics. This allows journal members to complete a more thorough, and consequently a more educational, examination of important legal issues.

The FCBJ is seeking feature articles that relate to the Federal Circuit’s jurisdiction. More information, including how to submit articles for consideration, is available at www.law.gmu.edu/fcbj.
GW LAW’S ENTERING CLASS AMONG STRONGEST IN HISTORY

The fall 2008 entering J.D. class is among the strongest in GW Law’s history as measured by both objective (median LSAT of 166 and median GPA of 3.67) and subjective standards. Out of more than 9,000 applicants, 520 students were selected. In this entering class, 172 indicated an interest in IP law; of those, 78 have science or engineering backgrounds. Twenty-five of those students hold advanced degrees in science or engineering. New entrants come to GW Law from 46 states, the District of Columbia, and six foreign countries.

This fall’s international LL.M. class, which hails from 47 countries, is an exceptionally gifted, diverse, and professionally accomplished group. The entering class of 115 foreign-trained lawyers includes 27 who have indicated that they will pursue a specialization in IP law. Additionally, the School expects to enroll 95 LL.M. students who received their legal training in the United States, 25 of whom will specialize in IP law.

The LL.M. candidates are judges, prosecutors, in-house counsels, professors, corporate counsel, government officers, practicing attorneys, and recent law graduates. They range in age from their early twenties to mid-fifties. Their presence will greatly enrich the academic life at the Law School and give their fellow students, both J.D. and LL.M., a chance to experience law from a global perspective and to learn from their prior legal and other career experiences.

SAVE THE DATE FOR FIRST GW SYMPOSIUM ON THE FEDERAL CIRCUIT

Mark your calendar for March 18, when GW Law and the Federal Circuit Bar Association will present a conference highlighting past and current chief judges of the U.S. Court of Appeals for the Federal Circuit.

We expect to hear the views of leaders of the Judicial Branch, the Office of the Solicitor General, and academia on past contributions and future considerations affecting the Federal Circuit community.

The event will be held at the National Press Club in Washington, D.C. For more information, please contact John Whealan at jwhealan@law.gwu.edu.