

# the ip record

## Annual U.S. IP Developments

*including*

Top 300 Patent Owners

U.S. Patent, Trademark, Copyright and Litigation Graphs and Tables

Federal Circuit Summaries

IPO Amicus Brief Highlights



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Association

# 2009

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**Dear IPO Members and Colleagues:**

I am pleased to present the second annual IP Record, a publication introduced in 2008 to offer members a convenient compilation of annual IP statistics. We are publishing this year's IP Record online only. I believe you will find the publication a useful reference tool, along with other resources available on the IPO website including the IPO Daily News™ and IPO's Federal Circuit Summaries™.



IPO is continuing to expand membership benefits. Soon we will launch IPOConnect™, a section of the website that will facilitate committee interaction and offer professional/social networking capabilities available to all IPO members. We hope you will take advantage of this new feature when it is announced later this spring. In 2009 the Board of Directors will continue to work on implementing the strategic plan, which includes developing a greater international presence, working with the USPTO to improve patent quality, and expanding educational programs on the real benefits and costs of intellectual property.

If you are a member of IPO and not taking advantage of all the membership benefits available to you, visit [www.ipo.org](http://www.ipo.org) or call the IPO office to find out how you can get more out of your membership. If you are not a member, I urge you to consider joining. Visit [www.ipo.org/joinipo](http://www.ipo.org/joinipo) or call the IPO office at 202/507-4500 for more information.

Cordially,

A handwritten signature in black ink that reads "Steven W. Miller". The signature is written in a cursive, flowing style.

Steven W. Miller  
IPO President

PS – Join us in Chicago for the 2009 IPO Annual Meeting, September 13-15, at the Chicago Hilton. Registration opens in June!

**SAVE THE DATES - MARK YOUR CALENDAR FOR IPO AND IPO EDUCATION FOUNDATION PROGRAMS!**



May 28, 2009

Realities and Myths in Patent  
Litigation Today - "Trolls II"  
*Washington, DC - Grand Hyatt*

SEPTEMBER 13-15, 2009

IPO Annual Meeting  
*Chicago, IL - The Chicago Hilton*

SEPTEMBER 12-14, 2010

IPO Annual Meeting  
*Atlanta, GA - Hyatt Regency Atlanta*

SEPTEMBER 11-13, 2011

IPO Annual Meeting  
*Los Angeles, CA - JW Marriott Los Angeles  
at L.A. Live*

SEPTEMBER 9-11, 2012

IPO Annual Meeting  
*San Antonio, TX - JW Marriott San Antonio Hill  
Country Resort & Spa*



MAY 28, 2009

Foundation Awards Dinner  
*Washington, DC - Smithsonian National  
Museum of American History*

DECEMBER 7, 2009

PTO Day  
*Washington, DC - Ronald Reagan Building  
and International Trade Center*

For event updates and registration information, please visit the IPO meetings and events calendar at [www.ipo.org/calendar](http://www.ipo.org/calendar)



Intellectual  
Property  
Owners  
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# Top 300 Organizations Granted U.S. Patents in 2008

*IPO DOES NOT INTEND TO ENCOURAGE MORE PATENTING IN U.S.*

*This annual report listing the organizations that received the most U.S. utility patents is being published by IPO for the 26th consecutive year. It is based on data obtained from the U.S. Patent & Trademark Office. Patents granted to parent and subsidiary companies are consolidated in some instances. See the end notes for background on how the report was prepared.*

*IPO does not intend for this report to encourage or discourage patenting. The U.S. Patent & Trademark Office announced two years ago that it would no longer publish its own report on organizations receiving the most patents, because it wanted to discourage “any perception that we believe more is better.” IPO has opted to continue publishing this IPO report, however, because the number of patents granted is one of the few objective measures of the patent system as a whole and the patenting activities of individual industries and companies. IPO and others are studying ways to develop more reliable measures of patent quality.*

*May 21, 2009*

## 2008 Patent Owners Numerical Listing

Rank	Organization	Patents	Rank	Organization	Patents
1	International Business Machines Corp.	4,169	45	Boeing Co.	421
2	Samsung Electronics Co., Ltd.	3,502	46	Robert Bosch GmbH	416
3	Hitachi, Ltd.	2,197	47	3M Innovative Properties Co.	408
4	Canon K.K.	2,153	48	Lucent Technologies Inc.	405
5	Microsoft Corp.	2,043	49	Johnson & Johnson	405
6	Intel Corp.	1,772	50	Toyota Jidosha K.K.	387
7	Panasonic Corp.	1,760	51	Taiwan Semiconductor Manufacturing Co., Ltd.	365
8	Toshiba Corp.	1,575	52	Boston Scientific Corp.	358
9	Fujitsu Ltd.	1,475	53	STMicroelectronics, Inc.	349
10	Sony Corp.	1,461	54	Ford Global Technologies, LLC	336
11	Hewlett-Packard Co.	1,422	55	United Technologies Corp.	333
12	Siemens AG	1,288	56	Fuji Xerox Co., Ltd.	332
13	Micron Technology, Inc.	1,277	57	Freescale Semiconductor, Inc.	322
14	General Electric Co.	1,243	58	TDK Corp.	322
15	Seiko Epson Corp.	1,219	59	Eastman Kodak Co.	320
16	Fujifilm Corp.	863	60	Applied Materials, Inc.	314
17	Ricoh Co., Ltd.	851	61	Delphi Technologies, Inc.	311
18	AT&T	820	62	Qualcomm, Inc.	309
19	Infineon Technologies AG	809	63	Alcatel-Lucent	293
20	LG Electronics Inc.	805	64	Medtronic Inc.	287
21	Honeywell International Inc.	774	65	Industrial Technology Research Institute, Taiwan	286
22	Texas Instruments, Inc.	755	66	Olympus Corp.	285
23	Cisco Technology, Inc.	704	67	Agilent Technologies, Inc.	279
24	Honda Motor Co., Ltd.	703	68	LG Display Co., Ltd.	274
25	Denso Corp.	655	69	Nortel Networks Ltd.	272
26	Broadcom Corp.	643	70	ASML Netherlands B.V.	271
27	Nokia Corp.	608	71	Procter & Gamble Co.	271
28	Silverbrook Research Pty. Ltd.	608	72	NEC Electronics Corp.	267
29	Xerox Corp.	606	73	Telefonaktiebolaget LM Ericsson	263
30	Sharp Corp.	585	74	Schlumberger Technology Corp.	259
31	Koninklijke Philips Electronics N.V.	584	75	Altera Corp.	257
32	Sun Microsystems, Inc.	543	76	Exxon Mobil Corp.	256
33	Motorola, Inc.	543	77	Electronics and Telecommunications Research Institute	254
34	NEC Corp.	527	78	LG Philips LCD Co., Ltd.	250
35	General Motors Corp.	510	79	LSI Logic Corp.	248
36	DuPont	501	80	SAP AG	246
37	Renesas Technology Corp.	500	81	Tokyo Electron Ltd.	246
38	Hon Hai Precision Ind. Co., Ltd.	498	82	Seagate Technology, LLC	245
39	Mitsubishi Denki K.K.	481	83	Xilinx, Inc.	243
40	Semiconductor Energy Laboratory Co., Ltd.	468	84	University of California, The Regents of	237
41	Brother Kogyo K.K.	462	85	Halliburton Energy Services, Inc.	236
42	Sanyo Electric Co., Ltd.	446	86	Illinois Tool Works Inc.	233
43	Hynix Semiconductor Inc.	435	87	OKI Electric Industry Co., Ltd.	232
44	Samsung SDI Co., Ltd.	432			

2008 Patent Owners  
Numerical Listing

Rank	Organization	Patents	Rank	Organization	Patents
88	Genentech, Inc.	226	134	Corning Inc.	144
89	United States of America, Navy	224	135	Kimberly-Clark Worldwide, Inc.	142
90	Nissan Motor Company, Ltd.	222	136	Avago Technologies (Singapore) Pte. Ltd.	141
91	Research In Motion Ltd.	220	137	Pfizer Inc.	141
92	BASF AG	214	138	Wyeth	137
93	SanDisk Corp.	211	139	Macronix International Co., Ltd.	136
94	Lockheed Martin Corp.	208	140	Interdigital Technology Corp.	135
95	Oracle International Corp.	201	141	Shell Oil Co.	135
96	Thomson Licensing S.A.	201	142	Massachusetts Institute of Technology	134
97	Baker Hughes Inc.	197	143	ADC Telecommunications, Inc.	131
98	Hong Fu Jin Precision Industry (Shenzhen) Co., Ltd.	196	144	Inventec Corp.	131
99	Advanced Micro Devices, Inc.	194	145	United States of America, Army	129
100	Dongbu Electronics Co., Ltd.	194	146	NGK Insulators Ltd.	125
101	Yamaha Corp.	193	147	International Game Technology (IGT)	124
102	EMC Corp.	192	148	Raytheon Co.	123
103	NXP B.V.	192	149	Analog Devices, Inc.	122
104	National Semiconductor Corp.	191	150	Sprint Communications Co., L.P.	122
105	Caterpillar Inc.	187	151	Stanford University	120
106	Apple, Inc.	185	152	United Microelectronics Corp.	120
107	AU Optronics Corp.	183	153	Eaton Corp.	119
108	Agere Systems Inc.	181	154	Hoya Corp.	114
109	Marvell International Ltd.	179	155	Northrop Grumman Corp.	114
110	Nvidia Corp.	175	156	Network Appliance, Inc.	112
111	GlaxoSmithKline	171	157	Advantest Corp.	110
112	Samsung Electro-Mechanics Co., Ltd.	170	158	United States of America, Health & Human Services	109
113	Monsanto Co.	169	159	Konica Minolta Business Technologies, Inc.	107
114	Mediatek Inc.	166	160	Cypress Semiconductor Corp.	106
115	Yazaki Corp.	164	161	Hyundai Motor Co.	104
116	VIA Technologies, Inc.	163	162	Air Liquide Corp.	104
117	Murata Manufacturing Co., Ltd.	161	163	Nitto Denko Corp.	103
118	Dell Products, L.P.	159	164	Hoffmann-La Roche Inc.	102
119	Black & Decker Inc.	159	165	Japan Science and Technology Agency	102
120	Pioneer Corp.	158	166	Kyocera Mita Corp.	102
121	Nikon Corp.	157	167	Sanofi-Aventis	102
122	Rohm Co., Ltd.	155	168	Yamaha Hatsudoki K.K., Yamaha Motor Co., Ltd.	101
123	NTT Docomo, Inc.	152	169	AstraZeneca AB	100
124	Deere & Co.	152	170	Merck Patent GmbH	100
125	Bristol-Myers Squibb Co.	147	171	Zahnradfabrik Friedrichshafen AG	99
126	Lexmark International, Inc.	147	172	Commissariat a l'Energie Atomique	98
127	Funai Electric Co., Ltd.	146	173	Verizon	98
128	Alps Electric Co., Ltd.	145	174	Daimler AG	97
129	Sumitomo Electric Industries Co., Ltd.	145	175	Elpida Memory, Inc.	97
130	Merck & Co., Inc.	145	176	KLA-Tencor Technologies Corp.	97
131	Finisar Corp.	144	177	California Institute of Technology	96
132	L'Oreal S.A.	144	178	Tyco Electronics Corp.	96
133	Sharp Laboratories of America, Inc.	144			



## 2008 Patent Owners Numerical Listing

Rank	Organization	Patents	Rank	Organization	Patents
179	Aisin Seiki K.K.	94	226	Institut Francais du Petrole	74
180	Victor Company of Japan, Ltd.	94	227	Kyocera Corp.	74
181	Casio Computer Co. Ltd.	93	228	LAM Research Corp.	74
182	Dai Nippon Printing Co. Ltd.	92	229	Lenovo Pte. Ltd.	74
183	Harris Corp.	92	230	Bayerische Motoren Werke AG	73
184	Konica Minolta Holdings, Inc.	92	231	Council of Scientific and Industrial Research	73
185	Shin Etsu Chemical Co., Ltd.	92	232	Matsushita Electric Works, Ltd.	73
186	NSK Ltd.	91	233	Schering Corp.	73
187	Silicon Laboratories Inc.	91	234	Headway Technologies, Inc.	72
188	Rohm and Haas Co.	91	235	Koito Manufacturing Co., Ltd.	72
189	Delta Electronics Inc.	90	236	Shimano Inc.	72
190	International Rectifier Corp.	90	237	Thales	72
191	Spansion LLC	90	238	Allergan, Inc.	71
192	Wisconsin Alumni Research Foundation	90	239	Accenture	71
193	Rockwell Automation Technologies, Inc.	90	240	Air Products and Chemicals, Inc.	70
194	Unisys Corp.	89	241	Chunghwa Picture Tubes, Ltd.	70
195	Fu Zhun Precision Industrial Co., Ltd.	88	242	Fanuc Ltd.	70
196	AOL LLC	87	243	Michelin Recherche et Technique S.A.	70
197	Mitsubishi Electric Research Laboratories, Inc.	87	244	Sony Ericsson Mobile Communications AB	70
198	Adobe Systems, Inc.	86	245	Advanced Cardiovascular Systems, Inc.	69
199	Rolls-Royce PLC	86	246	Cadence Design Systems, Inc.	69
200	Symantec Operating Corp.	86	247	Ciba Specialty Chemicals Corp.	69
201	Pacesetter, Inc.	85	248	Fraunhofer-Gesellschaft Zur Foerderung Der Angewandten Forschung E.V.	69
202	Takata Corp.	85	249	Rambus, Inc.	69
203	Omron Corp.	84	250	Sprint Spectrum L.P.	69
204	Dow Chemical Co.	82	251	Konica Minolta Opto, Inc.	68
205	CNH America LLC	81	252	Seiko Instruments Inc.	68
206	Juniper Networks, Inc.	81	253	Abbott Laboratories	67
207	Pitney-Bowes, Inc.	80	254	Dainippon Screen Mfg. Co., Ltd.	67
208	Sumitomo Chemical Co., Ltd.	80	255	Goodyear Tire & Rubber Co.	67
209	Acushnet Co.	79	256	Yahoo, Inc.	67
210	Fujinon Corp.	79	257	ARM Ltd.	66
211	PPG Industries Ohio Inc.	79	258	Cree, Inc.	66
212	University of Texas	79	259	Johns Hopkins University	66
213	Atmel Corp.	78	260	Okidata Corp.	66
214	BEA Systems, Inc.	78	261	United States of America, National Aeronautics and Space Administration	66
215	Kao Corp.	78	262	University of Michigan	66
216	Toyoda Gosei K.K.	78	263	Alstom Technology Ltd.	65
217	Weatherford/Lamb, Inc.	78	264	HRL Laboratories, LLC	65
218	Avaya Technology Corp.	78	265	Lear Corp.	65
219	NCR Corp.	77	266	Ajinomoto Co. Inc.	64
220	Asahi Glass Co., Ltd.	75	267	American Express Travel Related Services Company, Inc.	64
221	LG Chemical Ltd.	75	268	Cheng Uei Precision Industry Co., Ltd.	64
222	Mitsubishi Heavy Industries, Ltd.	75	269	Realtek Semiconductor Corp.	64
223	Sandia Corp.	75	270	Symantec Corp.	64
224	Bridgestone Corp.	74			
225	Carl Zeiss SMT AG	74			



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<b>Rank</b>	<b>Organization</b>	<b>Patents</b>
271	Applera Corp.	63
272	Callaway Golf Co.	63
273	Eli Lilly and Co.	63
274	FCI Americas Technology, Inc.	63
275	Rockwell Collins, Inc.	63
276	Societe Nationale d'Etude et de Construction de Moteurs d'Aviation	63
277	Sumitomo Wiring Systems, Ltd.	63
278	Smith International Inc.	62
279	Whirlpool Corp.	62
280	Novartis AG	61
281	Advanced Semiconductor Engineering, Inc.	60
282	Jtekt Corp.	60
283	Sumitomo Rubber Industries, Ltd.	60
284	Synopsys Inc.	60
285	Unilever	60
286	Chrysler LLC	59
287	Eastman Chemical Co.	59
288	Amgen, Inc.	58
289	Digimarc Corp.	58
290	Google, Inc.	58
291	Airbus France	57
292	Becton, Dickinson and Co.	57
293	Konica Minolta Medical & Graphic, Inc.	57
294	Nippon Telegraph & Telephone Corp.	56
295	Qisda Corp.	56
296	Yamaha Marine K.K.	56
297	BAE Systems, Inc.	56
298	Daikin Industries Ltd.	55
299	DSM IP Assets B.V.	55
300	Ebara Corp.	55
301	Heidelberger Druckmaschinen AG	55
302	Mitutoyo Corp.	55
303	Showa Denko K.K.	55
304	DirecTV Group, Inc.	55

## 2008 Patent Owners Alphabetical Listing

Rank	Organization	Patents	Rank	Organization	Patents
47	3M Innovative Properties Co.	408	292	Becton, Dickinson and Co.	57
253	Abbott Laboratories	67	119	Black & Decker Inc.	159
239	Accenture	71	45	Boeing Co.	421
209	Acushnet Co.	79	52	Boston Scientific Corp.	358
143	ADC Telecommunications, Inc.	131	224	Bridgestone Corp.	74
198	Adobe Systems, Inc.	86	125	Bristol-Myers Squibb Co.	147
245	Advanced Cardiovascular Systems, Inc.	69	26	Broadcom Corp.	643
99	Advanced Micro Devices, Inc.	194	41	Brother Kogyo K.K.	462
281	Advanced Semiconductor Engineering, Inc.	60	246	Cadence Design Systems, Inc.	69
157	Advantest Corp.	110	177	California Institute of Technology	96
108	Agere Systems Inc.	181	272	Callaway Golf Co.	63
67	Agilent Technologies, Inc.	279	4	Canon K.K.	2,153
162	Air Liquide Corp.	104	225	Carl Zeiss SMT AG	74
240	Air Products and Chemicals, Inc.	70	181	Casio Computer Co. Ltd.	93
291	Airbus France	57	105	Caterpillar Inc.	187
179	Aisin Seiki K.K.	94	268	Cheng Uei Precision Industry Co., Ltd.	64
266	Ajinomoto Co. Inc.	64	286	Chrysler LLC	59
63	Alcatel-Lucent	293	241	Chunghwa Picture Tubes, Ltd.	70
238	Allergan, Inc.	71	247	Ciba Specialty Chemicals Corp.	69
128	Alps Electric Co., Ltd.	145	23	Cisco Technology, Inc.	704
263	Alstom Technology Ltd.	65	205	CNH America LLC	81
75	Altera Corp.	257	172	Commissariat a l'Energie Atomique	98
267	American Express Travel Related Services Company, Inc.	64	134	Corning Inc.	144
288	Amgen, Inc.	58	231	Council of Scientific and Industrial Research	73
149	Analog Devices, Inc.	122	258	Cree, Inc.	66
196	AOL LLC	87	160	Cypress Semiconductor Corp.	106
106	Apple Inc.	185	182	Dai Nippon Printing Co. Ltd.	92
271	Applera Corp.	63	298	Daikin Industries Ltd.	55
60	Applied Materials, Inc.	314	174	Daimler AG	97
257	ARM Ltd.	66	254	Dainippon Screen Mfg. Co., Ltd.	67
220	Asahi Glass Co., Ltd.	75	124	Deere & Co.	152
70	ASML Netherlands B.V.	271	118	Dell Products, L.P.	159
169	AstraZeneca AB	100	61	Delphi Technologies, Inc.	311
18	AT&T	820	189	Delta Electronics Inc.	90
213	Atmel Corp.	78	25	Denso Corp.	655
107	AU Optronics Corp.	183	289	Digimarc Corp.	58
136	Avago Technologies (Singapore) Pte. Ltd.	141	304	DirecTV Group, Inc.	55
218	Avaya Technology Corp.	78	100	Dongbu Electronics Co., Ltd.	194
297	BAE Systems, Inc.	56	204	Dow Chemical Co.	82
97	Baker Hughes Inc.	197	299	DSM IP Assets B.V.	55
92	BASF AG	214	36	DuPont	501
230	Bayerische Motoren Werke AG	73	287	Eastman Chemical Co.	59
214	BEA Systems, Inc.	78	59	Eastman Kodak Co.	320
			153	Eaton Corp.	119

2008 Patent Owners  
Alphabetical Listing

Rank	Organization	Patents	Rank	Organization	Patents
300	Ebara Corp.	55	1	International Business Machines Corp.	4,169
77	Electronics and Telecommunications Research Institute	254	147	International Game Technology (IGT)	124
273	Eli Lilly and Co.	63	190	International Rectifier Corp.	90
175	Elpida Memory, Inc.	97	144	Inventec Corp.	131
102	EMC Corp.	192	165	Japan Science and Technology Agency	102
76	Exxon Mobil Corp.	256	259	Johns Hopkins University	66
242	Fanuc Ltd.	70	49	Johnson & Johnson	405
274	FCI Americas Technology, Inc.	63	282	Jtekt Corp.	60
131	Finisar Corp.	144	206	Juniper Networks, Inc.	81
54	Ford Global Technologies, LLC	336	215	Kao Corp.	78
248	Fraunhofer-Gesellschaft Zur Foerderung Der Angewandten Forschung E.V.	69	135	Kimberly-Clark Worldwide, Inc.	142
57	Freescale Semiconductor, Inc.	322	176	KLA-Tencor Technologies Corp.	97
195	Fu Zhun Precision Industrial Co., Ltd.	88	235	Koito Manufacturing Co., Ltd.	72
56	Fuji Xerox Co., Ltd.	332	159	Konica Minolta Business Technologies, Inc.	107
16	Fujifilm Corp.	863	184	Konica Minolta Holdings, Inc.	92
210	Fujinon Corp.	79	293	Konica Minolta Medical & Graphic, Inc.	57
9	Fujitsu Ltd.	1,475	251	Konica Minolta Opto, Inc.	68
127	Funai Electric Co., Ltd.	146	31	Koninklijke Philips Electronics N.V.	584
88	Genentech, Inc.	226	227	Kyocera Corp.	74
14	General Electric Co.	1,243	166	Kyocera Mita Corp.	102
35	General Motors Corp.	510	228	LAM Research Corp.	74
111	GlaxoSmithKline	171	265	Lear Corp.	65
255	Goodyear Tire & Rubber Co.	67	229	Lenovo Pte. Ltd.	74
290	Google, Inc.	58	126	Lexmark International, Inc.	147
85	Halliburton Energy Services, Inc.	236	221	LG Chemical Ltd.	75
183	Harris Corp.	92	68	LG Display Co., Ltd.	274
234	Headway Technologies, Inc.	72	20	LG Electronics Inc.	805
301	Heidelberger Druckmaschinen AG	55	78	LG Philips LCD Co., Ltd.	250
11	Hewlett-Packard Co.	1,422	94	Lockheed Martin Corp.	208
3	Hitachi, Ltd.	2,197	132	L'Oreal S.A.	144
134	Hoffmann-La Roche Inc.	102	79	LSI Logic Corp.	248
38	Hon Hai Precision Ind. Co., Ltd.	498	48	Lucent Technologies Inc.	405
24	Honda Motor Co., Ltd.	703	139	Macronix International Co., Ltd.	136
21	Honeywell International Inc.	774	109	Marvell International Ltd.	179
98	Hong Fu Jin Precision Industry (Shenzhen) Co., Ltd.	196	142	Massachusetts Institute of Technology	134
154	Hoya Corp.	114	232	Matsushita Electric Works, Ltd.	73
264	HRL Laboratories, LLC	65	114	Mediatek Inc.	166
43	Hynix Semiconductor Inc.	435	64	Medtronic Inc.	287
161	Hyundai Motor Co.	104	130	Merck & Co., Inc.	145
86	Illinois Tool Works Inc.	233	170	Merck Patent GmbH	100
65	Industrial Technology Research Institute, Taiwan	286	243	Michelin Recherche et Technique S.A.	70
19	Infineon Technologies AG	809	13	Micron Technology, Inc.	1,277
226	Institut Francais du Petrole	74	5	Microsoft Corp.	2,043
6	Intel Corp.	1,772	39	Mitsubishi Denki K.K.	481
140	Interdigital Technology Corp.	135	197	Mitsubishi Electric Research Laboratories, Inc.	87
			222	Mitsubishi Heavy Industries, Ltd.	75
			302	Mitutoyo Corp.	55

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Rank	Organization	Patents	Rank	Organization	Patents
113	Monsanto Co.	169	112	Samsung Electro-Mechanics Co., Ltd.	170
33	Motorola, Inc.	543	2	Samsung Electronics Co., Ltd.	3,502
117	Murata Manufacturing Co., Ltd.	161	44	Samsung SDI Co., Ltd.	432
104	National Semiconductor Corp.	191	223	Sandia Corp.	75
219	NCR Corp.	77	93	SanDisk Corp.	211
34	NEC Corp.	527	167	Sanofi-Aventis	102
72	NEC Electronics Corp.	267	42	Sanyo Electric Co., Ltd.	446
156	Network Appliance, Inc.	112	80	SAP AG	246
146	NGK Insulators Ltd.	125	233	Schering Corp.	73
121	Nikon Corp.	157	74	Schlumberger Technology Corp.	259
294	Nippon Telegraph & Telephone Corp.	56	82	Seagate Technology, LLC	245
90	Nissan Motor Company, Ltd.	222	15	Seiko Epson Corp.	1,219
163	Nitto Denko Corp.	103	252	Seiko Instruments Inc.	68
27	Nokia Corp.	608	40	Semiconductor Energy Laboratory Co., Ltd.	468
69	Nortel Networks Ltd.	272	30	Sharp Corp.	585
155	Northrop Grumman Corp.	114	133	Sharp Laboratories of America, Inc.	144
280	Novartis AG	61	141	Shell Oil Co.	135
186	NSK Ltd.	91	236	Shimano Inc.	72
123	NTT Docomo, Inc.	152	185	Shin Etsu Chemical Co., Ltd.	92
110	Nvidia Corp.	175	303	Showa Denko K.K.	55
103	NXP B.V.	192	12	Siemens AG	1,288
87	OKI Electric Industry Co., Ltd.	232	187	Silicon Laboratories Inc.	91
260	Okidata Corp.	66	28	Silverbrook Research Pty. Ltd.	608
66	Olympus Corp.	285	278	Smith International Inc.	62
203	Omron Corp.	84	276	Societe Nationale d'Etude et de Construction de Moteurs d'Aviation	63
95	Oracle International Corp.	201	10	Sony Corp.	1,461
201	Pacesetter, Inc.	85	244	Sony Ericsson Mobile Communications AB	70
7	Panasonic Corp.	1,760	191	Spansion LLC	90
137	Pfizer Inc.	141	150	Sprint Communications Co., L.P.	122
120	Pioneer Corp.	158	250	Sprint Spectrum L.P.	69
207	Pitney-Bowes, Inc.	80	151	Stanford University	120
211	PPG Industries Ohio Inc.	79	53	STMicroelectronics, Inc.	349
71	Procter & Gamble Co.	271	208	Sumitomo Chemical Co., Ltd.	80
295	Qisda Corp.	56	129	Sumitomo Electric Industries Co., Ltd.	145
63	Qualcomm, Inc.	309	283	Sumitomo Rubber Industries, Ltd.	60
249	Rambus, Inc.	69	277	Sumitomo Wiring Systems, Ltd.	63
148	Raytheon Co.	123	32	Sun Microsystems, Inc.	543
269	Realtek Semiconductor Corp.	64	270	Symantec Corp.	64
37	Renesas Technology Corp.	500	200	Symantec Operating Corp.	86
91	Research In Motion Ltd.	220	284	Synopsys Inc.	60
17	Ricoh Co., Ltd.	851	51	Taiwan Semiconductor Manufacturing Co., Ltd.	365
46	Robert Bosch GmbH	416	202	Takata Corp.	85
193	Rockwell Automation Technologies, Inc.	90	58	TDK Corp.	322
275	Rockwell Collins, Inc.	63	73	Telefonaktiebolaget LM Ericsson	263
188	Rohm and Haas Co.	91	22	Texas Instruments, Inc.	755
122	Rohm Co., Ltd.	155	237	Thales	72
199	Rolls-Royce PLC	86			

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<b>Rank</b>	<b>Organization</b>	<b>Patents</b>
96	Thomson Licensing S.A.	201
81	Tokyo Electron Ltd.	246
8	Toshiba Corp.	1,575
216	Toyoda Gosei K.K.	78
50	Toyota Jidosha K.K.	387
178	Tyco Electronics Corp.	96
285	Unilever	60
194	Unisys Corp.	89
152	United Microelectronics Corp.	120
145	United States of America, Army	129
158	United States of America, Health & Human Services	109
261	United States of America, National Aeronautics and Space Administration	66
89	United States of America, Navy	224
55	United Technologies Corp.	333
84	University of California, The Regents of	237
262	University of Michigan	66
212	University of Texas	79
173	Verizon	98
116	VIA Technologies, Inc.	163
180	Victor Company of Japan, Ltd.	94
217	Weatherford/Lamb, Inc.	78
279	Whirlpool Corp.	62
192	Wisconsin Alumni Research Foundation	90
138	Wyeth	137
29	Xerox Corp.	606
83	Xilinx, Inc.	243
256	Yahoo, Inc.	67
101	Yamaha Corp.	193
168	Yamaha Hatsudoki K.K., Yamaha Motor Co., Ltd.	101
296	Yamaha Marine K.K.	56
115	Yazaki Corp.	164
171	Zahnradfabrik Friedrichshafen AG	99

## NOTES:

1. The number of patents granted does not necessarily indicate the value of a company's technology, the effectiveness of its R & D, or whether it will be profitable. The number of patents per company varies widely from industry to industry and from company to company within an industry.
2. This report was compiled by IPO from data provided by the U.S. Patent and Trademark Office. Patents reported are utility patents granted during calendar year 2008 that listed the organization or a subsidiary as the owner on the printed patent document. If an assignment of rights to an organization or its subsidiary was recorded after the patent document was printed, the patent was not counted. Patents in the name of majority-owned subsidiaries are consolidated with patents of the parent organization if the organization asked IPO by March 1, 2009 to include subsidiaries. Patents that were granted to two or more organizations jointly are attributed to the organization listed first on the patent document.
3. The number of utility patents granted by the USPTO increased to 157,772 in 2008 from 157,282 in 2007.
4. IPO has published this report annually since 1984 as a service to its members. For annual lists go to [www.ipo.org/TopPatentOwners](http://www.ipo.org/TopPatentOwners).
5. Next year IPO will list patents under the name of the parent organization that are granted to majority-owned subsidiaries if the organization provides the names of its majority-owned subsidiaries to IPO by March 1, 2010.
6. IPO makes reasonable efforts to avoid errors, but cannot assure complete accuracy.

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Gerald DePardo, The Travelers Company, Inc. New IPO Corporate Member 2007

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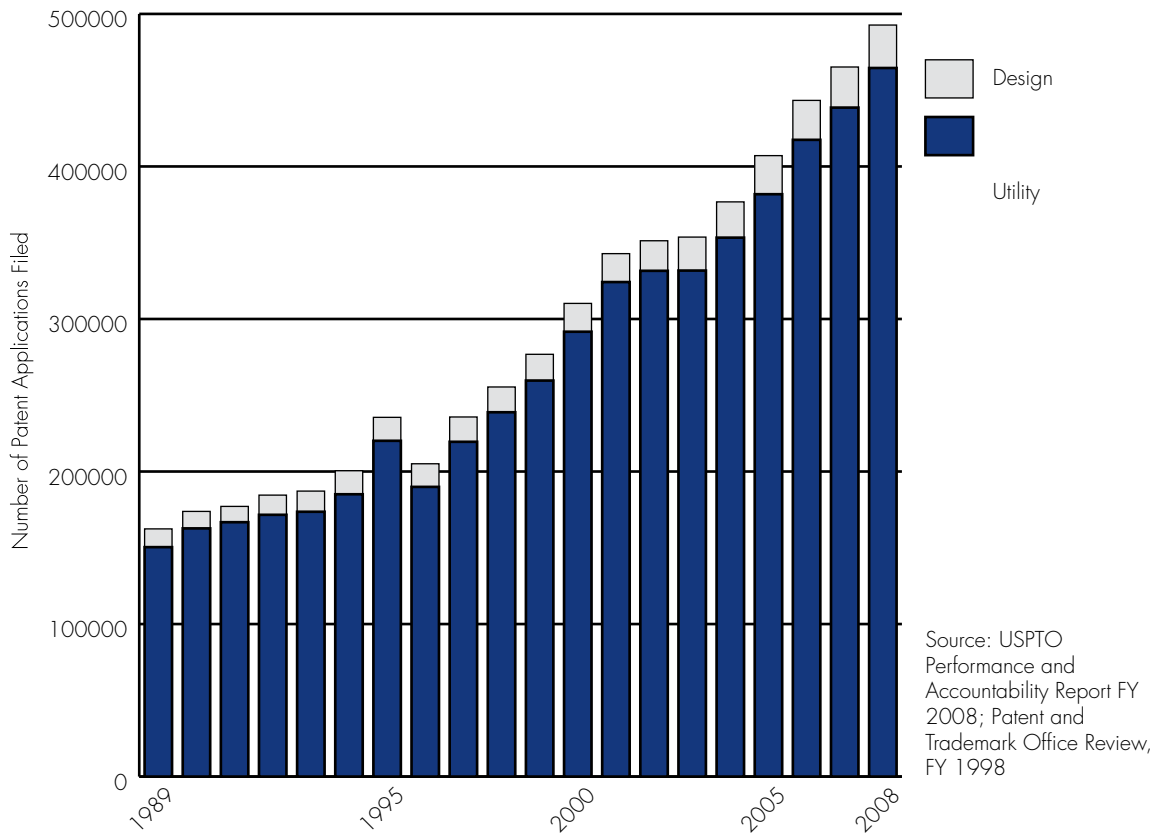
# Other Annual IP Statistics:

**Patents, Trademarks, and Copyrights:**  
by Type, State, and Country

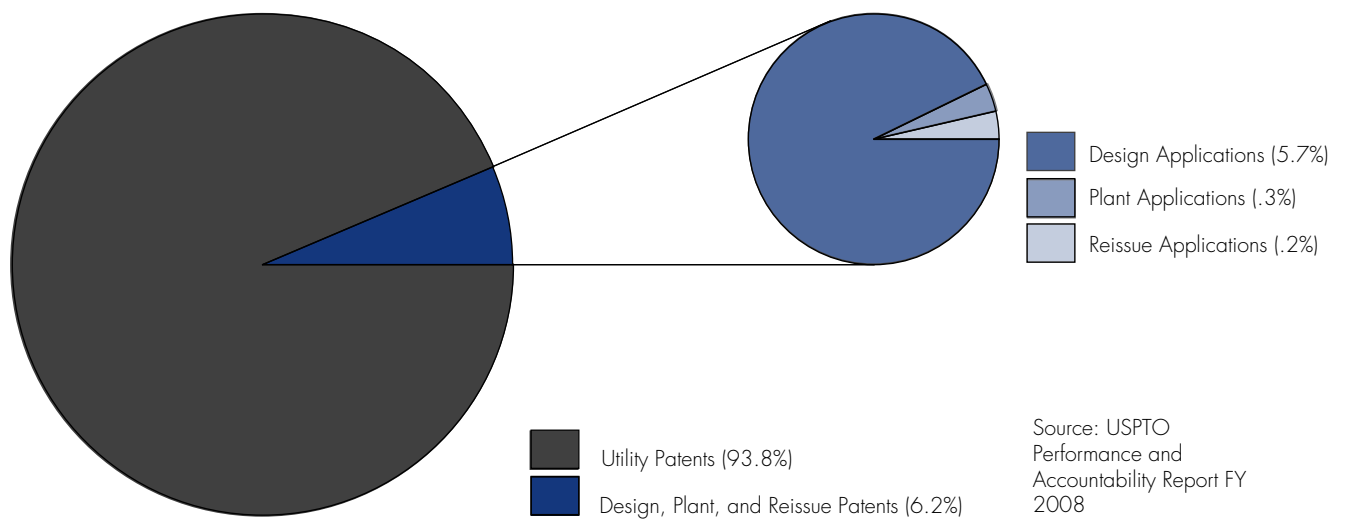
**U.S. District Courts Suits:**  
by Type and by Court

**Cases in the U.S. Court of Appeals for the Federal Circuit:**  
by Category, with Time to Disposition, and Petitions for Certiorari to the Supreme Court

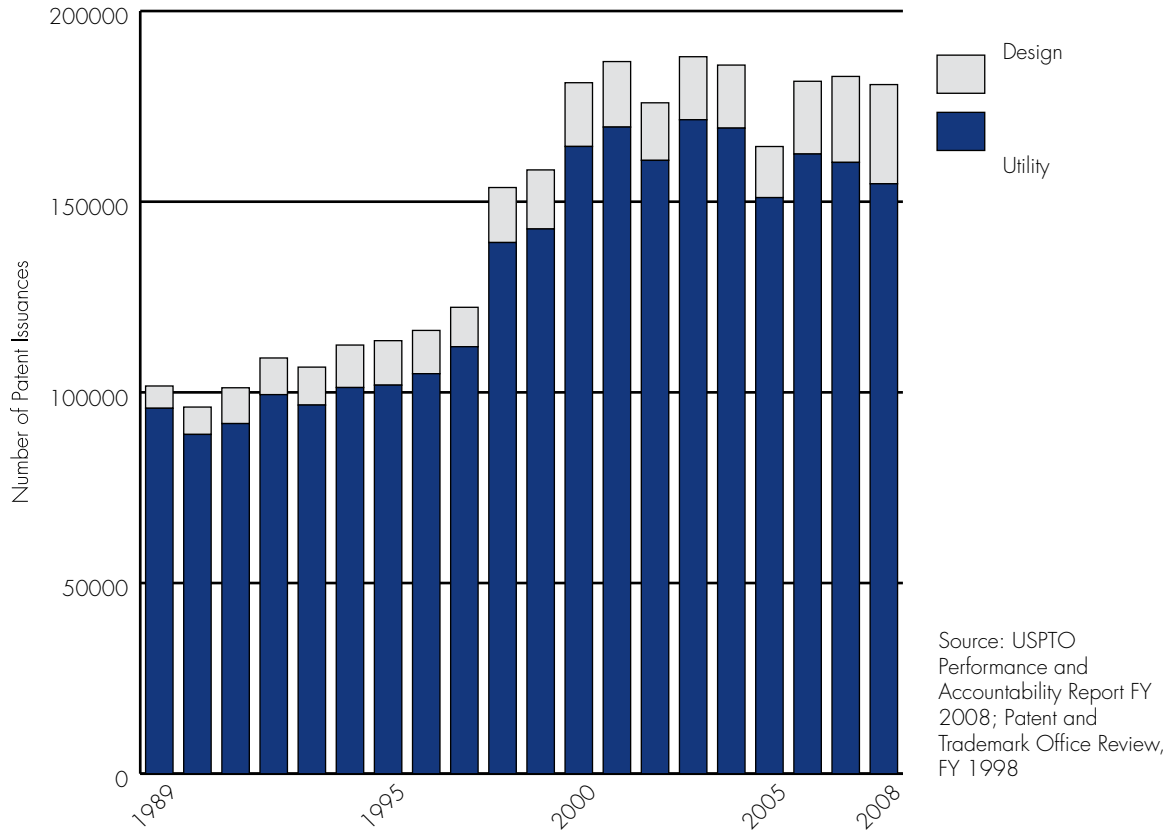
### U.S. Patent Applications, Utility and Design (1989 - 2008)



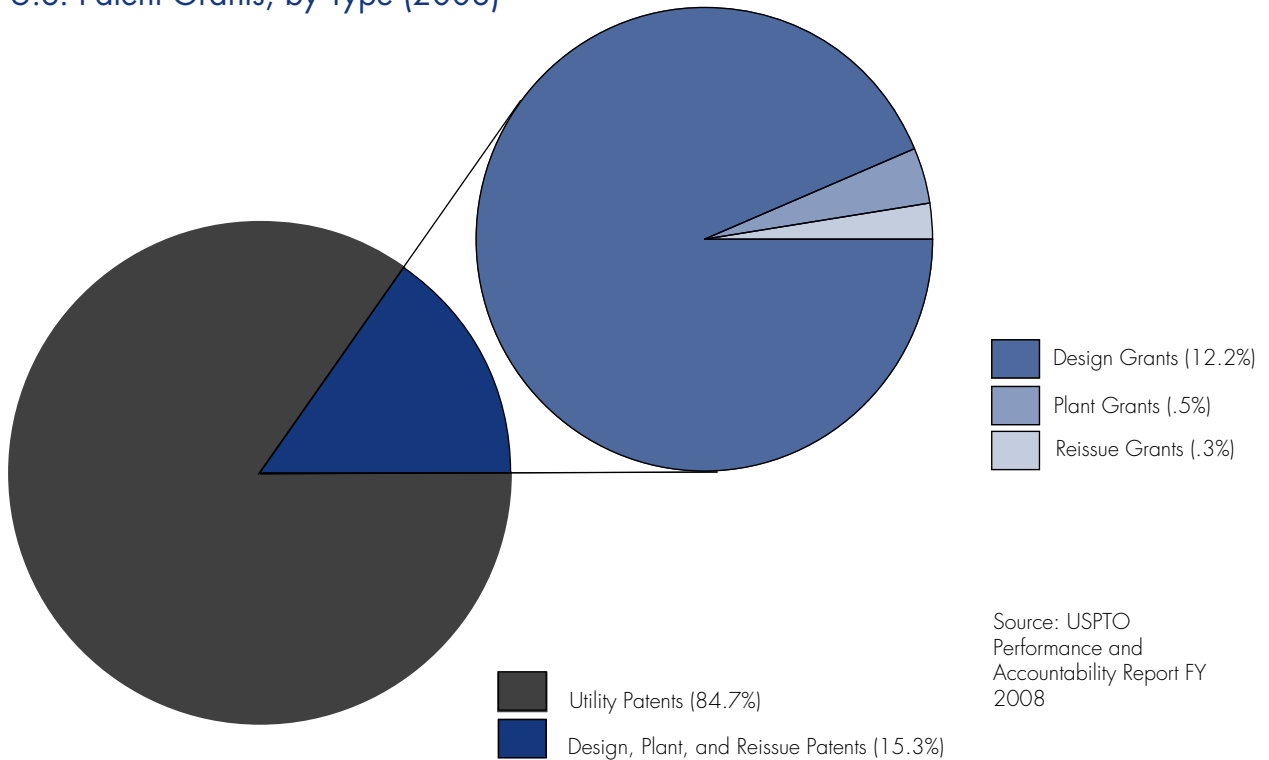
### U.S. Patent Applications, by Type (2008)



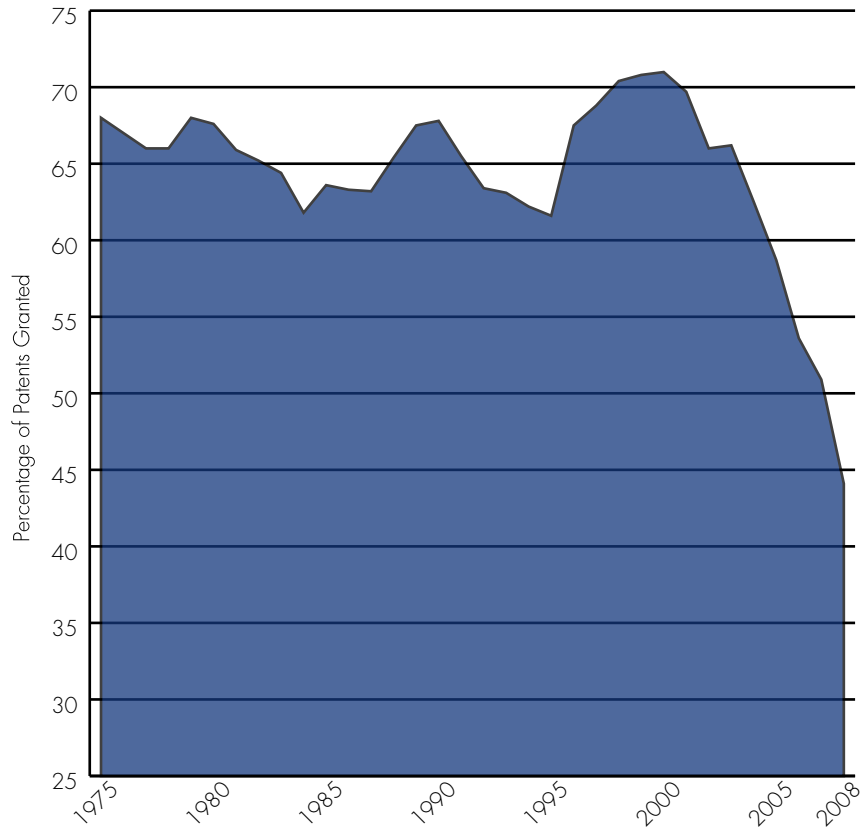
### U.S. Patent Grants, Utility and Design (1989 - 2008)



### U.S. Patent Grants, by Type (2008)



USPTO Patent Applications Allowance Rate\* (FY 1975 - 2008)

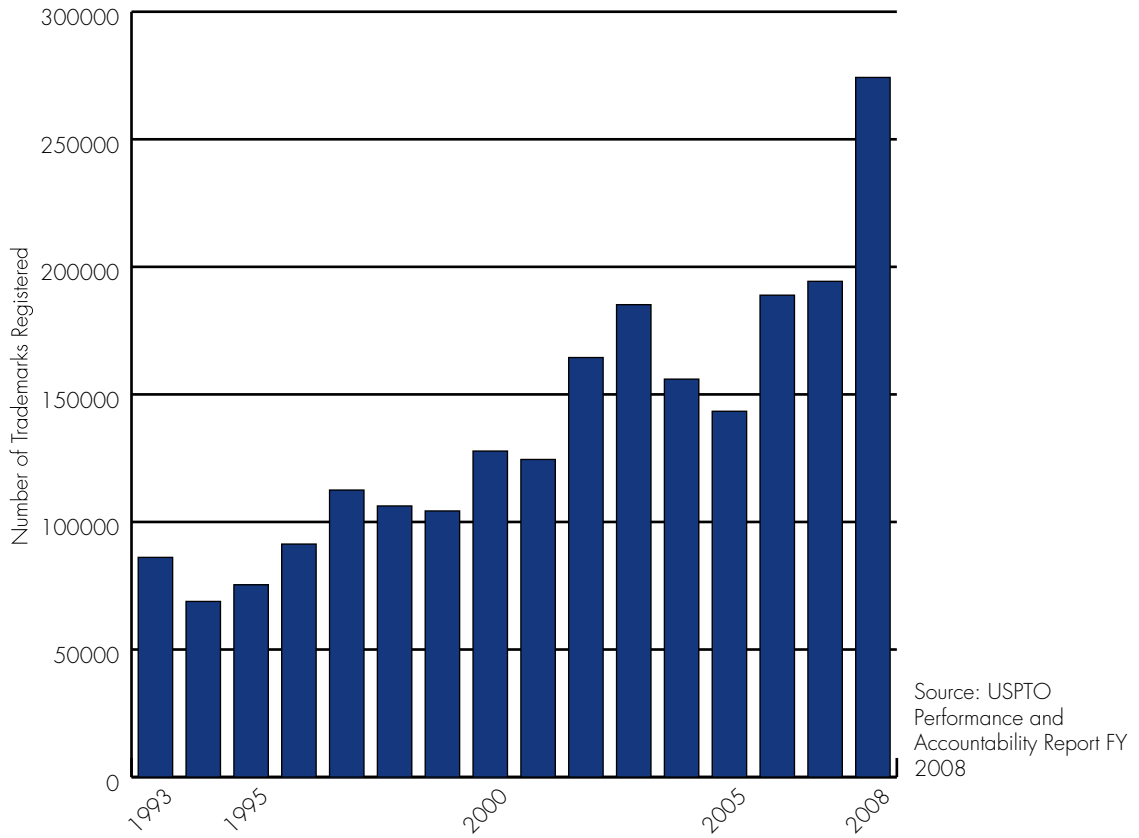


Source: USPTO, April 2009

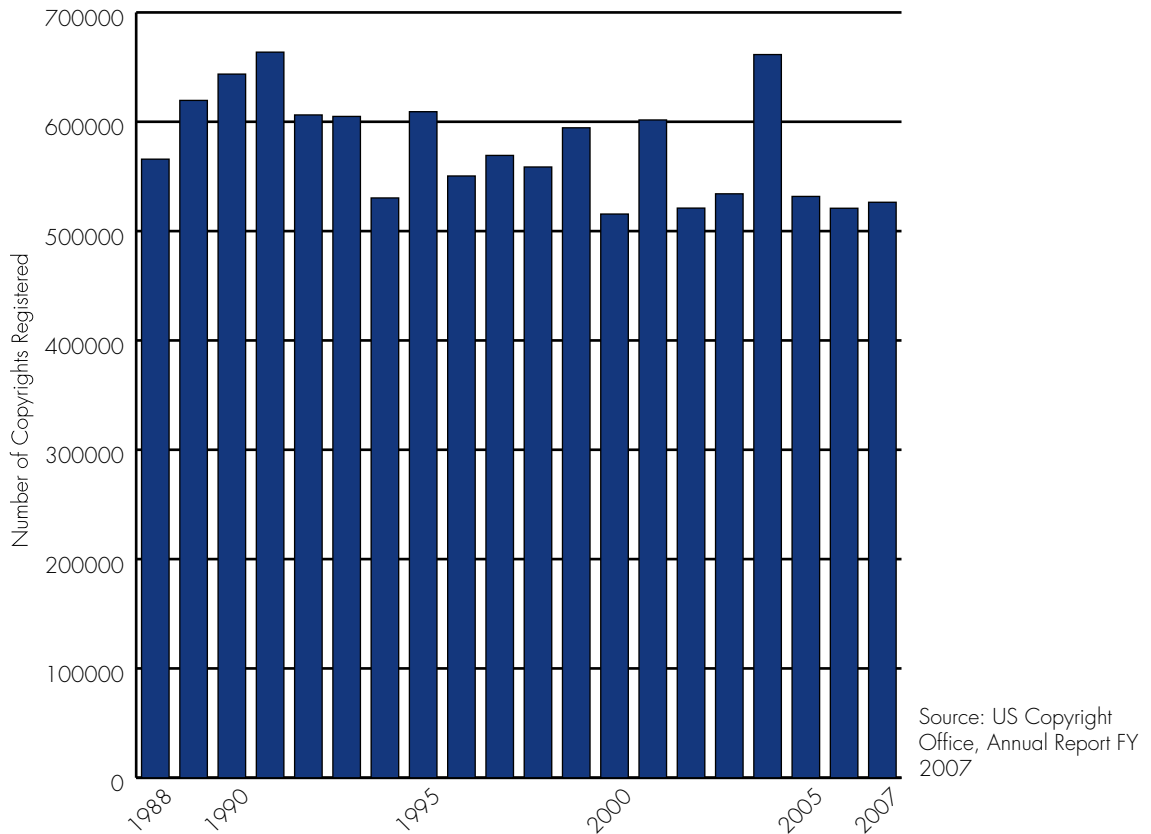
Note: Includes utility, plant, and reissue patents. Design patents are excluded.

\* The allowance rate is the percentage of patent applications on which a patent is granted.

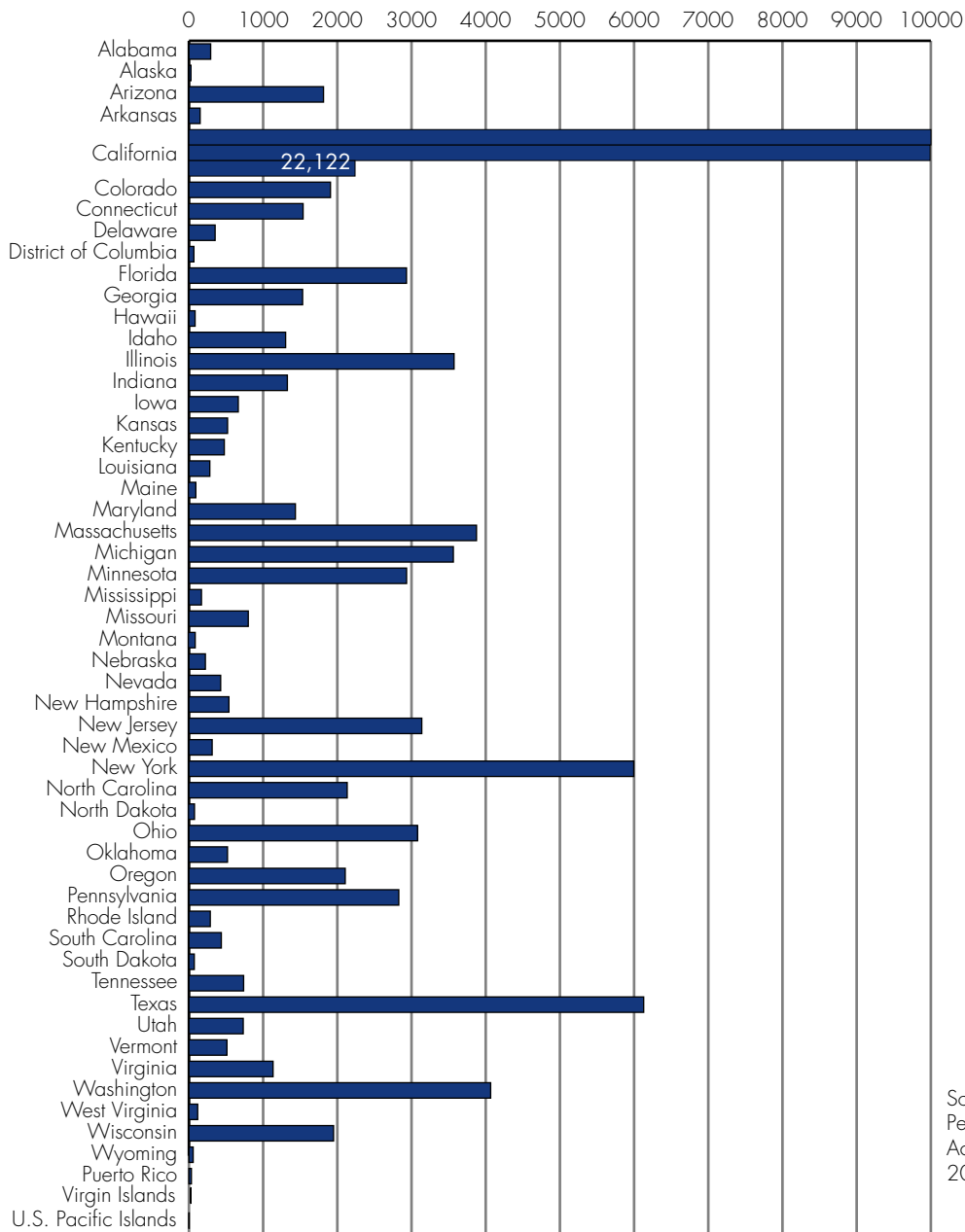
### U.S. Trademark Registrations (1993 - 2008)



### U.S. Copyright Registrations (1988 - 2007)



### U.S. Patents Granted by State of Residence (2008)



Source: USPTO Performance and Accountability Report FY 2008

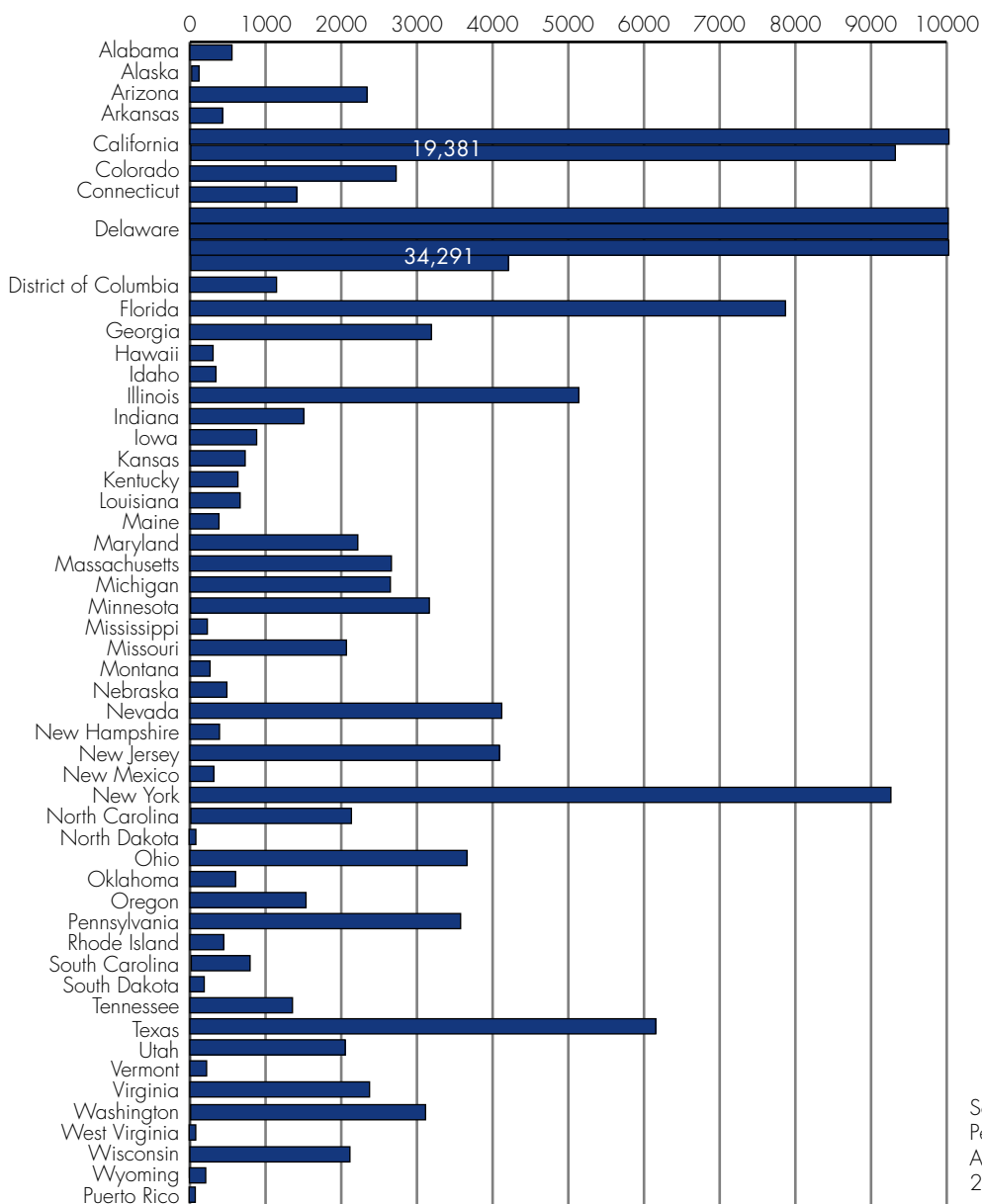
### Top 25 States Ranked by Patents Granted per Capita

Rank	State	Patents per 100,000 Inhabitants
1	Vermont	82.4
2	Idaho	81.7
3	Washington	62.0
4	California	60.2
5	Massachusetts	60.1
6	Oregon	56.2
7	Minnesota	55.6
8	Connecticut	45.3
9	Delaware	42.3
10	New Hampshire	41.1
11	Colorado	37.4
12	New Jersey	36.5
13	Michigan	35.6

14	Wisconsin	35.2
15	New York	30.5
16	Rhode Island	28.7
17	Arizona	28.4
18	Illinois	27.7
19	Ohio	26.9
20	Utah	26.1
21	Maryland	25.9
22	Texas	25.1
23	North Carolina	23.5
24	Pennsylvania	22.7
25	Iowa	21.1

Calculated using patent counts for FY 2008 and U.S. Census Bureau 2008 Population Estimates  
 Source: [www.census.gov/popest/states/NST-ann-est.html](http://www.census.gov/popest/states/NST-ann-est.html)

### U.S. Trademark Registrations by State of Residence (2008)



Source: USPTO Performance and Accountability Report FY 2008

### Top 25 States Ranked by Trademark Registrations per Capita

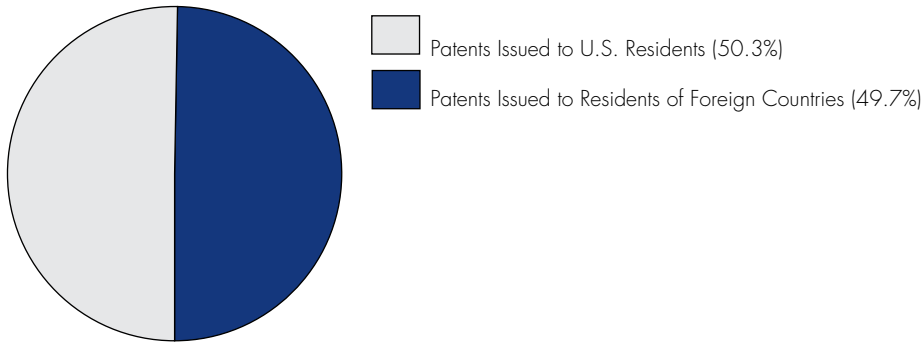
Rank	State	Trademarks per 10,000 Inhabitants
1	Delaware	392.8
2	District of Columbia	19.0
3	Nevada	15.8
4	Minnesota	6.0
5	Colorado	5.5
6	California	5.3
7	Utah	5.2
8	Washington	4.9
9	New York	4.8
10	Wyoming	4.7
11	New Jersey	4.6
12	Rhode Island	4.4
13	Vermont	4.2

14	Florida	4.2
15	Oregon	4.2
16	Connecticut	4.1
17	Illinois	4.0
18	Maryland	3.9
19	Wisconsin	3.8
20	Arizona	3.6
21	Missouri	3.5
22	Maine	3.4
23	New Hampshire	3.4
24	Georgia	3.3
25	Ohio	3.3

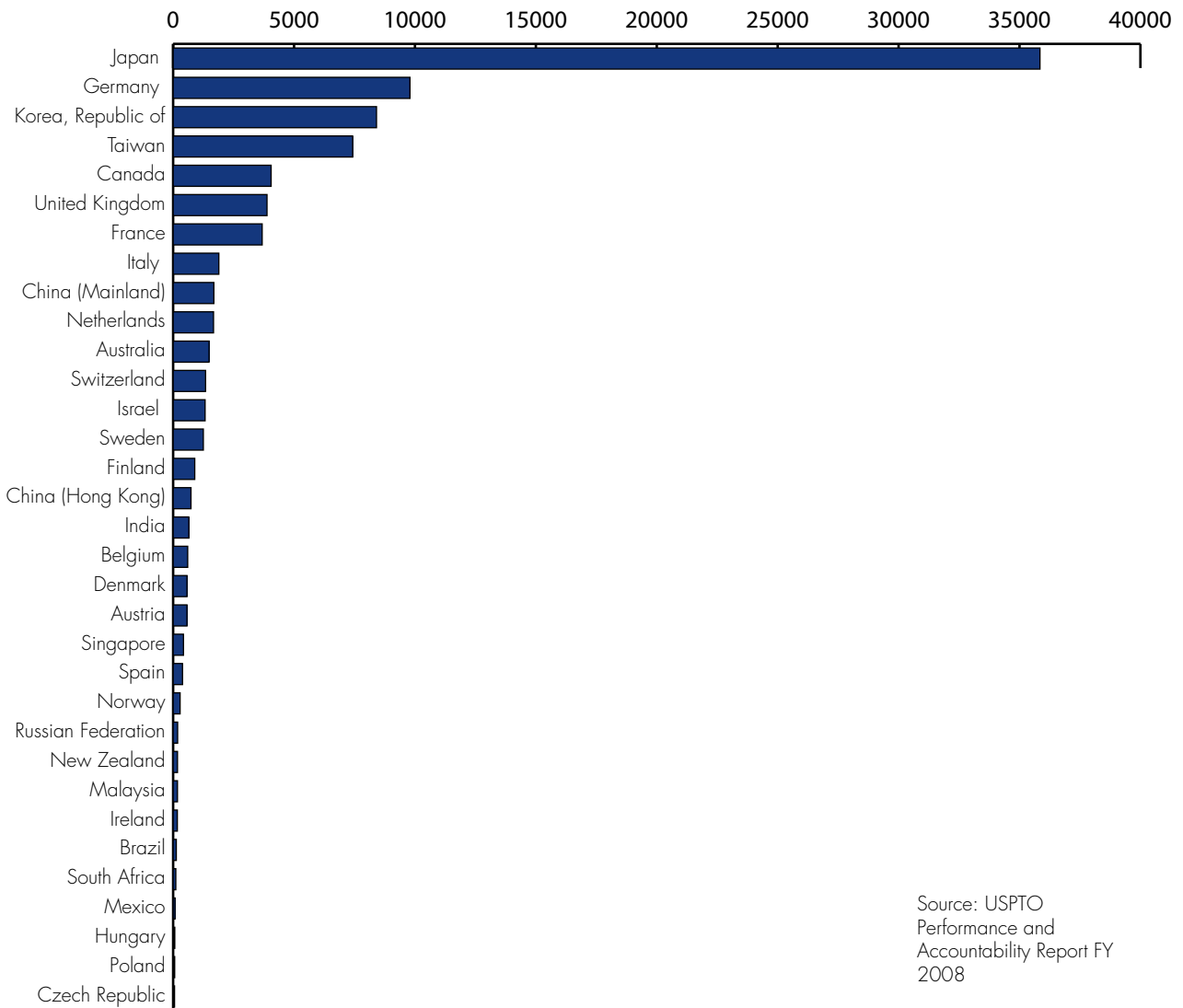
Calculated using trademark counts for FY 2008 and U.S. Census Bureau 2008 Population Estimates



### U.S. Patents Granted by Country of Residence (2008)

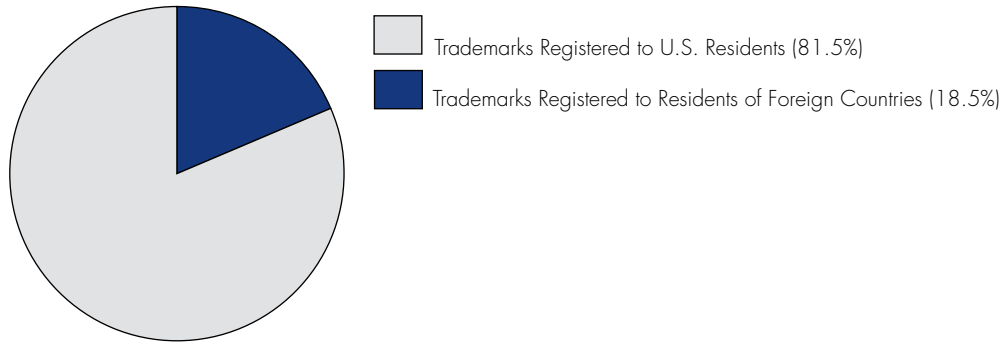


### U.S. Patents Granted to Residents of Foreign Countries (2008)

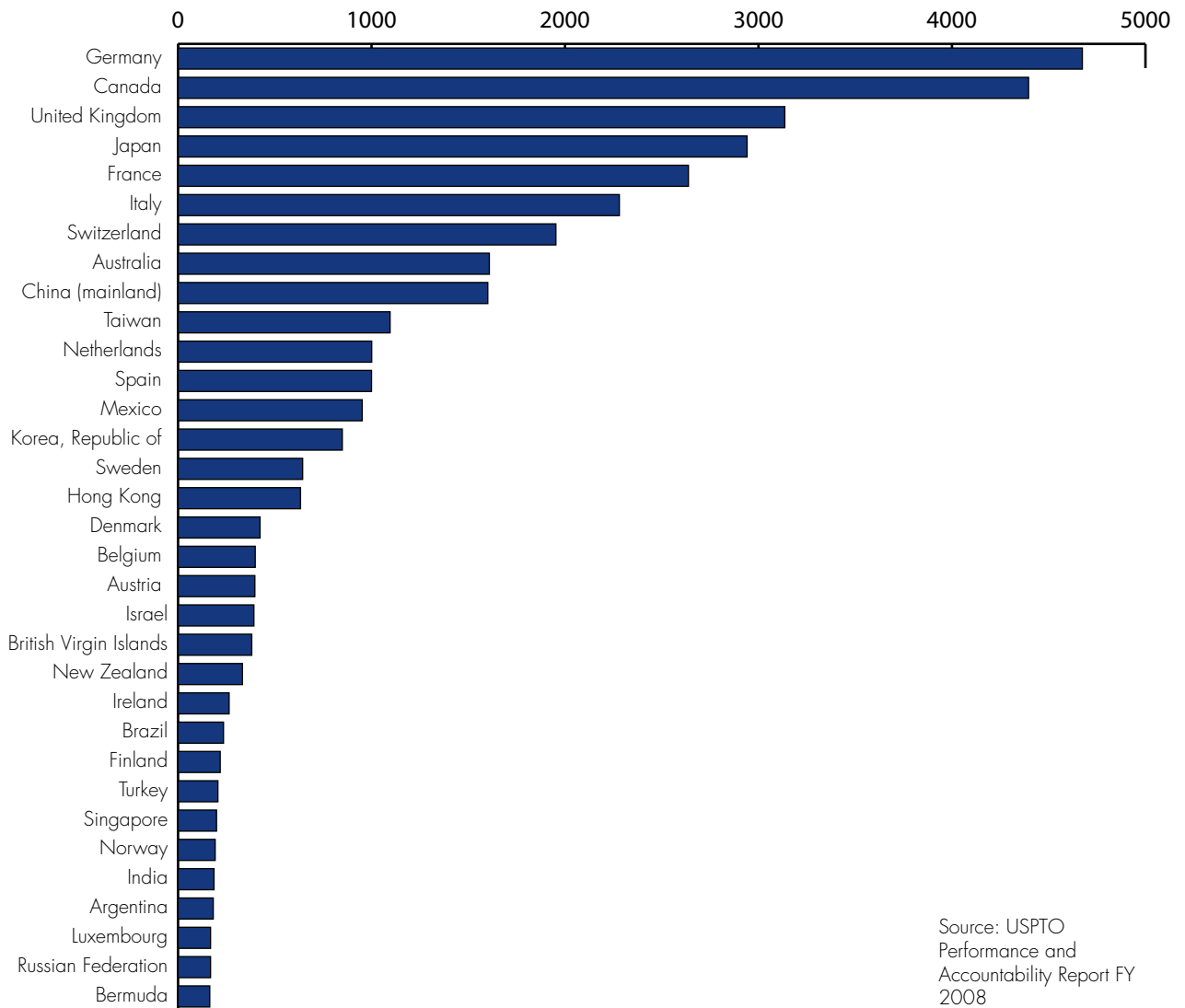


Source: USPTO  
Performance and  
Accountability Report FY  
2008

### U.S. Trademark Registrations by Country of Residence (2008)

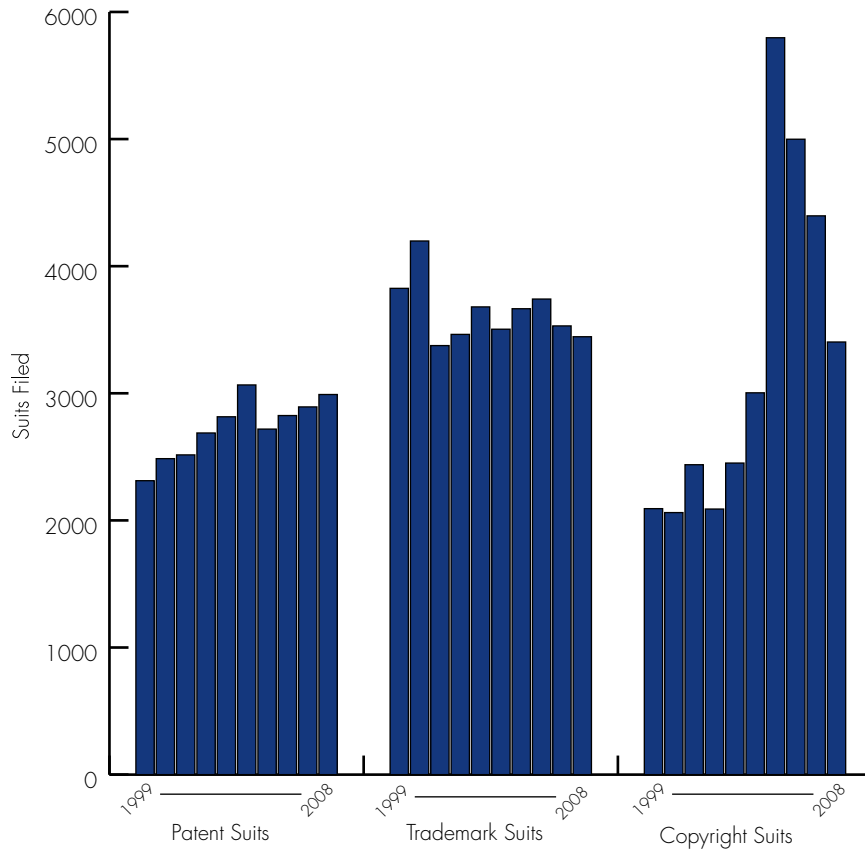


### U.S. Trademarks Registrations to Residents of Foreign Countries (2008)



Source: USPTO  
Performance and  
Accountability Report FY  
2008

### Patent, Trademark, and Copyright Suits in U.S. District Courts, by Year (1999 - 2008)



Source: Judicial Business of the United States Courts, 2008 Annual Report of the Director

## U.S. District Courts with Most Patent Suits Filed in 2008

Rank	District	Suits Filed
1	Texas, Eastern	322
2	California, Central	244
3	New Jersey	191
4	Delaware	187
5	California, Northern	169
6	Illinois, Northern	153
7	New York, Southern	121
8	California, Southern	92
9	Michigan, Eastern	72
10	Georgia, Northern	60
11	Massachusetts	59
12	Virginia, Eastern	58
13	Minnesota	57
14	Ohio, Northern	55

## U.S. District Courts with Most Trademark Suits Filed in 2008

Rank	District	Suits Filed
1	California, Central	556
2	New York, Southern	285
3	Florida, Southern	164
4	Illinois, Northern	145
5	California, Northern	144
6	New Jersey	116
7	Texas, Southern	105
8	Florida, Middle	100
9	Nevada	90
10	Texas, Northern	89
11	Arizona	88
12	Michigan, Eastern	84
13	Georgia, Northern	81
14	New York, Eastern	77

## U.S. District Courts with Most Copyright Suits Filed in 2008

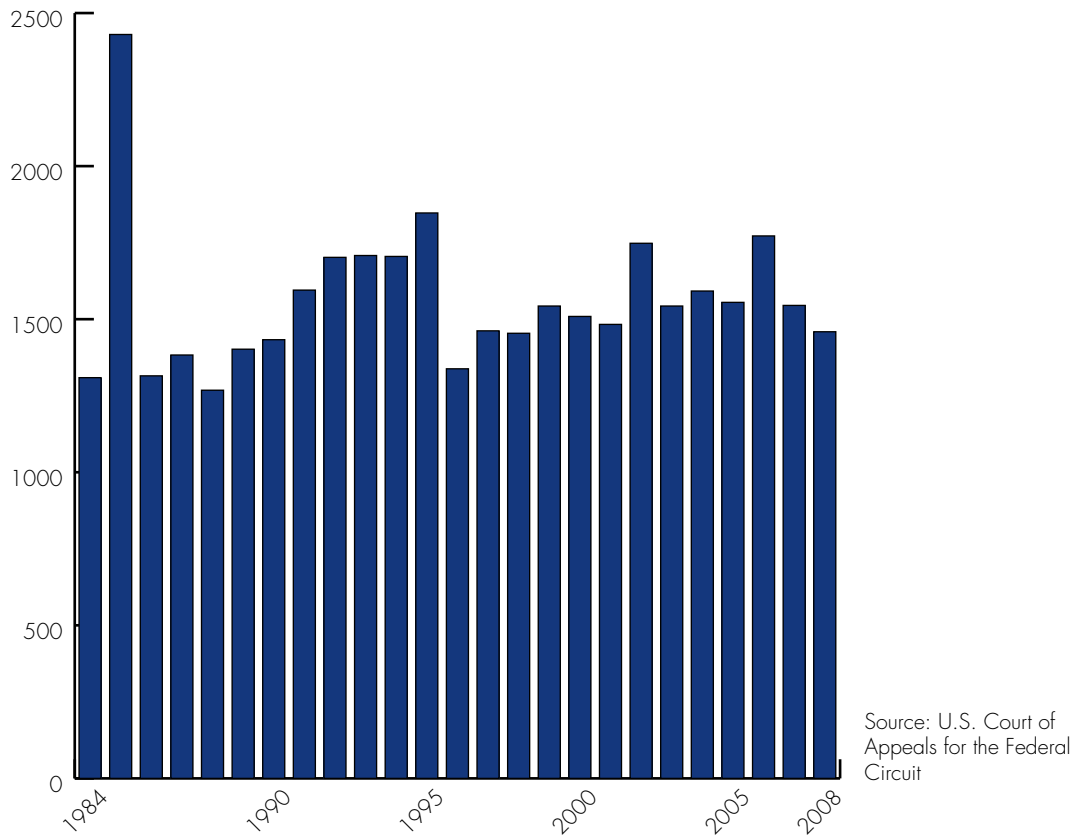
Rank	District	Suits Filed
1	California, Central	595
2	New York, Southern	289
3	Pennsylvania, Eastern	167
4	California, Northern	166
5	Texas, Western	152
6	N. Carolina, Eastern	97
7	Illinois, Northern	88
8	Massachusetts	74
9	Florida, Middle	66
10	New York, Eastern	60
11	Texas, Northern	59
12	Florida, Southern	58
13	Washington, Western	57
14	Texas, Southern	56

## U.S. District Courts with Most IP Suits Filed in 2008

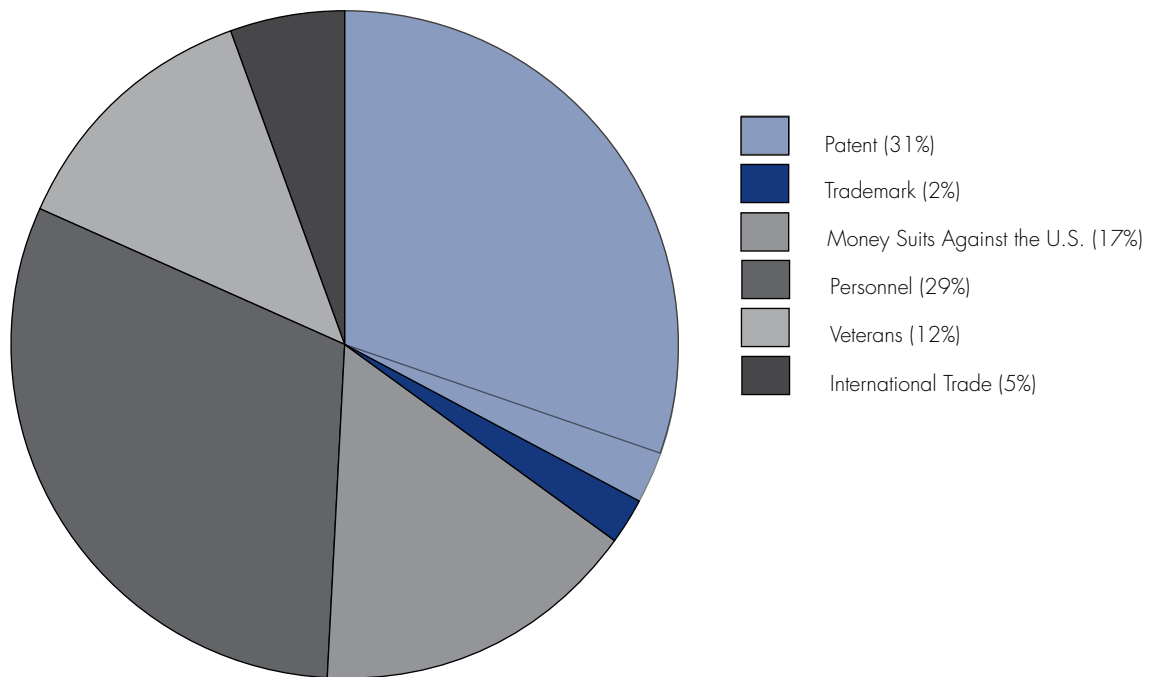
Rank	District	Suits Filed
1	California, Central	1395
2	New York, Southern	695
3	California, Northern	479
4	Illinois, Northern	386
5	New Jersey	361
6	Texas, Eastern	358
7	Pennsylvania, Eastern	279
8	Florida, Southern	266
9	Florida, Middle	220
10	Texas, Western	218
11	Delaware	214
12	Michigan, Eastern	206
13	California, Southern	197
14	Texas, Northern	195

Source: Judicial Business of the United States Courts, 2008 Annual Report of the Director

### Federal Circuit Court of Appeals Overall Caseload, by Year (1984 - 2008)

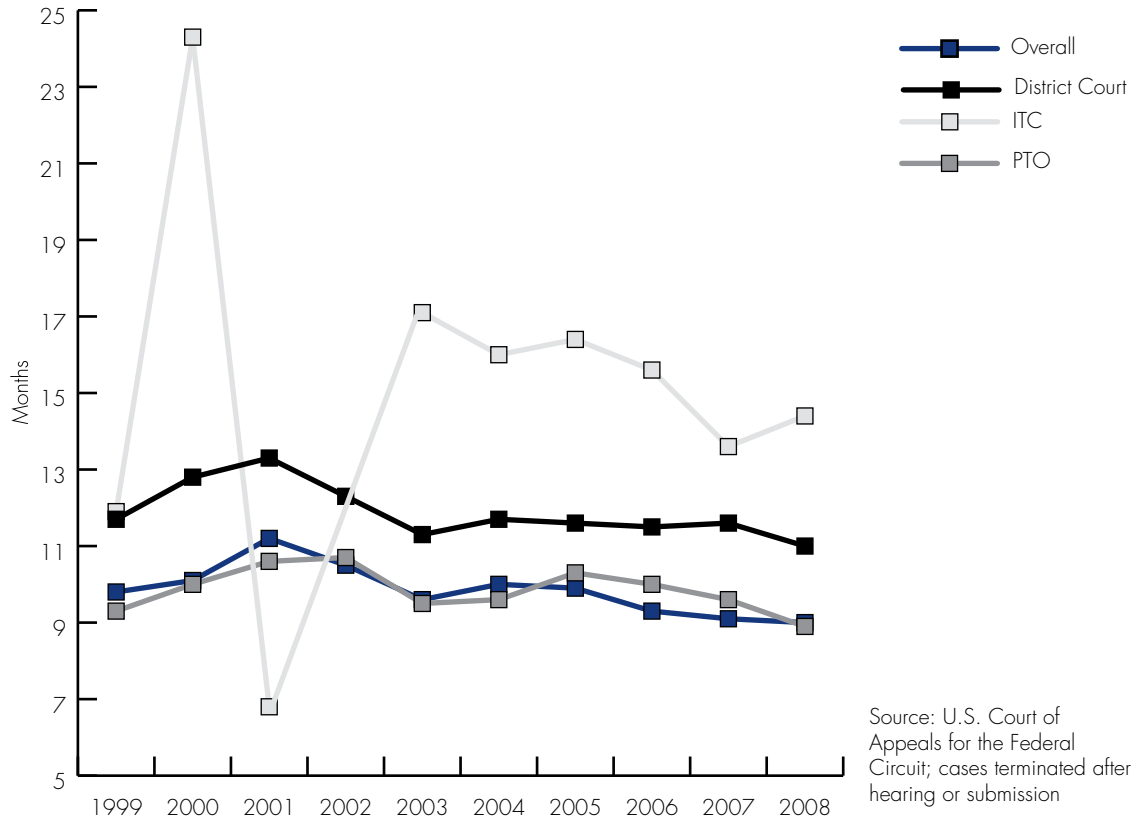


### Federal Circuit: Appeals Filed, by Category (FY 2008)

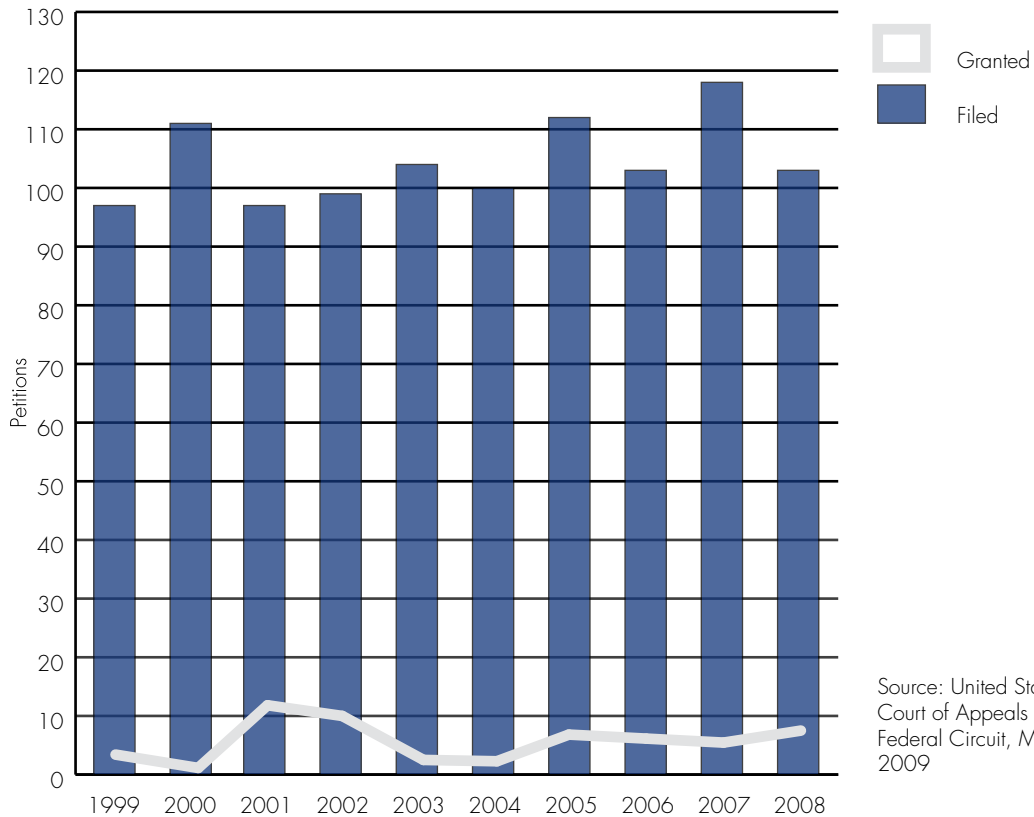


Source: United States Court of Appeals for the Federal Circuit, April 2009

### Federal Circuit, Median Time to Disposition of Appeals



### Certiorari Petitions to U.S. Supreme Court from Federal Circuit (FY 1999 - FY 2008)



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## **IPO's 4-Star Federal Circuit Summaries™ 2008 - 2009\***

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IPO publishes one-paragraph summaries of every precedential patent and trademark opinion issued by the Court of Appeals for the Federal Circuit. The summaries are distributed via the IPO Daily News™ and archived on the IPO website. Each decision is ranked on importance with, 4 stars being the highest ranking.

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### **U.S. Supreme Court Rules That Federal Circuit Had Jurisdiction to Review District Court's Remand of Invention Ownership Claim to State Court -- *Carlsbad Technology Inc. v. HIF Bio, Inc.* 07-1437 -- May 4, 2009**

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In an opinion by Justice Thomas, the U.S. Supreme Court overruled a Federal Circuit holding that the Federal Circuit lacked jurisdiction to review a U.S. district court's remand to a state court. The district court remanded a dispute over ownership of an invention and inventorship - issues of state law - to the state court. The remand was ordered after the district court dismissed a RICO claim, a matter of federal law. The Supreme Court decided the district court retained "supplemental jurisdiction" over the state law claims, so the district court's remand was discretionary and reviewable by the Federal Circuit. Three justices filed concurring opinions.

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### **Federal Circuit Relies on KSR and Older "Obvious to Try" Case to Hold Biotech Invention Obvious -- *In re Kubin* 2008-1184 -- April 3, 2009**

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In an opinion by Judge Rader, the Federal Circuit upheld a USPTO ruling that Kubin's DNA molecules encoding a protein known as "NAIL" were obvious over the combined teachings of prior art references. The Federal Circuit reviewed the "obvious to try" doctrine and repudiated its 1995 Deuel opinion in favor of its 1988 O'Farrell opinion and the Supreme Court's KSR opinion. According to the Federal Circuit, quoting O'Farrell, "obvious to try" is erroneously equated to obviousness if (1) the inventor is faced with "numerous possible choices . . . where the prior art gave either no indication of which parameters were critical or no direction as to which of many possible choices is likely to be successful" or (2) "the prior art gave only general guidance as to the particular form of the claimed invention or how to achieve it." In the Kubin case, a skilled artisan would have had a "reasonable expectation of success" in obtaining the claimed invention in light of the prior art. The court declined to adopt "formalistic rules" that would categorize entire classes of prior art as predictable or unpredictable.

\* Through May 2009



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## IPO's 4-Star Federal Circuit Summaries™

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### Split Federal Circuit Holds USPTO Had Authority to Limit Number of Claims and RCEs and Require Examination Support Documents But Not to Limit Number of Continuations -- *Tafas v. Doll 2008-1352* -- March 20, 2009

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In a majority opinion by Judge Prost, a split 3-judge panel of the Federal Circuit overturned in part a summary judgment by the U.S. District Court for the Eastern District of Virginia that controversial patent rules proposed by the USPTO exceeded the scope of the USPTO's rulemaking authority. The USPTO does not have "substantive" rulemaking authority, but courts should give "Chevron deference" to USPTO interpretations of statutes relating to exercise of "procedural" rulemaking authority. The Federal Circuit majority said that while it did not "purport to set forth a definitive rule for distinguishing between procedure and substance . . .," the rules at issue were procedural. The majority upheld USPTO authority to adopt rules that (1) limit an applicant to one request for continuing examination ("RCE"), (2) limit an applicant to 5 independent and 25 total claims, in the absence of an examination support document ("ESD"), and (3) impose several requirements in an ESD including requirements to conduct a prior art search and explain why claims are patentable over the prior art. The majority upheld the district court on the rule limiting applicants to two continuation applications because the rule was inconsistent with patent code section 120. The section states that an application "shall" have the benefits of a continuation if the requirements of the section are met. The court remanded the case for decisions on other issues.

### Judge Rader in Dissent Says All Patent Rules in Suit Are Substantive and Exceed USPTO Authority; Judge Bryson Concurrs With Majority But Says Statute May Allow USPTO to Impose Different Limit on Continuations -- *Tafas v. Doll 2008-1352* -- March 20, 2009

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The March 20 decision by the Federal Circuit included a majority opinion by Judge Prost, summarized earlier, a concurring opinion by Judge Bryson, and a dissenting opinion by Judge Rader. Bryson agreed with the result reached by the majority, but seemed to make a suggestion for how the USPTO might revise its rule limiting the number of continuations to make it consistent with patent code section 120. Bryson distinguished between "serial" continuations and "parallel" continuations. Rader dissented in a 14-page opinion. He argued strongly that all of the rules were substantive and therefore exceeded the USPTO's authority. The rules "drastically change the existing law and alter an inventor's rights and obligations . . ." Rader said that with less ability to claim "myriad methods of making, methods of use, species and intermediates . . .," an inventor will have less incentive to disclose the full dimension of the technological advance.

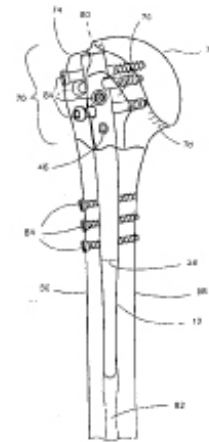
## IPO's 4-Star Federal Circuit Summaries™

### Federal Circuit by Vote of 7 to 5 Refuses En Banc Rehearing of Whether Business Method for Conducting Arbitration Was Patent-Eligible Subject Matter -- *In Re Comiskey*, 06-1286 -- January 13, 2009

The Federal Circuit denied a rehearing en banc by a vote of 7 to 5, with two concurring and two dissenting opinions, but authorized the 3-judge panel that authored the court's 2007 opinion to revise it. A revised panel opinion by Judge Dyk was issued on the same day. The claims at issue were for methods and systems for conducting mandatory arbitration involving legal documents such as wills and contracts. The original and revised opinions held that Comiskey's method claims, which depended entirely on the use of mental processes, did not contain patentable subject matter under patent code section 101. The revised opinion remanded system claims that could be interpreted to require the use of a machine for a USPTO determination of patentability under section 101. The concurring and dissenting opinions on whether to rehear the case en banc dealt in part with whether the Federal Circuit panel had authority to uphold the rejection of claims on an alternative ground, section 101, when the USPTO had rejected the claims as obvious under section 103.

### Permanent Injunction in Orthopedic Nail Case Upheld Despite Licenses to Others and Argument That Infringing Product Was Superior to Patent Owner's Product -- *Acumed LLC v. Stryker Corp.* 2008 - 1124 -- December 30, 2008

In an opinion by Judge Lourie, the Federal Circuit held the district court did not abuse its discretion in granting a permanent injunction to Acumed to prohibit Stryker from infringing a patent on a type of orthopedic nail. The Federal Circuit analyzed the issue under the four eBay factors, combining the first and second factors: (1) and (2) Irreparable harm and lack of remedy at law, (3) Balance of hardships, and (4) Public Interest. Re factors (1) and (2), licenses by Acumed to others did not preclude an injunction in the particular circumstances. "Adding a new competitor to the market may create an irreparable harm that the prior licenses did not." Re factor (3), the infringing product represented a small portion of Stryker's sales while Acumed's product covered by the patent was one of its flagship products. Re factor (4), evidence that Stryker's product was medically superior to Acumed's was inconclusive and products of Acumed's licensees were alternatives available to the public. The court noted, "[T]he essential attribute of a patent grant is that it provides a right to exclude competitors from infringing the patent. . . ." ". . . this was a close case."



U.S. Patent No. 5,472,444

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## IPO's 4-Star Federal Circuit Summaries™

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### Landmark Ruling Requires Eastern District of Texas to Transfer Patent Infringement Case to Ohio -- *In re TS Tech USA Corp.*, Misc. Docket No. 888 -- December 29, 2008

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In an order by Judge Rader, joined by Chief Judge Michel and Judge Prost, the Federal Circuit granted TS Tech's petition for a writ of mandamus to direct the U.S. District Court for the Eastern District of Texas to transfer the suit to the U.S. District Court for the Southern District of Ohio. Lear Corp. is alleging infringement by TS Tech of a patent on vehicle headrest assemblies. TS Tech's principal place of business is in Ohio and Lear's is in Michigan. The Federal Circuit applied the law of the 5th Circuit's recent, well-publicized, en banc opinion in *In re Volkswagen of America, Inc.*, which was not a patent case. The Federal Circuit ruled that the Eastern District of Texas clearly abused its discretion by (1) giving inordinate weight to the plaintiff's choice of venue, (2) ignoring the cost of attendance of witnesses, (3) ignoring the ease of access to physical and documentary evidence, and (4) disregarding the public interest in having localized interests decided at home.

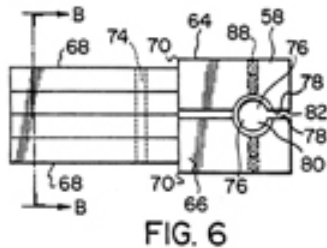
### Testimony of Patent Lawyers on Validity and Infringement is Inadmissible -- *Sundance, Inc. v. DeMonte Fabricating Ltd.* 2008 -1068 -- December 24, 2008

---

In an opinion by Judge Moore, the Federal Circuit ruled that Sundance's patent claim for a retractable cover system for truck trailers was obvious. Notably, the Federal Circuit decided that testimony of DeMonte's expert witness, a patent lawyer, on issues of infringement and validity was inadmissible, because he was not a qualified technical expert in the prior art. "Allowing a patent law expert without any technical expertise to testify on the issues of infringement and validity amounts to nothing more than advocacy from the witness stand." In a footnote, the Federal Circuit said, "... patent lawyers might offer testimony in contexts other than noninfringement and invalidity, such as patent office practice and procedure . . . ." The Federal Circuit in previous cases has upheld a district court's discretion to exclude testimony by a patent law expert, but apparently has not until now held that allowing a patent law expert to testify on invalidity and infringement is always an abuse of discretion.

## IPO's 4-Star Federal Circuit Summaries™

### Four Concurring and Dissenting Opinions on Patent-Eligible Processes Summarized -- *In re Bilski 2007-1130* -- October 30, 2008



U.S. Patent No. 5,026,109

Judge Dyk, in a 20-page concurring opinion joined in by Judge Linn, supported the majority opinion and responded to Judges Newman and Rader by reviewing the history of patent code section 101 back to 1793 and early English patent law. Judge Newman in a 41-page dissenting opinion said the majority interpreted section 101 and Supreme Court opinions too narrowly and may have cast doubt on the validity of thousands of business method patents. Judge Mayer, going in the other direction in a strongly-worded, 25-page dissenting opinion, said the court should have repudiated the State Street decision and the patentability of business method patents. He said State Street “launched a legal tsunami . . . .” In a 10-page dissenting opinion, Judge Rader said the majority disrupted settled principles of law and could have issued a single sentence opinion: “Because Bilski claims merely an abstract idea, this court affirms the Board’s rejection.”

### Landmark Federal Circuit Opinion Adopts “Machine-or-Transformation Test” for Patent-Eligible Processes -- *In re Bilski 2007-1130* -- October 30, 2008

In an en banc majority opinion by Chief Judge Michel, the Federal Circuit upheld the USPTO’s rejection of Bilski’s claims for a process of hedging risk in commodities trading. Among others, claim steps were: “initiating a series of transactions between [a] commodity provider and consumers . . . .” and “identifying market participants . . . having a counter-risk position. . . .” The Federal Circuit characterized the issue as whether the claims would pre-empt substantially all uses of a fundamental principle. The sole test for whether a process is patent-eligible subject matter is the “machine-or-transformation test,” which “is a two-branched inquiry; an applicant may show that a process claim satisfies section 101 either by showing that his claim is tied to a particular machine, or by showing that his claim transforms an article [into a different state or thing].” The court said “mere field-of-use limitations,” “insignificant postsolution activity,” and a “data gathering step” are generally insufficient to render a process patent-eligible. Electronic transformation of data into a visual depiction can be sufficient. The court rejected other section 101 tests: (1) the Freeman-Walter-Abele test for whether an algorithm is applied to physical elements or process steps, (2) the State Street “useful, concrete and tangible result” test, and (3) the “technological arts” test.

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## IPO's 4-Star Federal Circuit Summaries™

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**“Point of Novelty” Test for Design Patent Infringement Eliminated; “Ordinary Observer” Test the Sole Test -- *Egyptian Goddess, Inc. v. Swisa, Inc.* 2006-1562 – dissenting opinion -- September 22, 2008**

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In an opinion by Judge Bryson, the Federal Circuit en banc decided that the “point of novelty” test should no longer be used in analyzing issues of design patent infringement. The “ordinary observer” test should be the sole test. In some instances the ordinary observer test should include a “comparison of the claimed and accused designs with the prior art . . . .” The burden of production of prior art is on the accused infringer. In addition, the court said, “ordinarily,” a district court should not attempt to “construe” a design patent by providing a detailed verbal description of the design. Although the en banc court disagreed with the use of the “point of novelty” test, the en banc court agreed with the earlier decision by a 3-judge panel that Egyptian Goddess’s design patent for a nail buffer was not infringed.

**USPTO Patent Reexamination Was Proper Despite Earlier Consideration of Same Prior Art in District Court and Earlier Consideration in Different Context in USPTO -- *In Re Swanson* 2007-1534 -- September 4, 2008**

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In an opinion by Judge Gajarsa, the Federal Circuit upheld a USPTO decision that “a substantial new question of patentability” was presented for purposes of a USPTO patent reexamination proceeding. The invention was a method for analyzing small amounts of biological fluids by using “reaction zones” spaced on a test strip. The USPTO allowed the claims originally after making rejections based on prior art including the “Deutch” reference. Patent owner Abbott sued Syntron Bioresearch in a district court and the court held, and the Federal Circuit affirmed, that Syntron did not prove by clear and convincing evidence that the claims were invalid in light of the prior art. After the suit, Syntron requested ex parte reexamination, asserting the claims were anticipated or obvious in light of the Deutch reference. The Federal Circuit held a substantial new question of patentability was presented because (1) considering a question in district court is not the equivalent of having the USPTO consider it, as the standard of proof – a preponderance of evidence – is lower in the USPTO and (2) the Deutch reference originally was considered by the USPTO only in a different context, as a secondary reference.

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### Federal Circuit Emphasizes Requirement to Show Threshold Levels of Both Materiality and Intent to Deceive by Clear and Convincing Evidence in Patent Inequitable Conduct Cases -- *Star Scientific, Inc. v. R.J. Reynolds Tobacco Co.* 2007-1448 -- August 25, 2008

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In an opinion by Chief Judge Michel, the Federal Circuit overturned rulings of inequitable conduct and claim indefiniteness for patents on processes for preventing formation of carcinogenic nitrosamines during curing of tobacco. The district court clearly erred in finding materiality of the withheld information, which was a letter from a scientist to Star's patent attorney, and in finding intent to deceive. The appeals court emphasized that R.J. Reynolds had the burden of showing at least a threshold level of both materiality and intent. The district court said Star's explanation of circumstances relating to intent was not credible, but Star did not need to offer an explanation until R.J. Reynolds carried its burden of proving a threshold level of intent by clear and convincing evidence. On the materiality issue, the withheld letter was cumulative of other information disclosed. Courts must strictly enforce the burden of proof and elevated standard of proof and then exercise discretion on whether to render a patent unenforceable.

### Federal Circuit Upholds "Categorical Rule" That Patent Owner Cannot Obtain Permanent Injunction by Showing Irreparable Harm to Its Exclusive Licensee -- *Voda v. Cordis Corp.* 2007-1297, -1343 -- August 18, 2008

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In an opinion by Judge Gajarsa, the Federal Circuit upheld a district court's denial of a permanent injunction against infringement of Voda patents for cardiac guide catheters. Plaintiff Jan K. Voda, a medical doctor, attempted unsuccessfully to prove irreparable injury by alleging irreparable harm to his exclusive licensee. In an analysis consuming slightly more than one page of a 29-page opinion devoted largely to other issues, the Federal Circuit said the district court did not err "in adopting a categorical rule that precludes a patent owner from proving its entitlement to an injunction by showing irreparable harm to its exclusive licensee." The court said nothing in the Supreme Court's 2006 eBay opinion eliminates the requirement that a party seeking a permanent injunction must show that the party itself has suffered irreparable injury. In addition, the district court "did not clearly err or abuse its discretion in finding that monetary damages were adequate to compensate Voda."

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### Potential Infringer Lacked Basis for Declaratory Judgment Suit When Patent Owner Merely Marked Patent Numbers on Its Product and Failed to Sign Covenant Not to Sue -- *Prasco, LLC v. Medicis Pharmaceutical Corp.* 2007-1524 -- August 15, 2008

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In an opinion by Judge Gajarsa, the Federal Circuit upheld a ruling that no case or controversy existed under Article III of the U.S. Constitution to support a Prasco suit for a declaratory judgment that it did not infringe Medicis patents. Medicis marketed a benzoyl peroxide cleansing product, TRIAZ®, which was marked as being covered by four patents. No controversy of sufficient “immediacy and reality” existed under the Supreme Court’s 2007 MedImmune opinion. Prasco did not demonstrate injury by showing, for example, reasonable apprehension of suit, a demand for royalty payments, or creation of a barrier to regulatory approval of a product. The court was not persuaded by Prasco’s arguments of (1) “paralyzing” uncertainty (since Prasco was already making a product), (2) Medicis’s marking of its own product with patent numbers, (3) one prior Medicis suit concerned with unrelated patents and products, or (4) or Medicis’s failure to sign a covenant not to sue.

### Research Tools for Testing Products That Are Subject to FDA Approval Are Not Exempt From Patent Infringement -- *Proveris Scientific Corp. v. Innovasystems, Inc.* 2007 - 1428 -- August 5, 2008

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In an opinion by Judge Schall, the Federal Circuit upheld an interpretation of patent code section 271(e)(1) that denied Innovasystems an exemption from patent infringement. The section exempts “patented invention[s] . . . solely for uses reasonably related to the development and submission of information” to the FDA. The Proveris patent was for a device for analyzing aerosol spray plumes. The patented device was not subject to FDA approval, but was used for testing inhaler devices that are subject to FDA approval. The Federal Circuit accepted Proveris’s argument that Congress did not intend to exempt research tools such as “microscopes, analytical balances, [and] computers . . . “ that may be used in a pharmaceutical laboratory but are not subject to FDA approval themselves. The Federal Circuit distinguished two Supreme Court cases.



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Patented Process for Electronic Auctioning of Municipal Bonds Not Infringed Because Bidders Who Performed Step of Inputting Data Were Not Under Control of Defendant That Performed Other Process Steps -- *Muniauction, Inc. v. Thomson Corporation* 2007-1485 -- July 14, 2008

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In an opinion by Judge Gajarsa, the Federal Circuit overturned a decision that Thomson infringed Muniauction's patent for an electronic method of auctioning original issuer municipal bonds to bidders who typically purchase an entire bond offering. The Federal Circuit decided Thomson did not infringe because it did not perform every step of the claimed process itself or have another party perform the steps on its behalf. The step of "inputting data . . ." was performed by bidders. Thomson did not exercise "control or direction" over the entire process so that all of the steps were attributable to Thomson as required by the Federal Circuit's 2007 opinion in the BMC Resources case. The fact that Thomson controlled access to its system and instructed bidders on its use was not sufficient control or direction. The court also found several claims obvious because adapting electronic processes to incorporate modern web browser technology was "commonplace."

Shipments of Products "F.o.b" From Canada Into the U.S. Were Infringing Sales in the U.S. Under Patent and Copyright Law -- *Litecubes, LLC v. Northern Light Products, Inc.* 06-1646 -- April 28, 2008

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In a 34-page opinion by Judge Gajarsa, the Federal Circuit upheld a finding of patent and copyright infringement, although based on different grounds than the lower court. The suit was for infringement of Litecubes' rights in lighted artificial ice cubes. The Federal Circuit decided Northern Light made "sales" in the U.S. for purposes of infringement under patent code section 271(a) notwithstanding that Northern Light shipped the infringing products to U.S. customers "f.o.b." (free on board) from Canada, which meant that legal title was transferred while the products were still in Canada. The court gave a similarly expansive meaning to "distribute" and "sale" in the Copyright Act. The court also decided the U.S. territorial requirement in patent and copyright law is an element that must be established to prove infringement, but is not a requirement for a court's subject matter jurisdiction over an action. (Personal jurisdiction over the defendant was not contested in this case.)

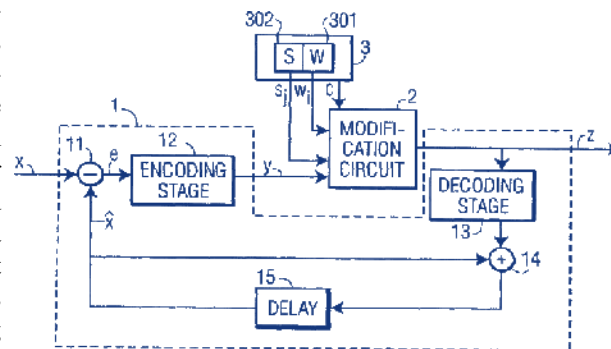
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### Federal Circuit Will Reconsider Business Method Patents -- *In re Bilski* 2007-1130 -- February 15, 2008

The Federal Circuit by its own action issued an order granting an en banc hearing in this case that has not yet been decided and posed five questions to be addressed by the parties in supplemental briefs. The questions were directed at the scope of patent-eligible subject matter under patent code section 101. Question 5 asks whether it is appropriate to reconsider the State Street Bank case, dealing with business method patents. The Bilski case is an appeal from the USPTO's rejection of patent claims for a method for managing the "consumption risk" of, for example, using more energy because of bad weather. The USPTO Board's opinion was 71 pages in length. (Normally IPO reports only precedential opinions and orders, but this non-precedential order is reported because of its importance.)

### Three Judges Dissent From Denial of En Banc Rehearing of Whether an Electrical Signal is a Manufacture -- *In re Nuijten* 2006-1371 -- February 11, 2008

The Federal Circuit denied a petition for en banc review of its October 20, 2007 decision. A dissenting opinion was filed by Judge Linn, in which Judges Newman and Rader joined. In the October decision, a 3-judge panel held that an electrical signal was not a "manufacture" and therefore not patentable subject matter. In his dissent from denial of a rehearing en banc, Judge Linn, who also dissented from the October decision, said the USPTO has allowed a claim to a storage medium containing the same signal on the ground that the storage medium is a manufacture, while in the USPTO view signals are unpatentable under the "printed matter" doctrine. He said, "These distinctions make no practical sense . . . ." He urged a "more holistic approach" to whether a claim is directed only to an unpatentable abstraction.



U.S. Patent No. 6,507,299

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## IPO Amicus Briefs Filed in 2008 - 2009\*

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IPO files amicus briefs in order to influence government IP policy for the benefit of members. The IPO Amicus Brief Committee and Board of Directors select a limited number of cases of interest to IPO members to file each year.

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### *Egyptian Goddess, Inc. v. Swisa, Inc.* (U.S. Court of Appeals for the Federal Circuit, No. 2006-1562) - IPO brief filed on February 5, 2008

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IPO urged the Court to issue an opinion “that clarifies the fundamental difference between design and utility patents and points in a new direction of design patent litigation that avoids excessive verbalization of the scope of design patents.”

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### *In re Bilski* (U.S. Court of Appeals for the Federal Circuit, No. 2007-1130) - IPO brief filed on April 7, 2008

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IPO said a process is patent-eligible subject matter “if it is tied to a particular machine or operates to transform matter into a different state or thing.”

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### *Muniauction, Inc. v. Thomson Corp* (U.S. Court of Appeals for the Federal Circuit, No. 2007-1485), IPO brief filed on August 2, 2008

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IPO urged the Federal Circuit to rehear the case on the issue of whether a patent infringer must perform every step of a process itself. The IPO brief stated, “. . . the panel has created an incentive for would-be infringers to perform every step in a patented process save one, which can then be performed by customers or other third parties . . . .”

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### *Tafas v. Dudas* (U.S. Court of Appeals for the Federal Circuit, No. 2008-1352), IPO brief filed on October 3, 2008

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IPO agreed with the district court that the rules proposed by the USPTO were “substantive rules that change existing law and alter the rights of applicants . . . under the Patent Act.” IPO argued that those changes would add to the costs and risk of patent prosecution and diminish legal rights.

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### *Broadcom Corp. v. Qualcomm, Inc.* (U.S. Court of Appeals for the Federal Circuit, No. 2008-1199), IPO brief filed on December 18, 2008

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The IPO brief argued that the absence of a legal opinion should not be considered in deciding intent to induce patent infringement. The brief said it was fair to allow opinions of counsel to be used only defensively.

For more information on IPO Amicus Briefs, see: <http://www.ipo.org/amicus>

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