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In this issue:

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1. Hope for Biotech Claims in View of *In re Bilski*?

Since the Federal Circuit issued its *In re Bilski* decision in October of 2008, there has been significant trepidation in the biotechnology community concerning its impact. Recent decisions from the Federal Circuit and guidelines from the PTO have begun to shed light on this subject and, while conflicting, offer a ray of hope for biotech claims.

2. Calculating Collateral Patent Damages: *Lucent v. Gateway* and the Entire Market Value Rule

When a patent owner proves infringement, U.S. patent law permits recovery of a reasonable royalty or an amount equal to the profits the patent owner would have made if the infringer had not infringed. Sometimes an infringer sells infringing and non-infringing components or products together. In these cases the Entire Market Value Rule can greatly increase the amount of a lost profits or reasonable royalty award.

3. Covenant Not to Sue May Invoke Patent Exhaustion Doctrine

Our August 23, 2009 article "International Exhaustion of Patents?" discussed the "exhaustion" principle, also known as the "First Sale Doctrine." Patent exhaustion is prompted by a first authorized and unrestricted sale of a patented product, and operates to terminate all patent rights to a protected product.

4. The Who, What, and When of Invention

Increasingly, inventions derive from collaboration between researchers at two or more organizations, and researchers are moving from one employer to another. Recent decisions highlight the importance of careful inventorship determinations when a patent application is first prepared and during its prosecution.

5. China's Disclosure of Origin Law to Enter Into Force on October 1, 2009

As of October 1, 2009, China's Patent Law will require disclosure of the origin of any genetic resources used in an invention for which patent protection is sought in China. With the entry into force of these changes to its Patent Law, China joins a growing number of countries that impose similar requirements on patent applicants.

6. Ralph Albrecht Named a Fellow of the American Bar Foundation

Venable partner **Ralph Albrecht**, an attorney in the Technology/Intellectual Property Division's Patent Prosecution Group, was recently named a Fellow of the American Bar Foundation (ABF). Albrecht practices in Venable's Tysons Corner, Virginia office.

Albrecht joins an elite group of attorneys nationally recognized for their leadership and professional excellence. Fellowship is a great honor and is limited to less than one percent of the attorneys in America. Albrecht is also the Immediate Past President of the Bar Association of the District of Columbia (BADC), the voluntary bar and nation's third oldest bar, founded in 1871.

The ABF was founded in 1952 by the American Bar Association (ABA) and is now recognized as the premier sociolegal research institute in the country. Fellows support the ABA's research, and participate in social events and educational programs during the ABA Midyear and Annual Meetings.

Albrecht joins twelve Venable attorneys in membership as Maryland Fellows: Benjamin R. Civiletti, Andrew Gendron, Paul T. Glasgow, James J. Hanks, Jr., John B. Howard, Dana Petersen Moore, Russell R. Reno, Jr., Kevin L. Shepherd, Nell B. Strachan, Paul F. Strain, Craig A. Thompson and Alan D. Yarbro.

7. Craig Thompson's Book Encourages Students to Invent

Venable attorney **Craig Thompson** has published "The ABCs of Black Inventors." The book covers African American inventions from A to Z, illustrating important contributions in the fields of engineering, biology, space exploration, telecommunications, agriculture, ultraviolet photography, nuclear power, and others.

Thompson is a partner in Venable's Baltimore office and represents clients in civil litigation and related counseling. He has used his analytical orientation and knowledge of technology to litigate technology disputes and help clients develop technology licensing programs.

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