

WHAT'S NEW — RESOURCE GUIDE

USPTO TO ELIMINATE THE DISCLOSURE DOCUMENT PROGRAM

*Provisional Patent Application Provides
More Benefits for Inventors*

The Department of Commerce's United States Patent and Trademark Office (USPTO) will eliminate its Disclosure Document Program on February 1, 2007. The USPTO implemented the Disclosure Document Program in 1969 to provide inventors not ready to file for a patent with an alternative method of establishing the date of conception of an invention. In the United States, priority for a patent goes to the person who is first to invent rather than to the person who is first to file a patent application. The date of conception is important in establishing who the first inventor is in the event another inventor applies for a patent for the same invention.

Under the Disclosure Document Program, the USPTO accepts, dates and retains for two years documents from inventors describing their inventions as evidence of the date the inventions were conceived. Very few inventors have used the Disclosure Document Program as part of the patent process, and some inventors who do use it erroneously believe that they are filing an application for a patent. In the over 3 million patents issued since 1976, only 1,330 (or 0.04%) reference a disclosure document.

Since 1995, inventors not ready to file a full patent application have been able to file a provisional patent application with the USPTO. A provisional application provides more benefits and protections to inventors than the disclosure document. A provisional patent application establishes a filing date and allows the term "patent pending" to be applied to the invention. A provisional application must contain a full disclosure of the invention, including drawings where necessary, and a cover sheet identifying the inventor(s). To maintain the priority date, a formal patent application for the invention must be filed with the USPTO within one year. A disclosure document is not an application for a patent and does not provide any benefits beyond establishing a conception date.

For more information, see the Federal Register notice: <http://www.uspto.gov/web/offices/com/sol/notices/71fr64636.pdf>.

THINKFIRE SECURES PATENT & TECHNOLOGY LICENSE ON BEHALF OF DIGITALCONTAINERS, CORP.

*Invention Facilitates Secure Updates for
Music and Video Downloads, Government
Mandated Compliance and E-Mailed
Documents*

ThinkFire, a leading intellectual property services firm, has successfully represented DigitalContainers Corp. in an agreement for use of the patents and know-how covering its valuable document security invention. The agreement provides significant advantage to SiteScape (<http://www.site-scape.com/>), a leading teamware, document management and workflow provider.

DigitalContainers' technology enables any digital material, including video, books, music, pictures, feature length films and documents, to be placed in a "container" which can be sent electronically to any recipient as an e-commerce object, permitting safe distribution of the material. The DigitalContainers inventions are covered by some fundamental patents and provide important controls for SiteScape documents in all phases of update.

"This technology will provide the SiteScape customer with complete document protection and compliance with many government standards and privacy initiatives," said Brian Hays, CEO and Chairman of the Board, SiteScape.

Current document management products permit a person who is authorized to update a particular document to retrieve it from the management system to bring it to her desktop, make updates and modifications (including keeping a local copy) and then post the new materials back into the document management system. The DigitalContainers' technology (<http://www.digitalcontainers.com/>) in combination with SiteScape's Forum product provides important controls for documents in all phases of the update process. DigitalContainers' technology provides SiteScape and its Forum product with:

- A digital container packager to "containerize" a document

- Control of the local update process, preventing a copy from being stored locally
- Return of the updated document to the Forum system or sending it to another user who will have to authenticate herself through the Forum controls before being granted access to the document
- Real-time control over the document
- Collaboration on large files

The volume of valuable and sensitive information, coupled with the easy and convenient methods for sharing files, have driven new mandates for protection and privacy. Requirements such as HIPPA (healthcare), Sarbanes-Oxley, FISMA and GISRA are just a few of the requirements now being placed on enterprise IT organizations. Significant increases in globalization and outsourcing also make the need for document security extremely timely.

"Technology licensing allows companies to quickly incorporate leading edge technology and expand their product reach," stated Kathie Lusardi, Vice President, Licensing for ThinkFire, who negotiated the license agreement. "The DigitalContainers inventions and know-how will enable SiteScape to provide significant security and distribution advantages without additional research and development costs."

About the Company

ThinkFire, Inc. (www.thinkfire.com) is an international intellectual property services firm that works with leading information technology, telecommunications, semiconductor, software and consumer electronics companies. ThinkFire's IP management resources help its clients increase profitability, minimize expense, and enhance freedom to operate. Earlier this year, the company concluded a sale of key communications patents for a Global 100 corporation which netted the patent owner approximately \$20 million and provided the purchasers with important assets that enhanced their portfolios.

ThinkFire's professionals include negotiators, market analysts, technologists and patent attorneys who have been previously associated with leading technology and professional services firms including IBM, British Telecom, Accenture, Siemens, PwC, Lucent Technologies, The McKenna Group,

and Intel. ThinkFire offices are located in greater New York, London and San Francisco.

**LEXISNEXIS COUNSELLINK
ENHANCED FOR LEGAL
SPEND MANAGEMENT**

New enhancements give attorneys access to topnotch business intelligence tools that make it easier to analyze matter and legal spend information

LexisNexis U.S., a leading provider of information and services solutions, announced significant enhancements to LexisNexis® CounselLink™, a one-stop solution for matter management, business intelligence and ebilling.

Users of the LexisNexis CounselLink services now have more options for displaying and analyzing law department operations and spend data on the fly. The integrated FactMine™ reporting tool has been upgraded to include deeper business intelligence capabilities that allow CounselLink clients to create robust reports and management dashboards with drag-and-drop technology and to export or deliver reports in a variety of formats.

“With the CounselLink solution, you’re able to make timely and informed business decisions because you can quickly view and analyze all your legal department’s spending and drill down for detailed information. For example, within CounselLink, corporate counsel can easily track the legal fees associated with a lawsuit, compare it to the budget, and collaborate with their law firms to develop the best strategy to achieve their company’s objectives,” said Marcus Linden, vice president, chief operating officer for LexisNexis Examen Inc. “The new CounselLink reporting enhancements make our leading-edge reporting tool even stronger and easier to use. We have made it easier to gather the information that corporate counsel needs and format it the way they want it. You don’t have to be an IT professional to create these custom reports.”

With these sophisticated reporting enhancements, users can now:

- Analyze and understand their data from different perspectives and easily “drill” down for more details within a report.
- Take advantage of more windows-like functions such as dialog boxes, mouse-over tool tips, and undo/redo buttons to easily navigate through the reports and dashboards.
- Rearrange any report with simple drag-and-drop actions or by clicking on new toolbar icons to get entirely new views of

To subscribe to Intellectual Property Today call 800.232.8078

the data, all from the same report and without IT assistance.

For more information, go to www.lexisnexis.com/counsellink/.

About LexisNexis

LexisNexis® (www.lexisnexis.com) is a leading provider of information and services solutions, including its flagship Web-based Lexis® and Nexis® research services, to a wide range of professionals in the legal, risk management, corporate, government, law enforcement, accounting and academic markets. A member of Reed Elsevier Group plc [NYSE: ENL; NYSE: RUK] (www.reedelsevier.com), LexisNexis serves customers in 100 countries with 13,000 employees worldwide.

USPTO AND THE EUROPEAN PATENT OFFICE TO LAUNCH ELECTRONIC PRIORITY DOCUMENT EXCHANGE

New Free Service Will Simplify Patent Application Procedures

The Department of Commerce’s United States Patent and Trademark Office (USPTO) and the European Patent Office (EPO) announced today that they are preparing to launch a new service that will allow patent application priority documents to be exchanged between the two offices electronically. Priority documents have to be filed when applicants wish to claim an earlier application filing date in one patent office based on a prior filing in another. Claiming priority is a valuable tool for businesses wanting to pursue patent rights globally. The new service, which will be free of charge to applicants, is the result of a 2005 agreement between the USPTO and the EPO and will pave the way for faster and more efficient processing in each office.

Under the Paris Convention for the Protection of Industrial Property, a treaty that provides a number of important rights for innovators, a patent applicant may file

an application in one Paris Convention member country (the priority document), and within 12 months, file corresponding applications in other member countries, while obtaining the benefit of the first application’s filing date. This 12-month period allows applicants to make important decisions about where to file subsequent applications to seek protection for their inventions. Paris Convention filings are a critical component in many applicants’ global business and patenting strategies and represent a substantial portion of worldwide patent activity. In order to obtain the benefit of an earlier filing, however, applicants are generally required to file paper copies of the priority document in each of the later-filing offices at their own expense. The new service will allow the USPTO and the EPO to obtain, with appropriate permissions, electronic copies of priority documents filed with the other office from its electronic records management system at no cost to the applicant.

“Electronic priority document exchange is a win for both applicants and our offices,” said Under Secretary of Commerce and USPTO Director Jon Dudas. “By leveraging our electronic file management systems, we can streamline our internal processing while providing our applicants with the substantial benefits of reduced expenses and paperwork.”

“The realization of the electronic priority document exchange is a major step towards a user-oriented, efficient patent system and a good example of the excellent cooperation between the EPO and the USPTO,” added EPO President Alain Pompidou. “It sets the standards for providing added value services in the future.”

Testing of the new service will be complete in early December, and full production is expected to begin in January 2007. Further details will be made available by each office prior to full production. **IP™**