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Upcoming Events

Monday, Sept. 27
USPTO Road Show

Thursday, Sept. 30
Member Networking and
Cocktail Social

**Tuesday, Nov. 4 -
Wednesday, Nov. 5**

Advanced PCT Seminar

President's Message

The Boston Patent Law Association continues to provide members with a variety of programs and functions – despite our hot summer! The Judges Dinner this year was held on June 4th and over 200 members and guests attended the event. The evening began with a cocktail reception held outside on the waterfront at the John Joseph Moakley United States Courthouse. We moved indoors for dinner, where our keynote speaker, Tyler “Dr. Vino” Colman, introduced the wine pairing to complement each course. Colman presented on “Wine Politics: How Governments, Environmentalists, Mobsters, and Critics Influence the Wines We Drink,” which is the title of his first book published in July 2008. I had the privilege to present this year’s BPLA Distinguished Public Service Award to the Honorable Rya W. Zobel for her significant involvement in a number of patent cases, as well as her involvement with the Federal Judicial Center, which provides training for new judges and CLEs for sitting judges. Judge Zobel graciously accepted the award, and entertained us with a “claim” reciting the key components of the plaque we awarded to her.

The BPLA Summer Outing was held at Fenway Park on Friday, July 16th when the Boston Red Sox took on the Texas Rangers. The BPLA was well represented in the 300 bleacher seats we were able to secure. The weather was extremely hot until a sudden rain shower cooled us off and caused a game delay.

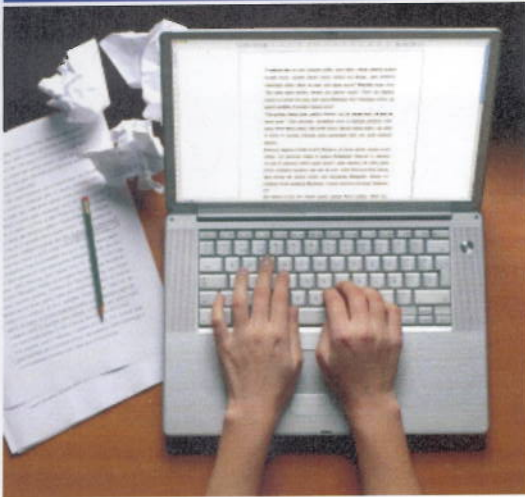


President Lisa Adams

Unfortunately, the game ended with the Rangers beating the Red Sox 8-4. But despite the loss, it was an exciting evening as Bengie Molina became the eighth player and first catcher since 1900 to hit for the cycle, even managing a grand slam.

As you may recall, back in April the Amicus Committee filed an amicus brief in the appeal of *Ex Parte Bilski*. The Supreme Court handed down a decision on June 28, 2010 rejecting the machine-or-transformation test as the sole test of process patent eligibility based on an interpretation of the language of §101. In the decision, Justice Kennedy cites to the BPLA amicus brief, which explained that the machine-or-transformation test would create uncertainty as to the patentability of software, advanced diagnostic medicine techniques, and inventions based on linear programming, data

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Countdown to 2013: Five Things Everyone Should Know About Recapture of Copyrights Under 17 U.S.C. § 203

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In just a few short years, the ownership of certain copyrights could undergo a drastic shift as authors seek to recapture their copyrights. Under the scheme set forth in 17 U.S.C. § 203, a grant of copyright or of any right under copyright executed by the author on or after January 1, 1978, is subject to "claw-back" right of termination by the author or his heirs under certain conditions. The year 2013 will be the first year in which authors can exercise the right to recapture their copyrights. However, the notice period for termination has already started for certain works, and will expire as early as next year for certain grants. As such, anyone who may advise clients regarding copyrights would be wise to keep these five things in mind.

1. § 203 does not apply to all transfers of copyright.

Not all transfers of copyright are subject to termination by the author under § 203. For example, the right to recapture copyrights does not extend to works made for hire or grants made by will. 17 U.S.C. § 203(a). Nor does the statute apply to rights arising under foreign laws. *Id.* at § 203(b)(5). Finally, derivative works prepared under the authority of a grant prior to termination may continue to be utilized even after termination. *Id.* at § 203(b)(1). However, this does not allow the former grantee to continue to prepare, post-termination, other derivative works based on the copyrighted work. *Id.*

2. Who may terminate a grant of copyright?

First and foremost, the statute provides that the author of a work may terminate a grant of copyright. This right is preserved even if the author has made an agreement to the contrary, including an agreement to make a will or to make a future grant. § 203(a)(5). However, it is incumbent upon the author to take action if he wishes to recapture a copyright; if the

author does not choose to terminate, the grant continues in effect unless otherwise provided. § 203(b)(6).

In the case of a work created by only one author, terminating a grant is straightforward and may be accomplished by the author himself. § 203(a)(1). If a grant was executed by two or more authors of a joint work, termination may be effected by a majority of the authors who executed the grant. *Id.*

The statute also contains provisions to allow for exercising the recapture right where an author is deceased. In the case of a grant executed by a single author, termination may be effected by the person(s) who, under § 203(a)(2), own and are entitled to exercise a total of more than half of the author's termination interest. Where a grant was executed by multiple authors of a joint work, the termination interest of the deceased author may be exercised as a unit by the person(s) who, under § 203(a)(2), own and are entitled to exercise a total of more than half of the author's interest.¹

3. When can termination be effected?

In most circumstances, an author may choose to recapture her rights at any time during a five-year window beginning thirty-five years from the date of the execution of the grant. § 203(a)(3). However, if the grant covers the right of publication, the five-year window commences at the end of thirty-five years from the date of publication of the work *or* at the end of forty years from the date the grant was executed, whichever term ends earlier. *Id.*

Although termination itself actually occurs during these five-year periods, the statute requires an author to serve an advance written notice of termination upon

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¹ 17 U.S.C. § 203(a)(2) provides a comprehensive scheme setting forth who may exercise a deceased author's termination interest. For more details, please refer to the statute.

2010 Judges Dinner Pictures



Hon. Richard and Patti Stearns



*Steve Henry, Matt Lowrie, Neil and Renee Ferraro,
Amy Mendel*

Count Down to 2013

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the grantee. Therefore, an author who wishes to recapture her rights must begin preparing for termination sufficiently in advance. This requirement is discussed below.

4. How is termination to be effected?

In order to terminate a grant of copyright, an author must serve a signed written notice upon the grantee. § 203(a)(4). The Copyright Office does not provide any forms for use in serving notices of termination. However, in general, the notice must state the effective date of the termination and must be served *no less than two* and no more than ten years before the termination date. § 203(a)(4)(A).

Once served, a copy of the notice must still be recorded in the Copyright Office before the date of termination to be effective. *Id.* The statute also mandates that the notice "shall comply, in form, content, and manner of service, with requirements that the Register of Copyrights shall prescribe by regulation." § 203(a)(4)(B). Under this authority, the Register of Copyrights has promulgated a set of regulations governing the content and service of notices of termination, which can be found at 37 C.F.R. § 201.10. The details of the regulations are beyond the scope of this article, but in general the notice must state that a termination is being made

under § 203, identify the work to which the notice applies and the grant being terminated, and state the effective date of termination 37 C.F.R. § 201.10(b)(2). The notice must be signed by each author who is terminating the grant and must be served upon each grantee whose rights are being terminated, either by personal service or first-class mail. *Id.* at § 201.10(c)-(d). Harmless errors will not render a notice of termination invalid. *Id.* at § 201.10(e).

5. The effects of termination

The future rights that will revert upon termination vest on the date the notice of termination is served. Then, upon the effective date of termination, the rights that were covered by the grant revert to the author(s) or other persons owning termination interests.² § 203(b). However, as noted above, a derivative work prepared under a grant before termination of that grant may continue to be utilized.

Conclusion

Beginning in 2013, it is expected that authors will increasingly seek to recapture their copyrights as more and more works become subject to termination. However, years before the date of termination, authors must take series of specific mandated steps. Failure to do so will result in loss of rights which, in many cases, may be extremely valuable.

Get ready. ♦

² The rights also revert to those owners who did not join in signing the notice of termination. § 203(b).