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# U.S. taking serious steps on international patents

By **ROSS DALY**  
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Though it sounds like a plea for a worldwide doo-wop concert, lawmakers in Washington are struggling with international harmonization, an effort to make U.S. patent law more compatible with laws in the rest of the world.

A key distinction is that most of the world uses a "first-to-file" system, where the first person to file with a patent office is presumed to have rights to a patent. The United States, by contrast, uses a "first-to-invent" method; that's less straightforward than the first-to-file method, and can lead to long and expensive battles over who is the true inventor.

When economies were relatively isolated, it was less important that patent systems be compatible, said Paul Esatto, a partner who works on patent applications and litigation with the Garden City firm of Scully, Scott, Murphy & Presser PC. But globalization has tied the world's economies more tightly together, and patent law needs to respond, he noted.

"I think we have to get to a point throughout the world where all the patent offices cooperate and all the patent laws are similar," Esatto said.

In general, larger companies with international dealings favor first-to-file. But smaller companies, universities and independent investors worry that they wouldn't have the resources to compete under such a system.

The second area where U.S. law is out of step with other parts of the world, especially Europe, is in post-grant opposition, which allows someone to challenge in patent court after a grant. The United

States has a very limited form of this, which allows only written evidence.

Most counsel recommend against these challenges, because the standard courts allow broader evidence, including the use of witnesses. But an opposition proceeding within a patent office would be much more focused and less expensive, Esatto said.

While bills pointing toward international harmonization have been introduced in past years, they seem to have more momentum this year, and sponsors in the House and Senate have introduced identical legislation.

"This time, something is going to pass," Esatto said.

## It's a small world after all

Want to make a connection with a high-powered Long Island attorney? Go to bluegrass concerts upstate. Way upstate.

Last week, I interviewed Lois Carter Schlissel, managing partner at Meyer, Souzzi, English and Klein P.C., for a story about the firm's growth, and as the interview was wrapping up, I asked her where she was from.

"It's a little town upstate near the Canadian border," she said. "No one's ever heard of it."

Which one, I asked? "Ellenburg Corners."

"I've been to a concert in Ellenburg!" I said. "A friend has a cabin on Lake Chateaugay!"

Schlissel's eyes widened. She's seen a lot in her career, but not a lot of people who've been to Ellenburg, a cluster of villages on the north slope of the Adirondacks, about 10 minutes from the border. How small are things up there? Her high school graduating class had 39

people.

"Well," she said, "if you were at a concert up there, it must have been country."

"Bluegrass," I said. "A group from the area called the Gibson Brothers."

Of course, she knew and appreciated the group's music. The Gibsons were performing a few years ago after a triumphant run at the Grand Ole Opry in Nashville, I said, and it seemed the whole county had turned out to welcome the hometown heroes.

"My dad was at that concert!" Schlissel said.

If you're interested, the Gibson Brothers are performing Sunday at Ellenburg Depot. I advise you to take your attorney.

## Nixon Peabody wins diversity recognition

Nixon Peabody LLP, a leading U.S. law firm with an office in Jericho, has received an award recognizing its commitment to diversity.

The Minority Corporate Counsel Association's 2007 Mid-Atlantic Region Thomas L. Sager Award is given each year to a law firm that shows a sustained commitment to diversity and minority issues, especially in hiring, retention and promotion of minority attorneys.

Nixon Peabody has developed a number of diversity initiatives and committees and has conducted diversity sensitivity and awareness trainings for all its lawyers and personnel.

The company was named by Fortune magazine in 2006 and 2007 as one of the "100 Best Companies to Work For," based in part on its diversity efforts.

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