

# Introducing the illustrious

Every year, a set of individuals is inducted into the IP Hall of Fame. For 2012, six people - all leaders in their fields and renowned among their peers - have been chosen to join the ranks of a very elite group

By **Helen Sloan**

The IP Hall of Fame honours those who have made an outstanding contribution to the IP world, and to intellectual property's increasing prominence as an engine of economic growth. The six individuals inducted for 2012 are Béatrix de Russé, Q Todd Dickinson, Alan Drewsen, David Kappos, J Thomas McCarthy and Marybeth Peters. They hail from different areas of expertise, including policy, industry and academia, and have a broad range of experience across all types of intellectual property.

The IP Hall of Fame was established by *IAM* magazine in 2006 in order to recognise the achievements of the most important individuals in intellectual property, and to highlight the vital role that intellectual property plays in today's global economy. Inductees are practitioners of influence - people who have made a difference in their field and who have helped to establish intellectual property as a vital business asset. They include men and women from business, politics, the law, finance and academia; this year's new members join such luminaries as inventor Thomas Edison, Microsoft's former head of IP Marshall Phelps and Tian Lipu, commissioner of China's State Intellectual Property Office.

The annual nomination process is an open call to the international IP community, giving everyone involved in the field the opportunity to acknowledge those who have influenced and guided them in their own careers. The names received are then sent to the members of the Hall of Fame Academy, who are invited to select up to five names for inclusion. The Academy comprises previous inductees into the IP Hall of Fame and other acknowledged experts from the international IP world. Usually, the five nominees who receive the most votes are inducted; however, due to a tie in the number of votes cast, this year six individuals have joined the ranks. Their names were revealed on the *IAM* blog in February 2012.

The six inductees for 2012 will be honoured at a gala dinner at the Estoril Casino in Portugal during the IP Business Congress in June. Over the following pages you will find interviews with all of this year's inductees: their careers, experiences and achievements set an inspiring example to all who work in the field. *iam*

You can find the names of all previous inductees into the IP Hall of Fame, as well as photos and profiles, at the IP Hall of Fame website. There is also a list of the current members of the IP Hall of Fame Academy. [www.iphalloffame.com](http://www.iphalloffame.com)



## Béatrix de Russé – leading the way in licensing

Technicolor, the French company formerly known as Thomson, is a beacon of IP practice, particularly when it comes to generating licensing revenue. It holds significant patents in areas including MP3, digital television and display technologies, with around 40,000 filed and pending patents in total. But what is more interesting than sheer numbers is how the company is making use of these assets. Licensing activities generated income of more than €450 million (almost US\$600 million) in 2010, a sum that puts Technicolor second only to Qualcomm in terms of patent revenue.

Behind this incredibly successful operation is Béatrix de Russé, who has been running the licensing programme since 1993 and responsible for the company's international intellectual property and licensing since 2004. Her career at the company dates back to 1976, when she initially joined as a contract lawyer. Thomson gradually evolved through mergers and acquisitions, and it turned out to be one of those deals that thrust intellectual property centre stage for de Russé, who at the time was working in the branch of Thomson that dealt with semiconductors (today known as STMicroelectronics). She explains: "We purchased an American company called Mostek, and we found out by chance - because somebody came to us and asked us to purchase a few patents - that we had acquired a jewel in patents, which was the famous DRAM patent," she says, referring to a crucial patent used in personal computers and laptops. "This brought in much more money than the cost of acquiring Mostek." Mostek, it turned out, also owned some other lucrative patents, so the US\$71 million price that Thomson paid for the company proved to be a wise investment.

Her interest piqued by the Mostek deal, de Russé decided to attend a course on intellectual property. And just as she started looking for opportunities to put her new-found skills into practice, the position of licensing negotiator for Thomson opened

up. "I knew what IP was, but I didn't know what the job of a licensing negotiator was," she confesses - but she accepted the post nonetheless. It turned out to be a good move, as subsequent changes at the company would give her the opportunity to expand and develop her department's capabilities. "At that time, the IP team of Thomson was six or seven people," she says. "So I was the chief negotiator. And then we grew and grew and grew. So I became in charge of patents and licensing at the time, which was a small team growing little by little." Today, that team numbers some 200 strong around the world.

"I am very proud to lead such a team, and I'm very proud to have built such a team," says de Russé. "Because it was not that easy, but I think it was an excellent move." She acknowledges that switching from her job as a lawyer to a leadership role was a risk, but it is not one that she has ever had cause to regret. "I made that choice in 1993; it was by chance - but what is chance? Chance for me is seizing an occasion. So I seized this occasion, and I'm glad I did it."

While the team's growth in size and scope under de Russé's direction is certainly impressive, it is dwarfed by the huge increase in income that Technicolor makes from licensing its patents. "I don't remember exactly how much the revenue was in 1999," she muses, "but let's say it was maximum €1 million. That has now grown to €451 million; so it is a great achievement."

Although her position today is very different from her early work as a contract lawyer, there is one common thread running through de Russé's career. "I have always loved negotiation," she says. "That is why I was attracted to the job. Because what was fun in negotiating contracts was the negotiating part - I've always loved that." The licensing team also looks very different today from when she first started out, which is a further bonus: "Another highlight is managing a team of very diversified people - patent attorneys, negotiators - all with their characters, their moods and so on. There is something like 10 different nationalities, so it is fascinating."

But despite the continued success that de Russé has enjoyed throughout her tenure, there are constant pressures to overcome. The proliferation of patent trolls is one of the biggest challenges that she

has faced over her career - although as she points out, they are nothing new. "I have always known about trolls," she says. "For example, when I joined Thomson, one of the first things that I had to do was negotiate with a troll. People now seem to be discovering trolls, but in the consumer electronics world they were already known for about 20 years." While de Russé may have more experience than most in dealing with patent trolls, they still pose a problem for her and her team. "This is not new for me; but what is new is that there are many more than before. They think it is easy money - it is not easy money at all. So I have seen evolution, not revolution."

Defining who or what a troll is has also become increasingly complicated in today's IP marketplace. For de Russé, it is a person or company that "instead of negotiating amicably, as I do, launches litigation before speaking to the target. This for me qualifies as a troll, and this I don't like at all." de Russé's attitude is understandable, given that she and her company have managed to make their patents so lucrative while still playing by the rules. Unfortunately, however, this does not mean that Technicolor can avoid being dragged into court when it finds itself under attack. "The problem is that when we are sued by a troll, we have to defend ourselves," she says. "It is a waste of money. Even if we demonstrate - and we usually do - that the patents have no value, we have to pay attorney fees and litigation costs, and they are very costly." de Russé fears that things are unlikely to change for the better in the near future: "So long as IP will continue to bring income, there will continue to be patent trolls."

de Russé does have one solution that she believes would make the trolls' lives more difficult: simply to improve the standard of patents granted. "The trolls, which are mainly active in the United States, would be a lot less active if the quality of patents out of the US Patent and Trademark Office was really good." She acknowledges that some improvements have been made in recent years, but points out that a large backlog of applications remains. "I think that instead of using the litigation system to assert the value of a patent, it would be better to have higher-quality patents," she concludes. ■



## Q Todd Dickinson – a varied career

Children's chemistry sets and the Vietnam War are seldom interlinked, but Q Todd Dickinson, executive director of the American Intellectual Property Law Association (AIPLA) and former director of the US Patent and Trademark Office (USPTO), credits both as instrumental to his chosen career path. The science sets kick-started a passion that saw him major in chemistry at university, which is where he became interested in the law and student politics. "It was the end of the Vietnam War conflict, an era of activism, and I thought about going to law school," he says. "My adviser, who was head of the chemistry department at the college I went to, suggested that I combine the two by looking into patent law."

Dickinson puts his professional evolution down to "planned luck", which began when he was hired straight out of law school by a local practitioner who had given a seminar at his university. This was just the start in a rich career that has involved a variety of roles both in-house and in private practice. "I was very fortunate that my career and my age roughly paralleled the rise of intellectual property," he says. "As it became more and more important, I was fortunate enough to be able to ride that crest, and I guess I did a good enough job that it led to a lot of these very interesting opportunities."

Dickinson's first big break came while he was working at a law firm. "A corporation called Baxter International was looking for folks. It was in Chicago and I thought that would be interesting," he says. He subsequently transferred to San Francisco and worked for Chevron for 10 years, before another opportunity brought him back east. "In my home town of Philadelphia, a major energy company called Sunoco was looking for a chief patent counsel and it was the right place and right time. I loved California and still do, but you have to take a risk sometimes."

When Dickinson looks back over his pre-government career, it is his move to Sunoco that marks a turning point. "I think for folks

who are in-house, getting that first chief IP counsel job is always a highlight. So when that opportunity came with Sunoco, I really couldn't say no."

But perhaps inevitably, it is Dickinson's time at the USPTO that is the pinnacle of his career. He served as director under President Clinton, between 1998 and 2001. "Working at the USPTO - with all due respect to my current boss - was probably the best and the most fun job I've ever had," he says. "Not only is it a great opportunity to serve your country, but to do it in a field that you've practised in and come to love is a really interesting confluence." Dickinson's tenure was a time of great change, with new legislation bringing constant challenges - clearly something that he relished. "It was a lot of fun to come into work and have the staff come in and say, 'Only you can decide which way you want the rule to go - you're the boss, the buck stops with you.' It would be breathtaking sometimes - it was so much fun."

As well as being "a once-in-a-lifetime opportunity" career-wise, Dickinson found the post immensely fulfilling and has no shortage of highlights from his time in office. "The growth of the biotechnology industry as well as the software and computing industry led to very interesting and very challenging issues in terms of patentability and patentable subject matter," he says. "You can see this reflected now down the road in the recent *Prometheus* decision - the seeds were planted when we did a set of guidelines for examiners on how to handle those new technologies. When the *State Street Bank* opinion came down and business methods were suddenly patentable, we had to come up with a whole new approach internally on how to deal with those."

Dickinson's time as director also took in the implementation of the American Inventors Protection Act, which introduced some significant changes to US patent law. He also oversaw major internal changes, which included reorganising the USPTO into a performance-based organisation and preparing for the relocation of the office, together with more than 7,000 staff, to new headquarters in Alexandria, Virginia.

Since stepping down from his USPTO role, Dickinson has worked in private practice for Howrey, and as vice president and chief IP counsel of General Electric. Then, in 2008, another opportunity came his way that would

give him the chance to lead a major organisation, engage with all corners of the US IP profession, educate the public and work with policy makers at the highest level: head of AIPLA. Dickinson seized it with both hands.

Today, he suggests that in many ways the role is "a mirror image" of his post at the USPTO. "A lot of it is policy and advocacy on behalf of our members. We have such a broad membership of 15,000 people, and we are an old organisation - we're 110 years old. We really care deeply about what's good for the system and trying to find the policies which are best for the economy, best for our members and best for the public."

AIPLA was a prominent voice in terms of advocacy over the America Invents Act and is currently involved in the rulemaking process, as Dickinson explains. "We've got a very elaborate internal taskforce to deal with these issues. To digest all the information, and to comment meaningfully and be constructive in our criticism, is as big a challenge as we've ever had." However, these efforts have tangible effects, and Dickinson is delighted to report that AIPLA's brief has twice been cited by a Supreme Court justice during oral arguments as part of the rulemaking process.

Also on the agenda for AIPLA is a renewed emphasis on public education. "There is a concern that the public doesn't always understand the importance of intellectual property and in some cases is unduly critical of it," Dickinson says. "We feel, and our members feel, that we have a role trying to inform the public about the importance to them of intellectual property." This includes not just the current political hot potato of illegal downloading, but also issues such as gene and business method patents.

Although originally a US organisation, AIPLA is also looking far beyond its national boundaries. It continues to expand its international presence and is collaborating with other IP professionals, governments and experts around the world. "We - legal service providers and policy makers - understand how critical IP is to the world economy, not only to incentivise innovation, which is a key part of it, but to protect innovation. The biggest challenge at the moment is to make sure that opinion leaders of the world and the public have the best view of the importance of intellectual property we can give them." ■

## Alan Drewsen – leadership lessons



When reflecting on his life's work to date, Alan Drewsen feels that he has enjoyed three separate careers - all within the legal sphere, but each quite different. He started out in litigation, then worked as a general counsel in the health insurance industry, and is now seeing a different side of legal practice as executive director of the International Trademark Association (INTA), a position that he has held since 1998. Intellectual property was thus a relatively recent focus, but this has posed no obstacles and today Drewsen is regarded as a tremendously influential thought leader.

Sketching out the details, Drewsen explains: "I started out as a litigator and an antitrust lawyer. I also did a fair amount of health insurance healthcare law, and as a result then became general counsel at Blue Cross and Blue Shield, which was at the time the largest of the 'blues'." Although trademarks were not his speciality, he found this aspect of the law fascinating, and when the INTA position presented itself, he felt that it would be "a good opportunity with an interesting association in an increasingly important field". His instincts proved sound: during his 14-year tenure, the law relating to trademarks has become increasingly complex and INTA has grown enormously in both size and status.

"I'd like to say it was all cause and effect - that this all happened as soon as I arrived - but I think I'd have a difficult time maintaining that position," Drewsen jokes. "There has been growth first of all in membership; second in the size and importance of the annual meeting; third in the size and competencies of the staff. Fourth, we

established international offices, which we didn't have when I arrived." Under Drewsen's stewardship, INTA's membership has reached almost 6,000, with representatives from virtually every jurisdiction in the world. And anyone who has attended one of INTA's annual meetings will attest to their scope and significance.

Drewsen points out that INTA was blossoming even before he joined in 1998. "The organisation had already changed its name" - from the US Trademark Association, which it had been called since its inception in 1878 - "and it already had a significant international membership. But it had a desire to become a truly international organisation." Someone who could fulfil the brief to expand worldwide was one of the main things that INTA was looking for when it hired Drewsen, and he has certainly delivered in spades. From a largely US organisation with a single office in New York, INTA has developed internationally and now has offices in Washington DC, Shanghai and Brussels, as well as consultancies in Mumbai and Geneva.

Since Drewsen came on board, the Internet has revolutionised the trademark world, and he expects that online issues will continue to dominate the agenda for some time to come. "The word 'internet' encompasses an awful lot," he says. "The greatest challenge over the next 15 years is coming to terms with it in current legal doctrine. But then - even more obviously, even more broadly - coming to terms with what it means for society. We are just a baby step into the internet age - all this is going to play out in the years to come."

The Internet has not been the only revolution of recent years; Drewsen points to the spectacular growth of China as another phenomenon to which trademark practitioners must pay close attention. "I'd say that the attempt to protect IP rights in that gigantic market is the second biggest challenge."

And what makes responding to these trends all the more challenging is that for most practitioners, they came out of the clear blue sky - as an anecdote of Drewsen's bears out: "This organisation had a meeting in Cannes in France, probably around 25 years ago. It was supposed to be about the future of trademarks and the future of IP. But nobody then could imagine the Internet; it wasn't a subject. And they didn't imagine the great growth in China. The economic engine at that time, apart from the US and Western Europe, seemed to be

Japan; so China didn't get the play that everybody gives it now."

But when the winds of change began blowing, INTA was quicker to react than most, and its decision to open an Asian office proved particularly prescient. The Shanghai branch was established in 2003, before even the Brussels and Washington DC offices - giving the organisation an essential base in the fastest-developing IP marketplace on the planet.

The past few years have been particularly turbulent for many in the IP sphere; yet despite the global economic downturn, INTA has still managed to maintain consistent growth, with new members signing up from a number of different areas. "As corporate members have expanded their businesses into countries everywhere, there has been growth of local IP firms, and a lot of them join INTA. And while in the industry we see consolidation and mergers of law firms, the gross number of people employed - even with the recent economic downturn - has grown consistently." Drewsen takes great pride in overseeing this development: "Managing an organisation like this - seeing the growth and the successes, day in, day out - is very gratifying. Watching the staff members perform at a high level, and demonstrate a lot of initiative and come up with excellent projects that are executed well - all of that is gratifying."

For many trademark professionals the world over, the INTA annual meeting is unmissable, presenting an unrivalled opportunity to attend sessions with global leaders and to network with over 9,000 practitioners from around the world. Organising such a huge event is a herculean undertaking for Drewsen and his team. "I have two reactions at the end of that week - one is pride and one is exhaustion," he says. "It is the highlight of the INTA calendar in a number of ways, including the visibility it creates for us. From a planning point of view, it absorbs a significant percentage of our energies. We have excellent meeting planners, excellent committee liaisons; but as an organisation, it absorbs a significant amount of time. So when it is over, there is a feeling of, 'Phew, we made it' - but it is still the highlight to the year."

Drewsen has announced his intention to step down in May next year. He will have spent 15 years at the helm of INTA, and he leaves the organisation a very different beast from when he joined. His successor will have big shoes to fill. ■

## David Kappos – America’s patent reformer



“When I started in this field, intellectual property was the domain of experts – nerds with plastic pocket liners and mechanical pencils,” recalls David Kappos, under secretary of commerce for intellectual property and director of the US Patent and Trademark Office (USPTO). “It’s gone from those days to now, when intellectual property is the most important thing that comes out of innovation. It is where the action is; that is a trend that is continuing and will continue into the indefinite future.”

Kappos is well placed to comment on the evolution of intellectual property: prior to taking up his current role as the head of the most important patent system in the world, he worked for IP powerhouse IBM. A long and distinguished career at the technology titan saw him rise through the ranks to become vice president and assistant general counsel.

“I was at IBM for 27 years. You can’t keep a job that long without having some major accomplishments,” he says. However, Kappos is at great pains to ensure that due credit is given to his colleagues: “Any time you do something big, it’s always a team effort. I’m happy and proud to have been part of a team at IBM that has shown how to be a leader in championing strong, but balanced IP rights.” Crucially for Kappos, IBM achieved this feat without getting entangled in lots of patent wrangles: “I’m very proud that IBM has managed to make billions of dollars on intellectual property licensing, but you rarely see it getting in disputes. For a company that big – a billion-dollar company – that is remarkable, and that is down to stewardship and leadership and balance.”

Kappos also points to IBM’s leadership regarding open source and standards setting as further key successes of his tenure. “I’m proud to have been part of a team at IBM that, very early on, saw the importance of open-source programming; saw the importance of reasonable and non-discriminatory standards, and of living up to the requirements of stewardship of playing in those fields.”

With a history dating back to the 19th century, IBM is the “mature adult in the room”, as Kappos describes it. And one of IBM’s fortes has been keeping pace with the fast-moving technology world. “It is understood that if you want to stay relevant – much less if you want to stay as big and as potent as IBM – you’ve got to be prepared to reinvent yourself,” he says. “There were massive technology changes just during the time I was there – from the era of the mainframe all the way to the era of the cloud – while many other companies stumbled and fell away.”

Kappos has been at the USPTO now for almost three years: a short stint compared to close to three decades at IBM. But as he points out, that is a relatively long time in this particular role; because the director of the USPTO is a presidential appointee, turnover tends to be high. Yet Kappos can already claim some considerable achievements – not least of which is overseeing the introduction of the America Invents Act (AIA).

“Of course, implementing the AIA is unquestionably a big deal,” he says. “It’s the biggest change in US patent law since 1836 – a complete rewrite.” Revamping a system that has already granted 8 million patents, with millions of users all over the world, was a mammoth project. And Kappos explains that the passage of the act is just the beginning: “Because the AIA, like all American law, is just the barest of

frameworks, the agency is then required to undertake what’s called rulemaking.” This involves stakeholder input and multiple rounds of feedback, writing and hearings. “It’s a gigantic project. It is one of those things in life that if you knew how big it was at the beginning, you might have been so petrified that you wouldn’t have been able to get started.”

However, the landmark AIA is not the only issue that Kappos has been tackling, and before he leaves office there are plenty of other things that he hopes to achieve. “I want to get the backlog of unexamined patent applications down to a reasonable level,” he elaborates. The bottleneck has already been eased to the tune of about 120,000 applications, but he acknowledges that there is still considerable work to be done in this area. Increased international cooperation is also on the agenda: “I’ve got to finish fixing the agency. But I feel strongly that I want to take a leadership role in moving our global patent system to a more harmonised level,” he says. “I’d like to work productively with our European and Asian counterparts – capitalising on the AIA and the improvements that have been made to the patent systems in Europe and Asia – to look towards harmonising the patent systems.”

Kappos is a passionate advocate of what intellectual property can achieve. In addition to protecting the work of innovators and creators, he explains that it can have a truly beneficial impact for all mankind: “It is now clear that, as daunting as the world’s problems are, they will all be solved on the back of innovation, and what incentivises innovation is intellectual property. So at the core of advancing productivity,

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health solutions, clean water, climate change - everything that we need to change on the planet - at the root of it is going to be innovation, and therefore intellectual property."

That said, the IP system still has its detractors; but this does not trouble Kappos unduly. The much-publicised disputes over the new online piracy bills in the United States, for example, are to Kappos a normal phase in a process aimed at striking a delicate balance between protecting freedom of expression and the Internet on the one hand, and a "Wild West scenario" in which IP rights are vulnerable on the other. Finding this balance is a difficult task, but the debate is a healthy one. And

while recent protests in the United States and Europe may have given an impression of widespread anti-IP sentiment, Kappos's own experience suggests that this is not the case. "It really depends on who you talk to, even among the younger generation. I was in New Orleans recently meeting with young folks freshly out of college, starting up their own entrepreneurial and innovative businesses, and they understand intellectual property really well - way better than I did when I was their age." He has witnessed the same sophisticated awareness in any number of cities across the United States.

Kappos accepts that current issues are nothing new and that to some extent,

polarity is part and parcel of the system. "Ever since the British statute of monopolies, patents have been controversial," he says. "They were controversial in Britain during the Industrial Revolution; they are at times controversial in the US where we have the strongest patent rights on the planet. Controversy comes with dealing with important critical issues in general, especially with an incentive system like the patent system, where you are inherently handing out rights and telling others that they can't do something. So I think controversy is inherent and inevitable. I don't mind it - it is all just part of the process of moving the system forward." ■

## J Thomas McCarthy – teaching trademarks



The McCarthy Institute of Intellectual Property and Technology Law at the University of San Francisco, established in 2001, is a testament to the work and achievements of its namesake. Professor J Thomas McCarthy jokes that it is unusual to be honoured in such a way while you are still alive. However, the accolade is unsurprising, for not only is McCarthy an academic of great standing and a world authority on trademark matters, he has also devoted much of his career to the university, including teaching there for 36 years.

There were a couple of false starts before McCarthy hit his stride on his chosen career path. His initial intention was to become an engineer: after completing a degree in electrical engineering, he worked for a short time on the fledgling US space programme. But despite this first-hand involvement in such a ground-breaking

project, he found the engineering side less inspiring. Law school beckoned, followed by three years as a patent lawyer, before another change finally revealed his true calling. "I tried my hand at being a teacher and I discovered that that was my niche - that was what I really loved doing," he says. "So the rest is history, and I taught at the university of San Francisco law school for 36 years."

A renowned author on IP matters, his best-known work is the seven-volume *McCarthy on Trademarks and Unfair Competition*, an essential guide to US trademark law. The treatise has preoccupied McCarthy for most of his career. "My trademark book was first published in two volumes in 1973, which is sobering for me to realise that it is almost 40 years ago now," he explains. "I was a pretty young law professor at the time, and in those days trademark law - and in fact all IP law - was largely unknown and neglected by both the legal profession and the public. It was a very small niche market: I am very lucky that I got involved in a field that grew and then became so important now."

He came to be involved in this epic undertaking partly through interest and partly through enthusiasm for a new project. McCarthy was keen to write on the subject of trademarks, but an initial pitch for a book on Californian trademark law was rejected. However, the publishers had an alternative suggestion - they had a two-volume trademark book that was due to be updated. "They said, 'Do you think you can write the successor to that?' I was young

and I said yes to everything then, so I said, 'Sure'," he recalls. "I didn't know what I was getting into. A few years and a lot of effort later, the two volumes came out in 1973."

Producing his first edition was no easy task for the young academic. "I didn't realise how much effort was involved," he admits. "And you have to remember that this was before computers - everything was done on old-fashioned typewriters, so it was much more of a physical challenge to put a book together than it is today." That said, the result has certainly been worth the effort: the treatise has since grown from two to seven volumes, and has been relied upon in more than 2,000 judicial opinions to date. But while McCarthy is revered for this and other works on trademarks and IP law, he does not regard his books as his greatest achievement.

"The highlight of my career is really my 36 years of classroom teaching," he says. "I like teaching; I like being in the classroom; I like working with young people. And even though I retired from classroom teaching 10 years ago, I really still think of myself as a teacher when I write. In a real sense, I think of my books as helping the legal profession and trying to take some of the difficult ideas and concepts and make them accessible and easy to find - to me, that is being a teacher."

The extraordinary evolution of technology and in the law over the course of McCarthy's career means that intellectual property has become an ever more complex subject - both to teach and to write about. "It is increasingly

challenging, especially with all the worldwide developments in trademark and unfair competition law. The trademark treatise is now seven volumes – it started out as two – and that is an embodiment of how the field has grown. It's a challenge to keep the coverage complete and in-depth, but also accessible. For example, 10 years ago, all the internet problems and domain name problems appeared out of nowhere – and that was a field that simply did not exist before.”

McCarthy's students' attitude to intellectual property is evolving as well, and with increased knowledge comes new and complex problems. “Young people have grown up with awareness of IP, so for them it's not strange, difficult, new or foreign – it's how the world is,” he says. “I think the problem is that they think that everything on the Internet is free, because there is not a policeman there telling you, ‘Don't do it.’” He observes that the debate over the US online piracy bills was often reduced to the level of a bumper slogan – “And it's a much more complicated and difficult thing. I never thought I would see ordinary people talking about IP law. Of course, much of what they think that they know is wrong!” he laughs.

McCarthy's biggest concern about the future of trademarks and IP law is how an increasingly globalised world will cope with the dissolution of traditional borders. “The law of trademarks continues to be largely a product of 19th century notions of brick and mortar sales outfits and rigid national boundaries. But the Internet is international, and that means that a lawyer in London or San Francisco or Beijing has to know something about the law around the world, and that was certainly not true even 15 or 20 years ago. So you have to be very flexible and light on your feet to be a trademark lawyer these days, and I have a feeling that things are going to change even more in the future.”

For McCarthy, increased harmonisation of trademark law is thus imperative. Online commerce is beyond national borders, and different registration procedures present a barrier that particularly affects smaller entrants to the market. But while the problems of this fractured regime may be clear, there is no easy solution available – “You see the difficulties even among the European nations,” he muses. He is ultimately cautiously optimistic about improvements in the future: “It's a long-term project, but it's something that I think has to be addressed and taken care of in the interests of free trade.” ■

## Marybeth Peters – dedication to copyright



Marybeth Peters' career at the US Copyright Office has been nothing short of exceptional. She devoted over 40 years of service to the office, ultimately becoming the US register of copyrights from 1994 until her retirement in 2010. Her lengthy tenure has been surpassed only by Thorvald Solberg, the first register, who took office in 1897.

It was Peters' beginnings as a “good, but not exceptional” music student that indirectly led to her entering the world of copyright law. After realising that a career as a professional musician was out of reach, Peters trained as a teacher, then moved to Washington DC with the intention of applying to law school. She found a job in the library of Congress in the meantime, and was deliberating over what field of law to focus on when she heard Barbara Ringer – then chief of the examining division and later the first female register of copyrights – mention the Copyright Office. “I heard her talk about the fact that it protected music and I thought, ‘There's my connection!’” Peters says. “So I walked down and told them that I was going to go to law school, and I got a job within the matter of a week as a music examiner in the Copyright Office. And so that was the road that led me to where I am today.”

Peters' early days, working in the Copyright Office by day and attending law school at night, coincided with a period of great excitement in the area, as the copyright law was about to undergo a major overhaul – the first since 1909. “I had the wonderful opportunity of going to congressional hearings, being involved in discussions in the office about policy, and I

became a lawyer in the office at the time before the law was passed.” The new law was finally enacted in 1976, and with it came a golden opportunity for Peters: “I was selected to be the educational officer, and I wrote something called the *General Guide to the Copyright Act*. That basically became everybody's bible. I went and spoke all over the world and certainly educated everybody in the United States. So that actually set my career.”

Peters' passion for music and the arts means that she has always been keenly attuned to the link between creativity and copyright. And she has found plenty of kindred spirits in the field: “One of the things that was interesting was how many people who were copyright lawyers were also associated with the arts. Many people who were really talented musicians and writers, and people who cared about all kinds of artistic things, found that copyright law was a place where they could indulge their passion and also learn a living.”

While she may not have had the top job in her sights when she joined the office in the late 1960s, Peters puts her ascent through the ranks down to her robust New England work ethic. “You do whatever you do to the best of your ability. If you end up doing something that you like, that's good; but it is all about working hard,” she explains. Her efforts did not go unrecognised, and as well as a series of promotions to different roles, she also spent a year working at the World Intellectual Property Organisation.

Peters' enduring stint at the Copyright Office is particularly unusual when compared to other government jobs, where the position changes with each new administration – in contrast, the position as head of the Copyright Office does not become available very often. “I was lucky enough that it came up in 1994 and I was lucky enough to be selected,” she says. “When I look back, I have been so fortunate to have had a career for almost all my life that is something I really care about and love, and to have worked with people who are creative; and I wanted to help make the copyright law in the United States better.”

On becoming register, Peters recognised that one major task ahead of her was to introduce an electronic filing system. “Making that happen was much more difficult than I thought,” she says. “Including

because our funding comes out of the legislative branch appropriations, and getting money enough to do that was a nightmare. Not having the technical expertise to get it right in the beginning was also a problem.” But despite the challenges, Peters remained convinced that this was a necessary step, and can now see the benefits of her endeavours having emerged the other side.

Another complex issue with which Peters has grappled concerns digital books. A major development in this sphere was a copyright class action filed by the Authors’ Guild against Google Books, which was scanning and publishing copyrighted works online. Peters played a key part in this litigation; her input included testifying before Congress on the issue of orphan works. The case was settled in 2008 with a US\$125 million pay-out by Google; however, the wider issue of digital copyright remains unresolved, and Peters suggests that “how we move forward is going to be really, really important”.

Digital books are far from the only issue that has troubled the Copyright Office during Peters’ tenure. The period from 1994 and 2010 was “an era where everything changed with regard to the way material was created and disseminated”. The internet revolution has led to unforeseen challenges for copyright lawyers across the world. Peters points in particular to peer-to-peer technology as an issue that did not exist when she first became register, but one that rapidly became a massive problem as users were able to share copyright works online with ease. “To create a law that is responsive and yet meets the needs not only of the authors and creators, but also the users, is very difficult to achieve,” she sums up.

Although she has now retired from the Copyright Office, Peter has not put her feet up. She continues to advise and assist the office where she can, and has gone into private practice with Oblon Spivak. She also continues to teach and guest lecture; “Once a teacher, always a

teacher,” she says. “One of the things about teaching, especially in a law school, is that students have all kinds of new ideas. They are not stuck in the past, so it forces you to rethink the issues. And to help students in intellectual property and make a difference in their careers is something that I find very rewarding.”

Guiding the next generation is particularly important to Peters, in part because she enjoyed great support herself on the way up, including from Ringer. “She served as a role model, as a mentor and, in the end, as a friend,” Peters says. And Ringer was just one among many: “There were so many people along the way. I joined the Copyright Society: I can’t tell you the number of people who were willing to sit down with me and tell me what their practice was and what the issues were, to help me understand things. That’s why I try to pay back. The copyright community is small - in the US and worldwide - so we are like a family and we try to help each other as much as we can.” ■

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