

UNITED STATES DISTRICT COURT  
NORTHERN DISTRICT OF NEW YORK

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**INVENTION SUBMISSION CORPORATION**  
**t/d/b/a INVENTHELP,**

*Plaintiff,*

-vs-

Civil Action No. 5:10-CV-74 (FJS/DEP)

**IP WATCHDOG INC., EUGENE R. QUINN,**  
**JR., and RENEE QUINN,**

*Defendants.*

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**DECLARATION OF EUGENE R. QUINN, JR.**  
**IN SUPPORT OF PLAINTIFF'S MOTION TO DISMISS**

**EUGENE R. QUINN, JR.** hereby declares as follows:

1. I am a defendant in the above-captioned action, and the Chief Executive Officer of defendant IPWatchdog, Inc. ("IPWatchdog"). I make this Declaration in support of Defendants' motion to dismiss.

2. I am also an attorney duly licensed to practice law before the courts of the State of New Hampshire, as well as the United States Patent and Trademark Office ("USPTO").

3. I received a B.S. in Electrical Engineering from Rutgers University, and a J.D. and a LL.M. in Intellectual Property from Franklin Pierce Law Center.

4. Between 2003 and 2007, I wrote a monthly column for *Patent World* and served on the *Patent World* editorial board. I also previously taught a variety of intellectual property courses at the law school level, including patent law, patent claim drafting, patent prosecution, copyright law, trademark law and introduction to intellectual property. Between 1998 and 2008, I taught at Syracuse University College of Law, Temple University School of Law, The University of Toledo College of Law, Franklin Pierce Law Center, and Whittier Law School. I

presently teach as an adjunct instructor at Concord Law School, and am a principal lecturer in the Practising Law Institute (“PLI”) Patent Bar Review Course, which helps aspiring patent attorneys and patent agents prepare themselves to pass the patent bar exam.

5. Prior to moving into the academic world, I practiced at a general civil litigation firm, where I primarily engaged in representing clients involved in complex litigation matters. In addition, I was a founding member and managing partner of Smith, Quinn & Associates, a small intellectual property boutique firm located in Concord, New Hampshire, and later a founding member of White & Quinn, a patent boutique located in Northern Virginia. I also spent two years as Vice President and General Counsel for an independent record label in Orlando, Florida.

6. Currently, I also maintain a part-time, private practice as a patent attorney. The focus of my practice is in the area of strategic patent consulting, patent application drafting, patent prosecution and technology licensing. In my 11 years of practice as a patent attorney, I have worked with inventors and start-up businesses in a variety of different technology fields.

7. The current focus of my practice is working with inventors who have computer implemented processes, such as software, business methods and Internet or e-Commerce applications. I estimate that over 50% of those coming to me for legal work present me with software, business methods and/or Internet or e-Commerce related inventions. I estimate that over 80% of those that move forward toward a patent application of any kind have inventions that relate to software, business methods and/or Internet or e-Commerce related inventions. The percentage of software, business methods and/or Internet or e-Commerce related clients continues to grow and I expect will continue to grow moving forward.

***IPWatchdog.com***

8. In 1999, I started IPWatchdog, which operates a website located at www.IPWatchdog.com (“IPWatchdog.com”), that is dedicated to providing a free, reliable and easily understandable resource on intellectual property law and related topics.

9. My wife, defendant Renee Quinn, serves as the Chief Operating Officer of IPWatchdog.

10. Since its creation, IPWatchdog.com has had millions of unique visitors. At least in part due to the exposure created by IPWatchdog.com, I have been quoted in the *Wall Street Journal*, the *New York Times*, the *LA Times*, *CNN Money*, *Popular Mechanics*, the *ABA Journal*, and various other newspapers and magazines worldwide.

11. In December 2009, the IPWatchdog.com Blog was selected as a Top 100 Blog by the American Bar Association (“ABA”) in the Third Annual *ABA Journal* Blog 100. The *ABA Journal* Blog 100 selects the best legal blogs in the opinion of the Journal’s editors and recognizes the best 100 blogs for lawyers.

12. During 2009, I, through IPWatchdog.com, also had several milestone events. First, in March 2009 I was granted an interview with then-Acting Commissioner for Patents at the USPTO, Peggy Focarino.

13. In or about the spring of 2009, I was also informed by the Communications Department at the USPTO that they considered me to be a member of the press, and when contacting USPTO officials I was requested to go through public relations personnel. This is significant because the patent process is an *ex parte* process and members of the Patent Bar are allowed to, even encouraged, to communicate directly with USPTO employees on an *ex parte* basis.

14. I was also granted press credentials by the Supreme Court to cover the oral arguments in *Bilski v. Kappos*, which was heard by the Court on November 9, 2009. The press credentials I was given and wore while in the Courtroom bore the name IPWatchdog, which is significant because based on my research this would make me the first blogger granted press credentials by the Supreme Court.

15. During 2009, I also covered several industry conferences live, including the National Association of Patent Practitioners conference in San Diego, CA, and oral arguments held at the United States Court of Appeals for the Federal Circuit.

16. The predominant content on IPWatchdog.com is pages associated with the IPWatchdog.com blog. As of March 2, 2010, there are 629 articles indexed in the IPWatchdog.com blog category. Approximately 46 of those have been written by guest bloggers, 10 were written by defendant Renee C. Quinn, 7 were press releases, and the remainder were written by me.

17. In addition to the IPWatchdog.com Blog articles, there are hundreds, if not thousands, of archived pages, pages cataloging articles based on subject matter (*i.e.*, Category) and pages cataloging articles based on content (*i.e.*, Tags). IPWatchdog.com also has thousands of pages in PDF format, which primarily consist of issued United States patents and published United States patent applications, as well as cases and court documents (*i.e.*, complaints, motions, decisions and orders) in dozens, if not hundreds, of past and pending litigations.

18. Indeed, according to the IPWatchdog.com server statistics (attached hereto as Exhibit 1) there were approximately 80,583 different pages on IPWatchdog.com having distinct Uniform Resource Locator (“URL”) addresses that received traffic in 2009.

19. During 2009, the IPWatchdog.com homepage was viewed 506,782 times, and the

RSS feed containing patent articles for professionals was viewed 33,292,213 times. The other most popular pages during 2009 were “The Cost of Obtaining a Patent” (viewed 76,676 times), “Confidentiality Agreements” (viewed 134,632 times), “Sample Confidentiality Agreements” (viewed 79,683 times), “Standard Confidentiality Agreement” (viewed 32,604 times), “Simple Confidentiality Agreement” (viewed 31,761 times), “Patent Bar Review” (viewed 25,403 times), “The Museum of Obscure Patents” (viewed 20,004 times), “Mutual Confidentiality Agreement” (viewed 18,439 times) and “Simple Confidentiality Agreement 2” (viewed 18,253). See Exhibit 1.

20. As seen in Exhibit 2 (attached hereto), traffic on IPWatchdog.com, over the 30 days preceding March 2, 2010, came from a variety of businesses and governmental agencies. This list was created from data from Quantcast.com. IPWatchdog.com has Quantcast tags embedded to attempt to independently verify traffic. Quantcast tags cannot be embedded into PDF files, but are embedded in HTML and PHP files on IPWatchdog.com. Because the PDFs on IPWatchdog.com relate to information likely only of interest to attorneys and other professionals, such as patents and court documents, it is quite likely our traffic numbers and visits from these various entities is much higher.

21. As we continually update this list for purposes of providing this information to potential advertisers, I can say these numbers have remained extremely steady going back to August 2009, which is when this list was first compiled.

22. Based on the Quantcast data (as seen in Exhibit 2), IPWatchdog.com received over 1,500 unique visitors from the USPTO. It also received visitors from the United States House of Representatives, the United States Senate, NASA, various universities, the European Patent Office, the Japanese Patent Office, many Fortune 500 companies, and patent law firms of

every size, including numerous of the top patent firms in the United States.

***Invention Promoters***

23. Invention promoters have been widely criticized in numerous circles, including political circles in Washington, DC, for many years.

24. In 1999, the American Inventors Protection Act (“AIPA”), 35 U.S.C. § 297, was enacted in an effort to address head-on the problems faced by a large number of inventors. Regardless of one’s view of whether the AIPA is viewed as a net positive or net negative for independent inventors, it is clear that certain provisions of the AIPA unequivocally attempted to provide important protections for inventors against invention promoters.

25. Under the AIPA, “invention promotion services” are defined as “the procurement or attempted procurement for a customer of a firm, corporation, or other entity ***to develop and market*** products or services that include the invention of the customer.” (emphasis added) An “invention promoter” is “any person, firm, partnership, corporation, or other entity who offers to perform or performs invention promotion services for, or on behalf of, a customer, and who holds itself out through advertising in any mass media as providing such services.”

26. Unlike Plaintiff, Defendants are not invention promoters and do not provide invention promotion services. Moreover, Defendants do not compete, and never have, with Plaintiff or any of the other invention promoters.

27. The legal services I offer as a patent attorney through IPWatchdog.com are expressly set forth on the website ([www.ipwatchdog.com/about/services/](http://www.ipwatchdog.com/about/services/)) (a hard copy is attached hereto as Exhibit 3). They include the preparation of: (a) patent searches and patentability opinions; (b) provisional patent applications; (c) nonprovisional patent applications; and (d) design patent applications. I also provide consulting services concerning general

intellectual property concepts (*i.e.*, patents, trademarks, copyrights, trade secrets, and unfair competition) in order to assist clients in determining whether pursuing intellectual property protection is feasible and economically wise. In other words, the services I offer through IPWatchdog.com are no different than countless other intellectual property attorneys across the country and around the world. Notably, none of these services constitute “invention promotion services.”

28. It should be noted that because my primary office is located in Virginia and I am not admitted to practice in Virginia, any services offered in areas other than patent law are always provided by and through another attorney appropriately admitted to practice.

29. To the extent that I discuss marketing with inventors, it is solely in the context of discussing a patent search and working on a patent application. In order to fulfill my obligations to my clients, I need to understand what each inventor wants to do with a patent should they obtain one. Regardless of the specific answer, it must be factored into the professional opinion and advice that I develop and provide.

30. That said, the services I offer vary greatly from those provided by Plaintiff because my services include offering negative opinions to inventors, and counseling them that it might not be wise to pursue a patent.

31. Although unique content drives Internet traffic to IPWatchdog.com, only a small portion of the revenues derived by IPWatchdog are attributable to the provision of legal services. The majority of revenue derived by IPWatchdog comes from my teaching in the PLI Patent Bar Review Course and from advertisers on IPWatchdog.com.

32. As previously stated, the majority of inventors and start-up businesses that I work with have inventions that relate to software, business methods and/or Internet or e-Commerce

inventions. These innovations do not relate to tangible or consumer products. In other words, these innovations do not relate in any way to the type of inventions that Plaintiff or any other invention promoter deals with. Therefore, it is difficult to understand how or why Plaintiff could be of the belief that I compete with them given that the “lion share” of my legal practice is in a field where they simply do no business.

33. The overwhelming majority of my practice is devoted to working with entrepreneurs, primarily those who are starting small businesses to pursue their inventions. In fact, I do not know of any clients whose primary interest is the desire to obtain a patent for the purpose of licensing or selling any intellectual property rights.

34. In addition, and to the best of my knowledge and recollection, I have not been retained by nor have I provided legal services to any current or former clients of Plaintiff. Rather, it has been my experience that Plaintiff’s current or former clients are looking for a company that will provide invention promotion services, which are services that we do not provide.

35. Moreover, Plaintiff’s claim that we are in competition with it fails from a logical perspective as well. If that were the case, then Defendants would not offer thousands of pages of *free* information on IPWatchdog.com.

36. In stark contrast to Defendants, Plaintiff solely provides “invention promotion services.” In other words, Plaintiff serves, for a fee, as a liaison between an independent inventor and an industry contact regarding the evaluation and development of a potential commercial product. This is confirmed by Plaintiff’s President, Robert J. Susa, in the declaration submitted in support of Plaintiff’s motion for a preliminary injunction (Docket No. 7-1 at ¶ 6):

[Plaintiff] offers a confidential submission program involving, among other things, a Data Bank of companies that have agreed to review inventions submitted to them by [Plaintiff]. [Plaintiff] submits its clients' inventions to these companies to obtain a good faith review and to determine whether there is a preliminary interest in the invention. We also refer our submission clients to a patent attorney to draft a patent application and perform patent application services.

37. In fact Plaintiff itself cannot provide the legal services I provide, and under 37 C.F.R. 11.5(b), it is my belief that it is not supposed to take in inventor clients and refer them to a patent attorney or patent agent for legal work.

38. Rule 11.5(b) defines "law-related service" as any service "relating to a client's rights, privileges, duties, or responsibilities under the laws or regulations administered by the Office for the grant of a patent . . . ." The Rule specifically prohibits non-practitioners from, among other things, "communicating with and advising a client concerning matters pending or contemplated to be presented before the Office."

39. On August 14, 2008, Rule 11.5(b) was published in the Federal Register, Vol. 73, No. 158, starting at Page 47650. The USPTO also published comments it received, including one which complained that the Rule would make it impossible for invention promoters to help inventors obtain patents.

40. In response, the USPTO stated, in part:

The Office frequently finds itself challenged by so-called "invention promoters" who exploit unsophisticated inventors, heap every invention with praise regardless of the merits or the real prospects of legal protection, and entice inventors into engagement agreements filled with hollow guarantees of patent protection and promises of royalty-bearing licenses that seldom yield anything of any significant value.

...

Non-practitioners are not entitled to provide legal advice or otherwise practice law. To the extent practice of law includes a law-related service

that comprehends any matter connected with the presentation to the Office, the preparation of necessary documents in contemplation of filing the documents with the Office, and communicating with . . . a client concerning matters pending or contemplated to be presented before the Office as in § 11.5(b), a practitioner authorized by relevant law must provide the legal services. For example, consultation with a client in contemplation of filing a patent application or other document with the Office as in § 11.5(b)(1) requires a registered practitioner to provide the services.

41. Plaintiff appears to recognize this, and states on its website ([www.inventhelp.com/inventhelp-about.asp](http://www.inventhelp.com/inventhelp-about.asp)) (a hard copy is attached hereto as Exhibit 4) that:

InventHelp gives no patent advice. It is advisable that you seek such advice from an independent patent attorney.

42. Nevertheless, Plaintiff alleges that it competes with Defendants. However, to do so, it is tacitly acknowledging that it is engaged in the unauthorized practice of law because I am authorized to provide legal services pursuant to my status as a Registered Patent Attorney, and none of these services are supposed to be provided by a non-practitioner, such as Plaintiff.

43. Notwithstanding, it is my understanding that those within Plaintiff that interface with inventors are commissioned sales people, not patent attorneys or patent agents. I further understand that they discuss with the inventors the patent search and whether the inventor should move forward, which under 37 C.F.R. 11.5(b) is the practice of law and, is only to be carried out by patent attorneys or patent agents. Not surprisingly, it is my understanding that these commissioned sales people encourage the inventor to move forward because they have no ethical obligation to provide advice that is in the inventor's best interest, and their commission depends upon convincing an inventor to move forward.

***Invent + Patent System<sup>TM</sup>***

44. The Invent + Patent System<sup>TM</sup> is an innovative approach I developed to allow an independent inventor to document his or her invention or ideas and then proceed to file a patent

application in a cost-effective and timely manner. The Invent + Patent System™ was originally created as a teaching tool to help me teach law students how to draft patent applications and over time was adapted for use with inventors. The Invent + Patent System™ is capable of three separate, yet related, endeavors. (The Invent + Patent System™ is described more fully at [www.ipwatchdog.com/patent/invent-patent-system](http://www.ipwatchdog.com/patent/invent-patent-system), a hardcopy of which is attached hereto as Exhibit 5).

45. First, independent inventors who have not yet reached the invention stage can use the system to collect their thoughts and begin to pull their ideas together. The Invent + Patent System™ can be effectively used to coax users into formulating their ideas in a more tangible way so that the concepts can move from pure idea into something descriptive enough to be legally viewed as an invention. In this aspect it is capable of invention “mining” and recognizes that as an idea becomes more tangible it can transform into an invention. This is because an idea that is adequately described as required by 35 U.S.C. 112, allows others to appreciate the scope of the invention, and then to both make and use the invention described with enough specificity to be legally called an invention.

46. Second, the Invent + Patent System™ can be used to create a provisional patent application that can be filed by the inventor at the United States Patent and Trademark Office. At the completion of the online questionnaire, independent inventors will receive the answers together with a patent application template, that includes instructions on where and how to insert the answers the system coached the user into creating. The user will also receive detailed filing instructions and the form that he or she will need to file a provisional patent application.

47. Finally, the Invent + Patent System™ can be used by those who want to take the first step toward filing a nonprovisional utility patent application with the United States Patent

and Trademark Office or filing an international patent application with the United States Patent and Trademark Office. The system is used to collect all the information necessary to turn over to a patent attorney or patent agent, who will then be in a much better position to actually begin the patent application drafting stage. In this incarnation, the system provides far greater efficiencies than simply working with a patent attorney or patent agent. This is because in the traditional situation, an independent inventor contacts a patent attorney or patent agent with an idea, or perhaps a sketch and a few paragraphs of text. The attorney or agent then tries to interpret this information and put it into the format required to file a patent application. The procedure could involve many sessions – back and forth – between the independent inventor and attorney, before a satisfactory first draft is produced. The process was, and is, slow, expensive and frustrating. Ultimately, an application would be filed not because it has covered the invention to the fullest extent possible, but because the independent inventor could not afford to pay the patent attorney or patent agent to spend any additional time working on the application. By using the Invent + Patent System™, the independent inventor can provide extremely directed information to the patent attorney or patent agent, thereby cutting costs and allowing for a much smoother and quicker patent application drafting process.

48. In my practice, I use the Invent + Patent System™. I have potential clients complete the online questionnaire at the earliest possible time, even before a patent search is conducted or a quote for services is provided. By collecting this information, I can provide a precise quote, and can obtain a patent search that is more targeted because more is known about the invention.

49. I then typically take the results of a patent search and go over them with the inventor, usually asking the inventor to provide his or her thoughts in writing. This allows me to

collect further information about the invention.

50. In the situation where there is likely patentable subject matter and the inventor wishes to proceed with either a provisional patent application or a nonprovisional patent application, the inventor is asked once again to complete the online questionnaire, this time armed with the knowledge provided by the patent search and my consultations. Thus, when we set out to draft a patent application we have received volumes of useful information from the inventor, tailored in specificity due to the fact that the online questionnaire asks targeted questions, provides answer templates for the inventor to use and depending upon the type of invention at issue, gives illustrative example answers to coach the inventor into understanding an appropriate level of detail. Help text explaining the question and how the answers will be used in a patent application also ensure more relevant answers.

51. This entire process leads to disclosure from the inventor that is typically at least 6 to 8 pages of single spaced text in addition to inventor notes and thoughts about the patents found. This information, combined with my patentability assessment (3 to 4 pages) or patentability opinion (1 to 2 pages) and my notes provide an excellent foundational disclosure that can be massaged into an extraordinarily detailed patent application.

52. At no time have I or anyone else affiliated with IPWatchdog represented that the Invent + Patent System™ can or would be used for “invention promotion services.”

***Relationship With Lambert & Lambert***

53. I met Trevor Lambert of Lambert & Lambert in March 2009 when we were both in North Carolina to participate in the filming of a 10-part mini-series sponsored by the UIA aimed at providing inventors information about the invention, patent, and commercialization process.

54. Since shortly after that time, Lambert & Lambert has been an advertiser on IPWatchdog.com.

55. Up until that point, I had incorporated Google AdSense into IPWatchdog.com, which delivered advertisements to various pages on IPWatchdog.com served by Google, Inc. I had limited control with respect to which advertisers could appear on IPWatchdog.com, and many individuals and businesses that I did not want to have advertising on IPWatchdog were appearing through being served from Google.

56. I started receiving complaints from readers of IPWatchdog.com and from some inventors that Plaintiff and other invention promoters were having their ads appear on IPWatchdog.com.

57. After much deliberation, I decided that having Google serve ads was not the best business decision, so I set out to become Google ads free. To accomplish this goal I decided I would actively seek out advertisers that I felt comfortable appearing on IPWatchdog.com and whom had good reputations.

58. Advertising started on a trial basis with Lambert & Lambert, and has grown over the months since we first started.

59. I have never had a referral relationship with Lambert & Lambert in any business sense.

60. Lambert & Lambert pays a flat monthly advertising fee for the right to have their ads appear on various IPWatchdog.com pages. No other fees are paid or monies exchanged. There are specifically no referral fees.

61. I never push any of my clients to work with Lambert & Lambert or any other

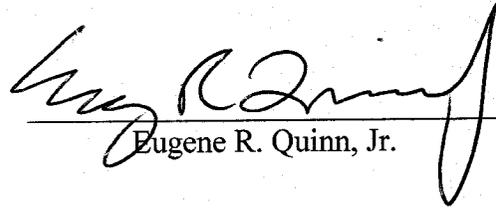
professionals, and I never receive any referral fee from any professional I refer clients (or non-clients) to.

62. I view my role in the invention-to-commercial-success process as limited based on my own knowledge and expertise, but I do what I can to point individuals and businesses in the right direction so that they might work with other professionals they may need assistance from, such as other attorneys who handle corporate matters, industrial designers and licensing professionals.

63. I have never engaged in licensing an invention or pitching an invention for purpose of licensing on behalf of a client or potential client.

In accordance with 28 U.S.C. § 1746, I declare under penalty of perjury that the foregoing is true and correct.

Dated: March 5, 2010

  
Eugene R. Quinn, Jr.