

## Intellectual Property Law Firm Celebrates 140 Years

By Sarah Scholz, Oakland County Legal News, June 24, 2005

This year the Troy law firm of Reising, Ethington, Barnes, Kisselle, P.C. is celebrating 140 years of practicing Intellectual Property Law. Since its foundation, the firm has specialized exclusively in the practice of intellectual property law, including the prosecution and litigation of patents, trademarks, and copyrights. Other areas of specialization include trade secrets, licensing, and unfair competition laws; as well as associated intellectual property matters.

The firm was founded in 1865 by Colonel Thomas S. Sprague, after his return from the Civil War. Unfortunately, not much else is known about Sprague, except that he opened up a patent law office after moving to Michigan from the East. The original name of the firm was Sprague and Son.

The firm has obtained some notable patents that have helped to create the Detroit market's image of being a leader in the manufacturing industry. Some of these notable patents include:

Charles B. King: Propeller drive for automobiles (first person to drive a motor vehicle in Detroit.)

Henry Ford: Motor vehicle components.

Ransom E. Olds: Motor vehicle.

David D. Buick: Two-cycle internal combustion engine.

General Motors: Motor vehicle components.

Fisher Body: Motor Vehicle body designs and functions.

John Kelsey (Kelsey-Hayes): Wheels for automobiles.

Briggs & Stratton: Motor starter.

Ternstidt Manufacturing: Radiator cap.

Fruehauf Trailer Co.: Trailer frame construction.

Bundy Tubing: Bundy weld process for copper tubing.

Dr. John Krehbiel: Method and machine for making gelatin capsules.

James Hinde: Corrugated wrapper for the electric light bulb.

Charles Munz: Household extension table in which the leaves were folded.

James Downey: Gas furnace for use by dentists in making porcelain enamel inlays.

Prescott M. Hulbert, who started at the firm on May 31, 1887, eventually became a partner of the firm. In 1947, at the 60th anniversary dinner held in his honor, at the Detroit Athletic Club, Hulbert reminisced about the early years of the firm. The following excerpts are recollections from those years.

"As neither Barthel nor Whittemore were lawyers, they made arrangements with one, Mr. George Lothrop of Detroit, to take care of any matters in litigation for them. It may be wondered why Mr. Barthel upon acquiring the business of Thomas S. Sprague & Son, which had been in operation for a period of 22 years, found it necessary to completely reorganize this business. The reason for this was that upon the death of Colonel Sprague, his law partner Mr. Hunt together with the stenographer by the name of Sculley, and the draftsman John Schumann, decided to go into business together for themselves and to advertise as 'Hunt & Sculley' successors to Sprague and Hunt. This left Mr. Barthel, who was not himself a typist, without any help, other than Harry Sprague...Barthel was a draftsman, but had not time to attend this part of the business and, therefore, offered me the situation. Barthel offered his brother-in-law, James Whittemore a partnership. He came to Detroit from Chicago in July 1887."

He added, "I (Hulbert) obtained from him (Adolf Barthel) my first understanding of patent practice, as well as a great deal of other valuable information. It had always been my expectation to take a university course in engineering, but he persuaded me that there was much better opportunity for advancement in a professional career in his employ than there might be after a number of years in further schoolwork. I have never regretted the decision to stay with him."

James Whittemore found that reading law by himself was not a very expeditious way of acquiring the necessary legal training to be admitted to the practice and to take care of that part of the firm's business. Along about the year 1891, a number of young men in Detroit who were in regular business and deciding to acquire a knowledge of law, conceived a plan of hiring a tutor who could instruct them along this line. They secured the services of Mr. Meachin who had been a law instructor and was the author of a number of books. This was the start of what later became the Detroit College of Law. Later, Mr. Meachin had an offer of a professorship in the University of Michigan, and other Detroit lawyers undertook the work of carrying on this law school in Detroit. James Whittemore graduated in 1893; soon after was admitted to the bar, and almost immediately started his patent litigation. In this he was helped by George H. Lothrop, who was quite an eminent patent lawyer.

"I began the study of patent practice almost immediately after entering the employ of Barthel and Whittemore..." Hulbert said. "I did not begin the study of general law until the year 1893, when I entered the Detroit College of Law. By this time, this college was quite completely organized, the law course was only for two years. Between 1893 and 1895 practically all of my time outside of office hours, was taken up with this law work," Hulbert said.

"L.J. Whittemore was attending a prep school in the East and subsequently entered the University of Michigan to take a course in electrical engineering. During the two years of this course he was in the employ of Barthel and Whittemore, acquiring a knowledge of patent practice, and after graduating formed a partnership with a Mr. Toulman of Dayton, Ohio, opening a branch office in Cleveland."

Hulbert added, "The offices moved numerous times. Shortly after moving to the Wayne County Bank building, Barthel and Whittemore decided to dissolve the partnership. They were still using the firm style of Thomas S. Sprague & Son. Barthel sold his interest in this to Mr. Whittemore, and he returned to the old office in the basement of the Seitz building, conducting a patent soliciting business (Adolph Barthel was not a lawyer) under the name of Barthel and Barthel. Mr. Barthel

offered me a partnership, but I preferred to stay with Mr. Whittemore as an employee. At that time, L.J. Whittemore returned from Cleveland, and also entered the employ of his brother."

According to Hulbert, "At the beginning of the partnership of Barthel and Whittemore, the usual cost of obtaining a patent was \$60. This included the first government fee of \$15, the final fee of \$20, and the attorney's fee of \$25 which included one sheet of drawings and also all amendments up to the allowance or final rejection. Preliminary examinations were \$5."

James Whittemore formed a partnership with L.J. Whittemore and Hulbert in 1906. The firm was renamed Whittemore, Hulbert & Whittemore.

William J. Belknap joined the firm in 1907 and eventually became a partner in the firm, thus the name of the firm changed again, this time to Whittemore, Hulbert, Whittemore & Belknap.

James Whittemore eventually sold his part of the business to L.J. Whittemore, Hulbert, and Belknap to take care of his wife. The firm was renamed Whittemore, Hulbert & Belknap.

The firm merged with another firm, Barnes, Kisselle, Raisch, Choate, in 1982. Eventually, the name was changed to its current one.

There are ten to fifteen firms in Southeastern Michigan that are just intellectual property law firms.

Lawyers must have a science/engineering degree in order to practice intellectual property law. Today, the amount of time it takes to get a patent depends on the technology. Sometimes it could take thirteen months all the way to four years. The cost is also variable.

Recently, the firm invested in new technology that allows them to file and track patent applications faster and for a lower cost. They have also invested in technology that enhances their ability to advocate a client's position in court.

The use of new electronic filing technology for patent applications entitles many of Reising's clients to reduced government fees and provides them with an immediate confirmation of a successful filing.

According to Reising attorney Jim Stevens, "The use of secure electronic access to the U.S. Patent and Trademark Office provides a number of efficiencies that directly benefit our clients. Through a confidential system, we have complete access to the internal Patent Office records for our client's files. This allows us to obtain copies of official documents and current file status information instantaneously. No more waiting weeks or even months to receive a filing confirmation or a response to an inquiry or request for documents."

On the litigation side, Reising attorneys are successfully using advanced presentation technology in the courtroom and throughout the litigation process. Reising attorney Jake Grove states, "When advocating a client's position, the visual power of color animation is worth more than a thousand words. We have seen the positive reactions and the positive results achieved when our attorneys use animation in the courtroom. We also file CD-ROM briefs and we take advantage of

the electronic filing systems available with the courts."

One of the most recent notable cases for Reising, Ethington, Barnes, Kisselle, P.C. was a landmark case that defined the boundaries of trademark and patent law.

The case, TrafFix Devices, Inc. v. Marketing Displays, Inc., involved a matter of trade dress. It went all the way to the U.S. Supreme Court in March of 2001. Reising, Ethington successfully identified an overlap between trademark law and patent law that created confusion when defining the requirements necessary for trade dress. In doing so, the firm helped the court define the requirements necessary for trade dress ownership. The court delivered a unanimous decision in favor of the firm's client, TrafFix Devices, Inc. The requirements defined in this case are used today in courtrooms across the country.

The firm represents some Fortune 100 companies and individual inventors. They encourage creative thinking, and provide strong support for the creative organizations in the community that help cultivate inventive thinking, including Automation Alley, the Cranbrook Educational Institutions, and the College for Creative Studies.