



# SDIPLA News

Join us on January 18th at the **Embassy Suites** in La Jolla to hear **Frederic Douglas** of Klein, O'Neill & Singh give a discussion on Inequitable Conduct entitled, "How to Lose Your Patent Rights." Mr. Douglas will provide an extensive overview of the hazards of patent prosecution that can lead to inequitable conduct, including settlement agreements, untranslated foreign documents, USPTO miscalculations of patent term, and the improper use of the past tense in patent applications.

## JANUARY MEETING

~WEDNESDAY, JANUARY 18TH

**"INEQUITABLE CONDUCT: HOW TO LOSE YOUR PATENT RIGHTS"**

BY: FREDERIC DOUGLAS; KLEIN, O'NEIL & SINGH

Mr. Douglas specializes in patent prosecution, trademark prosecution, and intellectual property litigation involving patent infringement, trademark disputes, trade secret misappropriation, and copyright issues. He also has negotiated all types of contracts, including joint venture agreements, intellectual property licenses, confidentiality agreements, non-compete agreements, and employment agreements. Mr. Douglas also has extensive experience conducting non-infringement reviews and patentability reviews, including preparing opinion letters.

### Upcoming Events:

~FEB 9 - Robert Spar; USPTOs Claims and Continuations Initiative

~Feb 16 - Dr. David McGowan, USD—IP Licensing & Antitrust

~Mar 4— Black and White Ball

~Mar 24-26 - Joint OCIPLA/ SDIPLA meeting at La Costa

~Mar 27-28 - LIMA; Advanced Licensing Seminars For Licensing Professionals 2006 (LA)

~May 25 - Chief Judge Damich

Prior to practicing at Klein, O'Neill & Singh L.L.P., Mr. Douglas was Lead Patent Attorney at Aetas Technology, Incorporated, Irvine, California, a start-up color laser printer company. Mr. Douglas is registered to practice before the U.S.P.T.O. and he is a member of the California Bar. He is admitted to practice before the U.S. Central District of California and the U.S. Ninth Circuit Court of Appeals.

Before attending law school, Mr. Douglas worked as an engineer with Tosco Refining in Martinez, California and as an engineering intern at the Lawrence Livermore National Laboratory in the area of semiconductor processing and plutonium reclamation.

Mr. Douglas obtained his Juris Doctor (J.D.) from the University of California, Davis School of Law where he was a member of the UC Davis Law Review. Prior to law school he obtained a Bachelor of Science (B.S.) in Chemical Engineering from the University of California at

## JANUARY 18th DINNER MEETING

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#### Date/Time/Location:

January 18, 2006  
6:00 p.m.—9:00 p.m.

**Embassy Suites**  
**4550 La Jolla Village Drive**  
**San Diego, CA**

858.453.0400  
[www.embassysuites.com/en/es/hotels/index.jhtml?](http://www.embassysuites.com/en/es/hotels/index.jhtml?)

#### Directions:

> From I-5, exit at La Jolla Village Dr.; go east one mile; hotel is on the left  
> From 805 - Take the La Jolla Village Dr. exit; go west 1/4 mile; hotel is on the right  
> From Miramar Rd. - go west 6 miles. Miramar Rd. Turns into La Jolla Village Dr.; pass over hwy. 805 and turn right on Executive Way.  
> From hwy. 8 west - take hwy. 805 north and exit at La Jolla Village Dr.; Go west a1/4 mile; hotel is on right side.  
> From San Diego Airport - take hwy. 5 north and exit La Jolla Village Dr.; Go east one mile; the hotel is on left side. The hotel is directly across from entrance of the Westfield UTC Shopping Mall.

**FEBRUARY 9TH MEETING****~LOCATION AND TIME TBA****“USPTO’S CLAIMS AND CONTINUATIONS INITIATIVE”**

BY: ROBERT J. SPAR, DIRECTOR

OFFICE OF PATENT LEGAL ADMINISTRATION AT THE USPTO

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**Robert J. Spar**

**Robert J. Spar** is the Director of the Office of Patent Legal Administration, (OPLA), under the Deputy Commissioner for Patent Examination Policy at the U.S. Patent and Trademark Office (USPTO). A major responsibility of the OPLA is addressing policy initiatives involving the patent examination process. This includes developing, implementing and disseminating information about changes to patent examining practices and procedures via rulemaking, publishing notices in the Federal Register and the Official Gazette, modifying USPTO forms which are used both internally and externally, and distributing internal memoranda. Recent extensive rulemaking efforts undertaken and completed by Mr. Spar and the OPLA are the four AIPA final rule packages (Requests for Continuing Examination or RCE, Patent Term Adjustment, Pre Grant Publication, and Inter Partes Reexamination) and the Patent Business Goals – Final Rule. In addition, OPLA is responsible for implementation of each of the final rule packages, which includes training, as needed, of the technical support staff, the examining corps, and members of Patent management. To inform the patent and inventor communities about the changes made by these various rulemakings, and how they are being implemented, Mr. Spar and his staff have developed AIPA and PBG – Final Rule web pages on the USPTO’s web site, and they have made numerous presentations throughout the country.

**Newsletter Editor**

Rob Prince

**Webmaster**

Tobey Tam  
Quidel Corporation

## Reservation Form for January 18, 2006 Meeting

### ***“Inequitable Conduct: How to Lose Your Patent Rights”***

BY: FREDERIC DOUGLAS; KLEIN, O'NEIL & SINGH

**Tuesday, January 18th, 2006**

Registration, networking, cocktails 6-6:45

Dinner starts at 6:45

Presentation starts at 7:15 p.m.

#### The Menu

##### **Coast Cafe Buffet**

<b>Buffalo Mozzarella Salad</b> Fresh Mozzarella Cheese, Ripe Tomatoes and Basil. Prepared with Olive Oil and Garlic	<b>California Salad</b> Spring Mix Lettuce, Mandarin Oranges, Hearts of Palm, Toasted Walnuts, Seasoned Croutons served with our House Vinaigrette
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##### **Tortellini Pasta Salad**

Fresh Seasonal Vegetables with chunks of Feta Cheese Served with a Pesto Sauce

##### **Chicken Piccata**

Boneless Breast of Chicken Sautéed with Lemon Butter and served with Lemon Capers Sauce

##### **Roasted Top Round**

Served with Au Jus and Appropriate Accompaniments

##### **Pasta Primavera**

Penne Pasta mixed with a Colorful Array of Seasonal Vegetables, Olive Oil and Herbs Two Sauces: Marinara & Alfredo Sauces

##### **Desserts**

(Included with Meal)

Chocolate Cake, Apple Pie, or Fresh Fruit

Due to the large number of attendees expected at this event, the SDIPLA is again requesting **Pre-Registration and Pre-Payment**.

To reserve your place, please fill out the below registration, and send it **WITH YOUR CHECK MADE PAYABLE TO ‘SDIPLA’** to:

Robert Prince  
SDIPLA Secretary  
14651 Woodhue Lane  
Poway, CA 92064  
(858) 722-4597  
FAX: (858) 748-8201  
[rprince@sbcglobal.net](mailto:rprince@sbcglobal.net)

Please include:  
[Ichristiansen@san.rr.com](mailto:Ichristiansen@san.rr.com) on all e-mail reservations.

Please complete separate form for each attendee.

### REMINDERS G

- Please mail, fax, or e-mail your reservation to Robert Prince at the address, fax, or e-mail address indicated for receipt *no later than 12:00PM, January 16, 2006*.
- The reservation deadline is dictated by the hotel and not by the SDIPLA.
- This program has been approved for MCLE credit by the State Bar of California in the amount of one (1.0) unit in Ethics.

#### NOTE Meeting PRICES

**\$40.00 SDIPLA Member**

**\$55.00 Non-Member**

## Reservation Form for January 18th Dinner Meeting

Name: \_\_\_\_\_

E-Mail Address: \_\_\_\_\_

Firm/Employer: \_\_\_\_\_

Telephone Number: \_\_\_\_\_

**DEADLINE FOR REGISTRATION IS 12:00PM, JANUARY 16, 2006**

## MEMBERSHIP RENEWAL

Name: \_\_\_\_\_

E-Mail Address: \_\_\_\_\_

\_\_\_\_\_

(required to receive newsletters)

Firm/Employer: \_\_\_\_\_

Mailing Address: \_\_\_\_\_

City/State/Zip: \_\_\_\_\_

Telephone Number: \_\_\_\_\_

Send check or money order payable to SDIPLA Dues to: Robert Prince

Attorney Member Dues: \$50/year

SDIPLA Secretary

Non-Attorney/Retired Attorney Dues: \$25/year

14651 Woodhue Lane

(e.g. law students, paralegals, patent agents, retired

Poway, CA 92064

### Please Renew Your Membership for Fiscal 2005-2006

All SDIPLA members are asked to send in their membership dues, if they have not already, using the Membership Renewal form above.

- E-Mailing of newsletters and notices will replace regular mailing.
- Members who have not renewed membership **by November 30, 2005**, will be **removed** from the active member mailing list.
- SDIPLA had approximately 275 active members in 2004-2005.
- **On-line registration now available– visit [www.SDIPLA.org](http://www.SDIPLA.org).**
- SDIPLA would like to increase active membership, including significantly in-house practitioners.
- SDIPLA welcomes any suggestions to make the renewal process more efficient.
- SDIPLA welcomes any suggestions to increase membership.
- If you have suggestions, please do not hesitate to contact one of the officers.

### Announcements

This Announcements section is designed to better serve the needs of the membership. This page may be used to advertise for positions offered or desired, as well as to provide a forum for announcements of interest to the San Diego IP community. Please contact Rob Prince if you would like to place an ad or announcement.

Date	Event	Speaker/Topic
January 19-20, 2006	Patent Procurement, Licensing and Litigation In China	Sponsored by: Center for American and International Law
February 9, 2006	USPTO's Claims and Continuations Initiative	Robert Spar
February 16, 2006	Dinner Meeting	Dr. David McGowan, USD—IP Licensing & Antitrust
March 4, 2006	5th Annual Black & White Ball <i>Gala to Benefit</i> The Association of Corporate Counsel - America & San Diego Habitat for Humanity	San Diego Chapter of the Association of Corporate Counsel – America
March 24-26, 2006		Joint OCIPLA/SDIPLA meeting at La Costa
March 27-28, 2006	Advanced Licensing Seminars For Licensing Professionals 2006	Sponsored by LIMA. ~Please see attached brochure
April	TBA	
May 25, 2006		Chief Judge Damich– US Court of Claims

Visit SDIPLA on the Web at:  
[www.sdipla.org](http://www.sdipla.org)

#### SDIPLA COMMITTEES

SDIPLA has Amicus, Awards, Editorial, Events, and Sponsorship committees. **Members are needed for the sponsorship and events committees.** Please contact an officer if you are interested in joining a committee. Go to the SDIPLA website at [www.sdipla.org](http://www.sdipla.org) for more information about these committees and SDIPLA.

#### Applications for SDIPLA Membership

The following individuals have applied for SDIPLA membership. Active Members may oppose membership status to these

Morgan Adessa	Thane Bauz	Samir Elamarari	Bernard Greenspan	John Grohs
Maryanne DeAngelo	Jae Hong Lee	Mary Lee	Jinn-Nan Lin	Bin Liu
Megan Jamroz	Ann Lygas	Daryl Muenchau	Lauren W. Nguyen	Ellen Nudelman
Penelope Long	Milan Patel	Eric Peterson	Steven C. Petersen	Kayla Seignious
Sara O'connell	Astrid Spain	Eric Vieira	Kathryn Waer	
Patricia A. Shackelford	Amy Bathke	Ethan Boyer	Laura Collins	

individuals by lodging a formal notice of opposition. The opposition must include relevant grounds for disqualification and

**ARTICLES:** If you have an article for the newsletter, please send it to Rob Prince.

**DUES:** To pay or renew your **membership dues:** Please use the form on page 4, and send form via mail or fax to Rob

### Announcements (continued)

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# Paul Hastings

## ATTORNEYS

### Grow Your Intellectual Property Career at Paul Hastings

**Paul Hastings** has a full-service intellectual property practice dedicated to serving leading information technology and life sciences companies all over the world. From Shanghai to Southern California, Palo Alto to Paris, our fast-growing practice includes more than 80 full time IP attorneys, many with advanced degrees in physics, mechanical engineering, electrical engineering, chemical engineering, biology, biochemistry, molecular biology and chemistry. We combine in-depth technical expertise and sophisticated legal talent to provide our clients with the best possible representation.

**Paul Hastings** currently has openings Los Angeles, Palo Alto and San Diego for motivated intellectual property attorneys with 2 to 5 years of patent litigation and/or patent prosecution experience in the following areas:

- Electrical Engineering
- Computer Engineering
- Computer Science
- Physics

Excellent academic credentials and writing skills required; technical degrees are preferred (but not required).

Please submit resumes and transcripts to:

*Lisa Patterson, Attorney Recruiting & Development Coordinator*

**PAUL, HASTINGS, JANOFSKY & WALKER LLP**

3579 Valley Centre Drive

San Diego, CA 92130

[lispatterson@paulhastings.com](mailto:lispatterson@paulhastings.com)

### INGRASSIA FISHER & LORENZ, P.C.

#### WE LEFT THE BIG GENERAL PRACTICE FIRMS BEHIND

... because we knew we could run a better patent practice ourselves. **Ingrassia, Fisher & Lorenz** is now one of the largest intellectual property boutique firms in the southwest, and we are looking for qualified patent attorneys for our expanded San Diego office. We provide top quality counsel to some of the nation's best technology companies, and we do it in an environment that is relaxed, flexible, generously-compensated and savvy to the unique needs of patent attorneys. If you have outstanding technical skills, a deep commitment to client service, and a burning desire for life beyond the almighty billable hour, we'd like to talk to you. EE degree and at least five years of patent preparation and prosecution experience required.

Email resume and writing sample in confidence to [recruiting@ifllaw.com](mailto:recruiting@ifllaw.com).

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~THURSDAY & FRIDAY, JANUARY 19-20TH ~ SAN FRANCISCO

#### "PATENT PROCUREMENT, LICENSING AND LITIGATION IN CHINA"\*\*\*

SPONSORED BY: CENTER FOR AMERICAN AND INTERNATIONAL LAW

INSTITUTE FOR LAW AND TECHNOLOGY

9.75 MCLE Credit Available

THE CENTER FOR AMERICAN AND INTERNATIONAL LAW

*ILT Forum*

**PATENT PROCUREMENT, LICENSING AND LITIGATION IN CHINA**

January 19-20, 2006  
*January 21, 2006 (optional)*

Hotel Nikko  
San Francisco, California

**Featuring**

- Day One — Overview and practical patent strategies in China
- Day Two — Overview and real world experience enforcing patents in China
- Luncheon Speakers —
  - *Chris Israel, U.S. Coordinator for International Intellectual Property Enforcement*
  - *The Honorable He Zhanglin, China Intellectual Property Society*
- Networking Roundables and Optional Wine Country Tour with Faculty

[www.cailaw.org](http://www.cailaw.org)



#### San Diego Chapter of the Association of Corporate Counsel – America Hosts 5th Annual Black & White Ball

*Gala to Benefit*  
The Association of Corporate Counsel - America & San Diego Habitat for Humanity

**What:** The San Diego chapter of the Association of Corporate Counsel – America will host its 4th annual “Black & White Ball,” a black-tie optional gala benefit for San Diego Habitat for Humanity. The evening will include music by Innovation, silent auction and a casino. San Diego Habitat for Humanity is an affiliate of Habitat for Humanity International, a non-profit, ecumenical organization with a mission to eliminate poverty housing. San Diego Habitat for Humanity builds homes and sells them to low-income families with a 20-year, 0%-interest mortgage.

**When:** Saturday, March 4, 2006  
Wine Reception at 6:00 p.m.;  
Dinner at 7:30 p.m.

**Where:** Manchester Grand Hyatt

**Info:** For more information or sponsorship opportunities please contact:

**Hillary Wilson** ([hwilson@alarismed.com](mailto:hwilson@alarismed.com)) or  
**Jon Hellings** ([jhellings@cox.net](mailto:jhellings@cox.net)).

For ticket information please contact:  
**Jon Hellings** at 619-758-0795 or  
[jhellings@cox.net](mailto:jhellings@cox.net).