



SDIPLA News

SDIPLA ANNOUNCES 2008 IP ACHEIVEMENT AWARD RECIPIENT

FLOSSIE WONG-STAAAL, PH.D.

Please join us on Thursday, December 11, 2008 at the Lodge at Torrey Pines for the SDIPLA 2008 Holiday Party where the 2008 IP Achievement award will be presented.



Flossie Wong-Staal, Ph.D. is a Chinese-American virologist and molecular biologist. Respected highly in the scientific community for her pioneering and continuing contributions to the field of viral research, she is credited as a co-discoverer of HIV along with Robert Gallo and Luc Montagnier. The first to define the genetic structure of HIV, she and her colleagues also identified many of the fundamental properties of HIV and provided most of the early key reagents for the field of HIV molecular biology. Dr. Wong-Staal's early work helped pave the way for the development of molecular diagnostics and therapies for HIV, the virus that causes AIDS.

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Date/Time/Location:

December 11, 2008
6:00 p.m.—9:00 p.m.
Lodge at Torrey Pines
11480 North Torrey Pines Rd.
La Jolla, California

Notes:

Cocktail Attire
Rooms available.

Directions:

From I-5 exit Genesee
Turn right
Genesee becomes North Torrey pines Rd.

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SDIPLA HOLIDAY PARTY



***Please join us on Thursday, December 11, 2008
at the Lodge at Torrey Pines for the
SDIPLA 2008 Holiday Party!!!***

The SDIPLA thanks our Sponsors for the
monthly meetings:

**Knobbe Martens Olson & Bear LLP
www.kmob.com**

**Perkins Coie LLP
www.perkinscoie.com**

**Townsend and Townsend and Crew LLP
www.townsend.com**

(listed alphabetically)

Reservation Form for December 11, 2008 Holiday Party

Featuring IP Achievement Award Recipient

FLOSSIE WONG-STAAAL, PH.D.

**Thursday, December 11th
Dinner Meeting**

Torrey Pines Lodge

Registration starts at 6:00 p.m.
Cocktails at 6:00 p.m.
Dinner starts at 6:45 p.m.
Award at 7:15 p.m.

The Menu

Romaine & Belgian Endive Salad

With one of the following entrees:

Roasted Pork Rib Roast

With maple syrup sweet potatoes

**** OR ****

Horseradish Crusted Salmon

With green beans, crème fraiche and chives

**** OR ****

Vegetarian Selection

And

Crème Brulee with

Coffee and Tea

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:

John E. Peterson
SDIPLA Secretary
Perkins Coie, LLP
1620 26th St., 6th Fl. South Tower
Santa Monica, CA 90404
(310) 788-3346
Fax: (310) 788-1272
JEPeterson@PerkinsCoie.com

On-line reservation available– go to www.acteva.com and search for SDIPLA or follow the link at www.SDIPLA.org

Please fill out a separate form for each attendee.

REMINDERS

- Please mail, fax, or e-mail your reservation to John Peterson at the address, fax, or e-mail address indicated for receipt **no later than December 9, 2008**.
- The reservation deadline is dictated by the hotel and not by the SDIPLA.
- **Please bring a guest and enjoy the Holiday spirit with your IP family!**

NOTE MEAL PRICES

\$89.00 per person

Registration

Name: _____ E-Mail Address: _____

Firm/Employer: _____

Telephone Number: _____

Member of SDIPLA? (circle one) YES NO

Entrée Choice: _____ Pork _____ Salmon _____ Vegetarian

MEMBERSHIP/RENEWAL APPLICATION

Name: _____

E-Mail Address: _____

(required to receive newsletters)

Firm/Employer: _____

Mailing Address: _____

City/State/Zip: _____

Telephone Number: _____

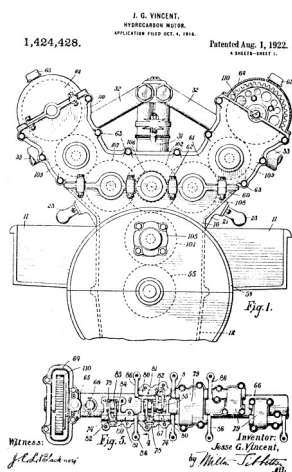
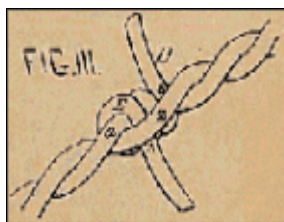
Send check or money order payable to SDIPLA Dues to: John E. Peterson

Attorney Member Dues: \$50/year SDIPLA Secretary

Non-Attorney/Retired Attorney Dues: \$25/year Perkins Coie, LLP

(e.g. law students, paralegals, patent agents, retired attorneys, etc.) 1620 26th St., 6th Fl. South Tower
Santa Monica, CA 90404**Notes Regarding Your Membership**

- E-Mailing of newsletters and notices has replaced regular mailing.
- **On-line registration now available– visit 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.



Flossie Wong-Staal, Ph.D. 2008 Recipient of the SDIPLA IP Achievement Award

Born Yee Ching Wong in communist mainland China, she fled with her family in 1952 to Hong Kong, where she entered an all-girls Catholic school. The school encouraged Wong to adopt an English name. Her father, who did not speak English, chose the name Flossie from newspaper accounts of Typhoon Flossie, which had struck Hong Kong the previous week. Even though none of Wong's female relatives had ever gone to college or university, her family enthusiastically supported her education and in 1965, she went to the United States to study at the University of California at Los Angeles. In 1968, Wong graduated magna cum laude with a B.S. in bacteriology and obtained a doctorate in molecular biology from UCLA in 1972.

Dr. Wong did her postgraduate work at the San Diego campus of the University of California in 1971 and 1972. It was during that time that she married and added Staal to her name. (She later divorced but kept the name). In 1973, Wong-Staal moved to Bethesda, Maryland, where she worked at the National Cancer Institute (NCI) with AIDS pioneer Robert Gallo. Searching for a cause for the newly discovered AIDS epidemic, Gallo, Wong-Staal, and other NCI colleagues identified HIV in 1983. In 1985, Wong-Staal was responsible for the first cloning of HIV. Her efforts also led to the first genetic mapping of the virus, allowing eventual development of tests that screen patients and donated blood for HIV.

In 1990 Wong-Staal left the National Cancer Institute to become the Florence Riford Chair in AIDS Research at the University of California at San Diego (UCSD). Her research at that time focused on gene therapy, using a ribozyme "molecular knife" to repress HIV in stem cells. The protocol she developed was the second to be funded by the United States government.



In 2002, Wong-Staal left her position as Florence Riford Chair in AIDS Research at UCSD to join Immusol, a San Diego-based biopharmaceutical company she co-founded. As Chief Scientific Officer and Vice President of Genomics at Immusol, Dr. Wong-Staal led drug discovery and development programs in several disease areas, including viral diseases. In December 2007, Immusol changed its name to iTherx. Dr. Wong-Staal is currently Executive Vice President of Research and Chief Scientific Officer of iTherx, a San Diego pharmaceutical company focused on the discovery and early clinical development of innovative treatments for Hepatitis C.

Discover Magazine recognized Dr. Flossie Wong-Staal in 2002 as one of 50 most extraordinary women scientists across all disciplines. Selection of the top women scientists was based on achievements in their particular field of study. Other commendations and professional achievements by Dr. Wong-Staal include election into the National Academy of Sciences' prestigious Institute of Medicine; Membership in Academia Sinica, Taiwan; Excellence 2000 award from the United States Pan Asian Chamber of Commerce; the T-Sector Innovator of the Year award 2001; and being named top woman scientist of the decade by the Institute for Scientific Information in 1992, based on the number of citations her work received in the scientific literature.

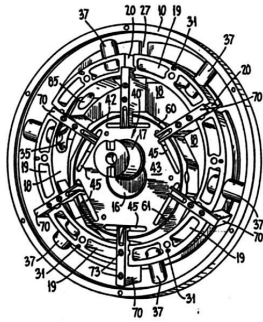
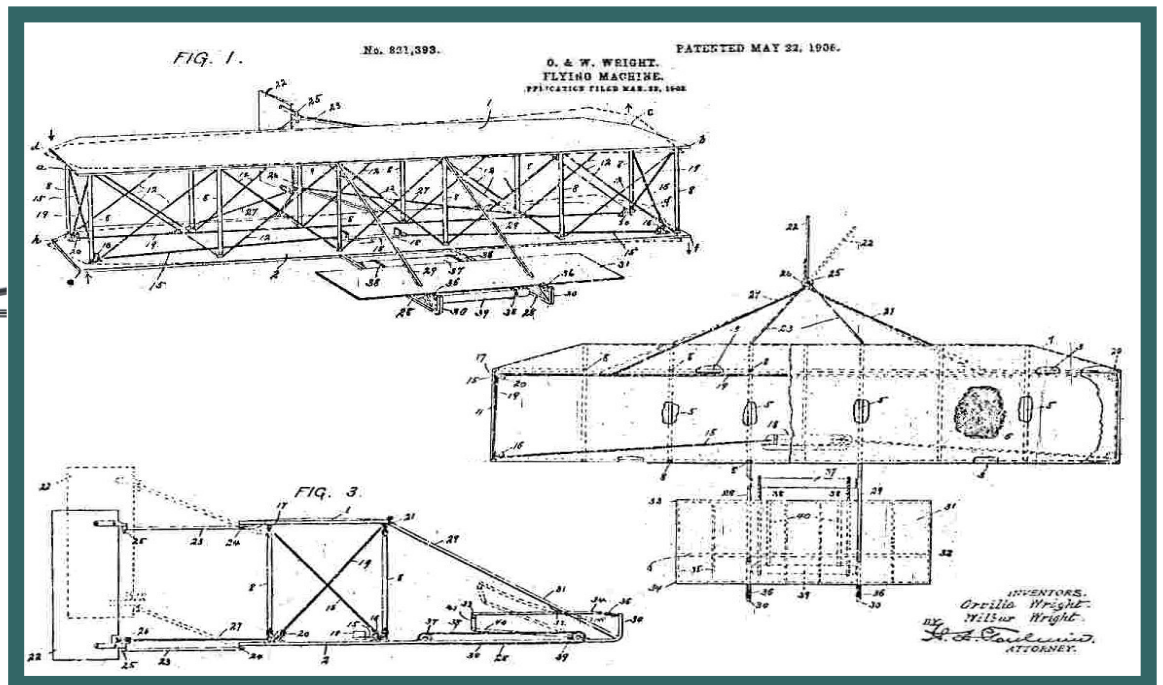
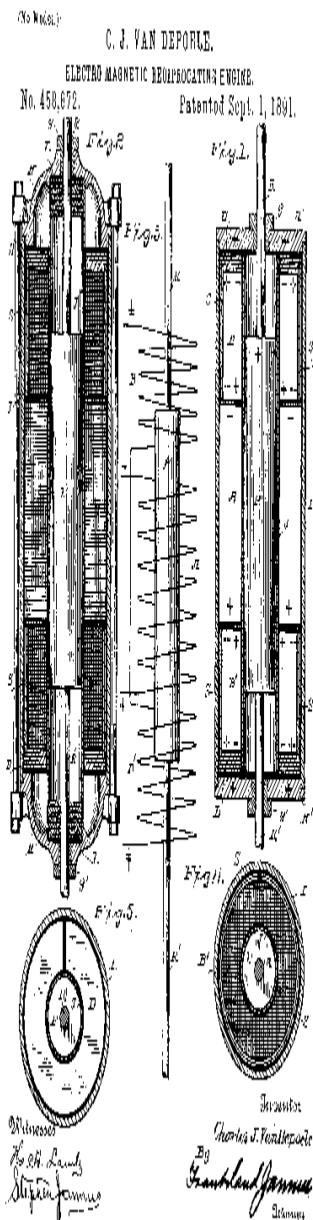


FIG. 2.





Internet Sightings column for December 2008

Heading - *Internet Sightings* by Jim Hawes

This column highlights some of the more notable recent internet notices, newsletters and blogs dealing with IP prosecution issues. It is a distillation by this newsletter's editor of the submitted IS column. The full IS column, with compilations of some of the sources such as Hal Wegner's newsletter, is now up and available at www.internetsightings.com. Check it out.

Hal Wegner's newsletter – a lot of great stuff – Contact: hwegner@foley.com

The 11/3/08 newsletter discussed the DBC Fed. Circuit decision which held, among other things, there to be no nexus between the claimed invention and considerable commercial success, so it was not considered.

The 11/5/08 email includes a PowerPoint attachment that projects the Obama IP program – PTO leadership, Patent reform (likely to take 2 years) and the Fed. Circuit (a new Chief Judge will be in place by early 2011) – note: there are now 1.2M pending patent applications.

Another 11/5/08 email reports a claim construction speech by CAFC Judge Plager who concludes that it is “inherently indeterminate.”

The 11/10/08 message includes an address for a free Podcast of a Bilski seminar – www.ipcolloquium.com.

Another 11/10/08 message urges the use of declarations to establish various KSR criteria (even though none have been successful so far). Hal's 11/11/08 email suggests why.

The 11/12/08 posting reports the Touchcom CAFC decision which, in granting a motion to disqualify, relied on an unpublished VA decision.

The 11/12/08 email presents Hal's current Top Ten list. Also see Hal's 11/18, 11/24, and 11/26 emails.

The ongoing Tafas case is discussed in Hal's emails of 11/11 and 11/12.

The 11/13/08 email further reports the Touchcom CAFC decision finding malpractice for use of a means claim in an application drafted 6 years *before* a rule change made such use improper

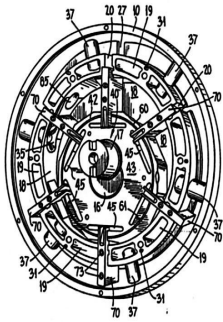


FIG. 2.



unless properly supported.

Another 11/13/08 email includes an attachment giving Hal's views about coming IP changes, including PTO leadership, Congressional leadership, patent reform legislation and the CAFC.

In still another 11/13/08 email Hal argues for 10 specific changes that would achieve prompt inter partes reexamination.

The 11/14/08 message discusses the PTO practice of registering Canadian patent attys. without examination.

The 11/17/08 email relays a report that about 1.21M patent cases await action at the PTO; 750K of them await first action. For details, see the Patently-O email of 11/16.

The 11/19/08 email reports that the CAFC has issued a revised internal operating procedures manual. Essential reading for those practicing before the Court.

The 11/20/08 message cites the Medegen CAFC decision in which the Court strongly criticized both sides for presenting admittedly inaccurate descriptions of the invention in their briefs (Hal says that the appellee was represented by a possible appointee to the Court).

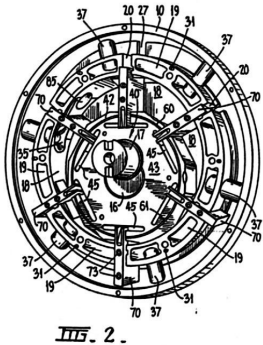
The 11/26/08 email discusses the PTO's suppression of internal decisions re petitions.

Patently-O – a blog written by Dennis Crouch – www.patentlyo.com.

The 11/2/08 blog discusses how to draft software claims post Bilski.

The 10/31 blog discusses patenting tax strategies post Bilski.

- The 11/3/08 blog presents a paper by Prof. Collins about Bilski.
- The 11/5/08 email discusses a paper by Prof. Holman applying Bilski to biotechnology and the life sciences.
- The 11/6/08 offering discusses the DBC Fed. Cir. decision which held, among other things, that the BPAI judge constitutionality appt. problem was deemed waived for not being raised before the BPAI.
- Another 11/6/08 email challenges the PTO's assertion that patent applicants are under an obligation to disclose different ownerships of each claimed invention in an application.
- A note posted 11/8/08 reports a patent appln. that allegedly buried a clearly relevant reference among a list of 75 references thereby violating the applicant's duty of disclosure.
- The 11/11/08 email discusses applying Bilski to a bodily fluid to determine vitamin deficiency – is this patentable under 101? (No)
- The 11/12/08 message discusses a proposal by Tim Wilson of SAS that



the patent application fee should be \$50,000.! Read why.

- The 11/14/08 blog reports the Bo Li BPAI decision applying Bilski to find a memory stored computer program statutory.
- The 11/16/08 email reports the average wait from filing to first OA by some tech centers (1.7 mo. for TC 3720 vs. 3.7 mo. for TC 1795).
- The 11/18/08 blog discusses the Baselle CAFC 2-1 decision holding that a double patenting obviousness decision may be only one-way, not two-ways, and is different than a 103 obviousness analysis.
- The 11/19/08 message cites data showing that electronic filing of patent applns. rose from about 14% in 2006 to about 72% in 2008.
- The 11/20/08 blog discusses the Anderson CAFC decision re analogous prior art, reversing because the cited screen was outside the scope of relevant prior art.
- The 11/21/08 message points out that the '72 Benson decision is still good law, and discusses how it applies in light of Bilski. Interesting.
- The 11/25/08 posting cites some new (to me) patent blogs.

The 11/26/08 blog discusses the BPAI Halligan decision holding that a means plus function claim requires a supporting description in the specification, including a computer's algorithm. When absent (as here) the claim lacks an adequate disclosure.

IP law 360 – a newsletter covering all IP, but focusing mainly on litigation – web address: www.iplaw360.com

*The 11/5/08 newsletter reports that the Danish PTO is joining the PTO's prosecution highway program.

* The 11/7/08 message includes a note that some firms are creating a part-time work-life balance track to partnership.

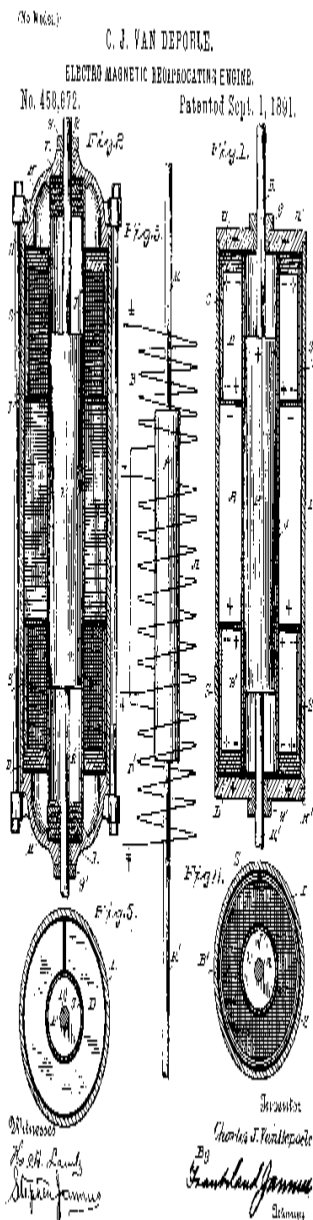
* The 11/7/08 message also includes a guest column suggesting that, under new OED rules, the scope of conduct relevant to moral character includes your driving record.

* The 11/13/08 offering includes a reminder that new PTO fees for PTC applications are now in force.

* The 11/14/08 email has a guest column discussing the recent changes to ITC sec. 337 litigation.

* The 11/17/08 newsletter includes a note about lawyer's blogs – gold mine or land mine?

Daily Dose of IP – a grab-bag of various IP matters by Mark Reichel –



www.dailydoseofip.com

*The 11/4/08 dose says that the Australian PO will now function as an International Searching Authority under the PCT.

Cal Bar IP Section – alerts when appropriate – Contact:
mitch.wood@calbar.ca.gov

The 11/17/08 alert reports that the PTO has begun a pat. atty. maintenance fee – it now will cost \$118 to maintain your registration. Hal Wegner says the fee will be due 9/30/09. See his 11/17/08 email. (Daily Dose says it will be due next spring.) A Patently-O email on 11/18/08 said that a paper submitted by a practitioner who had been suspended for non-payment of the registration maintenance fee will be treated as unsigned. Watch for further info.

AIPLA Direct – a newsletter issued from time to time to AIPLA members. http://www.aipla.org/Content/ContentGroups/About_AIPLA1/AIPLA_Reports/AIPLA_Reports_TOC.htm

A 11/7/08 notice states that the AIPLA will hold a live online seminar 12/3 concerning conflicts of interest in patent prosecution and litigation.

A 11/9/08 notice announces a 12/12 90 min. web conference “How to Protect Your Process Inventions after Bilski.”

On 11/17/07 the PTO issued final rules ‘codifying present trademark practice.’ See 73 FR 67759.

PTO notices – www.uspto.gov/main/newsandnotices

While not a notice but a report, at the AIPLA ’08 Annual Meeting Chief Judge Fleming summarized the achievements and plans for the BPAI. For a copy of his PowerPoint presentation call 571/272-9797 or email him.

Copyright Office News http://www.copyright.gov/newsnet/past_issues.html#2007

The 11/7/08 newsletter 356, among many other things, states that the anticipated implementation date for new fees is April 1, 2009.

Other Stuff –

On 11/12/08 a notice at 73 FR 66754 increases the PTO fees for ISA/



US searches to \$2080. on 1/12/09 from \$1800. now (and \$1000 or less a year ago). If the filing is either .pdf or .zip, the IB gives a discount.

Those involved in patent appeals should check the book Patent Appeals by Miles Davies and the CAFC's recently published internal procedures manual.

The FTC is holding a hearing on the IP Marketplace in DC on Dec. 5, 2008.

LSI's 17th Annual Technology Law Conf. is being held in Seattle on Dec. 10 and 11.

LSI is offering a seminar on Best Practices in Patent Profiting on Jan. 29 -30, 2009 in San Francisco.

LSI is presenting a "Commercializing Life Sciences Inventions" conference in Phoenix the end of January '09.

The Copyright Society will hold its midwinter meeting in San Francisco on Feb. 5-7, '09.

LSI is also offering a departing employees and IP seminar on Feb. 25, 2009 at Palo Alto, CA.

For more information about any of the patent topics mentioned consult *Patent Application Practice* published by West and updated twice a year.

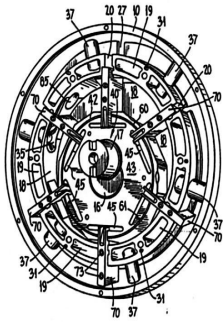


FIG. 2.

