



# SDIPLA News

## USPTO Technology Center 1600 Road-Show ALL DAY SYMPOSIUM

### FEATURING:

**John LeGuyader, Director of Technology Center 1600**

**Julie Burke, Training Quality Assurance Specialist**

**Jean Witz, Training Quality Assurance Specialist**

### TOPICS:

- **Chemical Enablement**
- **Incorporation by Reference: How Biological Sequences are Treated**
- **Written Description Overview**
- **Assessing Utility Relative to Sequence Homology**
- **Restriction Petition Overview and Burden in Restriction**
- **Obviousness in view of KSR: TC 1600-Specific Examples**

## ONLINE REGISTRATION NOW AVAILABLE!

<http://www.acteva.com/booking.cfm?bevaid=170469>

### IN THIS ISSUE:

#### TABLE OF CONTENTS

USPTO Road-Show Announcement	1
Call For Nominations IP Award	2
Sponsors	2
USPTO Road-Show Registration	3
Internet Sightings	4-6
APDRP Survey Announcement	7
Announcements and Advertisements	8

### November 14, 2008 Symposium - USD Campus:

#### Date/Time/Location:

Friday, November 14, 2008  
7:30 a.m.—5:00 p.m.

Joan B Kroc Center, USD  
Campus, San Diego, CA  
Lunch will be provided.

#### Notes/Directions:

Public Parking is available a short 10 minute walk from the event. A campus shuttle bus is also available.

Directions: <http://www.sandiego.edu/about/directions/>

#### Attendance Costs:

SDIPLA members: \$170  
Nonmembers: \$195  
Student: \$70

USD Student: free with registration

**Register Online or via the registration form on page 3.**

**SDIPLA  
Board of Directors**

**President**

Boris Zelkind  
Knobbe Martens Olson & Bear LLP  
619 235-8550  
boris.zelkind@kmob.com

**Vice President**

Jessica S. Mitchell  
Neil Dymott  
619 238-2265  
jmittchell@neildymott.com

**Secretary**

John E. Peterson  
Perkins Coie  
619 886-3854  
john.e.peterson.ph.d@gmail.com

**Treasurer**

Kenneth E. Jenkins  
Townsend, Townsend & Crew  
858 350-6100  
kjenkins@townsend.com

**Immediate Past President**

Robert W. Prince  
Palkion, Inc.  
rprince@sbcglobal.net

**Newsletter Editor**

John E. Peterson

**Webmaster**

Sarah Burrows

**CALL FOR NOMINATIONS  
IP ACHIEVEMENT AWARD**

The San Diego Intellectual Property Law Association is calling for nominations of outstanding inventors, investors, service providers, organizations and others who have significantly contributed to the San Diego IP community.

Past award recipients have included Andrew Viterbi, Ivor Royston, Howard Birndorf, Larry Maxham, Dr. Drew Senyei and the Honorable Rudi M. Brewster.

The winner of the Award will be announced in December, and the Award presented at the annual SDIPLA Holiday Dinner.

For nominations please contact the Award Committee Chairs:

**Boris Zelkind, Co-Chair  
SDIPLA President  
Knobbe Martens Olson & Bear LLP  
550 West C Street, Suite 1200  
San Diego, CA 92101  
Email: [boris.zelkind@kmob.com](mailto:boris.zelkind@kmob.com)**

**Jessica S. Mitchell, Co-Chair  
SDIPLA Vice President  
Neil Dymott Attorneys  
1010 Second Ave, Suite 2500  
San Diego, CA 92101-4959  
Email: [jmittchell@neildymott.com](mailto:jmittchell@neildymott.com)**

The SDIPLA thanks our Sponsors for the monthly meetings:

**Knobbe Martens Olson & Bear LLP  
[www.kmob.com](http://www.kmob.com)**

**Perkins Coie LLP  
[www.perkinscoie.com](http://www.perkinscoie.com)**

**Townsend and Townsend and Crew LLP  
[www.townsend.com](http://www.townsend.com)**

(listed alphabetically)

# 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

## USPTO ROADSHOW REGISTRATION FORM

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

**Completed forms must be received by close of business, Thursday, November 13th.**

### Registration

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

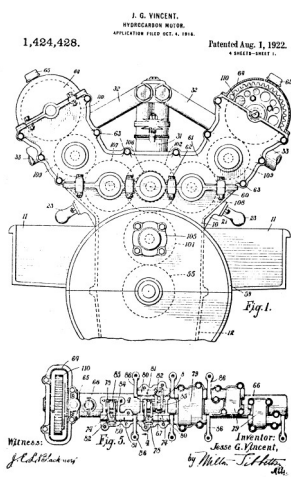
E-Mail Address: \_\_\_\_\_

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

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

SDIPLA Member: \$170    Nonmember: \$195    Student: \$70    USD Student: Free

Amount Paid: \$ \_\_\_\_\_



## *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 publication's editor of the submitted IS column. If you would like to receive the full column directly by email, write [onejehawes@aol.com](mailto:onejehawes@aol.com). The cited issues of Hal Wegner's newsletter are posted at [www.internetsightings.com](http://www.internetsightings.com).

**Hal Wegner's** newsletter – a lot of great stuff – Contact: [hwegner@foley.com](mailto:hwegner@foley.com) to subscribe.

The 10/2/08 newsletter attaches a Powerpoint presentation of the issues presented by deferred examination, the core issue of patent reform.

The 10/3/08 email discusses the Impax Labs CAFC decision holding that a cited prior art was not enabling, applying an 8 factor test, and thus not anticipatory.

The 10/6/08 offering discussed recent denials of cert, and presents his current top 10 list. See also his emails for 10/10, 10/15, 10/23 and 10/31.

Another 10/6/08 email reports that both current and past versions of the MPEP are now available on the PTO website for downloading.

The 10/9/08 newsletter discusses the Predicate CAFC decision chastising counsel for bad English usage.

The 10/10/08 email discusses the Technology Licensing CAFC decision re establishing priority under sec. 120, and the adequacy of a written descrip-

tion under sec. 112.

A 10/15/08 offering attaches Hal's PowerPoint LES presentation re the eBay and Quanta licensing decisions of the CAFC.

The 10/16/08 blog reports that the PTO has filed its reply brief in the Tafas case, and attaches a copy. Also, it gives the web address for a detailed analysis of the case.

The 10/20/08 email discusses the NetMoney CAFC decision holding that a means element was not properly supported in the disclosure.

The 10/21/08 message discusses the Tzipori CAFC decision criticizing the appellant for arguing evidence not before the BPAI, apparently a common problem with appeals today.

The 10/27/08 blog reports that the PTO, at the recent AIPLA annual meeting, acknowledged that the proposed IDS and Markush claiming rules (the Tafas case) are dead as a practical matter.

The 10/29/08 email reports the Systems Division CAFC decision sanctioning the appellant for a frivolous appeal after being warned.



The 10/30/08 message reports the long awaited Bilski CAFC en banc decision holding that patent eligibility under sec. 101 is established either if the claimed business method invention is significantly tied to a machine or if it significantly transforms an article.

The 10/31/08 email discusses the Amazin' Rasins CAFC decision in which the Court again refused to rewrite unambiguous claims.

**Patently-O** – a blog written by Dennis Crouch – [www.patentlyo.com](http://www.patentlyo.com).

The 10/6/08 blog discusses a recent state of the CAFC report, including some excellent advice for appellants.

The 10/7/08 email reports that the defendant in the Aristocrat case (see the Daily Dose for 10/6 below) has petitioned the CAFC for an en banc hearing. Hopefully it will be granted. A copy of the petition is posted on this website.

The 10/9/08 blog invites those who don't like the new BPAI rules to join in an effort to have them rejected by the OMB.

The 10/10/08 message reports that ABC is looking for a superstar family of inventors for its Wife Swap show, and will pay. See, you can make money reading this digest.

The 10/13/08 message reports the Cohesive Tech. CAFC case

holding that novelty and non-obviousness are separate inquiries: a patented invention may be anticipated but non-obvious.

The 10/15/08 email give the web addresses for 15 amicus briefs in the Tafas case before the CAFC.

Another 10/15/08 posting reconsiders the scope of prior art as prompted by the Cohesive Tech CAFC decision.

The 10/20/08 message discusses the Wyeth DDC decision and the calculation of patent term adjustments.

Another 10/20/08 posting discussed the NetMoney CAFC holding that, to anticipate under sec. 102, a reference must not only disclose all the claimed elements but also in they must be in the claimed arrangement.

The 10/23/08 blog discusses the Yamaguchi BPAI decision holding that a published application is a reference as of its provisional filing date.

The 10/26/08 posting reports the New Medium (ND III) decision holding that failure to disclose a prior association between the inventor and an expert submitting a declaration to the PTO was sufficient to establish inequitable conduct.

The 10/29/08 message reports that **Professor Lichtman is offering free IP-CLE Credit. Listen online:** [www.ipcolloquium.com](http://www.ipcolloquium.com)

**IP law 360** – a newsletter covering all IP, but focusing mainly on litigation – web address: [www.iplaw360.com](http://www.iplaw360.com)

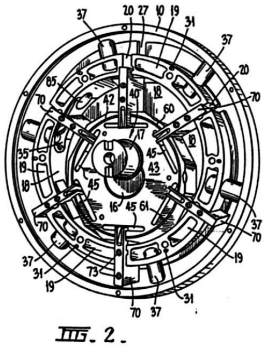


FIG. 2.





The 10/1/08 newsletter includes a guest column discussing the impact of the recent Egyptian Goddess CAFC decision holding that a “point of novelty” test for design patent infringement is no longer applicable.

The 10/2/08 email reports that a trial partnership adding the EPO to the USPTO’s patent prosecution highway has begun.

The 10/3/08 offering reports that malpractice claims are on the rise for such things as failing to follow a client’s instructions. So remember, always CYA.

The 10/6/08 guest column discusses a little known federal statute prohibiting the marketing of goods in a way falsely suggesting an American Indian origin, thereby creating a “staggering liability.”

**Daily Dose of IP** – a grab-bag of various IP matters by Mark Reichel – [www.dailydoseofip.blogspot.com](http://www.dailydoseofip.blogspot.com)

The 10/6/08 email discusses the Aristocrat CAFC decision holding that once the PTO revives an application, that action may not be challenged. Wow.

The 10/8/08 blog discusses a trademark application consistency review option by the PTO for those with multiple applications.

The 10/14/08 message reports that WIPO has added five new courses to its distance learning Worldwide Academy.

The 10/22/08 dose announced that the Korean IPO has been added to the PTO’s direct priority document exchange program, joining the EPO and JPO.

The 10/27/08 blog reports that the Danish PTO has been added as the eighth Office on the PTO’s patent prosecution highway program.

The 10/29/08 email discusses fraud on the Copyright Office, something those registering copyrights should study.

**Cal Bar IP Section** – Section news – [Mitch.Wood@calbar.ca.gov](mailto:Mitch.Wood@calbar.ca.gov)

The State Bar IP section is holding its Annual Institute in the Palm Springs area on Nov. 6-8, ’08.

On 10/21/08 the IP section announced formation of an in-house counsel committee.

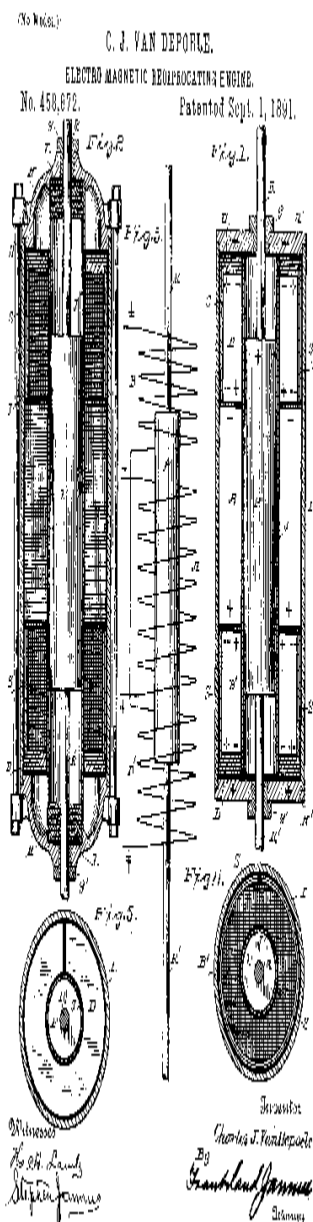
**Copyright Office News** – [copynews@loc.gov](mailto:copynews@loc.gov)

The Office gave notice on 10/16/08 that it is considering a new fee schedule. Comments are due 12/2/08.

**WIPO** – The international IP group in Geneva – [www.wipo.int](http://www.wipo.int)

An IP management executive program is being offered, and will be held in India 12/2-5/08.

In a notice dated 10/21/08 the Madrid system announced that the ROMARIN database now offers a status of protection of a mark feature.



**If you have an article, news bulletin, update, case summary, employment notice or other announcement that you would like to include in the SDIPLA Newsletter, please contact SDIPLA Secretary John E. Peterson at [John.E.Peterson.Ph.D@gmail.com](mailto:John.E.Peterson.Ph.D@gmail.com).**



### REMINDER: Patent Adjudication Alternatives Survey

Randy Berholtz is the Adjunct Faculty Advisor to the Alternative Patent Dispute Resolution Project (“APDRP”) at the Thomas Jefferson School of Law (“TJSL”) in San Diego, California. The APDRP is in the process of writing a law review article analyzing an updated survey on proposed alternatives to patent adjudication. Such alternatives include making changes to the current Federal patent adjudication process, creating new Federal adjudicative bodies, and improving the accessibility, affordability, and success of mediation and arbitration.

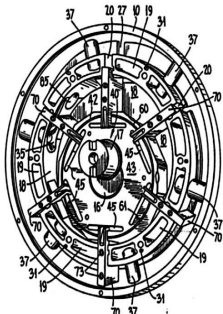
The APDRP is conducting an on-line survey of lawyers, judges, clerks and scholars to gauge the industry's perception of some fairly recent proposals to improve the current Federal patent adjudicative process in the United States and to encourage the use of alternatives thereto such as mediation and arbitration. The survey seeks to provide an update to a previous survey which was taken approximately 10 years ago for an article entitled *Using Alternative Dispute Resolution to Resolve Patent Litigation: A Survey of Patent Litigators*, which was published in the *Marquette Intellectual Property Law Review* by Eugene R. Quinn.

The results of the survey will be made available to you if you so request and will be analyzed, published by the APDRP in a law review article, and then discussed by the group at the Patent Dispute Resolution (PDR): Improving Patent Adjudication through ADR and Court Reform Symposium to be held in San Diego, CA on Friday, April 3, 2009. The APDRP would also like to present the results of the survey to members of the U.S. Congress and the judiciary to assist them in their efforts to improve the Federal patent adjudication process.

The survey consists of sixty-four questions and should take approximately 15 to 20 minutes to complete. We realize that your time is valuable, but we encourage you to participate in the survey to help the APDRP improve the patent adjudicative process.

As an inducement to take the survey, TJSL will be having a drawing to provide two free entrance tickets to the symposium to one winner and will be providing commemorative TJSL shirts to two additional participants. If you would like to be eligible for these prizes, simply request the results of the survey via Question #64. If you have any questions regarding the APDRP, the survey, or the symposium, then please contact Randy Berholtz directly at [rberholtz@tjssl.edu](mailto:rberholtz@tjssl.edu).

Please visit the SDIPLA Website for a link to the survey and a link to a description of TJSL, the APDRP and its faculty and student team.



III. 2.





### Other Stuff –

Law Seminars Int'l. has announced a patent marketing conference in San Francisco on Jan. 29-30, 2009.

LSI also announced a commercialization of life sciences conference on Jan. 29-30/08 in Phoenix.

The SDIPLA is hosting a PTO Tech Center 1600 (pharmaceuticals, biologicals and chemicals) all day Road Show at UCSD on 11/14/08.

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

## CALL FOR NOMINATIONS IP ACHIEVEMENT AWARD

The San Diego Intellectual Property Law Association is calling for nominations of outstanding inventors, investors, service providers, organizations and others who have significantly contributed to the San Diego IP community.

Past award recipients have included Andrew Viterbi, Ivor Royston, Howard Birndorf, Larry Maxham, Dr. Drew Senyei and the Honorable Rudi M. Brewster.

The winner of the Award will be announced in December, and the Award presented at the annual SDIPLA Holiday Dinner.

For nominations please contact the Award Committee Chairs:  
Boris Zelkind (boris.zelkind@kmob.com) and  
Jessica S. Mitchel (jmittchell@neildymott.com)

## UPCOMING EVENTS

Mark Your Calendar!!!

The Annual SDIPLA Holiday Party will be held December 11th at The Lodge at Torrey Pines. More details to follow.

