Volume 14, Issue 1

SDIPLA News

SDIPLA Board of Directors
for the 2008/2009 Term

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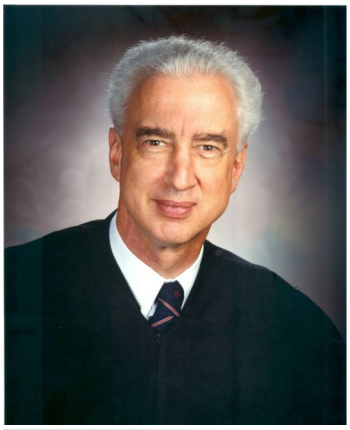
SEPTEMBER 23rd DINNER MEETING FEATURING CHIEF JUDGE PAUL R. MICHEL

(co-hosted by the IP Section of the SD Bar Association)



Topic: Litigating Obviousness, Injunctions, and Future Damages in Patent Infringement Cases

PAUL R. MICHEL was appointed as a Circuit Judge to the United States Court of Appeals for the Federal Circuit by President Ronald Reagan in 1988. On December 25, 2004, after 16 years on the court, he assumed the duties of Chief Judge. Chief Judge Michel has written over 300 opinions in patent, trademark, takings, contract, tax, veterans' rights, international trade and government personnel cases. He is the recipient of the Eli Whitney Prize, the Katz-Kiley Prize, and the Jefferson Medal for "outstanding contribution … to the progress of science and useful arts." In 2003, he was named by Managing Intellectual Property magazine as one of the 50

IN THIS ISSUE:
TABLE OF CONTENTS

Professional Profile: Circuit Judge Paul R. Michel	1
Letter From President	2
Sponsors	2
Dinner Reservation Info.	4
Internet Sightings	5
Membership Renewal Form	6
Announcements and Advertisements	8

September 23, 2008 Dinner Meeting — La Jolla Hyatt Hotel:

Date/Time/Location:

September 23, 2008
6:00 p.m.—9:00 p.m.

La Jolla Hyatt Hotel

3777 La Jolla Village Drive
La Jolla, California

Notes:

This is a **dinner** meeting.

Speaker: Circuit Judge Paul R. Michel

Directions:

From I-5 exit La Jolla Village Dr.;

Head east on La Jolla Village Dr.;

Hyatt is on right.

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A Few Words From The President

On behalf of the Board, it is my pleasure to welcome you to the 2008-2009 SDIPLA term. We have a great year in store, and we are starting things off with a bang. Chief Judge Paul Michel of the Court of Appeals for the Federal Circuit will speak to the SDIPLA at our September meeting about "Litigating Obviousness, Injunctions, and Future Damages in Patent Infringement Cases." This may be the first time that the sitting Chief Judge of the Federal Circuit has come to San Diego to keynote a meeting of the SDIPLA.

Before moving on, I would like to thank the membership for electing such a talented and energetic group to the Board. I am honored to serve as President and hope to carry the torch as capably as my predecessors. Rob Prince, Tom Coverstone, Kent Walker, and Vicki Norton were fantastic Presidents with whom I've had an opportunity to serve on the Board. They all worked diligently to bring prominent speakers and fascinating topics to our community.

This year we plan to continue to provide topical programs with exceptional speakers on a variety of IP issues. As mentioned above, our first meeting will be held on September 23, 2208 and will feature Chief Judge Michel. We are thrilled to have such a distinguished speaker in San Diego and are looking forward to a tremendous turn out.

On October 15, 2008, William F. Smith, a former Administrative Patent Judge at the Board of Appeals and Interferences, will discuss the new rules governing appeals at the USPTO. Mr. Smith's career at the PTO spanned over thirty years, and he currently works out of the Atlanta office of Woodcock Washburn LLP. Mr. Smith has taught at the Patent Academy at the USPTO and is a regular presenter at AIPLA meetings.

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)

(A Few Words From The President, continued from page 1 ...)

On November 14, 2008, the SDIPLA will sponsor the San Diego portion of the "PTO Road Show" featuring John LeGuyader, Julie Burke and Jean Witz from the Technology Office 1600 on a variety of topics ranging from KSR-training to restriction requirements and Enablement in Chemical cases.

In December, we will also continue our tradition of presenting the annual SDIPLA IP Achievement Award at our holiday party. Past award recipients have included Andrew Viterbi, Ivor Royston, Howard Birndorf, Larry Maxham, Dr. Drew Senyei, and the Honorable Rudi M. Brewster. SDIPLA Vice President Jessica Mitchell is already hard at work planning the event. I am sure that it will be a huge success.

It is our continued goal and mission to encourage participation in SDIPLA from practitioners in all aspects of intellectual property. We hope to bring you programs that will enlighten and prove of interest to those working in firms, solo or in-house. To that end, I encourage all of our members to contact me or any other member of the Board with a topic or speaker that you would like to hear at one of our meetings. Additionally, we will revisit our bylaws this year to redefine membership criteria to include practitioners in other disciplines of IP in addition to that of patent law. We also encourage our members to get involved in one of our committees, which include the Amicus, Editorial, Awards & Events, Sponsorship and Mentoring committees.

From all of us on the Board, thank you for your support and participation in the SDIPLA. We look forward to a rewarding and entertaining year. See you on September 23rd.

Boris Zelkind
SDIPLA President

(Profile of Circuit Judge Paul R. Michel, continued from page 1 …)

most influential people in the world in intellectual property. Prior to his appointment to the court, Chief Judge Michel served in the executive and legislative branches of government for 22 years. Following graduation from Williams College in 1963 and the University of Virginia Law School in 1966, he served as Assistant District Attorney and Deputy District Attorney for Investigations in Philadelphia under Arlen Specter; as Assistant Special Watergate Prosecutor under Leon Jaworski responsible for the Howard Hughes--Bebe Rebozo investigation; and under Dick Thornburgh as Deputy Chief of the Justice Department's Public Integrity Section directing the "Koreagate" investigation. In 1978 he was appointed by Benjamin Civiletti as Associate Deputy Attorney General, helping to supervise United States Attorneys, the FBI, and the Marshals Service. From April 1981 until his appointment to the court in March of 1988, he served on Senator Arlen Specter's staff, including as Chief of Staff. Since October 2005, he has been a member of the Executive Committee of the Judicial Conference of the United States, the governing body of the Judicial Branch. He has taught at George Washington and other law schools, made many presentations to various city, state, national and international bar associations and participated in the training of judges of other nations. With two co-authors, he helped produce a casebook for law students, entitled, Modern Patent Litigation and Strategy. He has published many articles on appellate advocacy.

Reservation Form for September 23, 2008 SDIPLA Meeting

LITIGATING OBVIOUSNESS, INJUNCTIONS, AND FUTURE DAMAGES IN PATENT INFRINGEMENT CASES
CHIEF JUDGE PAUL R. MICHEL, U.S. COURT OF APPEALS FOR THE FEDERAL CIRCUIT

-co-hosted by the IP Section of the SD Bar Association

La Jolla Hyatt Hotel

Tuesday, September 23rd
Dinner Meeting

La Jolla Hyatt Hotel

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

The Menu

Romaine & Belgian Endive Salad

With one of the following entrees:

Sautéed Chicken Breast
With lemon caper sauce
** OR **
Potato Crusted Salmon
With Roast Shallot Herb Sauce
** OR **
Vegetarian Selection
Served with Orzo Pasta

And
Italian Panna Cotta
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:

Jessica Mitchell
SDIPLA Vice President
Neil, Dymott, Frank, McFall & Trexler
1010 Second Avenue, Suite 2500
San Diego, CA 92101
(619) 238-1712
Fax: (619) 238-1562
jmitchell@neildymott.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 Jessica Mitchell at the address, fax, or e-mail address indicated for receipt **no later than September 18, 2008**.
- 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.

NOTE MEAL PRICES

$55.00 SDIPLA Member

$65.00 Non-Member

Registration

Name: _____ E-Mail Address: _____

Firm/Employer: _____

Telephone Number: _____

Member of SDIPLA? (circle one) YES NO

Entrée Choice: _____ Chicken _____ Salmon _____ Vegetarian

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. 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

In his 8/4/08 email Hal lists and discusses his current Top Ten cases on appeal. See also his emails on 8/5 (two emails), 8/8, 8/11, 8/22, and 8/25.

The 8/7/08 newsletter reports that Sydney Johnson is the new Acting Solicitor of the PTO.

The 8/11/08 newsletter discusses the recent PTO notice of new continuation rules if it prevails in the Tafas appeal.

The 8/14/08 email discusses the new PTO rule regarding patent agents and its curtailing of their permitted activities.

The 8/15/08 offering raises again the MuniAuction decision holding that a method claim is only infringed if all steps are performed by a single infringer, and attaches a paper discussing how method claims should now be drafted.

The 8/18/08 message conveys Hal's expectation that John Doll will be appointed Acting Director of the PTO when the present Director leaves next month.

The 8/19/08 email discusses the Cooper Techs CAFC decision holding that reexam applies to all patents having any filing date after the effective date of the statute.

(Internet Sightings, continued from page 2 …)

Another 8/19/08 email discusses the Cygnus CAFC decision holding that experimental use can't apply after a reduction to practice.

The 8/21/08 email discusses the Leggett CAFC decision and its holding of invalidity based on inherent anticipation of the invention in the prior art.

The 8/25/08 newsletter discusses Scroggie (BPAI) and the Board's ruling that it, not examiners or tech. directors, controls the legal and evidence issues before it.

Another 8/25/08 email concerns the Star Sci. CAFC holding re inequitable conduct that a threshold level of intent to deceive and materiality both must be shown by clear and convincing evidence before relative equities can be considered.

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

The 8/2/08 blog includes a 7 item checklist to avoid inequitable conduct.

The 8/9/08 email reports the parts of the rules package now under appeal (the Tafas case) will have reset effective dates if or when the appeal is concluded.

See the 8/11/08 catchall for a cite to "IP norms in standup comedy." And here you

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:

Attorney Member Dues: $50/year

Non-Attorney/Retired Attorney Dues: $25/year
(e.g. law students, paralegals, patent agents, retired attorneys, etc.)

Jessica S. Mitchell
SDIPLA Vice President
Neil Dymott Frank McFall & Trexler, PC
1010 Second Ave, Suite 2500
San Diego, CA 92101

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.

thought IP was not funny.

The 8/13/08 blog reports that the Duffy bill re BPAI judges has now been signed into law. Will it work? See the 8/14/08 IP360 newsletter for a discussion.

The 8/23/08 offering discusses the Omeprazole CAFC decision holding that reduction to practice requires knowledge that the invention works for its intended purpose.

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

The 8/1/08 newsletter reported that WIPO announced worldwide patent filings up about 5% in 2006, with the biggest increases being in China, Korea and the US.

The 8/11/08 emailing reports a PTO ruling that the University of Southern California, not the University of South Carolina, owns the USC trademark.

(Internet Sightings, continued from page 3 …)

The 8/12/08 message reports a survey finding that you (IP lawyers) are happier than other lawyers. Congratulations.

The 8/27/08 email includes the opinion that specialized patent courts "fail to gain traction." It also includes a guest column discussing steps to reduce the risk of a false patent marking claim.

The 8/28/08 newsletter reports that the ABA is considering a proposal to ease the conflict of interest rules, especially as they apply to attorneys joining another firm.

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

The 8/1/08 newsletter also reports that in the Research Corp. Technologies CAFC decision post application filing research is not material to consideration of inequitable conduct.

The 8/5/08 email states that registration for the 2008 Annual Meeting in DC on 10/23-25 is now open. The 8/15/08 email gives the full program.

The 8/13/08 notice reports that former PTO Commissioner Todd Dickinson has been named the Association's new Executive Director.

The 8/20/08 newsletter reports that the PTO is increasing fees by 5% effective in October 2008.

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

The PTO published its final revised rules re discipline, professionalism and patent agents on August 15, 2008. The patent agent rules do not permit agents to give opinions about patent infringement, nor about validity unless as a part of a reexamination.

The PTO, on 8/29/08, published a notice that it is seeking volunteer practitioners to help it test a pilot mandatory continuing education program.

PTO FEES GO UP BY 5% OCTOBER 2.

WIPO notices – www.wipo.int
An 8/26/08 notice announces that the 2008 Forum on Trademarks and Industrial Designs will be held in Brussels on 9/24/08.

Other Stuff –
The 8/3/08 Pat-O reports that Bill Patry has decided to stop his Copyright Law blog, in part because the state of copyright law has become too depressing for him.
WestLegalWorks now offers the IP due diligence and audit bootcamp on demand.

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

UPCOMING EVENTS

On October 15, 2008, William F. Smith, a former Administrative Patent Judge at the Board of Appeals and Interferences, will discuss the new rules governing appeals at the USPTO. Mr. Smith's career at the PTO spanned over thirty years, and he currently works out of the Atlanta office of Woodcock Washburn LLP. Mr. Smith has taught at the Patent Academy at the USPTO and is a regular presenter at AIPLA meetings.

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EXPERIENCED PATENT ATTORNEY

Sheldon Mak Rose & Anderson is an intellectual property firm located in Pasadena, CA. We are seeking a patent attorney, California-licensed, US PTO-registered, with at least five years of US and foreign patent prosecution experience with a background in the biological sciences. Our firm offers a competitive salary, 1600 billable hours' requirement, non-discretionary bonus based on hours billed in excess of 1600 and an excellent benefits package. Pasadena is one of the best areas to live in Southern California. Come and join our team. Fax your resume to (626) 795-6321, attention Jennifer R. McClean, or e-mail it to jennifer.mcclean@usip.com. No recruiters, please.