



SDIPLA News

ANNUAL SDIPLA IP ACHIEVEMENT AWARD AND HOLIDAY DINNER PARTY HONORING JUDGE RUDI M. BREWSTER DECEMBER 6, 2007, 6:30 P.M., AT THE LODGE



December 6, 2007 SDIPLA Holiday Dinner Party-The Lodge of Torrey Pines

The Honorable Rudi M. Brewster of the United States District Court for the Southern District of California in San Diego, California has been named as the recipient of the 2007 SDIPLA IP Achievement Award. A native of Sioux Falls, South Dakota, Judge Brewster attended Princeton University and participated in the Navy ROTC program. He graduated in 1954 with a Bachelor of Arts in Public and International Affairs from Princeton's Woodrow Wilson School and received his commission as an Ensign. Returning from deployment as a naval aviator in the Western Pacific in 1957, he attended Stanford Law School and received his J.D. in 1960.

Upon graduation, Judge Brewster began his legal career as a civil trial lawyer with the San Diego firm of Gray, Cary, Ames & Frye, where he became a partner in 1968. In 1984 he was appointed to the federal bench by President Ronald Reagan and confirmed the same year. He took senior status in 1998. Judge Brewster is a judicial fellow of the American College of Trial Lawyers and an associate of the American Board of Trial Advocates. He is a past president and chancellor of the Louis M. Welsh Inn of Court and an alumni member of the J. Clifford Wallace Inn of Court.

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December 6, 2007, 6:30 p.m. SDIPLA Holiday Dinner Party-The Lodge

<u>Date/Time/Location:</u>	<u>NOTES</u>
December 6, 2007 6:30 p.m.—10:00 p.m.	Cocktail Attire
The Lodge of Torrey Pines 11480 North Torrey Pines Rd. La Jolla, California	

Directions:

From I-5 S to Genesee;
Turn right.;
Genesee becomes North Torrey Pines Rd.
From I-5 N to Genesee;
Turn left

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The Power of an Attorney to Shape the Future of Biotechnology by Douglas E. Olson and David M. Fortner (cont. p. 3)

An excellent example of how a lawyer can change society and the world is found right here in San Diego. Attorneys, working along with scientists and entrepreneurs, played a key role in starting the biotech revolution. Larry Respass is such an attorney. He helped establish San Diego as home to one of the largest biotechnology industries in the United States and the world. Of course, it could not have happened without the scientists. But, even the greatest inventive ideas need money, patents for commercial development, and protection from well-financed copiers. Without the patents and the likelihood that those patents could be enforced, there would have been far fewer scientist, entrepreneurs, and venture capitalists who would take the risk to start a fledgling biotechnology company.

The biotechnology revolution began in the early 80's when attorneys fought for and convinced the Supreme Court that patentable subject matter included biotechnology. *Diamond v. Chakrabarty*, 447 U.S. 303 (U.S. 1980). Six weeks later, San Diego attorney Larry Respass filed and prosecuted the application which later became Hybritech's 4,376,110 patent entitled: "Immunometric assays using monoclonal antibodies," which issued March 8, 1983. Respass, a former partner at the premier IP boutique, Lyon & Lyon, was no stranger to biotechnology. He had earned a Ph.D. in Chemistry at M.I.T. and was involved in writing the applications for the patents that launched Genentech as the first blockbuster biotechnology company. In fact, his connection with the Genentech start up team, including venture capitalist, Brook Byers, resulted in Respass working for Hybritech.

Howard Birndorf hired Respass as General Counsel for Hybritech. "I knew patents were going to be the key to our success at Hybritech and that Larry Respass was the person to make it happen," Birndorf recalls. Birndorf has since started many biotech companies. In fact, the New York Times has called him "The Johnny Appleseed of Biotechnology." (James Sterngold, *The Johnny Appleseed of a Biotechnology Forest*, N.Y. Times, August 18, 1996.) In doing so, he has almost always relied on the counsel of Respass to insure that strong patent protection was in place. Today they work together at Nanogen where Birndorf is the C.E.O. and Respass is the General Counsel.

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www.kmob.com

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www.paulhastings.com

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www.townsend.com

(listed alphabetically)

The Power of an Attorney to Shape the Future of Biotechnology by Douglas E. Olson and David M. Fortner (cont. p. 8)

Respass knew that the Hybritech product, monoclonal antibodies used for diagnosing major diseases, would be copied by major pharmaceutical companies who could drive the tiny Hybritech out of business. He thus developed a patenting and patent enforcement strategy to protect the Hybritech invention. The first step in carrying out his plan was to obtain a patent on the use of emerging technology, monoclonal antibodies, to diagnose disease. He then created a licensing strategy which resulted in many of the largest companies in the country taking a license from Hybritech. Finally, for those who would not take a license, he devised a litigation strategy aimed at getting the Hybritech patent validated on appeal to the Federal Circuit, the Court newly created to hear all patent appeals.

Although the trial court held the Hybritech patent invalid, Respass forged ahead with his strategy which he anticipated would not be vindicated until the case reached the appellate court. The Federal Circuit reversed the District Court and for the first time held a biotechnology patent to be infringed. *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367 (Fed. Cir. 1986). In doing so, the Federal Circuit took a page from the Respass playbook and ruled that the patent was valid because the substitution of monoclonal antibodies for polyclonal antibodies had led to unexpected advances in medical diagnosis.

This is the only case your author has ever been involved in where the client came with a game plan, not only for winning, but for creating new law. All I had to do was follow the script in order to change biotechnology patent law.

Testimony for the importance of patents and patent attorneys comes from Ted Green, a Renaissance man who is both an inventor and a venture capitalist. He was an inventor on the Hybritech patent and C.E.O. of Hybritech. He also founded Amylin Pharmaceuticals and is an inventor on one of Amylin's first patents. In reflecting on the Hybritech experience, Green stated, "If people had lost confidence in the patent system, venture capital would have dried up completely. Fortunately, with the Hybritech patent, we established that biotechnology inventions could be patented and that the courts would enforce them, thus protecting the huge investments necessary to bring biotechnology inventions to market." Mr. Green further explained that, "If venture capitalists didn't make investments, new medicines would not exist." "Patents are fundamental." Green stated.

Birndorf recalls early skepticism about the value of Hybritech's patent position. When asked about the impact of the successful defense of that patent, he thought for a moment and then mused "Our success helped open the funding tap of Big Pharma. Before that we had been courted mostly by Japanese companies. But after that, the doors of the corporate development departments at major pharmaceutical companies were open to us. I think that has been one of the most, if not the most profound impacts on biotech. It helped us survive after launch with venture money and early IPO money until we were able to put products on the market."

Brook Byers, a principal in the venture capital firm of Kleiner Perkins Caufield and Byers reflected on Hybritech, his first biotechnology company, stating, "Intellectual property is the foundation of the biotech industry. Using that foundation for my companies. Larry Respass, in my mind, is the Godfather of the biotechnology legal profession. He was instrumental in opening the door for venture funding of biotechnology."

This was the first biotechnology patent held valid and infringed and showed the world that biotechnology intellectual property could indeed be protected and enforced. It vindicated the analysis by Respass when he joined Hybritech that the Hybritech technology could be protected by patents. The case was the pinnacle of Hybritech's success and provided an inspiration to other start-up biotechnology companies. As Respass said, "I like to think that Hybritech's success in obtaining and enforcing its patents gave those [biotechnology] companies the conviction that they could patent their inventions and protect them from the giant pharmaceutical companies."

Reservation Form for December 6, 2007 Holiday Dinner Party

DECEMBER 6, 2007 SDIPLA HOLIDAY DINNER PARTY

**Hon. Rudi M. Brewster—SDIPLA’s 5th Annual IP Achievement Award Recipient
The Lodge of Torrey Pines**

**Thursday
December 6, 2007**

The Lodge of Torrey Pines

Mixer 6:30 p.m.
Dinner 7:30 p.m.
Presentation 8:30 p.m.

The Menu

Choice of the following entrees:

Roasted Pork Rib Roast

With maple syrup sweet potatoes and glazed pars-nips

** OR **

Horseradish Crusted Salmon

With green beans, crème fraiche, and chives

OR

Chef's Choice of Vegetarian

And

Spiced Pumpkin Crème Brulee

Due to space limitation of 100 attendees for this event, please promptly reserve your space.

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

Jessica Mitchell
SDIPLA Secretary
Neil, Dymott, Frank, McFall & Trexler
1010 Second Avenue, Suite 2500
San Diego, CA 92101
(619) 238-2255
Fax: (619) 238-1562
jmittell@neildymott.com

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

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 December 3, 2007.**
- The reservation deadline is dictated by the hotel and not by the SDIPLA.

NOTE MEAL PRICES

\$89.00 Per Person

Please fill out a separate form for each attendee.

Registration

Name: _____ E-Mail Address: _____

Firm/Employer: _____

Telephone Number: _____

Member of SDIPLA? (circle one) YES NO

Entrée Choice: _____ Roasted Pork Rib Roast _____ Horseradish Crusted Salmon _____ Vegetarian

Internet Sightings by *Jim Hawes* (cont. p. 6)



This column highlights some of the more notable recent internet notices, newsletters and blogs dealing with IP prosecution issues. It is a distillation by the editor of the submitted IS column. By next month the full IS column, and compilations of some of the sources such as Hal Wegner's newsletter, also should be up and available at www.internetsightings.com.

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

- The 10/8/07 newsletter cites a site that offers a recording of the oral argument in the KSR case, which Hal says is a must-listen.
 - The 10/9/07 issue reports the Ferguson CAFC decision holding that claims to a method of marketing a product are non-statutory.
 - The 10/10/07 offering attaches the PTO's just released new guidelines on obviousness resulting from the KSR decision. Must reading for all. A second posting on that date discusses some of the guidance it gives. See also Hal's 10/12 posting on the guidelines.
 - Hal's 10/10/07 newsletter discusses the CAFC's Nilssen inequitable conduct holding against a pro se applicant, and suggests that it evidences the Court's intolerance for poor prosecution before the PTO.
 - The 10/12/07 posting discusses the new continuation rules chaos and the GSK just-filed lawsuit challenging them.
 - For those interested in patent reform, Hal's 10/12/07 offering discussing the GAO's report card on the PTO includes the GAO's 9 point reform proposal.
 - The 10/15/07 newsletter addresses legal malpractice arising from patent prosecution and litigation.
 - A 10/23/07 posting includes a report that since inter partes patent reexaminations began at the PTO in 1999 there has been no final decision on any such case, and only 2 interlocutory decisions, each returning the file to the examiner for further consideration.
 - Another 10/23/07 posting discusses the two §101 cases now before the CAFC.
- Hal's 10/24/07 posting focuses on the PODS and AFG petitions for cert before the Supremes, asserting that CAFC precedence in at least claim construction and patent infringement is a mess, and needs rectification.
- In the 10/25/07 email Hal discusses the latest three business method cases before the CAFC.
 - In another 10/25/07 email Hal quotes a European reporter who attended the recent AIPLA annual meeting: relations between the PTO and patent attys. are "profoundly unhealthy at the moment" because of the new rules.
 - The 10/26/07 posting discusses patent law reform happenings in Congress, focusing on the new rules and what the currently pending amendments would do.
 - The 10/31/07 email reports that today the ED Va enjoined the PTO from applying its new continuation and claim rules. Hurrah. And what a mess! For details also see the Patently-O blog for 10/31/07 (it includes the text of the PI).



Patently-O – a blog written by Dennis Crouch – patent@gmail.com

- The 10/3/07 blog reminds readers of the new PTO fees now in effect. To check them, go to the USPTO website.

Internet Sightings by *Jim Hawes* (cont. p. 10)

- The 10/15/07 posting reports that the OED Director, in a speech, asserted that all registered practitioners have an ethical duty to comply with the new rules. Among many other things, squealing on clients is now required.
- The 10/16/07 issue reports that the PTO has stopped examining applications with more than 25 claims. On 10/19/07 the PTO reportedly issued a memo revoking this policy.
- The 10/26/07 blog discusses the Par Pharm. holding by the CAFC that a claimed surfactant was not enabled by three working examples. Good Lord - would 30 have been enough?
- The 10/29/07 posting reports a limited study of prior art used in recent litigation. More than half (53%) were patents; next was products (23%) then articles (11%), so when citing prior art to the PTO be sure to include prior product information if relevant.

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

- The 10/30/07 issue includes a guest column that discusses patent valuation.

The Invent blog – also from feedblitz@mail.feedblitz.com

- The 10/9/07 blog cites a site that offers help in compiling information on competitors.
- The 10/10/07 posting reports that Oxford University Press would welcome inquiries from those interested in writing IP treatises.
- The 10/12/07 offering reports that freePat has returned – it offers free international PDF patent copies.
- The 10/25/07 posting includes a guest column that calls attention to the new definition of “divisional application” and its potential for serious misunderstanding by patent attorneys.

Daily Dose of IP – a blog by Mark Reichel – www.dailydoseofip.blogspot.com – an ongoing grab-bag of various IP developments, and recent CAFC decisions.

- The 10/1/07 blog reports that WIPO’s PatentScope database now, in addition to a lot of PCT application info, makes available applicants’ informal comments to ISA reports.
- The 10/5/07 issue states that the UK Trademark Office no longer will refuse to register a new mark because of a conflicting prior mark, but will notify the owner of the conflicting mark on publication of the new mark. Quite a change.
- The 10/31/07 dose presents a good review of the Tafas and GSK cases challenging the PTO’s new rules.

I/P Updates – a blog by Bill Heinze – www.ip-updates.com

- The 10/4/07 blog includes suggestions concerning how to handle the new continuation rules that were to be effective 11/1/07.
- The 10/11 issue contains two sections on the new claims and continuation rules; one being the PTO’s Powerpoint presentation to examiners, the other being a suggested best practices strategy.

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

- The 10/12/07 posting reports that the Section Education Institute will be held 1/18-20/08 in San Diego, and also lists section recordings available for downloading.

AIPLA Direct – a newsletter issued from time to time – www.aipla.org

- The 10/1/07 issue of AIPLA Direct reported that on 9/25 the Supreme Court granted cert in the Quanta case to reconsider the first sale, patent right exhaustion doctrine.
- The 10/26/07 posting reports that a series of networking dinners, titled “Women in IP,” are being arranged for 1/16/08.

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

- The new TMEP 5th edition is now available at this website. But it is still woefully out of date.
- The 6th revision to the 8th edition of the MPEP is now posted on the PTO’s website.

Employment Situation Available



Rayspan Corporation's core business is in licensing its proprietary Revolutionary Metamaterial Air Interface technology. We are seeking an experienced Intellectual Property attorney or agent to work with our management, technical team, and outside patent attorneys to build the company's IP foundation and licensing strategies. The ideal candidate will have experience in drafting, filing, maintaining, and licensing patents in the Radio Frequency domain.

Essential Duties:

The primary responsibilities of the patent Attorney/Attorney are:

- Secure Rayspan's IP by working closely with the R&D group and by establishing and leading a process to efficiently protect the company's breakthrough RF innovations and discoveries.

- Prosecute and maintain existing patent portfolio.

- Work with external patent counselors.

Work with Rayspan's management to establish a strategy and process to license the company's IP to its direct and indirect customers.

- Work with external patent counselors.

- Work with Rayspan's management to establish a strategy and process to license the company's IP to its direct and indirect customers.

General Description:

Rayspan Corporation is the world's leading innovator of revolutionary Metamaterial Air Interface solutions for high performance wireless communication networks. Metamaterial designs are based on left-handed structures that exhibit negative index of refraction and other electromagnetic properties not found in natural media. These unique properties enable breakthrough improvements in communication system performance.

Rayspan is developing a broad line of metamaterial air interface devices including antennas, filters, diplexers, couplers, and matching networks. Its research and development activities encompasses analysis, design, modeling, simulation, and prototype development and test.

Experience & Education

- 2+ years of U.S. and international patent drafting and prosecution
- Technical background in electrical engineering with RF focus Ability to apply innovative strategies to maximize value of the company's intellectual property.
- Excellent oral and written communication skills
- Ability to learn IP-based business models, licensing strategies, and the means to enforce and defend Rayspan's innovations
- Excellent oral and written communication skills
- Strong ability to organize, multi-task and establish priorities among protecting, licensing, and enforcing Rayspan's intellectual properties

Demonstrated attention to detail during patent process and maintenance to protect Rayspan's intellectual property from all angles



The Power of an Attorney to Shape the Future of Biotechnology **by Douglas E. Olson and David M. Fortner (cont.)**

Hybritech proved to be an incredible environment for biotechnology talent with more than 50 San Diego biotechnology companies founded by former Hybritech employees including Gen-Probe, Idec Pharmaceuticals, Ligand Pharmaceuticals, Biosite, and Nanogen. Attorney Respass helped change San Diego from a sleepy, small community of biotechnology and patent firms into the powerhouse it is today. One attorney truly can make a difference.

About the Authors

Doug Olson is a Partner in the Paul Hastings' San Diego office with thirty plus years of trial experience in the pharmaceuticals, genetic engineering, medical devices, and semiconductor industries and specializes in intellectual property litigation.

David Fortner is an Associate in the Paul Hastings' San Diego office and focuses his practice on patent and other intellectual property litigation and patent prosecution in the areas of biotechnology and life sciences.

Applications for SDIPLA Membership

The following individuals have applied for SDIPLA membership. Active Members may oppose membership status to these individuals by lodging a formal notice of opposition. The opposition must include relevant grounds for disqualification and should be submitted to the Secretary on or before January 1, 2008.

Anthony Craig

Yan Leychkis

Scott Davison

Randall Lukasiewicz

Negin Demehry

Russell Mangum

Courtney Etnyre

Rounak Nassirpour

Thomas Grossman

John Scott

Lisa Karczewski

Brian Sun

Denise Lew

Kevin Walda

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:** Jessica S. Mitchell

Attorney Member Dues: \$50/year SDIPLA Secretary

Non-Attorney/Retired Attorney Dues: \$25/year Neil Dymott Frank McFall & Trexler, PC
(e.g. law students, paralegals, patent agents, retired attorneys, etc.) 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.

Internet Sightings by *Jim Hawes (cont.)*

- On 10/2/07 the EFS Web group sent an email subscription invitation to all interested in PTO training, events and other matters relevant to its patent filing system.
- The 10/9/07 eCommerce eAlert includes a tip that the “Drawing” description is only for drawings; index drawing amendments as part of your Remarks; if you have questions call EBC at 866 / 217-9197.

TTABlog – a blog written by John Welch – www.TTABlog.com

*The 10/22/07 blog presents the current roster of TTAB judges.

- The 10/25/07 posting reports that the TTAB’s “precedential no. 61” ruling in Sunrider held that 6 days’ notice of a testimonial depo was sufficient.
- The 10/29/07 blog includes a hypothetical timeline for an inter partes proceeding under the new rules. If the Institution Order was issued on Nov. 1, 2007, the request for oral argument (without any intervening extensions) would be due on May 14, 2009. Who knows how long it would take after that?

Copyright Office News – copynews@loc.gov

* On 10/2/07 the Office announced a new customized email service to report recent developments to those interested. If you are, go to loc@service.govdelivery.com.

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

Visit SDIPLA on the Web at:
www.sdipla.org

ARTICLES: If you have an article for the newsletter, please send it to Jessica.
DUES: To pay or renew your **membership dues:** Please use the form on page 9, and send form via mail or fax to Jessica Mitchell. - online registration now available - visit www.SDIPLA.org.

Date	Event	Speaker/Topic
December 6, 2007, 6:30 p.m.	SDIPLA Holiday Dinner Party at The Lodge of Torrey Pines	Judge Rudi M. Brewster