



OCPLA NEWSLETTER

Orange County Patent Law Association

www.ocpla.org

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December 2007

SEASON'S GREETINGS

The Board would like to wish all of you and yours a fantastic Holiday and a Prosperous New Year. See you all at the January 23rd luncheon for more stimulating discussions.

2007 HOLIDAY PARTY

For those that could not attend the Holiday Party, here's a little summary: Greg eloquently recapped the year with various accomplishments and tales from distinguished guests. Greg then ceded power to Neal but before Neal could accept the Fez, a sombrero-wielding stranger from south of the border intercepted it. Here's a pic:

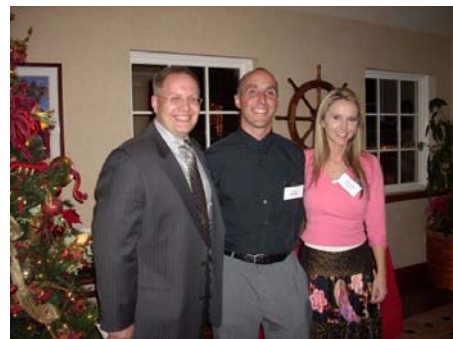


What's a holiday party without acknowledging friends, supporters, and colleagues? Along that same vein, the Board has selected three winners from a group of talented local law students to award this year's OCPLA Scholarships. The winners were selected for their well reasoned and compelling stories of why they wish to be an IP attorney. The winners are:

1st - Dean Stathakis – Whittier Law School

2nd - Sascha Topa - Whittier Law School

3rd - Aleksandra Sarosiek – Chapman Law School



* Sascha Topa, had to study for finals and therefore could not attend.

JANUARY BOARD MEETING

The January board meeting has been scheduled for 11:00 AM, January 23, 2008, at the Wyndham Hotel, just prior to the lunch meeting. Members who wish to present items for the Board's consideration are encouraged to contact our president, Greg Holtrigel, to have their items placed on the agenda.

2008 OCPLA MEMBERSHIP RENEWAL

Attached at the end of this newsletter is the renewal form for the 2008 calendar year.

The association needs your support. Please renew early by printing and filling out the form and returning it at your earliest convenience.

There have been a few changes for the 2008 calendar year. The membership dues will be \$50 for attorneys and agents and \$25 for student memberships to offset higher fixed costs.

Additionally, renewing members may pay for an annual lunch passport and the membership renewal at one low package price, which will cover 9 lunch meetings (excluding the special Dinner engagement with Judge Gajarsa, the Spring Seminar, and the 2008 Holiday Party) and the membership fee.

The lunch passport is \$360 for attorneys and agents and \$180 for students.

Monthly lunch meetings have increased to \$40 for members; \$20 for student members \$50 for non-members; and \$25 for non-member students to reflect the increased costs at the Wyndham Hotel.

**SPECIAL MARCH '08 DINNER EVENT
FEDERAL CIRCUIT JUDGE GAJARSA**

Save the date!

Judge Gajarsa is confirmed as a special guest speaker at the March '08 monthly OCPLA function. Due to the expected number of attendees and Judge Gajarsa's schedule, the March meeting will be a dinner event to be held March 20, 2008, from 6:30 PM to 8:30 PM.

Further information will be forth coming.

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 the editor of the submitted IS column. The full IS column, with compilations of some of the sources such as Hal Wegner's newsletter, will be up and available soon at www.internetsightings.com. Check it out.

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

The 11/01/07 issue, as usual, gives a lot of insider, behind the scenes, material about the ED Va's issuance of a preliminary injunction against the PTO's now ex-new rules.

The 11/02/07 newsletter reports the Philips decision by the CAFC holding that the DOE can apply to numerical limitations, such as ranges, in a claim.

Another 11/02/07 emailing discusses forum shopping, and cites Judge Moore's testimony, her law review article, and Prof. Crouch's recent study.

In still another 11/02/07 posting Hal looks into his crystal ball and discusses the future of the preliminary injunction against the PTO's new rules.

The 11/07/07 blog reports the Fed. Circuit's recent Zenon decision holding a sec. 120 incorporation by reference to be defective, thereby invalidating the patent (of course).

The 11/15/07 report states that the PTO, at the end of FY '07, had a total of 3609 (or about 40% of all) examiners working at home. So chances are pretty good that the examiner you are talking with by phone is at home.

- Hal's 11/16/07 posting adds to the 11/15 at home news that one-third of all new examiners at the PTO resign during their first year of service. Wow.

- The 11/18/07 newsletter attaches the PTO annual report – it has full funding (about

\$2 bil.) but its goals are elusive (esp. in reexamination).

- A second 11/18/07 issue states that Senate Maj. Leader Reid is “confident” that Patent Reform legislation will pass in the Senate this year.

- A 11/19/07 emailing discusses Perez, another black mark against the CAFC for refusing to consider an appeal because of poor briefing by a prison guard. Have they no sense of justice?

- The 11/20/07 newsletter discusses the patent views of presidential candidates.

- The 11/23/07 email gives more info about presidential candidates and patents. Now is the time for patent attorneys to get involved.

- The 11/24/07 issue addresses problems citing Westlaw to the CAFC.

- The 11/25/07 email talks about how NOT to brief and argue before the CAFC.

- Hal’s 11/28 posting says of the recent Law CAFC decision, “the court continues its misunderstanding of sec. 132 and its relationship to sec.112.”

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

The 11/01/07 blog reports the Digeo CAFC decision holding that an erroneous assertion of title to a patent, based on a knowingly forged assignment, does not create an exceptional case allowing the award of attorney’s fees. Boy, if that doesn’t, what does?

The 11/07/07 posting discusses In re Ferguson, to be argued before the CAFC 12/5, a case challenging the PTO’s sec. 101 patentability tests for business method applications.

The 11/08/07 blog discusses problems with the proposed new BPAI rules, rules which some see as mainly roadblocks to appeals.

A second 11/08/07 posting discusses the Zenon case – see Hal Wegner’s 11/07 posting.

- The 11/14/07 issue reports a “gold plated” patent proposed by Presidential candidate Obama.

- The 11/16/07 blog reports the Apotex decision of the CAFC holding that “ordinary”

fraud is not a sufficient reason to reopen patent litigation. Oh?

- The 11/18/07 posting discusses the PTO’s new appellate rules, including some for appellate misconduct.

- The 11/19/07 blog discusses the Quanta patent exhaustion case now before the Supreme Court in which two rules were held to swallow the doctrine.

- The 11/20/07 note suggests 10 gifts for a patent attorney. Hint, hint.

- The 11/26/07 blog discusses the z4 Fed. Cir. 102(g) decision relating to invalidating but secret activities.

- The 11/27/07 posting concerns the Egyptian CAFC decision to en banc review design patent novelty tests.

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

The 11/05/07 issue includes a guest column that discusses the CAFC’s Nuijten and Comiskey decisions and the redrawn scope of sec. 101’s patentable subject matter.

The 11/16/07 letter reports that our own KMOB has opened a DC office.

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

The 11/06/07 issue cites an “excellent” article about tips and tricks for making the most of dual monitors.

- The 11/12/07 posting cites sources for IP docketing and related software.

- The 11/20/07 blog tells how to set up Adobe Acrobat for the PTO.

Daily Dose of IP – a grab-bag of various IP matters by Mark Reichel – www.dailydoseofip.blogspot.com

The 11/07/07 dose included discussion of the PTO’s justification to Congress of the examiner work at home program (reportedly, one examiner even works “at home” in Colorado).

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

- The 11/22/07 blog includes a discussion of how examiners “count” at the PTO, for those who wonder why examiners do what they do.

Gen-Eric – a newsletter reporting IP happenings – www.gen-eric.com

*The 11/06/07 blog includes links to the PTO’s just revised PCT procedures and to its memo discussing the new sec. 103 obviousness tests.

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

The 11/01/07 issue reports that the ED Va issued a preliminary injunction against the PTO implementing its new claiming and continuation rules.

The 11/13/07 newsletter announces an interactive webcast on 12/12 to discuss IP ethics and the duty of good faith.

- The 11/16/07 announcement describes the Mid-winter “Best Practices in IP” Institute to be held in Phoenix Jan. 23-26.’08 (reg. closes 1/7)

- The 11/20/07 issue discusses the mentoring program, and invites mentors and mentorees to sign up.

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

The 11/02/07 blog presents an example of the TTAB’s new “institution (of an opp. or canc.) order” for those into that sort of thing.

If you know who Leo Stoller is, you might be interested in the summary of his recent (and some would say, well deserved) woes given in the 11/07/07 blog.

- The 11/14/07 blog reports a PTO proposed rule change that would require a description for all non-standard character components of a mark.

- The 11/15/07 issue reports that NY has fallen to Santa Barbara in the “I love” phrase department for failure to properly make evidence of record before the TTAB. Well, I always thought SB was nicer than NY anyway.

- The 11/20/07 blog discusses how to avoid a “Monster” mistake in a TTAB proceeding – ie how to make registrations of

record depends on when the proceeding began.

- The 11/26/07 email discusses the Bose 2(d) victory in spite of losing the fraud claim. Here’s how to win the war even after losing the fraud battle.

Copyright Office News – copynews@loc.gov

The 11/01/07 issue (#325) reports that the CO has issued new rules relating to renewals of copyright, and requiring the use of new renewal forms.

The 328 issue (11/22/07) announces the CO website posting of an updated 17 USC in both pdf and html formats.

WIPO – The international IP group in Geneva – wipo.int

- If you like surveys, WIPO emailed one about IP education and research on 11/26/07.

Other Stuff –

- Patent management solutions, especially for searching, are now offered at www.wizpatent.com. Among other things, this service combines USPTO, Espacenet, FreePatentOnline, and Google patent searches. Check it out.

- The ABA Journal has put together a list of IP blawgs – you can look it over at www.abajournal.com/blawgs/intellectual+property+law.

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

RECENT IP CASES

BY IRFAN LATEEF
KNOBBE, MARTENS, OLSON & BEAR

In *Digeo, Inc. v. Audible, Inc.*, Case No. 07-1133, the Federal Circuit affirmed the district court’s denial of attorney’s fees under 35 U.S.C. § 285 and the denial of the request

for additional discovery to develop the § 285 claim.

In this case, the patentee brought suit with a patent having a defect in its title. The district court found no clear and convincing evidence that the plaintiff knew or should have known of the defect, therefore no evidence of having brought a baseless or frivolous suit against the accused infringer, which would have made the case exceptional. Although the facts of the case were unique and unusual - an inventor thought dead but who was not, some forged documents, no evidence of culpability - the Court agreed that the case was not exceptional.

In *U.S. Philips Corporation v. Iwasaki Electric Company LTD.*, Case No. 07-1117, the Federal Circuit affirmed the district court's summary judgment of infringement as based on a correct claim construction of a numeric range; rejected the district court's conclusion that the doctrine of equivalents is foreclosed as to the disputed range; and remanded for consideration of infringement of the range under the doctrine of equivalents.

The patent-in-suit is directed to high-pressure mercury vapor discharge lamps filled with a gaseous mixture in which "at least one of the halogens Cl, Br or I is present in a quantity between 10^{-6} and 10^{-4} $\mu\text{mol}/\text{mm}^3$."

Philips argued that the phrase "a quantity between 10^{-6} and 10^{-4} $\mu\text{mol}/\text{mm}^3$ " expresses a range of orders of magnitude, not a range of more-precise numbers -- the term " 10^{-4} ," as an order of magnitude, encompasses a range of values from $10^{-4.5}$ and $10^{-3.5}$ -- the set of numbers with base-10 logarithms that round to -4. The district court disagreed and construed the phrase to mean "a quantity between 1×10^{-6} and 1×10^{-4} $\mu\text{mol}/\text{mm}^3$." The Federal Circuit agreed and affirmed the district court's finding that the defendant's product did not infringe because it had a quantity of $1.6 \pm 0.4 \times 10^{-4}$ $\mu\text{mol}/\text{mm}^3$, which exceeded the range.

Having found non-infringement, the district court foreclosed the possibility of infringement under the doctrine of equivalents so as to not vitiate the claim limitation. The Federal Circuit disagreed and held that the doctrine of equivalents is available to extend the claimed range beyond its literal scope.

In *Zenon Environmental, Inc. v. United States Filter Corporation (now known as Water Applications & Systems Corporation)*, Case No. 06-1266, the Federal Circuit reversed the district court's final judgment, following a bench trial, of no invalidity as based on an erroneous priority date determination and held that the '319 patent is invalid. The '319 patent relates to the field of water treatment and filtration systems and is directed to relatively large systems for the microfiltration of liquids. The patent was the sixth to issue from a series of connected applications filed by the same assignee.

The question on appeal was whether the '319 patent was entitled to claim priority to the earlier '373 patent, through the '250 patent. The parties had previously stipulated that the '373 patent discloses every element of the claims of the '319 patent. The Court found that the intervening '250 patent failed to incorporate by reference, with sufficient particularity to one reasonably skilled in the art, the gas distribution system disclosed in the '373 patent. The Court stated that incorporation by reference is a question of law, not fact. Thus, the Court held that because a lack of continuity of disclosure exists in the family chain, the '319 patent is not entitled to the filing date of the '373 patent. Because the '373 patent was filed more than one year prior to the filing of the '319 patent, the Court concluded that the '319 patent is anticipated by the '373 patent and hence invalid.

In her dissent, Judge Newman opined that the question of what material was incorporated by reference was a question of fact.

In *HIF Bio, Inc., et al. v. Yung Shin Pharmaceuticals Industrial Co., LTD, et al.*, Case No. 06-1522, the Federal Circuit dismissed the appeal for lack of jurisdiction to review the district court's decision to remand the case to state court. The Plaintiffs asserted twelve causes of action, including declaratory judgment for ownership and inventorship of an invention, and RICO violations. The district court dismissed the RICO claim and declined supplemental jurisdiction over the ownership and inventorship issues, remanding the case to state court. The Defendants appealed the remand decision.

Title 28 U.S.C. § 1447(d) provides (with an exception for civil rights cases) that “[a]n order remanding a case to the State court from which it was removed is not reviewable on appeal or otherwise.” The Supreme Court has interpreted this section narrowly. The question on appeal was whether a remand based on declining supplemental jurisdiction under § 1367(c) falls within this preclusion. The Federal Circuit concluded that because every § 1367(c) remand necessarily involves a predicate finding that the claims at issue lack an independent basis of subject matter jurisdiction, a remand based on declining supplemental jurisdiction can be colorably characterized as a remand based on lack of subject matter jurisdiction. Accordingly, a remand based on declining supplemental jurisdiction must be considered within the class of remands barred from appellate review by § 1447(d).

In *Apotex Corp. v. Merck & Co., Inc.*, Case No. 06-1405, the Federal Circuit affirmed the district court's grant of summary judgment dismissing an action by Apotex to set aside a judgment on charges of fraud, pursuant to Federal Rule of Civil Procedure 60(b)(3).

Rule 60(b)(3) provides that a judgment can be set aside for fraud or misrepresentation only when the motion is made within a year after the judgment, unless there was “fraud upon the court” or another egregious act not previously uncovered. Fraud upon the court is

typically limited to egregious events such as bribery of a judge or juror or improper influence exerted on the court, affecting the integrity of the court and its ability to function impartially.

Merck made various representations and arguments in a previous trial. Apotex alleged that Merck subsequently admitted that those representations and arguments were false. In this case, filed more than one year after the previous suit was decided and affirmed, the district court found that the alleged misrepresentations: (1) were irrelevant to the issues decided in the previous suit and (2) were reasonable inferences that could be drawn from the evidence and not direct testimony or evidence. The Court agreed and held that evidence and argument presented during a trial does not establish fraud upon the court. The Court also agreed with the district court that the crime-fraud exception to the attorney-client privilege did not apply because Apotex failed to make a *prima facie* showing that fraud was committed.

In *Z4 Technologies, Inc. v. Microsoft Corporation, et al.*, Case No. 06-1638, the Federal Circuit affirmed the district court's denial of Microsoft's motion for JMOL of non-infringement and invalidity and affirmed the district court's denial of Microsoft's motion for a new trial. The patents-in-suit are directed to the prevention of software piracy.

Microsoft argued that the district court erred in denying its motion for JMOL of invalidity under 35 U.S.C. § 102(g). The Court held that Microsoft bore the burden of demonstrating by clear and convincing evidence that its License Verification Program (LVP) software, which it implemented in its 1998 Brazilian Publisher software, constituted an actual reduction to practice of the invention claimed in Z4's patents. Because substantial evidence in the record supported the jury's finding that Microsoft's LVP software did not work for its intended purpose and the jury's verdict that Z4's patents were not invalid for anticipation, the Court affirmed the district court's denial of Microsoft's motion.

On Microsoft's argument that the district court abused its discretion by refusing to instruct the jury that Microsoft's "burden [of proving invalidity] is more easily carried when the references on which their assertion is based were not directly considered by the examiner during prosecution," the Court held that the district court did not abuse its discretion in refusing to provide the instruction. On Microsoft's request for remand in light of the *KSR*, the Court held there was no abuse of discretion by the district court in instructing the jury to use the TSM test because Microsoft failed to identify specific evidence or arguments establishing a prima facie case of obviousness under the *Graham* factors.

In *Elbex Video v. Sensormatic Electronics*, Case No. 07-1097, the Federal Circuit affirmed in, reversed in part, and remanded the district court's grant of summary judgment of noninfringement.

The patent at issue relates to closedcircuit television (CCTV) systems. The district court granted summary judgment of noninfringement based on its construction of the claim term "receiving means" or alternatively based on the absence in the accused systems of a signal that corresponds to a second code signal as required by Claim 1.

The Federal Circuit held that the district court erred in construing "receiving means" as limited to a "monitor" based on the prosecution history because the statement relied upon by the district court "was not a clear and unmistakable surrender of claim scope." The court reached its conclusion based on the lack of support in the specification or drawings for such a construction, the inoperability of a device constructed in accordance with the district court's claim construction, the inability of appellee's technical witness to understand how the system would operate consistent with the erroneous statement during prosecution, and ambiguity created by other statements in the same prosecution document. The court

held that summary judgment was thus inappropriate on this ground.

However, the Federal Circuit held that summary judgment of noninfringement was nonetheless appropriate for two of three accused CCTV systems based on an absence in the accused systems of features corresponding to the claim limitation requiring a second code signal.

NEWSLETTER VIA EMAIL ONLY

The Newsletter is now being transmitted solely by electronic mail. If you know of anyone who should be, but is not getting this e-mail distribution, please have them contact Tom Dao at tom.dao@cph.com.

OCPLA POLICY

Although we are open to comments and suggestions, present policy concerning publication of advertisements in this newsletter is as follows: (1) "Positions Wanted," "Positions Available," and other similar ads will be printed free of charge and, unless otherwise requested, will run for two months; (2) Other ads such as word processing, legal support services, and firm announcements will be published for \$15 per issue or \$150 per year (for all 12 issues), payable in advance. We reserve the right to edit each advertisement. Please contact the Newsletter editor to place your ad or with your comments and suggestions.

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OCPLA NEWSLETTER

Orange County Patent Law Association

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The OCPLA reserves the right to determine which, if any, submitted articles will appear in this Newsletter.

We hope that the Newsletter is helpful, informative, entertaining and interesting. Comments, ideas, announcements, proposed articles, suggestions and any other communications concerning the content, form or other aspect of this newsletter may be directed to:

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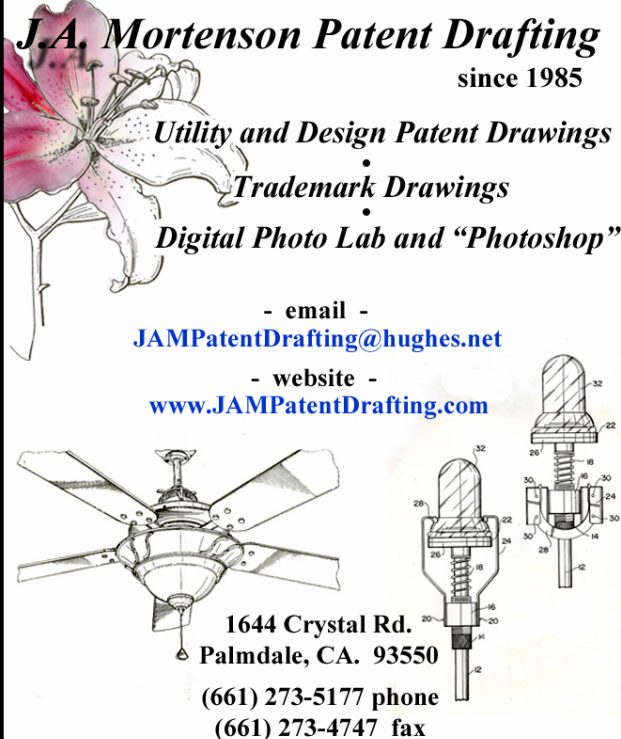
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2008 OCPLA MEMBERSHIP APPLICATION/RENEWAL FORM

This is an application for (please check one):

- Membership Renewal
- New Membership

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Are you registered to practice before the U.S.P.T.O.?	___	___	Reg. No. _____
Are you a student?	___	___	School: _____

Please circle not more than TWO committees in which you would like to participate:

Annual Seminar	Law Office Management	Membership
Copyright Practice	Legislation	Patent Practice
Federal Courts	MCLE	Trademark Practice
International Practice	Meetings/Programs	Trade Secret/Unfair Competition

Dues Membership Year 2008 (please circle one):

Regular Membership (attorneys, agents):	\$50.00
Student Membership	\$25.00
Associate Membership (other)	\$50.00
Membership + Annual Lunch Passport (Regular or Associate)	\$360.00
Membership + Annual Lunch Passport (Student)	\$180.00

New Applicants please complete the following:

I believe I qualify for membership in the Orange County Patent Law Association.

Applicant's Signature: _____ Date: _____
 Printed Name: _____

Send Application to OCPLA P.O. Box 7632 Newport Beach, CA 92658

2008 OCPLA EVENTS SCHEDULE

Date	Location	Speaker/Event	Topic
Jan. 23, 2008	Wyndham Garden Hotel	Alex Schlee of Schlee IP International	EP Inventive Step
Feb. 27, 2008	Wyndham Garden Hotel	TBD	TBD
Mar. 20, 2008	Wyndham Garden Hotel	Federal Circuit Judge Gajarsa (special dinner event to replace the monthly luncheon)	Keynote Speaker
April 23, 2008	Wyndham Garden Hotel	TBD	TBD
May. 28, 2008	Wyndham Garden Hotel	TBD	TBD