

SPECIAL
POINTS OF
INTEREST:

- May Meeting
- Federal Circuit Case Summaries
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- Fall Seminar
- Hatch-Waxman Bootcamp
- Holiday Party
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OCPLA Newsletter

VOLUME 16, ISSUE 3

MAY 2010

June Meeting

The June meeting will be held on June 17th and will feature Bill Smith from Woodcock Washburn speaking on "Tips for Success Before the BPAI."

Make sure to register early and to invite your

Save-The-Date

12-19-2010

OCPLA Holiday Party

May Meeting—Special 2.5 Hour CLE

We are thrilled to announce that Sharon Barner, Deputy Under Secretary of Commerce and Deputy Director of the USPTO, will be speaking for a 2.5 hour CLE including a roundtable discussion with local practitioners on May 13th from 12 pm—3:30 P.M. at the Sports Club. Go to www.ocpla.org to register by Monday May 10th.

Want to Become More Involved With
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If you would like to become more involved with OCPLA, for example, do a presentation, submit an article, provide feedback or ask a question, please send an e-mail to

Federal Circuit Case Summaries

By Irfan Lateef

In *Comaper Corp. v. Antec, Inc.*, Case Nos. 2009-1248 and -1249, the Federal Circuit affirmed the district court's claim construction but vacated the final judgment

because of inconsistent jury verdicts on obviousness.

Comaper asserted a patent for a computer cooling device against Antec. After a jury trial

on infringement and validity, the jury returned a special verdict that found the independent claims valid and infringed but the dependent claims obvious. The district

Federal Circuit Case Summaries



“In particular, the Federal Circuit noted that while a card’s presentation may be unlimited, the asserted claims are related to content which has a finite number of available solutions.”

court found that Antec failed to present sufficient evidence to support the obviousness verdicts and ordered judgment for Comaper.

On appeal, Antec asserted that the district court erred in construing claim terms and in finding that the obviousness verdicts were unsupported. The Federal Circuit found that the district court correctly construed the claims but improperly found that the evidence would not support a finding of obviousness. Rejecting the district court’s conclusion that the asserted references were not analogous prior art, the Federal Circuit determined that the jury could have found the dependent claims obvious in light of one of the prior art devices and the testimony of Antec’s expert.

Because the evidence could support the jury’s verdict that the dependent claims were obvious, the obviousness verdicts were irreconcilably inconsistent, and the Federal Circuit remanded for a new trial on invalidity.

In *Media Technologies Licensing, Llc. v. The Upper Deck, Co.*, Case No. 2009-1022, the Federal Circuit affirmed the district court’s grant of summary judgment that two patents were invalid due to obviousness.

The two patents in suit require attaching a tiny piece of a sports memorabilia item to a card in combination with a photograph of a famous figure having a relationship to the item. The plaintiff sued for infringement, and in response, the defendants filed requests for reexamination. After reexamination confirmed the patentability of both patents, the district court nevertheless granted a motion for summary judgment that the patents were invalid for obviousness.

The Federal Circuit affirmed the grant of summary judgment. An expert declaration supported finding the patents obvious in view of the prior art and the application of the references by one of ordinary skill of the art to a “sports trading card.” The Federal Circuit rejected Media Tech’s argument that the combination would not be applied to a sports card, based on the trading card field containing an infinite number of identified and unpredictable solutions. In particular, the Federal Circuit noted that while a card’s presentation may be unlimited, the asserted claims are related to content which has a finite number of available solutions. The secondary considerations presented by Media Tech also were insufficient to establish non-obviousness.

In *Davis v. Brouse McDowell, L.P.A.*, Case No. 2009-1395, the Federal Circuit affirmed the district court’s grant of summary judgment in a patent malpractice suit because the plaintiff’s failed to establish a genuine issue of material fact as to the patentability of her inventions.

Plaintiff Davis approached an attorney at the defendant law firm Brouse McDowell to obtain patent protection, including international protection, for certain aspects of an IP exchange website. In response, the defendant sent her a letter outlining PCT filings, deadlines, and costs associated with PCT applications.

Federal Circuit Case Summaries

However, the letter did not mention the “absolute novelty” rule that applies in certain countries to bar patentability if there was public disclosure prior to a patent filing. After filing two provisional applications by herself, and, five days before the deadline for utility and PCT filings, Davis contacted the attorney to prepare the formal filings. Because the attorney was leaving for vacation, he asked for the files to be sent to him before he left. He did not receive the files until after he returned. The attorney then filed three U.S. utility applications on the day of the filing deadline, but did not file any PCT applications. The defendant also sent the plaintiff a letter stating that no PCT applications were filed because obtaining patent protection in Europe was unlikely (although the defendant later filed a PCT application for the plaintiff after the deadline). Davis filed a malpractice suit due to the failure to timely file PCT applications before the deadline. The district court found that adjudication of the malpractice claims first required a determination of the patentability of the inventions, as any of the defendant’s alleged negligence in drafting and filing patent applications would have been immaterial if the plaintiff’s inventions were not patentable. Consequently, the plaintiff needed to prove by a preponderance of the evidence that she would have obtained patents on her invention but for defendant’s alleged negligence. The Federal Circuit affirmed.

The Federal Circuit found that the plaintiff’s expert report regarding patentability was deficient because it was only a naked conclusion. Hence, because the plaintiff failed to establish an issue of material fact as to the patentability of her inventions, she could not establish causation as to her malpractice claim.

In *Tivo, Inc. v. EchoStar Corp.*, Case No. 2009-1374, the Federal Circuit affirmed the district court’s finding that EchoStar was in contempt of a permanent injunction.

Tivo sued EchoStar in the Eastern District of Texas alleging EchoStar’s DVR receivers infringed its patent. The jury found the DVRs infringed both the “software” and “hardware” claims of the patent. The district court granted a permanent injunction, and ordered EchoStar (1) to stop making or selling the infringing receivers and (2) to disable the DVR functionality in existing receivers. EchoStar failed to appeal the permanent injunction.

Subsequently, the district court found EchoStar in contempt of the permanent injunction because EchoStar’s redesigned DVRs were not colorably different from the adjudged infringing devices. EchoStar also failed to disable DVR functionality in existing receivers.

The Federal Circuit held that the district court did not abuse its discretion regarding EchoStar’s redesigned DVRs. In particular, EchoStar’s redesigns of the “parsing” and “buffering” steps were insufficient because other components still infringed these claim limitations. Accordingly, the contempt hearing was an appropriate forum to adjudge infringement of the redesigned DVRs.

Moreover, the Federal Circuit affirmed the finding that EchoStar was in contempt of the disablement provision of the permanent injunction. The injunction expressly prohibited “DVR functionality,” and therefore EchoStar’s failure to completely disable the functionality was in contempt. Most importantly, the Federal Circuit noted that EchoStar never appealed the broad terms of the injunction, and therefore EchoStar could not question the injunction’s legitimacy.

“The Federal Circuit found that the plaintiff’s expert report regarding patentability was deficient because it was only a naked conclusion.”

Federal Circuit Case Summaries

In *Ajinomoto Co., Inc. v. International Trade Commission*, Case No. 2009-1081, the Federal Circuit affirmed invalidity of the asserted claims for failure to disclose best mode.

Ajinomoto's '698 and '160 Patents relate to improved methods of producing lysine, a dietary supplement added to livestock feed, from genetically modified *E. coli* bacteria. Ajinomoto filed a complaint with the International Trade Commission, alleging a violation of 19 U.S.C. § 1337 in the respondents' importation and sale of lysine feed products made by the methods claimed in the patents. The administrative law judge (ALJ) determined that the asserted claims of the '698 and '160 Patents were invalid for failing to comply with the best mode requirement of 35 U.S.C. § 112, first paragraph, which requires that an inventor disclose the preferred embodiment of the claimed invention as well as preferences that materially affect the properties of the invention. Because the inventors failed to disclose the best mode, the ALJ also found the asserted patents unenforceable for inequitable conduct. The Commission affirmed the ALJ's determinations.

The Federal Circuit affirmed. On appeal, Ajinomoto did not challenge the Commission's factual findings that the inventors had subjective preferences for particular subject matter and that the patents' lack of disclosure concealed that subject matter. Instead, Ajinomoto argued that the Commission erred in defining the scope of the invention and the best mode requirement. The Federal Circuit affirmed the Commission's decision, noting that "the scope of the best mode requirement [included] an obligation to disclose the inventors' preferred host strains." The preferred host strains were not disclosed. Thus, the Federal Circuit concluded that "[t]he inventors could not, consistent with the best mode requirement, claim the cultivation of a bacterium containing an ldc mutation while simultaneously keeping from the public the identity of

the one and only bacterium they used to practice that cultivation."

In *Richardson v. Stanley Works, Inc.*, Case No. 2009-1354, the Federal Circuit affirmed a finding of non-infringement because the district court correctly factored out the functional aspects of a design patent during claim construction.

The patent claimed the design for a multi-function carpentry tool combining a hammer with a stud climbing tool and a crowbar. Stanley's manufactured and sold a competing multi-function hammer. The district court held that Stanley did not infringe the patent after discounting the functional elements of the patent.

In affirming the decision, the Federal Circuit confirmed that the ordinary observer test applies in cases where the patented design incorporates numerous functional elements. The Federal Circuit also emphasized that a design patent limits protection to the ornamental design of an article, and that a design containing numerous functional elements mandates a narrow claim construction. Accordingly, an ordinary observer would not have been deceived into thinking the

design of Stanley's hammers were the same as the patented design because the only similarities between Stanley's hammers and the patent design were functional elements. The overall effect of the streamlined theme of Stanley's hammers could not be found in the patent and hence could not cause market confusion.

In *i4i LP v. Microsoft Corp.*, Case No. 2009-1504, a revised opinion from a panel rehearing, the Federal Circuit held that Microsoft failed to challenge the district court's finding of willfulness on appeal and affirmed that finding.

i4i's patent relates to XML technology allegedly infringed by Microsoft in

products such as Word. On December 22, 2009 the Federal Circuit affirmed the district court's findings of no invalidity, willful infringement, and damages, including enhanced damages and issuance of a permanent injunction. In a single sentence in that opinion, the Federal Circuit held that Microsoft did not challenge the finding of willfulness.

Microsoft then requested a rehearing and rehearing en banc. The Federal Circuit granted Microsoft's petition for rehearing both for the panel and en banc. The panel rehearing was limited to revising the previous opinion, resulting in this opinion.

The Federal Circuit further explained its finding that Microsoft did not challenge the finding of willfulness. The Federal Circuit acknowledged that Microsoft challenged the enhanced damages award and requested "[JMOL] on the issue of willfulness." However, the Federal Circuit deemed this insufficient to constitute a challenge to the finding of willfulness, as these issues are distinct (willfulness being a prerequisite for enhanced damages). The Federal Circuit noted that Microsoft did not challenge the jury instructions or the basis for the jury's willfulness verdict.

Nevertheless, the Federal Circuit indicated that a reasonable jury could have concluded that Microsoft willfully infringed the patent based on the evidence presented at trial, citing numerous emails among Microsoft employees.

In *Laboratory Corp. of America Holdings v. Metabolite Laboratories, Inc.*, Case No. 2008-1597, the Federal Circuit transferred the appeal to the Tenth Circuit because the Federal Circuit lacked jurisdiction.

The district court granted summary judgment to LabCorp on a declaratory judgment claim that it did not breach a license agreement for failure to pay know-how royalties. A prior judgment had established that LabCorp infringed a Metabolite-licensed patent. Infringement of that patent was a prerequisite to the

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payment of know-how royalties under the license agreement.

On appeal, Metabolite argued that the Federal Circuit had jurisdiction because its hypothetical contract claim required proof of patent infringement and because the judgment would determine the res judicata effect of the prior judgment of infringement. Rejecting these arguments, the Federal Circuit found that infringement was undisputed, and, therefore, the claim did not present any disputed issue of patent law. The Federal Circuit held that it does not take jurisdiction over cases simply because they relate to the res judicata effect of its prior judgment.

In dissent, Judge Dyk argued that the Federal Circuit had jurisdiction because the question of infringement for some LabCorp products did not become undisputed until after the case was filed. Judge Dyk also would have held that a suit arises under the patent laws when the suit enforces or determines the res judicata effect of a prior judgment arising under the patent laws.

In *Delaware Valley Floral Group, Inc. v. Shaw Rose Nets, LLC*, Case No. 2009-1357, the Federal Circuit affirmed summary judgment of invalidity and affirmed denial of motion for reconsideration.

In response to interrogatories, Shaw stated that conception of its patent was in August 1995. Then, in a deposition, Shaw adamantly asserted that this was an error, that the process was invented in August 1994, and that sales of roses grown with the patented process began in September 1994. After the deposition, Shaw attempted to retract the deposition testimony with an errata sheet, but after the thirty days provided by Fed. R. Civ. P. 30. The plaintiffs therefore sought summary judgment of invalidity under the on-sale bar. Shaw responded by filing declarations in support of the 1995 conception date. The district court granted summary judgment in view of the deposition testimony, finding the errata sheet and declarations inadmissible. Shaw's motion for reconsideration, which included additional declarations, was also denied.

The Federal Circuit held that there was no abuse of discretion in denying the errata sheet and the summary judgment declarations because the Eleventh Circuit has held that a court may disregard an affidavit opposing a motion for summary judgment when the affidavit is directly contradicted by deposition testimony. The Federal Circuit also affirmed the denial of the motion for reconsideration because Shaw failed to show that the additional declarations filed with the motion for reconsideration were unavailable during the pendency of the summary judgment motion.

In *Marrin v. Griffin*, Case No. 2009-1031, the Federal Circuit affirmed the district court's grant of summary judgment of invalidity based on anticipation.

The preamble of Griffin's patent claims stated that the invention was directed to "[a] scratch-off marking label for permitting a user to write thereon without the use of a marking implement." The district court found that the preamble language was not limiting on summary judgment.

The Federal Circuit affirmed, stating that preamble language merely stating an intended use of the invention does not limit the scope of the claim. A patentee can use the preamble to distinguish the invention from the prior art if the patentee demonstrates clear reliance on the preamble language during prosecution. The Federal Circuit found that the Griffins did not do so. As such, the Federal Circuit concluded, the preamble language at issue was not limiting and the asserted claims were anticipated by the prior art.

In *Ariad Pharmaceuticals, Inc. v. Eli Lilly and Co.*, Case No. 2008-1248, the Federal Circuit affirmed the panel's reversal of the district court's denial of Lilly's motion for JMOL on invalidity, holding the patent claims at issue invalid for lack of written description, and affirming the panel's affirmation of the district court's finding of no inequitable conduct.

Ariad's patent claims "the use of all substances that achieve" a certain biochemical reaction. After a bifurcated trial, the patent was found infringed, valid, and enforceable. The district court denied a motion for JMOL on invalidity. On appeal, a panel of the Federal Circuit reversed the denial of the motion for JMOL, finding the claims invalid for lack of written description. The Federal Circuit granted en banc rehearing on (1) whether the written description requirement was separate from enablement, and (2) the scope of such a separate written description requirement.

(1) The Federal Circuit held that the written description requirement is separate from the enablement requirement. The Federal Circuit looked to the grammatical syntax of the statute, Supreme Court precedent such as *Festo*, and stare decisis as reasons for retaining a separate requirement.

The Federal Circuit noted that written description differs from enablement particularly when generic claims are at issue. Ariad argued that its originally filed claims inherently satisfied written description. The Federal Circuit disagreed. In its view, even an originally-presented generic claim may lack written description support if the specification fails to show "that the applicant has invented species sufficient to support a claim to a genus." The disclosure must include enough examples or common structural features to allow one of skill in the art to "visualize or recognize" the members of the genus."

(2) Regarding the scope of the written description requirement, the Federal Circuit upheld the prevailing standard of "possession of

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the invention,” but acknowledged that the word “possession” had “never been very enlightening.” Noting that the requirement is a question of fact, the Federal Circuit provided several guideposts. It stated that “a description that merely renders the invention obvious does not satisfy the requirement.” Generic claims that “merely recite a description of the problem to be solved while claiming all solutions to it” are unsatisfactory because they cover solutions not yet invented. The requirement “limits patent protection to those who actually perform the difficult work of ‘invention’ . . . and disclose the fruits of that effort to the public.” The Federal Circuit concluded that the jury lacked substantial evidence for its verdict that the asserted claims were supported by adequate written description, and thus held the asserted claims invalid.

In *Pressure Products Medical Supplies, Inc. v. Greatbatch Ltd.*, Case No. 2008-1602, the Federal Circuit vacated the district court’s finding of infringement, remanded in light of its claim construction, and affirmed the district court’s denial of motions for JMOL and leave to amend.

The trial judge *sua sponte* supplemented the *Markman* construction with a new definition in order to avoid jury confusion over the scope of corresponding structure under 35 U.S.C. § 112, sixth paragraph. The Federal Circuit noted that a “rolling claim construction” is permitted, and the new definition came early enough in trial to allow the defendant to adjust arguments. However, the Federal Circuit found the district court’s construction impermissibly expanded the corresponding structure to include structures that were not described in the specification, but rather described in prior art cited by the patent, but not explicitly incorporated by reference.

The defendant had moved for leave to amend to assert inequitable conduct based on a recent declaration concerning a reexamination. The district court’s scheduling order set a deadline for the plaintiff to submit final amended pleadings, but set no such deadline for the defendant. Accordingly, the district court applied Rule 15(a) and, based on likelihood of undue delay and prejudice to the plaintiff, denied the defendant’s motion, also noting that the defendant could have discovered the issue and brought its motion months ago. The Federal Circuit affirmed, noting the defendant had failed to meet its burden of showing abuse of discretion, and that recent Federal Circuit cases raising the standard of proof to invoke inequitable conduct would likely render the defendant’s motion to amend insufficient.

In *Enzo Biochem, Inc. v. Applera Corp.*, Case No. 2009-1281, the Federal Circuit affirmed-in-part summary judgment of invalidity or noninfringement on two patents and reversed-in-part on invalidity of two other patents.

Enzo’s patents relate to techniques for labeling and detecting nucleic acids, such as DNA and RNA. The district court granted summary judgment in favor of Applera that all asserted claims of Enzo’s patents were invalid as either indefinite or anticipated. In particular, the district court found that the claim phrase “not interfering substantially” was indefinite because a person of ordinary skill would not understand whether a linkage group interferes with hybridization “substantially.”

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Hatch-Waxman Bootcamp for OCPLA Members

A primer on IP basics and regulatory fundamentals relative to small molecules and biologics for brand names, generics, and biopharmas.

When: May 24-25, 2010

Where: The Hilton San Diego Resort & Spa

Cost: OCPLA Members are entitled to a \$400 discount off the regular registration price.

Enter “OCPLA” when registering.

Registering: <http://www.americanconference.com/HWBootCamp.htm>

Internet Sightings

By Jim Hawes

This column highlights some of the more notable recent internet notices, newsletters and blog postings dealing with IP prosecution issues. The IS column is now up and available at www.internetsightings.blogspot.com. Check it out.

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

The 3/1/10 newsletter presents a listing of recently-filed false marking cases. Hurry. Join the gold rush. You too can strike it rich.

Another 3/1/10 posting reports the election as President of the EPO of a candidate who opposes the Patent Prosecution Highway movement.

Still another 3/1/10 email reports the Media Tech CAFC decision holding a certain baseball playing cards patent invalid, one reason being that it “does not advance rocket science,” says Rader in dissent.

The 3/4/10 message reports an appeal to reverse a BPAI decision holding that failure to include a subgeneric claim is not a reversible “error.” Hal suggests two other routes to achieve the result desired here.

Another 3/4/10 email discusses the current and anticipated vacancies at the CAFC and, once again, repeal of the Baldwin rule.

The 3/8/10 news reported the Ajinomoto CAFC decision holding a patent invalid for failing to disclose the best strain of bacteria known to the patentee for a method of producing L-lysine using bacteria.

The 3/9/10 offering discusses the Richardson CAFC design patent holding of non-infringement, with guidance on evaluating a design patent incorporating both ornamental and functional elements. For a different view, see GrayonClaims for 3/10/10.

Another 3/9/10 email discusses PTO Director Kappos' ruling in Ex parte Frye setting a new standard for reversible error; no deference is to be given to an examiner's position on a contested issue. Some of the views are challenged in Hal's 3/10/10 email. See also Patently-O for 3/12/10.

The 3/10/10 email states that District Court Judge Kathleen O'Malley (ND Ohio) is the next CAFC nominee. See also Patently-O for 3/11.

The 3/22/10 message discusses the Ariad en banc CAFC decision confirming, among other things, that the written description requirement is separate from the enablement requirement. See also Pat-O for 3/23/10.

Another 3/22/10 posting discusses the Marrin CAFC decision holding a patent invalid where the only distinguishing factor was in the claims' preamble.

Still another 3/22/10 message reports that the PTO expects the present high rate of RCE filings to continue through FY2014.

In the 3/24/10 email Hal reports that the PTO has promised the Senate that if the present budget is approved it will be on the road to achieving a 12 mo. total pat. app. pendency by 2014. Hal considers this goal to be impossible under present law, and describes why. For more about the RCE problem see Hal's 3/26, 28 and 31 postings.

Another 3/24/10 email discusses the Pressure Products expanded panel CAFC decision holding a broad means element to be adequately supported by prior art cited in the patent's disclosure. See also GrayonClaims for 3/30/10.

The 3/29/10 blog reports that the PTO now has more than 1.2 million pending patent applications, including a first office action backlog of more than 700,000 cases.

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

The 3/1/10 blog discusses false marking, what's required to prove it, and the recent cases so holding.

The 3/3/10 email reports that first action restriction requirements in biotech applications rose from about 1,000 in 1993 to 21,911 in 2008 on a 30% rise in first office actions. The 3/4/10 blog quotes some observations on this topic by a biotech patent examiner.

Carl Oppedahl – emails of IP practice matters: carl@oppedahl.com.

The 3/20/10 email reports that six new free podcast patent bar review lectures have been published – check his message for a list of all those now available.

Patent Docs – a blog about patent cases – zuhn@mbhb.com

The 3/1/10 message discusses the In re Chapman CAFC decision and the standard for obviousness and for review of BPAI decisions.

The 3/22/10 blog reports various upcoming biotech IP conferences.

GrayonClaims blog – About much more than just claims – grayonclaims@gmail.com

The 3/3/10 blog discusses patent marking prospectors and 68 false marking lawsuits so far in 2010.

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The 3/5/10 email reports that the proposed patent reform legislation will now also end most false marking lawsuits.

The 3/18/10 message reports the Payrelevade BPAI decision holding certain claims broad enough to cover a signal to be non-statutory.

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

The Section’s eNews was published on 5/15/10. If you are not on the distribution list, you should be.



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

A 3/2/10 message reports the Supreme Court’s Reed Elseiver decision holding that the copyright registration requirement is not jurisdictional. The Association is holding its spring meeting on 5/6-8/10 at the NYC Marriott. Early registration discounts

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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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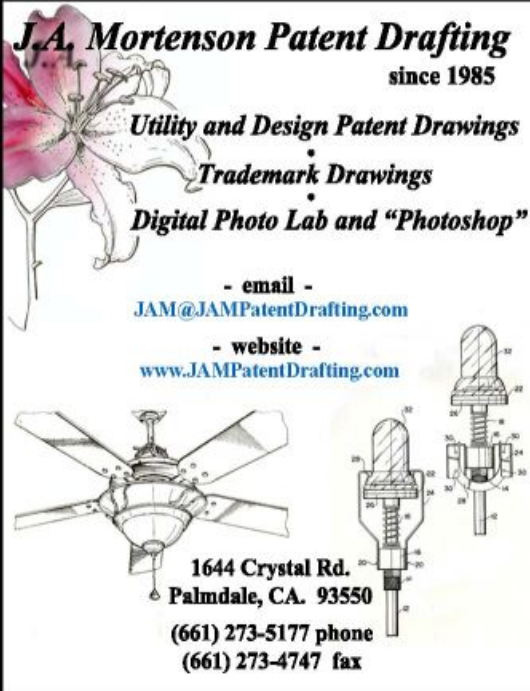
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If you would like to place an announcement or a help wanted advertisement in the OCPLA newsletter, please contact Alyson Barker at BarkerA@howrey.com.

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On appeal, the Federal Circuit held that Enzo's patents were not indefinite. The Federal Circuit noted that a claim cannot be both indefinite and anticipated. Here, the specifications cited examples of linkage groups that interfere with hybridization and ways in which polynucleotide properties can be used to measure this interference. Because it was possible to compare an experimental hybridization profile to the examples in the specification, it would not be up to the "subjective opinion of the particular chemist performing the hybridization" whether the claim limitation was satisfied. Accordingly, the Federal Circuit concluded that the patents sufficiently described the claim language "not interfering substantially" in regards to hybridization of nucleic acids.

The Federal Circuit additionally held that Enzo raised a genuine issue of material fact as to anticipation of two of the patents based on expert testimony. Enzo's expert opined that the relevant prior art did not have sufficient chemical rigidity to prevent "significant interference with hybridization" of nucleotides. By viewing this testimony in the light most favorable to Enzo, the Federal Circuit remanded for further proceedings. .

Finally, the Federal Circuit affirmed noninfringement of one of Enzo's patents, as it concluded that the district court correctly construed "non-radioactive moiety" as needing to be capable of indirect detection by a specific molecular complex.

In *Power-One, Inc. v. Artesyn Technologies, Inc.*, Case No. 2008-1501 and -1507, the Federal Circuit affirmed judgment of direct infringement of the asserted patent and failure by Artesyn to prove invalidity of the patent for obviousness.

Power-One held a patent directed to power supply systems that use regulators to supply power to the components in an electronic system. The jury found that Artesyn (1) directly infringed multiple claims of the patent; and (2) failed to prove that any asserted claims of the patent were invalid. The district court entered a permanent injunction.

On appeal, Artesyn challenged the district court's construction of the term "POL regulator" (point-of-load regulator). Artesyn also challenged the district court's denial of Artesyn's motion for JMOL that the asserted claims were invalid for obviousness.

Regarding claim construction, the Federal Circuit held that the terms "adapted to," "near," and POL were not indefinite because a person of ordinary skill in the field would understand the meaning. The fact that the terms "adapted to" and "near" are not defined using a precise numerical measurement did not render them incapable of providing meaningful guidance to the jury. The terms "adapted to" and "near" and POL, when taken in context of the entire patent, provides a sufficiently reasonable meaning to one skilled in the art of distributed power systems.

The Federal Circuit also determined that sufficient evidence supported the district court's finding that the scope of the prior art was limited, that there are significant differences between the invention disclosed in the patent and the prior art, and that the relevant

OCPLA Fall Seminar:



OCPLA is planning a half-day CLE seminar in the Fall. We welcome your input and ideas regarding possible topics and speakers. If you are interested in volunteering, please contact Tom Dao (tomhdao@koslaw.com).

Internet Sightings . . .

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end 4/19.

PTO – www.uspto.gov/main/newsandnotices

One of the results of the Trilateral Conf. in 2007 was that the PTO, EPO and JPO agreed to develop a common patent application format. That has been done, and the result is posted – see uspto.gov/web/patents/caf.

The PTO has released the first bimonthly issue of “Inventorseye,” an e-pub reporting happenings of interest to inventors. The first issue focuses on patent application scams.

The PTO has offered reissue best practices guidance in a 32 slide article by Stephen Kunin posted 3/10/10 – see Patentspostgrant.com.

WIPO – madrid@wipo.int

WIPO reported on 3/23/10 that for 2009 international patent filings were off 12% and international trademark filings 16%.

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

The 3/2/10 blog reports the Amazon TTAB interlocutory decision holding that objections to discovery must be made with specificity.

The 3/3/10 email reports that internet printouts are now admissible via a notice of reliance provided some minimal requirements are met.

The 3/5/10 message reports the Qualcomm decision holding that one must provide initial disclosures before moving for summary judgment per 2.127 (e)(1).

The 3/11/10 blog reports that a majority of a 5 judge panel found the mark KHORAN for wine to be disparaging.

The 3/23/10 email – what’s an “eBandage?”: I don’t know, but whatever it is the mark has been held to be descriptive by the TTAB.

Other Stuff –

Chief Judge Paul Michel of the CAFC is retiring on 5/31/10.

The India Patent Office has published a new draft Manual Of Patent Practice and Procedure.

Stafford will be offering a 1 ½ hour webinar on 4/14/10 about “Obviousness post-KSR.”

IPFrontline.com published an article “Seven IP Sins Tech Startups Must Avoid” by Rally Patel on 3/29/10.

The 12th Comprehensive PCT Seminar will be held on 4/23-24 at the Franklin Pierce Law Center, Concord, NH, for those who like old snow.

The 2nd Annual Corporate Counsel Summit will be held on 4/27-28 in NYC for those who like monetizing IP.

GW’s Law School Symposium on IP will be held 5/11/10 with an “all star” cast of speakers.

The European Communities Trademark Assn. will hold its annual conference in Barcelona on 6/15-19/10.

Ever wonder what “unauthorized whimsy” might be? If you have, check out the dissent in *Ex parte Shnittgrund* (BPAI, 3/9/2010).

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

