



# OCPLA NEWSLETTER

Orange County Patent Law Association  
[www.ocpla.org](http://www.ocpla.org)

Vol. 14, No. 11

November 2008

## OCPLA 2008 HOLIDAY PARTY

The OCPLA 2008 Holiday Party will be held on December 4, 2008 at Sage on the Coast. Sage on the Coast is located in the Crystal Cove Promenade, 7862 East Coast Hwy. in Newport Beach, California.

As with the Lunches, reservations will be made online via the OCPLA's website at [www.ocpla.org](http://www.ocpla.org). A copy of the menu is attached. The cost is \$75.00. Menu selections will be made at the event. We look forward to seeing you all there!

## OCPLA SCHOLARSHIP

We are pleased to announce that Kelly Nguyen of Whitter Law School has been awarded the OCPLA Scholarship. Kelly will be attending the holiday party and looks forward to meeting everyone.

## 2009 OCPLA MEMBERSHIP RENEWAL

Membership for 2009 is now available online only. At the time of registration, payment can be made using a credit card or a PayPal account. Please register early. Go to [www.ocpla.org](http://www.ocpla.org) and click on the "Membership App" link on the left hand side of the screen. If you have any questions regarding 2009 membership applications or renewals, please contact Marlene Klein [marlene.klein@cda.canon.com](mailto:marlene.klein@cda.canon.com).

## INTERNET SIGHTINGS BY JIM HAWES

What follows are some of the more notable recent internet notices, newsletters and blogs dealing with IP prosecution issues. It is a distillation by this publication's editor of the submitted IS column.

If you would like to receive the full column directly by email, write [onejehawes@aol.com](mailto:onejehawes@aol.com) or subscribe at [www.internetsightings.com](http://www.internetsightings.com).

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

- The 10/2/08 newsletter attaches a Powerpoint presentation of the issues presented by deferred examination, the core issue of patent reform.
- The 10/3/08 email discusses the Impax Labs CAFC decision holding that a cited prior art was not enabling, applying an 8 factor test, and thus not anticipatory.
- The 10/6/08 offering discussed recent denials of cert, and presents his current top 10 list. See also his emails for 10/10, 10/15, 10/23 and 10/31.
- Another 10/6/08 email reports that both current and past versions of the MPEP are now available on the PTO website for downloading.
- The 10/9/08 newsletter discusses the Predicate CAFC decision chastising counsel for bad English usage.
- The 10/10/08 email discusses the Technology Licensing CAFC decision re establishing priority under sec. 120,

and the adequacy of a written description under sec. 112.

- A 10/15/08 offering attaches Hal's PowerPoint LES presentation re the eBay and Quanta licensing decisions of the CAFC.
  - The 10/16/08 blog reports that the PTO has filed its reply brief in the Tafas case, and attaches a copy. Also, it gives the web address for a detailed analysis of the case.
  - The 10/20/08 email discusses the NetMoney CAFC decision holding that a means element was not properly supported in the disclosure.
  - The 10/21/08 message discusses the Tzipori CAFC decision criticizing the appellant for arguing evidence not before the BPAI, apparently a common problem with appeals today.
  - The 10/27/08 blog reports that the PTO, at the recent AIPLA annual meeting, acknowledged that the proposed IDS and Markush claiming rules (the Tafas case) are dead as a practical matter.
  - The 10/29/08 email reports the Systems Division CAFC decision sanctioning the appellant for a frivolous appeal after being warned.
  - The 10/30/08 message reports the long awaited Bilski CAFC en banc decision holding that patent eligibility under sec. 101 is established either if the claimed business method invention is significantly tied to a machine or if it significantly transforms an article.
  - The 10/31/08 email discusses the Amazin' Rasins CAFC decision in which the Court again refused to rewrite unambiguous claims.
- Patently-O** – a blog written by Dennis Crouch – [www.patentlyo.com](http://www.patentlyo.com).
- The 10/6/08 blog discusses a recent state of the CAFC report, including some excellent advice for appellants.
  - The 10/7/08 email reports that the defendant in the Aristocrat case (see the Daily Dose for 10/6 below) has petitioned the CAFC for an en banc hearing. Hopefully it will be granted. A copy of the petition is posted on this website.
  - The 10/9/08 blog invites those who don't like the new BPAI rules to join in an effort to have them rejected by the OMB.
  - The 10/10/08 message reports that ABC is looking for a superstar family of inventors for its Wife Swap show, and will pay. See, you can make money reading this digest.
  - The 10/13/08 message reports the Cohesive Tech. CAFC case holding that novelty and non-obviousness are separate inquiries: a patented invention may be anticipated but non-obvious.
  - The 10/15/08 email give the web addresses for 15 amicus briefs in the Tafas case before the CAFC.
  - Another 10/15/08 posting reconsiders the scope of prior art as prompted by the Cohesive Tech CAFC decision.
  - The 10/20/08 message discusses the Wyeth DDC decision and the calculation of patent term adjustments.
  - Another 10/20/08 posting discussed the NetMoney CAFC holding that, to anticipate under sec. 102, a reference must not only disclose all the claimed elements but also in they must be in the claimed arrangement.

- The 10/23/08 blog discusses the Yamaguchi BPAI decision holding that a published application is a reference as of its provisional filing date.
- The 10/26/08 posting reports the New Medium (ND III) decision holding that failure to disclose a prior association between the inventor and an expert submitting a declaration to the PTO was sufficient to establish inequitable conduct.
- The 10/29/08 message reports that Professor Lichtman is offering free IP-CLE Credit. Listen online: [www.ipcolloquium.com](http://www.ipcolloquium.com)

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

- The 10/1/08 newsletter includes a guest column discussing the impact of the recent Egyptian Goddess CAFC decision holding that a “point of novelty” test for design patent infringement is no longer applicable.
- The 10/2/08 email reports that a trial partnership adding the EPO to the USPTO’s patent prosecution highway has begun.
- The 10/3/08 offering reports that malpractice claims are on the rise for such things as failing to follow a client’s instructions. So remember, always CYA.
- The 10/6/08 guest column discusses a little known federal statute prohibiting the marketing of goods in a way falsely suggesting an American Indian origin, thereby creating a “staggering liability.”

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

- The 10/6/08 email discusses the Aristocrat CAFC decision holding that

once the PTO revives an application, that action may not be challenged. Wow.

- The 10/8/08 blog discusses a trademark application consistency review option by the PTO for those with multiple applications.
- The 10/14/08 message reports that WIPO has added five new courses to its distance learning Worldwide Academy.
- The 10/22/08 dose announced that the Korean IPO has been added to the PTO’s direct priority document exchange program, joining the EPO and JPO.
- The 10/27/08 blog reports that the Danish PTO has been added as the eighth Office on the PTO’s patent prosecution highway program.
- The 10/29/08 email discusses fraud on the Copyright Office, something those registering copyrights should study.

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

- The State Bar IP section is holding its Annual Institute in the Palm Springs area on Nov. 6-8, '08.
- On 10/21/08 the IP section announced formation of an in-house counsel committee.

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

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

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

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

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

#### Other Stuff –

- Law Seminars Int'l. has announced a patent marketing conference in San Francisco on Jan. 29-30, 2009.
- LSI also announced a commercialization of life sciences conference on Jan. 29-30/08 in Phoenix.
- The SDIPLA is hosting a PTO Tech Center 1600 (pharmaceuticals, biologicals and chemicals) all day Road Show at UCSD on 11/14/08.

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

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| <p><b>RECENT IP CASES<br/>BY IRFAN LATEEF<br/>KNOBBE, MARTENS, OLSON &amp; BEAR</b></p> |
|---|

In *In re Alonso*, Appeal No. 2006-2148, the Federal Circuit affirmed the decision of the Board of Patent Appeals and Interferences (BPAI) rejecting Claim 92 for lack of adequate written description.

The claim recited a method of treating neurofibrosarcoma by administering a MAb “idiotypic to the neurofibrosarcoma” and “secreted from a human-human hybridoma derived from the neurofibrosarcoma cells.” The specification recited an experiment depositing and describing only one hybridoma which was derived from a single patient’s carcinoma.

The Board held that the MAb secreted by the one hybridoma was insufficiently representative to provide adequate written descriptive support for the genus of antibodies claimed, because the claim more generally

encompassed MABs that bind to a neurofibrosarcoma and was not limited to the MAb described.

The Federal Circuit agreed, noting that a genus can be described by disclosing (1) a representative number of species in the genus or (2) its relevant identifying characteristics. Because antibodies within the genus would be expected to vary substantially, the one described MAB was not sufficiently representative. The specification also failed to teach any relevant identifying characteristics of antibodies implicated by the method. Therefore, a claim to the genus lacked sufficient written description.

In *In re Bilski*, Appeal No. 2007-1130, the Federal Circuit affirmed the BPAI’s decision to sustain rejections under 35 U.S.C. § 101.

The claims related to methods of hedging risk in the field of commodities. The Board concluded that the claims did not involve any patent-eligible transformation, that the claims covered an abstract idea, and that the claimed methods did not produce a “useful, concrete and tangible result.” The board therefore sustained the examiner’s rejection under § 101.

The Federal Circuit agreed that the claims were not patentable subject matter under § 101 because the claims would effectively preempt the use of the fundamental principle of hedging. The court, relying on *Gottschalk v. Benson*, concluded that the claims (1) were not tied to a particular machine or apparatus, and (2) did not transform a particular article into a different state or thing. Therefore, the claims did not recite patentable subject material under § 101.

The court revisited the *Freeman-Walter-Abele* test (determining whether an “algorithm” is “applied in any manner to physical elements or process steps”) and the “useful, concrete and tangible result” test relied on in *State Street* and *AT&T*. The court found both tests inadequate to determine whether a claim recited patentable subject matter. Instead, the

court adopted the Gottschalk machine-or-transformation test as the applicable test for process claims under § 101.

The court stated that the transformation portion of the test is satisfied when a process transforms an article into a different state or thing. The transformation must be central to the purpose of the claimed process. The article must be (1) a physical object or substance, or (2) a representation of a physical object or substance. Electronic data that represents the structure of a physical object is a representation of the object.

The court determined that the claimed processes recited manipulations of public or private legal obligations, business risks, and other abstractions. Such abstractions did not meet the transformation portion of the test because they were not (1) physical object or substances, or (2) representative of physical objects or substances. The processes encompassed the exchange of commodities options, which are legal rights, not representations of physical objects. The applicant also conceded that the claims were not tied to a particular machine or apparatus.

Three dissents issued with the opinion. Judge Newman argued for a broad interpretation of § 101, stating that neither the statute nor Supreme Court precedent required the result reached by the court. Judge Mayer argued that the claims should not be patent eligible because they were “business methods,” which should be categorically excluded from eligibility under § 101. Finally, Judge Rader argued the court improperly relied on Supreme Court dicta no longer applicable in the current technological environment.

In a concurring opinion, Judge Dyk examined the legislative history of § 101 and argued that methods for organizing human activity that do not involve manufactures, machines, or compositions of matter within the scope of patentable subject material are not included under § 101.

In *Abbott Laboratories v. Sandoz*, Appeal No. 2007-1300, the Federal Circuit affirmed the

district court’s decision to grant a preliminary injunction against generic drug manufacturer Sandoz.

Abbott, the owner of the asserted patents on extended release formulations of the antibiotic drug clarithromycin (Biaxin® XL), filed an infringement suit against Sandoz after the FDA granted Sandoz’s ANDA for its own extended release formulation. After motion by Abbott, the district court granted a preliminary injunction against Sandoz, and Sandoz appealed.

In reviewing Abbott’s likelihood of success on the merits, the court analyzed each of Sandoz’s defenses, including invalidity based on anticipation and obviousness, unenforceability based on inequitable conduct, and noninfringement. With respect to anticipation, the court discerned no clear error in the district court’s conclusion that the asserted claims were not anticipated by a prior art reference that neither described the product of the asserted claims nor enabled the claimed pharmacokinetic properties set forth in the asserted claims.

The court also found no clear error in the district court’s conclusion that the claimed in vivo extended release properties for clarithromycin were sufficiently dissimilar to or unpredictable from the prior art in vitro controlled released data for azithromycin. A person of ordinary skill in the art would not have had the degree of confidence of success in transferring the prior art formulation to the different systems of clarithromycin as would render the asserted claims obvious.

The court also found no clear error in the district court’s conclusion that Sandoz was not likely to succeed in establishing inequitable conduct. Each evidentiary ground of inequitable conduct asserted by Sandoz was found to lack evidence supporting either materiality or intent to deceive the PTO.

The court further agreed with the district court that the construction of the claim term “pharmaceutically acceptable polymer” should not be limited to the polymers listed in the

specification, as that list did not negate the broader description of the term also contained in the specification. As a result of this construction, the majority found no clear error in the district court's conclusion that Abbott had shown a reasonable likelihood of proving infringement.

The court also found no clear error in the district court's conclusion that the equitable factors of irreparable harm and balance of hardships, which are relevant to the grant of a preliminary injunction, weighed in favor of Abbott. The fact that two generic drug producers were already in the market did not negate the potential loss of market share and revenue that resulted from Sandoz's entry while litigation proceeded. Furthermore, with respect to the public interest factor, the court agreed that the incentive for discovery and development of new products outweighed the public interest in the availability of less expensive forms of medicines.

In *Net MoneyIN, Inc. v. VeriSign, Inc.*, Appeal No. 2007-1565, the Federal Circuit affirmed the grant of summary judgment of invalidity for indefiniteness, affirmed the denial of NMI's motion to amend, and reversed the grant of summary judgment of invalidity for anticipation.

NMI obtained patents directed toward processing credit card transactions over the Internet and subsequently filed an infringement suit against a number of parties, including VeriSign. Following claim construction, the district court granted VeriSign's motions for summary judgment stating that NMI's patents were invalid and that VeriSign did not induce infringement. The court also denied NMI's motion for leave to amend its complaint to add an inducement claim. NMI appealed the summary judgment of invalidity and denial of its motion.

Regarding invalidity due to indefiniteness, the patents included means-plus-function claims implemented on a computer. Citing *Aristocrat Techs.*, the Federal Circuit stated that in cases involving computer-implemented inventions, the disclosed structure must be more than simply a general purpose computer or

microprocessor. Simply disclosing the computer did not limit the scope of the claim as required by § 112 ¶ 6. The disclosed structure should instead be the special purpose computer programmed to perform the disclosed algorithm. The patents-in-suit failed to disclose structure as a component of a computer for performing the claimed functions. Therefore, the district court correctly concluded that the claims, including the means-plus-function elements, were indefinite under § 112 ¶ 2.

Regarding invalidity due to anticipation, the district court had found the patents-in-suit were anticipated because a single prior art reference disclosed every element of the claimed invention. The Federal Circuit reversed because the prior art reference did not disclose those elements as "arranged in the claim." The opinion cited several examples of cases interpreting "arranged in the claim" to hold that unless a reference disclosed, within the four corners of the document, not only all the limitations claimed but also all of the limitations arranged or combined in the same way as recited in the claim, it cannot be said to prove prior invention of the thing claimed and, thus, cannot anticipate under § 102.

Regarding the NMI's motion for leave to amend, the Federal Circuit affirmed, holding that the district court acted within its discretion in finding that VeriSign sought summary judgment on the ground of waiver and the grant of NMI's motion would result in extreme delay and severe prejudice to VeriSign.

In *Minks v. Polaris Industries*, Appeal No. 2007-1490, the Federal Circuit vacated the district court's judgment on damages and remanded for a new trial on damages. The court further affirmed the district court's award of attorney fees, the jury verdict of infringement, and the jury verdict of willfulness.

The jury awarded over \$1 million in compensatory royalty damages to the plaintiff, but the district court reduced this amount to less than \$30,000 without offering the plaintiff the option of a new trial. The Federal Circuit held that while a district court can reduce

damages based on legal error without offering the option of a new trial, the Seventh Amendment prohibits a district court from reducing damages on the basis of the sufficiency of the evidence without offering the option of a new trial.

The Federal Circuit affirmed the district court's award of only half the reasonable attorney fees on the ground that the plaintiff was "unable or unwilling to articulate a coherent damages theory." The court also held that the district court's jury instruction on actual notice of infringement did not properly articulate that knowledge of a specific infringing device is not a legal prerequisite to a finding of actual notice.

In *In re Ciprofloxacin Hydrochloride Antitrust Litigation*, Appeal No. 2008-1097, the Federal Circuit affirmed grant of summary judgment by the district court. The Federal Circuit held that the reverse payments from the patent holder to the generic drug manufacturer did not violate antitrust laws.

Generic drug manufacturer Barr challenged the validity of a ciprofloxacin (Cipro®) patent owned by Bayer. Just before trial, Bayer agreed to make periodic payments to Barr ("reverse payments") in exchange for settlement and an agreement by Barr that the drug covered by their ANDA infringed certain Bayer patents. Consumers filed antitrust actions, alleging that the agreement was an illegal restraint on trade in violation of sections 1 and 2 of the Sherman Act.

Applying a rule-of-reason analysis, the Federal Circuit analyzed whether the agreements restricted competition beyond the "exclusionary zone" of a patent. The district court found that the reverse payments in the settlement agreement did not constitute anticompetitive behavior. Further, absent an allegation of inequitable conduct or sham litigation, the court did not need to consider the validity of the underlying patent in its antitrust analysis of reverse payment settlements.

In *Kyocera Wireless Corp. v. International Trade Commission*, Appeal No. 2007-1493, the Federal Circuit vacated and remanded the

ITC's finding of inducement and the ITC's Limited Exclusion Order (LEO).

The ITC found that Qualcomm had infringed certain Broadcom patents on an inducement theory and issued a limited exclusion order against imports by Qualcomm and its customers.

The Federal Circuit remanded the ITC's finding of inducement because the ITC had applied an incorrect standard of inducement based on a lower level of general intent. It required the ITC to look for specific intent to cause infringement on remand.

Further, the court vacated the ITC's LEO because the ITC lacked the authority to issue an LEO against non-respondents under 19 U.S.C. §1337(d). Broadcom must either include Qualcomm's customers in the case or it must apply for a General Exclusion Order and meet its higher requirements.

In *Technology Licensing Corp. v. Videotek Inc.*, Appeal No. 2007-1441, the Federal Circuit affirmed the district court's judgment of invalidity of the asserted claims of the '250 patent on anticipation grounds, enforceability of the remaining claims of the '250 patent, non-infringement of the '869 patent, and validity of claim 31 of the '869 patent.

The '869 patent issued from an application filed in 1992. The '250 patent issued from a CIP application filed in 1995.

The Federal Circuit affirmed the holding that the asserted claims of the '250 patent are anticipated by a prior art reference published in 1993. The court agreed that the new matter recited in the asserted claims is not supported by the 1992 disclosure and that the patentee has the burden of persuasion to prove it was entitled to the earlier filing date.

The court affirmed the holding that the remaining claims of the '250 patent are enforceable.

The court also affirmed the holding that the '869 patent was not infringed and that the disclosure recited an adequate structure

corresponding to the claimed function of claim 31.

In *Asyst Technologies Inc. v. Emtrak Inc.*, Appeal No. 2007-1554, the Federal Circuit affirmed the grant of JMOL by the district court that certain asserted claims were obvious.

After trial, the defendants moved for JMOL that the asserted claims were invalid due to obviousness, and the district court granted the motions.

The Federal Circuit affirmed the district court's decision, holding that the jury was incorrect in concluding that the Hesser patent was not relevant prior art. As admitted by Asyst's expert witness, the communication means disclosed in the Hesser patent implicitly involved a sensing means, thereby meeting the limitation of the asserted claims. Further, Asyst's evidence of commercial success and long felt need was insufficient to rebut obviousness. The evidence lacked a nexus with the inventive features not disclosed in the Hesser patent.

In *Predicate Logic, Inc. v. Distributive Software Inc.*, Appeal No. 2007-1539, the Federal Circuit reversed and remanded the district court's grant of summary judgment for invalidity.

The district court originally granted summary judgment for invalidity, finding that reexamination amendments improperly broadened the scope of Claim 1.

The Federal Circuit found the claim was not broadened because no method could infringe the amended claim language "comprising...at least one said index" without also infringing the original claim language "comprising...said at least one index." The reasoning was based on the open-endedness of the term "comprising."

The district court had also concluded that amending "instantiating" to "first instantiating" and "second instantiating" substantively changed the claim. The Federal Circuit disagreed, citing the fact that another limitation in the claim already required a first and second instantiation.

In *Cohesive Tech. Inc. v. Waters Corp.*, Appeal No. 2008-1029, the Federal Circuit reversed the district court's judgment of literal infringement by certain products and the district court's finding of no anticipation. The Federal Circuit vacated the district court's finding of no actual damages; affirmed the judgment of infringement by other products, no inequitable conduct, no willful infringement, and no enhanced damages; and denied the appellant's motion to reassign the case.

The asserted patents at issue related to high-performance liquid chromatography used, for example, in pharmaceuticals testing.

The district court first granted judgment as a matter of law that the asserted patent claims were not anticipated. The district court concluded that the anticipation case was "iffy" and that the defendants would not be prejudiced by the court's decision on anticipation because the jury was to decide obviousness. The Federal Circuit reversed, noting that the tests for anticipation and obviousness were distinct, and that anticipation must be presented to the jury.

On the issue of inequitable conduct, the Federal Circuit refused to reverse the district court's finding that there was no deceptive intent where the prosecuting attorney and expert both believed the undisclosed information to be immaterial.

The Federal Circuit also construed the word "about," explaining that courts must look to the function served by the element of the claim to determine the scope of the term. The Federal Circuit relied on the specification to determine that "about 30 micrometers" means, within limits, dimensions that provide adequate turbulent flow as discussed in the specification. The court remanded to the district court to determine what dimensions satisfied that requirement. The Federal Circuit noted, however, that because the word "about" brought functional equivalents within the literal scope of the claim, the doctrine of equivalents was unavailable with regard to that element.

Judge Mayer dissented on the issue of anticipation. In his view, a finding of nonobviousness should preclude a finding of anticipation. He would have affirmed the district court's grant of judgment as a matter of law for no anticipation.

In *Impax Laboratories Inc. v. Aventis Pharmaceuticals Inc.*, Appeal No. 2007-1513, the Federal Circuit affirmed the district court's judgment that a prior art patent did not anticipate the asserted claims because the prior art reference was not enabling.

Aventis owns a patent that is related to the use of riluzole to treat ALS (Lou Gehrig's disease or amyotrophic lateral sclerosis). In 2001, Impax filed an ANDA with the FDA seeking approval to market generic riluzole, asserting that the patent was invalid because it was anticipated by the prior art.

The Federal Circuit held that the district court's application of the *Wands* factors (regarding enablement) properly supported its conclusion that one of skill in the art reading the prior art patent specification would have need to perform undue experimentation to gain possession of the claimed invention. Specifically, the prior art patent merely provided broad and general dosage guidelines, no working examples, and no guidance on a treatment regiment. Thus, it was not an enabling reference.

In *The John Hopkins University v. Datascope Corp.*, Appeal No. 2007-1530, the Federal Circuit reversed the district court's judgment of infringement.

The patents related to methods for mechanically fragmenting blood clots. The district court instructed the jury that the claims required that a fragmentation member "expands and adjusts to remain in contact with the inner lumen in three dimensions along its length and width." Both parties agreed to the instructions, and the jury found infringement.

The accused device rotates a single "S" shaped wire. Finding the plaintiff's expert testimony to be contradictory, the court found

that the plaintiff failed to show that the S-wire expanded prior to rotation and that it remained in contact with the inner lumen in three dimensions, as required by the claims. Although the court indicated that the expert's statements may have supported a finding under the doctrine of equivalents, it noted that the plaintiff did not present the particularized testimony and linking argument necessary to support such a finding.

**AUSTRALIAN PATENT LAW  
By BILL BENNETT  
PIZZEYS PATENT & TRADEMARK ATTORNEYS**

Bill Bennett of Pizzeys Patent & Trademark Attorneys has written a textbook relating to Australian Patent Law. A pdf version of the book can be viewed at <http://www.pizzeys.com.au/Articles/Australian%20Patent%20System%20Guide>. It can also be viewed at the Pizzeys website <http://www.pizzeys.com.au>.

For more information, please contact Bill Bennett at [bbennett@pizzeys.com.au](mailto:bbennett@pizzeys.com.au).

**NEWSLETTER VIA EMAIL ONLY**

**The OCPLA Newsletter is 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 Stacey Halpern at [ocpla@kmob.com](mailto:ocpla@kmob.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; and
- (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.

### BOARD OF DIRECTORS AND COMMITTEE CHAIRS

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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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**SERVICES, ANNOUNCEMENTS, WANT ADS**

Press Release

**KLEIN, O'NEILL & SINGH, LLP ANNOUNCES SIGNIFICANT EXPANSION**

Irvine, CA (October 29, 2008) — Klein, O'Neill & Singh LLP, an Irvine intellectual property law firm, has significantly strengthened and broadened its capabilities with the addition of attorneys in the patent prosecution field.

Since this past May, former Christie, Parker & Hale partners Daniel Cavanagh and Tom Dao have joined the firm as partners, along with patent agent Bridgette Phan, Ph.D.

"We are extremely excited about the addition of these highly experienced patent prosecutors," said Howard Klein, a founding partner at Klein, O'Neill & Singh LLP. "Their depth of knowledge and breadth of experience in a wide range of technologies and diverse IP transactions will strengthen our core competencies."

"I am delighted to join a growing Klein, O'Neill and Singh," said Cavanagh. "Klein, O'Neill & Singh's focus on delivering exceptional legal service in IP matters in a collegial professional environment provides a unique opportunity to expand the service and support I can give to my clients. I am very excited to be part of this dynamic team."

Mr. Cavanagh has over 11 years of experience as an IP lawyer. His expertise includes Strategic Patent Prosecution, Intellectual Property Counseling, and Litigation Support Services. He has extensive technical and background knowledge in the electrical and software fields. He counsels domestic and international clients from start-ups to large multi-national corporations with an emphasis on the procurement and exploitation of high technology intellectual property assets. Mr. Cavanagh earned his engineering degree from Harvey Mudd College and worked a number of years for Hughes Aircraft Co. prior to receiving his JD from the University of Southern California. He is registered to practice before the United States Patent and Trademark Office.

Tom Dao concentrates his practice on medical device technology, oil and gas machinery and green technologies after 9 years of experience in IP law. His expertise includes domestic and foreign intellectual property counseling, litigation support, patent prosecution, licensing and opinions. Mr. Dao received his JD from Western State University, his BSME from UC Irvine, and is registered to practice before the United States Patent and Trademark Office.

Dr. Brigitte Phan's patent prosecution practice includes a variety of technologies, with an emphasis on life sciences, Biotechnology, Chemical Arts and Medical devices. Dr. Phan formerly served as the Director of Chemistry for Burstein Technologies, Inc. and at FastraQ Inc. directed the research and development of medical assays on proprietary platforms. Dr. Phan received her MS and PhD in Biochemistry from UCLA. Dr. Phan is registered to practice before the United States Patent and Trademark Office.

**About Klein, O'Neill & Singh LLP**

Klein, O'Neill & Singh LLP specializes in the Intellectual Property law. Our attorneys have extensive expertise in various aspects of IP law in diverse technology areas. Our technical expertise includes medical devices, imaging, electronics, computers (software and hardware), semiconductor processing, Internet, advanced telecommunication arts (including wireless communications), industrial processes and systems, and other areas. Our attorneys have technical degrees from some of the best institutions; years of business and legal experiences with some of the best-known international companies and prestigious law firms. Our client base includes start-up to multinational global corporations.

Guided by our value driven principles of high service and quality standards, we are committed to provide our clients with legal services efficiently while meeting the highest standard of quality and professionalism. For additional information, please visit our Web site at [www.koslaw.com](http://www.koslaw.com).

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### **Business Development Patent Attorney**

Intellectual property law firm in Irvine, California seeks attorney for Business Development and Patent Prosecution position. **Position can be business development only or a combination of business development and case work.** This position will be responsible for developing new business in litigation and patent prosecution areas by establishing, maintaining and growing relationships with key decision-makers at medium to large size corporations.

Qualified candidate must have experience in patent prosecution with a technology background (minimum 10 years preferred). Experience as corporate counsel a plus. Ideal candidate must possess excellent communication skills and be professional, charismatic, and self-motivated. Prior business development experience preferred.

Position requires the ability to prospect via phone, email or other medium, face-to-face sales calls, interaction with clients and potential clients at networking events, and the ability to work independently and as a team player. Please send resume to [sbowen@shimokaji.com](mailto:sbowen@shimokaji.com).  
03/09

### **Patent Counsel**

LS9, Inc., the Renewable Petroleum Company™, has an opening for a Patent Counsel. LS9 is a privately-held industrial biotechnology company based in South San Francisco, California that develops patent-pending biofuels made with the power of synthetic biology.

The Patent Counsel's primary responsibilities will include all aspects of intellectual property counseling related to LS9's product development and technology innovation efforts. In particular, the Patent Counsel will:

- \* Draft patent applications and manage outside counsel involved in drafting;
- \* Prosecute patent applications, both in the United States and internationally, and manage outside counsel involved in prosecution;
- \* Participate in the formation and implementation of policies, procedures/guidelines related to intellectual property protection;
- \* Participate in developing and implementing a corporate IP strategy;
- \* Review and analyze competitor patents and competitor technology and provide analysis for developing both defensive and offensive IP strategies;
- \* Provide advice on LS9 product and technology development in light of the competitive IP landscape;
- \* Provide legal counsel regarding infringement and validity issues, and patentability of new products and technologies;
- \* Keep up to date and knowledgeable concerning third-party IP and industry IP trends, caselaw and other legal development; and
- \* Provide education at various company functions and facilitate the integration of corporate IP strategy company-wide.

#### **Minimum Requirements:**

The candidate must have a J.D. with four to eight years of experience as a patent attorney primarily engaged in patent prosecution, either in a biotech corporate setting or in a law firm servicing such clients; and Be admitted to practice before the U.S. Patent and Trademark Office and a state bar number is required. An advanced degree in Molecular Biology or Biochemistry is desirable but not required.

Individuals who are interested in applying for the position can e-mail their resume in MS Word, RTF, HTML, or ASCII to [26058-CJB-0@ls9.hrmdirect.com](mailto:26058-CJB-0@ls9.hrmdirect.com).

For more information about LS9, please visit our website: [www.ls9.com](http://www.ls9.com).  
11/08

**2008 OCPLA EVENTS SCHEDULE**

| <b>Date</b>      | <b>Location</b>   | <b>Speaker/Event</b>          | <b>Topic</b>        |
|------------------|-------------------|-------------------------------|---------------------|
| December 4, 2008 | Sage on the Coast | 5:30 Cocktails<br>6:30 Dinner | OCPLA Holiday Party |

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