



OCPLA NEWSLETTER

Orange County Patent Law Association

www.ocpla.org

February 2009

THURSDAY, FEBRUARY 19, 2009 LUNCHEON

Erwin Chemerinsky, Dean of the University of California, Irvine School of Law, will speak on "Perspectives on the U.S. Supreme Court and the future of UCI's Law School: Shaping the future of intellectual property law in Orange County." The luncheon will be held at the Sports Club/LA Orange County. Please register online by close-of-business Monday, February 16, 2009. We are very pleased to be hosting Dean Chemerinsky and look forward to seeing you there.

As a reminder, the OCPLA monthly luncheons will now take place at the Sports Club/LA Orange County, 1980 Main St., Irvine, California 92614.

Registration and payment for OCPLA luncheons must be made online ONLY at www.ocpla.org. Payment must be made at the time of registration using a credit card or a PayPal account.

PLEASE RSVP ON TIME FOR MONTHLY LUNCHEONS

To ensure adequate seating at our monthly luncheons and to reduce the likelihood of rate increases, please register no later than close-of-business on the Monday preceding the luncheon. Your efforts to register within this timeline are greatly appreciated by the host facility and the OCPLA board.

FEBRUARY BOARD MEETING

The February 2009 OCPLA board meeting will be held Thursday, February 19, 2009, 11:00 AM at the Sports Club/LA Orange County prior to the February luncheon. Members who wish to present items for the Board's consideration should contact our president, TJ Singh, at tjsingh@koslaw.com to have their items placed on the agenda, and to verify the time and location of the meeting.

2009 OCPLA MEMBERSHIP RENEWAL

Membership for 2009 is now available online only. Payment must be made at the time of registration using a credit card or a PayPal account. Go to www.ocpla.org and use the "Membership App" link on the left column. If you have any questions regarding 2009 membership applications or renewals, please contact Tom Dao at tdao@koslaw.com.

NEW MEMBERS

We are pleased to welcome the following new member(s) to OCPLA:

David Choi (student – Cal. State Fullerton)

Michael Christensen (Knobbe, Martens, Olson & Bear LLP)

Robert Copeland (The Boeing Company)

Marcus Dawes (Law Offices of Daniel Dawes)

Aaron Fong (Cislo & Thomas LLP)

Tim Hsieh (Greenberg Traurig)

Mark Kertz (VNUS Medical Technologies Inc.)

Kenny Masaki (International Knowledge Asset Office)

Aaron McGushion

Nicholas Myers (Burkhalter Kessler Goodman & George)

Keith Newbury (Edwards Lifesciences Corporation)

Terry Tullis (Knobbe, Martens, Olson & Bear LLP)

Alison Vass (J. Mark Holland & Associates)

Kevin Welch (Law Office of Kevin M. Welch)

Please encourage your colleagues to renew their OCPLA membership or to join as new members!

INTERNET SIGHTINGS

BY JIM HAWES

This column highlights some of the more notable recent internet notices, newsletters and blogs dealing with IP prosecution issues. The full IS column, with compilations of some of the sources such as Hal Wegner's newsletter, is now up and available at www.internetsightings.com. Check it out!

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

- The 1/2/09 newsletter gives the first Top Ten listing in a new format. Subsequent listings were given on 1/4, 1/6, 1/9 (two), 1/12, 1/22, 1/24 and 1/28.
- The 1/5/09 email reports a UCLA 1 hour-plus audio interview with Chief Judge Michel of the CAFC about the presumption of validity, written

disclosures, etc., and gives its online address.

- The 1/8/09 message discusses the *Kubin* CAFC oral argument, and cites the web address for Dr. Noonan's summary of its obviousness and written description issues.
- Another 1/8/09 email discusses two pending malpractice cases – *Coin Acceptor* (CAFC) and *Parus Holdings* (ND Ill).
- A third 1/8/09 email addresses the split decision by the CAFC in the *Vehicle* IP case, and the ongoing claim construction mess.
- Two 1/11/09 newsletters discuss BPAI petition decision difficulties identified by Pat-O, and the PTO's lame response.
- The 1/12/09 email is one of a series discussing the PTO's possible move away from USPQ cites.
- Another 1/12/09 email discusses the *Frisket* CAFC decision denigrating secondary considerations as inadequate to overcome a strong showing of obviousness (but this is *dicta* because the evidence was insufficient).
- The 1/13/09 message considers the *Comiskey* en banc petition opinion in which a § 103 rejection was ignored, and a new § 101 rejection was stated *sua sponte*. A dissent suggests that now any ground of rejection can be raised before an appellate court. See also Pat-O for 1/14/09 and Hal's 1/25/09 offering.
- The 1/21/09 email wonders if the Obama suspension of Exec. Branch rulemaking applies to PTO interpretations of recent court decisions.
- The 1/22/09 message reports the three foci of the Obama administration in the IP area.
- The 1/26/09 email states that the JPO has published in English the patent examination guidelines it uses and gives the web address.

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

- The 1/4/09 blog discusses the *Sundown* CAFC decision in which the Court rejected the trial testimony of a patent attorney as not from a qualified expert, but then because the art was “simple enough,” found obviousness on its own.
- The 1/5/09 posting documents the increasing number of appeals to the BPAI in recent years, and the dropping rate for examiner reversals (now about 20%).
- The 1/8/09 email documents the “soaring” increase in appeals to the BPAI in recent years.
- The 1/15/09 blog states that last year for the first time less than 50% of US patents issued to US applicants.
- The 1/17/09 message reports the *Boston Scientific* CAFC decision holding as obvious the combination of two embodiments of a prior art patent in spite of a jury’s contra holding. So why bother with trial courts?
- The 1/18/09 email (for those pat. litigators among us) cites a new patent case management guide for federal judges being developed for the Federal Judicial Center.
- The 1/23/09 blog lists six easy suggestions to make the PTO more transparent to the public.
- The 1/28/09 posting cites recent examples of the BPAI applying *Bilski* to reject business method claims.
- The 1/29/09 message reports that deferred examination continues to be considered at the PTO beyond 37 CFR § 1.103(d).
- The 1/31/09 blog discusses the *Atkins* BPAI decision holding *sua sponte* that certain system and method claims for converting a web address are not patentable under § 101 for they don’t require transformation of an article into a different state or thing.

Carl Oppedahl – e-mails of IP practice matters: carl@oppedahl.com.

- Three 1/8/09 e-mails, and two on 1/9, discuss some PCT issues, with answers – e.g. filing fees, priority, new matter, etc.

Anticipate This – e-mails from Jake Ward focusing on patent practice – web address: www.anticipatethis.wordpress.com.

- The 1/15/09 message reports the author’s conclusions from attending a new PTO CEB program on current issues and practices.

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

- The 1/21/09 newsletter includes a guest column that discusses the impact of the *Bilski* business method decision on life science inventions.
- The 1/26/09 email includes a guest column that discusses the recent *Net Money* CAFC decision re: anticipation.

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

- The 1/5/09 bag focuses on WIPO’s last ‘08 magazine; it summarizes various WIPO meetings and comments on software patentability.
- The 1/12/09 e-mail reviews recent PTO fee changes.
- The 1/14/09 message reports that the US assignment data at the EPO is corrupted and is being replaced.
- The 1/27/09 message gives the new EPO fee schedule effective 4/1/09.

AIPLA Direct – a newsletter issued from time to time

http://www.aipla.org/Content/ContentGroups/About_AIPLA1/AIPLA_Reports/AIPLA_Reports_TOC.htm

- A 1/21/09 notice announces an online seminar Feb. 4 re: Insurance for IP Litigation.

WIPO – madrid@wipo.int

- On 1/14/09 WIPO published on its website information about new rules under the Madrid Agreement.
- On 1/14/09 WIPO also published its list of non-working days for 2009.

Other Stuff –

RP Bell offers a review and analysis of patent application practice changes during the last five years – see robertplattbell.com.

- The joannascholer.com blog of 1/29/09 reports that the EPO will accept Internet Archive page date stamps as adequate evidence.
- Legal Force, an online lawyer group, invites all to use the site for comment, debate, announcements, etc. See legalforce.com.
- LSI is offering a “Departing Employees and IP” seminar in Palo Alto on 2/25/09.
- LSI has announced a two day gamer technology law conference being held on 3/9-3/10/09 in Beverly Hills.
- LSI will hold a two day conference, “IP Licensing,” in Austin 3/30-3/31/09.
- Fordham announces its 17th IP conference at Cambridge UK on 4/15-4/16/09.
- LSI will offer a copyright management conference 4/23-4/24/09 in Seattle.

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 *In re Comiskey*, No. 06-1286, the Federal Circuit held that certain claims were invalid as unpatentable subject matter. The Federal Circuit remanded other claims to the Board to consider whether they recited patentable subject matter.

The application claimed methods and systems for conducting mandatory arbitration. The Board found the claims invalid as obvious under 35 U.S.C. § 103. Revising its original 2007 opinion, the Federal Circuit held that it was procedurally proper to affirm the Board’s decision on a legal ground not relied on by the Board because there were no issues of fact, policy, or agency expertise.

The court stated that a determination of whether the claims are directed to patentable subject matter under 35 U.S.C. § 101 should precede analysis of novelty and obviousness. Systems or methods that depend entirely on the use of mental processes, untied to another category of statutory subject matter, or depend for their operation on human intelligence alone are not directed to patentable subject matter.

The court noted that the method claims did not require a machine and did not describe a process of manufacture or a process for the alteration of matter. Finding that the method claims sought to patent the use of human intelligence alone, the court concluded that the claims were not directed to patentable subject matter. The system claims recited “modules,” “databases,” and actions performed “through the Internet, intranet, [etc.]” Because these claims could be interpreted to recite the use of a machine, the court remanded them to the Board for further consideration under § 101.

- ♦ In *In re Comiskey* [order], No. 06-1286, the Federal Circuit granted a rehearing en banc for the limited purpose of authorizing the panel to revise its opinion.

In dissent, Judges Moore and Newman argued for a rehearing en banc with full briefing and argument.

Judge Moore’s dissent argued that it was improper to rule on patentable subject matter issues under 35 U.S.C. § 101 without first addressing the § 103 rejections under appeal. Moore cited Supreme Court precedent stating that a new ground could be used to affirm an agency only when the agency’s ground was erroneous, because then a remand would be wasteful. Moore

argued this standard was not met because the panel did not find the Board of Patent Appeals and Interferences § 103 ruling erroneous. Moore additionally pointed to Federal Circuit precedent that new grounds of rejection should not be considered on appeal and argued that the court had gone beyond its proper judicial role.

Judge Newman's dissent criticized the new opinion as (1) being unclear regarding the standards of § 101 and (2) improperly limiting the scope of patentable subject matter. Newman supported her position with arguments based substantially on the policy and history of patent law.

Judge Dyk's concurrence generally pointed to instances in which other appellate courts affirmed on alternative grounds, noting that in this case the court's ruling obviated the initially appealed issues. Regarding the remand on § 101 without ruling on the initially appealed § 103 rejections, Dyk argued that further § 101 analysis at the PTO might obviate the § 103 rejections. Dyk further noted that the case presented "unusual circumstances."

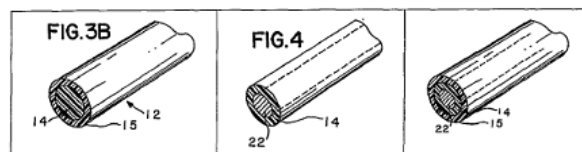
Judge Lourie's concurrence expressed sympathy for Moore's position, but argued that the § 103 rejections did not require further analysis. Lourie noted that the original opinion was contrary to law because "[t]he implication . . . that the 'otherwise unpatentable mental process' is prior art . . . is incorrect."

♦ In *Boston Scientific Scimed, Inc. v. Cordis Corp.*, No. 08-1073, at trial, the jury found the claims in question nonobvious and infringed by Cordis. Cordis sought JMOL or a new trial on infringement and validity, which were both denied. The Federal Circuit affirmed the construction but found the asserted claims invalid because of obviousness.

In this appeal by Cordis, the Federal Circuit applied standard claim construction procedure to affirm that that a "non-thrombogenic" stent as recited in three of the claims meant non-thrombogenic as compared to prior art stents (as asserted by Boston Scientific and held by the trial court) and not to bare metal stents (as asserted by

Cordis). Cordis also sought a construction of "long term non-thrombogenicity" that would allow its stents, which post-trial FDA findings indicated may actually have had "long term" thrombosis risks, to be non-infringing. Because the specification did not require a particular minimum threshold for "long term" the Federal Circuit approved the construction equating it merely to a "period of time."

Cordis cited two figures from another Medtronic patent. The court concluded that although that patent showed a stent with two layers, it was described as representing an embodiment with possibly "several" layers. It then concluded that the all of the limitations in the disputed Claim 8 were disclosed by separate but combinable embodiments of the patent. Cordis illustrated the point by showing a merger of two figures from the patent.



♦ In *Sud-Chemie, Inc. v. Multisorb Technologies, Inc.*, No. 08-1247, the Federal Circuit vacated a district court's grant of summary judgment of invalidity for obviousness and remanding.

Sud-Chemie owns a patent for a dessicant container comprising dessicant material surrounded by two layers of compatible polymeric materials that are heat sealed together. Sud-Chemie sued Multisorb for the manufacture and sale of an allegedly infringing desiccant bag. Both parties filed cross motions for summary judgment on the issues of infringement and validity.

The district court granted Multisorb's motion for summary judgment, finding the patent invalid for obviousness over the Komatsu patent, which teaches a container of two layers that surround an oxygen-absorbing material. The Federal Circuit concluded that the district court erred in finding that Komatsu discloses the use of "compatible polymeric materials" as claimed in the patent. The Federal Circuit agreed that

Komatsu and the patent disclose the same general classes of materials. However, the district court erred by failing to acknowledge that these materials can be compatible or incompatible, depending on how they are assembled in layers to form the container. The court remanded the case for a determination of whether the same materials recited in the patent's claims were taught by the cited prior art reference and whether these materials produce results significantly better than conventional methods.

NEWSLETTER VIA EMAIL ONLY



The Newsletter is now transmitted solely by e-mail. If you know of anyone who should be but is not receiving the OCPLA Newsletter, please have them contact Valerie Sarigumba at vl@viplawgroup.com.

OCPLA NEWSLETTER POLICY

While we are open to comments and suggestions, our 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, Valerie Sarigumba at vl@viplawgroup.com, to place your ad or with your comments and suggestions.

OCPLA BOARD OF DIRECTORS

BOARD OF DIRECTORS	TELEPHONE/E-MAIL
President	T.J. Singh (949) 955-1920 tjsingh@koslaw.com
V.P./President Elect	Marlene Klein (949) 932-3132 marlene.klein@cda.canon.com
Secretary	Tom Dao (949) 476-0757 TDao@koslaw.com
C.F.O./Treasurer	Stacey Halpern (949) 721-6301 stacey.halpern@kmob.com
Directors	Valerie Sarigumba (949) 724-1849 vl@viplawgroup.com
	Stacey Halpern (949) 721-6301 stacey.halpern@kmob.com
	Alyson Barker (949) 759-3924 BarkerA@howrey.com
	Sean O'Neill (949) 466-3860 soneill@novatechip.com
Immediate Past Pres.	Neal M. Cohen (949) 724-1849 nmc@viplawgroup.com

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:

OCPLA Newsletter Editor
Valerie Sarigumba
Vista IP Law group LLP
2040 Main Street, 9th Floor
Irvine, CA 92614-3641
Tel: (949) 724-1849
Fax: (949) 625-8955
E-mail: vls@viplawgroup.com

SERVICES, ANNOUNCEMENTS, WANT ADS

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.
03/09

Orange County company looking for solo practitioner or small firm to do occasional patent prosecution work in medical/polymer arts. Please send resume or firm description to darzint@yahoo.com"

PATENT ATTORNEY POSITION WANTED

Recent law school graduate seeks an entry level patent attorney position in Orange County. Qualifications include: USPTO registered, California Bar member, Ph.D. in genetics, B.A. in molecular and cell biology. Patent prosecution experience includes both molecular biology and medical device patents. Looking for part time or full time position in patent prosecution, litigation, or both. For full resume or CV, please e-mail Adam Diament at adamdiament@gmail.com.
2/09

Intellectual Property Counsel

Opportunity Snapshot:

Edwards Lifesciences (NYSE: EW) is a global leader in products and technologies to treat advanced cardiovascular disease, the global leader in acute hemodynamic monitoring and the number-one heart valve company in the world. This individual will support one of our fastest growing business units, Cardiac Surgery Systems. This is an excellent opportunity for someone looking to transition into a corporate environment with greater work life balance, opportunity for growth, and broad exposure to a variety of patents. Responsibilities include invention disclosure handling, patent application preparation and prosecution, portfolio management, and licensing and transactional work.

Our Requirements:

- A minimum of 4 years of experience practicing patent law (law firm experience preferred).
- J.D. required, along with a Bachelors degree in a technical field such as Electrical Engineering, Mechanical Engineering, Physics or Computer Science.
- Must be a registered patent attorney with the United States Patent Office.
- Must have experience in drafting and prosecuting patent applications along with experience assisting in client intellectual property assertion reviews.
- The ability to effectively bridge the technical and commercial aspects of the work.
- Must have the ability to influence senior executive decisions and have strong written, verbal communication and presentation skills, as well as the ability to successfully manage outside counsel.

How to Apply:

Please e-mail resume to Jayshri Patel, jayshri_patel@edwards.com
2/09

OCPLA Upcoming Events

Date	Location	Speaker/Event	Topic
February 19, 2009	Sports Club/LA - Orange County	Erwin Chemerinsky, Dean of UCI School of Law	Perspectives on the U.S. Supreme Court and The Future of UCI's Law School: shaping the future of intellectual property law in Orange County
March 19, 2009	Sports Club/LA- Orange County	Ron Schoenbaum and John King of Knobbe, Martens, Olson & Bear, LLP	<i>In re Bilski</i> ; Prosecution and Litigation Perspective