



# OCPLA NEWSLETTER

Orange County Patent Law Association

[www.ocpla.org](http://www.ocpla.org)

November 2009

## WEDNESDAY, NOVEMBER 18, 2009 LUNCHEON

### **Please note our lunch is being held early this month and on Wednesday.**

Our November luncheon will feature: *Review of 2009 Patent Decisions by the Federal Circuit Court of Appeals and Recent Federal Circuit Decisions on Malpractice, Conduct Exposing a Patent Attorney to Sanctions, Discipline or Harm to Attorney's Reputation*, presented by Roland Tong and Jon Hokanson from Lewis Brisbois Bisgaard & Smith LLP.

The luncheon will be held at the Sports Club/LA Orange County from 12:00-1:30 PM. We look forward to seeing you there!

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

## NOVEMBER BOARD MEETING

The November OCPLA board meeting will be conducted November 18, 2009 at 11:00 AM at the Sports Club/LA, prior to the November luncheon. Members who wish to present items for the Board's consideration should contact our president, TJ Singh, at [tjsingh@koslaw.com](mailto:tjsingh@koslaw.com) to have their items placed on the agenda, and to verify the time and location of the meeting.

## 2010 OCPLA OFFICERS

Thanks to everyone who participated in our annual election for the 2010 OCPLA officers. The newly elected officers for 2010 are:

President.....Marlene Klein  
V.P./President Elect.....Tom Dao  
Secretary .....Stacey Halpern  
C.F.O./Treasurer.....Valerie Sarigumba  
Director ..... Alyson Barker  
Director.....Sean O'Neill  
Director.....Lynne Boisineau

Thank you and we look forward to working with everyone next year.

## OCPLA ANNUAL HOLIDAY PARTY, DECEMBER 10, 2009

Our annual Holiday Party for 2009 will be held at **The Ritz-Carlton in Dana Point** on **December 10**. Each member is welcome to bring a guest. Please RSVP at [www.ocpla.org](http://www.ocpla.org) and pre-select your entrée of choice.

There will be a cocktail reception from 6:00-7:00 PM, followed by a four-course dinner. The cost is \$80.00 per person, including the cocktail reception, dinner, and parking. Please see the invitation and menu at the end of the newsletter.

Last year was a very enjoyable event, and we hope to share it with all of you again this year.

### 2010 OCPLA MEMBERSHIP: NEW ON-LINE APPLICATION SYSTEM

Please remember to renew your membership on-line for 2010 at [www.ocpla.org](http://www.ocpla.org). Don't forget to encourage your colleagues who are not already members to join.

Also, to improve the membership application process, OCPLA is implementing a new website system for accepting membership applications, as well as event registrations, for 2010. The new system should be operating by mid-December. (But you can still renew your membership beforehand.)

We hope to see all of you again, as well as some new members, in 2010.

### INTERNET SIGHTINGS

BY JIM HAWES

This column highlights some of the more notable recent internet notices, newsletters and blogs dealing with IP prosecution issues. It may be 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 check [internetsightings.blogspot.com](http://internetsightings.blogspot.com).

**Hal Wegner's** newsletter – a lot of great stuff – see [Grayonclaims.com/Hal](http://Grayonclaims.com/Hal) or contact: [hwegner@foley.com](mailto:hwegner@foley.com)

- The 10/6/09 newsletter reports calls by the Administration for comprehensive patent law reform ASAP. The 10/9/09 email states that the Administration is committed to the comprehensive patent reform legislation introduced 53 months ago and passed by the Senate Judiciary Committee 6 months ago. Sen. Leahy hopes for a Senate debate and vote by year end.
- A second 10/6/09 post states that Hal's Top Ten list of IP cases on appeal is now available at [GrayOnClaims.com/Hal](http://GrayOnClaims.com/Hal).
- The 10/15/09 message gives the Internet address for a summary and

analysis of Director Kappos' recent speech before the AIPLA.

- The 10/20/09 email states China expects 845,000 patent applications to be filed this year, the most for any country ever. The US expects 460,000 patent applications this year.
- The 10/21/09 post states that the PTO has revised the Examiner count system, and commends all. See Pat-O of 10/1/09 below for more.
- The 10/27/09 email discusses the Patent Prosecution Highway with recent developments and proposals.

**Patently-O** – a blog written by Dennis Crouch – [www.patentlyo.com](http://www.patentlyo.com).

- The 10/1/09 blog discusses the PTO's count system for gauging examiner's performance, and proposed revisions. Basic stuff for anyone who prosecutes patent applications before the PTO.
- The 10/2/09 email discusses the *Stanford v. Roche* CAFC decision resolving conflicting assignment documents among joint inventors. If you prepare employee agreements, be sure and read this one.
- The 10/5/09 blog surveys and summarizes the many amicus briefs filed with the Supreme Court in *Bilski*.
- The 10/9/09 message reports that in spite of a substantial increase in appeals the BPAI has managed to keep the average pendency to 7.7 months from assignment of appeal number to date of decision.
- The 10/19/09 blog cites various amicus briefs in the *Ariad* appeal that discuss the written description requirement – 35 U.S.C. § 112.
- The 10/22/09 email discusses recent PTO steps to discourage RCE filings and encourage examiner-applicant cooperation. This discussion is continued in the 10/26/09 post.
- The 10/23/09 message discusses the considerable spike in DC district court filings due in part to patent term adjustment cases.
- The 10/27/09 blog reviews the recently proposed changes (about two dozen) to the CAFC rules.
- The 10/28/09 message discusses the effective reference date of a US patent

preceded by a provisional application, raised by a case now before the CAFC.

**Gray on Claims** – Justin Gray, a Foley & Lardner attorney, focuses mainly on BPAI decisions: see [grayonclaims.com](http://grayonclaims.com).

- The 10/12/09 focus discusses the *Buabud* decision (BPAI) holding that “high frequency” in a claim imposed no frequency limitation.
- The 10/17/09 email reviewed the *Hermmet* decision (BPAI) applying *Bilski* to find non-statutory a claimed method not tied to a machine nor to transformation of an article.
- The 10/30/09 *Senjui* decision (BPAI) held indefinite a claim including a type of volatile solvent not defined in the specification, nor did the examples given permit the scope of the term to be defined.

**Carl Oppedahl** – email of IP practice matters: [carl@oppedahl.com](mailto:carl@oppedahl.com).

- The 10/3/09 email reports the new WIPO PCT-SAFE FM program for communicating with WIPO that took effect 10/13/09. Contact WIPO.
- The 10/7/09 email about a second opinion from the IPEA is a good example of the sort of detail Carl addresses. If you do much PCT stuff, you should subscribe to Carl’s emails.

**IP Watchdog** – IP ramblings by Gene Quinn – [www.ipwatchdog.com](http://www.ipwatchdog.com)

- The 10/3/09 message addresses handling telephone and email requests from inventors for a brief, one question, telephone conference.

**Cal Bar IP Section** –

Contact: [mitch.wood@calbar.ca.gov](mailto:mitch.wood@calbar.ca.gov)

- The section offers eNews that announces numerous teleseminars on timely IP topics and gives free MCLE credits to boot. Sign up.
- NOTE – there is a lot going on in this Section. To keep up you should get its eNews email. Sign up at [ipsection.org](http://ipsection.org).

**AIPLA Direct** – a newsletter issued on occasion:

<http://www.aipla.org/Content/ContentGroup>

[s/About AIPLA1/AIPLA Reports/AIPLA Reports\\_TOC.htm](#)

- On 10/8/09 the Association announced that it was on Twitter, whatever that means.
- On 10/9/09 the Association made the 2009 Economic Survey results available as an Excel file.
- The midwinter meeting will be held at La Quinta Jan. 27-30.
- An audio download of the address by PTO Director Kappos to the Annual Meeting about the state of the PTO is available at the Association’s website for free.
- On 11/17/09 the Association will hold a teleconference with PTO reps Kappos and Dickinson about the latest changes to rules and practice.

#### PTO notices

[www.uspto.gov/main/newsandnotices](http://www.uspto.gov/main/newsandnotices)

- The PTO announced that it is expanding the pre-first action interview program to encompass additional technology areas as of 10/1/09.
- On 10/8/09 the PTO announced that it is rescinding the Tarfas rules package.
- The PTO and IPO will offer the 20<sup>th</sup> annual PTO Day conference on Dec. 7, 2009 in DC. Contact either if you are interested.

#### Other Stuff

- McDermott Will & Emery’s 9/28/09 newsletter includes an article on *In re Bose* (CAFC ’09), with some recommended best practices.
- Patent docs on 10/23/09 reported a 17% increase in VC investments (to \$4.8B) for the 3Q09 over the 2Q09.
- The Solo IP Practitioner blog ([soloip.blogspot.com](http://soloip.blogspot.com)) of 10/27/09 recommends that solo patent attorneys set up shop as a consultant, not an attorney. Read it to see why.
- LSI will hold a technology law conference in Seattle on Dec. 10 & 11.

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**

No precedential Federal Circuit decisions to report for this time period.

**OCPLA BOARD OF DIRECTORS****BOARD OF DIRECTORS – PHONE/E-MAIL**

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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****Patent Attorney/Patent Agent**

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Our Irvine Office has an opening for a Patent Attorney or Patent Agent with an electronics background to join our growing practice. The ideal candidate will have a Bachelor's degree in Electrical Engineering, Computer Science, or Physics; 1-5 years of patent prosecution experience (including experience in electronics); and excellent written and oral communication skills. As a boutique firm, we can customize a package for the right candidate. Please submit resume, transcripts, writing sample, and references for consideration to: [info@koslaw.com](mailto:info@koslaw.com). For more information about our firm, please visit our website: [www.koslaw.com](http://www.koslaw.com).

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FITCH EVEN, TABIN & FLANNERY, a national Intellectual Property law firm, is expanding its Woodland Hills office. FETF also has offices in Chicago, San Diego, San Luis Obispo, Washington, D.C., and Boulder. We are seeking partners and associates who have established client relationships. FETF will consider merger opportunities. To learn more about the firm and our practice, please visit us at: <http://www.fitcheven.com>

All submissions are held in confidence. For confidential discussion and consideration, please contact:

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Recruitment Coordinator  
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(312) 577-7000

**OCPLA Upcoming Events**

Event	Date	Details
November OCPLA Luncheon	Nov. 18, 12:00-1:30 PM, Sports Club/LA Orange County, California 92614 (949) 975-8400	Topic: <i>Review of 2009 Patent Decisions by the Federal Circuit Court of Appeals and Recent Federal Circuit Decisions on Malpractice, Conduct Exposing a Patent Attorney to Sanctions, Discipline or Harm to Attorney's Reputation</i>  Speakers: Roland Tong and Jon Hokanson from Lewis Brisbois Bisgaard & Smith LLP
OCPLA 2009 Holiday Party	December 10 The Ritz-Carlton, Dana Point	Cocktail Reception: 6:00-7:00 PM Dinner: 7:00 PM  <i>See invitation below for more event details.</i>



*OCPLA ANNUAL HOLIDAY PARTY*



THE RITZ-CARLTON®  
LAGUNA NIGUEL

**Thursday, December 10, 2009**

**The Ritz-Carlton, Laguna Niguel**

One Ritz-Carlton Drive, Dana Point, California 92629

**RSVP and select your dinner entrée at [www.ocpla.org](http://www.ocpla.org) by  
Sunday, December 6, 2009**

Members are welcome to bring a guest.

\$80 per person, includes Parking, Cocktail Reception, and Four-Course Dinner

***Ocean View Cocktail Reception 6:00-7:00 PM***

◆ **Hors D'Oeuvres** ◆

Cajun Shrimp, Avocado Mousse and Tomato Relish  
Roasted Vegetable Ratatouille, Manchengo Cheese on Foccacia Toast  
Chicken Boursin Fricasse in Phyllo

2 drinks per person

***Dinner – Plaza Room 7:00 PM***

Chardonnay and Cabernet Sauvignon (Beaulieu Vineyard) served with Dinner

◆ **Salad** ◆

Spinach and Radicchio Salad, Toasted Almonds,  
Red and Yellow Pear Tomatoes, Sherry Wine Vinaigrette

◆ **Soup** ◆

Tomato Basil Bisque, Black Pepper and Parmesan Crostini

◆ **Entrée** ◆

Pre-selected choice of:

- ❖ Breast of Chicken stuffed with Goat Cheese, Pine Nuts, Fresh Herbs, Sun Dried Tomato, Marsala Sauce
- ❖ Grilled Mahi Mahi, Papaya Seed Beurre Blanc, Island Salsa
- ❖ Nine Spice Slow Roasted Prime Rib, Au Jus
- ❖ Vegetarian Option available upon request

◆ **Dessert Duet** ◆

Crunchy Passionfruit Chocolate Cake and Seasonal Berry Tart