OCPLA NEWSLETTER

Orange County Patent Law Association
www.ocpla.org

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OCTOBER 2008 LUNCH

The next OCPLA Lunch Meeting will be held on October 15, 2008 at 12:00 Noon at the Wyndham Garden Hotel. Joe Re of Knobbe, Martens, Olson & Bear, LLP will be speaking. The topic will be "In Defense of the Clear and Convincing Standard for Proving Patent Invalidity."

The annual election is also being held in conjunction with our monthly luncheon. If you are unable to attend, please fill out the proxy form at the end of this newsletter and return it to Marlene Klein via e-mail.

Please note that registration and payment for the October 2008 Lunch Meeting and all other Lunch Meetings 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. **Checks and other forms of payment are no longer accepted.**

NOVEMBER 2008 LUNCH

Please note the November 19, 2008 special date for the November Lunch Meeting.

OCPLA 2008 HOLIDAY PARTY- SAVE THE DATE

The OCPLA 2008 Holiday Party will be held on December 4, 2008 at Sage on the Coast. Details regarding the Holiday Party will be coming soon. As with the Lunches, reservations will be made online via OCPLA's website (http://www.ocpla.org).

2008 OCPLA MEMBERSHIP RENEWAL

Attached at the end of this newsletter is a renewal form for the remainder of the 2008 calendar year. The association needs your support. Please renew by printing and filling out the form and returning it at your earliest convenience.

OCTOBER BOARD MEETING

The October Board Meeting is scheduled for 11:00 a.m. on October 15, 2008 at the Wyndham Garden Hotel before the OCPLA's Annual Meeting (see below). Members who wish to present items for the Board's consideration are encouraged to contact our president, Neal Cohen at nmc@viplawgroup.com and have their items placed on the agenda.

2009 BOARD OF DIRECTORS

OCPLA's annual meeting will be held this year on October 15, 2008 at the Wyndham Garden Hotel, beginning at 11:45 a.m., before the regular monthly lunch meeting. At this annual meeting, we will elect the 2009 Board of Directors. As is tradition, each current Board member will be nominated to advance to the next available position. Other members will be nominated for the first year director position. Proxy forms were previously e-mailed to all members and an additional copy is attached to this newsletter. Please note that we will ***not*** be voting at the upcoming annual meeting in October on any issues related to a potential merger with LAIPLA.

LAIPLA JUDGES' NIGHT- NOVEMBER 7, 2008

Attached at the end of this newsletter is information (including registration materials) for the LAIPLA Judges' Night, which will take place on November 7, 2008. Please note that OCPLA members can register at the same member rate as LAIPLA members.

OCPLA is considering arranging for transportation for this event if enough members are interested. If you are planning on attending and are interested in OCPLA providing transportation, please send an e-mail to Neal Cohen at nmc@viplawgroup.com indicating the names and e-mail addresses of the members that are interested in OCPLA-provided transportation to the event if it is available. Please note that providing transportation is dependent on the number and timeliness of responses indicating interest. A final determination will be made by October 15. Only those members who request transportation AND receive an email confirmation from Neal Cohen will be entitled to the OCPLA transportation.

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 or subscribe at www.internetsightings.com.

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

- The 9/1/08 newsletter presented Hal's current top ten list of cases on appeal, with some predictions. See also the 9/5, 9/14, 9/24, 9/28 and 9/30 newsletters.

- The 9/4/08 email discusses the DBC case just argued before the CAFC and why there was no mention in the Westlaw briefing record of the invalid BPAI panel argument. See also Hal's 9/5/08 newsletter.

- The second 9/4/08 message concerns the Swanson CAFC decision affirming a denial of reexamination based on one reference already considered by the examiner (thus, no new question of patentability was presented). But see Pat-O for 9/16.

- The 9/6/08 offering attached a copy of Hal's eBay/injunctive relief paper. It was updated on 9/8 to reflect the Voda decision.

- The 9/8/08 email reported the CAFC Carnegie Mellon U. decision re the written description requirement of sec. 112, holding it to be a separate requirement.

- A second 9/9/08 email discusses a PTO Power Point about continuations and RCE practice, and includes current data. See also Hal's 9/9 follow up.

- A final 9/9/08 email reports that, according to Chief Judge Michel of the CAFC, the Bilinski decision re statutory subject matter should issue within the next two months and be quite significant.

- A 9/12/08 offering reports an IP debate between reps of the 2 Presidential candidates. Those who are not yet tired of debates can access a cited webcast of the debate. Other emails – 9/12 and 9/14 – report Chief Judge Michel's response.

- The 9/19/08 email discusses the Commonwealth Scientific CAFC decision and its detailed KSR obviousness application – a worthwhile case to review.

- The 9/22/08 message reports the long awaited Egyptian Goddess CAFC decision on design patent infringement – the point of novelty test is gone; the only test is now the ordinary observer test.

- The 9/24/08 email says that the NSF is now funding a $4 million study of patent issues.

- The 9/25/08 offering discusses the Aristocrat Tech CAFC decision and the written description requirement.

- The 9/28/08 email reports that Congress has passed an extensive IP bill with copyright enforcement provisions and a new "Top IP Cop" position – it is unclear whether on not Pres. Bush will sign it.

- The 9/29/08 report discusses the Plaxair CAFC decision on inequitable conduct, one hard to reconcile with the Court's recent Star Scientific rationale.

- Another 9/29/08 email reports the F&G Res. order of the CAFC – a "stinging rebuke" of counsel. The Court vents its frustrations with cases and counsel. Watch out.

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

- The 9/2/08 blog presents data showing the tendency to delay responding to Office Actions, and reminds all that each day of delay shortens the life of any resulting patent.

- The 9/12/08 email includes a graph of PTO allowance rates – it shows a reduction from 70% in 1999 to 43% in 2008. Undoubtedly at least some of the reduction is due to the PTO's current continuation and RCE practices, but still . .

- The 9/15/08 blog reports a study showing how the years in prosecution goes up with an increasing number of claims in the application (eg 1 claim – 2 years; 30 claims – 3 years).

- The 9/16/08 email discusses the CAFC Swanson decision that a previously considered reference may support a request for reexamination when it is being argued pursuant to a substantial new question not considered previously by the PTO.

- The 9/30/08 blog discusses the Praxair decision, also reviewed in Hal's 9/29 email above.

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

- The 9/2/08 newsletter includes a guest column that suggests policies and procedures for avoiding export control liabilities, a danger for all companies with international activities.

- The 9/3/08 offering includes a profile of the McDermott Will & Emery firm. Maybe your firm's profile should be next?

- The 9/11/08 email includes a guest column discussing idea theft and CA law.

- The 9/18/08 newsletter includes a guest column pointing out that the Madrid Trademark Protocol improves efficiencies and reduces costs significantly.

- The 9/23/08 newsletter has an entry discussing how not to mess up a law firm retreat.

- The 9/25/08 email includes a guest column that discusses the future of business method patents after Bilski.

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

- The 9/10/08 dose reports that WIPO offers many free publications, and has grouped them by topic or category.

- The 9/16/08 dose reports an EPO conference discussing innovation and patent statistics.

- The 9.26/08 offering states that WIPO has appointed Francis Gurry as its new Director General.

AIPLA Direct – a newsletter issued from time to time: http://www.aipla.org/content/contentgroups/about_aipla1/aipla_reports/aipla_reports_toc.htm.

- The Annual Meeting is being held Oct. 23-25 at the Marriott in DC.
- The Assn. is offering a live online seminar Nov. 5 to discuss Hot IP Topics for '08.

PTO notices – www.uspto.gov/main/newsandnotices.

- The new fee schedule, effective October 2, has been published.

WIPO notices – www.wipo.int.

- WIPO has published its 2008 Annual Report surveying IP worldwide.

Other Stuff –

- A Technology Law Conference is to be held 12/11-12 in Seattle; contact LSI News.
- A massive patent reform bill was introduced by Sen. Kyl in Congress 9/24/08 – a preview of '09?

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 *Howmedica Osteonics Corp. v. Wright Med. Tech. Inc.*, Case No. 00-CV-1167, the Federal Circuit reformed a prior settlement agreement that otherwise would have released the claim of infringement at issue, vacated judgment of noninfringement and remanded.

The patent at issue related to orthopedic knee implants. Prior to the present action, the parties settled litigation in New Jersey (NJ) and Massachusetts (MA) regarding a different set of patents. For accounting purposes, the parties executed two settlement agreements, corresponding to the litigation in the two states. The initial drafts of the agreements contained identical releases that ultimately proved to be broad enough to encompass the current litigation. Howmedica objected to the breadth of the release in the MA agreement and the parties narrowed it significantly. However, Howmedica overlooked the identical language in the NJ agreement and this language was not revised.

The district court construed the two agreements in harmony and construed the broad NJ release to have only the same limited scope as the narrow MA release. The Federal Circuit agreed that the parties' prior agreements did not release the current claims, but on different grounds. The Federal Circuit held that the language of the NJ release did not accurately reflect the express intentions of both parties at the time of execution due to a mutual mistake, and reformed the NJ release accordingly.

With regard to the issue of infringement, the parties stipulated to noninfringement under the district court's claim construction. Thus, the only issue on appeal was the correctness of the claim construction. The construed term on appeal was: "at least one condylar element." The claim also specified the structure of "the condylar element." The district court held that when there is more than one condylar element both must meet the structural limitations. The Federal Circuit disagreed, holding that the claim was met by a device having one condylar element with the required structural features, even if the device also included a second condylar element that did not have the required structural features. Thus, the Federal Circuit vacated the judgment of noninfringement and remanded.

Judge Prost dissented on claim construction, arguing that the function of the implant and the specification indicate that the limitations apply to "each" condylar element.

In *Janssen Pharmaceutica, N.V. v. Apotex, Inc.*, Case No. 06-CV-1020, the Federal Circuit affirmed the district court's dismissal of defendant's declaratory judgment action for lack of subject matter jurisdiction.

Plaintiff Janssen is the holder of three patents covering its drug Risperdal. Defendant Apotex submitted an ANDA and filed Paragraph IV Certifications on all three patents. In March, 2006, Janssen filed suit on one patent ("the 2008 patent"--set to expire in 2008), but did not file suit on the other two patents ("the 2014 patents"--set to expire in 2014). Apotex responded by filing a declaratory judgment action regarding the 2014 patents. Janssen moved to dismiss the declaratory action claims alleging that no case or controversy existed between the parties.

Janssen granted a covenant not to sue Apotex on the 2014 patents and Apotex later stipulated to the validity, enforceability, and infringement of the 2008 patent. On October 11, 2007 the district court granted the motion to dismiss the declaratory judgment claims for lack of subject matter jurisdiction.

On appeal, Apotex argued that because another pharmaceutical company, Teva, was the first to file a Paragraph IV certification with regard to the 2014 patents, Apotex was blocked from the market until 180 days after either Teva began marketing its generic or the 2014 patents were found to be invalid, unenforceable, or not infringed. Thus, a case or controversy existed as to whether its generic would infringe the 2014 patents, because such a holding would trigger Teva's exclusivity allowing Apotex to enter the market 180 days later.

The Federal Circuit disagreed with Apotex and affirmed the district court's ruling. The Court stated that because Apotex stipulated to infringement of the 2008 patent, it would still be blocked from entering the market until June, 2008. The harm Apotex alleged (Teva not triggering its 180 day exclusivity and delaying Apotex's entrance) was too speculative at the time of dismissal because Teva could not launch its generic product until the 2008 patent expired 6 months later, and there was no evidence Teva would not launch its product.

In *In Re Swanson*, Case No. 2007-1534 (Reexamination No. 90/006,785), the Federal Circuit affirmed a Board of Patent Appeals and Interferences (BPAI) finding that several claims were invalid.

The patent at issue related to quantitative analysis of biological fluids. The claims at issue were challenged in prior litigation that resulted in a jury finding that the accused infringer failed to prove that the claims were invalid. The district court entered judgment accordingly, and the Federal Circuit affirmed. The accused infringer subsequently filed a request for *ex parte* reexamination of the patent based on a reference considered by the examiner during the initial prosecution of the patent. The examiner had considered the reference only as a secondary reference. However, the district court and Federal Circuit had considered the exact same issue raised by the reexamination.

The Federal Circuit concluded that a reference considered by the examiner during initial prosecution, even if considered with respect to the same claims, can still raise a substantial question of patentability if it is considered for a substantially different purpose during reexamination.

The Federal Circuit also held that the reexamination statute does not prohibit the PTO from considering an issue of validity previously litigated in federal court because there are different evidentiary standards for invalidity required in federal court and the PTO. The court explained that, because a patent is entitled to a presumption of validity during litigation whereas no such presumption exists in proceedings before the PTO, its holding would not conflict with the required finality of federal court judgments mandated by Article III.

In *Carnegie Mellon University v. Hoffmann La-Roche Inc.*, Case Nos. 95-CV-3524 and 01-CV-0415, the Federal Circuit affirmed the district court's grant of summary judgment of

(1) invalidity based on lack of written description and (2) noninfringement.

With regard to invalidity, the claims at issue were directed to a genus of recombinant plasmids that contained gene coding regions for the expression of DNA polymerase I from “any bacterial source.” The Federal Circuit affirmed a finding that the claims were invalid for lack of written description where the narrow specifications of the patents at issue only disclosed the gene coding sequence from one bacterial source, E.Coli, and not “any bacterial source.” The Court further found that given the thousands of bacteria species, the polymerase I gene variations among these bacteria species, and the specifications’ particular emphasis on careful construction of the claimed recombinant plasmids, the written description requirement was not met by describing only one bacterial source.

With regard to noninfringement, the Federal Circuit affirmed the district court’s finding that there was no infringement under the doctrine of equivalents where the claims recited E.coli as the bacterial source and the accused product used the “Taq” bacteria. The Court concluded that “Taq” was not an equivalent to E.coli and that a finding otherwise would vitiate the bacterial source limitation in the claims.

In *Medical Solutions Inc. v. C. Change Surgical*, Case No. 06-CV-01261 the Federal Circuit affirmed the district court's final judgment dismissing the suit for lack of personal jurisdiction.

Plaintiff MSI asserted that Defendant CCS's product infringed two of its patents and that personal jurisdiction existed under the District of Columbia's long-arm statute because CCS both used and offered to sell the product at a trade show in Washington, D.C. The District Court dismissed the suit for lack of personal jurisdiction. MSI appealed, but abandoned its offer to sell argument and advanced only its use argument.

The Federal Circuit found that the district court correctly considered and interpreted all of the facts with regard to CCS's use of the allegedly infringing product at the trade show. CCS displayed a prototype, staffed its booth with representatives, and made available brochures about the product. None of these activities, however, were sufficient to establish an infringing use.

In *Excelstor Tech. Inc. v. PAPST Licensing GMBH & Co. KG*, Case No. 07-CV-2467, the Federal Circuit affirmed the district court’s dismissal for lack of subject matter jurisdiction.

ExcelStor sued Papst for violating a licensing agreement that required Papst to periodically notify ExcelStor of the existence of any other royalty-bearing licenses to sell patented hard disk drives. ExcelStor brought suit in the Northern District of Illinois. ExcelStor initially alleged fraud and breach of contract; it subsequently amended its complaint to seek declaratory relief for violation of the patent exhaustion/first sale doctrine based on Papst’s collection of two royalties for the sale of the same patented hard disk drives, and to include claims of fraud and breach of contract for failure to disclose this violation.

The Federal Circuit explained that patent exhaustion is a defense to patent infringement and not a cause of action. The court reasoned that ExcelStor’s claims merely invoked “defenses to hypothetical claims of patent infringement” and thus did not arise under the patent laws as required to create federal question jurisdiction under 28 U.S.C. § 1338. The court further explained that the claims did not require resolution of a substantial question of federal patent law, as the alleged collection of two sets of royalties was properly resolved under state law of contract and fraud.

In *The Campbell Pet Co. v. Miale*, Case No. 07-CV-5375, the Federal Circuit reversed the district court’s dismissal for lack of personal jurisdiction.

Miale held two patents relating to stretchers for injured animals. Through her company in California, Miale sold 12 units in the State of Washington for a total of $13,851 and operated a website selling its products. In June 2007 Miale attended a veterinary convention in

Washington where she confronted Campbell's employees and accused them of patent infringement. Further, she unsuccessfully requested that the convention manager remove Campbell's booth on the grounds of patent infringement. Miale later sent a letter to Campbell accusing Campbell of patent infringement. Campbell then filed a declaratory judgment action in Washington seeking a finding of noninfringement.

The district court held that it would offend traditional notions of fair play and substantial justice for it to exercise personal jurisdiction. The Federal Circuit reversed. Miale's attempt to remove Campbell's booth from the convention was an attempt at extra-judicial patent enforcement beyond simply informing the alleged infringer, and thus was sufficient to establish personal jurisdiction.

In *Broadcom Corp. v. International Trade Commission*, Investigation No. 337-TA-543, the Federal Circuit affirmed the ITC's noninfringement determination as to one patent, but vacated and remanded the noninfringement determination as to a second patent.

Broadcom filed a petition with the ITC alleging that Qualcomm had imported chipsets that infringed Broadcom's patents in violation of 19 U.S.C. § 337. The patents in suit relate to wireless communications, such as the EV-DO standard. On appeal, based on a technical record, the Federal Circuit affirmed the ITC's noninfringement determination as to the '311 patent, but vacated and remanded the noninfringement determination as to the '675 patent.

In *Commonwealth Scientific and Industrial Research Org. v. Buffalo Tech. Inc.* Case No. 2:05-CV-53, the Federal Circuit affirmed summary judgment that the '069 patent was not anticipated, that the '069 patent was not invalid because of the addition of new matter to the application or because the asserted claims lacked a sufficient written description in the original specification, vacating the summary judgment that the '069 was not obviousness, and affirming summary judgment of infringement.

Commonwealth Scientific and Industrial Research Organisation ("CSIRO") is Australia's national science agency. CSIRO's '069 patent relates to wireless local area networks. CSIRO claimed that its patent covered any product that implements the IEEE 802.11 a, g, or draft n standards.

The District Court's decision regarding obviousness was rendered prior to KSR. The Federal Circuit found that the district court's analysis of obviousness was flawed in light of KSR and remanded.

In *Egyptian Goddess v. Swisa Inc.*, Case No. 3:03-CV-0594, the Federal Circuit, sitting en banc, abandoned its long-standing "point of novelty" test for design patent infringement and reinstated the Supreme Court's "ordinary observer" test as the sole test for design patent infringement.

The en banc court concluded that the point of novelty test, as a second and free-standing requirement for proof of design infringement, is inconsistent with the ordinary observer test announced by the Supreme Court in *Gorham Co. v. White*, and is not needed to protect against unduly broad assertions of design patent rights. The ordinary observer test, therefore, should be the sole test for determining whether a design patent has been infringed.

The Federal Circuit traced the history of Supreme Court design patent cases in finding that the ordinary observer test, in which the observer compares the patent and accused designs in the context of similar designs found in the prior art, is the appropriate legal standard. The ordinary observer has reasonable familiarity with the objects and is capable of assessing the similarity of the patented and accused designs in light of the similar objects in the prior art. To apply the test, the ordinary observer must evaluate the similarity of the patented design to the prior art and determine if the accused device has appropriated the novelty in the patented design

which distinguishes it from the prior art. Accordingly, where a field is crowded with many references relating to the design, the range of equivalents will be construed very narrowly.

Applying the ordinary observer test to the facts of this case, the Federal Circuit concluded that no reasonable fact-finder, taking into account the prior art, would conclude the accused design infringed the patented design and affirmed the district court's summary judgment of non-infringement.

In *Aristocrat Technologies Australia PTY Lmtd. v. International Game Tech.*, Case No. 06-CV-3717, the Federal Circuit reversed and remanded the district court's grant of summary judgment invalidating the two asserted patents on the basis that an abandoned parent application was "improperly revived."

The Federal Circuit held that the defendants' asserted defense for improper revival of an abandoned patent application was not a valid defense under 35 U.S.C. §§ 282 (2) & (4). Specifically, Section 282(2) only relates to defenses of invalidity for lack of utility and eligibility, novelty, and nonobviousness. With respect to Section 282(4), the Federal Circuit held that generally a procedural irregularity is not a defense unless it rises to the level of inequitable conduct, which was not asserted here.

In *Broadcom Corp. v. Qualcom Inc.*, Case No. 05-CV-467, the Federal Circuit reversed a jury verdict of infringement of one patent and instead found the patent invalid; affirmed the judgment of induced infringement and no invalidity of two additional patents; and affirmed the entry of a permanent injunction on those two patents.

Broadcom and Qualcomm compete in the market for chipsets used in mobile devices such as cell phone handsets. The patents at issue related to wireless voice and data communications on cellular telephone networks.

With respect to the first patent, the '686 patent, the Federal Circuit found that the district court erroneously imported a requirement for a "global controller" into the relevant claim. With that correction, the Court reversed the jury verdict of infringement as to the '686 patent, and found it invalid as anticipated.

With respect to induced infringement of the remaining two patents, the '317 and '010 patents, Qualcomm argued for a new trial because the jury instructions on the intent factor stated that whether Qualcomm had obtained opinions of counsel was relevant to inducement. Qualcomm argued that under the Federal Circuit's en banc *Seagate* decision, opinions of counsel had no relevance to the issue of induced infringement. The Federal Circuit disagreed, holding that an opinion of counsel may be relevant to whether the accused inducer "knew or should have known" that its actions would cause another to directly infringe.

In *Lucent Tech. Inc. v. Gateway Inc.*, Case Nos. 02-CV-2060, 03-CV-0699, and 03-CV-1108, the Federal Circuit affirmed the district court's grant of JMOL based on lack of standing for one patent and based on non-infringement for another patent.

The technology at issue related to methods of compressing digital audio files. Following a jury verdict of infringement and a damages award of $1.5 billion, the district court dismissed the claims for infringement with respect to the first patent and granted JMOL, and alternatively a new trial, on infringement with respect to a second patent. The district court found that the first patent was co-owned by AT&T (now owned by Lucent) and a third-party, Fraunhofer, under a Joint Development Agreement ("JDA") signed years earlier. Because Lucent failed to join Fraunhofer in the present suit, it lacked standing to sue for infringement on the co-owned patent. On the second patent, the district court found that Lucent failed to provide sufficient evidence that the allegedly infringing software ever performed the claimed methods.

On appeal, Lucent argued the dismissal of its claims for lack of standing was improper because two claims of the patent were invented prior to the JDA and, therefore, Fraunhofer could not be a co-owner of the patent. The Federal Circuit rejected this reasoning, finding instead that because some of the claims were invented during the period of the JDA, Fraunhofer was a co-owner of the entire patent. Lucent also argued that the grant of JMOL of non-infringement was improper because it had presented sufficient circumstantial evidence to support the jury's findings. The Federal Circuit also rejected this argument, finding that the circumstantial evidence established only uncertainty and speculation as to whether the allegedly infringing software every performed the claimed methods.

In *Praxair v. ATMI*, Case No. 03-CV-1158, the Federal Circuit affirmed the district court's finding of unenforceability for one patent ('115), reversing it for a second ('609); affirmed the district court's finding of no invalidity for second patent, but vacated its finding of infringement and remanded; and reversed the district court's finding of invalidity of claims in third patent ('895) for indefiniteness and remanded.

With respect to inequitable conduct, the Federal Circuit rejected Praxair's argument that because the withheld reference did not anticipate the '115 patent it was not material to '115. Materiality is decided based on the overall degree of similarity in light of all prior art. The Federal Circuit refused to entertain the argument that the withheld reference was cumulative and thus not material because Praxair raised it for the first time on appeal. The Federal Circuit inferred intent to deceive based on findings: (1) that the reference was highly material, (2) that the applicants knew of the reference and knew or should have known of its materiality, and (3) that the patentee failed to come forward with any credible good faith explanation for the applicants' failure to disclose the reference to the PTO. Materiality was high because the prior art would have directly contradicted four statements made by Praxair while prosecuting '115.

The Federal Circuit reversed the district court's inequitable conduct finding on the '609 patent because the district court had improperly relied on statements made only during the prosecution of the '115 patent. They were not in the prosecution history of '609 and Praxair had not argued that the unenforceability of the '115 infected the '609.

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.

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.

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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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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

Patent Attorney/Patent Agent Position

Klein, O'Neill & Singh, LLP is a cutting edge Intellectual Property law firm with offices in Irvine and San Jose, CA. Our mission is to provide top-quality service for our clients, and our employees share that vision. Klein, O'Neill & Singh offers a collegial and creative work environment, with excellent compensation and benefits.

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: acalumpang@koslaw.com. For more information about our firm, please visit our website: www.koslaw.com.
10/08

Patent Attorney Position

The Intellectual Property Division of Canon U.S.A., Inc. has an opening for an in-house Patent Attorney. This position acts as legal counsel to the IP Division and maintains company patent applications, trade secrets, trademarks, copyrights, licensing and research agreements. Primarily, the Patent Attorney will be responsible for preparing legal opinions, analysis of patents, and reviewing and drafting significant corporate documentation. Other responsibilities include evaluation of validity of competitor patents and potential infringements that require recommendation and study.

Minimum Requirements

This position requires a JD degree plus 3 years of prior patent/IP experience in the area of electrical engineering, chemistry or physics, and you must be registered with the U.S. Patent and Trademark Office. The ideal candidate will demonstrate strong written and verbal communication skills with technical depth and patent expertise.

About the Company

Canon U.S.A., Inc. is an industry leader in consumer, business-to-business, and industrial imaging solutions. The company offers a comprehensive line of imaging solutions and products for our customers from individual consumers to large corporate enterprises. Canon is listed as one of Fortune's Most Admired Companies in America and is rated #35 on the BusinessWeek list of 'Top 100 Brands.' Its parent company, Canon Inc. (NYSE: CA) is a top patent holder of technology, ranking second overall in the U.S. in 2005, with global revenues of $31.8 billion. For more information, visit www.usa.canon.com

If interested, please apply online at:
http://track.jobviper.com/ViewJob.asp?id=528482-1248-5036
10/08

Patent Agent Position

The Intellectual Property Division of Canon U.S.A., Inc. has an opening for an in-house Patent Agent. The primary responsibilities include reviewing and filing provisional and utility patent applications and responding to Office Actions and other USPTO correspondence. Additional responsibilities include drafting provisional and utility patent applications, performing prior and patentability searches, evaluations of third party patents, and supporting contract and licensing activities.

Minimum Requirements

This position requires a Bachelors degree plus 3 years of prior patent/IP experience in the area of electrical engineering, chemistry or physics, and you must be registered with the U.S. Patent and Trademark Office. The ideal candidate will demonstrate strong written and verbal communication skills with technical depth and patent expertise, a high degree of attention to detail, an ability to organize assignments, work under pressure and meet deadlines.

About the Company

Canon U.S.A., Inc. is an industry leader in consumer, business-to-business, and industrial imaging solutions. The company offers a comprehensive line of imaging solutions and products for our customers from individual consumers to large corporate enterprises. Canon is listed as one of Fortune's Most Admired Companies in America and is rated #35 on the BusinessWeek list of 'Top 100 Brands.' Its parent company, Canon Inc. (NYSE: CA) is a top patent holder of technology, ranking second overall in the U.S. in 2005, with global revenues of $31.8 billion. For more information, visit www.usa.canon.com

If interested, please apply online at:
http://track.jobviper.com/ViewJob.asp?id=528492-1248-6036
10/08

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.

For more information about LS9, please visit our website: www.ls9.com.
10/08

Orange County Patent Law Association
P.O. Box 7632
Newport Beach, CA 92658
www.ocpla.org

2008 OCPLA MEMBERSHIP APPLICATION/RENEWAL FORM

This is an application for (please check one):

☐ **Membership Renewal** ☐ **New Membership**

Member / Applicant Information:

Name: ______________________________

Firm/Employer: ______________________________

Address: ______________________________

E-mail Address (**required to receive newsletter**): ______________________________

Telephone No.: ______________________________ Facsimile No.: ______________

Professional Information:	Yes	No	
Are you a member of the California bar?	___	___	Bar No. ______________
Are you a member of the bar of another state or the District of Columbia?	___	___	Jurisdiction/Bar No. ______________
Are you registered to practice before the U.S.P.T.O.?	___	___	Reg. No. ______________
Are you a student?	___	___	School: ______________

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

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

Dues Membership Year 2008* (please circle one):

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

* For new members signing up for 2008 after 8/1/2008, membership fee is one half of that listed above

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New Applicants please complete the following:

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

Applicant's Signature: ______________________________ Date: ______________

Printed Name: ______________________________

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

2008 OCPLA EVENTS SCHEDULE

Date	Location	Speaker/Event	Topic
October 15, 2008	Wyndham Garden Hotel	Joe Re Knobbe, Martens, Olson & Bear, LLP	In Defense of the Clear and Convincing Standard for Proving Patent Invalidity
November 19, 2008	Wyndham Garden Hotel	Jacques Nack Ngue Founder, eClaris, LLC	Effective Strategies For Conducting eDiscovery
December 4, 2008	Sage on the Coast	5:30 Cocktails 6:30 Dinner	OCPLA Holiday Party

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LAIPLA

Los Angeles Intellectual Property Law Association

together with the

The Federal Circuit Bar Association BENCH & BAR

Presents

The Federal Circuit In Los Angeles

An LAIPLA Judge's Night Event

Friday, November 7, 2008
Beverly Wilshire Hotel

Special Guests

Judges from the local judiciary and Judge Arthur J. Gajarsa of the Court of Appeals for the Federal Circuit and Circuit Executive Jan Horbaly

Dinner Speaker

Federal Circuit Judge Arthur J. Gajarsa

Afternoon MCLE Seminar

"Are the Courts Meeting the Needs of the Technology Community?"

Individual Pricing	Tables	Friday November 7, 2008
Reception & Dinner $175 for Members * & Guests $250 for Non-Members & Guests **Afternoon Seminar & Reception** $145 for Members * $195 for Non-Members $75 for Students * Members of LAIPLA, FCBA, & OCPLA	**Sponsor Table** $2,500 for table of 10 and special recognition in program	**The Beverly Wilshire Hotel** 9500 Wilshire Boulevard Le Grand/Le Petit Trianon Beverly Hills, CA **(213) 275-5200** Afternoon Seminar at 4:00 PM Reception at 6:00 PM Dinner at 7:00 PM

EVENT SUPPORTED BY

- SEE ATTACHED REGISTATION FORM –

LAIPLA
Los Angeles Intellectual Property Law Association

REGISTRATION FORM
The Federal Circuit In Los Angeles & Seminar
November 7, 2008

Please complete the following form and return with your payment as follows:

LAIPLA - 1430 South Grand Avenue, # 256, Glendora, CA 91740 **OR** Fax the form to: (626) 974-5439

MCLE Seminar: ___ Member * $145 ___ Non-Member $195 ___ Student $75

Reception & Dinner: ___ Member * $175 ___ Non-Member $250

___ Sponsor Table $2,500 (includes 10 attendees or 8 attendees and 2 event guests, if available)

___ I/We want to be the Key Sponsor of this event – Contact Scott Hansen at 310- 824-5555

* Members of LAIPLA, FCBA, & OCPLA

Name: ______________________ State Bar Number (if any): ______________________

Firm: ______________________ E-Mail: ______________________

Address: ______________________ Tel: ____________ Fax: ____________

Visa/MC/Amex (circle one): #______________________ Expiration Date: ________ Code on of Card: ________

Print Name as it appears on card: ______________________ Signature: ______________________

Please list all attendees from company/firm:

______________________ ______________________

______________________ ______________________

______________________ ______________________

______________________ ______________________

Please reserve early. We expect a sold-out event. Reservations made by phone, fax, e-mail and U.S. mail are considered made in good faith and you will be responsible for payment. Cancellations or refunds must be received by LAIPLA by noon, Tuesday, November 4, 2008. No cancellations or refunds will be honored after this date and time. Walk-in registrants will be accommodated only as space permits. **Credit card payments will be accepted.**

OCPLA Election of Officers Annual Meeting

Wyndham Garden Hotel
Wednesday, October 15, 2008
12:00 p.m.

All OCPLA Members must submit their vote.
The Officers and Board of Directors up for Election and Re-election for 2009 are:

V.P./President Elect .... Marlene Klein

Secretary .... Tom Dao

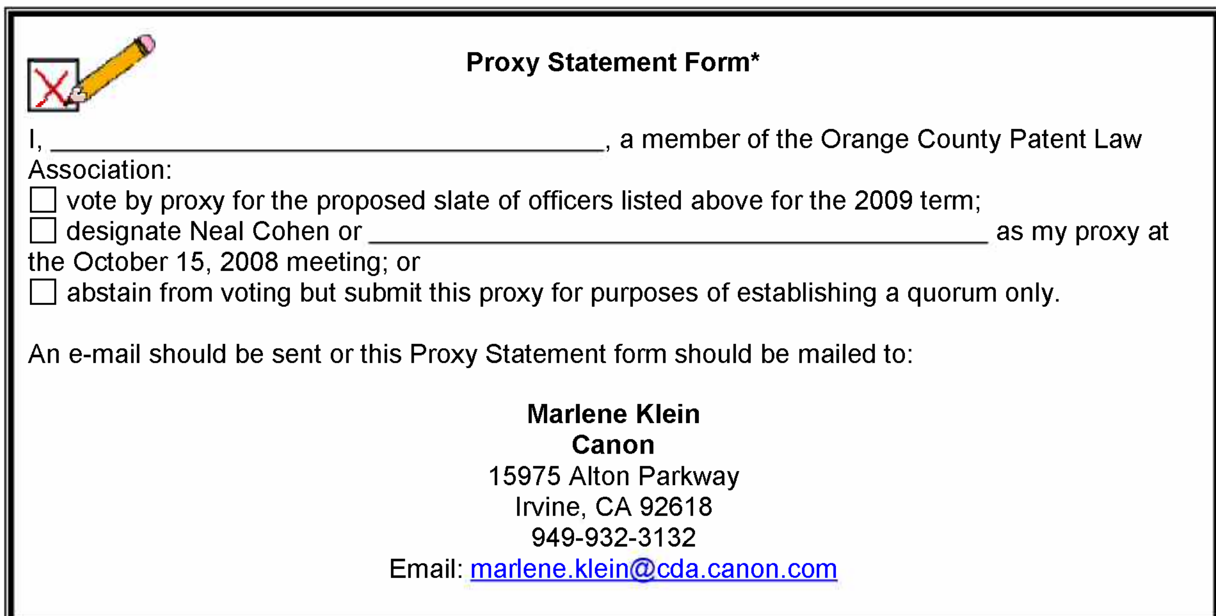
C.F.O./Treasurer .... Stacey Halpern

Director .... Valerie Sarigumba

Director .... Alyson Barker

Director .... Sean O'Neill

The President for the year 2009 will be TJ Singh



Proxy Statement Form*

I, ______________________________, a member of the Orange County Patent Law Association:
☐ vote by proxy for the proposed slate of officers listed above for the 2009 term;
☐ designate Neal Cohen or ______________________________ as my proxy at the October 15, 2008 meeting; or
☐ abstain from voting but submit this proxy for purposes of establishing a quorum only.

An e-mail should be sent or this Proxy Statement form should be mailed to:

Marlene Klein
Canon
15975 Alton Parkway
Irvine, CA 92618
949-932-3132
Email: marlene.klein@cda.canon.com

*If you are unable to attend the Annual Election Meeting on October 15, 2008, please fill out this proxy statement form and return prior to the meeting.