



# OCPLA NEWSLETTER

Orange County Patent Law Association

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

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January 2007

## JANUARY 2007 LUNCHEON

Please join us at our next lunch meeting **NEXT WEDNESDAY, January 24**, when we are pleased to present Brent J. North of North & Nash LLP, who will speak on "Elimination of Bias".

Please note that this presentation will provide those difficult to obtain MCLE **Elimination of Bias Credits**.

*The lunch meeting will be held at noon at the Wyndham Garden Hotel.*

## CALL FOR SPEAKERS

The Board of Directors is currently arranging speakers and topics for the OCPLA 2007 monthly luncheon meetings. As usual, the topics can be directed at any aspect of intellectual property law. If you are interested in speaking, or know someone who may be interested in speaking, at one of the monthly meetings, please contact Greg Hollrigel at [ghollrigel@coopervision.com](mailto:ghollrigel@coopervision.com) or at 949-597-4700 x3341.

## FEBRUARY BOARD MEETING

The February Board meeting will be held on February 7, 2007 at noon at the offices of Mr. Cousins at McPherson, Kwok, Chen & Heid. Members who wish to present items for the Board's consideration should contact our president, Greg Hollrigel, to have their item

placed on the agenda, and to verify the time and location of the meeting.

## NEW MEMBERS

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

Lance Smemoe of Knobbe, Martens, Olson & Bear, LLP

Choongseop Lee of Knobbe, Martens, Olson & Bear, LLP

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

## PLEASE RSVP ON TIME FOR MONTHLY LUNCHEONS

To reduce the likelihood of additional rate increases associated with last minute reservations, please RSVP early, i.e., no later than noon on the Friday preceding the meeting, so that we can provide more accurate numbers of luncheon attendees to the hotel. Your effort to register at least five days in advance of the lunches is greatly appreciated by the hotel and the OCPLA Board.

The cost for the monthly luncheon meetings for student members is \$15.

**RECENT IP CASES**

**BY IRFAN LATEEF  
KNOBBE, MARTENS, OLSON & BEAR**

MedImmune, Inc. v. Genentech, Inc.

In *MedImmune, Inc. v. Genentech, Inc.*, No. 05-608, \_\_\_ U.S. \_\_\_ (2007) (Scalia, J.), the Supreme Court (8-1 decision) reversed the Federal Circuit's and district court's dismissal for lack of subject-matter jurisdiction based on no justiciable controversy. MedImmune had sought a declaratory judgment of invalidity on a patent related to a children's respiratory drug that it licensed from Genentech. Instead of breaching the licensing agreement based on its beliefs of invalidity, however, MedImmune continued to make royalty payments to Genentech under protest throughout the declaratory judgment proceedings. This prompted Genentech to argue that MedImmune's complaint should be dismissed for lack of a justiciable controversy. The Supreme Court granted certiorari to decide whether a patent licensee in good standing must terminate or be in breach of its license agreement before it can seek a declaratory judgment that the underlying patent is invalid, unenforceable, or not infringed. Justice Scalia, writing for the majority, held that MedImmune had satisfied the legal requirement for a controversy, even though it continued to make royalty payments. The Court concluded that the requirements of a case or controversy are met where payment of a claim is demanded as of right and where payment is made, but where the "involuntary or coercive nature of the exaction" preserves the right to recover the sums paid or to challenge the legality of the claim. Justice Thomas dissented, arguing that MedImmune was seeking a declaratory judgment for the purpose of obtaining a ruling on matters that remained hypothetical or conjectural and therefore presented no case or controversy.

**PTO UPDATE**

**BY GREG S. HOLLRIGEL  
COOPERVISION, INC.**

Elimination of Disclosure Document Program on February 1, 2007

Effective February 1, 2007, the USPTO will eliminate the Disclosure Document Program. Apparently use of disclosure documents was extremely rare and it is believed that the benefits provided by provisional patent applications outweigh the benefits of disclosure documents. The USPTO will continue to accept disclosure documents until January 31, 2007. Disclosure documents received on or after February 1, 2007 will be returned to the sender.

For further information, see the notice at

<http://www.uspto.gov/web/offices/com/speeches/06-67.htm>

and the Federal Register notice at

<http://www.uspto.gov/web/offices/com/sol/notices/71fr64636.pdf>.

Electronic Office Action Notifications

On December 16, 2006, the USPTO began a pilot program to provide electronic notifications of outgoing correspondence regarding US national patent applications and patents. This pilot program was designed for a limited number of Private PAIR users who expressed interest in participating in the program. Apparently, the program is currently full. The electronic notification does not apply to PCT patent applications.

However, some discrepancies have been reported regarding discrepancies between the notification date provided for correspondence viewed in Private PAIR and the actual email notification date. For those of you participating in this Pilot Program, it would probably be worthwhile carefully monitoring the accuracy of

the information of the different communications you receive from the USPTO.

For further information, see the notice at

<http://www.uspto.gov/web/offices/pac/dapp/opa/preognotice/eofficeaction.pdf>.

### **Internet Patent Practice Tools/Sites**

**By Greg S. Hollrigel  
CooperVision, Inc.**

When I first started practicing, I was often frustrated at the relative difficulty of finding and obtaining information regarding patents, searching for patents, and hearing what other practitioners were doing and talking about. Over the years, in my quest to improve my efficiency and remain current in trends involving patent practice and various patent offices, I have begun maintaining lists of internet websites that have useful information and I think help improve my work.

At the chance of presenting something you already know, I decided to compile a list of resources that are useful to me, whether it is for obtaining patent information regarding various foreign patent applications, learning about new practical developments in patent practice, hearing gossip about trends and USPTO events/policies, or remaining current on recent court cases. Hopefully, at least some of you will find this list useful, and can use it as a tool in your practice or for your amusement.

### Patent Offices With Access to Online Patent Information

US - <http://www.uspto.gov>  
 Canada - <http://cipo.gc.ca/>  
 Australia - <http://www.ipaustralia.gov.au/>  
 Europe - <http://www.epoline.org/portal/public>  
 Japan - <http://www.jpo.go.jp/>  
 WIPO - <http://www.wipo.int/pctdb/en/>  
 Germany - <http://depatinet.dpma.de>

### Electronic Filing and PAIR Discussion Lists

You can review the instructions for joining the email discussion groups at the websites below.

EFS Web Information  
<http://www.patents.com/efsweb/>

PAIR  
<http://www.oppedahl.com/pair/>

PCT  
<http://www.oppedahl.com/pct/>

### Patent Blogs

Patent Prospector -  
<http://www.patenthawk.com/blog/>

Just a Patent Examiner -  
<http://just-n-examiner.livejournal.com/>

Patently-O -  
<http://patentlyo.com/>

Patent Japan -  
<http://patent-japan.blogspot.com/>

Patent Docs -  
<http://patentdocs.typepad.com/>

Patent Baristas -  
<http://www.patentbaristas.com/>

FedCirc.US -  
<http://www.fedcirc.us/home/index.php>

### **SHOULD YOU TAKE ON THE US GOVERNMENT<sup>1</sup>?**

**BY MICHAEL MANSOUR AHMADSHAHI  
 LAW OFFICES OF MICHAEL M. AHMADSHAHI,  
 A.P.C.**

### **INTRODUCTION**

The United States annual budget is approximately two (2) trillion dollars. The Department of Defense alone spent \$375.7

billion in 2004 and its estimated spending budget for 2005 and 2006 are \$400.1 billion and \$419.3 billion, respectively<sup>1</sup>. The U.S. Government invariably will spend some of that money to purchase and use a slue of manufactured articles from contractors and subcontractors, domestic and foreign, in order to carry out its programs. What if you own a patent or copyright on such article? Can U.S. Government be held liable for infringement?<sup>2</sup> Should you take on the U.S. Government for infringing your patent or copyright?

This article addresses the applicable laws and procedures that a patent owner<sup>3</sup> may have to traverse to obtain compensation from U.S. Government for infringement. Of particular interest is that a patent owner can not seek injunctive relief, contrary to when the infringer is a private entity. The legislative provisions and administrative procedures, pertaining to patent and copyright infringement by the U.S. Government, will be discussed. A likely scenario in practice will be examined and recommendations as to possible course of actions will be presented.

## **APPLICABLE LAWS**

### **A. Federal Statutes**

The U.S. Constitution<sup>4</sup> confers upon the U.S. Government the power of eminent domain, through the "taking clause" of the Fifth Amendment, to take private property for public use. The Fifth Amendment provides in pertinent part: "nor shall private property be taken for public use, without just compensation."<sup>5</sup> Although it permits the U.S. Government to take private property for public

<sup>1</sup> See *e.g.*

<http://www.gpoaccess.gov/usbudget/fy06/browse.html>

<sup>2</sup> See Dana H. Shultz, *Patents, Copyrights, Government*, California Bar Journal, April 2005, at 14.

<sup>3</sup> A copyright owner faces similar hurdles when seeking relief for infringement by the U.S. Government. Any differences between the two will be cited.

<sup>4</sup> U.S. Constitution, Amendment V.

<sup>5</sup> See *Id.*

use, it "bar[s it] from forcing some people alone to bear public burdens which, in all fairness and justice, should be borne by the public as a whole."<sup>6</sup> Claims against the U.S. Government for Patent and copyright infringements, a taking of private intellectual property, are governed by the Tucker Act of 1887, as codified in 28 U.S.C. §1491<sup>7</sup>, *et seq.*, as amended. It provides in pertinent part: "The United States Claims Court<sup>8</sup> shall have jurisdiction to render judgment upon any claim against the United States founded either upon the Constitution, or any Act of Congress or any regulation of an executive department, or upon any express or implied contract with the United States, or for liquidated or unliquidated damages in cases not sounding in tort."<sup>9</sup>

A patent owner's claim for infringement is a claim "not sounding in tort." The federal law governing patent infringement claims against the U.S. Government is 28 U.S.C. §1498<sup>10</sup>, *et*

<sup>6</sup> *Armstrong v. United States*, 364 U.S. 40, 49 (1960).

<sup>7</sup> 28 U.S.C. §1491. Claims against United States generally; actions involving Tennessee Valley Authority

(a)(1) The United States Court of Federal Claims shall have jurisdiction to render judgment upon any claim against the United States founded either upon the Constitution, or any Act of Congress or any regulation of an executive department, or upon any express or implied contract with the United States, or for liquidated or unliquidated damages in cases not sounding in tort. For the purpose of this paragraph, an express or implied contract with the Army and Air Force Exchange Service, Navy Exchanges, Marine Corps Exchanges, Coast Guard Exchanges, or Exchange Councils of the National Aeronautics and Space Administration shall be considered an express or implied contract with the United States.

<sup>8</sup> See <http://www.uscfc.uscourts.gov>

<sup>9</sup> See *supra* note 8.

<sup>10</sup> 28 U.S.C. §1498 states in pertinent part: Patent and copyright cases:

(a) Whenever an invention described in and covered by a patent of the United States is used or manufactured by or for the United States without license of the owner thereof or lawful right to use or manufacture the same, the owner's remedy shall be by action against the United States in the United States Court of Federal Claims for the recovery of

*seq.* It states in pertinent part: "Whenever an invention described in and covered by a patent of the United States is used or manufactured by or for the United States without license of the owner thereof or lawful right to use or manufacture the same, the owner's remedy shall be by action against the United States in the United States Court of Federal Claims for the recovery of his reasonable and entire compensation for such use and manufacture."<sup>11</sup>

A significant limitation of this law is that the patent owner is barred from seeking injunctive relief. Ordinarily, when faced with an infringer, the patent owner initially tenders a cease and desist letter to the infringer, apprising the infringer of a looming litigation. If pre-litigation negotiation fails, the patent owner most likely will file a temporary restraining order to prevent the infringer from further infringement. This bargaining position is lacking, however, when the infringer is the U.S. Government. The patent owner, assuming he has the time, money, and incentive to wage a protracted legal battle<sup>12</sup>, will have to prosecute its claim while the Government continues its infringing

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his reasonable and entire compensation for such use and manufacture. Reasonable and entire compensation shall include the owner's reasonable costs, including reasonable fees for expert witnesses and attorneys, in pursuing the action if the owner is an independent inventor, a nonprofit organization, or an entity that had no more than 500 employees at any time during the 5-year period preceding the use or manufacture of the patented invention by or for the United States.

Notwithstanding the preceding sentences, unless the action has been pending for more than 10 years from the time of filing to the time that the owner applies for such costs and fees, reasonable and entire compensation shall not include such costs and fees if the court finds that the position of the United States was substantially justified or that special circumstances make an award unjust.

<sup>11</sup> See *Id.*

<sup>12</sup> In a successful suit, the patent owner may recover "reasonable costs, including reasonable fees for expert witnesses and attorneys, in pursuing the action if the owner is an independent inventor, a nonprofit organization, or an entity that had no more than 500 employees. . ." 28 U.S.C. §1498(a).

activities. Furthermore, the patent owner may recover damages for infringement up to the time of suit only. There is no provision for recovery of damages for unauthorized use in the future.

### **B. Federal Regulations-Administrative Procedures**

The policy governing patent litigation against U.S. Government presses for administrative adjudication prior to filing suit.<sup>13,14</sup> In fact, this is preferable by most businesses as an alternative to costly litigation. Different Departments of the U.S. Government have different administrative procedures. The Department of Defense, for instance, requires that the patent owner meet 17 requirements for filing a patent infringement claim.<sup>15</sup> Upon filing

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<sup>13</sup> 48 CFR §227.7001 Policy.

Whenever a claim of infringement of privately owned rights in patented inventions or copyrighted works is asserted against any Department or Agency of the Department of Defense, all necessary steps shall be taken to investigate, and to settle administratively, deny, or otherwise dispose of such claim prior to suit against the United States. This subpart 227.70 does not apply to licenses or assignments acquired by the Department of Defense under the Patent Rights clauses.

<sup>14</sup> 48 CFR §227.7002 Statutes pertaining to administrative claims of infringement.

Statutes pertaining to administrative claims of infringement in the Department of Defense include the following:

- A. The Foreign Assistance Act of 1961, 22 U.S.C. 2356 (formerly the Mutual Security Acts of 1951 and 1954);
- B. The Invention Secrecy Act, 35 U.S.C. 181–188; 10 U.S.C. 2386; 28 U.S.C. 1498; and 35 U.S.C. 286.

<sup>15</sup> 48 CFR §227.7004 Requirements for filing an administrative claim for patent infringement.

(a) A patent infringement claim for compensation, asserted against the United States under any of the applicable statutes cited in 227.7002, must be actually communicated to and received by a Department, agency, organization, office, or field establishment within the Department of Defense.

Claims must be in writing and should include the following:

- (1) An allegation of infringement;
  - (2) A request for compensation, either expressed or implied;
  - (3) A citation of the patent or patents alleged to be infringed;
  - (4) A sufficient designation of the alleged infringing item or process to permit identification, giving the military or commercial designation, if known, to the claimant;
  - (5) A designation of at least one claim of each patent alleged to be infringed; or
  - (6) As an alternative to (a) (4) and (5) of this section, a declaration that the claimant has made a bona fide attempt to determine the item or process which is alleged to infringe, but was unable to do so, giving reasons, and stating a reasonable basis for his belief that his patent or patents are being infringed.
- (b) In addition to the information listed in (a) of this section, the following material and information is generally necessary in the course of processing a claim of patent infringement. Claimants are encouraged to furnish this information at the time of filing a claim to permit the most expeditious processing and settlement of the claim.
- (1) A copy of the asserted patent(s) and identification of all claims of the patent alleged to be infringed.
  - (2) Identification of all procurements known to claimant which involve the alleged infringing item or process, including the identity of the vendor or contractor and the Government procuring activity.
  - (3) A detailed identification of the accused article or process, particularly where the article or process relates to a component or subcomponent of the item procured, an element by element comparison of the representative claims with the accused article or process. If available, this identification should include documentation and drawings to illustrate the accused article or process in suitable detail to enable verification of the infringement comparison.
  - (4) Names and addresses of all past and present licensees under the patent(s), and copies of all license agreements and releases involving the patent(s).
  - (5) A brief description of all litigation in which the patent(s) has been or is now involved, and the present status thereof.
  - (6) A list of all persons to whom notices of infringement have been sent, including all departments and agencies of the Government, and a statement of the ultimate disposition of each.

the claim and receiving a favorable outcome, the Department will commence with a determination of the appropriate damages with guidance from court decisions applicable to the claim at hand. According to precedence, “[t]he [appropriate] measure of [damages] is what the owner has lost, not what the taker has gained.”<sup>16</sup>

### **RECOVERY FOR DAMAGES**

In order to assess what the patent or copyright owner has lost, the Department will look into existing licensing agreements between the owner and other parties. Absent such agreements, the Department will likely “chase to apply the ‘willing buyer-willing seller’ rule in determining a reasonable royalty.”<sup>17</sup> If it is impractical to apply such rule, the Department’s position is that “savings to the government may be considered in determining reasonable compensation.”<sup>18</sup> If such options are unavailable, the policy of the U.S. Government is to negotiate with the patent or

(7) A description of Government employment or military service, if any, by the inventor and/or patent owner.

(8) A list of all Government contracts under which the inventor, patent owner, or anyone in privity with him performed work relating to the patented subject matter.

(9) Evidence of title to the patent(s) alleged to be infringed or other right to make the claim.

(10) A copy of the Patent Office file of each patent if available to claimant.

(11) Pertinent prior art known to claimant, not contained in the Patent Office file, particularly publications and foreign art. In addition in the foregoing, if claimant can provide a statement that the investigation may be limited to the specifically identified accused articles or processes, or to a specific procurement, it may materially expedite determination of the claim.

<sup>16</sup> *Leesona Corp. v. United States*, 599 F.2d. 958, 969 (Ct. Cl. 1979).

<sup>17</sup> *Georgia-Pacific Corp. v. United State Plywood Corp.*, 318 F.Supp. 1116, 1120 (S.D.N.Y. 1970), *modified* 446 F.2d. 295 (2d Cir. 1971).

<sup>18</sup> *Leesona*, 599 F.2d. at 971.

copyright owner a reasonable solution to the dispute.<sup>19</sup>

Of particular interest to patent and copyright owners who may be planning to sue the U.S. Government for infringement, is the preclusion of injunctive relief as a means for recovery.<sup>20</sup> Accordingly, the U.S. Government is in a unique position to continue infringing the owner's intellectual property rights indefinitely. Knowing that most owners lack the money<sup>21</sup>, time, and incentive to wage a protracted legal battle, the Government is, in effect, saying: "if you don't like this offer, sue us!" Since the owner is barred from obtaining injunction against the Government, and that there is no recovery for projected unauthorized use in the future, and considering further the applicable statutes of limitations<sup>22,23</sup>, the U.S. Government is, in effect, free to continue infringement of the owner's rights and the latter is forced to go back to court repeatedly for the duration of the patent (20 years) or copyright (at least 70 years). Consequently, it is highly recommended to negotiate with the Government rather than litigate.

### **INFRINGEMENT BY ENTITIES ACTING ON BEHALF OF THE U.S. GOVERNMENT**

As stated above, the U.S. Government invariably will purchase a variety of manufactured articles from contractors and

subcontractors, domestic and foreign, in order to carry out its programs. The unauthorized use or manufacture of patented or copyrighted articles by such contractors or subcontractors (referred to as "agents"), on behalf of the U.S. Government, is similarly prohibited as "use or manufacture for the United States."<sup>24</sup>

With respect to patents: "use or manufacture of an invention . . . by a contractor, a subcontractor, or any person, firm, or corporation for the Government and with the authorization or consent of the Government, shall be construed as use or manufacture for the United States."<sup>25</sup>

With respect to copyrights: "whenever the copyright in any work protected under the copyright laws of the United States shall be infringed by the United States, by a corporation owned or controlled by the United States, or by a contractor, subcontractor, or any person, firm, or corporation acting for the Government and with the authorization or consent of the Government, the exclusive action which may be brought for such infringement shall be an action by the copyright owner against the United States."<sup>26</sup>

Government "authorization or consent" can be expressed or implied. Express authorization or consent may come in many forms, including "by contracting officer instructions, by specifications or drawings which impliedly sanction and necessitate infringement, [or] by

<sup>19</sup> See *supra* note 14.

<sup>20</sup> See *supra* note 11.

<sup>21</sup> "Reasonable and entire compensation shall include the owner's reasonable costs, including reasonable fees for expert witnesses and attorneys, in pursuing the action if the owner is an independent inventor, a nonprofit organization, or an entity that had no more than 500 employees at any time during the 5-year period preceding the use or manufacture of the patented invention by or for the United States." 28 U.S.C. §1498(a). See *supra* note 14.

<sup>22</sup> A copyright claim must be filed within three (3) years from the time the claim accrues. 28 U.S.C. §2501(a).

<sup>23</sup> A patent claim must be filed within six (6) years from the time the claim accrues. 28 U.S.C. §1498(b).

<sup>24</sup> 28 U.S.C. §1498.

<sup>25</sup> 28 U.S.C. §1498(a).

<sup>26</sup> 28 U.S.C. §1498(b) states in pertinent part: (b) Hereafter, whenever the copyright in any work protected under the copyright laws of the United States shall be infringed by the United States, by a corporation owned or controlled by the United States, or by a contractor, subcontractor, or any person, firm, or corporation acting for the Government and with the authorization or consent of the Government, the exclusive action which may be brought for such infringement shall be an action by the copyright owner against the United States in the Court of Federal Claims for the recovery of his reasonable and entire compensation as damages for such infringement, including the minimum statutory damages as set forth in section 504(c) of title 17, United States Code

post hoc intervention of the Government in pending infringement litigation against individual contractors."<sup>27</sup> An express authorization or consent will be found where the government requires the private contractor to use or manufacture the allegedly infringing device, even if the government does not know that the device infringes a patent.<sup>28</sup> In addition, authorization or consent can be implied.<sup>29</sup> "In proper circumstances, Government authorization can be implied . . . by the specific requirement that . . . [the contractor] demonstrate, under the guidelines of the bidding procedure, the allegedly infringing [device]."<sup>30</sup>

Government employees are barred from suing the U.S. Government for infringement if (1) the patented or copyrighted work was invented or prepared "while in the employment or service of the United States, or (2) they were in a position to "order, influence, or induce" use of the patented or copyrighted work.<sup>31,32</sup>

<sup>27</sup> *Hughes Aircraft Co. v. United States*, 209 Ct. Cl. 446, 465, 534 F.2d 889, 901 (1976).

<sup>28</sup> *TVI Energy Corp. v. Blane and Blane Enterprises, Inc.*, 806 F.2d 1057, 1060 (Fed. Cir. 1986).

<sup>29</sup> *Ibid.*

<sup>30</sup> *Ibid.*

<sup>31</sup> 28 U.S.C. §1498(a) states in pertinent part:  
(a) A Government employee shall have the right to bring suit against the Government under this section except where he was in a position to order, influence, or induce use of the invention by the Government. This section shall not confer a right of action on any patentee or any assignee of such patentee with respect to any invention discovered or invented by a person while in the employment or service of the United States, where the invention was related to the official functions of the employee, in cases in which such functions included research and development, or in the making of which Government time, materials or facilities were used.

<sup>32</sup> 28 U.S.C. §1498(b) states in pertinent part:  
(b) [A] Government employee shall have a right of action against the Government under this subsection except where he was in a position to order, influence, or induce use of the copyrighted work by the Government: Provided, however, That this subsection shall not confer a right of action on any copyright owner or any assignee of such owner with respect to any copyrighted work prepared by a person while in the employment or service of the

Finally, Government liabilities, at least with respect to the provisions of §1498, are limited to activities within the territorial limits of the United States.<sup>33</sup> Accordingly, patent or copyright owners can not sue the Government for "acts in foreign countries that would be infringements at home."<sup>34</sup>

### **A LIKELY SCENARIO IN PRACTICE AND RECCOMENDATIONS**

You are an attorney representing a client who provides articles of manufacture to the U.S. Government. The client contacts you and says that one of its patented/copyrighted articles is being "outsourced" by the U.S. Government abroad. That the Government has an agreement, with a foreign company in a foreign country, to use infringing articles, which are manufactured abroad by the foreign company, here in the United States. The following are some suggestions that might be instrumental in negotiations with the Government and/or reasonable compensation for your client:

1. Determine if the client owns similar patent/copyright in the foreign country and if so whether enforcing these rights in that foreign country is practical.
2. Determine which governmental Department(s) is/are procuring the infringing article and research the procedure establishing the requirements for filing a claim.
3. Compose a detailed documentation of infringing activities since the Departmental procedures require you

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United States, where the copyrighted work was prepared as a part of the official functions of the employee, or in the preparation of which Government time, material, or facilities were used.

<sup>33</sup> 28 U.S.C. §1498(c) states in pertinent part:  
(c) The provisions of this section shall not apply to any claim arising in a foreign country.

<sup>34</sup> [\*Decca Limited v. United States\*, 210 Ct. Cl. 546, 550, 544 F.2d 1070, 1072 \(1976\), cert. denied, 454 U.S. 819 \(1981\).](#)

to provide explicit allegation of infringement.

4. Determine a reasonable royalty fees for the client.
5. Negotiate with the Government before filing the claim.
6. If negotiation fails, file suit before the applicable statute of limitation run.

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.

### OCPLA WEBSITE

Check the OCPLA website at [www.ocpla.org](http://www.ocpla.org) for copies of the OCPLA newsletter, membership information, current events of interest to members, and online reservations for OCPLA events. Let us have your comments. We will be making changes and improvements as time passes, and your comments will be useful in knowing what to change and what to leave alone. Send comments to "[webmaster@ocpla.org](mailto:webmaster@ocpla.org)."

### NEWSLETTER VIA EMAIL ONLY



**The Newsletter is now being 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 TJ Singh at [tjsingh@koslaw.com](mailto:tjsingh@koslaw.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; (2) Other ads such as word processing, legal support services, and firm announcements will be published for \$15

## BOARD OF DIRECTORS AND COMMITTEE CHAIRS

### BOARD OF DIRECTORS                      TELEPHONE/E-MAIL

<b>President</b>	Greg Holtrigel	(949) 597-4700 gholtrigel@coopervision.com
<b>V.P./President Elect</b>	Neal M. Cohen	(949) 724-1849 nmc@viplawgroup.com
<b>Secretary</b>	T.J. Singh	(949) 955-1920 tjsingh@koslaw.com
<b>C.F.O./Treasurer</b>	Marlene Klein	(949) 932-3132 marlene.klein@cda.canon.com
<b>Directors</b>	Tom Dao	(949) 476-0757 thd@cph.com
	Stacey Halpern	(949) 721-6301 stacey.halpern@kmob.com
	Cliff Cousins	(949) 752-7040 ccousins@macpherson-kwok.com
<b>Immediate Past President</b>	John King	(949) 760-0404 jking@kmob.com

### COMMITTEE CHAIRPERSONS

<b>Annual Seminar</b>	Neal M. Cohen	(949) 724-1849 nmc@viplawgroup.com
	Stacey Halpern	(949) 721-6301 stacey.halpern@kmob.com
<b>Copyright Practice</b>	Darren S. Rimer	(949) 367-1541 darren@rimermath.com
<b>Federal Courts</b>	Robert L. Grabarek, Jr.	(949) 263-8400 rgrabarek@crowell.com
<b>Int'l IP Practice</b>	Alexander R. Schlee	310-545-9851 alexschlee@vjp.de
<b>Law Off. Mgmt.</b>	Gabia Pakstys	650-326-3466 gpakstys@sbcglobal.net
<b>Legislative</b>		<b>Position Open</b>
<b>MCLE</b>	Cliff Cousins	(949) 752-7040 ccousins@macpherson-kwok.com
<b>Meetings/Programs</b>	Stacey Halpern	(949) 721-6301 stacey.halpern@kmob.com
<b>Newsletter Editor</b>	Tom Dao	(949) 476-0757 thd@cph.com
<b>Patent Practice</b>	Tom Dao	(949) 476-0757 tom.dao@cph.com
<b>Trade Secrets/Unfair</b>	Scott Feldmann	(949) 263-8400 rfeldmann@crowell.com
<b>Competition Law</b>	Perry J. Viscosity	714-755-8288 perry.viscosity@lw.com
<b>Trademark Practice</b>	Susan Natland	949-760-0404 smn@kmob.com
<b>Lunch Speakers</b>	Greg Holtrigel	(949) 597-4700 gholtrigel@coopervision.com
<b>OCPLA Website</b>	Marlene Klein	949-932-3132 marlene.klein@cda.canon.com
<b>OCPLA Database</b>	Greg S. Holtrigel	(949) 597-4700 gholtrigel@coopervision.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

**TJ Singh**

Klein, O'Neill & Singh

43 Corporate Park, Suite 204

Irvine, CA 92606

Tel: (949) 955-1920

Fax: (949) 955-1921

E-mail: tjsingh@koslaw.com

**SERVICES, ANNOUNCEMENTS, WANT ADS**

**MARCELO E. SROKA, CPA**

Wertz & Co., CPAs  
5450 Trabuco Road  
Irvine, CA 92620-5074  
949-756-5000 x218

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Fax: 714-754-0500

## Orange County Patent Law Association

**Date:** Wednesday, January 24, 2007

**Time:** 12:00 Noon; Lunch will be served promptly at 12:15 p.m.

**Location:** Wyndham Garden Hotel  
3350 Avenue of the Arts  
Costa Mesa, California

**Topic:** Elimination of Bias

**Speakers:** Brent J. North of North & Nash LLP

**Cost:** \$30 for members, \$15 for students (proof of student status required), and \$35 for non-members

**Reservations:** Please make reservations by using our online system at [www.ocpla.org](http://www.ocpla.org) or by filling out the form below and mailing it with a check to Marlene Klein at her office address given below. If time is short, please also email Marlene at [Marlene.Klein@cda.canon.com](mailto:Marlene.Klein@cda.canon.com) or call in your reservation to her at (949) - 932-3132.

The Orange County Patent Law Association certifies that this activity has been approved for minimum Continuing Legal Education credit by the State Bar Association of California in the amount of 1.0 hour. The Orange County Patent Law Association certifies that this activity conforms to the standards for approved education activities prescribed by the rules and regulations of the State Bar of California governing Minimum Continuing Legal Education. The Orange County Patent Law Association is a State Bar of California MCLE-approved provider.

### Reservation Form

Enclosed is a check for \$\_\_\_\_\_ payable to ORANGE COUNTY PATENT LAW ASSOCIATION for the OCPLA General Membership luncheon on Wednesday, January 24, 2007 for the following person(s):

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This form and check should be mailed to:

Marlene Klein  
Attention: OCPLA Lunch Reservations  
Canon USA  
IP Dept  
15975 Alton Pkwy  
Irvine, CA 92618-3731  
Tel: (949)-932-3132

**E-mail:** [Marlene.Klein@cda.canon.com](mailto:Marlene.Klein@cda.canon.com)



**Orange County Patent Law Association**  
 Orange County Patent Law Association  
 WWW.OCPLA.ORG • P.O. Box 7632 Newport Beach, CA 92658

**2007 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.: \_\_\_\_\_

<b>Professional Information:</b>	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

<b>Dues Membership Year 2007 (please circle one):</b>		<b>(New Member After 08/01/07)</b>
Regular Membership (attorneys, agents):	\$35.00	\$17.50
Student Membership	\$17.50	\$ 8.75
Associate Membership (other)	\$35.00	\$17.50

**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**

**2007 OCPLA EVENTS SCHEDULE**

<b>Date</b>	<b>Location</b>	<b>Speaker/Event</b>	<b>Topic</b>
January 24, 2007	Wyndham Garden Hotel	Brent J. North of North & Nash LLP	Elimination of Bias *MCLE Elimination of Bias Credits*
February 28, 2007	Wyndham Garden Hotel	TBD	TBD
March 28, 2007	Wyndham Garden Hotel	TBD	TBD