



OCPLA NEWSLETTER

Orange County Patent Law Association

www.ocpla.org

Vol. 13, No.2

February 2007

FEBRUARY 2007 LUNCHEON

Please join us on Wednesday, February 28, to hear Joseph Thorpe and Todd King of IQWEST Information Technologies, Inc., provide an overview of current electronic tools and technologies useful in your patent practice.

The presentation will include a discussion of currently available products to assist you in patent litigation, including the ability to comply with the recent amendments to the Federal Rules of Civil Procedure that went into effect on December 1, 2006. In addition, the presentation will include a discussion of some software which can be used in other aspects of your patent practice, such as patent application preparation, due diligence, and opinions.

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

2007 LUNCHEONS

The Wyndham hotel has recently adjusted its price for the lunch meals and has added a parking fee for each attendee. While these costs will affect the 2007 OCPLA budget, the Board of Directors has decided to hold the monthly costs the same. However, the Board may have revisit this issue at a future date depending on its budget.

CALL FOR SPEAKERS

The Board of Directors is still soliciting ideas and suggestions 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 or at 949-597-4700 x3341.

MARCH BOARD MEETING

The March Board meeting will be held on March 7, 2007 at noon at the offices of Mr. Singh at Klein, O'Neill & Singh. Members who wish to present items for the Board's consideration should contact our president, Greg Hollrigel, to have their items 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:

Alyson Barker of Howrey, LLP

Tatsua Baba

Randy K. Change of Jafar Law Group

Gabriel Fitch of Christie, Parker & Hale, LLP

Francis Rushford of Christie, Parker & Hale, LLP

Fariba Sirjani of Christie, Parker & Hale, LLP

Beth Stephenson (Student)

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

2007 SPRING SEMINAR

This year's Spring Seminar will be held on June 8-10 at the beautiful Ritz Carlton Hotel in Dana Point. It will be a joint seminar in conjunction with the LAIPLA, SDIPLA, and SFIPLA. The Board expects a well attended meeting with lots of opportunities to network and mingle with IP attorneys and agents from across the state. More information will be provided as it is received. Please save the dates and hope to see everyone there.

PLEASE RSVP ON TIME FOR MONTHLY LUNCHESES

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

Abbott Laboratories v. Andrx Pharmaceuticals, Inc., et al., Case No. 06-1101. Before MICHEL, PROST and ELLIS. Opinion by PROST.

Summary: affirming grant of preliminary injunction. The denial of preliminary injunctions in two other proceedings against different defendants did not collaterally estop a grant of preliminary injunction in the present case because the determinations in the other proceedings were not sufficiently final to be accorded preclusive effect.

Propat International Corp., et al. v. Rpost, Inc., et al., Case No. 06-1222. Before NEWMAN, MAYER and BRYSON. Opinion by BRYSON.

Summary: affirming dismissal of patent infringement suit for lack of sufficient ownership interest in patent. An agreement providing Propat the right to license a patent, enforce the licenses and sue infringers was insufficient to provide standing, where the patentee retained ownership of the patent, an economic interest in the patent and the right to veto any licenses or transfer of rights under the patent.

Ventana Medical Systems, Inc. v. Biogenex Laboratories, Inc., Case No. 06-1074. Before LOURIE, DYK, and PROST. Opinion by PROST. Dissenting opinion by LOURIE.

Summary: vacating judgment of noninfringement due to an erroneous claim construction. The district court improperly imported a limitation from the specification to interpret the claim term "dispensing" to mean "direct dispensing."

Eli Lilly v. Zenith Goldline, Case No. 05-1396. Before RADER, SCHALL, and GAJARSA. Opinion by RADER.

Summary: affirming trial court's conclusions on the validity of the patent. The trial court's findings of no anticipation, nonobviousness and no public use were not clearly erroneous based on objective evidence.

Plumtree Software, Inc. v. Datamize, LLC, Case No. 06-1017. Before NEWMAN, FRIEDMAN and DYK. Opinion by DYK.

Summary: vacating district court's grant of summary judgment of invalidity based on the on-sale bar. An agreement to perform a service in exchange for valuable consideration that did not unambiguously require use of the patented method in performance of the service was insufficient to trigger the on-sale bar.

Fuji Photo Film Co., LTD. v. International Trade Commission, Case No. 04-1618. Before LOURIE, SCHALL, and DYK. Opinion by DYK.

Summary: The appeal involves the ITC's final determination concerning civil penalties for violation of a cease and desist order issued to Jazz and "officers." The cease and desist order barred Jazz from importing disposable cameras that infringed fifteen of Fuji's patents. The issue before the Commission were whether: (1) the cameras were first sold abroad (making their refurbishment infringing regardless of whether they were repaired or reconstructed); and (2) whether the processes Jazz used to refurbish the cameras first sold in the United States constituted permissible repair or impermissible reconstruction. Fuji challenges the order on the ground that the Commission erred in finding that certain of Jazz's cameras were permissibly repaired. On appeal Benun, an officer of Jazz, challenges the order insofar as it imposes civil penalties.

The Court concluded that Fuji lacked standing to bring this appeal. The Court held that Fuji has no standing to challenge the Commission's penalty determinations unless the civil penalties are "for violations that are ongoing at the time of the complaint and that could continue into the future if undeterred." Because there is no threat here of on-going violations, Fuji lacked standing.

With respect to Benun's appeal, the Court conclude that the Commission had the authority to issue an order against Benun.

The court also held that the ITC did not err in concluding that most of the cameras were impermissibly reconstructed. However, the Court concluded that the ITC did err in holding that the replacement of the full backs of cameras was impermissible reconstruction.

E-Pass Technologies, Inc. v. 3Com Corporation (also known as 3Com, Inc.), et al., Case No. 06-1356. Before MICHEL, LINN and PROST. Opinion by LINN.

Summary: affirming district court's grant of final summary judgment of non-infringement. This case was previously up on appeal, E-Pass I, where the Court reversed summary judgment of non-infringement.

The Court disagreed with E-Pass's argument that the Court's statement in E-Pass I that "issues of material fact remain in dispute as to both literal and doctrine of equivalents infringement under the proper construction" of the term "card" precludes a latter summary judgment based on the same limitation. The Court held that the district court correctly concluded that it had the authority to entertain the defendants' motions for summary judgment on remand.

The Court relied upon the law of the case doctrine with respect to an issue of claim construction despite the fact that after the prior ruling the intervening *en banc Phillips* decision came out. The Court found no direct conflict between the prior claim construction ruling and *Phillips*. The Court went on to affirm the district court's finding that E-Pass failed to supply sufficient evidence of direct infringement of a method claim, despite the evidence of excerpts from the product manuals for various of the accused devices that combined teach all the method steps.

Transclean Corporation et al. v. Jiffy Lube International, Inc., et al, Case No. 06-1077. Before MICHEL, PLAGER, and BRYSON. Opinion by PLAGER.

Summary: affirming district court's grant of summary judgment in favor of defendants because under the doctrine of claim preclusion, a prior judgment against the defendants' supplier bars Transclean from bringing a separate infringement action against the supplier's customers. The Court invoked judicial estoppel to hold Transclean to its repeated concessions that the supplier and its customers (the defendants) were in privity for claim preclusion purposes.

Hydril Company, LP, et al. v. Grant Prideco LP, et al., Case No. 06-1188. Before MAYER, FRIEDMAN, and BRYSON. Opinion by FRIEDMAN, in which BRYSON joins. Dissenting opinion by MAYER.

Summary: reversing the district court's dismissal under Rule 12(b)(6) of Walker Process antitrust and patent claims. The plaintiff brought a declaratory judgment action alleging that the defendant monopolized two product markets by enforcing a patent that had been obtained by fraud on the PTO. The Court held that the patentee's threats of litigation against customers. Based on a fraudulently-procured patent, with a reasonable likelihood that such threats will cause the customers to cease dealing with the plaintiff, are the kind of economic coercion that the antitrust laws are intended to prevent and give rise to jurisdiction.

MBO Laboratories, Inc. v. Becton, Dickinson & Company, Case No. 06-1062. Before BRYSON, CLEVENGER, and GAJARSA. Opinion by GAJARSA.

Summary: affirming the construction of the term "immediately" and reversed as to "slidably receiving," "relative movement," "adjacent," "proximity," and "mounted on said body", and

remanded the case. The claims were broadened during reissue. But the district court limited the broadened terms at least in part on the recapture rule. The Court held that the district court erred by applying recapture rules to rewrite claims to preserve validity.

VAS-CATH, Inc. v. Curators of the University of Missouri, et al., Case No. 06-1100. Before NEWMAN, LOURIE, and RADER. Opinion by NEWMAN.

Summary: reversing the district court's dismissal, on Eleventh Amendment grounds, of Vas-Cath's appeal from the PTO in an interference between Vas-Cath and the University of Missouri. The Court concluded that the Eleventh Amendment does not shield the University from appeal of the PTO's decision in favor of the University. The Court held that by requesting and participating in the interference proceeding in the PTO, the University waived its constitutional immunity not only in that proceeding but also in the appeal taken by the losing party.

Ortho-McNeil Pharmaceutical, Inc. v. Caraco Pharmaceutical Laboratories, Ltd., Case No. 06-1102. Before SCHALL, GAJARSA, and MCKINNEY. Opinion by MCKINNEY.

Summary: affirming district court's grant of summary judgment of noninfringement. The pharmaceutical claim at issue recited a ratio of "about 1:5", which was construed to encompass a range of ratios between 1:3.6 to 1:7.1. The accused product used a ratio of 1:8.67, and the patentee sought a finding of infringement under the doctrine of equivalents. The Federal Circuit found no error in the district court's determination that infringement under the doctrine of equivalents would impermissibly vitiate the limitation.

International Electronic Technology Corp. v. Hughes Aircraft Co., Inc., Case No. 06-1368. Before GAJARSA and MOORE, and

JORDAN, 3rd Circuit Judge sitting by designation. Opinion by GAJARSA.

Summary: dismissing an appeal for lack of jurisdiction because the record did not contain either a dismissal of pending counterclaims or a Rule 54(b) determination by the district court. The Court chastised the parties because it should not be required "to scrub every case to determine finality." The court warned the parties and other members of the bar that the Court will in the future begin to cite and sanction counsel for failure to determine whether or not the appealed judgment is final.

Andersen Corp. v. Fiber Composites, LLC, Case No. 05-1434. Before BRYSON and PROST, and SARIS, District Judge sitting by designation. Opinion by BRYSON.

Summary: reversing summary judgment of infringement on certain patents, affirming judgment, after a jury trial, that those patents were not invalid, and affirming summary judgment of no infringement on other patents.

The Court affirmed the district court's narrow claim construction of "composite composition" claims, despite a claim differentiation argument. The Court found that even though the "composite composition" claims cover substantially the same subject matter that is covered by some other claims, the overlap did not render the other claims redundant.

The Court reversed the district court's claim construction on another term in an apparatus claim based primarily on the prosecution history. The Court stated that the applicant's argument that a prior art reference is distinguishable on a particular ground (here, a process step) served as a disclaimer of claim scope even though the applicant distinguished the reference on other grounds as well. Thus, the Court determined that the apparatus claim included a process limitation.

Israel Bio-Engineering Project v. Amgen, Inc., et al., Case No. 06-1218. Before BRYSON, PROST, and SARIS, District Judge sitting by designation. Opinion by SARIS.

Summary: affirming district court's summary judgment ruling that Israel Bio lacked standing to bring the suit because it did not have sole ownership of the patent. The Court ruled that an inventor was not under an obligation to assign to Israel Bio and that his assignment to Yeda gave Yeda at least a pro rata undivided ownership interest in the whole patent. The Court ruled that without a complete ownership interest or the voluntary joinder of Yeda, Israel Bio lacked standing to sue for infringement.

PTO UPDATE

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

EFS-WEB CHANGES

To be consistent with submissions to the USPTO by fax or first class mail, the USPTO has implemented a change in the regulations to allow the USPTO to treat correspondence submitted by EFS-WEB based on the submission date as opposed to the receipt date by the USPTO. Effectively, this allows documents to be filed by EFS-WEB on the West Coast up to midnight on the due date. Similar to fax transmissions and first class mailings, a "certificate of EFS-WEB transmission" should be included as evidence of the date of submission, if necessary.

In addition, the USPTO has changed the rules to allow EFS-WEB users to rely on the acknowledgment receipt generated upon a filing of a national stage filings and correspondence as evidence of receipt of those documents by the USPTO in the event that the USPTO has no evidence of receipt.

These changes became effective on January 23, 2007.

For further information, see the Federal Register notice at

<http://www.uspto.gov/web/offices/com/sol/notices/72fr2770.pdf>

NEW PROCEDURES FOR NONPROVISIONAL APPLICATIONS HAVING OMITTED ITEMS

If you receive a Notice of Omitted Items in a nonprovisional application, you have the following three options for responding: (i) petition for the date of deposit with an assertion that the omitted item(s) was in fact deposited with the USPTO along with evidence of the deposit and the necessary fee; (ii) petition for a later filing date by filing the omitted item along with a supplemental oath/declaration and the necessary fee; and (iii) accept the application as deposited and filing an appropriate amendment to the application.

Under the new procedures, if an applicant choosed option (iii), the amendment to the application will be required within the extendable time period provided by the Notice to avoid abandonment of the application. In other words, applicants will no longer be able to accept the nonprovisional application as deposited by failing to reply to the notice within the set time period.

Be aware that the USPTO is treating the Notice as a notice or action under 35 U.S.C. § 154(b)(2)(C)(ii) or 37 CFR § 1.704(b), and therefore, failure to reply to the Notice within three months of the mailing date of the Notice will result in a reduction of patent term adjustment.

For further information, see the notice at

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

OCPLA WEBSITE

Check the OCPLA website at www.ocpla.org for current and archived copies of the OCPLA newsletters, 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."

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 Tom Dao at tom.dao@cph.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 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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CONEXANT SYSTEMS
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We have been retained by our client Conexant Systems to conduct a search for a senior patent attorney. The candidate may choose to work in Newport Beach or Sorento Valley, San Diego.

Conexant is a leading provider of broadband communications solutions for consumer, enterprise, personal computer and service provider markets. Products include broadband system-level solutions for modems, routers, residential gateways, settop boxes, and DSLAMs.

JOB DESCRIPTION AND DUTIES

Candidate will be responsible for the preparation and prosecution of patent applications and maintenance of patents for the company. Relevant technologies include video, MPEG, H.264 (high definition MPEG), RF, cable modem, digital subscriber line (DSL), wireless local area networks (WLAN), multi-function-peripherals (MFP), power line communications, voice over IP (VoIP), satellite, and other semiconductor related technologies.

The structure is a hybrid of vertical responsibilities depending on the skill set, technical competencies and the needs of the product lines. Candidate will need experience in a variety of legal and IP areas. The candidate's primary responsibilities will be related to patent prosecution, in U.S. and abroad (India). Travel to Conexant sites in India is required.

The candidate will be responsible for managing the patent portfolio of the company currently consisting of over 1200 U.S. and foreign cases. Secondary responsibilities may also evolve to licensing IP diligence and litigation matters.

With regard to patent prosecution the candidate will be responsible for relationships with various engineers and product lines; harvesting of intellectual property; training; interviewing inventors; preparing and drafting patent applications; working with patent drafters based outside the U.S.; filing; and prosecuting patent applications. The candidate will also manage a case load that is currently prosecuted by outside counsel.

IDEAL CANDIDATE PROFILE

- Experience in communication semiconductors is a huge plus;
- JD with strong academic credentials; excellent writing skills; and a bachelor degree or masters degree in electrical arts (EE, CPRE, physics);
- Member of the Patent bar (USPTO);
- Minimum 5+ years experience as a patent attorney in a law firm with prosecution emphasis; and/or in-house setting at a semiconductor company;
- Experience in managing a patent portfolio; patent prosecution; cultivating, harvesting and managing a patent portfolio; reviewing and evaluating the work of outside law firms and drafters;
- Negotiating and drafting documents, i.e., settlement agreements, licensing and technology agreements, contracts, joint venture agreements, etc.

Please contact Dee Summers for additional information or email your resume for consideration to dee@attorneyplacement.com

Additional position available for Patent Attorney with 3-5 years experience, please call Erin Brownstein for details.

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Orange County Patent Law Association

Date: Wednesday, February 28, 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: Overview of current electronic tools and technologies useful in IP practice

Speakers: Joseph Thorpe and Todd King of IQWEST Information Technologies, Inc.

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 or by filling out the form below and mailing it with a check to Stacey Halpern at her office address given below. If time is short, please also email Stacey at ocpla@kmob.com or call in your reservation to her at [949-721-7654](tel:949-721-7654).

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):

This form and check should be mailed to:

Stacey R. Halpern
Knobbe Martens Olson & Bear LLP
2040 Main Street, 14th Floor
Irvine, CA 92614-3641
[949-721-7654](tel:949-721-7654)
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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.: _____

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 2007 (please circle one):		(New Member After 08/01/07)
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

Date	Location	Speaker/Event	Topic
February 28, 2007	Wyndham Garden Hotel	Joseph Thorpe and Todd King of IQWEST Information Technologies, Inc.	Overview of current electronic tools and technologies useful in IP practice
March 28, 2007	Wyndham Garden Hotel	Gary Augusta of OCTANE	Overview of Orange County's Innovation Environment
April 25, 2007	Wyndham Garden Hotel	Michael Elmer of Finnegan, Henderson, Farabow, Garrett & Dunner	Worldwide Patent Litigation Strategies
May 30, 2007	Wyndham Garden Hotel	TBD	TBD
June 8-10	Ritz Carlton Hotel, Dana Point, CA	2007 SPRING SEMINAR	TBD