



# OCPLA NEWSLETTER

Orange County Patent Law Association

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

Vol. 11, No. 3

March 2005

## APRIL LUNCHEON MEETING

Remember, there is no March lunch meeting at the Wyndham Hotel, due to our Spring Seminar being held March 18-20. After the Spring Seminar, please join us at our next luncheon meeting on Wednesday, April 27, 2005, when we are pleased to present R. Scott Feldmann of Crowell & Moring, LLP, who will speak on "What To Do When Your Trade Secrets Are Stolen – Litigation"

## APRIL BOARD MEETING

On April 6, 2005 the OCPLA Board of Directors is holding its monthly meeting at noon at the offices of Birch, Stewart, Kolasch, and Birch, LLP in Costa Mesa. Members who wish to present items for the Board's consideration should contact our president, Margaret Kivinski, to have their item placed on the agenda, and to verify the time and location of the meeting.

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## MARK YOUR CALENDARS . . .

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| <b>March 18-20, 2005</b> | <b>OCPLA/SDIPLA Annual Spring Seminar</b>                         |
| <b>April 27, 2005</b>    | <b>What to Do When Your Trade Secrets Are Stolen – Litigation</b> |
| <b>May 25, 2005</b>      | <b>ITC Actions and the Eveready Battery Case</b>                  |

## MESSAGE FROM THE PRESIDENT

**BY MARGARET KIVINSKI**  
THEROX, INC.  
[mkivinski@therox.com](mailto:mkivinski@therox.com)



Our February meeting was enlightening. Brian Daucher and Aaron Malo of Sheppard Mullin Richter & Hampton gave us an interesting presentation on bankruptcy considerations in intellectual property licensing. Aaron provided insight into the basic principles of bankruptcy practice. Brian related these principles to the practice of intellectual property law, IP licensing in particular. Together they took us through the cases and gave us practical tips to consider when drafting licenses to protect our clients in the unfortunate circumstance of bankruptcy of the licensor.

Brian and Aaron came through on their offer to provide their presentation materials to anyone interested in receiving them. I got them and they're great. The materials include an annotated outline of the presentation. The annotations in the outline act as links to the actual cases, which are included at the end of the materials. Even if you weren't able to attend, these are great materials to have, and all you have to do to get them is send an e-mail to Brian at [bdaucher@sheppardmullin.com](mailto:bdaucher@sheppardmullin.com) or Aaron at [amalo@sheppardmullin.com](mailto:amalo@sheppardmullin.com).

This month we will hold our annual spring seminar on March 18-20 at the Balboa Bay Club in Newport Beach, so we won't be having a regular lunch meeting in March. Hope to see you at the Balboa Bay Club.

### E-MAIL DISTRIBUTION OF THE NEWSLETTER



**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 Neal Cohen at [nmc@cohen-sak.com](mailto:nmc@cohen-sak.com).

### RSVP ON TIME FOR MONTHLY LUNCHESES

**REMINDER:** Please remember to RSVP to T.J. Singh instead of to Neal Cohen.

To reduce the likelihood of additional rate increases associated with last minute reservations, and attendance without advance reservations, we encourage you to RSVP early, i.e., no later than by noon on the Friday preceding the meeting, so that we can provide more accurate numbers of luncheon attendees to the hotel. Your efforts to register at least five days in advance of the lunches will be greatly appreciated, both by the hotel and the OCPLA Board of Directors.

In addition, the OCPLA is pleased to announce that the costs for the monthly luncheon meetings for student members has been reduced. Student members can attend the monthly luncheon meetings for \$15 beginning in January 2005.

### 2005 MEMBERSHIP RENEWAL

Dues for 2005 will remain at \$35 for attorneys and agents and entitle you to receive the monthly OCPLA newsletter, frequent announcements, and reduced rates for the monthly luncheons and seminars. A membership form is included in this month's newsletter and is also available on our website, at [www.ocpla.org](http://www.ocpla.org). Please renew early to reduce delays in processing your application.

### MARCH SPRING SEMINAR

The OCPLA/SDIPLA annual Spring Seminar will be held on March 18, 2005 to March 20, 2005, at the Balboa Bay Club and Resort in Newport Beach. A reservation form is included in this newsletter. For more information, please contact Amy Durrant at 949-760-0404 or [adurrant@kmob.com](mailto:adurrant@kmob.com).

### MINUTIAE

BY NEAL M. COHEN  
COHEN SAKAGUCHI & ENGLISH LLP  
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### From Washington to Alexandria - Fax And Mailing To The PTO

Since at least December 1, 2003, there has been a "central" fax number to be used for "most patent related correspondence". The fax number is (703) 872-9306. There has also been a "central" customer service window for hand-delivery of correspondence. The address is currently 401 Dulany Street, Alexandria, VA 22314. Of course, for express Mail, the address has been PO Box 1450, Alexandria, VA 22313-1450 (as set forth in Rule 1). These delivery options are still in effect today, but there are quite a few exceptions.

For example, hand-delivered correspondence related to: 1) Access requests; 2) Patent term extensions under 35 U.S.C. § 156; 3) Assignments for recording; 4) Office of General Counsel; 5) Solicitor's office; 6) Interferences; 7) Secrecy orders; 8) Express petitions for foreign filing licenses; 9) Petitions to withdraw from issue; and 10) Responses to the Office of Patent Publication, all have special locations. Similarly, faxed correspondence related to: 1) OIPE; 2) PCT Operations and administration; 3) Office of Patent Publication; 4) Office of Pre-grant publication; 5) EBC; 6) Assignments; 7) Central Reexamination Unit; 8) BPAI; 9) Office of the General counsel; 10) Office of the Solicitor; 11) Licensing and review; and 12) Office of Petitions, all have special fax numbers.

So before you hand-deliver or fax anything to the "central" locations, be sure to verify your correspondence does not fit into one of the exceptions. Complete details are currently available at the PTO website by selecting "News" from the toolbar, then locating the March 5, 2005 document under the Patents column.

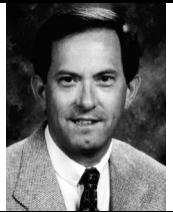
And while you're checking addresses on your correspondence, be sure to check that you don't mail anything to the PTO's "old" D.C. address (that 20231 zip code may ring a bell).

That's because starting April 4, 2005, any such correspondence will **not** be forwarded to Alexandria, and instead will be returned to the sender. And yes, that also means you would not get a filing date under Rule 1.8 or Rule 1.10.

Please e-mail any questions, comments, or submissions for future *Minutiae* columns, to Neal M. Cohen, at [nmc@cohen-sak.com](mailto:nmc@cohen-sak.com). (Note: all submissions must be approved by the Editor prior to publication).

#### RECENT INTERESTING IP CASES

BY LEONARD R. SVENSSON  
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### 1. CORROBORATING EVIDENCE NEEDED TO ADD AN INVENTOR TO AN ISSUED PATENT

**Linear Tech. Corp. v. Impala Linear Corp.**, 379 F.3d 1311, 72 U.S.P.Q.2d (BNA) 1065 (Fed. Cir. Aug. 17, 2004)

**Issue:** When seeking to add a co-inventor to an issued patent, is the alleged inventor's own testimony regarding the relevant facts sufficient to prove conception of the claimed invention? **Answer:** No.

**Facts:** Linear Technology Corp. ("Linear") owns U.S. Patent No. 5,481,178 ("the '178 patent"), directed to voltage regulator technology for supplying a load with a constant output voltage from a fluctuating input voltage source. Certain claims of the '178 patent require an element that prevents the current flowing to the load from reversing polarity. In 1997, Linear sued Impala Linear, Maxim Integrated Products ("Maxim") and other manufacturers of switching voltage regulators, alleging infringement of the '178 patent.

At trial, Maxim argued that a former employee of Teledyne, Ronald Vinsant, developed the polarity reversing circuitry in 1989 while working at Teledyne and shared this knowledge with the named inventor of the '178 patent after joining Linear. Maxim

contended that Vinsant should have been named as a joint inventor in the '178 patent and that Maxim could not infringe the '178 patent because it purchased Teledyne's ownership interest in the subject technology.

On summary judgment, the district court ruled that Maxim failed to present sufficient evidence to prove that Vinsant was a joint inventor of the '178 patent. Maxim appealed.

**Argument:** Maxim argues that detailed oral and written testimony presented at trial was sufficient to establish that Ronald Vinsant conceived the claimed polarity reversing prevention technology circuitry in 1989, while working at Teledyne, and that Vinsant later shared his knowledge with the named inventor. For this reason, Maxim argued that Vinsant qualified as a co-inventor and that Maxim could not infringe due to its purchase of Teledyne's ownership interest of the subject technology.

**Reasoning:** A party seeking to add an inventor to an issued patent must prove inventorship by clear and convincing evidence. To meet this evidentiary burden, mere testimony from the alleged co-inventor concerning the relevant events is insufficient to prove that he or she contributed to the conception of the invention. In other words, evidence that corroborates the alleged co-inventor's version of events is required. Whether the alleged co-inventor's testimony has been sufficiently corroborated is evaluated under a "rule of reason analysis," which requires evaluating all pertinent evidence to determine credibility of the alleged inventor's testimony.

**Conclusion:** Although Maxim presented circuit diagrams made by Vinsant and testimony from a professional acquaintance with whom Vinsant discussed voltage regulating circuitry, such evidence failed to corroborate Vinsant's claim that he conceived of the specific technology claimed in the '178 patent while employed by Teledyne. Without sufficient corroborating evidence in support of Maxim's claim of co-inventorship, the district court's summary judgment of non-inventorship is affirmed.

## 2. ISP ACTING AS MERE CONDUIT NOT REQUIRED TO PRODUCE CUSTOMER RECORDS

***Recording Indus. Ass'n of Am. v. Charter Comm., Inc.*, 393 F.3d 771, 73 U.S.P.Q.2d (BNA) 1339 (8th Cir. Jan. 4, 2005)**

**Issue:** Does 17 U.S.C. sec. 512, part of the Digital Millennium Copyright Act ("DMCA"), permit a copyright holder to obtain customer records from an Internet Service Provider ("ISP") where the ISP is merely acting as a conduit for the transmission of information within the safe harbor provisions of the DMCA? **Answer:** No.

**Facts:** Unlike earlier centralized peer-to-peer ("P2P") file-sharing programs which rely upon a single facility for identifying files, a new generation of P2P file sharing programs such as the one used by Charter Communications ("Charter") allows an Internet user to access files located on other computers through the Internet. By utilizing this new technology, an Internet user can directly search MP3 file libraries of other users, with no web site being involved, because the transferred files are not stored on the ISP computers. Utilizing a tracking program, the Recording Industry Association of America ("RIAA") identified Internet Protocol ("IP") addresses and user names of Charter subscribers suspected of trading copyrighted music files. The RIAA logged into P2P networks and observed certain users offering the copyrighted songs for downloading. It confirmed infringement by downloading files offered by individuals and verifying the songs as being unauthorized copies of copyrighted sound recordings. The RIAA served subpoenas requiring Charter to produce the customer information of their subscribers. Charter filed a motion to quash. The district court denied Charter's motion to quash and ordered Charter to produce the customer information. Charter appealed.

**Argument:** Charter argued that the district court based its decision on an erroneous reading of the DMCA. Specifically, Charter argued that the DMCA did not authorize the issuance of a subpoena to an ISP who acts

solely as a conduit transferring information between two users. The RIAA maintained that the DMCA authorizes the issuance of a subpoena to any ISP, regardless of whether the ISP is actually storing the copyrighted files.

**Reasoning:** In order to obtain a subpoena under sec. 512(h) of the DMCA, a copyright owner must file certain items with its request for a subpoena to the court clerk including a notification of claimed infringement identifying the copyrighted work(s) claimed to have been infringed. Because Charter merely acts as a conduit between users, it does not have access to any alleged infringing material, which is stored only on the user's computer. As such, Charter could not have removed or disabled a user's access to infringing material resident on another user's computer (a requirement of sec. 512(c)(3)(A)(iii)). The validity of a subpoena of this nature depends on the requirements under the DMCA being satisfied. Any notice given to an ISP acting as a conduit for transferring information between users does not satisfy this requirement. Since the requirement was not met, the subpoena under sec. 512(h) is not valid.

**Conclusion:** This case was remanded to the district court to: (1) order the RIAA to return any and all information obtained from the subpoenas, (2) order the RIAA to maintain no record of any information derived from the subpoenas and (3) order the RIAA to make no further use of the subscriber data obtained from the subpoenas.

### NEW MEMBERS

We are pleased to welcome the following new members to the ranks of the OCPLA. His/her workplace and sponsors are listed.

<b>New Member/Org.</b>	<b>Sponsors</b>
<b>Mimi Justice</b> Deloitte	Margaret Kivinski Matt Weil
<b>Scott Trask</b> Newport Corporation	Margaret Kivinski Matt Weil

**OCPLA WEBSITE**

Check the OCPLA website at [www.ocpla.org](http://www.ocpla.org) for copies of the OCPLA newsletter, for membership information and for current events of interest to members. 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)."

**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.

## BOARD OF DIRECTORS AND COMMITTEE CHAIRS

### BOARD OF DIRECTORS TELEPHONE/E-MAIL

<b>President</b>	Margaret A. Kivinski	949-757-1999 mkivinski@therox.com
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	TJ Singh	(949) 955-1920 tjsingh@koslaw.com
	Marlene Klein	949-932-3132 marlene.klein@cda.canon.com
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### COMMITTEE CHAIRPERSONS

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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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**PATENT AGENT / PATENT ATTORNEY**

Klein, O'Neill & Singh, a growing Orange County Intellectual Property law firm seeks a patent agent or patent attorney with at least 2-7 years of patent prosecution experience in electrical, electronics, computer related and mechanical arts. Must be able to work with minimum supervision and training. Must have excellent written and oral communication skills and have top-notch credentials. We offer competitive salary and benefits with a collegial work environment. Email your resume/writing sample to [acalumpang@koslaw.com](mailto:acalumpang@koslaw.com). No phone calls please.

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**OFFICE AVAILABLE**

Sublease 12' by 14' fully furnished window office available in patent law suite. Join a patent attorney, patent agent and a patent drafter as 4th party. Phone, fax, DSL, high speed copier/printer, computer work station, postage meter. JW airport area, easy parking, close to 405, 55 and 73 freeways. Call: 714/668-1900

Ad: xaft1205

**OFFICE SPACE AVAILABLE**

2000 sq. ft available for sublease beginning April 1st near the Spectrum. New construction. 3 offices plus open area on first floor. Private entrance, copy area and kitchen. Shared conference room. \$4500 per month. Call Jill Swedo at 949-223-0838 if interested

Ad: xaft0305

**POSITIONS AVAILABLE**

**Patent Associate:** Shimokaji & Associates needs a full-time patent associate for OC offices. Duties include mechanical and electrical patent preparation and prosecution. Must have at least 5 years US and PCT experience, and ability to work as primary client contact. Technical background is preferably EE, physics or mechanical.

**Litigation Associate:** Shimokaji & Associates needs a full-time litigation associate for OC offices. Duties include managing infringement litigation from inception through trial. Must have first or second chair trial experience. IP experience required.

**Patent Writer:** Would you like to work from any location? Shimokaji & Associates needs Virtual Patent Associates. Duties include mechanical, chemical and electrical patent preparation and prosecution. Must have at least 5 years US and PCT experience with ability to work as primary client contact.

Please email Jill Swedo,  
[swedo@shimokaji.com](mailto:swedo@shimokaji.com), if you are interested.

Ad: xaft0405

**PATENT ATTORNEY/AGENT POSITION**

MacPherson Kwok Chen & Heid LLP seeks a patent prosecution attorney/agent for its Irvine Office. The ideal candidate has an Electrical Engineering, Computer Science, or Physics degree with some engineering and patent prosecution experience. For more information about our firm, visit our website at [www.macpherson-kwok.com](http://www.macpherson-kwok.com). Please provide resume to Tom Chen at [tchen@macpherson-kwok.com](mailto:tchen@macpherson-kwok.com).

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**MONTEREY LITIGATION ATTORNEY**

LaRiviere, Grubman & Payne, LLP, an av-rated intellectual property firm in Monterey, CA, is seeking a mid-level intellectual property litigation associate. Three to five years litigation experience, a strong professional work ethic in a casual atmosphere and excellent analytical and writing skills are required. High-tech education and a lively sense of humor are pluses. Contact Karen Rachelle at (831) 649-8835 (fax) or [krachelle@lqpatlaw.com](mailto:krachelle@lqpatlaw.com) (e-mail).

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**MONTEREY PATENT ATTORNEY**

LaRiviere, Grubman & Payne, LLP, an av-rated intellectual property firm in Monterey, CA, is seeking an associate patent attorney. Three to five years prior experience in patent preparation and prosecution in a wide range of technologies, opinion letters and due diligence reports, a strong professional work ethic in a casual atmosphere and excellent analytical and writing skills are required. Experience in trademark registration and opposition practice and a lively sense of humor are desirable. Contact Karen Rachelle at (831) 649-8835 (fax) or [krachelle@lqpatlaw.com](mailto:krachelle@lqpatlaw.com) (e-mail).

Ad: xaft0305



# Orange County Patent Law Association

WWW.OCPLA.ORG • P.O. Box 7632 Newport Beach, CA 92658

## 2005 MEMBERSHIP APPLICATION/RENEWAL FORM

**This is an application for (please circle one):**      **Membership Renewal or 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 2005 (please circle one):**

Regular Membership (attorneys, agents):	\$35.00	\$17.50
Student Membership	\$17.50	\$ 8.75
Associate Membership (other)	\$35.00	\$17.50

**(New Member After 07/01/05)**

**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**

Two OCPLA member sponsors are required for new applicants. Two undersigned members hereby recommend the above-signed applicant for membership into the Orange County Patent Law Assn.

Sponsor Signature: \_\_\_\_\_ Date: \_\_\_\_\_

Printed Name: \_\_\_\_\_

Sponsor Signature: \_\_\_\_\_ Date: \_\_\_\_\_

Printed Name: \_\_\_\_\_

**2005 OCPLA EVENTS SCHEDULE**

<b>Date</b>	<b>Location</b>	<b>Speaker/Event</b>	<b>Topic</b>
<b>March 18-20, 2005</b>	Balboa Bay Club	Various	OCPLA/SDIPLA Annual Spring Seminar
<b>April 27, 2005</b>	Wyndham Garden Hotel	<b>R. Scott Feldmann</b> Crowell & Moring, LLP	What to Do When Your Trade Secrets Are Stolen - Litigation
<b>May 25, 2005</b>	Wyndham Garden Hotel	<b>Wei-ning Yang and Bill Thompson</b> Hogan & Hartson	ITC Actions and the Eveready Battery Case



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