



OCPLA NEWSLETTER

Orange County Patent Law Association

www.ocpla.org

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March 2007

MARCH 2007 LUNCHEON

Please join us on Wednesday, March 28th, to hear Gary Augusta of OCTANe giving an overview of biomedical and hi-tech companies in Orange County, as well as Venture Capital financing and factors that are considered in determining who receives funding and what investors look for in starting up a new company.

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

CALL FOR SPEAKERS

Topic suggestions may be submitted to the Board by contacting Greg Hollrigel at ghollrigel@coopervision.com or at 949-597-4700 x3341.

APRIL BOARD MEETING

The April Board meeting will be held on April 5, 2007 at noon at the offices of Knobbe Martens Olson & Bear. 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:

Sean D. Burdick of Snell & Wilmer

Theodore Lopez of Klein, O'Neill & Singh
Kenny Masaki

Ehab Samuel of Snell & Wilmer

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 Ritz Carlton Hotel in Dana Point with other patent law associations. More information to follow.

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.

BEWARE OF PHISHING

When paying for your reservation online, you should NOT receive further requests from "PAYPAL", via e-mail, asking for additional information related to OCPLA or your OCPLA lunch reservation. If you do, this e-mail could

be from a phisher phishing for prey. Typically this involves a phisher sending out an e-mail that poses as a legitimate business request – for example, a hotel asking its customers to verify his or her financial data. The email includes a link that purports to go to the hotel's legitimate website. However, the site is a sham, a mere illusion of legitimacy, and when the unwary types in passwords or other personal information, that data is captured and may subsequently be used by the phisher to adorn his new apartment and enjoy the lifestyle of the Rich and Infamous.

PTO UPDATE

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

PROPOSED RULE REGARDING CHANGES TO REPRESENTATION BEFORE THE USPTO

Following up to a December 2003 proposal, on February 28, 2007, a revised proposal was published in the Federal Register. The deadline for submitting comments about the revised proposal is May 29, 2007.

Among the proposed changes is a change or clarification in who may prepare and file patent assignments with the USPTO.

In particular, the proposed rules seek to clarify whether a registered patent agent is authorized to prepare a contract, such as an assignment or a license, for recordation in the PTO. The proposal is requesting comments on whether in certain situations, it may be permissible for a patent agent to prepare a contract, such as by completing a standard assignment form document without violating state law, which the Notice confirms governs the preparation of contracts.

Although the proposal is specifically directed at patent agents, the proposal also potentially impacts patent attorneys who represent out-of-

state clients and who are not licensed in the state of their client. In essence, it could be considered that preparing an assignment for an out-of-state client may be unauthorized practice of law if the attorney responsible for preparing the assignment is not licensed in the client's state.

Please see the Notice at the website below and consider submitting comments by the May 29, 2007 deadline.

<http://www.uspto.gov/web/offices/com/sol/notices/72fr9196.pdf>

PROPOSED CHANGES REGARDING CLAIMS WHICH RECITE ALTERNATIVES, SUCH AS MARKUSH GROUPS

Stay tuned for a new proposal regarding the use of claims that contain alternatives, such as claims that contain Markush groups. Apparently, at the March 6, 2007 Biotechnology and Chemical Pharmaceutical Customer Partnership Meeting, these types of claims were discussed, especially with regards to the burden in examining patent applications with these claims. I have heard that a proposal regarding changes to these types of claims is due to be published in the next month or two.

CHANGES TO JAPANESE PATENT LAW AND PRACTICE

**BY MARLENE KLEIN
CANON USA**

New laws regulating claim amendments and the filing of divisional applications in Japan will take effect on April 1, 2007. These laws are not retroactive and will only apply to patent applications having a legal filing date of April 1, 2007 or later. If the parent application has a filing date before April 1, 2007, the current Japanese patent laws will apply, even if a related divisional application is filed on or after April 1, 2007.

Prohibition of Claim Scope Shifting in Amendments in Response to an Office Action

New Paragraph 4 of Article 17-2 states that “any claim amendment prepared in response to an Office Action must define a single group of general inventive concept that will meet the unity of invention requirement under Article 37 in relation to the examined patent claim.”

Under the current system, in response to a first Office Action, claims can be freely amended as long as the amendments are supported by the original specification and/or drawings. Under the current system, it is possible to add new independent claims even though the new claims may claim different subject matter than the currently pending claims. The current practice may require the patent examiner to conduct a new search. The change in the law with respect to change in claim scope after an amendment seeks to rectify this problem due to the time and expense required for an Examiner to conduct a new search based on a claim scope shifting amendment made in response to an Office Action.

Under the new laws, an applicant can not amend a claim or add a claim that lacks unity of invention with the previously pending (examined) claims and does not have common technical features with the previously pending claims. Under the new law, the Examiner will reject such claims. If such a rejection is justified, the Applicant can file a divisional patent application in order to introduce the new claims.

Change in Divisional Practice

Under the current law, divisional patent applications cannot be filed after receipt of a final Office Action or a Notice of Allowance. Based on this, current practice is to file divisional applications since an Applicant cannot predict when a Notice of Allowance might be received.

Under the new law, for new patent applications filed on or after April 1, 2007, divisional patent applications may be filed within a prescribed

time frame following a final Office Action or Notice of Allowance.

Under the new law, the applicant can file a divisional application within 30 days from the date of a Notice of Allowance. The term may be extended for foreign applicants.

Under the current law, an applicant must file an appeal against a first final rejection in order to obtain an opportunity to file a divisional application even if the applicant does not wish to continue pursuing the claims of the parent application. The new law has eliminated the need to file an appeal against the final rejection in order to file a divisional patent application, i.e., after a Final Rejection, an applicant can file a divisional application, regardless of whether the applicant files an appeal in the parent application. A foreign applicant will have 90 days from the date of issue of the final office action to file the divisional patent application.

A divisional patent application filed after the final rejection is treated as a new patent application and a new examination will be conducted. If the examiner determines that the claimed invention in the divisional application is almost identical to the claimed invention in the parent application, the Examiner can issue a final Office Action as the first Office Action for the divisional application.

Change in Extensions of Time

Under current practice, a single extension of time request can be filed for a time extension of up to 3 months. Under the new rules, extension requests along with the required fee must be paid every month. This rule is applicable to any requests for time extensions after April 1, 2007 even if the Office Action was issued before April 1, 2007.

RECENT IP CASES**BY IRFAN LATEEF
KNOBBE, MARTENS, OLSON & BEAR**

In *Voda, M.D. v. Cordis Corporation*, Case No. 05-1238, the Federal Circuit vacated the district court grant of leave to amend complaint to include allegation of supplemental jurisdiction pursuant to 28 U.S.C. § 1367 over foreign patent infringement claims. Voda sued Cordis on U.S. patents and asserts that the district court has supplemental jurisdiction under 28 U.S.C. § 1367 over his foreign patent infringement claims.

Instead of addressing the merits, the Court ruled that several reasons would compel the district court to decline the exercise its discretion under § 1367(c) regarding supplemental jurisdiction: (1) limitations imposed by treaties, (2) considerations of comity, (3) judicial economy, (4) convenience, and (5) fairness. Because the district court did not undertake such an analysis, the Court held that the district court abused its discretion and remanded for such an analysis.

In a 23 page dissent, Newman argues that the panel has created an improper exception in patent cases to general rule that American courts have the authority to resolve controversies that require the application of foreign law.

In *In Re Bose Corporation*, Case No. 06-1173, the Federal Circuit affirmed the PTO Board's judgment that the trademark application was barred by the doctrine of res judicata. Bose applied for a trademark registration on a speaker design. The Court held that the Board's rejection of the identical mark in a previous application as functional barred the present application. The Court determined that there were no intervening facts or law that warranted barring the application of res judicata.

In *Dippin' Dots, Inc., et al. v. Mosey, et al. v. Esty, Jr., et al.*, Case No. 05-1330, the Federal Circuit affirmed summary judgment of noninfringement and judgments, after jury trial, of obviousness and unenforceability, but reversing judgment as to the antitrust counterclaim. The patent covers a process for making a form of cryogenically prepared novelty ice cream product.

Regarding inequitable conduct, the Court held that sales made before the critical date were material under the reasonable examiner standard because these sales could have rendered the claimed invention obvious. With respect to intent, the Court held that the failure to disclose these sales to the PTO, coupled with the enthusiastic touting of sales made after the critical date permits an inference of the minimum threshold level of intent required for inequitable conduct.

With respect to the antitrust claim, the Court held that while Walker Process intent may be inferred from the facts and circumstances of a case, a mere failure to cite a reference to the PTO will not suffice. Because the defendant could not prove deceptive intent independent of the omission to cite the sales, the Court reversed the antitrust judgment.

In *Regents of the Univ. of California v. Dako North America*, Case No. M-8420, the Federal Circuit granted the University's petition for permission to appeal an order involving claim construction certified by the district court as one involving a controlling issue of law as to which there is substantial ground for difference of opinion and for which an immediate appeal may materially advance the ultimate termination of the litigation. The Court already has before it appeals from a denial of a preliminary injunction. After those appeals were filed, based on a more complete record, the district court revisited some of the claim construction issues, and issued an order granting in part and denying in part Dako's motion for summary judgment of

noninfringement of the two patents at issue in the pending appeals. The Court exercised its discretion to allow the appeal because it would be an efficient use of judicial resources and would facilitate resolution of all of the claim construction disputes.

In *Cargill v. Cambra Foods*, Case No. 06-1265, the Federal Circuit affirmed the district court judgment of invalidity based on the on-sale bar and unenforceability. Regarding materiality, the Court held that under the reasonable examiner standard, regardless of whether the examiner would ultimately allow the patent application, an examiner would certainly want to consider test data that is directly related to an important issue of patentability, along with the applicant's interpretation of that data. With respect to intent, the Court found no error with respect to the district court's finding of intent to deceive based on several circumstantial factors: the repeated nature of the omission, the applicant's motive to conceal, and the high materiality of the undisclosed information. The Court rejected arguments regarding good faith stating that when an applicant knows or obviously should know that information would be material to the examiner, but the applicant decides to withhold that information, "good faith" does not negate intent to deceive.

In *RFR Indus. v. Century Steps*, Case No. 05-1610, the Federal Circuit vacated the district court's grant of judgment on the pleadings because RFR voluntarily dismissed the action under Fed. R. Civ. P. 41(a)(1)(i) before Century served its answer on RFR and reversing the district court's grant of attorney fees because Century is not a prevailing party.

In *Mymail, Ltd. v. America Online, Inc., et al.*, Case No. 06-1147, the Federal Circuit affirmed district court's grant of summary judgment of noninfringement and district court's ruling that MyMail had standing to assert infringement of the '290 patent.

The Defendants challenged patent ownership based on federal law relating to fraud, not state law. The Court ruled that, as a matter of federal law, later-discovered fraud relating to patent procurement can be raised as an enforceability defense, but cannot be raised with respect to patent ownership. The Court stated that state law, not federal law, addresses such property ownership disputes.

The Court held that in light of the specification's teachings and MyMail's counsel's admissions at the district court hearing, the district court's claim construction (that a Network Service Provider performs authentication) must be affirmed. Under that claim construction, the Court affirmed the summary judgment of noninfringement, because the authentication procedure is not performed by the processing MyMail accused of meeting this limitation, though it is performed in other processing not accused of infringement.

In *Sevenson Environmental Services, Inc. v. Shaw Environmental, Inc.*, Case No. 06-1391, the Federal Circuit affirmed the district court's grant of summary judgment that suit against a hazardous waste remediation contractor was barred by government contractor immunity under 28 U.S.C. § 1498 because the contractor's use of the accused method was "for the Government and with the authorization and consent of the Government."

In *Hakim v. Cannon Avent Group, PLC, et al.*, Case No. 05-1398, the Federal Circuit affirmed district court's grant of summary judgment that the '931 patent is not infringed and the '620 patent is invalid. The patents relate to drinking cups that prevent the spilling of liquid if the cup is tipped over.

Regarding the '931 patent, Hakim argued that the district court improperly relied on an argument in an abandoned parent application in narrowly construing the claims. Hakim argued that by filing a continuation application and explaining to the examiner that he was seeking broader claims, he avoided

any disclaimer of claim scope. The Court held that Hakim's actions failed to rescind the prior disclaimer and affirmed the noninfringement holding.

Regarding the '620 patent, Hakim argued that the district court erred in invalidating the '620 patent without first construing the claims. The Court held that when there is no dispute as to the meaning of a term that could affect the disputed issues, "construction" may not be necessary. Here, because Hakim did not propose alternative meanings for terms that might affect validity of the claim, or how claim "construction" would affect the issue of anticipation, the Court disregarded this challenge. The Court went on to affirm the invalidity ruling finding no error in the district court's analysis.

In *Aquatex Industries, Inc. v. Techniche Solutions*, Case No. 06-1407, the Federal Circuit held that the district court erred in finding the doctrine of equivalents barred by prosecution history estoppel and in relying on unclaimed features to find a lack of equivalents in the accused product but affirming the grant of summary judgment of no infringement under the doctrine of equivalents because AquaTex did not satisfy its burden to present particularized evidence of equivalents in opposition to the motion for summary judgment.

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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EXP 03/08

IP Counsel

Advanced Medical Optics, is a global medical device leader and spin-off from Allergan, Inc. based in Santa Ana, CA.

Serves as business lawyer supporting the acquisition and protection of the intellectual property of AMO. Support and manage intellectual property litigation and licensing efforts. Includes: Patent drafting, prosecution and strategy, including oppositions and appeals; Clearance, counseling and opinion work; Litigation ;Licensing and contracts; Trademark prosecution, maintenance and enforcement.

Requirements: J.D. plus at least 4-5 years IP experience in patent prosecution and counseling; Permitted to practice in California; USPTO Licensed; Technical background in physics, optical, biomechanical or electrical engineering; Experience drafting and prosecuting medical device patents; licensing and litigation experience. Email Resumes to: resume@amo.inc.com. AA/EOE M/F/D/V

EXP 0407

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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.

exp 0307

Orange County Patent Law Association

Date: Wednesday, March 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 Orange County's Innovation Environment

Speakers: Gary Augusta of OCTANe

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, March 28, 2007 for the following person(s):

This form and check should be mailed to:

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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):

Regular Membership (attorneys, agents):	\$35.00	(New Member After 08/01/07) \$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
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 23, 2007	Wyndham Garden Hotel	TBD	TBD
June 8-10	Ritz Carlton Hotel, Dana Point, CA	2007 SPRING SEMINAR	TBD
July 25, 2007	Wyndham Garden Hotel	TBD	TBD