



OCPLA NEWSLETTER

Orange County Patent Law Association

www.ocpla.org

Vol. 10, No. 7

July 2004

JULY LUNCHEON MEETING

Please join us at our next luncheon meeting on Wednesday, July 28, 2004, when we are pleased to present Charles C.H. Wu, Esq of the Law Offices of Wu & Cheung, L.L.P., who will speak on "Arguing KP v. Lasting Impression in the Supreme Court". The lunch will be held at noon at the Wyndham Garden Hotel.

AUGUST BOARD MEETING

On August 3, 2004, the OCPLA Board of Directors is holding its monthly meeting at noon at the offices of Birch, Stewart, Kolasch & Birch, LLP.

Members who wish to present items for the Board's consideration should contact our president, Matthew Weil, 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 . . .

July 28, 2004 **Arguing KP v. Lasting Impression in the Supreme Court**

August 25, 2004 **SCO v. IBM What Every IP Lawyer and In-House Lawyer Needs to Know About This Landmark Litigation and About Open Source Software Legal Issues**

September 22, 2004 **Patent Allowance, Now What? Continuation Strategies That Significantly Increase Patent Value**

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 Greg Hollrigel at gsh@patlawyers.com.

RSVP ON TIME FOR MONTHLY LUNCHEONS

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, several members have inquired about ordering fruit plates for the lunches. If you wish to order a fruit plate, or a vegetarian dish, please indicate your meal preference when you RSVP.

2004 MEMBERSHIP RENEWAL

Dues for 2004 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. If you have not already done so, please renew now!

MESSAGE FROM THE PRESIDENT

BY MATTHEW F. WEIL
MCDERMOTT, WILL & EMERY
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Post-Grant Review of Patents: Good, Bad or Ugly?

Visit the USPTO website at <http://www.uspto.gov/web/offices/com/strat21/action/sr2.htm> and you will see an Action Paper recommending that the patent law be changed to allow post-grant review of newly issued patent claims.

In a nutshell, the paper recommends giving third parties the chance to initiate post-grant review to challenge recently issued patents. The PTO would administer and adjudicate

the proceeding, which would give parties threatened with litigation an alternative forum to challenge patent validity. "By using the [PTO]'s expertise," the paper argues, "these challenges could be adjudicated for less money and in less time than by civil suit. This will enhance the patent system as a whole by strengthening those patents that survive the review and eliminating those patents which contain unpatentable subject matter."

The desirability of such a change in the law is far from settled, and no clear consensus has emerged on a wide range of questions: By whom, where, when such review can be sought? By what standards and according to what evidence the issues will be judged? Who will decide? What avenues of appeal should be available, and what preclusive effect should the proceedings have? And of course, as with nearly any government action, the big question is whose ox is likely to be gored in the process of reform?

In the next few months, I will be participating as a member of a working group of the Sedona Conference (www.thesedonaconference.org/wg), attempting to formulate a reasoned position on the subject to help advance the public debate. Although I am taking part in my own capacity, and not as a partner of my firm or a member of the OCPLA, I would welcome any input Association members might have about the pros and cons of the various post-grant review proposals, or any details you think might be particularly worthy of attention.

As always, you can reach me at 949.757.7153 or by e-mail at mweil@mwe.com.

PTO UPDATE

BY GREG S. HOLLRIGEL
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**Latest Revision of MPEP Now Available**

The May 2004 version of the Manual of Patent Examining Procedure is now available.

It can be downloaded from the following website:

<http://www.uspto.gov/web/offices/pac/mpep/index.html>

RECENT INTERESTING IP CASES

BY LEONARD R. SVENSSON
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1. **DISTRICT COURT INTERFERENCE PROCEEDINGS REQUIRES FULL TWO-WAY TEST ANALYSIS**

Medichem, S.A. v. Rolabo, S.L., Nos. 02-1461, -1480 (Fed. Cir. Dec. 23, 2003)

Issue A: Can a method claim using the language "comprising" be construed to exclude un-named steps when applying the two-step test to determine interference-in-fact? **Answer:** No.

Issue B: Must each of the claimed inventions analyzed in the two-step test be unpatentable over each other before an interference-in-fact can be initiated? **Answer:** Yes.

Facts: Medichem was the assignee of U.S. Patent No. 6,084,100 ("the '100 patent") and Rolabo was the assignee of U.S. Patent No. 6,093,827 ("the '827 patent"). Both patents were directed towards processes for preparing loratadine, the active ingredient of

Claritin®. The Medichem patent claims described a process "consisting of" performing a "McMurry" reaction in the presence of a tertiary amine to prepare loratadine, while the Rolabo patent claims recited a process that also resulted in loratadine "comprising" a "McMurry" reaction and making no mention of the need for a tertiary amine. Medichem filed a complaint under 35 U.S.C. sec.291 against Rolabo in district court, initiating an interference.

The district court applied the two-way test to assess whether an interference-in-fact existed. The two-way test first asks whether Party A's claim, if it were prior art, would destroy novelty or make obvious Party B's claim, and then asks whether Party B's claim, if viewed as prior art to Party A's, would destroy novelty or make obvious Party A's claim.

The district court first assumed that Medichem's patent was prior art to Rolabo and then analyzed novelty and obviousness. The court concluded that a tertiary amine was necessary to Medichem's process and, relying entirely on Rolabo's expert witness' testimony, that without the tertiary amine it was *not* obvious that the same result could be obtained. As a consequence, the court concluded that Rolabo's invention was patentable over Medichem's and that no interference-in fact existed. Medichem appealed.

Argument and Reasoning A: On appeal Medichem argued that Rolabo's claim encompassed processes that included tertiary amines because of the transitional term "comprising." It argued that had Rolabo intended to exclude tertiary amines, it could have drafted the claims using the transition phrase "consisting of." The CAFC agreed, noting that the district court improperly assumed the absence of an affirmative claim to tertiary amines excluded them from the claim's scope. The court concluded that the Medichem patent anticipated Rolabo's, meeting the first prong of the two-way test and reversing the district court's opinion.

Conclusion A: A method claim "comprising" includes not only the steps listed in the claim, but also any additional steps.

Argument and Reasoning B: Medichem argued that the district court also performed the second leg of the two-way test, finding that the requirement for a tertiary amine would have been obvious because of the well known use of tertiary amines in McMurry reactions and because of the minor differences between the claims of the two patents. The CAFC disagreed, finding that the district court did not make factual determinations of anticipation and obviousness and so did not analyze the second leg of the two-way test.

Conclusion B: An interference-in-fact under 35 U.S.C. sec. 291 requires both parties to be unpatentable over each other. Therefore, this portion of the interference determination was remanded for the district court to make factual determinations of anticipation and obviousness.

2. CONFUSION ALONG THE NILES

Peaceable Planet, Inc. v. Ty, Inc., No. 03-3452 (7th Cir. Apr. 2, 2004)

Issue A: Does the use of a product name that is sometimes, but not commonly, a personal name necessarily render the mark merely descriptive? **Answer:** No.

Issue B: If the defendant's product is found to have been a copy of the plaintiff's product, is this sufficient to support a claim of product disparagement under state law? **Answer:** No.

Facts: This case presents the uncommon issue of "reverse passing off" which consists of a defendant attempting to pass off the plaintiff's product as the defendant's; the result being that consumers would be likely to think that the plaintiff was actually pirating or copying the defendant's goods even though the reverse is true. In 1999, the plaintiff, Peaceable Planet, began making plush toys in the form of a stuffed toy camel.

The name of the stuffed toy camels is "Niles." The plaintiff claims that the name was chosen to be suggestive of the Nile river region of Egypt. In 2000, the defendant, Ty, Inc., began selling a stuffed toy camel named "Niles". Ty sold roughly two million "Niles" camels whereas Peaceable Planet sold only a few thousand.

Peaceable Planet sued Ty claiming trademark infringement and false advertising under the Lanham Act plus other claims under Illinois state law, including product disparagement. All claims were rejected by the district court on summary judgment. The district court ruled that "Niles" was a personal name and therefore was a descriptive mark not entitled protection absent acquired secondary meaning through proof that consumers associate the name "Niles" with the plaintiff's product. Here, the plaintiff did not show secondary meaning. Peaceable Planet appealed.

Reasoning A: The appeals court (hereinafter, the "court") noted that the Lanham Act governs surnames by preventing registration of surnames that are "primarily merely a surname," absent acquired secondary meaning, but does not prohibit the use of first names. Further, the court stated that case law and treatises often treat personal names as a subset of descriptive marks. The rationale for this is threefold. First, a fear that allowing one party to receive trademark protection for a personal name would prevent others with the same personal name from using their name in connection with their product or service. Second, some names are so common that consumers would not assume the two products with the same name come from the same source and would therefore not be confused as to the origin of the product. The third concern is preventing someone from using their personal name for his or her product may deprive consumers of useful information.

The court found that none of the three reasons for treating personal names as a subset of descriptive marks applies to the

present case. Namely, the public is not likely to assume that "Niles" is a personal name. Secondly, the name in question is the name of a camel. The court stated that Peaceable Planet's use of the name "Niles" for a stuffed toy camel is not preventing other camels from using the name "Niles" for similar goods. Third, "Niles" is not a very common name for humans, and much less so for camels. The court goes on to state that "Niles" is a suggestive mark protected by trademark law without proof of secondary meaning. The court reasoned that there are plenty of alternative suggestive names available for use for stuffed camels. In short, "Niles" is not the name of the defendant, it is not a common name, and making the defendant use a different name would not deprive consumers of valuable information about the defendant or its product. Further, the court reasoned, the fact that "Niles" can be a personal name does not make "Niles" a descriptive mark for plush toy camels.

Conclusion A: The court concluded that Peaceable Planet does have a valid trademark in the name "Niles" as it relates to stuffed toy camels and the claim must therefore be remanded to the district court to allow the plaintiff to prove trademark infringement and related claims.

Reasoning B: Regarding product disparagement, a pirated product may in fact be equal in quality to the product being copied. Therefore, a claim of piracy by itself is not sufficient to establish product disparagement. Regarding a claim of reverse passing off, the purpose of trademark law is to prevent consumer confusion as to source. Since knowing or thinking that a party is a pirate does not constitute confusion as to source, reverse passing off is not the proper claim in the instant case. The fact that consumers may be likely to think that Peaceable Planet is in fact pirating Ty's product does not constitute confusion as to source.

Conclusion B: The court concluded that the district court was correct to dismiss the product disparagement count.

3. SINGLE SPECIES INSUFFICIENT TO SUPPORT LATER CLAIM TO GENUS

In re Curtis, No. 03-1215 (Fed. Cir. Jan. 6, 2004)

Issue: Is there substantial evidence in the record supporting the United States Patent and Trademark Office ("USPTO") Board of Patent Appeals and Interferences ("Board") determination that the disclosure of a species in an earlier application does not provide a written description of a later-claimed genus of friction enhancing coatings? **Answer:** Yes.

Facts: John P. Curtis, James H. Kemp and Jan-Joost Pabst (collectively "Curtis") appeal the decision of the USPTO Board denying the benefit of the filing date of an earlier patent application. Curtis filed U.S. Patent Application No. 07/174,757 (the "'757 application") which discloses an improved dental floss made of expanded polytetrafluoroethylene ("PTFE") filaments coated with microcrystalline wax ("MCW") having a coefficient of friction ("COF") between 0.08 and 0.25.

From the '757 application, Curtis filed a continuation-in-part ("CIP"), Application No. 07/282,962 ("the '962 application"), which issued as U.S. Patent No. 5,033,488 (the "'488 patent") and a foreign counterpart application which published as EP 355,466 ("EP '466"). The claims of the '488 patent and EP '466 are directed to a dental floss made of expanded PTFE filaments coated with MCW. Curtis then filed a second CIP, Application No. 07/729,834 ("the '834 application"), which issued as U.S. Patent No. 5,209,251 ("the '251 patent"). The written description of the '834 application contains statements which are not found in the '962 application, and discloses a genus of "friction enhancing coatings" (e.g. materials that adhere well to PTFE and that increase the COF of a PTFE dental floss to about 0.08 or greater).

Curtis filed Reissue Application No. 08/316,297 ("the '297 reissue application") for the '251 patent, which added claims directed to a PTFE dental floss having at least one friction enhancing coating that were not limited to a particular coefficient of friction (COF) range.

The USPTO Examiner rejected several of the pending claims as being anticipated by EP '466 and as obvious in light of U.S. Patent No. 4,776,358. Curtis attempted to remove EP '466 as prior art by claiming benefit of the filing date of the '962 application. The Examiner determined that Curtis was not entitled to the earlier filing date of the '962 application due to lack of enablement of the genus claims and issued a final rejection. Curtis appealed to the Board, which reversed the enablement rejection. The Board ruled Curtis was not entitled to the benefit of the filing date of the '962 application because the application did not provide an adequate written description of the later-claimed genus of friction enhancing coatings. The Board remanded the case to provide Curtis an opportunity to amend the claims or present evidence of written description. The Examiner was unconvinced by declaration evidence to support the claim for priority of the genus claims. Curtis appealed to the Board, which affirmed the Examiner's decision denying Curtis the benefit of the '962 application filing date. Curtis appealed the decision of the Board.

Reasoning: A patentee will not be deemed to have invented species sufficient to constitute the genus by virtue of having disclosed a single species when, as is the case here, the evidence indicates ordinary artisans could not predict the operability in the invention of any species other than the one disclosed.

The Board's factual determinations are reviewed for substantial evidence in the administrative record and the Board's conclusion that a particular disclosure does or does not comply with the written description is a determination of fact. The

Board's opinion quotes from the record and points out instances in the disclosure of the '962 application where Curtis spoke only of MCW as a suitable friction enhancing coating. The record also indicates that at the time the '962 application was filed, the inventors did not convey any other material that could adhere to PTFE to produce an acceptable dental floss.

Further, the Board properly applied *In re Smythe*, 480 F.2d 1376, 178 U.S.P.Q. (BNA) 279 (C.C.P.A. 1973) to hold that where there is unpredictability "in performance of certain species or subcombinations other than those specially enumerated, one skilled in the art may be found not to have been placed in possession of a genus or combination claimed at a later date in the prosecution of a patent application." The Board concluded the "preponderance of the evidence" precluded a finding of support in any of the parent documents ... for claims to 'the entire class of material capable of increasing the coefficient of friction of the PTFE' dental floss." In other words, mere recitation of the properties common to all the species of a friction enhancing coating in the '962 application did not put persons of ordinary skill in the art in possession of the later-claimed friction enhancing coatings.

Conclusion: The record before the Board provided more than substantial evidence to support the conclusion that one of ordinary skill in the art would read the disclosure in the '962 application and conclude that it does not describe the genus of friction enhancing coatings claimed in the '251 patent and the '297 reissue application. Since the record contains considerable evidence showing that MCW was the only friction enhancing coating disclosed by Curtis at the time the '962 application was filed, the evidence is legally sufficient to support the Board's decision to deny Curtis the benefit of the earlier filing date.

4. CONTRIBUTORY INFRINGEMENT, VICARIOUS INFRINGEMENT, AND THE DIGITAL MILLENNIUM COPYRIGHT ACT

Ellison v. Robertson, No. 02-55797 (9th Cir. Feb. 10, 2004)

Issue A: Is summary judgment dismissal of contributory copyright infringement action proper when the district court identifies triable issues of fact? **Answer:** No.

Issue B: Is dismissal of vicarious copyright infringement proper when moving party does not offer sufficient evidence to survive summary judgment? **Answer:** Yes.

Issue C: Is summary judgment proper when there is a triable issue of material fact regarding a party's eligibility for the safe harbor limitations of liability under the Digital Millennium Copyright Act ("DMCA") **Answer:** No.

Facts: Harlan Ellison is the author of several science fiction novels and short stories. Stephen Robertson posted several of Ellison's copyrighted works on an America Online ("AOL") user network ("USENET") group. On April 17, 2000, Ellison's counsel sent an e-mail to AOL notifying them of the infringing activity. This message was sent in compliance with the procedures specified in the DMCA. Ellison, upon hearing nothing from AOL, filed suit on April 24, 2000 against AOL. Upon receipt of Ellison's complaint, AOL blocked access to the USENET group in question.

In the fall of 1999, AOL had changed its contact e-mail address. AOL did not register this change with the U.S. Copyright Office until April of 2000. AOL failed to configure its original e-mail address so that any e-mails sent to this address would return to the sender or be forwarded from the original address to the new address. The district court found that (i) the evidence failed to establish Ellison's claims of direct and vicarious copyright infringement, (ii) whether AOL was liable of contributory copyright infringement presented a triable issue of fact, (iii) the evidence showed that AOL met the threshold eligibility requirements for safe

harbor limitations and (iv) AOL qualified for safe harbor. Ellison appeals.

Reasoning A: Contributory copyright infringement requires that for Ellison to substantiate his claim, he must show that AOL knew or had reason to know of the infringing activity taking place on its USENET servers and that AOL materially contributed to the infringing activity.

Evidence indicates that AOL changed its e-mail address in an unreasonable manner and that AOL should have been on notice of infringing activity. That the USENET service allowed subscribers access to copyrighted works was sufficient to raise a triable issue regarding material contribution.

Reasoning B: Vicarious infringement requires Ellison to show that AOL derived a direct financial benefit from the infringing activities and had the right and ability to supervise the infringing activity.

There is no evidence to support that AOL subscriptions increased or decreased because of the infringement or that AOL lost subscriptions because of its obstruction of the infringement.

Reasoning C: The safe harbor liability limitations under 17 U.S.C. sec. 512(i) of the DMCA requires that a service provider satisfies the following:

[it] has adopted and reasonably implemented, and informs subscribers and account holders of the service provider's system or network of, a policy that provides for the termination in appropriate circumstances of subscribers and account holders of the service provider's system or network who are repeat infringers....

Because of their email address change, AOL "allowed notices of potential copyright infringement to fall into a vacuum and to go unheeded". Since AOL could not be notified of infringing activity via its posted e-mail

address, a reasonable jury could conclude that AOL "had not reasonably implemented its policy against repeat infringers" and thus AOL does not have the right to protection under the DMCA.

Conclusion A: A reasonable trier of fact could find that AOL materially contributed to the copyright infringement by storing infringing copies of Ellison's works on its USENET groups and providing the group's users with access to those copies. Thus, the appeals court affirmed the district court finding that triable issues exist with regard to contributory infringement and the case was remanded for trial on Ellison's claim of contributory copyright liability.

Conclusion B: No jury could reasonably conclude that AOL received a direct financial benefit from providing access to the infringing material. Therefore, Ellison's claim of vicarious copyright infringement fails.

Conclusion C: The appeals court reversed the district court's finding that AOL qualifies for the safe harbor limitation of liability under the DMCA since the district court failed to discern triable issues of facts concerning AOL's threshold eligibility for the DMCA's safe harbor limitations of liability.

OCPLA WEBSITE

Check the OCPLA website at 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."

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.

WELCOME NEW MEMBERS

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

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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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Contact us at: ronny.fogel@ibrux.com or Nizani@ibrux.com.

PATENT ATTORNEY

Blakely, Sokoloff, Taylor & Zafman LLP, Orange County office, seeks a patent attorney, preferably with an electrical or computer science background. Candidates should have at least 1-3 years experience in patent prosecution. The candidate will be responsible for all preparation and prosecution of U.S. and foreign patent applications. The firm offers a collegial environment, competitive salary and benefits.

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Orange County Patent Law Association July Meeting

Date: Wednesday, July 28, 2004

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: Arguing *KP v. Lasting Impression* in the Supreme Court

Speaker: Charles C.H. Wu of Law Offices of Wu & Cheung, LLP

Cost: \$30 for members and \$35 for non-members

Reservations: Please make reservations by filling out the form below and mailing it with a check to Neal M. Cohen to reach his office address given below, by the Friday before the meeting. If time is short, please also email Neal at nmc@cohen-sak.com or call in your reservation to the OCPLA Reservations Line number at (949) 724-1849.

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, June 23, 2004 for the following person(s):

This form and check should be mailed to:

Neal M. Cohen
Attention: OCPLA Lunch Reservations
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Orange County Patent Law Association

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2004 MEMBERSHIP APPLICATION/RENEWAL FORM

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

Member / Applicant Information:

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New Applicants please complete the following:

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

Applicant's Signature: _____ Date: _____

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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.

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2004 OCPLA EVENTS SCHEDULE

Date	Location	Speaker/Event	Topic
July 28, 2004	Wyndham Garden Hotel	Charles C.H. Wu Law Offices of Wu & Cheung, LLP	Arguing <i>KP v. Lasting Impression</i> in the Supreme Court
August 25, 2004	Wyndham Garden Hotel	Richard C. Hsu - Townsend and Townsend and Crew LLP Michael M. Krieger - UCLA Computer Science Department Jason H. Wilson - Willenken Wilson Loh & Stris LLP	SCO v. IBM What Every IP Lawyer and In-House Lawyer Needs to Know About This Landmark Litigation and About Open Source Software Legal Issues
September 22, 2004	Wyndham Garden Hotel	John R. King Knobbe, Martens, Olson & Bear, LLP	Patent Allowance, Now What? Continuation Strategies That Significantly Increase Patent Value



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