



OCPLA NEWSLETTER

Orange County Patent Law Association

www.ocpla.org

Vol. 13, No. 7

July 2007

JULY 2007 LUNCHEON

This month's luncheon will feature a panel of speakers commenting about the recent Supreme Court decisions in *KSR v. Teleflex* and *Microsoft v. AT&T*. Please register online or by filling out and returning the lunch reservation form attached below.

- Nina P. Tsai (BMKG Lawyers)

- Nicholas M. Zovko (Knobbe, Martens, Olson & Bear)

AUGUST BOARD MEETING

The August board meeting will be held on August 7 at the Law Offices of Kline, 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.

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.

NEW MEMBERS

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

- David A. Bernstein (BMKG Lawyers)
- Jared C. Bunker (Knobbe, Martens, Olson & Bear)
- Eric J. Goodman (BMKG Lawyers)
- Amanda J. McLaughlin (BMKG Lawyers)
- Justin Sanders (Student)
- Edward Schewe (Lauson & Schewe LLP)

INTERNET SIGHTINGS

BY JIM HAWES

This column highlights some of the more interesting recent internet newsletters and blogs dealing with IP prosecution issues. For more info go to the site cited. The sites mentioned are only the ones with notable stuff this last review period. If your favorite site isn't here, or if you'd like a full listing of the sites reviewed, email Jim at onejehawes@aol.com.

Hal Wegner's newsletter – the best of a lot of great stuff - hwegner@foley.com -

- The 6/6/07 issue cites a PCT application with 33 claims, 77

inventions, and a \$176,000. search fee. Can you top that?

- The 6/15/07 issue is one of many postings by Hal addressing the mess triggered by the recent KSR and Pfizer decisions. Hal's 6/21/07 posting attaches his "Chemical Obviousness" updating paper.
- The 6/16/07 posting reports that the OMB is being urged by an awesome group to return the new continuation rules to the PTO for "reproposal."
- The 6/24/07 issue discusses the Biomedino case and its significant impact on the use of means type claims. A must read for prosecution attorneys.
- The 6/25/07 posting discusses the Microstrategy decision and its fatal impact on the sloppy use of English in patent applications.
- The 6/30/07 posting presents Hal's current Top Ten list of cases on appeal.

Patently-O – a blog written by Dennis Crouch – patent@gmail.com

- The 5/30/07 blog presents the jury instructions on obviousness used in the Forgent case.
- The 6/18/07 blog discusses the Biomedino CAFC decision holding a claim and patent invalid for failing to disclose structure corresponding to a means clause, even if such disclosure is non needed by a skilled tech.
- The 6/21/07 pub reports the Bender disciplinary decision holding patent counsel to a higher standard when the client is "unsophisticated." See also Hal Wegner's 6/21/07 posting on this case.
- The 6/24/07 blog includes a discussion by Paul Morgan of a dangerous prosecution trap concerning published US patent appln. references.
- The 6/27/07 issue discusses the CAFC Young decision explaining fatal indefiniteness and curing inequitable conduct.

IP law 360 – a newsletter covering all IP, but focusing mainly on litigation –
web address: www.iplaw360.com

- The 6/12/07 issue's guest column urges all to carefully review their patent portfolios before the new patent rules come into force.

- The 6/20/07 newsletter includes a guest column that urges trademark owners on registerfly.com to check the status of their mark there.
- The 6/26/07 guest column discusses the tax consequences of a patent sale vs. a patent license, and how one can become the other.
- The 6/28/07 issue cites a lawyer name trademark case, of interest for its pleading (held adequate) that a former firm could not use his name.

The Invent blog – also from feedblitz@mail.feedblitz.com

- The 6/11/07 blog presents documents filed in the FTC action against Int'l. Product Design (Julian Gumpel), an invention development company.

Daily Dose of IP – a blog by Mark Reichel – www.dailydoseofip.blogspot.com –

- an ongoing series of synopses of recent notable CAFC decisions

I/P Updates – an occasional posting by Bill Heinze – billheinze@yahoo.com

- the 6/19/07 issue includes discussions of the background problem in pat. disclosures, structural vs. combination obviousness, and online access to the ECO trademark files.

Copyright Office News – copynews@loc.gov -

- A 6/1/07 notice invites participation in beta testing of an automated electronic copyright registration system to begin in July 2007.

WIPO notices – about the Madrid system posted at www.wipo.int/madrid/en/notices

PDF for lawyers – a tech newsletter for lawyers – feedblitz@mail.feedblitz.com

- As an example of this site's listings, the 6/6/07 issue discusses solutions to OCR problems encountered when using Acrobat 8.
- The 5/21/07 newsletter discusses Bates stamping documents the easy way.

Misc – Have you tried using the Google patent search function? What do you think of it

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

In *Entegris, Inc. (formerly known as Mykrolis Corporation) v. Pall Corporation*, Case No. 04-1440, Entegris sued Pall for infringement of patents relating to fluid filtering devices. The district court initially granted a preliminary injunction and subsequently held Pall in contempt for violating the injunction. The district court later dissolved the preliminary injunction based on a newly-raised invalidity challenge to the patents. Entegris appealed the dissolution of the preliminary injunction. Pall appealed the contempt finding.

The Federal Circuit dismissed Pall's appeal for lack of jurisdiction over the contempt order under 28 U.S.C. § 1292 because that order did not "modify" or "continue" the existing injunction. The Court also found that Pall's appeal lacked jurisdiction under Section 1295(a) because, although the order imposed a fine, it was not a "final decision" of the district court. The Court also refused to exercise pendant jurisdiction over the contempt order because it was not "inextricably intertwined" with the remaining issues on appeal. The Federal Circuit also affirmed the district court's decision to dissolve the preliminary injunction because the district court was within its discretion in finding that Pall's newly-raised invalidity defense did not "lack substantial merit."

In *Biomedino, LLC v. Waters Technologies Corporation, et al.*, Case No. 06-1350, the Federal Circuit affirmed the district court's invalidity determination because the claim limitation "control means" has no corresponding structure described in the specification as required by 35 U.S.C. § 112, ¶ 6. The Court found that "control" does not recite structure sufficient to rebut the presumption that 112 ¶ 6 applies. The Court also held that one of skill in the art would not understand the specification itself to disclose any corresponding structure and that whether that person would be capable of implementing a structure not disclosed in the specification to perform the function is irrelevant.

In *Bender v. Dudas*, Case No. 06-1243, the Federal Circuit affirmed the district court's grant of summary judgment upholding the PTO's disciplinary action. This case involves the

American Inventors Corporation, an invention promoter, that contracted with Bender to file design patents instead of utility patents for unsuspecting inventors. The PTO found that Bender had neglected an entrusted legal matter in violation of 37 C.F.R. § 10.77(c); accepted employment where professional judgment may be affected in violation of 37 C.F.R. § 10.62(a) and accepted compensation from a person other than a client without a full disclosure to the client in violation of 37 C.F.R. § 10.68(a)(1); and engaged in conduct that was prejudicial to the administration of justice in violation of 37 C.F.R. § 10.23(b)(5). The Court found that the PTO's findings were supported by substantial evidence, and that the disciplinary action was not arbitrary, capricious, an abuse of discretion, or otherwise not in accordance with the law.

In *The Saunders Group, Inc. v. Comfortrac, Inc., et al.*, Case No. 06-1576, the Federal Circuit reversed the district court's grant of summary judgment of no infringement as based on an erroneous claim construction. The patent at issue is directed to a portable cervical traction device and is the third in a sequence of related applications. The district court held that the term "pneumatic cylinder" in claim 1 is limited to pneumatic cylinders containing at least one pressure activated seal. In light of the structure of the claims (with some reciting pressure activated seals and others lacking that limitation), the focus of a Petition to Make Special on the defendants' device, and the absence of any clear disclaimer in the specification or the prosecution history, the Court held that the term "pneumatic cylinder" encompasses cylinders that do not use pressure activated seals.

The Court noted that: "Cases such as this one, in which predecessor applications or patents were drawn to narrow claims and in which the claims in the successor application are arguably broader than the invention described in the specification, present difficult questions of both claim construction and validity. [W]here—as in this case—the patentee has not been explicit about the scope of the new claims, the case can pose interdependent problems of both claim construction and validity."

In *Young v. Lumenis, Inc.*, Case No. 06-1455, the Federal Circuit reversed the district court's judgment that claims of the patent are indefinite due to the recitation of the term "near" and reversing the summary judgment of unenforceability. The patent is directed to a surgical method for removing a claw from a

domesticated cat. The Court held that the term "near" is not insolubly ambiguous and does not depart from the ordinary and customary meaning of the phrase "near" as meaning "close to or at."

With respect to inequitable conduct, the Court found that the prosecuting attorney's statements distinguishing a reference were attorney argument, not gross mischaracterizations or unreasonable interpretations of the reference. The Court also noted that the examiner was free to reach his own conclusions and accept or reject the prosecuting attorney's arguments. Thus, the Court held that there was no inequitable conduct.

In *Takeda Chemical Industries, LTD., et al. v. Alphapharm PTY., LTD., et al.*, Case No. 06-1329, the Federal Circuit affirmed the district court's judgment, after a bench trial, that the claimed compounds would not have been obvious in light of the prior art. The patent at issue is directed to compounds which can be used as antidiabetic agents having a broad safety margin between pharmacological effect and toxicity or unfavorable side reactions.

Though the district court rendered its decision before *KSR*, the Court found that nothing in *KSR* mandates reversal. The Court stated that test for prima facie obviousness for chemical compounds is consistent with the legal principles enunciated in *KSR*. While *KSR* rejected a rigid application of the teaching, suggestion, or motivation test, *KSR* acknowledged the importance of identifying a reason that would have prompted a person of ordinary skill to combine the elements in the way the claimed invention does. Moreover, the Court indicated that there is "no necessary inconsistency between the idea underlying the TSM test and the Graham analysis as long as the test is not rigidly applied." Thus, in cases involving new chemical compounds, the Court held that it remains necessary to identify some reason that would have led a chemist to modify a known compound in a particular manner to establish prima facie obviousness of a new claimed compound.

The Court upheld the district court's judgment in light of its "thorough" and "well-reasoned" opinion including extensive findings of fact and conclusions of law as to the four *Graham* factors.

In *Hyatt v. Dudas*, Case No. 06-1171, the Federal Circuit reversed the district court's judgment that the PTO Board erred in rejecting an

application's claims as lacking written description. Hyatt has filed numerous patent applications and continuation applications since the 1970s. Five of these are at issue in this case, all continuation applications with lineages that can be traced back for decades.

The question on appeal is when and how the PTO may require additional information from an applicant when determining whether to reject an application based on lack of written description pursuant to MPEP § 2163.04(I)(B). The Court held that, in the context of the written description requirement, an adequate prima facie rejection must sufficiently explain to the applicant what, in the examiner's view, is missing from the written description. The Court further held that the burden then properly shifts to the applicant to cite to the examiner where adequate written description could be found, or to make an amendment to address the deficiency. Here, the Court found that the examiner's rejection was sufficiently clear and that Hyatt cannot avoid addressing the rejection by instead challenging the PTO's view that the burden was properly shifted.

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

* Representative samples of corporate instruction manuals for proper usage of corporate trademarks are solicited for a research project.

* Confidential and/or proprietary information is not desired.

* Anonymity will be maintained if requested.

G. Donald Weber, Jr.
18442 Taft Avenue
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EXP 09/07

**IP Transactional Attorney
Paul Hastings**


The San Diego office of Paul, Hastings, Janofsky & Walker LLP is seeking a 2nd - 4th year (Class of 2003 - 2005) IP associate for IP licensing and patent prosecution. Ideal candidates will have a degree in electrical engineering or computer science, significant experience in patent prosecution, diligence, and counseling, and some experience in licensing and transactional work with an interest in acquiring additional experience in this area.

Outstanding academic credentials and admission to the CA State Bar required. Major law firm experience is preferred.

Please forward cover letter, resume and transcript to:

Johanna Carney
Attorney Recruiting & Development Senior
Coordinator
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3579 Valley Centre Drive
San Diego, CA
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EXP 09/07

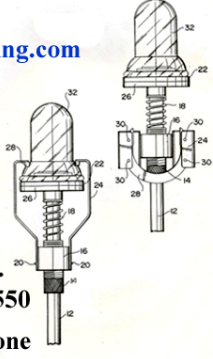
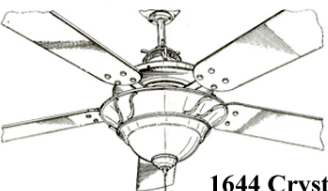


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Exp. 07/08

Orange County Patent Law Association

Date: Wednesday, July 25, 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: Recent Supreme Court Decisions in Intellectual Property Law

Speakers: Ed O'Connor, The Eclipse Grup; Georgann Grunebach, DirecTV; Randall Wick, Emulex Inc.; and TJ Singh of Klein, O'Neil & Singh

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, May 23, 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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Orange County Patent Law Association
Orange County Patent Law Association
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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	
Student Membership	\$17.50	
Associate Membership (other)	\$35.00	

(New Member After 08/01/07)

\$17.50
\$ 8.75
\$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
July 25, 2007	Wyndham Garden Hotel	Ed O'Connor, The Eclipse Grup; Georgann Grunebach, DirecTV; Randall Wick, Emulex Inc.; and TJ Singh of Klein, O'Neil & Singh	KSR v. Teleflex and Microsoft v. AT&T decisions and their impact
August 22, 2007	Wyndham Garden Hotel	TBD	McKesson Decision on Inequitable Conduct or New USPTO Rules
Sept. 26, 2007	Wyndham Garden Hotel	TBD	TBD
Oct. 24, 2007	Wyndham Garden Hotel	TBD	TBD
Nov. 28, 2007	Wyndham Garden Hotel	TBD	TBD