



# OCPLA NEWSLETTER

Orange County Patent Law Association  
[www.ocpla.org](http://www.ocpla.org)

Vol. 13, No. 8

August 2007

## AUGUST 2007 LUNCHEON

John King of Knobbe Martens Olson & Bear will speak on the McKesson case in which the CAFC affirmed a finding of Inequitable Conduct for failing to disclose information at this month's luncheon. Per the previous reminders sent, please register online by August 17, 2007.

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.

## SEPTEMBER BOARD MEETING

The September board meeting will be held on September 4th at the Law Offices Vista IP Law. 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.

## INTERNET SIGHTINGS

BY JIM HAWES

This column highlights some of the more notable 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](mailto:onejehawes@aol.com).

## SEEKING NOMINATIONS FOR THE 2008 OCPLA BOARD OF DIRECTORS

If you are interested or know of dedicated individuals that may be interested in serving on the OCPLA Board of Directors, please forward their names to Greg Hollrigel at [ghollrigel@coopervision.com](mailto:ghollrigel@coopervision.com) or to Tom Dao at [tom.dao@cph.com](mailto:tom.dao@cph.com).

**Hal Wegner's newsletter** – the best of a lot of great stuff - [hwegner@foley.com](mailto:hwegner@foley.com) -

- The 7/5/07 issue reports the Festo rehearing by the CAFC and its decision that the DOE does not apply when the accused structure is foreseeable. (I am sure glad I'm retired.)
- One of his 7/6/07 letters reports that a CAFC panel sat in the West once every four years since 1988. Some "national" court!
- The second 7/11/07 letter reports that the new continuation rules have been approved by the OMB, and become effective in October. It also lists many things that practitioners should be doing to prepare.

## 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

- Hal's third 7/11/07 blog reports a CAFC study – essential reading for appellate patent attorneys.
- If you use parallel arguments in parallel applications, you should read Hal's 7/12/07 blog concerning the British Apotex case.
- The 7/18/07 issue reports the Kubin BPAI expanded panel decision as the most significant biotech decision in at least a decade. Among much else it repudiates Deuel and adopts the Enzo decision reasoning re written description requirements.
- Another 7/18/07 note discusses the new Smith decision of the BPAI and its "tightened" standard of obviousness. And a third 7/18 note reports the Catan decision and PTO efforts to teach examiners KSR decision matters.
- The 7/19/07 issue gives Hal's overview of patent reform – insightful.
- The 7/26/07 note reports that 60% of CAFC dissents come from three members of the court. Amazing.
- Hal's 7/27/07 blog gives his current top ten list of cases on appeal.
- The 7/29/07 issue reports further eBay developments, and the E.D. Va. views concerning reexamination delays.

**Patently-O** – a blog written by Dennis Crouch – [patent@gmail.com](mailto:patent@gmail.com)

- The 7/1/07 blog discusses the CAFC Hyatt decision and its holding of inadequate disclosure for linkage among newly claimed elements.
- The 7/7/07 issue also discusses the Festo decision – see Hal Wegner @ 7/5
- The 7/8/07 blog cites a new statistics database of the CAFC.
- The 7/12/07 blog discussing the Pharmastem decision shows why the examiner's stated reasons for allowance do matter.
- The 7/23/07 issue includes an article titled "Are Administrative

Patent Judges Illegal?" It concludes that many of the BPAI judges were improperly appointed. Interesting.

**Rethink(IP)** – a newsletter of recent PTO matters – [feedblitz@mail.feedblitz.com](mailto:feedblitz@mail.feedblitz.com) -

- The 7/4/07 issue includes an update of its Guide to Downloading Patent Copies.

**IP law 360** – a newsletter covering all IP, but focusing mainly on litigation –

web address: [www.iplaw360.com](http://www.iplaw360.com)

- The 7/19/07 letter reports that the House Judiciary Committee unanimously OK'd the Patent Reform bill – is it getting on a fast track?

**The Invent blog** – also from [feedblitz@mail.feedblitz.com](mailto:feedblitz@mail.feedblitz.com)

- The 7/4/07 blog includes an updated PTO top 10 e-filing mistakes.
- The 7/24/07 blog updates internet patent research and downloading options.

**Daily Dose of IP** – a blog by Mark Reichel – [www.dailydoseofip.blogspot.com](http://www.dailydoseofip.blogspot.com) –

- Mostly an ongoing series of synopses of recent notable CAFC decisions
- The 7/12/07 blog reports PCT fee changes effective August 1, 2007.
- The 7/20/07 issue repeats the PTO notice of an LA piracy seminar on 8/20.

**Cal Bar IP Section** – alerts when appropriate - [mitch.wood@calbar.ca.gov](mailto:mitch.wood@calbar.ca.gov)

- The 7/9/07 alert announces the IP and Internet Program in late August.

## RECENT IP CASES

BY IRFAN LATEEF  
KNOBBE, MARTENS, OLSON & BEAR

In *Festo Corporation v. Shoketsu Kinzoku Kogyo Kabushiki Co., LTD*, (also known as *SMC Corporation*), et al., Case

No. 05-1492, the Federal Circuit affirmed the district court's judgment of no infringement under the doctrine of equivalents. This case raises the question of whether an equivalent is foreseeable within the meaning of *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722, 740 (2001), and subject to surrender under the doctrine of prosecution history estoppel. The Court held that foreseeability does not require the applicant to be aware that a particular equivalent would satisfy the insubstantial differences test or the function/way/result test with respect to the claim as amended. Rather, the Court found that an alternative is foreseeable if it was generally known to those skilled in the art at the time of amendment as available in the field of the invention as defined by the pre-amendment claim scope. Thus, the Court held that SMC's aluminum sleeve was a foreseeable alternative to Festo's magnetizable sleeve and that prosecution history estoppel applies.

In *Hutchins v. Zoll Medical Corporation*, Case No. 06-1539, the Federal Circuit affirmed the district court's grant of summary judgment of no infringement. All of the patent claims require a "general purpose computer system" that is adapted for specified purposes. The definition of "general purpose computer" was agreed to by the parties. Zoll's device contains a Hitachi SuperH RISC (Reduced Instruction Set Computer) microprocessor. The district court observed that the specification is specific to a general purpose computer and that all of the claims were so limited during prosecution producing a prosecution history estoppel bar. The Court found that it was "implausible" for a RISC microprocessor to be deemed a general purpose computer, for RISC microprocessors have limited functionality. The Court agreed.

In *Honeywell International, Inc., et al. v. Universal Avionics Systems Corp., et al.*, Case No. 06-1406, the Federal Circuit affirmed the district court's claim construction and the jury's infringement verdict under that claim construction. The patent involved an invention for assisting aircraft landings. The Court held that the specification and prosecution

history clearly showed that the term "aligning" referred to the orientation between the aircraft and the runway and no other form of alignment. The Federal Circuit similarly relied on the intrinsic evidence to construe several other disputed claim terms and affirmed both the claim construction and the district court's entry of judgment on the jury's infringement verdict.

In *Pharmastem Therapeutics, Inc. v. Viacell, Inc., et al.*, Case No. 05-1490, the Federal Circuit affirmed the district court's JMOL as to noninfringement of two patents, and, with respect to invalidity for obviousness, reversing the denial of JMOL and directing the entry of judgment for the defendants. The two patents in suit recite compositions and methods relating to a medical procedure for treating persons with compromised blood and immune systems.

With respect to infringement of the '681 patent, the only contested limitation is that the claimed composition contain neonatal or fetal hematopoietic stem cells "in an amount sufficient to effect hematopoietic reconstitution of a human adult." PharmaStem did not use direct testing or other scientific evidence to prove infringement. Instead, PharmaStem relied on indirect evidence in the form of advertising, scientific evidence relating to stem cell research in general, and testimony from representatives of the defendants. The Court found that this evidence did not provide a sufficient basis for a finding of infringement.

With respect to infringement of the '553 patent, PharmaStem based its claim of infringement on contributory infringement, because no defendants performed all the steps of any claim. The issue on appeal is whether there was substantial evidence to support the jury's finding that each of the defendants "contributorily infringed the '553 patent by selling or offering to sell cryopreserved cord blood that was actually used by a third party in . . . direct infringement" of that patent. The Court found that the defendants were never the owners of the blood and thus never "sold"

the blood and could not be found liable for contributory infringement under section 271(c).

With respect to obviousness and citing *KSR*, the Court found that the patents in suit were not patentable inventions because the inventors merely used routine research methods to prove what was already believed to be the case.

In her dissent, Judge Newman argues that the majority committed error by reweighing the evidence to reach its preferred result, rather than considering whether substantial evidence as presented at the trial supports the verdict that was reached by the jury.

In *In re Metoprolol Succinate Patent Litigation, AstrZeneca AB, et al. v. KV Pharmaceutical Company, et al.*, Case No. 06-1254, the Federal Circuit affirmed the district court's invalidity holding based on double patenting and vacating the district court's inequitable conduct holding and remanding the case because a genuine issue of material fact remains regarding the intent to deceive. The case involves patents related to metoprolol succinate in "extended release" forms, such as Toprol-XL®. The Court held that the '154 Patent was invalid for double patenting because genus claimed by the '154 Patent was an obvious variation of a species claimed by an earlier patent.

In *Integra Lifesciences I, LTD., et al. v. Merck KGaA, et al.*, Case No. 02-1052c, the Federal Circuit, upon remand from the Supreme Court regarding the statutory construction of Section 271(e)(1), reversed the district court's judgment of infringement. The Federal Circuit found that a reasonable jury could only find that the challenged experiments are within the FDA Exemption.

In *Biotechnology Industry Organization, et al. v. District of Columbia, et al.*, Case No. 06-1593, the Federal Circuit affirmed the district court's judgment declaring that the D.C.'s Prescription Drug Excessive Pricing Act of 2005, codified at D.C. Code § 28-4551

to 28-4555 ("the Act"), is preempted by the federal patent laws and enjoining its enforcement. The District of Columbia law restricts the sale of patented drugs "for an excessive price." The Federal Circuit explained that because the law is targeted at diminishing the returns Congress made available to patent owners, it conflicted with federal patent law.

In *In Re Icon Health and Fitness, Inc.*, Case No. 06-1573, the Federal Circuit affirmed the PTO Board's decision holding Icon's claims unpatentable as obvious. The patent related to a treadmill with a folding base. The appeal centered on whether it would have been obvious to add a gas spring to the treadmill to improve stability when folding it into an upright position. The Federal Circuit agreed that the claim was obvious in view of a combination of one reference that taught every limitation except the gas spring and another teaching the spring. The Court explained that because a gas spring was a well-known device to provide counterbalancing, one of skill in the art would have looked to gas spring technology to improve the ease of folding a treadmill into an upright position.

#### 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](mailto: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.

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[gdw4iplaw@aol.com](mailto:gdw4iplaw@aol.com)

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:

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Attorney Recruiting & Development Senior  
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3579 Valley Centre Drive  
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EXP 09/07

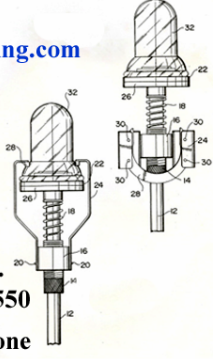
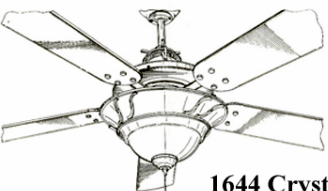


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Exp. 07/08

## Orange County Patent Law Association

**Date:** Wednesday, August 22, 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:** McKesson Information Solutions, Inc. v. Bridge Medical, Inc., Inequitable Conduct

**Speakers:** John King of Knobbe Martens Olson & Bear, LLP

**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](http://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](mailto: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, August 22, 2007 for the following person(s):

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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  
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**2007 OCPLA MEMBERSHIP APPLICATION/RENEWAL FORM**

**This is an application for (please check one):**

- Membership Renewal**  
 **New Membership**

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**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. _____
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**Please circle not more than TWO committees in which you would like to participate:**

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**Dues Membership Year 2007 (please circle one):**

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Student Membership	\$17.50	
Associate Membership (other)	\$35.00	

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\$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**

<b>Date</b>	<b>Location</b>	<b>Speaker/Event</b>	<b>Topic</b>
August 22, 2007	Wyndham Garden Hotel	John King, KMOB	McKesson Decision on Inequitable Conduct
Sept. 26, 2007	Wyndham Garden Hotel	TBD	TBD
Oct. 24, 2007	Wyndham Garden Hotel	TBD	TBD
Nov. 28, 2007	Wyndham Garden Hotel	TBD	TBD
Dec. 12, 2007	Balboa Yacht Club, NB	Holiday Party / Christmas Boat Parade	