



# OCPLA NEWSLETTER

Orange County Patent Law Association

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

Vol. 10, No. 10

October 2004

## OCTOBER LUNCHEON MEETING

Please join us at our next luncheon meeting on Wednesday, October 27, 2004, when we are pleased to present Charles Fowler of Orrick, Herrington & Sutcliffe, LLP, who will speak on "Knorr Bremse - The Aftermath". The lunch will be held at noon at the Wyndham Garden Hotel. This presentation qualifies for MCLE ethics credit.

In addition, at this October's meeting, we will be holding the OCPLA annual election. Please see the announcement on page 2 of this newsletter.

## NOVEMBER BOARD MEETING

On November 3, 2004, the OCPLA Board of Directors is holding its monthly meeting at noon at the offices of Knobbe, Martens, Olson & Bear, 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 . . .

- October 27, 2004**      **Knorr Bremse - The Aftermath**
- November 17, 2004**      **Enjoining the Serial Copyist**  
(the 3rd Wednesday of November)
- December 15, 2004**      **OCPLA Annual Holiday Party (Club 33)**

## MESSAGE FROM THE PRESIDENT

BY MATTHEW F. WEIL  
MCDERMOTT, WILL & EMERY  
[mweil@mwe.com](mailto:mweil@mwe.com)



Our congratulations and thank you go out to Marlene Klein for accepting the nominating committee's invitation to join the OCPLA's Board of Director's slate as a first-year director. Marlene, who works for Canon, is going to be a great addition to the Board. The Board elections are at our next general membership luncheon on October 27. Please make every effort to attend or return your proxy so your vote will count. The topic for the luncheon is the Knorr-Bremse opinion and the implications for writing opinion letters and asserting the attorney-client privilege.

## 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](mailto:gsh@patlawyers.com).

### RSVP ON TIME FOR MONTHLY LUNCHES

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.

### ELECTION OF OFFICERS

At the October meeting we will be voting on the officers for the Orange County Patent Law Association, for the year 2005. Our president for the year 2005 is Margaret Kivinski. All other officers and the three members of the Board of Directors are up for election, or re-election. Traditionally, the Officers and Board of Directors have advanced through various duties each year toward the office of President.

That leaves one position to fill on the Board of Directors. A nominating Committee appointed pursuant to Section 8.1 of the Association's By-Laws has nominated Marlene Klein of Canon's Intellectual Property Division.

The complete slate of officers and directors proposed for 2005 is as follows:

President	Margaret A. Kivinski
V.P./President Elect	John King
Secretary	Leonard R. Svensson
C.F.O./Treasurer	Greg S. Hollrigel
Director	Neal M. Cohen
Director	T.J. Singh
Director	Marlene Klein

Additional Candidates can be nominated pursuant to Section 8.3 of the By-Laws.

### ANNUAL MEETING PROXY

If you are unable to attend the Annual Meeting on October 27, 2004, please complete the enclosed proxy statement form on page 9, prior to the meeting.

### 2004 OCPLA HOLIDAY PARTY

#### **Please remember to mark your calendars.**

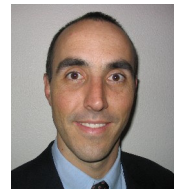
This year the OCPLA will be hosting its annual holiday party at Club 33 at Disneyland on **December 15, 2004**. Please join your fellow OCPLA members in celebrating the 2004 Holiday Season, and witness "The Passing of The Official Fez" ceremony. Details and a reservation form will be provided in the November newsletter.

### 2005 MEMBERSHIP RENEWAL

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

### PTO UPDATE

BY GREG S. HOLLRIGEL  
STOUT, UXA, BUYAN & MULLINS,  
LLP  
[gsh@patlawyers.com](mailto:gsh@patlawyers.com)



### Changes To Support Implementation of the United States Patent and Trademark Office 21st Century Strategic Plan

On September 21, 2004, the USPTO published a notice regarding several changes to the rules to practice before the USPTO. Depending on the particular rule, the changes went into effect

on September 21 or go into effect on October 21 or November 21, 2004.

Among the changes, are:

- provisions to permit signing of paper communications by electronic signatures (S - signatures; effective September 21, 2004);
- changes to "incorporation-by-reference" practice, including no longer requiring an express incorporation by reference for an application that is part of a priority claim (effective September 21, 2004);
- changes to Application Data Sheet requirements (effective October 21, 2004);
- requirements for labeling of replacement or new sheets of drawings (effective September 21, 2004);
- changes regarding preliminary amendments that are submitted at the time of filing an application (effective September 21, 2004); and
- elimination of the physical surrender of the original ribboned patent for a reissue application (effective September 21, 2004).

Additional information may be obtained at the following website:  
<http://www.uspto.gov/web/offices/com/sol/notices/69fr56481.pdf>

### **New Mailing Addresses for Paper Submissions of Trademark-Related Correspondence and Madrid Protocol Rules Change**

On September 24, 2004 the USPTO published a notice regarding new mailing addresses for paper submissions of trademark related correspondence. The changes went into effect on October 4, 2004.

Additional information can be found at:  
<http://www.uspto.gov/web/offices/com/sol/notices/69fr57181.pdf>.

## **MINUTIAE**

**BY NEAL M. COHEN**  
**COHEN SAKAGUCHI & ENGLISH LLP**  
[nmc@cohen-sak.com](mailto:nmc@cohen-sak.com)



### **Sizing up Trademark Specimen Requirements**

Most folks would agree that the electronic trademark filing system (E-TEAS) is years ahead of the electronic patent filing system (what is that one called?). But despite the ease of TEAS, the somewhat strict requirements for electronic specimens has caused more than a few E-TEAS users a bit of frustration.

Specifically, the specimens are required to be in jpg format, and be between 300 and 350 dots per inch. Furthermore, the dimensions of a specimen are required to be between 250 pixels 944 pixels. But how is one supposed to change these characteristics of an image, especially when the image is client-provided and way out of range? Surely, there must be some simple way, right? The short answer is, yes, there is. It's Irfanview, and is available for free at [www.irfanview.com](http://www.irfanview.com). The PTO even has a link to Irfanview within the help text of E-TEAS related to submitting specimens.

Now that we have Irfanview, we have conquered one of the last obstacles to a worry-free E-TEAS! Too bad, though, because effective October 6, 2004, THE PTO IS WAIVING THE JPG IMAGE REQUIREMENTS [69 FR 59810, October 6, 2004, or if that cite is not "proper", try <http://www.uspto.gov/web/offices/com/sol/notices/69fr59809.pdf>]. In any case, even if we no longer need Irfanview for E-TEAS, Irfanview can be very valuable for manipulating non-specimen-type images. Check it out!

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

## OCPLA WEBSITE

Check the OCPLA website at [www.ocpla.org](http://www.ocpla.org) for copies of the OCPLA newsletter, for membership information and for current events of interest to members. Let us have your comments. We will be making changes and improvements as time passes, and your comments will be useful in knowing what to change and what to leave alone. Send comments to "[webmaster@ocpla.org](mailto:webmaster@ocpla.org)."

## OCPLA POLICY

Although we are open to comments and suggestions, present policy concerning publication of advertisements in this newsletter is as follows: (1) "Positions Wanted," "Positions Available," and other similar ads will be printed free of charge and, unless otherwise requested, will run for two months; (2) Other ads such as word processing, legal support services, and firm announcements will be published for \$15 per issue or \$150 per year (for all 12 issues), payable in advance. We reserve the right to edit each advertisement. Please contact the Newsletter editor to place your ad or with your comments and suggestions.

## BOARD OF DIRECTORS AND COMMITTEE CHAIRS

BOARD OF DIRECTORS	TELEPHONE/E-MAIL
<b>President</b>	Matthew F. Weil 949-851-0633 mweil@mwe.com
<b>V.P./President Elect</b>	Margaret A. Kivinski 949-757-1999 mkivinski@therox.com
<b>Secretary</b>	John R. King 949-760-0404 jking@kmob.com
<b>C.F.O./Treasurer</b>	Leonard R. Svensson 714-708-8555 lrs@bskb.com
<b>Directors</b>	Greg S. Hollrigel 949-450-1750 gsh@patlawyers.com Neal M. Cohen (949) 724-1849 nmc@cohen-sak.com TJ Singh (949) 955-1920 tjsingh@koslaw.com
<b>Immediate Past President</b>	Stefan J. Kirchanski 310-734-5200 skirchanski@reedsmith.com
<b>COMMITTEE CHAIRPERSONS</b>	
<b>Annual Seminar</b>	Margaret A. Kivinski 949-757-1999 mkivinski@therox.com Neal M. Cohen (949) 724-1849 nmc@cohen-sak.com
<b>Copyright Practice</b>	Darren S. Rimer (949) 367-1541 darren@rimermath.com
<b>Federal Courts</b>	Robert L. Grabarek, Jr. (949) 263-8400 rgrabarek@crowell.com
<b>Int'l IP Practice</b>	Alexander R. Schlee 310-545-9851 alexschlee@vjp.de
<b>Law Off. Mgmt.</b>	Gabia Pakstys 650-326-3466 gpakstys@sbcglobal.net
<b>Legislative</b>	<b>Position Open</b>
<b>MCLE</b>	T. J. Singh (949) 955-1920 tjsingh@koslaw.com
<b>Meetings/Programs</b>	Neal M. Cohen (949) 724-1849 nmc@cohen-sak.com
<b>Newsletter Editor</b>	Greg S. Hollrigel 949-450-1750 gsh@patlawyers.com
<b>Patent Practice</b>	Neal M. Cohen (949) 724-1849 nmc@cohen-sak.com
<b>Trade Secrets/Unfair</b>	<b>Position Open</b>
<b>Competition Law</b>	Perry J. Viscounty 714-755-8288 perry.viscounty@lw.com
<b>Trademark Practice</b>	Susan Natland 949-760-0404 smn@kmob.com
<b>Luncheon Speakers</b>	Matthew F. Weil 949-851-0633 mweil@mwe.com
<b>OCPLA Website</b>	Marlene Klein 949-932-3132 marlene.klein@cda.canon.com
<b>OCPLA Database</b>	Greg S. Hollrigel 949-450-1750 gsh@patlawyers.com

## 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:

OCPLA Newsletter Editor  
**Greg S. Hollrigel**  
 Stout, Uxa, Buyan & Mullins, LLP  
 4 Venture, Suite 300  
 Irvine, CA 92618  
 email: [gsh@patlawyers.com](mailto:gsh@patlawyers.com)  
 Tel: 949-450-1750  
 Fax: 949-450-1764

## SERVICES, ANNOUNCEMENTS, WANT ADS

### MARCELO E. SROKA, CPA

Wertz & Co., CPAs  
 5450 Trabuco Road  
 Irvine, CA 92620-5074  
 949-756-5000 x218

### STEPHEN T. FREEMAN, ESQ.

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The \$399 **iClaim®** Software by Brux Software Solutions can be explored at [www.ibrux.com](http://www.ibrux.com). Evaluation software is available for FREE download at: <http://www.ibrux.com/Try.asp>.

**iClaim®** software is installed as an add-in to Microsoft Word®. It is very easy to use and requires no training.

Contact us at: [ronny.fogel@ibrux.com](mailto:ronny.fogel@ibrux.com) or [Nizani@ibrux.com](mailto:Nizani@ibrux.com).

### Patent Attorney/Agent Wanted

MacPherson Kwok Chen & Heid LLP is seeking a first or second year patent attorney/agent in its Irvine office. Preferrably, the candidate will have a degree in EE, Comp. Sci., or Physics with some engineering experience. For more information about the firm, please visit our web site at [www.macpherson-kwok.com](http://www.macpherson-kwok.com). Please direct any questions or resumes to Tom Chen at [tchen@macpherson-kwok.com](mailto:tchen@macpherson-kwok.com).

### PATENT ASSOCIATE WANTED:

The growing IP group of the Orange County office of Paul, Hastings, Janofsky & Walker LLP is seeking an IP associate with two to three years of experience in patent prosecution and/or IP litigation. Candidates must possess either a degree in Electrical Engineering or Computer Science. JD required; admittance to the California State Bar and USPTO is a plus.

Please send resumes and transcript to [marilynradley@paulhastings.com](mailto:marilynradley@paulhastings.com) or direct fax to 714 668-6570

### ASSOCIATE ATTORNEY

Crockett & Crockett, a Laguna Hills Patent and Trademark Law Firm, is seeking an attorney. Candidate must have a technical degree - electrical, mechanical, or biomedical engineering preferred. At least 2 years of experience required. Job duties include patent and trademark prosecution and litigation.

Fax or email cover letter and resume to Susan Crockett, Esq., Crockett & Crockett, fax #949 588 6172, email [Susancrockett@crockett-crockett.com](mailto:Susancrockett@crockett-crockett.com)

### Office Available

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

### PATENT ASSOCIATE WANTED

The Orange County office of McDermott Will & Emery is seeking a patent prosecution associate with 2+ years experience. Applicants must have a degree and/or graduate study experience in Electrical Engineering or Computer Science or an advanced degree in Physics. Candidates must be admitted to practice in California. In addition, the qualified candidate will have excellent analytical skills, writing skills and academic records.

Please send cover letter, resume and transcripts to [kvandriel@mwe.com](mailto:kvandriel@mwe.com) or fax to 949.851.9348.

### POSITIONS OPEN

#### Patent Associate

Duties include mechanical and electrical patent preparation and prosecution. Must have at least 5 years US and PCT experience, and ability to work as primary client contact. Technical background is preferably EE, physics, or mechanical.

#### Supervising Attorney

Duties include 1) ensuring that patent applications/amendments written by other attorneys meet written quality control standards of firm; 2) working 2-3 days per week – about 10-20 hours per week; 3) writing own cases outside of office if desired.

#### Litigation Associate

Duties include managing infringement litigation from inception through trial, including oversight of junior associates. Must have first or second chair trial experience.

#### Trademark Paralegal

Paralegal needed to handle trademark work. Must have 5+ years trademark experience and be able to work independently. Patent prosecution experience a plus.

#### Legal Secretary or Paralegal

Duties include the administrative management of all patent applications. Must have 5+ years patent prosecution experience and be able to work independently.

Email letter and resume to: Shimokaji & Associates, P.C., [swedo@shimokaji.com](mailto:swedo@shimokaji.com).

**AMGEN Inc.**

**Company Background:** Amgen, the world's largest biotechnology company, uses science and innovation in an effort to dramatically improve people's lives. Amgen aspires to be the world's best human therapeutics company. Our researchers harness the powerful tools of cellular and molecular biology and medicinal chemistry to discover, develop and commercialize naturally occurring proteins, antibodies and small molecules, with the goal of extending the reach of science to unleash the body's own powerful therapeutic responses.

**Position No. 1**

**Title:** Corporate Counsel II

**Department:** Amgen Legal / Patent Law Group

**Location:** Thousand Oaks, CA

**Job Description**

This candidate will be involved primarily in patent litigation, drafting opinions and developing legal strategies associated with Amgen's business and research endeavors and may be involve in some patent prosecution and licensing

**Experience**

The position requires a minimum of 5-7 years of experience in patent litigation, including trial experience, preferably in biotechnology related cases, and a solid background in all aspects of U.S. intellectual property law, and the ability to travel. This position requires a J.D. degree and admission to practice before a state bar and the U.S. Patent Office.

**Position No. 2**

**Title:** Corporate Counsel II

**Department:** Amgen Legal / Patent Law Group

**Location:** South San Francisco, CA and Thousand Oaks, CA

**Job Description**

This candidate will be involved in patent application drafting and prosecution, drafting and negotiation of various research and licensing agreements in coordination with licensing counsel, drafting opinions and developing legal strategies associated with Amgen's business and research endeavors, as well as the potential for having involvement in some copyright, trademark and litigation matters. The position requires a minimum of 4 years of experience in all aspects of U.S. foreign intellectual property law relating to chemistry, preferably in the pharmaceutical or agrichemical industries. This position requires a J.D. degree and admission to practice before a state bar and the U.S. Patent Office.

**How to Apply:**

If you are interested in applying for these , please apply online on Amgen's website at [www.amgen.com](http://www.amgen.com) and please contact Craig Seipel at (805) 313-4534 or [cseipel@amgen.com](mailto:cseipel@amgen.com) if you have any questions.

As an EEO/AA M/F/D/V employer, Amgen values and encourages diversity in the workplace.

**Orange County Patent Law Association  
October Meeting****Date:** Wednesday, October 27, 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:** Knorr Bremse - The Aftermath**Speaker:** Charles Fowler, Orrick, Herrington & Sutcliffe, 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](mailto: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, October 27, 2004 for the following person(s):

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This form and check should be mailed to:

**Neal M. Cohen**  
**Attention: OCPLA Lunch Reservations**  
**Cohen Sakaguchi & English LLP**  
**2040 Main Street, 9th Floor**  
**Irvine, CA 92614**  
**Tel: (949) 724-1849**  
**Fax: (949) 625-8955**  
**E-mail: [nmc@cohen-sak.com](mailto:nmc@cohen-sak.com)**

### OCPLA Election of Officers Annual Meeting



Wyndham Garden Hotel  
Wednesday, October 27, 2004  
12:00 p.m.




**All OCPLA Members must submit their vote.**

**The Officers and Board of Directors up for Election and Re-election for 2005 are:**

- V.P./President Elect ..... John R. King
- Secretary ..... Leonard R. Svensson
- C.F.O./Treasurer ..... Greg S. Hollrigel
- Director ..... Neal M. Cohen
- Director ..... T.J. Singh
- Director ..... Marlene Klein

The President for the year 2005 will be Margaret Kivinski.



**Proxy Statement Form\***

I, \_\_\_\_\_, a member of the Orange County Patent Law Association:

vote by proxy for the proposed slate of officers listed above for the 2005 term;

designate Margaret Kivinski or \_\_\_\_\_ as my proxy at the October 27, 2004 meeting; or

abstain from voting but submit this proxy for purposes of establishing a quorum only.

This Proxy Statement form should be mailed or faxed to:

**Neal M. Cohen**  
**Attention: OCPLA Lunch Reservations**  
**Cohen Sakaguchi & English LLP**  
**2040 Main Street, 9th Floor**  
**Irvine, CA 92614**  
**Tel: (949) 724-1849**  
**Fax: (949) 625-8955**  
**E-mail: nmc@cohen-sak.com**

\*If you are unable to attend the Annual Meeting on October 27, 2004, please fill out this proxy statement form prior to the meeting.



# Orange County Patent Law Association

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

## 2005 MEMBERSHIP APPLICATION/RENEWAL FORM

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

Member / Applicant Information:

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

Firm/Employer: \_\_\_\_\_

Address: \_\_\_\_\_

E-mail Address (required to receive newsletter): \_\_\_\_\_

Telephone No.: \_\_\_\_\_ Facsimile No.: \_\_\_\_\_

**Professional Information:**

	Yes	No	
Are you a member of the California bar?	___	___	Bar No. _____
Are you a member of the bar of another state or the District of Columbia?	___	___	Jurisdiction/Bar No. _____
Are you registered to practice before the U.S.P.T.O.?	___	___	Reg. No. _____
Are you a student?	___	___	School: _____

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

Annual Seminar	Law Office Management	Membership
Copyright Practice	Legislation	Patent Practice
Federal Courts	MCLE	Trademark Practice
International Practice	Meetings/Programs	Trade Secret/Unfair Competition

**Dues Membership Year 2005 (please circle one):**

		<b>(New Member After 07/01/05)</b>
Regular Membership (attorneys, agents):	\$35.00	\$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**

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

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

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

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

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

## 2004 OCPLA EVENTS SCHEDULE

Date	Location	Speaker/Event	Topic
<b>October 27, 2004</b>	Wyndham Garden Hotel	<b>Charles Fowler</b> Orrick, Herrington & Sutcliffe, LLP	Knorr Bremse - The Aftermath
<b>November 17, 2004, *11:59 AM*</b>  *Note special date and time	Wyndham Garden Hotel	<b>Paul Stewart</b> Knobbe, Martens, Olson & Bear, LLP	Enjoining the Serial Copyist
<b>December 15, 2004</b>	Club 33 at Disneyland		OCPLA Annual Holiday Party



Orange County Patent Law Association  
P.O. Box 7632  
Newport Beach, CA 92658