OCPLA NEWSLETTER

Orange County Patent Law Association

www.ocpla.org

Vol. 10, No. 11 November 2004

NOVEMBER LUNCHEON MEETING

Please join us at our next luncheon meeting on Wednesday, November **17**, 2004, when we are pleased to present Paul Stewart of Knobbe, Martens, Olson & Bear, LLP, who will speak on "Enjoining the Serial Copyist". The lunch will be held at noon at the Wyndham Garden Hotel.

Please note that this month's lunch is on the 3rd Wednesday, as opposed to the normal 4th Wednesday.

DECEMBER BOARD MEETING

On December 1, 2004, the OCPLA Board of Directors is holding its monthly meeting at noon at 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.

2005 BOARD OF DIRECTORS

We are pleased to announce the following duly elected OCPLA Board of Directors for 2005:

President	Margaret A. Kivinski
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Director	Neal M. Cohen
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MARK YOUR CALENDARS . . .

November 17, 2004	**Enjoining the Serial Copyist**
December 15, 2004	**OCPLA Annual Holiday Party (Club 33)**
January 26, 2006	**Valuing Intellectual Property and IP Damages**

E-MAIL DISTRIBUTION OF THE NEWSLETTER

<u>The Newsletter is now being transmitted solely by electronic mail</u>. 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 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.

2004 OCPLA HOLIDAY PARTY

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. The Party will begin at 6:00 p.m. with hors d'oevres and a cash bar. At 7:00 p.m. dinner will be served. A reservation form is attached. Please RSVP to Greg Hollrigel **before November 22, 2004**. Reservations are limited to the first 100 people.

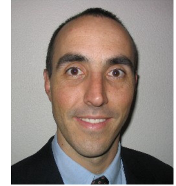
We look forward to celebrating the 2004 holiday season with you and a guest at Club 33. Your reservation entitles you and your guest to entrance at both Disneyland and California Adventure Park during the day before the dinner.

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. Please renew early to reduce delays in processing your application.

PTO UPDATE

BY GREG S. HOLLRIGEL
STOUT, UXA, BUYAN & MULLINS, LLP
gsh@patlawyers.com



Patents

On October 29, 2004, the USPTO announced that most provisional applications that are relied upon for their earlier filing dates in U.S. patent application publications or U.S. patents are now available to the public over the Internet. Exceptions include provisional applications with filing dates prior to 1997. Provisional applications may be viewed using the Public PAIR website at http://portal.uspto.gov/external/portal/pair.

Additional information can be found at the following website: http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/termprovcopies.pdf

Trademarks

The USPTO has also published notices regarding corrections to new mailing addresses for trademark-related correspondence and Madrid Protocol rule changes. In addition, electronic forms for Madrid Protocol filings are now available.

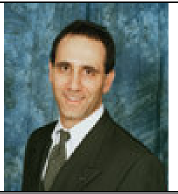
Additional information can be obtained at the following websites:

http://www.uspto.gov/web/offices/com/sol/notices/69fr63320.pdf and

http://www.uspto.gov/web/offices/com/speeches/04-30.htm

MINUTIAE

BY NEAL M. COHEN
COHEN SAKAGUCHI & ENGLISH LLP
nmc@cohen-sak.com



Addressing Patent Correspondence To The Trademark Office Mailing Address

What?! Why would you address patent correspondence to the Trademark Office mailing address? I don't know. But I know that if you did, you might not get your desired filing date. But you might! There. Now you understand what this article is about, right? "Of course," you say. "It's about a subtle difference between Rule 1.8 and Rule 1.10." Just to prove you're right, go ahead and keep reading.

Rule 1.8 (37 C.F.R. 1.8, Certificate of mailing or transmission), states that correspondence required to be filed with the PTO within a set period of time will be considered as being timely filed if the procedure described in that section is followed. The procedures in that section then allow for mailing or faxing. For mailing, subsection (1)(A) requires that the correspondence be addressed "as set out in § 1.1(a)". Section 1.1(a) in turn provides for specific addresses depending on the nature of the correspondence. For example, "All correspondence concerning patent matters processed by organizations reporting to the Commissioner for Patents should be addressed to: Commissioner for Patents, PO Box 1450, Alexandria, Virginia 22313-1450."

Now let's look at Rule 1.10 (37 C.F.R. §1.10, Filing of correspondence by "Express Mail"), which states that any correspondence ***received*** by the PTO that was delivered by the Express Mail Post Office to Addressee service of the USPS will be considered filed with the USPTO on the date of deposit with the USPS. Unlike Rule 1.8, there is no requirement that the correspondence was actually addressed properly.

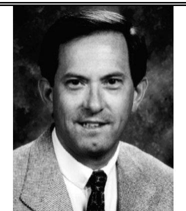
So, going back to the original question, hopefully you can now see that if you mail a patent correspondence addressed to the Trademark Office mailing address and send it using what you believe to be a Rule 1.8 Certificate of mailing, you will be disappointed. That's because since you did not use the specific address required under Rule 1.1(a) (as required by Rule 1.8), you will not get the filing date you expected. On the other hand, if you mail that same patent correspondence addressed to the same Trademark Office mailing address and send it using Express Mail under 1.10 instead, you will probably be pleasantly surprised. That's because despite mailing the correspondence to the "wrong" address, Rule 1.10 allows you to get the filing date you expected because the "T" part of the "PTO" will have presumably ***received*** the correspondence.

So there you have it. Not something to try for fun, but something to know in case you ever need it.

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

RECENT INTERESTING IP CASES

BY LEONARD R. SVENSSON
BIRCH, STEWART, KOLASCH & BIRCH, LLP
lrs@bskb.com



1. ALL SUBSTANTIAL RIGHTS RULE RECONFIRMED FOR ENFORCEMENT BY "EXCLUSIVE" LICENSEE

***Fieldturf, Inc. v. S.W. Recreational Indus., Inc.*, 357 F.3d 1266, 69 U.S.P.Q.2d (BNA) 1795 (Fed. Cir. Feb. 4, 2004)**

Issue: Does a successor to an "exclusive" patent licensee have standing to enforce the licensed patent if the license agreement in question did not mention who would hold the right to enforce the patent? **Answer:** No.

U.S. Patent No. 4,337,283 ("the '283 patent") issued in 1982 to Frederick T. Haas, Jr., and was directed to a certain artificial turf for athletic games. During prosecution, the patent application was assigned to Mod-Sod Sports Surfaces ("MSSS"), a partnership owned by

Haas and his family. In 1994, Haas and Mod-Sod Sports Surfaces, Inc. ("MSSSI"), the purported successor to MSSS, granted a limited exclusive license to make and market embodiments of the '283 patent to Jean Prevost and SynTenniCo, Inc. ("STC"), which is a predecessor to Fieldturf Holdings, Inc. The exclusive license agreement ("the 1994 agreement") allowed STC and Prevost to enforce the '283 patent against infringers only after MSSSI and Haas had refused to do. Prevost on behalf of STC, and Haas on behalf of MSSSI, later entered into a one-page letter agreement ("the 1998 agreement") which stated, in relevant part, that it "cancels and replaces the [1994] agreement" and that STC "[would] continue to be the exclusive licensee of [the '283 patent] except for golf products." The 1998 agreement, however, had no mention as to who would hold the right to enforce the '283 patent. STC's rights in the 1998 agreement were eventually assigned to Fieldturf, Inc., one of the plaintiffs to this litigation (collectively "Fieldturf").

Fieldturf filed suit against S.W. Recreational Industries, Inc. ("Southwest") for infringement of the '283 patent. The District Court for the Eastern District of Kentucky dismissed all of the counts with prejudice. Fieldturf appealed to the CAFC.

Southwest asserts that Fieldturf lacks standing to enforce the '283 patent and that Fieldturf's patent claim should therefore be dismissed. Fieldturf asserts that it has standing because it is an exclusive licensee endowed with all substantial rights in the patent, as evidenced by the 1998 agreement made between its predecessor, STC, and MSSSI.

The Court found that:

> “To bring an action for patent infringement, ... [a] purported exclusive licensee must show that he possesses "'all substantial rights' in the patent." ... Lacking all substantial rights, he may bring suit against "third parties only as a co-plaintiff with the patentee" or a successor in title to the patentee. ... Otherwise, he lacks standing.”

(Citations omitted.) Under the 1998 agreement, STC was not granted the right to enforce the patent, "either explicitly or impliedly," and the licensor retained a limited right to develop and market the patented invention.

Conclusion: Because it lacks the important consideration of patent enforcement rights, the 1998 agreement "is nothing more than an exclusive licensing agreement that fails to convey all substantial interest in the '283 patent." Since STC failed to acquire all substantial rights in the patent by the 1998 agreement, plaintiff Fieldturf lacks standing and the claim must be dismissed.

2. NO ADVERSE INFERENCES FROM AN ACCUSED INFRINGER'S FAILURE TO OBTAIN OR PRODUCE AN OPINION OF COUNSEL; PRECEDENT AUTHORIZING SUCH INFERENCE IS OVERRULED

***Knorr-Bremse Systeme fuer Nutzfahrzeuge GmbH v. Dana Corp.*, Nos. 01-1357, -1376, 02-1221, -1256 (Fed. Cir. Sept. 13, 2004) (*en banc*)**

Issue A: When a defendant invokes the attorney-client privilege and/or work-product privilege in an infringement suit, is it appropriate for the trier of fact to draw an adverse inference with respect to willful infringement? **Answer:** No.

Issue B: When the defendant had not obtained legal advice, is it appropriate to draw an adverse inference with respect to willful infringement? **Answer:** No.

Issue C: If the court concludes that the law should be changed, and the adverse inference withdrawn as applied to this case, what are the consequences for this case? **Answer:** The finding of willful infringement must be vacated for reconsideration of a totality of the circumstances.

Issue D: Should the existence of a substantial defense to infringement be per se sufficient to defeat liability for willful infringement even if no legal advice has been secured? **Answer:** No.

Background: Knorr-Bremse manufactures air disk brakes for use in heavy commercial vehicles. Defendants-appellants Dana

Corporation, an American company, and the Swedish company Haldex Brake Products AB and its United States affiliate agreed to collaborate and sell in the United States an air disk brake manufactured by Haldex in Sweden. The appellants imported about 100 units of a Haldex brake (the Mark II model), into the U.S. Between 1997 and 1999, the Mark II brake was installed in around eighteen trucks of Dana and potential customers.

On August 31, 1999, Knorr-Bremse notified Dana of infringement litigation against Haldex in Europe and that Knorr-Bremse's U.S. Patent No. 5,927,445 ("the '445 patent") had issued on July 27, 1999. Knorr-Bremse filed suit on May 15, 2000. In September 2000, Haldex presented a modified brake design to the district court (the Mark III), and moved for a summary declaration of non-infringement by the Mark III brake. Knorr-Bremse moved for summary judgment of literal infringement by the Mark II brake and infringement by the Mark III either literally or under the Doctrine of Equivalents. The district court granted Knorr-Bremse's motion for summary judgment of literal infringement by the Mark II brake. Following a trial in January 2001, the district court found literal infringement by the Mark III brake.

On the issue of willful infringement, Haldex said it had consulted European and U.S. counsel regarding Knorr-Bremse's patents. However Haldex asserted attorney-client privilege and declined to produce any legal opinion or disclose advice received. Dana stated that it did not itself consult counsel, but rather relied on Haldex. Applying Federal Circuit precedent, the district court found that it was "reasonable to conclude that such opinions were unfavorable."

The district court concluded that "the totality of the circumstances compels the conclusion that defendants' use of the Mark II brake … [was] willful infringement of the '445 patent." Based on this finding of willful infringement, the district court found the case "exceptional" under 35 U.S.C. sec. 285 and awarded Knorr-Bremse attorney fees for the portion of the case related to the Mark II brake.

The appellants appealed the issue of willfulness of the infringement and the ensuing award of attorney fees. After the appellate argument, the CAFC issued an order to take the case en banc to reconsider precedent and to obtain further briefing on four questions. *See* BSKB Case Brief, vol. 1, no. 45.

Arguments: The appellants argued that the adverse inferences made from Haldex's invocation of the attorney-client privilege regarding the opinion of counsel they obtained and from Dana's failure to obtain an opinion were improper.

Reasoning: The determination of willfulness is made considering the totality of circumstances and may include the contributions of several factors. Earlier cases found that an adverse inference may be made from invocation of the attorney-client privilege or failure to obtain an opinion. This adverse inference was reinforced in *Fromson v. Western Litho Plate & Supply Co.*, 853 F.2d 1568, 1572-73, 7 U.S.P.Q.2d (BNA) 1606, 1611 (Fed. Cir. 1988), which established the general rule that a court must be free to infer that either no opinion was obtained or, if an opinion were obtained, it was contrary to the infringer's desire to initiate or continue its use of the patentee's invention.

However, the inference that withheld opinions are adverse to the client's actions can distort the attorney-client relationship, in derogation of the foundations of that relationship. ... There should be no risk of liability in disclosures to and from counsel in patent matters because such risk can intrude upon full communication and ultimately the public interest in encouraging open and confident relationships between client and attorney.

Conclusion A: Although the duty to respect the law is undiminished, no adverse inference shall arise from invocation of the attorney-client and/or work-product privilege.

Conclusion B: Dana Corporation did not seek independent legal advice upon notice by Knorr-Bremse of the pendency or issuance of the '445 patent or by the charge of infringement. The CAFC held that it is not appropriate to draw an adverse inference from failure to consult counsel. Although there remains "an affirmative duty of due care to avoid infringement of the known patent rights of others," *L.A. Gear Inc. v. Thom McAn Shoe*

Co., 988 F.2d 1117, 1127, 25 U.S.P.Q.2d (BNA) 1913, 1920 (Fed. Cir. 1993), failing to obtain an exculpatory opinion of counsel no longer provides an adverse inference or a presumption that such an opinion would have been unfavorable.

Conclusion C: The district court based its willfulness determination on several factors in addition to the adverse inference gained from Haldex's assertion of attorney-client privilege and Dana's failure to obtain legal advice. However, because elimination of the adverse inference is a material change in the totality of the circumstances, a "fresh weighing of the evidence is required to determine whether the defendants committed willful infringement." The CAFC therefore vacated the willful infringement finding and remanded for a re-determination of the issue.

Conclusion D: Precedent includes the factor of whether there was a substantial defense to infringement with others to be considered among the totality of circumstances. "However, precedent also authorizes the trier of fact to accord each factor the weight warranted by its strength in the particular case." The CAFC viewed this approach [as] preferable to abstracting any factor for per se treatment, for this greater flexibility enables the trier of fact to fit the decision to all of the circumstances.

The CAFC thus declined to adopt a per se rule.

3. PATENT RESTORATION DENIED FOR A MARKETED DRUG WITH MORE THAN ONE ACTIVE INGREDIENT

***Arnold P'ship v. Dudas*, 362 F.3d 1338, 70 U.S.P.Q.2d (BNA) 1311 (Fed. Cir. March 24, 2004)**

Issue: Is a drug whose two main ingredients had been previously approved and marketed individually eligible for patent term extension under 35 U.S.C. sec. 156? **Answer:** No.

Facts: 35 U.S.C. sec. 156 provides for the extension of a patent term for a patented drug which has undergone regulatory approval by the U.S. Food and Drug Administration ("FDA"). One requirement for patent term extension under 35 U.S.C. sec. 156 is that the marketing of the drug must be the "first commercial marketing". The Arnold Partnership ("Arnold") is the owner of U.S. Patent No. 4,587,252 ("the '252 patent") which is commercially embodied as Vicoprofen®. Vicoprofen® is a combination of hydrocodone bitartrate and ibuprofen. Arnold filed a request for patent term extension under 35 U.S.C. sec. 156 with the U.S. Patent and Trademark Office ("USPTO"). The USPTO denied Arnold's request stating that Vicoprofen® did not comply with the "first commercial marketing" clause of 35 U.S.C. sec. 156(a)(5)(A) because both hydrocodone and ibuprofen had been previously marketed either alone or in combination with other drugs. Arnold filed a lawsuit against the USPTO. The district court affirmed the USPTO's decision denying patent term restoration. Arnold appealed.

Argument: Arnold argues that under 35 U.S.C. sec. 156 a drug product must be examined as a whole, not part by part. As a whole, the combination of hydrocodone bitartrate and ibuprofen have never been previously marketed and therefore Vicoprofen® is entitled to patent term extension.

Reasoning: The language of 35 U.S.C. sec. 156 defines a drug product "... as a single entity or in combination with another active ingredient." Thus, the statute places a combination drug product in the same category as a drug product with a single active ingredient. In both such instances, each active ingredient qualifies for examination with respect to the first approved marketing requirement. Therefore, at least one of the active ingredients must be new to the commercial marketplace.

Conclusion: Because both components of Vicoprofen® had been previously marketed, Arnold's application for extension of the '252 patent's term was denied and the district court decision affirmed.

4. PRIORITY APPLICATIONS MUST BOTH DESCRIBE AND ENABLE AN INVENTION

***Chiron Corp. v. Genentech, Inc.*, 363 F.3d 1247, 70 U.S.P.Q.2d (BNA) 1321 (Fed. Cir. Mar. 30, 2004)**

Issue: Can a patent have a priority claim to an earlier-filed application that fails to describe or enable the claimed invention? **Answer:** No.

Facts: Chiron owns U.S. Patent No. 6,054,561 ("the '561 patent"), which claims monoclonal antibodies that bind to human c-erbB-2 antigen (also called HER2), an antigen associated with breast cancer. Chimeric antibodies combine DNA from more than one type of species, and humanized antibodies are antibodies having mostly human DNA. In 1984, the inventors of the '561 patent filed a patent application. The 1984 application disclosed one monoclonal antibody that binds to HER2 without identifying the structure, function or molecular weight of the antigen. In 1985 a continuation-in-part (CIP) application was filed, which disclosed six additional monoclonal antibodies but still did not provide identity, structure or function of the antigen. In 1986 another CIP application was filed, which disclosed an additional six monoclonal antibodies. In 1995 another CIP application was filed, which claimed priority to the applications filed in 1984, 1985 and 1986 and which became the '561 patent. Chiron then sued Genentech over sales of the humanized antibody Herceptin®, which is useful for the treatment of breast cancer. Both parties stipulated that if the '561 patent was not entitled to the priority claim of the 1984, 1985 and 1986 applications, the patent would be invalid due to intervening prior art. After a jury trial, the district court entered judgment in favor of Genentech that all claims of the '561 patent are invalid under 35 U.S.C. sec. 102. The court found that none of the asserted claims is entitled to the priority claim to the earlier filed applications because none of the earlier applications satisfied both the enablement and written description requirements.

Reasoning: The '561 patent cannot claim priority based on the 1984 application because it fails to comply with the written description requirement. Because chimeric antibody technology did not exist at the time of the 1984 filing, Chiron scientists could not have possessed and disclosed this technology in the 1984 filing. In addition, while chimeric antibodies where known by the 1985 filing, the technology was still new and unpredictable. Since the 1985 and 1986 applications provide no disclosure of either how to make and use chimeric antibodies or working examples of chimeric antibodies within the scope of the '561 patent's claims, the applications were not enabled for chimeric antibodies.

Conclusion: Because substantial evidence supported the jury's verdict that the '561 patent cannot claim priority to any of the 1984, 1985 and 1986 applications, the CAFC affirmed the judgment of the district court.

5. ADDITION OF ".COM" TO DESCRIPTIVE TERM DOES NOT TYPICALLY MAKE PROPOSED MARK REGISTRABLE

***In re Oppedahl & Larson LLP*, 373 F.3d 1171, 71 U.S.P.Q.2d (BNA) 1370 (Fed. Cir. June 25, 2004)**

Issue: Is there an absolute prohibition on the use of a top-level domain indicator, such as ".com", to make an otherwise descriptive or generic mark registrable? **Answer:** No.

Facts: In 2001, appellant Oppedahl & Larson LLP filed an intent-to-use application to register the mark "patents.com" and identified the relevant goods as "[c]omputer software for managing a database of records and for tracking the status of the records by means of the Internet." The USPTO refused to register the mark based on a finding that the mark was merely descriptive of the applicant's goods. Specifically, the USPTO found that the term "patents" describes a feature of the goods, and the term ".com" is a top-level domain indicator (TLD) without any trademark significance. The Trademark Trial and Appeal Board ("the Board") affirmed the USPTO's decision citing prior cases in which it held that ".com" has no source-identifying significance and that the addition of a TLD to an otherwise descriptive or generic term did not make the proposed mark registrable. Oppedahl & Larson appealed.

Argument: Appellant challenges the Board's application of a strict rule that allegedly always disregards the use of ".com" and other TLDs in a trademark application. According to the appellant, the USPTO erred by cutting off the TLDs before evaluating the consumer's

impression of the mark. The appellant asserts that the Board should consider a domain designation as part of the mark as a whole.

Reasoning: The CAFC did not read the USPTO's policy to include an absolute prohibition on the possibility that adding a TLD to a descriptive term could operate to create a distinctive mark. In considering the mark as a whole, the Board may weigh the individual components of the mark to determine the overall impression of the descriptiveness of the mark and its various components. The court agreed with the Board's findings that taken individually, "patents" and ".com" are both descriptive of features of the appellant's goods. The court also agreed with the Board's conclusion that the combination of "patents" and ".com" does not render the mark as a whole distinct and registrable, adding that considering the mark as a whole only strengthened the Board's descriptiveness finding.

Conclusion: The court ruled that in this case the mark "patents.com" as a whole was merely descriptive of the appellant's goods and affirmed the decision of the Board.

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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Scott Shea Chisk Corporation	Neal M. Cohen William A. English
Elizabeth Winston	TJ Singh Howard Klein

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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.

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BOARD OF DIRECTORS		TELEPHONE/E-MAIL
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V.P./President Elect	Margaret A. Kivinski	949-757-1999 mkivinski@therox.com
Secretary	John R. King	949-760-0404 jking@kmob.com
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Directors	Greg S. Hollrigel	949-450-1750 gsh@patlawyers.com
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	TJ Singh	(949) 955-1920 tjsingh@koslaw.com
Immediate Past President	Stefan J. Kirchanski	310-500-3500 skirchanski@linerlaw.com

COMMITTEE CHAIRPERSONS

Annual Seminar	Margaret A. Kivinski	949-757-1999 mkivinski@therox.com
	Neal M. Cohen	(949) 724-1849 nmc@cohen-sak.com
Copyright Practice	Darren S. Rimer	(949) 367-1541 darren@rimermath.com
Federal Courts	Robert L. Grabarek, Jr.	(949) 263-8400 rgrabarek@crowell.com
Int'l IP Practice	Alexander R. Schlee	310-545-9851 alexschlee@vjp.de
Law Off. Mgmt.	Gabia Pakstys	650-326-3466 gpakstys@sbcglobal.net
Legislative		**Position Open**
MCLE	T. J. Singh	(949) 955-1920 tjsingh@koslaw.com
Meetings/Programs	Neal M. Cohen	(949) 724-1849 nmc@cohen-sak.com
Newsletter Editor	Greg S. Hollrigel	949-450-1750 gsh@patlawyers.com
Patent Practice	Neal M. Cohen	(949) 724-1849 nmc@cohen-sak.com
Trade Secrets/Unfair		**Position Open**
Competition Law	Perry J. Viscounty	714-755-8288 perry.viscounty@lw.com
Trademark Practice	Susan Natland	949-760-0404 smn@kmob.com
Luncheon Speakers	Matthew F. Weil	949-851-0633 mweil@mwe.com
OCPLA Website	Marlene Klein	949-932-3132 marlene.klein@cda.canon.com
OCPLA Database	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
Tel: 949-450-1750
Fax: 949-450-1764

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

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

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.

IP LEGAL SECRETARY FOR COSTA MESA LAW FIRM:

Paul, Hastings, Janofsky & Walker LLP seeks an IP legal secretary with a minimum of 5 years patent prosecution and litigation experience. Must have excellent written and verbal communication skills. Proficiency in Microsoft Word and general knowledge of PowerPoint and Excel. Please send resumes to marilynradley@paulhastings.com or direct fax to 714 668-6570.

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 or fax to 949.851.9348.

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

Orange County Patent Law Association

November Meeting

Date: Wednesday, November 17, 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: Enjoining the Serial Copyist

Speaker: Paul Stewart, Knobbe, Martens, Olson & Bear, 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, November 17, 2004 for the following person(s):

____

____

____

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

2004 OCPLA Holiday Party

Wednesday, December 15, 2004

Club 33, 33 Royal Street, New Orleans Square, Disneyland

The OCPLA is pleased to invite you and your guest to the 2004 OCPLA Holiday Party. The party will be held on Wednesday, December 15, 2004 at Club 33, Disneyland. On this day of traditional OCPLA holiday frivolity, your holiday party ticket entitles you to dinner and free entry into Disneyland and California Adventure Park. We encourage all to spend the afternoon enjoying the amusement park. At 6:00 p.m., kindly make your way to the New Orleans Square for dinner and the OCPLA "Fez" - tivities. Enter through the door marked "33".

6:00 p.m. –7:00 p.m. No Host Bar & Hors D'oeuvres – *Teriyaki Skewers with Pineapple Jus; Saga Blue on Toasted Muffin with Arugula; and Olive Tepanade Crustini with Dill Cream Cheese*

7:00 p.m. - ? Dinner - *The Club 33 Mizuna House Salad. Choice of Chateaubriand & Contessa Shrimp; Honey Glazed Chicken Breast; or Truffled Risotto Cake. Exotic Pabana Mousse, and complimentary Coffee/Tea and Soft Drinks. Shortly following dinner the OCPLA "Fez" – tivities will begin.*

Cost: $50.00 per person, OCPLA members and guests.

RSVP: Before November 22, 2004. (Limited to first 100 reservations.)

Reservation Form

NAME: ______________________________

GUEST: ______________________________

FIRM/CO: ______________ **TELEPHONE NUMBER:** ______________

ADDRESS: ______________________________

Street City State Zip Code

CHOICE OF ENTRÉE:

Self Guest

☐ ☐ **Chateaubriand & Contessa Shrimp**

☐ ☐ **Honey Glazed Chicken Breast**

☐ ☐ **Truffled Risotto Cake**

PARK ENTRY GUEST LIST:

Self Guest

☐ ☐ **Amusement Park Day Entry and OCPLA Holiday Party at Club 33**

☐ ☐ **Evening Entry for OCPLA Holiday Party at Club 33 Only**

Complete and return with your check payable to OCPLA to Greg S. Hollrigel, Stout, Uxa, Buyan & Mullins, LLP, 4 Venture, Suite 300, Irvine, CA 92618 **by November 22, 2004** - Please e-mail any questions to gsh@patlawyers.com.

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):		**(New Member After 07/01/05)**
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: ____________________

2004/2005 OCPLA EVENTS SCHEDULE

Date	Location	Speaker/Event	Topic
November 17, 2004	Wyndham Garden Hotel	**Paul Stewart** Knobbe, Martens, Olson & Bear, LLP	Enjoining the Serial Copyist
December 15, 2004	Club 33 at Disneyland		OCPLA Annual Holiday Party
January 26, 2005	Wyndham Garden Hotel	**Mimi Justice** and **Jay Jesclard** Deloitte & Touche Financial Advisory Services	Valuing Intellectual Property and IP Damages

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