



OCPLA NEWSLETTER

Orange County Patent Law Association

www.ocpla.org

Vol. 11, No. 11

November 2005

NOVEMBER LUNCHEON MEETING

Please join us at our next luncheon meeting on Wednesday, November 16, 2005, when we are pleased to present **Mimi Justice** of Deloitte & Touche, who will speak on "Calculating and Proving Patent Damages in Litigation". **NOTE: the date is November 16, 2005 (not November 23 as previously advertised).**

The lunch will be held at noon at the Wyndham Garden Hotel.

OCPLA HOLIDAY PARTY

More than half of the spaces available have already been reserved and paid for! If you plan on attending, please get your reservation and payment in ASAP. If you would like a confirmation that your reservation has been received and processed, please email Neal at nmc@cohen-sak.com. This year's OCPLA Holiday Party is at Ralph Brennan's Jazz Kitchen, in Downtown Disney, on Friday December 9, 2005 starting at 6:30 pm. The cost is \$50.00 per person, and includes a four-course meal with choice of entree, two drink tickets, and unlimited hot tea, iced tea, and soda. SPACE IS LIMITED, and tickets will be sold on a first-pay basis, to OCPLA Members and one guest only. The reservation form is included in this OCPLA newsletter. If you have any questions, please contact Neal Cohen at nmc@cohen-sak.com.

OCPLA 2006 SPRING SEMINAR

SAVE THE DATE. OCPLA's annual Spring Seminar will be held this spring from March 24-26, 2006, at the La Costa Resort & Spa in Carlsbad, California.

NOVEMBER BOARD MEETING

On November 9, 2005 the OCPLA Board of Directors is holding its monthly meeting at noon at Birch Stewart Kolasch & Birch LLP, in Costa Mesa. Members who wish to present items for the Board's consideration should contact our president, Margaret Kivinski, to have their item placed on the agenda, and to verify the time and location of the meeting.

NEW MEMBERS

Please encourage your colleagues to renew their OCPLA membership or to join as new members!

MESSAGE FROM THE PRESIDENT

BY MARGARET KIVINSKI
THEROX, INC.
mkivinski@therox.com



I'm certain that, like me, you found our October meeting worthwhile. The Patent Claims Drafting Workshop presented by John King was informative, thought-provoking and entertaining. The interactive presentation took us in detail through several real-world claims in interesting, and sometimes funny, issued patents and helped us identify potential pitfalls and important drafting techniques. Thank you, John, for sharing your wisdom and skill with our members, and for making it fun at the same time.

I am pleased to report that our organization's officers and directors for 2006 were elected at the October meeting, which served as our annual membership meeting. The President, elected last year, will be John King. The remaining positions will be: President-Elect - Len Svensson; Secretary - Greg Hollrigel; Treasurer - Neal Cohen; Third Year Director -

TJ Singh; Second Year Director – Marlene Klein; and the First Year Director (the newest member of the board) – Tom Dao. Congratulations to the board members on their election, and to us all, for getting such an active and dedicated board. With this leadership, membership in the OCPLA in 2006 will be as rewarding as ever.

Special thanks go out to Stefan Kirchanski for his planning, coordination, and execution of the 2-day PCT Seminar held in October at Whittier Law School. Members and sponsored guests were updated on procedures and practices under the Patent Cooperation Treaty by speakers from the World Intellectual Property Organization. By all accounts the program was a huge success and another worthwhile OCPLA event.

In November, we are fortunate to have the return of Mimi Justice of Deloitte & Touche to discuss calculating and proving damages in patent infringement litigation. As you may recall, Mimi came to our January meeting prepared to make her presentation, but there was insufficient time at that meeting for her to give her talk. We welcome Mimi back and look forward to hearing her presentation. Please note the meeting will be on November 16th, and not the usual fourth Wednesday of the month, to avoid potential conflicts during Thanksgiving week.

The final event of the year will be the annual Holiday Party. This year is going to be an enjoyable evening at Ralph Brennan's Jazz Kitchen located in Downtown Disney. Come celebrate the season with your fellow members and witness the traditional "passing of the fez" to the incoming President, John King.

I hope to see you at all the remaining events this year.

RSVP ON TIME FOR MONTHLY LUNCHES

To reduce the likelihood of additional rate increases associated with last minute reservations, please 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 is greatly appreciated by the hotel and the OCPLA Board.

The costs for the monthly luncheon meetings for student members is \$15.

2005 MEMBERSHIP RENEWAL

Dues for 2005 are \$35 for attorneys and agents. Members receive the monthly OCPLA newsletter, and reduced rates for the monthly luncheons and seminars. A membership form is included in this month's newsletter and is also available at www.ocpla.org. Please renew early to reduce delays in processing.

OCPLA WEBSITE

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

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 Neal Cohen at nmc@cohen-sak.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.

MINUTIAE

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

**How To Prevent A U.S. Patent Application From Being Published**

Generally, U.S. patent applications are published 18 months from their priority date. 35 U.S.C. § 122. But publication can be prevented by filing a request for non-publication at the time of filing the application, subject to certain requirements. Further, provisional applications, design patent applications, and applications subject to secrecy orders (of course) are not published. Another category of applications that are not published are applications “no longer pending”.

So presume you file a U.S. non-provisional utility application without simultaneously filing the request for non-publication, and then later decide (or more likely, your client decides) that the application should still be examined but it should not be published? What can you do? Well, assuming the application is not subject to a secrecy order, it seems that the only hope is to force the application into the “no longer pending” category. Indeed, the PTO anticipated this situation, and has it covered in 37 CFR 1.138(c). The PTO requires the applicant to expressly abandon the application (and of course pay a petition fee). However, the PTO also states (directly in the CFR) that the applicant should not expect the petition to be granted if the petition is filed less than four weeks before projected publication. Interestingly, the PTO does not guarantee the petition *will* be granted if it is filed before that time. So it might be a good idea to monitor the petition very closely, and also a good idea to file a continuation application along with a request for non-publication when filing the Rule 138(c) petition.

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).

OTHER ARTICLES

BY YOU
YOUR FIRM
YOUR E-MAIL

**YOUR
PHOTO?**

Do you have an article you'd like published in next month's OCPLA Newsletter? If so, please submit it to the OCPLA Newsletter editor, Neal Cohen, for review, at nmc@cohen-sak.com. All submissions become the property of OCPLA and may be published without compensation.

BOARD OF DIRECTORS AND COMMITTEE CHAIRS

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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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949-756-5000 x218

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Contact: Michael Shimokaji

mshimokaji@shimokaji.com.

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POSITION AVAILABLE

Law firm in Irvine seeks chemical/biotechnology associate (attorney or agent) with about two or more years patent application preparation/prosecution experience. Growth opportunity with competitive salary and benefit package. Send resume to: jmcghee@patlawyers.com

Ad: xaft1144053

PATENT ATTORNEY

Henkel Corporation is seeking an experienced solo practitioner or retired patent attorney to provide part time on-site support to its West Coast businesses located in Irvine and Baypoint, California. Responsibilities would include patent application preparation and prosecution, as well as patent clearances, patent licensing, and IP counseling. Additionally, the attorney may provide general legal support to these business units, particularly on transactional and contract matters, and act as a liaison for Henkel's in-house counsel located on the East Coast. At present, it is expected that the attorney's workload would average about 10-15 hours per week. The ideal candidate will have a strong technical background (organic & inorganic chemistry/polymer science/material science). Please contact Stephen D. Harper, Chief Patent Counsel, Henkel Corporation, The Triad, Suite 200, 2200 Renaissance Blvd, Gulph Mills, PA 19406

Phone: 610-278-4927

E-Mail: stephen.harper@us.henkel.com.

Ad: xaft1105MK1

ATTORNEY OR AGENT

If you are interested in doing occasional overflow work on a project basis, please contact us at:

GDW4IPLAW@AOL.com

Ad: xaft120205

Patent Attorneys: Big Firm Clients in a Small Firm Environment

Klein, O'Neill & Singh, LLP, a growing Southern California IP firm is seeking experienced patent prosecutors who enjoy working with major corporate clients, but would prefer a small firm environment with more reasonable billable hour requirements. At least 1 year of patent prosecution experience with a top-line law firm or corporate patent department, preferably in the electrical and/or computer arts, with some experience in the mechanical arts. Competitive salaries and benefits, with flexible working arrangements, collegial relationship with other attorneys and staff, and a potential fast track to partnership. Send resume to info@koslaw.com or fax it to 949-955-1921. No phone calls

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**POSITIONS AVAILABLE
PATENT ATTORNEYS**

Stetina Brunda Garred & Brucker, P.C., a growing intellectual property law office located in Aliso Viejo, CA, has immediate openings for patent attorneys having 1-5 years of experience. Qualified candidates will have significant experience in either patent prosecution and/or intellectual property litigation, with a preferred engineering degree in the mechanical or electrical arts.

Please send employment inquires to:

Stetina Brunda Garred & Brucker, P.C.
Recruiting Attorney
75 Enterprise, Suite 250
Aliso Viejo, CA 92656

or email at recruiting@stetinalaw.com

Please visit us at www.stetinalaw.com

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Member: IPR Professional Associations: U.S.A.,
U.K., Germany, Japan, France, Italy, et. al.

Contact Person: Mr. Hiral Chandrakant Joshi

Areas of

- Patent & Trademark Search
- Patent & Trademark Watch
- Registration, post registration
- Infringement, etc.
- Translation of Patent Specification
- Franchise & Joint Venture Agreements
- Cyberlaw, Mergers & Acquisitions

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PATENT ATTORNEY/AGENT POSITION

MacPherson Kwok Chen & Heid LLP seeks a patent prosecution attorney/agent for its Irvine Office. The ideal candidate has an Electrical Engineering, Computer Science, or Physics degree with some engineering and patent prosecution experience. For more information about our firm, visit our website at www.macpherson-kwok.com. Please provide resume to Greg Michelson at gmichelson@macpherson-kwok.com.

Ad: xaft012206S2



SAVE THE DATE FOR THE UPCOMING

OCPLA-SDIPLA SPRING SEMINAR

24 – 26 MARCH 2006

Location: The La Costa Resort and Spa in Carlsbad, San Diego

Legal Program: Saturday and Sunday mornings, including the annual patent law, trademark law and copyright law reviews.

Social Program: Friday evening reception
Saturday evening banquet
Saturday afternoon golf, tennis, spa, etc.

More details will surely follow.

Orange County Patent Law Association

November Meeting

Date: Wednesday, November 16, 2005

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: Calculating and Proving Patent Damages in Litigation

Speaker(s): **Mimi Justice** of Deloitte & Touche

Cost: \$30 for members, \$15 for students (proof of student status required), and \$35 for non-members

Reservations: Please make reservations by filling out the form below and mailing it with a check to T.J. Singh to reach his office address given below, by the Friday before the meeting. If time is short, please also email T.J. at tjsingh@koslaw.com or call in your reservation to the OCPLA Reservations Line number at (949) 955-1920.

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 16, 2005 for the following person(s):

This form and check should be mailed to:

T.J. Singh
Attention: OCPLA Lunch Reservations
Klein, O'neill & Singh, LLP
2 Park Plaza, Suite 510
Irvine, CA 92614
Tel: (949) 955-1920
Fax: (949) 955-1921
E-mail: tjsingh@koslaw.com



Orange County Patent Law Association

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

2005 OCPLA 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):

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

OCPLA Holiday Dinner at Ralph Brennan's Jazz Kitchen

-Downtown Disney, Anaheim-

Friday, December 9, 2005

6:30 p.m. – Drinks and hors d'ouvres

8:00 – Dinner & Program

\$50 per person

Reserve your spot(s) by returning this form with check payable to OCPLA to:

Neal M. Cohen
Cohen Sakaguchi & English LLP
2040 Main Street, 9th Floor
Irvine, California 92614

Member Name: _____ Phone #: _____ Entrée No.: _____
Guest Name (1 guest maximum): _____ Entrée No.: _____

Menu

Hand Passed Hors d'ouvres

Spicy Parmesan Cheese Straws

Zydeco Grilled Chicken Skewers with Cilantro Bordelaise

Boiled Spicy Shrimp with Remoulade Sauce

Appetizer

Onion Soup (with entrée selections 1-4 below)

Stuffed Tomato (with entrée selection 5 below)

Salad

French Quarter salad

Choice of Entrée (**non-changeable**)

Please choose from the following entrées and indicate your number choice above:

- 1) Roasted Chicken Rosemary
- 2) Jazz Kitchen Grilled Fish (Chef's selection)
- 3) Filet Mignon
- 4) Pasta Jambalaya
- 5) Vegetarian Linguini (vegetarian selection)

Dessert

Beignets – A New Orleans Classic! French donuts deep fried and topped with powdered sugar

** Price also includes coffee, hot tea, iced tea, soda, and two drink tickets **

Complementary self-parking is available for up to 5 hours with validation.
Please call Neal at (949) 724-1849 if you have any questions.

2005 OCPLA EVENTS SCHEDULE

Date	Location	Speaker/Event	Topic
November 16, 2005	Wyndham Garden Hotel	Mimi Justice Deloitte & Touche	Calculating and Proving Patent Damages in Litigation
December 9, 2005	Ralph Brennan's Jazz Kitchen (Downtown Disney)	OCPLA Holiday Party	Fun



Orange County Patent Law Association
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