



OCPLA NEWSLETTER

Orange County Patent Law Association

www.ocpla.org

Vol. 11, No. 12

December 2005

DECEMBER LUNCHEON

There was no December luncheon. The monthly luncheons will resume in January 2006, and the topic will be certified for 1 hour of MCLE credit for **Elimination of Bias**.

CHANGING OF THE GUARD

The newly-elected OCPLA directors will begin their terms in January 2006. Note that the new second-year director will be Marlene Klein, and therefore all lunch reservations should be sent to her attention. The reservation form will be updated accordingly.

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.

DECEMBER BOARD MEETING

There will be no December Board meeting. The January Board meeting will be held January 11, 2005 at noon at Therox, in Irvine. Members who wish to present items for the Board's consideration should contact our president-elect, John King, to have their item placed on the agenda, and to verify the time and location of the meeting.

NEW MEMBERS

We are pleased to welcome the following new members to the ranks of the OCPLA.

Karen Lenker

Knobbe Martens Olson & Bear

Friederike Woltereck

Knobbe Martens Olson & Bear

Ashley Schneider

Knobbe Martens Olson & Bear

Adam Gilbert

Knobbe Martens Olson & Bear

Jennifer Pascua

Knobbe Martens Olson & Bear

Michael Hall

Knobbe Martens Olson & Bear

Steven P. Ruden

Knobbe Martens Olson & Bear

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



In November, we were fortunate to have Mimi Justice return and speak to us on Calculating and Proving Patent Infringement Damages. Her presentation was truly deserving of the full hour devoted to this important topic. The discussion that ensued demonstrates the interest and, to some extent, controversy, that surrounds this area for many of us in our respective practices.

It was wonderful celebrating with all of you who attended our annual Holiday Party in December. Thanks very much to Neal Cohen for planning and executing the enjoyable evening at Ralph Brennan's Jazz Kitchen in Downtown Disney. John King was duly installed as the President for 2006, as were the rest of the officers and directors for the coming year. The fez, newly adorned with a jeweled crown to represent our new President, was passed from me to John in the traditional

OCPLA fashion. If you've never seen the fez, be sure to attend next year's Holiday Party, or ask John for a preview. It really is a sight to be seen.

In January we will have the pleasure of hearing from a talented speaker on the topic of Discrimination: "I Know It When I See It." This talk will satisfy the special CLE credit for Elimination of Bias in the Legal Profession. Although not directly related to intellectual property substantive law, I'm certain you'll appreciate the opportunity to obtain this often hard-to-get required credit, especially if you have a compliance deadline of February 1, 2006 (last names starting with H-M) and are still in need of this credit. The speaker is Diane F. Wyzga, R.N., J.D., of Lightning Rod Communications. I'm sure you'll enjoy both her professional story-telling and interactive approach to this mandatory topic.

And with the planning of the January lunch meeting, I am officially relieved of my duties as President for 2005. Thank you all for a great year. It was an honor and gratifying experience being your President for 2005. I hope you enjoyed the programs and benefits of membership and that you will continue to do the same in 2006 and beyond. I feel confident I am leaving you all in good hands and look forward to any opportunity to serve this fine organization in the future.

I wish all of you a successful 2006.

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.

2006 MEMBERSHIP RENEWAL

Dues for 2006 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

**POSTAGE INCREASE**

This month, I decided not to concentrate too hard on Minutiae (no funny comments please). But still, this Minutiae is IMPORTANT. All I want to say is MAKE SURE YOU ARE AWARE OF THE POSTAGE INCREASE THAT GOES INTO EFFECT JANUARY 8, 2006. I thought it was appropriate to remind everyone here, considering the USPS sure has decided not to make the information easily available on its website www.usps.gov. (Maybe they're waiting until after the Holidays...) Most relevant to us patent folk are the following increases:

Postcards go up 0.01 to 0.24

First Class 1 ounce goes up 0.02 to 0.39

First Class 2 ounces goes up 0.03 to 0.63

Express Mail Flat Rate goes up 0.75 to 14.40.

HAPPY HOLIDAYS.

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. Claim Language Specifying "First" and "Second" Elements Does Not Define Chronological Positioning of Such Elements

Free Motion Fitness, Inc. v. Cybex Int'l, Inc., No. 05-1006 (Fed. Cir. Sept. 16, 2005)

Issue: Does claim language that describes an apparatus element as having a "first" point and a "second" point define chronological, spatial locations of such "first" and "second" points?

Answer: No.

Facts: Plaintiff-Appellant Free Motion Fitness, Inc. ("FMF"), manufactures exercise machines and owns U.S. Patents Nos. 6,238,323 ("the '323 patent") and 6,458,061 ("the '061 patent"), directed to an exercise apparatus comprising: a resistance assembly; two adjustable extension arms that pivot at two pivot points adjacent the resistance assembly, on an axis substantially parallel to the axis of rotation of a pulley at the end of each arm; and a cable linking the resistance assembly to the adjustable extension arms. Defendants-Appellees manufacture exercise machines that contain arms attached to a resistance assembly, such that the arms pivot at four possible pivot points (two on each side of the resistance assembly) in two different planes (one of the planes being transverse to axis of rotation of a pulley at the end of the arms). In an infringement action brought by FMF, the United States District Court for the District of Utah found that the Defendants-Appellees did not infringe the '323 patent or the '061 patent, concluding that the "first pivot point" claim limitation was not met by the accused devices. In reaching this conclusion, the district court construed the "first pivot point" and the "second pivot point" claim language to mean that such pivot points are chronologically, spatially arranged.

Reasoning/Conclusion: The CAFC disagreed with the district court's interpretation of the "first pivot point" and "second pivot point" claim language, concluding that "first" and "second" do not denote spatial locations, and instead are consistent with common convention used in patent claims to distinguish between repeated instances of an element or limitation, relying on *3M Innovative Prods. Co. v. Avery Dennison Corp.*, 350 F.3d 1365, 1371 (Fed. Cir. 2003). Thus, the term "first" merely associates the first pivot point with the first extension arm and the term "second" merely associates the second pivot point with the second extension arm. The CAFC vacated the judgment of the district court and remanded the case for a determination of literal infringement and infringement under

the doctrine of equivalents under the correct claim construction.

2. Foreign-Made Copies of U.S. Software Deemed "Supplied" from US Under Section 271(f)

AT&T Corp. v. Microsoft Corp., No. 04-1285 (Fed. Cir. July 13, 2005)

Issue: Is software replicated in another country from a master version exported from the United States "supplied" from the United States and therefore infringement under 35 U.S.C. sec. 271(f)?

Answer: Yes.

Facts: Microsoft supplies master versions of its Windows Operating System to foreign computer manufacturers and authorizes foreign "replicators" to make copies of the master for installation on foreign computers. The master versions are created in the United States and sent abroad via disks and electronic transmissions. These master versions incorporate digital speech analysis functions that infringe an AT&T patent when installed on a computer. AT&T sued Microsoft under 35 U.S.C. sec. 271(f), which makes actionable the supply, from the United States, of a component of a patented invention in a manner that actively induces infringement abroad. The district court ruled that copies made abroad were "supplied" from the United States "in light of the statute's purpose of prohibiting the circumvention of infringement through exportation."

Argument: Microsoft argued that a foreign-replicated copy of software has actually been manufactured abroad by the process of "encoding a storage medium" with the software, i.e., not "supplied" from the United States. Microsoft further argued that a master version only contains instructions for creating a component of the allegedly infringing product, and therefore does not constitute an exported "component" under sec. 271(f). Lastly, Microsoft suggested that electronic transmissions abroad and the shipment of a master version abroad should be treated differently under sec. 271(f).

Reasoning: Recognizing that the statute does not define the term "supplied," the court considered the manner in which software is typically supplied; concluding that supplying software usually involves generating a copy of the software. In other words, copying is "part and parcel of software distribution." Consequently, liability can arise when a copy is made abroad from software exported from the United States with the intent of replication.

The court flatly rejected Microsoft's assertion that a master version merely consisted of instructions for creating a component of the allegedly infringing product, reasoning that: "what is being supplied abroad is an actual component, i.e., the Windows operating system." It suggested that instructions for creating the component would teach how to design and code the software, not just how to copy it.

The court concluded by rejecting Microsoft's argument that electronic and physical transmissions should be treated differently, stating that "[l]iability ... does not depend on the medium used for exportation." Citing precedent, the court noted that liability is not limited to "structural or physical" components. Therefore, it is not the "mode of exportation" that triggers sec. 271(f) liability, but the "fact of exportation."

Conclusion: Rejecting all of Microsoft's arguments, the court affirmed the judgment of the district court holding Microsoft liable under sec. 271(f).

**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

BOARD OF DIRECTORS TELEPHONE/E-MAIL

President	Margaret A. Kivinski	949-757-1999 mkivinski@therox.com
V.P./President Elect	John R. King	949-760-0404 jking@kmob.com
Secretary	Leonard R. Svensson	714-708-8555 lrs@bskb.com
C.F.O./Treasurer	Greg S. Hollrigel	949-450-1750 gsh@patlawyers.com
Directors	Neal M. Cohen	(949) 724-1849 nmc@cohen-sak.com
	TJ Singh	(949) 955-1920 tjsingh@koslaw.com
	Marlene Klein	949-932-3132 marlene.klein@cda.canon.com
Immediate Past President	Matthew F. Weil	949-851-0633 mweil@mwe.com

COMMITTEE CHAIRPERSONS

Annual Seminar	John R. King	949-760-0404 jking@kmob.com
	T.J. Singh	(949) 955-1920 tjsingh@koslaw.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	Marlene Klein	949-932-3132 marlene.klein@cda.canon.com
Meetings/Programs	T.J. Singh	949-955-1920 tjsingh@koslaw.com
Newsletter Editor	Neal M. Cohen	(949) 724-1849 nmc@cohen-sak.com
Patent Practice	Tom Dao	(949) 476-0757 tom.dao@cph.com
Trade Secrets/Unfair	Scott Feldmann	(949) 263-8400 rfeldmann@crowell.com
Competition Law	Perry J. Viscounty	714-755-8288 perry.viscounty@lw.com
Trademark Practice	Susan Natland	949-760-0404 smn@kmob.com
Luncheon Speakers	Margaret Kivinski	949-757-1999 mkivinski@therox.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

The OCPLA Newsletter is a copyrighted publication that is normally published shortly before each OCPLA General Meeting. Copyright © 2004 The Orange County Patent Law Association. All rights reserved. Printed in the United States of America. Reproduction of this newsletter is authorized if the source, author and copyright notice information are provided on all reproductions.

This document is provided for informational purposes only. The articles contributed by identified authors express only the views of the particular author or authors, and do not necessarily reflect the opinions of the Orange County Patent Law Association or its editorial staff. Any questions or comments concerning the articles should be directed to the author. Any errors should be brought to the attention of the Editor so that appropriate corrections can be published in a subsequent edition of the Newsletter.

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
Neal M. Cohen
 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

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.

Straddling, Yocca, Carlson & Rauth
Corporate and Tax Matters
(949) 725-4000

OFFICE AVAILABLE

Sublease 9' by 14' window office in intellectual property law suite, \$500/mo. Join a patent attorney, patent agent and a transaction attorney. Phone, fax, DSL, high speed copier/printer/FAX, postage meter. JW airport area, free parking, close to 405, 55 and 73 freeways. Call: 714/ 668-1900

Ad: xaft1205P4

OFFICE SPACE AVAILABLE

New class A construction in Irvine Spectrum available for sublease. 3 offices, open secretarial space, kitchen, copier room, and shared conference room. Free surface parking. Your own first floor entrance.

Contact: Michael Shimokaji

mshimokaji@shimokaji.com.

Ad: xaft1205SK4

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

Paul Hastings Attorneys

Grow Your Intellectual Property Career at Paul Hastings

Paul, Hastings, Janofsky & Walker LLP has a full-service intellectual property practice dedicated to serving leading information technology and life sciences companies all over the world. From Shanghai to Southern California, Palo Alto to Paris, our fast-growing practice includes more than 80 full time IP attorneys, many with advanced degrees in physics, mechanical engineering, electrical engineering, chemical engineering, biology, biochemistry, molecular biology and chemistry. We combine in-depth technical expertise and sophisticated legal talent to provide our clients with the best possible representation.

Paul Hastings currently has openings Los Angeles, Palo Alto and San Diego for motivated intellectual property attorneys with 2 to 5 years of patent litigation and/or patent prosecution experience in the following areas:

- Electrical Engineering
- Computer Engineering
- Computer Science
- Physics

Excellent academic credentials and writing skills required; technical degrees are preferred (but not required).

Please submit resumes and transcripts to:

Lisa Patterson

Attorney Recruiting & Development Coordinator
PAUL, HASTINGS, JANOFSKY & WALKER LLP

3579 Valley Centre Drive

San Diego, CA 92130

lisapatterson@paulhastings.com

Please specify the location(s) you are interested in.

Ad: xzft0606K4

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

Ad: xzft1205K3

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

Ad: xaft0606K2

CHANDRAKANT M. JOSHI

INDIAN PATENT & TRADEMARK ATTORNEYS
5th & 6th Floor, Vishwananak, Chakala Road,
Andheri (East), Mumbai – 400 099, **INDIA**

Phones: +91-22-28380848, 28205425, 28324920

Telefax: +91-22-28380737, 28066294, 28389839

Emails:

cmjoshi@bom3.vsnl.net.in
chandrakantmjoshi@vsnl.net
chandrakantjoshi@vsnl.net

Website:

www.cmjoshi.us

Languages: English, French, German & Italian

Other Offices: New Delhi, Kolkata, Ahmedabad,
Hyderabad & Chennai

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

Ad: xzft0806D3

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

Date: Wednesday, January 25, 2006

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: Discrimination: "I Know It When I See It."

Speakers: **Diane F. Wyzga, R.N., J.D.**, Lightning Rod Communications

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 Marlene Klein to reach her office address given below, by the Friday before the meeting. If time is short, please also email Marlene at Marlene.Klein@cda.canon.com or call in your reservation to her at (949) - 932-3132.

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

[NOTE NEW MAILING ADDRESS BEGINNING JANUARY 1, 2006]

Enclosed is a check for \$_____ payable to ORANGE COUNTY PATENT LAW ASSOCIATION for the OCPLA General Membership luncheon on Wednesday, January 25, 2006 for the following person(s):

This form and check should be mailed to:

Marlene Klein
Attention: OCPLA Lunch Reservations
Canon USA
IP Dept
15975 Alton Pkwy
Irvine, CA 92618-3731
Tel: (949) -932-3132
E-mail: Marlene.Klein@cda.canon.com



Orange County Patent Law Association

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

2006 OCPLA MEMBERSHIP APPLICATION/RENEWAL FORM

This is an application for (please check one):

- Membership Renewal
 New Membership

Member / Applicant Information:

Name: _____

Firm/Employer: _____

Address: _____

E-mail Address (required to receive newsletter): _____

Telephone No.: _____ Facsimile No.: _____

Professional Information:

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

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

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

Dues Membership Year 2006 (please circle one):

Regular Membership (attorneys, agents):	\$35.00	(New Member After 08/01/06) \$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

2006 OCPLA EVENTS SCHEDULE

Date	Location	Speaker/Event	Topic
January 25, 2006	Wyndham Garden Hotel	Diane F. Wyzga, R.N., J.D. , Lightning Rod Communications	Discrimination: "I Know It When I See It."



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