



OCPLA NEWSLETTER

Orange County Patent Law Association

www.ocpla.org

August 2009

THURSDAY, AUGUST 20, 2009 MIXER

This month OCPLA is hosting a Networking Mixer on August 20th from 6-8 p.m. at "Sage on the Coast," in lieu of our monthly luncheon. The restaurant is located at Crystal Cove Promenade, 7862 East Coast Hwy., Newport Beach, California 92657 (Tel: 949.715.7243).

There is no charge for this event and no registration through the OCPLA website is required.

We will return to our regular schedule and location to host our next luncheon on September 17.

AUGUST BOARD MEETING

The August OCPLA board meeting is tentatively scheduled to be conducted via teleconference on August 31, 2009 at 2:00 PM. Members who wish to present items for the Board's consideration should contact our president, TJ Singh, at tjsingh@koslaw.com to have their items placed on the agenda, and to verify the time/date of the meeting.

2009 OCPLA MEMBERSHIP RENEWAL

Membership for 2009 is now available online only. Payment must be made at the time of registration using a credit card or a PayPal account. Go to www.ocpla.org and use the "Membership App" link on the left column. If you have any questions regarding 2009 membership applications or renewals, please contact Tom Dao at tdao@koslaw.com.

NEW MEMBERS

We welcome our newest members to OCPLA:

Nicholas Cairns – Combinix, Inc.
Debra Condino – Allergan, Inc.

INTERNET SIGHTINGS

BY JIM HAWES

This column highlights some of the more notable recent internet notices, newsletters and blogs dealing with IP prosecution issues. It is a distillation by the editor of the submitted IS column. The full IS column with compilations of some of the sources, such as Hal Wegner's newsletter, is now up and available at www.internetsightings.com. Check it out.

Hal Wegner's newsletter – a lot of great stuff – Contact: hwegner@foley.com

- The 7/1/09 post discusses the international exhaustion of patent rights – does the sale abroad of a US patented product prevent enforcement of the patent if the sold product is imported into the US?
- The 7/6/09 newsletter reports that the *Tafas* CAFC decision will be reheard en banc.
- The 7/8/09 email presents Hal's Top Ten list of cases on appeal. See also the newsletter for 7/28.
- The 7/9/09 offering clearly shows how dysfunctional *inter parte* reexams are, one of Hal's favorite subjects – see also Pat-O for 7/8. Of the 3 decisions handed down 7/8 the first two were vacated due to BPAI errors. The third stated a new ground of rejection and was

- remanded to the examiner some 65 months after reexam began. So much for special dispatch. See also Hal's email of 7/20.
- Another 7/9/09 email gives a concrete example of the mess patent law is now in. It cites two recent CAFC decisions – *Net Money* and *Catlin* – and the MPEP for their almost opposite treatments of computer means claims. Don't read this posting sober. See also Hal's 7/27 post.
 - The 7/10/09 post discusses claiming multiple priorities in a European pharmaceutical patent application.
 - Another 7/10/09 email reports a CAFC reexam decision in PODNERS 9 years after filing the case in which an obviousness rejection was affirmed on a *sua sponte* ground. And to think that in Japan it takes about 7 months from start to finish for a reexam.
 - The 7/13/09 newsletter reports Quinn's ranking of patent law blogs – also see Pat-O for 7/11 – and discusses some of them.
 - The 7/17/09 email discusses the *Courtney* BPAI decision basing a claim term construction on a dictionary definition given 4 years after the application was filed; can this be proper?
 - The 7/20/09 post reports that the PTO will not be collecting the patent attorney registration fee due 9/30/09. But see the 7/21 post.
 - The 7/27/09 post presents more about priority claims, and states that *Tafas* will be reargued on 10/7/09, but a second post on the same day states that the DOJ has asked that argument be deferred. An AIPLA post states that the deferral requested is until 60 days after Kappos is confirmed as the new Director of the PTO.
 - The 7/29/09 newsletter discusses the PTO's recently reported *inter partes* reexamination statistics.
 - Another 7/29/09 post discusses the cert petition in *Apotex* raising the question: if X is asserted to be obvious to try, will a showing that the outcome is not predictable rebut the assertion of obviousness? Let's hope so.
 - The 7/31/09 email concerns the *McNeil-PPC* decision of the CAFC holding that the "decision date" is the date the decision is first publically disseminated, **not** the date printed on the opinion.
- Patently-O** – a blog written by Dennis Crouch – www.patentlyo.com.
- The 7/3/09 blog posts an article discussing the flawed nature of the false marking statute.
 - The 7/8/09 email reports that for *inter parte* reexams filed during the '01-'05 period about half have now been concluded (only one by a BPAI decision) and took an average of 37.5 months.
 - The 7/9/09 post reports for those who love data that the average number of inventors per US patent has gone from 1.6 in 1970 to 2.5 in 2000.
 - Another 7/9/09 blog (you won't believe this) reports that the Pope (yes, the head of the Catholic Church) in his 6/29 encyclical letter is against strong patent rights.
 - The 7/11/09 email reports the ranking of the top patent law blogs in a survey conducted by Gene Quinn.
 - The 7/13/09 post states that the average length of non-final OAs has increased from 7.5 pp in '03 to 10.7 pp in '09, and wonders why. Any thoughts?
 - The 7/21/09 blog presents interesting data about the effectiveness of interviewing the examiner.
 - The 7/23/09 email includes 3 topics: (1) inventorship and scientific certainty, (2) claim construction, and (3) a PTO re-examination overview.
- IP Watchdog** – a blog of Gene Quinn: <http://IPwatchdog.com>
- The 7/13/09 blog includes links to two interesting topics – examiner interviews favor face-to-face and how to patent software post-*Bilski*.

- The 7/14/09 email gives seven good ideas for reducing foreign filing costs.
- The 7/21/09 blog discusses in detail the budget problems facing the PTO.
- The 7/22/09 post reports that **patent examiners are being told to find ways to allow applications.** Interesting, to say the least.

AIPLA Direct – a newsletter issued from time to time

[http://www.aipla.org/Content/ContentGroups/About AIPLA1/AIPLA Reports/AIPLA Reports_TOC.htm](http://www.aipla.org/Content/ContentGroups/About%20AIPLA1/AIPLA%20Reports/AIPLA%20Reports_TOC.htm)

- The 7/7/09 newsletter reports that the TTAB now offers an Accelerated Case Resolution (ACR) procedure to allow parties to promptly reach a stipulated resolution.
- A notice in the 7/23/09 Pat-O attaches a copy of a paper appearing in the AIPLA Quarterly Journal, v.37, n.3, about the unreasonableness of the “broadest reasonable interpretation” standard applied to claims during examination.
- The 7/24/09 Direct reminds us that Copyright Office fees go up on 8/1/09.

Other Stuff –

- The article, “Are we moving towards a global patent?” by Michael Austin (a UK patent atty.), is a general answer to the question; it appeared in ptemag.com on 7/1/09.
- Facebook is denying use by others of trademarks registered with it – see Linex Legal for 7/3/09 – and suggests that all register their marks with it.
- Matthew Smith’s book *Inter Partes Reexamination* is available online for free. Can’t get a better deal than that.

For more information about any of the patent topics mentioned consult *Patent Application Practice* published by West and updated twice a year. If you would like Internet Sightings emailed to you each month, email onejehawes@gmail.com.

RECENT IP CASES

BY IRFAN LATEEF
KNOBBE, MARTENS, OLSON & BEAR

♦ In *Tafas v. Doll*, No. 2008-1352, the Federal Circuit vacated its previous panel opinion and granted a petition for rehearing en banc of the USPTO’s appeal of the district court’s grant of summary judgment invalidating new rules that restrict continuations, requests for continued examination (RCEs), and the number of claims in patent applications.

A pharmaceutical company and an individual challenged the new rules as exceeding the scope of the USPTO’s rulemaking authority. The district court granted summary judgment in favor of the challengers. The USPTO appealed, and in a March 20, 2009 panel opinion, the district court’s judgment was vacated with respect to the rules limiting RCEs and the number of claims. The Federal Circuit’s present order reinstates the appeal for hearing en banc and allows for additional briefing of the issues.

♦ In *Gemtron, Corp. v. Saint-Gobain Corp.*, No. 2009-1001, the Federal Circuit affirmed the district court’s claim construction and grant of summary judgment of infringement for certain accused device models.

The Plaintiff accused the Defendant of infringing two patents directed to a refrigerator shelf in which a glass piece is snap-secured into a plastic frame. The only disputed limitation required the device to include “a relatively resilient end edge portion which temporarily deflects and subsequently rebounds to snap-secure one of said glass piece” The Defendant argued for a claim construction requiring resiliency in the finished product. The Plaintiff showed

that the accused device was resilient when still warm from manufacture, when the glass was snap-secured into place. The Federal Circuit noted that all mentions of “relatively resilient” in the specification were in the context of facilitating assembly and affirmed the district court’s rejection of Defendant’s proposed construction.

The Federal Circuit further affirmed the district court’s grant of summary judgment of infringement for certain accused models. The Defendant provided no evidence showing that the models were not “relatively resilient” at the time of manufacture. The Defendant had only produced evidence showing that the models were not resilient when cooled. Because there was no dispute that the accused models could deflect and rebound while at manufacturing temperatures, summary judgment was appropriate.

♦ In *University of Pittsburgh of the Commonwealth System of Higher Education v. Hedrick*, No. 2008-1468, the Federal Circuit affirmed the lower court’s finding that the Appellant researchers were not co-inventors of a particular U.S. patent.

Katz and Llull at Pittsburgh studied adipose (fat) tissue and discovered that stem cells could be isolated from cells derived from fat tissue in 1997. Researcher Hedrick joined Katz’s laboratory for a fellowship in July 1997 and returned to UCLA in late 1999. In March 2000, Pittsburgh filed an international patent application, identifying Hedrick and other UCLA-based researchers as inventors with Katz and Llull. The international patent application later issued as a U.S. patent. On October 29, 2004, Pittsburgh filed this action seeking removal of Hedrick and the other UCLA-based researchers as inventors on the patent.

The disputed claims contained the term “adipose-derived stem cell.” To bolster their claim of inventorship, the Hedrick and the UCLA-based researchers argued that the term should be construed to mean a species of stem cell distinct from the mesenchymal stem cell obtainable from bone marrow tissue. In construing the claim language, however, the district court held that “adipose-derived” simply meant “derived from fat tissue.” The Federal Circuit agreed with the district court’s construction of “adipose-derived” and affirmed the ruling that, under this construction, Katz and Llull conceived of the claims before the arrival of Hedrick at Pittsburgh in July 1997.

♦ In *Blackboard, Inc. v. Desire2learn, Inc.*, Nos. 2008-1368 and 2008-1396, the Federal Circuit affirmed the district court’s finding of invalidity for indefiniteness for some claims and revised the district court’s failure to grant JMOL of invalidity for anticipation.

The patent at issue related to an Internet-based educational support system and associated methods. The district court found some of the claims invalid for indefiniteness. The district court also found that the remaining claims required that the method permit access to multiple courses and roles through a single login. Those remaining claims were valid over the prior art.

Regarding indefiniteness, the relevant claims included four mean-plus-function clauses. The Federal Circuit affirmed that the specification lacked sufficient structure to support a “means for assigning a level of access . . . based on a user of the system’s predetermined role in a course.” The Patentee argued that, in light of limited disclosure in the specification, the remaining structural steps would be well known to a person of ordinary skill. However, the court noted that this erroneously conflates the

indefiniteness requirements of 35 U.S.C. § 112, sixth paragraph and enablement.

Regarding the prior art, the court first overruled the district court's claim construction, finding that the relevant claims did not contain a "single login" limitation. Notably, the Patentee's expert did not identify any other differences between the claims and the prior art. Thus, the court found that the claims were anticipated.

♦ In *Wavetronix v. EIS Electronic Integrated Systems*, Nos. 2008-1129 and 2008-1160, the Federal Circuit affirmed the district court's summary judgment of non-infringement by EIS.

Wavetronix's patent related to a system for identifying lanes of traffic so that a device can thereafter track the flow of automobiles in those lanes. The accused EIS product performed a similar tracking function and included a setup mode that, according to Wavetronix, infringed the patent claims. On summary judgment, and without entering a claim construction, the district court found no infringement.

The parties agreed that only one term—"probability density function estimation" or PDFE—required construction. The Federal Circuit construed the claim for the first time on appeal. The record indicated the district court had nothing further to add on the term, the parties both asked the court to do so, and the record was sufficiently developed to allow construction without prejudice to either party.

The construction concluded that a PDFE was an approximation of a PDF based on actual data points, such that peak values represent a high probability of an event and valleys represent a low probability. The court concluded that the data gathered by the accused project was not a PDFE: it consisted of

discrete values for each candidate lane, which were compared to a cut-off value, thereby determining if the candidate lane was an actual lane. In contrast, the PDFE disclosed in the patent involved counting the number of cars that passed over discrete locations in the roadbed, identifying peaks and valleys in the data, and setting the peaks to be the centerpoints of the lanes. In other words, not only did the accused product not use a PDFE, as required by the claims, it also did not define lanes but merely confirmed which of its pre-defined candidate lanes corresponded to actual roadway lanes.

♦ In *In re McNeil-PPC, Inc.*, No. 2008-1546, the Federal Circuit reversed a decision of the Board of Patent Appeals and Interferences that affirmed the Examiner's claim rejections for anticipation and obviousness.

The Examiner initially found the Appellant's patent was anticipated and obvious during a reexamination initiated by the Appellant. The Board affirmed, and the Appellant appealed. The Federal Circuit reversed because there was no evidence that the prior art disclosed the specific density characteristics and structural limitations of the ribs recited in the Appellant's patent.

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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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Our Irvine Office has an opening for a Patent Attorney or Patent Agent with an electronics background to join our growing practice. The ideal candidate will have a Bachelor's degree in Electrical Engineering, Computer Science, or Physics; 1-5 years of patent prosecution experience (including experience in electronics); and excellent written and oral communication skills. As a boutique firm, we can customize a package for the right candidate. Please submit resume, transcripts, writing sample, and references for consideration to:

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