

San Diego Intellectual Property Law Association

SDIPLA News



Special points of interest:

- SDIPLA will host a dinner meeting on October 30 featuring Robert J. Spar of the USPTO.
- Please renew your membership for 2003-2004 if you have not done so already (page 4).
- SDIPLA is soliciting nominations for its annual award to a person or entity that has made outstanding contributions to San Diego's intellectual property community (page 7).
- See brief article on Registered Community Designs on page 3.
- See brief article on the Madrid Protocol on page 6.
- This year's holiday party is on December 11 at L'Auberge.

October 30, 2003 SDIPLA Dinner (MCLE 1hr)

"Recent Significant Patent Office Notices and Rule Makings (Proposed and Final)"

By **ROBERT J. SPAR**

Director, Office of Patent Legal Administration, Office of Deputy Commissioner for Patent Examination Policy

SDIPLA is pleased that Robert J. Spar has agreed to speak at this month's SDIPLA dinner. Mr. Spar has been a big draw in the past for patent prosecutors, and his presentations address highly relevant issues to litigators and transactional attorneys as well.



Mr. Spar is the Director of the Office of Patent Legal Administration (OPLA), formerly known as the Special Program Law Office. Under the Deputy Commissioner for Patent Examination Policy at the U.S. Patent and Trademark Office, Mr. Spar's major responsibility is to develop and implement rules packages and policy initiatives involving patent examination processes. Mr. Spar is also a former examiner.

This year, Mr. Spar's presentation will be directed to the following topics: Image File Wrapper (IFW) - Final Rule, and overview of IFW implementation in PTO Revised

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Date/Time/Location:

October 30, 2003
6:00 p.m.—8:30 p.m.

La Jolla Marriott
4240 La Jolla Village Drive
La Jolla, California
858-587-1414

Checks payable to SDIPLA.

DIRECTIONS TO THE OCT. 30, 2003 MEETING

Notes:

This meeting is at the La Jolla Marriot.

This is a dinner meeting.

Directions:

I-5 to La Jolla Village Drive;
.5 miles east, between Genesee and Regents Road
I-805 to La Jolla Village Drive,
1 mile west

Continued from page 1 (Bob Spar dinner speaker)

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Amendment Practice; Elimination of CPA Practice—Final Rule; Notice of Foreign Filing—OG Notice; Reexamination Guidelines—OG Notice; Patent Cooperation Treaty—Proposed Rule Making; Clarification of Power of Attorney Practice, and Revisions to Assignment Rules—Proposed Rules Making; Unity of Invention Study—OG Notice; Changes to Support Implementation of the United States Patent and Trademark Office 21st Century Strategic Plan, Notice of Proposed Rule Making, 68 FR 5315 (September 12, 2003); YY Off. Gaz. (2003).

SDIPLA COMMITTEES: SDIPLA has Amicus, Awards, Editorial, Events, and Sponsorship committees. Please contact an officer if you are interested in joining a committee. Go to the SDIPLA website at www.sdipla.org for more information about these committees and SDIPLA. David Guttman is our webmaster.

Applications for SDIPLA Membership

The following individuals have applied for SDIPLA membership. Active Members may oppose membership status to these individuals by lodging a formal notice of opposition. The opposition must include relevant grounds for disqualification and should be submitted to the Secretary on or before October 28, 2003.

Richard Clegg
Mikael Havluciyani
Anthony Insogna
Michael W. Landry
Joseph J. Mallon
Scott E. McPherson
Victoria Newland
Michael Ruse
Alison Schaefer
Natalie Schiller
Kerry Taylor
Rose Thiessen
Richard Thill

Practice note (article provided by the author identified below)

Registered Community Designs Can Be Filed Under the New Regulation on Community Designs

By: Alexander R. Schlee, Viering, Jentschura & Partners, L.A. Office
tel.: 310 545 9851, e-mail: alexschlee@vjp.de

Since the beginning of 2003, applications for Registered Community Designs can be filed under the new Regulation on Community Designs. All applications for these design patents—known as “RCDs”—filed on or before April 1 will receive this April 1 filing date.

U.S. applicants might have some questions.

What qualifies for protection as an RCD? The Regulation defines that: “design’ means the appearance of the whole or a part of a product resulting from the features of, in particular the lines, contours, colors, shape, texture and/or materials of the product itself and/or materials of the product itself and/or its ornamentation.” The requirements should therefore be fairly similar to a U.S. Design Patent Application.

Where do RCD applications have to be filed? The creator of the design or any legal successor, irrespective of nationality or place of residence. The legal successor can be either an individual or a legal entity, so that applications can be filed in the name of the creator’s employer.

When should an RCD application be filed? Preferably, before public disclosure of the design.

What is the grace period? If a public disclosure prior to the filing or priority date is based on the work of the creator, a 12-month grace period applies. The grace period is calculated from the filing date, or if a priority is claimed, from the priority date.

What priority may the applicant claim? A 6-month priority can be claimed from any prior design patent or utility model application filed in any of the Paris Convention countries or in any of the WTO member countries.

What is the novelty requirement? There is a worldwide novelty requirement, but prior published designs affect novelty only if they could reasonably have become known in the normal course of business to those specialized in the concerned field of business operating within the EU.

Which territories are covered by an RCD application? All 15 EU countries. These are currently Austria, Belgium, Denmark, Finland, France, Germany, Greece, Ireland, Italy, Luxemburg, The Netherlands, Portugal, Spain, Sweden, and the United Kingdom.

What is the maximum duration? 25 years from the filing date if maintenance fees are paid on time in 5-year intervals.

What are the costs? Extremely low! The official fee totals \$350 (US). Foreign associate charges might total around \$ 500 (US). Several designs can be combined into one application for a minor surcharge. No designation fees or validation formalities are required. Consequently, any RCD covers all of the EU without any extra costs.

What is the biggest risk? A central invalidity suit can be filed against the entire RCD, invalidating the RCD for all EU countries. To avoid this risk, applicants should consider filing parallel national applications in the most important EU countries.

MEMBERSHIP RENEWAL

Name: _____ E-Mail Address: _____

Firm/Employer: _____

Mailing Address (for notices): _____

City/State/Zip: _____

Telephone Number: _____

Please continue to send newsletters, notices, etc., via regular mail: Yes No

Send check or money order payable to SDIPLA Dues to: Kent Walker
Attorney Member Dues: \$50/year SDIPLA Secretary
Non-Attorney/Retired Attorney Dues: \$25/year Cooley Godward LLP
(e.g. law students, paralegals, secretaries, retired 4401 Eastgate Mall
attorneys, etc.) San Diego, CA 92121-9109

Please Renew Your Membership for 2003-2004

If you have not done so already, all SDIPLA members are asked to send in their membership dues (please feel free to use the form above or provide equivalent information with your renewal check).

- E-Mailing of newsletters and notices will replace regular mailing unless a member specifically marks "YES" on the membership renewal form requesting otherwise.
- Members who have not renewed membership by November 30, 2003, will be removed from the active member mailing list.
- SDIPLA had approximately 285 active members in 2002-2003.
- Several additional members were inactive (did not pay dues in 2002-2003).
- SDIPLA would like to increase active membership, including significantly in-house practitioners.
- SDIPLA welcomes any suggestions to increase membership and to make the renewal process more efficient.
- Firms are encouraged to send in renewals for all active members.
- Dues help pay for dinners, speakers, non-dinner events, non-profit corporation fees, tax returns, copies, postage, etc.

Dinner Reservation Form for October 30, 2003 Meeting

Topic— “Recent Significant Patent Office Notices and Rule Makings (Proposed and Final)”

By ROBERT J. SPAR

Director, USPTO Office of Legal Administration

THURSDAY

Oct. 30, 2003

La Jolla Marriott on La Jolla Village Drive
Registration starts at 6:00 p.m.
Dinner starts at 6:45 p.m.
Presentation starts at 7:15 p.m.

The Menu

Tomato Bisque and Caesar Salad

With one of the following entrees:

Chicken Madagascar

(with Creamy Peppercorn Demi Glaze and Garlic
Mashed Potatoes)

** OR **

Grilled Mediterranean Salmon

(with Tomatoes, Olives, Capers and Oregano
served over Spinach Fettuccini)

OR

Vegetarian Lasagna

With

Chef's Selection of Accompaniments
and

California Fruit Tart with Creamy Vanilla Sauce

Please register early. Due to the large number of attendees expected at this event, the SDIPLA is again requesting **Pre-Registration and Pre-Payment**.

To reserve your place, please fill out the below registration, indicate your meal choice, and send it **WITH YOUR CHECK MADE PAYABLE TO 'SDIPLA'** to:

Kent Walker
SDIPLA Secretary
c/o Cooley Godward
4401 Eastgate Mall
San Diego, CA 92121-9109
(858) 550-6065
Fax: (858) 550-6420
walkerkm@cooley.com

REMINDERS

- Please mail, fax, or e-mail your reservation to Kent Walker at the address, fax, or e-mail address indicated for receipt **no later than Tuesday, Oct. 28, 2003**.
- The reservation deadline is dictated by the hotel and not by the SDIPLA.
- This program has been approved for MCLE credit by the State Bar of California in the amount of one (1.0) unit.

NOTE MEAL PRICES

\$40.00 SDIPLA Member

\$45.00 Non-Member

Registration

Name: _____ E-Mail Address: _____

Firm/Employer: _____

Telephone Number: _____

Member of SDIPLA? (circle one) YES NO

Entree Choice: ___ Chicken Madagascar ___ Grilled Salmon ___ Vegetarian Lasagna

Another Practice Note

Get Tuned, November 3 Is Closer Than You Think!

By: Alexander R. Schlee

Viering, Jentschura & Partners, L.A. Office
tel.: 310 545 9851

From November 3, 2003 on, U.S. applicants will be entitled to file applications under the Madrid Protocol, the progeny of the very old Madrid Agreement going back as far as 1891. The Madrid Protocol was finalized in 1989 but did not become effective in any country before 1995. Nowadays, most but not all Madrid Agreement member countries are Madrid Protocol members as well. Not so vice versa: There are a number of Madrid Protocol-only countries, the United States being one of these.

U.S. applicants might have some questions.

What qualifies for protection under the Madrid Protocol?

- The Madrid Protocol application has to be based on a domestic U.S. "home" application or registration. Therefore, the requirements are fairly similar to a U.S. Trademark Application.

Where do Madrid Protocol applications have to be filed?

- At the USPTO, forwarding the application to the International Bureau (IB) in Geneva, Switzerland, often called WIPO.

Who can be the applicant?

- Any legal entity domiciled in the U.S.
- Any U.S. citizen, even if not domiciled in the U.S.
- Any individual, domiciled in the U.S.

Articles of Interest

The Editorial Committee is looking for articles of interest to the SDIPLA Membership for inclusion in the newsletter. Please submit articles or request information from Mark Wiczorek.

CALL FOR NOMINATIONS - SDIPLA ANNUAL AWARD

The San Diego Intellectual Property Law Association (SDIPLA) is making a call for nominations for outstanding inventors, attorneys, patent agents, technology transfer specialists, investors, organizations, service providers and other individuals or entities who have significantly contributed to the San Diego IP community.

For nominations please contact either:

Rob Prince
Salmedix Pharmaceuticals or
9380 Judicial Drive
San Diego, CA
Ph. (858) 622-2160
Email: rprince@salmedix.com

Helen Irza
Morrison & Foerster
3811 Valley Centre Drive, suite 500
San Diego, CA 92130
(858) 720-5156
hirza@mofo.com

The winner of the SDIPLA 2003 IP Achievement Award will be announced in December, and the award will be presented at the annual SDIPLA Holiday Dinner on December 11, 2003. All nominations must be in by November 7, 2003.

ATTORNEY



Townsend and Townsend and Crew LLP, one of the premiere Intellectual Property law firms, is looking for candidates with an electrical engineering background and 2-5 years of patent prosecution experience to join our San Diego, California office.

Candidates should have:

- prosecution experience in the telecommunications industry
- excellent writing and communication skills
- prior admission to the California bar

Salary is highly competitive.

Please send resume and cover letter to:

Lindy Van der Reis, Esq.
Manager of Recruitment and Professional Development
Townsend and Townsend and Crew LLP
Two Embarcadero Center, Eighth Floor
San Francisco, CA 94111
mhv@townsend.com

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Barbara Treash-Osio
Ph: (619) 482-4706
Email: btreashosio@yahoo.com

Announcements

This Announcements section is designed to better serve the needs of the membership. This page may be used to advertise for positions offered or desired, as well as to provide a forum for announcements of interest to the San Diego IP community. Please contact Kent Walker if you would like to place an ad or announcement.



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Canadian Patent Agent (BSc. in Mathematics and Physics) with 6 years experience in Patent Prosecution of Hardware, Software, and Mechanical Patents seeking Immediate Full Time Position (Sponsor Visa required) to work in the area of Patent Prosecution. Resume (with samples of issued U.S. patents) and References will be provided upon request. Relocating to Irvine Area with Fiancé for immediate placement in October 2003.

Please contact
Paul A. Taylor
780-699-9999

or via email at paul_taylor@shaw.ca.

IP Attorney Position Open

AV rated North County firm seeks IP attorney with 4-5 years experience to assist with various IP matters, with special emphasis on trademarks, including trademark clearance and counseling, trademark prosecution, trademark infringement litigation, Internet-related trademark disputes, and opposition and cancellation proceedings before the Trademark Trial and Appeal Board of the U.S. Patent and Trademark Office. Send resume via email to info@mandclaw.com or via fax to 760-931-9086.

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opening of its San Diego office.

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**Visit SDIPLA on the Web at:
www.sdipla.org**

Upcoming SDIPLA Events

Date	Event	Speaker/Topic
October 30, 2003	SDIPLA Dinner Meeting	Robert J. Spar, Director, USPTO Office of Patent Legal Administration (see topic on pages 1 and 2).
December 11, 2003	SDIPLA Holiday Party at the L'Auberge Hotel in Del Mar	SDIPLA's annual award will be presented by the Awards Committee.
January 15, 2004	First SDIPLA Dinner Meeting of 2004	Mark Jansen, Esq. of Townsend and Townsend and Crew LLP on "Reverse Payment Patent Litigation Settlements."