

San Diego Intellectual Property Law Association

# SDIPLA News



**Special points of interest:**

- SDIPLA will host a dinner meeting on January 15 featuring Mark Jansen, Esq. of Townsend and Townsend and Crew.
- SDIPLA will host a dinner meeting on February 26 featuring John Benassi, Esq. of Paul Hastings.
- OCIPLA will sponsor a weekend IP workshop in Rancho Mirage on March 26-28, 2004.

## January 15, 2004 SDIPLA Dinner (MCLE 1hr)

“Reverse Payment Patent Litigation Settlements.”

By MARK JANSEN, ESQ.

Partner, Townsend and Townsend and Crew LLP

**TOPIC:** Can a patent holder settle patent infringement claims by paying the accused infringer to stay out of the market, without violating the antitrust laws? Some courts (and the Federal Trade Commission staff) say "No"; others courts say "Yes."

So called "reverse payment" patent litigation settlements are an especially hot topic in the generic pharmaceutical field. The many recent court decisions involving pharmaceutical patent litigation settlements also will impact patent dispute settlement considerations in other markets and products. In his presentation, Mr. Jansen will review the key recent FTC and court decisions this year in the "reverse payment" settlement area (*Schering-Plough*, *Bristol-Myers Squibb*, *Cardizem*, *Terrazosin*, *Ciproflaxin*, *Tamoxifen Citrate*), as well as antitrust issues affecting patent litigation settlements generally.



**SPEAKER:** Mark Jansen has been a litigation partner at the San Francisco offices of Townsend and Townsend and Crew LLP, since 1992, and was an antitrust and unfair practices litigator with Khourie Crew & Jaeger in San Francisco for seven years before that.

Mark specializes in antitrust, unfair business practices and intellectual property litigation.

Among the high profile antitrust/intellectual property cases that Mark and the Townsend firm have handled are:

The California consumer class action against Microsoft Corporation, in which the Townsend firm was lead counsel, and which settled earlier this year of 2003 for more than \$1.2 billion dollars;

**Contents**

1/15/04 Speaker	1, 2, 4
Article on PCT Filings in 2004	3
SDIPLA Information	2, 4
Announcements, Ads	5, 6

**Date/Time/Location:**

January 15, 2004  
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 JAN. 15, 2004 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

## SDIPLA Board of Directors

### President

Mark Wieczorek, Ph.D.  
Innercool Therapies, Inc.  
858 677-6390  
markw@innercool.com

### Vice President

Vicki G. Norton, Ph.D.  
Pillsbury Winthrop LLP  
858 847-4321  
vnorton@pillsburywinthrop.com

### Secretary

Kent M. Walker  
Cooley Godward, LLP  
858 550-6065  
walkerkm@cooley.com

### Treasurer

Thomas E. Coverstone  
Townsend and Townsend and  
Crew, LLP  
858 350-6100  
tec@townsend.com

### Immediate Past President

Richard C. Kim  
Morrison & Foerster, LLP  
858 720-5100  
rkim@mofo.com

### Newsletter Editor

Kent M. Walker

### Webmaster

David Guttman

## Continued from page 1 (Mark Jansen dinner speaker)

Also, a patent-tying antitrust case brought on behalf of Tandy Corporation against Texas Instruments which successfully challenged the practice of engaging in coerced "package licensing" to settle claims of patent infringement; and

Intergraph Corporation v. Intel Corporation, which the Townsend firm brought on behalf of Intergraph Corporation against Intel Corp. based upon Intel's refusal to provide advance technical information to OEM customers who had asserted their patents against Intel. The Intergraph case formed the basis of a Federal Trade Commission antitrust investigation and consent decree entered against Intel barring it from such coercive practices, and Intel last year agreed to pay in excess of \$300 million to settle Intergraph's patent infringement claims.

In addition, Mark provides counseling, primarily in the antitrust and unfair business practices law areas, in a wide range of contexts including licensing, distribution and joint venture agreements, and also represents clients in connection with grand jury and other government investigations.

**SDIPLA COMMITTEES:** SDIPLA has Amicus, Awards, Editorial, Events, and Sponsorship committees. **Members are needed for the sponsorship and events committees.** Please contact an officer if you are interested in joining a committee. Go to the SDIPLA website at [www.sdipla.org](http://www.sdipla.org) for more information about these committees and SDIPLA. David Guttman is our webmaster.

### SDIPLA Holiday Party

The holiday party was a success this year. Thanks to everyone who planned it and to those who attended. The SDIPLA Award for outstanding contributions to the San Diego intellectual property community went to Ivor Royston and Howard Birndorf, co-founders of Hybritech and several other biotech companies in San Diego. Thanks to Rob Prince of Salmedix and Helen Izra of Mofo of the Awards committee who planned and presented the award.

### 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 January 13, 2004.

Joseph Stephen DaRe  
Sheila R. Gibson  
Ronald Gulino  
Philip A. Morin  
Vasumati K. Pestonjamas  
William L. Respass  
Franco A. Serafini  
Bob Soltis  
Ryan Sullivan  
Lauren Sundheimer  
Jeffrey Talkington

If you have an **article for the newsletter** (see, e.g., page 3), please send it to Kent Walker.

To pay or renew your **membership dues**: Go to [www.sdipla.org](http://www.sdipla.org). Please pay your dues.

Practice note (article provided by the author identified below)

## **The PCT – A fast moving horse riding into 2004**

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

Many changes will come at the beginning of 2004. The following represents a selection of the most important changes. More details can be found at <http://www.wipo.org/pct/en/newslett/index.htm>. In particular, the November 2003 Newsletter is relevant.

### **New PCT Request and Chapter II Demand forms**

- Beginning January 1, 2004, new forms can be downloaded from <http://www.wipo.org/pct/en/forms/index.htm>

### **Automatic designation of all countries and all types of protection**

- There will be no possibility to opt out from the designation of specific countries other than from Germany, Korea and the Russian Federation. By separate withdrawal notice it is possible to withdraw any designation simultaneously when filing the PCT application. The USPTO and WIPO are still working on a solution for withdrawal of the U.S. designation without the need for signatures from the inventors.
- Without express indication, all available types of patent or utility model protection or national and regional protection are covered by the automatic designation.
- An express indication of a parent application or patent should be made when filing the PCT application if the relation to the parent is one of the following: application for a patent of addition, certificate of addition, inventor's certificate of addition, utility certificate of addition, continuation or continuation-in-part application.

### **EPO again ISA and IPEA for all applicants and in all "technical" fields**

- U.S. applicants will have the option again to use the European Patent Office (EPO) as International Search Authority (ISA) or International Preliminary Examining Authority (IPEA) in the field of biotechnology from 1 January 2004 and as IPEA in the field of telecommunications from 1 July 2004. Business methods will continue to be excluded as "non-technical" by the EPO.

### **New Chapter II Demand deadline**

- The new term for filing a Chapter II Demand will be 22 months from the oldest priority date or 3 months from the date of transmittal of the International Search Report (ISR) or declaration that no ISR will be prepared, whichever term expires later.

### **New ISR and IPER**

- All PCT applications filed on or after 1 January 2004 will receive a combined ISR and Written opinion called "international preliminary report on patentability (Chapter I of the Patent Cooperation Treaty)". This Written Opinion will be used as a first Written Opinion by IPEA unless IPEA notifies WIPO to the contrary. The IPER will change its name to "international preliminary report on patentability (Chapter II of the Patent Cooperation Treaty)."

### **New fees**

- When using WIPO as Receiving Office (RO): 1,400 Swiss Francs filing fee. For Chapter II Demands 200 Swiss Francs handling fee (in addition of fees charged by the IPEA). For fees at other ROs see applicants guide at <http://www.wipo.org/pct/guide/en/index.html>.

### **PCT-SAFE substitutes PCT-EASY**

- The new software can be downloaded from <http://www.int/pct-safe> Fee reductions apply for filing PCT application with PCT-SAFE.

## Dinner Reservation Form for January 15, 2004 Meeting

### Topic— “Reverse Payment Patent Litigation Settlements”

By MARK JANSEN, ESQ.

Partner, Townsend and Townsend and Crew, LLP

#### THURSDAY

Jan. 15, 2004

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

Please include Wanda Robinson  
 (wrobinson@cooley.com)  
 On email reservations

### 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, Jan. 13, 2004.**
- 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



[WWW.IPXONLINE.COM](http://WWW.IPXONLINE.COM)

**PATENT AND TRADEMARK  
WATCH SERVICE  
CALL 1-866-988-0970 OR  
VISIT US ON THE WEB  
FOR A FREE CONSULTATION**

**“KNOW YOUR COMPETITION  
KNOW YOUR CUSTOMERS  
WITH IPXONLINE.COM”**

ATTORNEY

**e**lectrical  
**e**ngineering

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

**TOWNSEND and TOWNSEND and CREW LLP**

A Full-Service Intellectual Property Law Firm  
[www.townsend.com](http://www.townsend.com)

## AGENT POSITION SOUGHT

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 to work in the area of Patent Prosecution.

Resume (with samples of issued U.S. patents to date) and References will be provided upon request.

Relocating to Irvine Area with Fiancé for immediate placement after November 1st, 2003.

Please contact **Paul Taylor** at +1 (780) 699-9999 or via email at [paul\\_taylor@shaw.ca](mailto:paul_taylor@shaw.ca).

## Patent Agent Seeks IP Work

**Patent Agent and law student with excellent grades open to any type of patent/IP work, part-time or full-time. BS in Cellular and Molecular Biology. Six years of academic and biotech lab experience.**

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

## 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](mailto:info@mandclaw.com) or via fax to 760-931-9086.

## 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.

**When  
innovation  
STRIKES . . .**

**call  
Townsend**



**Townsend**  
is pleased to announce the  
opening of its San Diego office.

For more information, please contact:

**Karen B. Dow**  
Biotechnology & Chemistry Practice Group

**Thomas E. Coverstone**  
Electronics & Software Practice Group

**Sean L. Collin**  
Technology Licensing Practice Group

**TOWNSEND *and* TOWNSEND *and* CREW** LLP

A Full-Service Intellectual Property Law Firm

[www.townsend.com](http://www.townsend.com) 858.350.6100

SDIPLA  
c/o Kent M. Walker  
Cooley Godward LLP  
4401 Eastgate Mall  
San Diego, CA 92121-9109

**Visit SDIPLA on the Web at:  
[www.sdipla.org](http://www.sdipla.org)**

## Upcoming SDIPLA Events

Date	Event	Speaker/Topic
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.”
February 26, 2004	SDIPLA Dinner Meeting	John Benassi, Esq., of Paul Hastings on “Applying Already Construed Claims to Prove Infringement—Literally and by Equivalents.”
March 26-28, 2004	OCIPLA Workshop in Rancho Mirage	Multiple Speakers and MCLE opportunities; more details and registration information to follow.