

San Diego Intellectual Property Law Association

# SDIPLA News



**Special points of interest:**

- SDIPLA will host a dinner meeting on February 26 featuring John Benassi, Esq. of Paul Hastings.
- SDIPLA and the San Diego chapter of the Federal Bar Association will host a dinner meeting on March 16 featuring a panel comprised of Federal Circuit Judge Rader, Chief Judge Huff (S.D. Cal.), Judge Brewster (S.D. Cal.) and David Doyle of Morrison Foerster LLP. The topic will be claim construction.
- OCPA will sponsor a weekend IP workshop in Rancho Mirage on March 26-28, 2004.
- SDIPLA will host a dinner meeting on April 21 featuring R. Danny Huntington of Burns Doane on patent interferences.

## February 26, 2004 SDIPLA Dinner (MCLE 1hr)

**“Applying Already Construed Claims to Prove Infringement, Literally or by Equivalents.”  
By JOHN BENASSI, ESQ.**

**TOPIC:** After your claims have been construed, now you’ve got to apply them to prove infringement, either literally or by equivalents. Mr. Benassi will discuss recent authority and experiences in the important process of applying construed claims to prove infringement.

**SPEAKER:** John Benassi is Paul, Hastings, Janofsky & Walker LLP's co-chair of worldwide IP group. He was voted by his peers as one of "The Best Lawyers in America" ([www.bestlawyers.com](http://www.bestlawyers.com)). He is also listed in the Guide to the World's leading Patent Law Experts ([www.expertguides.com](http://www.expertguides.com)).

In litigation, for the last twenty-eight years, Mr. Benassi has represented clients in State and Federal Courts (both trials and appeals) in technologies ranging from internet commerce to semiconductors to medical devices to biotechnology.



Examples of such cases include: Bristol Myers v. Gensia Sior (represented generic drug manufacturer Gensia Sior in the invalidation of Bristol Myers' Cisplatin chemotherapy patent which was used to cure Lance Armstrong's cancer); First Virtual Holdings and Message Media v. InfoBeat and Exactis.com (One of first lawsuits on Internet Commerce patents); Amylin v. University of Minnesota (patent on biotechnology diabetes treatment drug); Metro-Goldwyn-Mayer Studios, Inc., et al. v. Grokster, LTD., et al.; Streamcast Networks, Inc. (Morpheus) (C.D.CA "next Napster" copyright case).

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**Date/Time/Location:**

February 26, 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 FEB. 26, 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

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## Continued from page 1 (John Benassi dinner speaker)

Before the Patent and Trademark Office and Copyright Office, Mr. Benassi was responsible for obtaining of patents, trademarks and copyrights for a variety of different ideas and media and in technological areas ranging in semiconductor, mechanical, medical, and computer technology.

Mr. Benassi also has expertise in counseling start-up and venture capital firms involved in internet commerce, biotechnology and electronics, including building up their patent portfolios and conducting patentability and infringement analysis.

A graduate from the University of Illinois (Champaign-Urbana) in 1971, he first studied engineering, then attended law school at the George Washington University in Washington D.C. graduating cum laude in Patent, Trademark, Copyright and Anti-Trust Law. He obtained experience with the workings of the Patent Office in Washington D.C. and in 1975 and 1976 he served as a Law Clerk at the U.S. Claims Court (trial division) assisting in the trial and decision of patent infringement cases brought against the U.S. Government.

### OCPLA 2004 SPRING SEMINAR TO BE HELD IN RANCHO MIRAGE ON MARCH 26-28

The OCPLA/SDIPLA 2004 Spring Seminar will be held on March 26, 2004 to March 28, 2004 at the Hyatt Regency Suites Palm Springs, 285 North Palm Canyon Drive. Save the date! Don't miss your chance to meet the PTO's Commissioner Rogan, and other distinguished speakers. Check this column in upcoming newsletters for more information, or contact OCPLA Secretary, Margaret Kivinski, at 949 757-1999 (mkivinski@therox.com).

**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.

### 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 February 24, 2004.

William B. Anderson, Michael B. Farber, Lawrence S. Graham, Thomas F. Lebens, Kate McEl-

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

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

## Dinner Reservation Form for February 26, 2004 Meeting

### Topic— “Applying Already Construed Claims to Prove Infringement, Literally or by Equivalents”

By JOHN BENASSI, ESQ.

Partner, Paul, Hastings, Janofsky & Walker, LLP

#### THURSDAY

Feb. 26, 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, Feb. 24, 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



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## SYMPOSIUM ANNOUNCEMENT

Title: Enforcement of Patents in the Pacific Rim

Speakers: Patent Attorneys from China, Japan, Australia, and the US

Where: Anaheim Convention Center

When: 9:30 AM - NOON  
Monday, March 29, 2004

The Symposium is sponsored by the American Chemical Society (ACS) in conjunction with the 227th National Meeting of the ACS. For registration, contact the ACS at [www.chemistry.org](http://www.chemistry.org) and register for a day pass (Monday) to the ACS National Meeting in Anaheim. For more information, contact Don Lewis at [dlewis@scripps.edu](mailto:dlewis@scripps.edu).

## 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.

## **Silicon Valley Seminars'**

### **2004 Workshop Schedule**

#### **U.S. PATENTS & the PATENT PROCESS**

**(Secretaries • Paralegals • New Patent Attorneys/  
Agents)**

San Diego 3/15 • LA 4/1

San Fran Area 5/13

San Francisco 10/28

#### **The PCT & the PCT PROCESS**

**(Secretaries • Paralegals • Patent Attorneys/Agents)**

San Fran Area 3/15 • Los Angeles 4/19

San Diego 4/20

#### **PATENTS & PATENT CLAIM DRAFTING**

**(Patent Attorneys/Agents)**

San Diego 3/26, 27 • Los Angeles 4/2, 3 • San Fran Area  
5/14, 15

San Fran Area (Summer and new Associates/agents,  
July 12, 13

San Fran Area 10/29, 30

#### **TRADEMARKS & and the TRADEMARK PROCESS**

**(Secretaries • Paralegals • Attorneys)**

San Francisco 6/15 • San Diego 6/16

**FOR DETAILS VISIT [www.patentseminars.com](http://www.patentseminars.com)**

**or contact Steve Shear at [steve@patentseminars.com](mailto:steve@patentseminars.com)**

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**TOWNSEND AND TOWNSEND AND CREW LLP**, one of the premier Intellectual Property law firms, is seeking a patent agent to join our growing San Diego office. Ideal candidate has an electrical engineering background, 1-3 years of patent prosecution experience, and excellent writing and communication skills. Competitive salary and good benefits. Please send resume to:

Lindy Van der Reis, Esq.

Manager of Recruitment and Professional Development

Townsend and Townsend and Crew LLP

2 Embarcadero Center, 8th Floor

San Francisco, CA 94111

[mhv@townsend.com](mailto:mhv@townsend.com)

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

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

## Upcoming SDIPLA Events

Date	Event	Speaker/Topic
<b>February 26, 2004</b>	SDIPLA Dinner Meeting	John Benassi, Esq., of Paul Hastings on “Applying Already Construed Claims to Prove Infringement, Literally or by Equivalents.”
<b>March 16, 2004</b>	Joint Dinner Meeting SDIPLA and the Federal Bar Association	Panel presentation featuring Federal Circuit Judge Rader, Chief Judge Huff (S.D. Cal.), Judge Brewster (S.D. Cal.) and David Doyle of Morrison Foerster in San Diego on Claims Construction.
<b>March 26-28, 2004</b>	Orange County Patent Law Association Workshop in Rancho Mirage	Multiple Speakers and MCLE opportunities; see page 3 and <a href="http://www.ocpla.org">www.ocpla.org</a> for details.
<b>April 21, 2004</b>	SDIPLA Dinner Meeting	R. Danny Huntington, Esq. of Burns Doane Swecker & Mathis, LLP on Patent Interferences.