



# SDIPLA News

## June 28, 2005 SDIPLA Dinner (MCLE 1hr)

“The Impact of *Merck v. Integra* on the § 271(e)(1) Exemption from Patent Infringement”

By MAURICIO A. FLORES

Partner

McDermott Will & Emery LLP



### Special points of interest:

- Election of the 2005-2006 SDIPLA Board will take place on June 28, 2005.
- Sign-up sheets to be a Mentor for the new SDIPLA Mentor Program will be available at the meeting and on-line.

Mauricio Flores is a partner in the law firm of McDermott Will & Emery LLP based in the Orange County office. As a member of the Intellectual Property, Media & Technology Department, his practice is focused primarily on biotechnology patent infringement and trade secret disputes. He has handled numerous high-profile biotechnology cases and has extensive experience as a trial lawyer in federal and state courts, as well as state and federal administrative tribunals. Mauricio has had significant involvement in cases concerning licensing disputes and the ownership of patent rights to federally-funded research under the Bayh-Dole Act.

Prior to joining McDermott, Mauricio was a founding partner of Campbell & Flores, LLP, a San Diego based biotech intellectual property law firm. In addition to his 10 years at Campbell & Flores, he practiced general litigation for 12 years at a U.S. law firm where he tried a wide variety of commercial disputes and state and federal environmental regulatory matters.

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### JUNE DINNER MEETING:

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### “The Impact of *Merck v. Integra* on the § 271(e)(1) Exemption from Patent Infringement”

#### Date/Time/Location:

June 28, 2005  
6:00 p.m.—8:30 p.m.  
La Jolla Marriott  
4240 La Jolla Village Drive  
La Jolla, California

#### Notes:

This meeting is at the La Jolla Marriot.  
  
This is a **dinner** meeting.  
  
Speaker: Mauricio A. Flores

#### Directions:

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

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I-805 to La Jolla Village Drive  
1 mile west

**SDIPLA**  
Board of Directors

**President**

Vicki G. Norton, Ph.D.  
Wilson Sonsini Goodrich & Rosati LLP  
858 350-2305  
vnorton@wsgr.com

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858 550-6065  
walkerkm@cooley.com

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858 336-8620  
patpend@sbcglobal.net

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San Diego, CA

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Thomas E. Coverstone

**Webmaster**

Tobey Tam

Professional Profile (Continued from Page 1)

**June 28, 2005 Lunch (MCLE 1hr)**

**“The Impact of *Merck v. Integra* on the § 271(e)(1) Exemption from Patent Infringement”**

**Speaker:**  
**Mauricio A. Flores**

Mauricio has published and lectured on a wide variety of issues relating to biotechnology litigation and licensing. His recent lecture topics have included, “Biotechnology Litigation as a Multi-Disciplinary Enterprise,” “Due Diligence in the Acquisition of Biotechnology Intellectual Property,” and “Licensing the Tools of Biotechnology.” His article, “Taking the profit out of biomedical research tools,” appeared in *Nature Biotechnology*.

Among his many professional activities Mauricio is a member of the Licensing Executives Society, the Association of University Technology Managers and the San Diego Patent Law Association. He is also a member of the Orange County Bar Association and the California State Bar Association. Mauricio also serves on the board of directors of the San Diego Legal Aid Society.

Mauricio clerked for the Chief Justice of the California Supreme Court and served as a trial attorney for the U.S. Department of Justice, Civil Division, under the Department’s Honor Law Graduate Program. He is licensed to practice law in California, the District of Columbia, before numerous U.S. District Courts and the U.S. Court of Appeals for the Ninth and Federal Circuits.

**Practice Areas & Industries**

- Biotech & Life Sciences
- Intellectual Property, Media & Technology
- IP, Media & Technology – Life Sciences
- IP, Media & Technology - Litigation
- IP, Media & Technology – Transactions & Asset Management
- Licensing
- Trade Secrets

**Education**

- Harvard Law School, J.D., 1977
- San Diego State University, A.B., 1973

## Reservation Form for June 28, 2005 Meeting

### “The Impact of *Merck v. Integra* on the § 271(e)(1) Exemption from Patent Infringement”

By MAURICIO A. FLORES

Tuesday  
June 28, 2005

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

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:

Thomas E. Coverstone  
SDIPLA Secretary  
c/o Jeanette Olivera  
12730 High Bluff Drive, Suite 400  
San Diego, CA 92130  
(858) 336-8620  
Fax: (858) 350-6111  
patpend@sbcglobal.net

Please include Jeanette Olivera  
(jolivera@townsend.com) on all e-mail reservations.

**Please fill out a separate form for each attendee.**

### REMINDERS

- Please mail, fax, or e-mail your reservation to Thomas Coverstone at the address, fax, or e-mail address indicated for receipt **no later than 5:00 p.m. on Wednesday, June 22, 2005.**
- 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

**\$45.00 SDIPLA Member**

**\$50.00 Non-Member**

## Registration

Name: \_\_\_\_\_ E-Mail Address: \_\_\_\_\_

Firm/Employer: \_\_\_\_\_

Telephone Number: \_\_\_\_\_

Member of SDIPLA? (circle one) YES NO

Entrée Choice: \_\_\_\_\_ Chicken Madagascar \_\_\_\_\_ Grilled Salmon \_\_\_\_\_ Vegetarian Lasagna

RESERVATION DEADLINE IS 5:00 P.M., JUNE 22, 2005

### Election of the SDIPLA Board on June 28, 2005

On June 28, 2005, the SDIPLA will elect the Board members for the 2005-2006 term. **After careful consideration, the SDIPLA Board has selected *Tim Smith* as its nominee for Treasurer for the 2005-2006 SDIPLA calendar year.** Tim's nomination statement is published in this newsletter on p. 5.

Members who cannot attend the June 28, 2005 meeting may send their proxy vote (on p. 6), by Friday, June 24, 2005 to:

Tom Coverstone  
SDIPLA Secretary  
4130 La Jolla Village Drive, #107-121  
La Jolla, CA 92137  
(858) 336-8620  
fax: (858) 350-6111  
e-mail: patpend@sbcglobal.net

### ATTENTION NEW MEMBERS

If you are interested in applying for membership, please fill out the form located at:

[http://www.sdipla.com/SDIPLA\\_New\\_Member\\_Application2004\\_2005.doc](http://www.sdipla.com/SDIPLA_New_Member_Application2004_2005.doc)

and mail in the form with your membership dues to Tom Coverstone.

**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](http://www.sdipla.org) for more information about these committees and SDIPLA.

### 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 28, 2005.

David L. Clark  
Charles E. Eggers  
Victor M. Felix

Matthew V. Grumbling  
Michelle Hon  
David E. Kleinfeld

Todd North  
Richard San Pietro  
Barry Tucker

**ARTICLES:** If you have an article for the newsletter, please send it to Tom Coverstone, 4130 La Jolla Village Drive, #107-121, La Jolla, CA 92137, phone: (858) 336-8620, fax: (858) 350-6111, e-mail: [patpend@sbcglobal.net](mailto:patpend@sbcglobal.net).

**DUES:** To pay or renew your **membership dues:** Please use the form on the web page, and send the form via mail or fax to Tom Coverstone.

**SPONSORSHIP:** If your firm or company is interested in sponsoring a meeting, please contact Tom Coverstone.

SDIPLA TREASURER NOMINEE: TIM SMITH

The SDIPLA Board is pleased to announce its selection of Timothy L. Smith as its nominee for treasurer. The Board believes that Tim's longstanding participation in the SDIPLA and his unique breadth of experience gained in his position as Vice President Business and Legal Affairs at Genomics Institute of the Novartis Research Foundation, and from his previous practice of patent law with Townsend and Townsend and Crew will complement and prove a valuable resource to the SDIPLA Board.

Tim Smith's Nomination Statement:

I have been a member of the San Diego IP community since 2001, and have been actively involved with the SDIPLA throughout this time. I have found the SDIPLA to be an important resource not only because of the high quality of presentations, but also because of the collegiality of the members. I believe it is important to do my part to participate in helping the Association facilitate the growth and prosperity of the IP bar in San Diego. I believe that I can assist this effort as Treasurer.

BACKGROUND:

I have been involved in patent law since 1991, first as a patent agent and then as a patent attorney. My experience is mostly in pharmaceutical, biotechnical, and mechanical engineering patent prosecution. Most of my early patent prosecution career was spent with Townsend and Townsend and Crew in San Francisco, and since 2001 I have been with the Genomics Institute of the Novartis Research Foundation (GNF) here in San Diego.

I have a B.S. degree in chemistry from the University of Minnesota-Duluth, and a Ph.D. in molecular biology from the University of Wisconsin. I did time as a postdoc and a research scientist before fleeing from the lab bench and getting into patent law.

# PROXY VOTE FOR SDIPLA BOARD 2005 ELECTION



Please mail or e-mail your proxy vote by Friday, June 24, 2005 to:

Tom Coverstone  
SDIPLA Secretary  
4130 La Jolla Village Drive, #107-121  
La Jolla, CA 92137  
(858) 336-8620  
fax: (858) 350-6111  
e-mail: patpend@sbcglobal.net

POSITION

SDIPLA BOARD'S NOMINEE

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VICKI NORTON

President

KENT WALKER

Vice President

TOM COVERSTONE

Secretary

ROB PRINCE

Treasurer

TIM SMITH

Name: \_\_\_\_\_

*Please check one of the boxes below:*

- I vote to elect the SDIPLA Board's nominees for each Board position.
- I wish to vote for the SDIPLA Board's nominees except for the following write-in candidate(s) for the position listed:

\_\_\_\_\_  
(Position)

\_\_\_\_\_  
(Name)

\_\_\_\_\_  
(Position)

\_\_\_\_\_  
(Name)

\_\_\_\_\_  
(Position)

\_\_\_\_\_  
(Name)

## Join QUALCOMM and Be Part of the Wireless Future

QUALCOMM is a leading 3G wireless technologies and solutions company composed of diverse, visionary people from around the world. Through individual and team efforts, we are making a positive impact on the future of the wireless industry and the world. Proof of our success is in our 3,000 issued or pending patents, each having a unique story behind it. And this is just the beginning — our commitment to the continued success of wireless communications is stronger than ever.

Selected by FORTUNE magazine as one of the *100 Best Companies to Work for in America* for the 7th year in a row, we strive for a balance of personal achievement and corporate excellence. If you've got a creative mind and ideas for wireless technology others find a bit radical, we might have just the spot for you

**Below are a few job positions that we currently have available in our Legal Department. For a detailed description of each job and to see what other positions we have available, please visit our website at [www.qualcomm.com/careers](http://www.qualcomm.com/careers).**

**C1665248 - Patent Counsel**

**C1674171 - Patent Counsel**

**C1664970 - Associate Patent Counsel-Software IP**

**C1660609 - Associate Patent Counsel**

**TO APPLY:** QUALCOMM has created an on-line system that makes it easy for you to apply for these positions and keep your resume current. To be considered for these positions, your resume must be submitted on line at: [www.qualcomm.com/careers](http://www.qualcomm.com/careers) Please locate position by job code number . Resumes submitted in any other format will not be integrated into this on-line system.

*QUALCOMM is an equal opportunity employer. Our value of global inclusion is reflected in our employees, corporate culture, programs and activities.*

### 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 Tom Coverstone if you would like to place an ad or announcement.

# AIPLA

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## 2005 Advanced Patent Cooperation Treaty Seminars

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July 18 – 19, 2005  
Hamilton Crowne Plaza  
Washington, DC

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July 21 – 22, 2005  
Hyatt Regency Minneapolis  
Minneapolis, MN

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July 25 – 26, 2005  
The Westin Horton Plaza  
San Diego, CA

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**UP TO 15.6 CLE CREDITS OFFERED**

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American Intellectual Property Law Association  
2001 Jefferson Davis Highway, Suite 203  
Arlington, VA 22202  
[www.aipla.org](http://www.aipla.org)  
phone 703-415-0780 fax 703-415-0786

For Registration Information, please visit  
[www.aipla.org](http://www.aipla.org)  
or call (703) 415-0780 for further information

## SEMINAR COORDINATORS & SPEAKERS

### **John H. Hornickel**

*Program Chair*  
PolyOne Corporation  
Avon Lake, OH

### **Alan J. Kasper**

*Program Vice-Chair*  
Sughrue Mion, PLLC  
Washington, DC

## SPEAKERS

### **Carol Bidwell**

United States Patent and Trademark Office  
Alexandria, VA  
(DC, MN, CA)

### **John P. Blasko**

Fox Rothschild, LLP  
Lawrenceville, NJ  
(DC, MN, CA)

### **Jay Erstling**

World Intellectual Property Organization  
Geneva, Switzerland  
(MN, CA)

### **John H. Hornickel**

PolyOne Corporation  
Avon Lake, OH  
(CA)

### **Alan J. Kasper**

Sughrue Mion, PLLC  
Washington, DC  
(DC)

### **Carl Oppedahl**

Oppedahl & Larson, LLP  
Dillon, CO  
(DC, MN, CA)

### **Salvatore A. Sidoti**

Curatolo & Sidoti  
Westlake, OH  
(MN)



## ADVANCED PATENT COOPERATION TREATY SEMINAR

**H**ave you re-formed your PCT practice since the major PCT Reforms of 2004? A handful of active PCT patent attorneys have prepared two days of presentation, discussion, and debate for your active participation. They do not have all of the answers. They do not even have all of the questions. But what they do have is an engaging two days of topics such as:

- Implications of PCT without designations
- To demand or not to demand?
- Evidentiary effect of PCT prosecution
- Use of PCT SAFE and electronic filing
- Value of IPRP I vs. IPRP II in the EISPE system
- What about business method applications?
- Where to search and where to preliminarily examine?
- What countries matter in a patent portfolio?

Carol Bidwell, Supervisor, Office of PCT Legal Administration from the United States Patent and Trademark Office (USPTO) and Jay Erstling, Director, Office of the PCT from the World Intellectual Property Organization (WIPO), will offer explanations about PCT procedures.

This seminar is designed for active practicing attorneys, agents, paralegals and administrators who have an understanding of the substance of PCT in addition to its procedures.

Comprehensive written materials are being prepared for the seminar, which will run two days from 9:00 a.m. to 5:00 p.m., with registration/continental breakfast starting at 8:00 a.m., lunch and two breaks each day. The program will be conducted to permit questions as they arise. Active audience participation is encouraged; several topics include debates by the panelists of the ramifications of PCT Reform and the future of the PCT.

### SEMINAR CANCELLATION POLICY

Pre-registration is on a first come-first serve basis. Participation is limited. Refunds will be made only if **cancellation is received by AIPLA in writing as follows:**

July 18 & 19 Seminar – no later than July 5

July 21 & 22 Seminar – no later than July 7

July 25 & 26 Seminar – no later than July 11

Call AIPLA at **703-415-0780** for further information.

## HOTEL INFORMATION

JULY 18 – 19, 2005

WASHINGTON, DC

Hamilton Crowne Plaza  
14th & K Street, NW  
Washington, DC 20005

**Reservations:** (800) 263-9802  
or (202) 682-0111

**Room Rate:** \$129 (Single/Double)

**Reservation Cut-Off Date:** June 27, 2005

JULY 21 – 22, 2005

MINNEAPOLIS, MN

Hyatt Regency Minneapolis  
1300 Nicollet Mall  
Minneapolis, MN 55403

**Reservations:** (888) 421-1442  
or (612) 370-1234

**Room Rate:** \$149 (Single/Double)

**Reservation Cut-Off Date:** July 1, 2005

JULY 25 – 26, 2005

SAN DIEGO, CA

The Westin Horton Plaza  
910 Broadway Circle  
San Diego, CA 92101

**Reservations:** (800) Westin-1  
or (619) 239-2200

**Room Rate:** \$219 (Single/Double)

**Reservation Cut-Off Date:** July 3, 2005

\*When you contact the hotel, be sure to identify yourself as an **AIPLA Seminar Participant** in order to get the special rate. Limited hotel rooms have been blocked, so please reserve your room as soon as possible.

## TRANSPORTATION INFORMATION

**AIR TRAVEL AND CAR RENTAL INFORMATION:** AIPLA has contracts with these official airlines and a car rental agency to better serve the needs of members nationwide. You must use the special telephone number and the appropriate code. Each offers discounts of up to 5-10% on various fares and rental rates and guarantees the lowest fare or rate at the time you make your reservations. Naturally, the earlier you call, the more you save. Certain rules and restrictions apply.

*Reminder: These discounts are available only through the use of the special meeting desk toll-free telephone numbers and the proper code number. Special airfares are available three days before and three days after selected meeting date. Special car rental rates are available one week before and one week after scheduled meeting date.*

American Airlines	(800) 433-1790	Code #15945
United Airlines	(800) 521-4041	Code #510RS
Avis Rent-A-Car	(800) 331-1600	Code #D086869

MAIL REGISTRATION AND PAYMENT TO:

Thomas E. Coverstone  
 SDIPLA Secretary  
 4130 La Jolla Village Drive  
 #107-121  
 La Jolla, CA 92037

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

Date	Event	Speaker/Topic
<b>June 28, 2005</b>	SDIPLA dinner meeting	Mauricio Flores of McDermott, Will & Emery on “Merck v. Integra”; also, Election of Officers