



SDIPLA News



Robert J. Spar

Robert J. Spar is the Director of the Office of Patent Legal Administration, (OPLA), under the Deputy Commissioner for Patent Examination Policy at the U.S. Patent and Trademark Office (USPTO). A major responsibility of the OPLA is addressing policy initiatives involving the patent examination process. This includes developing, implementing and disseminating information about changes to patent examining practices and procedures via rulemaking, publishing notices in the Federal Register and the Official Gazette, modifying USPTO forms which are used both internally and externally, and distributing internal memoranda. Recent extensive rulemaking efforts undertaken and completed by Mr. Spar and the OPLA are the four AIPA final rule packages (Requests for Continuing Examination or RCE, Patent Term Adjustment, Pre Grant Publication, and Inter Partes Reexamination) and the Patent Business Goals – Final Rule. In addition, OPLA is responsible for implementation of each of the final rule packages, which includes training, as needed, of the technical support staff, the examining corps, and members of Patent management. To inform the patent and inventor communities about the changes made by these various rulemakings, and how they are being implemented, Mr. Spar and his staff have developed AIPA and PBG – Final Rule web pages on the USPTO's web site, and they have made numerous presentations throughout the country.

~Agenda follows on page 02

Special Points of Interest:

~Oct. 18– Bob Spar Dinner Meeting Recent rule change and developments in the PTO. Agenda p. 2

~Oct. 19-PTO Technology Center 1600 Road Show Note: All day event

November–TBA December 8th–Holiday Awards party p. 8

WIPO PCT Seminar Info, p. 9

OCTOBER MEETING(S)

~TUESDAY, OCTOBER 18TH

“RECENT DEVELOPMENTS IN USPTO RULES AND PROCEDURES”

BY: ROBERT J. SPAR, DIRECTOR, OFFICE OF PATENT LEGAL ADMINISTRATION AT THE USPTO

~WEDNESDAY, OCTOBER 19TH*

BIO SCIENCE FORUM SPECIAL SYMPOSIUM

“USPTO TECHNOLOGY CENTER 1600 WEST COAST ROAD SHOW 2005”

**For detailed information of the October 19th 2005 meeting, please see page 3; Bios and Abstracts begin on pgs. 4, 5.*

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OCTOBER 18th DINNER MEETING

Date/Time/Location:

October 18, 2005
 6:00 p.m.—9:00 p.m.
 Radisson LaJolla
 3299 Holiday Court
 La Jolla, California
 phone: 858.453.5500
www.radisson.com/lajollaca



Directions:

- > From I-5, exit at LaJolla Village Drive.
- > Proceed West and turn left at Villa La Jolla Drive,
- > Turn left at Holiday court
- > Located in the Golden Triangle Business District

SDIPLA Board of Directors

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October Meetings (Continued from Page 1)

~TUESDAY, OCTOBER 18TH

"RECENT DEVELOPMENTS IN USPTO RULES AND PROCEDURES"

BY: ROBERT J. SPAR, DIRECTOR, OFFICE OF PATENT LEGAL ADMINISTRATION AT THE USPTO

AGENDA

1. Significant Office Statistics
2. Initiatives for Reducing Patent Backlog and Enhancing Quality
 - Expanding the Workforce & Telecommuting
 - School of Examiner Education & Development (SEED)
 - Shared Responsibility - Quality of Applications Submitted
 - Rework and Continuing Applications
 - Applications that Have Extraordinary Number of Claims
3. Outsourcing PCT Search Pilot Program
4. Pre-Appeal Brief Conference Pilot Program
5. Improved Reexamination Process
6. Final Rule: 35 USC 103(c) as Amended by the CREATE Act
7. Final Rule: Claiming the Benefit of a Non-English Provisional Application, and Other Miscellaneous Matters

~WEDNESDAY, OCTOBER 19TH

BIO SCIENCE FORUM SPECIAL SYMPOSIUM "USPTO TECHNOLOGY CENTER 1600 WEST COAST ROAD SHOW 2005"

SPEAKERS:

JASEMINE CHAMBERS, PH.D., J.D., DIRECTOR
GARY JONES, SUPERVISORY PATENT EXAMINER (SPE)
BRENDA BRUMBACK, SPE
JOSEPH K. MCKANE, SPE
DEBORAH J. REYNOLDS, QUALITY ASSURANCE SPECIALIST
ANDREW WANG, SPE

CO-SPONSORS:

WASHINGTON STATE PATENT LAW ASSOCIATION (WSPLA);
SAN DIEGO INTELLECTUAL PROPERTY LAW ASSOCIATION (SDIPLA);
THE UNIVERSITY OF SAN DIEGO (USD) SCHOOL OF LAW;
THE STATE BAR OF CALIFORNIA, INTELLECTUAL PROPERTY LAW
SECTION; AND
THE UNIVERSITY OF SAN FRANCISCO (USF) SCHOOL OF LAW

~continued on page 3

~ October Meetings continued from page 2

~WEDNESDAY, OCTOBER 19TH

BIO SCIENCE FORUM ~ SPECIAL SYMPOSIUM

“USPTO TECHNOLOGY CENTER 1600 WEST COAST ROAD SHOW 2005”

Target Audience:

Scientists in industry and academia, Intellectual Property Attorneys, Paralegals and Patent Agents, Corporate Officers, Directors of Research and Development, Scientists and Inventors and anyone who has an interest in Patents for Life Sciences.

Abstract:

This Symposium presents the latest information from the USPTO Examining Group 1600, which deals with Biotechnology, Pharmaceuticals and Organic Chemistry. Speakers represent the top management of the Group and the topics include some of the most important that face companies trying to protect intellectual property rights to Biotechnology, Pharmaceutical and Chemical inventions. The guests will provide the most up-to-date information from the USPTO regarding restriction practice, electronic filing of patent applications, sequence listings, incorporation by reference, new matter, claim interpretation, written description, microarray claims and chemical polymorphs and isomers, among others.

CLE credit applied for by BioSF for California Attorneys
and by WSPLA for Washington Attorneys
Lunch will be provided

Tentative Program

7:45 - 8:15: Registration.

8:15 AM: **Introduction:** Ben Borson, Ph.D., J.D., President, BioSF

8:30 - 9:15: **Overview and Restriction Practice:** Jasmine Chambers

9:15 - 10:00 AM: **Electronic Filing,** Gary Jones

10:00 - 10:15: Break

10:15 - 11:00: **Sequence Listings and Incorporation by Reference,** Andrew Wang

11:00 - 11:45: **New Matter** Deborah Reynolds

11:45 PM- 12:45 PM: Lunch ~ **Buffet Lunch provided** ~

12:45 - 1:30: **Claim Interpretation,** Brenda Brumback

1:30 - 2:15: **Written description,** Deborah Reynolds

2:15 - 2:30 Break

2:30 - 3:15: **Examination Issues for Microarrays,** Andrew Wang

3:15 - 4:00: **Chemical Polymorphs and Isomers,** Joesph McKane

4:00 - 4:30: **Closing Remarks and Q&A**

SD: University of San Diego

Institute of Peace and Justice, San Diego, CA

For a map, see <http://peace.sandiego.edu/about/directions.html>

Registration:

Only those who pre-register will receive a pre-printed name badge and Booklet of Materials

For Registration Information, see our web page at www.sdipla.org or www.biosf.org.

OR to register by mail, please complete the registration form on page 5

Pre-Registration Pricing (prior to 11:55 PM, Sunday October 16th, 2005)

- \$225 Non-Members
- \$200 for members of the State Bar of California (IP Law Section) and SDIPLA members
- \$100 full-time students & post docs

On-Site Registration

\$250

~ October Meetings continued from page 3

~WEDNESDAY, OCTOBER 19TH

BIO SCIENCE FORUM ~ SPECIAL SYMPOSIUM

“USPTO TECHNOLOGY CENTER 1600 WEST COAST ROAD SHOW 2005”

Technology Center 1600 Road Show
October 18-20, 2005

Biographies and Abstracts of Presenters

Jasemine C. Chambers

Jasemine C. Chambers is a Director in Technology Center 1600 at the USPTO overseeing the examination of biotechnology, pharmaceuticals, and organic chemistry patent applications. Her previous appointments include serving as a law clerk to the Honorable Randall R. Rader at the U.S. Court of Appeals for the Federal Circuit, as a Senior Policy Analyst at the White House Office of Science and Technology Policy, and as a Senior Staff Fellow at the National Institutes of Health. Jasemine holds a PhD in Molecular Biophysics from the Florida State University, and a JD with Honors from the George Washington University Law School. She is a member of the Maryland state bar and the District of Columbia bar, and is admitted to practice before the U.S. Supreme Court and the Court of Appeals for the Federal Circuit.

Abstract ~ TC 1600 Overview and Restriction Reform Update (Chambers)

An overview of the recently published Green Paper on USPTO study on restriction reform and a quick update of TC1600 restriction practice action plan will be presented.

Brenda Brumback

Brenda Brumback is a Supervisory Patent Examiner for Art Unit 1647 in Technology Center 1600 at the USPTO overseeing the examination of patent applications dealing with receptors, cytokines, cell signaling, and neurobiology. She joined the USPTO in 1996 and became a Supervisory Patent Examiner in 2002. Prior to joining the PTO, Brenda worked in biotechnology industry, where she managed a diagnostic virology laboratory. Brenda has a BS in Biology from Longwood College and completed graduate studies in Microbiology, Virology, and Immunology from George Mason University and The FAES at the NIH.

Abstract ~ Claim interpretation (Brumback)

The name of the game is the claim. Now what does that claim mean? What is covered, what is not? Discussion of how examiners interpret claim and some pointers on language to avoid.

Gary Jones

Gary Jones is a Supervisory Patent Examiner

for Art Unit 1634 in Technology Center 1600 at the USPTO overseeing the examination of patent applications drawn to hybridization assays, nucleic acid probes and primers. He holds a B.S. in Animal Science and an M.S. in Chemical Engineering and performed mutagenesis assays for Litton Bionetics prior to joining the PTO as a Patent Examiner in May 1983. He has been a Supervisory Patent Examiner since January 1992, and the supervisor of his current art unit since May 1995. Gary has also most recently served as one of the four main patent examination resources of the Image File Wrapper Implementation team, facilitating the conversion of patent examination from a paper to a fully electronic process.

Abstract ~ Electronic filing of patent applications (Jones)

The Electronic Filing System will be upgraded to a web based system which will allow simple, safe filing of Patent applications, Information Disclosure Statements and computer readable form bio-sequence listings.

~continued on page 5

OCTOBER 19th SYMPOSIUM MEETING

Date/Time/Location:

October 19, 2005

All day event

Joan B. Kroc Institute for Peace & Justice—

University of San Diego

5998 Alcalá Park, San Diego, CA 92110

Phone: 619.260.7509

<http://peace.sandiego.edu/>

Speakers

Jasmine Chambers, Ph.D., J.d., Director

Gary Jones, Supervisory Patent Examiner

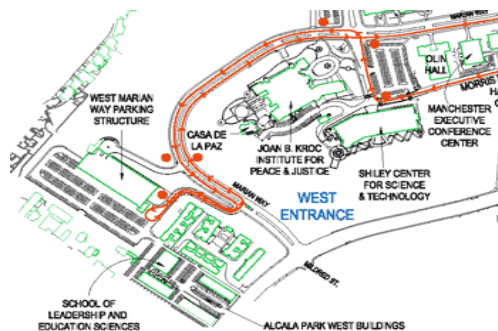
Brenda Brumback, SPE

Joseph K. McKane, SPE

Deborah J. Reynolds, Quality Assurance Specialist

Andrew Wang, SPE

Directions:

> <http://peace.sandiego.edu/about/directions.html>

Biographies and Abstracts of Presenters

~ continued from page 4

Joseph K. McKane

Joseph McKane is a Supervisory Patent Examiner for Art Unit 1626 in Technology Center 1600 at the USPTO overseeing the examination of patent application dealing with heterocyclic compounds. He joined the USPTO in 1989, and became a Supervisory Patent Examiner in 1999. Joe has a dual degree in Biology and Chemistry and a minor in business from the University of Scranton.

Abstract ~ Chemical polymorphs and isomers (McKane)

Crystalline forms including x-ray diffraction patterns of known chemical compounds and isomers including racemic mixtures and enantiomers of known chemical compounds, how to distinguish over the art, and how an examiner analyzes the claim regarding activity and whether or not a rejection is appropriate.

Deborah J. Reynolds

Deborah Reynolds is a Quality Assurance Specialist for Technology Center 1600. Deborah came to the USPTO in July 1996, progressed to Primary Examiner in July of 2000 and was promoted to Supervisory Patent Examiner in November of 2000. Deborah holds a B. of S. in Chemistry from Pikeville College, Pikeville, Kentucky. She worked in the Biochemistry Department at Uniformed Services University from 1989 to 1992. In

1992 she began working at the National Institute of Allergies and Infectious Diseases, NIH.

Abstracts ~ New matter training module for examiners (Reynolds)

Examiners in TC1600 received training on New Matter recently. You will see first hand the materials used in this training and will discuss examples.

Written description (Reynolds)

Discussion of how examiners analyze claims for written description and a few examples of analysis when the claims recite "% identity".

Andrew Wang

Andrew Wang is a Supervisory Patent Examiner for Art Unit 1639 in Technology Center 1600 at the USPTO. Andrew joined the USPTO in 1996 and became a Supervisory Patent Examiner in 2002. He has a BS in Biology and a MS in Molecular Biology from Temple University in Philadelphia.

Abstracts ~ Sequence listings and incorporation by reference under 37 CFR 1.57 (Wang)

Discussion of new rule 37 CFR 1.57 and how it applies to disclosure of sequences.

Examination issues when claiming microarrays (Wang)

Discussion of examination issues that include utility, written description, enablement, and prior art, that arise during prosecution of claims drawn to microarray or biochip technology.

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

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 for more information about these committees and SDIPLA.

Please mail your Pre-Registration form for the October 19th Symposium to Robert Prince at the address indicated on the form *no later than Sunday, October 16, 2005.*

Mail-in Pre-Registration* Form for October 19, 2005 Symposium

Name: _____ E-Mail Address: _____

Firm/Employer: _____

Telephone Number: _____

Send check or money order **payable to SDIPLA** to:

- \$225 - Non-Member
- \$200 - SDIPLA/CA State Bar IP Section
- \$100 - Student/Post Docs

*Note: On-site registration fee will be \$250

~ Buffet Lunch provided ~

Robert Prince

SDIPLA Secretary
c/o Salmedix, Inc.
9381 Judicial Drive, Suite 160
San Diego, CA 92121

DEADLINE FOR REGISTRATION IS SUNDAY, OCTOBER 16, 2005

Reservation Form for October 18, 2005 Meeting

“Recent Developments in USPTO Rules & Procedures”

BY: ROBERT J. SPAR, DIRECTOR, OFFICE OF PATENT LEGAL ADMINISTRATION AT THE USPTO

Tuesday, October 18th, 2005

Registration starts at 6:00 p.m.

Dinner starts at 6:45

Presentation starts at 7:15 p.m.

The Menu

Halibut Macadamia

Fresh Halibut Filet with crushed Macadamia Nuts. Presented with a Rum Raisin Glaze served with Stir Fried Rice.

Chicken La Jolla

Breast of Chicken marinated in Rosemary, Olive Oil and Garlic. Broiled. Rosemary and Lemon Zest garnish. Herbed Couscous accompaniment

Grilled Vegetable Pasta

An array of Sautéed and Grilled Seasonal Vegetables lightly tossed with Fresh Herbs and Spinach Fettuccini in a Light Cream Sauce.

Salad—Mixed Field Greens

Dessert—Old fashioned NY Cheesecake w/ Strawberry Coulis

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, and send it **WITH YOUR CHECK MADE PAYABLE TO ‘SDIPLA’** to:

Robert Prince
SDIPLA Secretary
c/o Salmedix
9381 Judicial Drive, Suite 160
San Diego, CA 92121
(858) 622-2160
Fax: (858) 320-5060
rprince@salmedix.com

Please include:
lchristiansen@salmedix.com on all e-mail reservations.

Please complete separate form for each attendee.

REMINDERS

- Please mail, fax, or e-mail your reservation to Robert Prince at the address, fax, or e-mail address indicated for receipt *no later than Friday, October 14, 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 Meeting PRICES

\$40.00 SDIPLA Member

\$50.00 Non-Member

Reservation Form for October 18th Dinner Meeting

Name: _____

E-Mail Address: _____

Firm/Employer: _____

Telephone Number: _____

Member of SDIPLA? (circle one) YES NO

Halibut

Chicken

Vegetable

DEADLINE FOR REGISTRATION IS FRIDAY, OCTOBER 14, 2005

MEMBERSHIP RENEWAL

Name: _____ E-Mail Address: _____
(required to receive newsletters)

Firm/Employer: _____

Mailing Address: _____

City/State/Zip: _____

Telephone Number: _____

Send check or money order payable to SDIPLA Dues to: Robert Prince

Attorney Member Dues: \$50/year SDIPLA Secretary

Non-Attorney/Retired Attorney Dues: \$25/year Salmedix, Inc.

(e.g. law students, paralegals, patent agents, retired attorneys, etc.) 9381 Judicial Drive, Suite 160
San Diego, CA 92121

Please Renew Your Membership for 2005-2006

All SDIPLA members are asked to send in their membership dues, if they have not already, using the Membership Renewal form above.

- E-Mailing of newsletters and notices will replace regular mailing.
- Members who have not renewed membership by **November 30, 2005**, will be **removed** from the active member mailing list.
- SDIPLA had approximately 275 active members in 2004-2005.
- **On-line registration now available– visit www.SDIPLA.org.**
- SDIPLA would like to increase active membership, including significantly in-house practitioners.
- SDIPLA welcomes any suggestions to make the renewal process more efficient.
- SDIPLA welcomes any suggestions to increase membership.
- If you have suggestions, please do not hesitate to contact one of the officers.

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 Rob Prince if you would like to place an ad or announcement.

| Date | Event | Speaker/Topic |
|------------------|------------------------|---|
| October 18, 2005 | SDIPLA dinner meeting | Bob Spar/Recent Rule Changes and Developments in the PTO Rules |
| October 19, 2005 | SDIPLA all day meeting | PTO Technology Center 1600 Road Show/Topics include restriction reform, electronic filing of patent applications, sequence listings and incorporation by reference, new matter training module for examiners, claim interpretation, written description, examination issues associated with microarray applications, chemical polymorphs and isomers. |
| November 2005 | SDIPLA meeting | TBA |
| December 8, 2005 | SDIPLA Holiday Party | Holiday Party/Awards Presentation |

Intellectual Property Litigation

Cooley Godward LLP's San Diego office currently has openings for intellectual property associates with 2 to 5 years of patent litigation experience in the following areas:

Electrical Engineering
Biotechnology

High-quality academic credentials and writing skills required; technical degrees are preferred (but not required); patent prosecution experience may substitute in part for litigation experience.

Please submit resumes and transcripts to:

Septina McDonnell
Attorney Recruiting Manager

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 November 1, 2005.

| | | | | |
|-------------------------|--------------|-----------------|--------------------|-----------------|
| Morgan Adessa | Thane Banz | Amy Bathke | Ethan Boyer | Laura Collins |
| Maryanne Deangelo | Karen B. Dow | Samir Elamarari | Bernard Greenspan | John Grohs |
| Megan Jamroz | Jae Hong Lee | Mary Lee | Jinn-Nan Lin | Bin Liu |
| Penelope Long | Ann Lygas | Daryl Muenchau | Lauren W. Nguyen | Ellen Nudelman |
| Sara O'connell | Milan Patel | Eric Peterson | Steven C. Petersen | Kayla Seignious |
| Patricia A. Shackelford | Astrid Spain | Eric Vieira | Kathryn Waer | |

ARTICLES: If you have an article for the newsletter, please send it to Rob Prince.

DUES: To pay or renew your membership dues: Please use the form on page 7, and send form via mail or fax to Rob Prince. - online registration now available - visit www.SDIPLA.org.

Announcements (continued)

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 Rob Prince if you would like to place an ad or announcement.



TM/SM Orange County Patent Law Association

P.O. Box 7632, Newport Beach, CA 92658

WIPO PCT SEMINAR

Monday and Tuesday, October 24 and 25, 2005

SPACE IS LIMITED—FIRST COME, FIRST SERVED!

The OCPLA sponsored PCT Seminar will be taught by Mr. Matthias Reischle, Senior Legal Officer of the PCT Legal Affairs Section and an additional lecturer to be announced. This seminar is suitable for attorneys or paralegals who have only limited knowledge of the PCT System. Because of the recent significant changes in the PCT, this seminar is also recommended for those with considerable PCT experience. The speakers will answer questions and address more advanced topics as time and audience preference dictate.

The seminar will run from 9:00 AM to 4:00 PM each day with a one-hour lunch break. Please arrive by 8:30 AM to enjoy the included continental breakfast. The seminar will be held at Whittier Law School in Costa Mesa, CA. Directions will be sent to enrolled attendees. Or check their web site at www.law.whittier.edu.

Cost for the two day seminar which includes two continental breakfasts, two lunches and instructional materials in the form of a CD-ROM which includes printable PDF files of the materials is only \$250 for members of the OCPLA, SDIPLA or LAIPLA or for their sponsored guests who can attend in the member's place (e.g., a member may attend OR send one guest in his or her place) and \$290 for non-members.

Rooms will be available at the Wyndham Hotel in Costa Mesa (\$119 per night—mention the OCPLA) or at the Westin South Coast Plaza (\$180 per night—mention the Whittier Law School). Please make your reservations as early as possible.

Your reservation will not be secured until full payment is received. Cancellation refunds are available until Oct. 15, 2005. Please fax or email the form on page 2 and mail your check (made payable to the OCPLA) to:

Stefan Kirchanski
 LINER YANKELEVITZ SUNSHINE & REGENSTREIF LLP
 1100 Glendon Ave., 14th Floor
 Los Angeles, CA 90024
 Phone: 310 5003548
 Fax: 800 708-1593
 Email: skirchanski@linerlaw.com

Secretary: Heather Centurioni, 310 500-3541

The OCPLA has been approved as a continuing legal education provider for Minimum Continuing Legal Education credit by The State Bar of California. The two-day PCT seminar provides 12 hours MCLE.

~ Enrollment form page 10

Announcements (continued)

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 Rob Prince if you would like to place an ad or announcement.

OCPLA PCT Enrollment Form

\$250 for members or sponsored guests; \$290 for non-members

Please submit a separate form for each attendee

Name: _____

Firm: _____

Telephone: _____

Email or Fax: _____

Member (yes/no): _____

If claiming guest rate,
name of sponsoring member: _____

Check Number: _____ Amount of Check _____

Note for a paper version of the materials, please add \$30.00 per copy.

Please provide ___ paper copies of the material; I have enclosed \$30.00 per copy.