



SDIPLA News

**SDIPLA DINNER EVENT, THURSDAY, MAY 29, 2008 AT 6:00 P.M.
U.S. DISTRICT COURT JUDGES RUDI BREWSTER, MARILYN HUFF AND DANA SABRAW
AND MAGISTRATE JUDGE CATHY BENCIVENGO
“VIEWS FROM THE BENCH AND PRACTITIONERS”
MARRIOTT DEL MAR - LAST EVENT OF THE 2007-2008 TERM**

TOPICS: The impact of *KSR* to patent cases, the impact of the Southern District's local patent rules on how cases are handled (an open discussion between judges and practitioners), the Federal Circuit decisions on the Northern District local patent rules, the Judges' likes and dislikes in the courtroom, practitioners' suggestions for the Judges, and possibly some statistics on the number of court filings and the number of settled cases. There will be note cards available at the event for you to write questions to the panel. Distinguished trial lawyers Doug Olson of Duane Morris and Steve Swinton of Latham & Watkins will moderate.

PANEL: **Judge Rudi M. Brewster** is a Senior United States District Court Judge for the Southern District of California. Judge Brewster was appointed to the bench on June 29, 1984 by President Ronald Reagan. Judge Brewster has a particular interest in patent cases and has presided over numerous Markman hearings and patent trials. His enthusiasm for patent cases is well documented and observed. Judge Brewster earned his Bachelor of Arts degree from Princeton University in 1954 and a Doctor in Jurisprudence degree in 1960 from Stanford University in Palo Alto, California.

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May 29, 2008 — Marriott Del Mar:

Date/Time/Location: **NOTES:**

May 29, 2008
6:00 p.m.—8:30 p.m.
Marriott Del Mar
11966 El Camino Real
San Diego, CA 92130

Directions:

From I-5 S to Del Mar Heights Rd.;
Turn left, right on El Camino Real, right side of street
From I-5 N to Carmel Valley Rd.;
Turn right, left on El Camino Real, left side of street

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SDIPLA Board of Directors

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District Judge Marilyn L. Huff was appointed to the bench in 1991 by President George Herbert Walker Bush. Judge Huff has presided over numerous patent trials. She has served as the Chairperson for the Conference of Chief Judges for the Ninth Circuit and on the Ninth Circuit Judicial Council in that capacity. Additionally, Judge Huff has served as the Chairperson of the Judicial Conference Statistics Subcommittee and has been a member of the U.S. Judicial Conferences Judicial Resources Committee. Judge Huff earned a Bachelor of Arts degree in 1972 from Calvin College in Grand Rapids, Michigan and a Doctor of Jurisprudence degree in 1976 from the University of Michigan Law School in Ann Arbor, Michigan.

District Judge Dana M. Sabraw was nominated to the federal bench in May 2003 by President George W. Bush, and was unanimously confirmed by the U.S. Senate. Judge Sabraw served as Chair of the Court's Patent Advisory Committee, which was responsible for promulgating the local rules of practice for patent cases before the Southern District Courts. He is also a founding member of two American Inns of Court, the Clifford J. Wallace Inn and the Oliver Wendell Holmes, Jr. Inn. Judge Sabraw currently serves as President of the Wallace Inn of Court.

Magistrate Judge Cathy A. Bencivengo was appointed a magistrate judge for the Southern District of California on December 5, 2005. Prior to that appointment, she was in private practice as an associate and partner at DLA Piper in San Diego (formerly Gray Cary Ware & Freidenrich) from 1998-2005. Judge Bencivengo earned her B.A. in Political Science and Journalism and M.A. in Political Science from Rutgers University in 1980 and 1981, respectively, and her J.D. from the University of Michigan Law School in 1988.

Moderator: Douglas E. Olson is a partner at Duane Morris LLP in its San Diego office with thirty plus years of litigation and trial experience in the pharmaceuticals, genetic engineering, medical devices, and semiconductor industries and specializes in intellectual property. He earned a B.S. and M.S. in Chemical Engineering from the University of Wisconsin in Madison, WI.

The SDIPLA thanks our Sponsors for the monthly meetings:

Knobbe Martens Olson & Bear LLP
www.kmob.com

Townsend and Townsend and Crew LLP
www.townsend.com

(listed alphabetically)

Mr. Olson is a graduate of The George Washington University Law School, where he served as Editor, *Law Review* and elected to the Order of the Coif. Mr. Olson previously served as a law clerk to the predecessor of the U.S. Court of Appeals for the Federal Circuit. He is admitted to practice before the United States Patent and Trademark Office and California.

Stephen P. Swinton is a partner at Latham & Watkins in its San Diego office. He concentrates his practice in complex litigation involving patent rights and related intellectual property matters in various industries including software, electronics, pharmaceutical, biotechnology, medical device, semiconductor, and telecommunications. Mr. Swinton earned a Bachelor of Science degree in Chemical Operations from Iowa State University and a J.D., with honors, from Drake University. He previously served as an extern to the Hon. Roy L. Stephenson, Judge, U.S. Court of Appeals, Eighth Circuit. He is admitted to practice before the United States Patent and Trademark Office and California.

Internet Sightings by Jim Hawes (continued p. 5)

This column highlights some of the more notable recent internet notices, newsletters and blogs dealing with IP prosecution issues. It is a distillation by this publication's editor of the submitted IS column. If you would like to receive the full column directly by email, write onejehawes@aol.com.

Hal Wegner's newsletter – Contact: hwegner@foley.com to subscribe.

- The 4/1/08 message states that at least 8 of the 11 CAFC judges are now or will be eligible for senior status within the next two years.
- Another 4/1/08 mailing reports that the ED Va Court in the *Tafas* case has held the PTO's continuation rules to be void as beyond the PTO's authority. But don't throw away all your new continuation rule plans just yet. The PTO may appeal - see Hal's 4/2/08 newsletter.
- The 4/7/08 newsletter discusses 10 years of experience with the Japanese doctrine of equivalents.
- Two 4/8/08 offerings continue Hal's running criticism of the accelerated examination fiasco at the PTO. In the second, Hal suggests that the PTO is cooking the books. See – IP practice can be fun.
- The 4/9/08 message points out that the PTO has not yet issued a final, appealable decision in *any* inter partes reexamination. So much for "special dispatch."
- The 4/11/08 issue states that, contra to Hal's prayers, the Leahy patent reform bill may make it to the floor for a vote, possibly even in a week or two. Oh, oh. (That now looks to be very unlikely – Ed.)
- Another 4/11/08 posting gives Hal's current top ten list of cases on appeal. It was updated by Hal on 4/17/08 and 4/21/08.
- Still another 4/11/08 message discusses the PowerOasis CAFC decision affirming denial of priority to a CIP and pointing out that a priority filing date does not apply to subject matter obvious over what is expressly disclosed. See also *Patently-O* for 4/14/08.
- And yet another 4/11/09 offering discusses the Symantec CAFC decision and when a claim's preamble is a limitation. *Patently-O* discusses the decision in its 4/15/08 posting.
- The 4/16/08 posting discusses the Zenith CAFC decision, the latest bucket of mud dumped by the Court into patent law waters. It concerns the now-questionable axiom: If it infringes if later, it anticipates if earlier.
- The 4/17/08 message discusses the unconstitutionality of PTO Boards, some recent challenges to Board decisions on this basis, and some PTO efforts to fix the problem.

Reservation Form for May 29, 2008 Dinner Meeting

MAY 29, 2008, 6:00 P.M. DINNER MEETING
U.S. DISTRICT COURT JUDGES RUDI BREWSTER, MARILYN HUFF AND DANA SABRAW
AND MAGISTRATE JUDGE CATHY BENCIVENGO
MARRIOTT DEL MAR

Thursday
May 29, 2008
Marriott Del Mar

Cocktails 6:00 p.m.
 Dinner 6:45 p.m.
 Presentation 7:30 p.m.

The Menu
 Bibb & baby lettuce salad
 Choice of the following entrees:

Deep-Seared Salmon
 With potatoes
 ** OR **

Roasted Lemon-Rosemary Chicken
 With Vegetables
 ** OR **

Vegetarian
 And
Dessert
 Chocolate Mousse Cake

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

Jessica Mitchell
 SDIPLA Secretary
 Neil, Dymott, Frank, McFall & Trexler
 1010 Second Avenue, Suite 2500
 San Diego, CA 92101
 (619) 238-2255
 Fax: (619) 238-1562
 jmitchell@neildymott.com

On-line reservation available– go to www.acteva.com and search for SDIPLA or follow the link at www.SDIPLA.org

REMINDERS

- Please mail, fax, or e-mail your reservation to Jessica Mitchell at the address, fax, or e-mail address indicated for receipt **no later than May 26, 2008, 5:00 p.m.**
- The reservation deadline is dictated by the hotel and not by the SDIPLA.

NOTE MEAL PRICES

Member: \$55.00
Non-member: \$65.00

Please fill out a separate form for each attendee.

Registration

Name: _____ E-Mail Address: _____

Firm/Employer: _____

Telephone Number: _____

Member of SDIPLA? (circle one) YES NO

Entrée Choice: _____ Deep-Seared Salmon _____ Roasted Lemon-Rosemary Chicken _____ Vegetarian _____

Internet Sightings

by Jim Hawes



Patently-O – a blog written by Dennis Crouch – www.patentlyo.com.

- The 4/1/08 blog discusses the Agrizap CAFC decision showing why NOT to file a terminal disclaimer in response to a 103 rejection.
 - The 4/2/08 issue gives a thorough discussion of the Tafas decision with relevant attachments.
 - The 4/8/08 blog discusses the Akira decision of the CAFC which answers the question – while patent assignments must be in writing, do intestate transfers need be in writing? The Court’s answer – NO.
 - The 4/10/08 issue considers some of the briefs in the en banc Biliski case before the CAFC. Oral argument is scheduled for May 8.
 - The 4/11/08 blog cites a new patent searching site – priorsmart.com. Check it out.
 - The 4/12/08 message reports that the PTO has issued a new set of written description training materials for examiners with 17 mostly biotech examples covering 60 plus pages.
 - The 4/17/08 posting discusses the Translogic BPAI decision now on its way to the Supreme Court for the inclusion on the BPAI panel of an assertedly unconstitutional judge.
 - The 4/23/08 blog discusses the Finistar CAFC decision and its requirement that means plus function clauses in claims require some (even minimal) support in the specification.
- The 4/25/08 message includes a reminder that the CAFC has an active mediation program. Recent statistics are given.

IP law 360 – a newsletter covering all IP, but focusing mainly on litigation – web address: www.iplaw360.com

- The 4/2/08 issue reports that WIPO has cut its patent application fees.
- The 4/7/08 newsletter includes a discussion of how the KSR decision has forced prosecutors to “step up their own game.”
- The 4/8/08 message reports that two Chinese companies face record damages for enabling the downloading of copyrighted music. Query: when an ISP located in country A posts on the web a file that is unprotected in A but which is requested by a site in country B, where downloading violates rights, which law applies – A or B?
- The 4/17/08 issue includes an observation that IPOs for IP law firms are on the way.
- The 4/28/08 newsletter includes a guest column which asks if the enablement bar has been set too high by recent decisions.



Employment Situation Available (cont. p. 7)

Patent Agent/ Attorney Req #463

Innovation is in our genes.

Illumina (NASDAQ: ILMN) develops next-generation tools for large-scale analysis of genetic variation and function. The results will pave the way for personalized medicine, a key goal of genomics and proteomics – the underpinnings of tomorrow's medicine. With thought-provoking work and people inspired to reach new levels of creativity, the potential to help mankind is the great motivator for the staff at Illumina. We thrive on an environment that is intellectually stimulating, team-oriented and responsive. We enjoy cutting-edge technology, excellent training, industry-leading benefits, and a strong belief in ethical behavior – and each other. Oh, and fun. Lots of it.

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Job Summary:

This individual will work in a team environment to prepare and prosecute company patent applications, evaluate intellectual property landscapes around research projects, and assist with intellectual property aspects of licensing and research agreements.

Job duties include but are not limited to:

- Identify and evaluate patentable inventions emerging from dynamic, multi-disciplined research projects.
- Prepare and prosecute patent applications in-house.
- Assist with evaluation of intellectual property landscapes and freedom to operate analyses.
- Manage outside counsel involved in patent prosecution and freedom to operate analyses.
- Assist with intellectual property aspects of licensing and research agreements.

Employment Situation Available (cont.)



Education and Experience:

- Strong background in at least one of the following technical areas: biochemistry, molecular biology, bioinformatics, mechanical engineering, electrical engineering or chemical engineering; and must be comfortable interfacing with technical personal while performing job duties related to all of these technical areas.
- Strong knowledge of all aspects of patent law.
- Minimum of 3 years experience as a registered patent agent.
- Law firm experience preferred.
- PhD in relevant technical area preferred.

To apply, please go to the careers page on our website via the link posted below and click on “search jobs”

www.illumina.com/careers

EOE

About Illumina:

At Illumina, its goal is to apply innovative technologies and revolutionary assays to the analysis of genetic variation and function, making studies possible that were not even possible just a few years ago.

Illumina has developed a comprehensive line of products that address the scale of experimentation and the breadth of functional analysis required to achieve the goals of molecular medicine. Its offering includes leading-edge solutions for:

- SNP genotyping
- Copy number variation
- DNA methylation studies
- Gene expression profiling
- Low-multiplex analysis of DNA, RNA, & protein



The SDIPLA Board's Selection of Kenneth E. Jenkins as its Nominee for the Board

The SDIPLA Board is pleased to announce its selection of Kenneth E. Jenkins as its nominee for the new member of the Board. The Board believes that Ken's consistent enthusiasm, eagerness, and proactive efforts to generously volunteer his time to the SDIPLA, including assisting the Board at monthly events and sponsorship matters will prove to be a valuable resource to the SDIPLA Board.

SDIPLA Nominee:**Statement of Kenneth E. Jenkins for Treasurer**

After beginning my career in the San Francisco Bay Area, I joined the San Diego IP community in 2004 and became an active member of SDIPLA shortly thereafter. Since then, I have consistently enjoyed insightful continuing legal education presented by nationally recognized speakers courtesy of SDIPLA. In addition to providing helpful presentations on the latest IP developments, SDIPLA provides an open and relaxed forum to interact with members of the San Diego IP community. As a transplant to the San Diego region, I have been especially impressed and appreciative of the collegial atmosphere fostered by SDIPLA in its monthly meetings. By providing accessible continuing legal education and serving as a major hub for IP law discussion in San Diego, SDIPLA has served as an invaluable resource to the local IP community. As Treasurer, my goal will be to work closely with the other members of the Board to insure SDIPLA continues to grow and provide indispensable service to the San Diego IP community.

Background

I am currently Special Counsel at Townsend and Townsend and Crew LLP, where my practice focuses on patent counseling and patent litigation, primarily in the chemical and biosciences industries. I received my J.D. from the University of California, Hastings College of the Law while externing for the Hon. Phyllis J. Hamilton of the United States District Court for the Northern District of California. I earned my Ph.D. in Chemistry and Biochemistry from the University of Colorado at Boulder under the direction of Dr. Marvin H. Caruthers. And I received my B.S. degree in Chemistry and Biochemistry from the University of Texas at Austin.

Kenneth E. Jenkins

MEMBERSHIP/RENEWAL APPLICATION

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: Jessica S. Mitchell

Attorney Member Dues: \$50/year SDIPLA Secretary

Non-Attorney/Retired Attorney Dues: \$25/year Neil Dymott Frank McFall & Trexler, PC

(e.g. law students, paralegals, patent agents, retired
attorneys, etc.) 1010 Second Ave, Suite 2500

San Diego, CA 92101

Notes Regarding Your Membership

- E-Mailing of newsletters and notices has replaced regular mailing.
- **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.

PROXY VOTE FOR THE SDIPLA BOARD 2008 ELECTION

Please mail or email your proxy vote by Tuesday, May 27, 2008 to SDIPLA Secretary Jessica S. Mitchell.

POSITION

SDIPLA BOARD'S NOMINEE

Past President	Robert W. Prince
President	Boris Zelkind
Vice President	Jessica S. Mitchell
Secretary	John E. Peterson
Treasurer	Kenneth E. Jenkins

Name: _____

Please check one of the circles below:

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

(position)

(name)

Date	Event	Speaker/Topic
May 29, 2008	Dinner Meeting at Marriott Del Mar and Board Election	U.S. District Judges Brewster, Huff, and Sabraw and Magistrate Judge Bencivengo will discuss various IP topics.