

San Diego Intellectual Property Law Association

SDIPLA News

Two Really Hard issues In Patent Litigation

President's Opening Remarks - Richard C. Kim

It is with great pride and enthusiasm that I take on the role of President of the San Diego Intellectual Property Law Association (SDIPLA) for the 2002-2003 fiscal year. In the past seven years that I have been a member of this organization, including the past three years as a member of the Board of Directors, I have seen the SDIPLA

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Michael A. Jacobs, Esq.

About the topic:

Mr. Jacobs' presentation will address two difficult issues in current intellectual property litigation practice: 1. What are the practical implications of the willfulness rules, especially given the CAFC's emphasis on the role of opinions of counsel? When do we get opinions and how do we use them? 2. How will evolving standards for qualifying experts and their testimony in federal civil litigation affect the use of experts in intellectual property litigation? Should we anticipate more *Daubert* motions to exclude such testimony?

About the speaker:

Michael A. Jacobs joined Morrison & Foerster in 1983 and is a partner in its San Francisco office. He has served as co-head of the firm's 140-person Intellectual Property Group since its founding in 1990. He also served as the firm's Managing Partner for Operations from 1995 to 1997.

Mr. Jacobs has concentrated

Date/Time/Location:

SEPTEMBER 26, 2002
6:00 p.m.—8:30 p.m.
La Jolla Marriott
4240 La Jolla Village Drive
La Jolla, California
858-587-1414

his practice on litigation of high-technology and intellectual property matters. Representing a broad array of clients, Mr. Jacobs has helped to shape the laws governing the emerging information and entertainment technologies. He led the technical team that represented Fujitsu Ltd. in its landmark operating system software arbitration with IBM. On behalf of several motion picture companies, Mr. Jacobs managed a litigation team in the *On Command Video* case, which established that video "on demand" performances must be licensed under the copyright public performance right.

Mr. Jacobs has litigated a wide range of patent and trade secret disputes in the IT field, representing companies such as *Novell* (client-server architectures), *Chips and Technologies* (memory controllers), *Cirrus Logic* (video/graphic display controllers), *Scientific Learning* (auditory dyslexia software), *Altera* (programmable logic devices), *Visa* (credit card incentive programs), *Greenleaf Medical* (hand evaluation software and virtual reality technologies), *Evolve Software* (a B2B company providing a Web-based system for managing the operations of systems integrators), *DoubleClick* (Internet advertising management), and *Yahoo!* (fantasy football programs). He also currently represents *Intel* in a case involving the sending of mass e-mails to Intel employees by a disgruntled former employee, *Verio* in a dispute with

Register.com concerning the use of the WHOIS domain name database for marketing purposes, and *Yahoo!* in a case concerning the sale of counterfeit items on auction sites.

Mr. Jacobs also concentrates his IP litigation practice in the area of life sciences. He has represented Chiron in patent disputes concerning HIV and Hepatitis C, *Kaiser Permanente* in a patent dispute concerning the use of HCG in prenatal screening, and *Imagyn* in a multi-patent dispute with U.S. Surgical concerning breast biopsy and endoscopic surgical devices. He also represented *Yoshitomi Pharmaceuticals* in a licensing dispute involving recombinant human serum albumin.

Mr. Jacobs is co-author, with Professor Donald Chisum, of *World Intellectual Property Guidebook, United States*, published in 1992 by Matthew Bender & Company, New York. He has served as a member of the editorial board of the *Association of Business Trial Lawyers, Northern California*, for which he wrote a periodic column on intellectual property litigation. Mr. Jacobs also served as USA Editor for *Intellectual Property Reports*, published by Butterworths Australia, and as Chairman of the Computer Program Copyright Protection Subcommittee of the American Bar Association's Section on Patent, Trademark and Copyright Law. A native of New York City, Mr. Jacobs received his B.A. degree from Stanford University in 1977, graduating Phi Beta Kappa with honors in history. He then entered the United States Foreign Service, where he held assignments in Kingston, Jamaica, and Washington, D.C. In 1983, Mr. Jacobs received his J.D. degree from Yale Law School and was a Senior Editor of *The Yale Law Journal*.

Directions:

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

I-805 to La Jolla Village Drive,
1 mile west

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President's Opening Remarks:

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grow to over 475 registered members. Thanks to the dedication and leadership of my predecessors and the Board members that served under them, the SDIPLA has grown to be among the largest intellectual property bar organizations in the country. As I have gotten to know many of SDIPLA's members I have come to realize the excellence and strength of the San Diego IP community. I am both humbled and proud to be part of such a great community.

This year, as always, a primary goal of the SDIPLA is to continue its long-standing tradition of providing valuable continuing legal education to its members by securing top-quality, nationally-recognized speakers to address the most current issues in intellectual property law. Another goal this year will be to "give back" to San Diego by assisting organizations that play a vital role in our community. In this spirit, the SDIPLA is planning to host its First Annual Charity Golf Tournament sometime in the spring of 2003 (still in the planning stages), with all profits to benefit the San Diego Volunteer Lawyers Program (SDVLP). Additionally, at this year's

SDIPLA Holiday Party scheduled for December 5th, the SDIPLA will recognize at least one individual who has made significant contributions to the San Diego community, particularly in the area of intellectual property.

The SDIPLA Board is continuing to work hard to provide improved and expanded services to its members. As many of you know, last year, the Board set up various committees such as the Awards Committee, Events Committee, Sponsorship Committee, Editorial Committee and Amicus Committee, to improve SDIPLA's ability to address the needs and desires of its members. Although start-up has been slow, these committees are becoming rooted and will play an important role in the future operation and effectiveness of the SDIPLA.

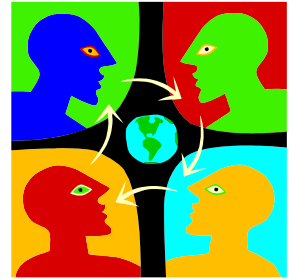
I look forward to an educational, productive and exciting 2002/2003 fiscal year. On behalf of the SDIPLA Board, thank you for your continued support and participation in our fine organization.

Richard C. Kim
SDIPLA President



Applicants for SDIPLA Membership

The following people 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 October 31, 2002.



Prem Advani	USD Law Student
Jodi L. Connolly	Heller Ehrman White & McAuliffe, LLP
Carolyn Erickson	Diversa
Neil D. Greenstein	Greenstein Law, P.C.
John S. Kyle	Procopio Cory Hargreaves & Savitch, LLP
Eleanor M.S. McCarthy	ACON Laboratories, Inc.
Quan Le Nguyen	Isis Pharmaceuticals, Inc.
Richard Rouse	UCSD
Tobey M. Tam	Heller Ehrman White & McAuliffe, LLP
Lee M. Taylor	USD Law Student

Membership Dues

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

Please Note that Due to the Costs of Regular Mailing, the Following Will Take Effect on November 30, 2002:

- E-Mailing of newsletters and notices will replace regular mailing unless a member specifically marks "YES" on the membership renewal form requesting otherwise.
- Members who have not renewed membership by November 30, 2002, will be dropped from the regular mailing list.

MEMBERSHIP RENEWAL

Name: _____ E-Mail Address: _____

Firm/Employer: _____

Mailing Address (for notices): _____

City/State/Zip: _____

Telephone Number: _____

Please continue to send newsletters, notices, etc., via regular mail: Yes No

Send check or money order payable to SDIPLA Dues to:

Attorney Member Dues:	\$50/year
Non-Attorney/Retired Attorney Dues:	\$25/year
(e.g. law students, paralegals, secretaries, retired attorneys, etc.)	

Vicki G. Norton
SDIPLA Secretary
c/o Brobeck, Phleger & Harrison
12390 El Camino Real
San Diego, CA 92130

Dinner Reservation Form

Michael A. Jacobs, Esq.

Two Really Hard Issues in Patent Litigation

THURSDAY

SEPTEMBER 26, 2002

San Diego Marriott La Jolla
Mixer 6:00 p.m. (No Host Bar)
Dinner 6:30 p.m.
Presentation 7:00—8:30 p.m.

The Menu

Mixed Green Salad with Balsamic Vinaigrette

With one of the following entrees:
Breast of Chicken with a Pinot Noir Glace

**** OR ****

Grilled Salmon Served with a Dill Sauce

**** OR ****

Pasta Primavera (vegetarian)

With
Chef's Selection of Accompaniments
and
New York Cheesecake, Raspberry 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, fill out the below registration, indicate your meal choice, and send it **WITH YOUR CHECK MADE PAYABLE TO 'SDIPLA'** to:

Vicki G. Norton

SDIPLA Secretary

c/o Brobeck, Phleger & Harrison

12390 El Camino Real

San Diego, CA 92130

Fax: (858) 720-2555

vnorton@brobeck.com

REMINDERS

- Please mail, fax, or e-mail your reservation to Vicki G. Norton at the address indicated for receipt **no later than Monday, September 23rd**.
- 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.

Please fill out a separate form for each attendee.

NOTE INCREASE IN MEAL PRICES

\$40.00 SDIPLA Member

\$45.00 Non-Member

Registration for September 26, 2002, SDIPLA Dinner

Name: _____ E-Mail Address: _____

Firm/Employer: _____

Telephone Number: _____

Member of SDIPLA? (circle one) YES NO

Dinner Choice:

Salmon

Chicken

Pasta

SDIPLA
c/o Vicki G. Norton
Brobeck, Phleger & Harrison, LLP
12390 El Camino Real
San Diego, CA 92130

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

Upcoming SDIPLA Events

Date	Event	Topic
10/24/02	Dinner Meeting: Don W. Martens, KMOB	Year-End Review of Patent Law
11/21/02	Dinner Meeting: TBA	TBA
12/5/02	SDIPLA Holiday Party @ L'Auberge	
January 2003	Dinner Meeting: TBA	TBA