



# SDIPLA News

## SDIPLA ANNOUNCES U.S. DISTRICT COURT, SOUTHERN DISTRICT MAGISTRATE JUDGE PANEL DISCUSSION

*Please join us on Thursday, February 26, 2009 at the  
**La Jolla Marriott**  
(Note location change — it is not at the Hyatt)*

U.S. Magistrate Judge Leo S. Papas, U.S. Magistrate Judge Anthony Battaglia and U.S. Magistrate Judge Cathy Ann Bencivengo, from the U.S. District Court for the Southern District of California, will participate in a panel discussion of many topics of interest to members, including electronic discovery, the local patent rules and the early neutral evaluation process.

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#### Date/Time/Location:

February 26, 2009  
6:00 p.m.—9:00 p.m.

La Jolla Marriott

4240 La Jolla Village Drive,  
La Jolla, CA 92037

#### Notes:

This is a dinner meeting.

#### Directions:

North on I-5. Exit La Jolla Village Drive  
(Turn Right)

Hotel is approximately 3/4 mile to east  
on left side.

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**U.S. DISTRICT COURT  
MAGISTRATE JUDGES  
PARTICIPATING ON THE PANEL:**

Hon. Leo S. Papas  
Hon. Anthony Battaglia  
Hon. Cathy Ann Bencivengo

Online registration is currently available at:  
<http://www.acteva.com>  
The deadline to register is Tuesday,  
February 24, 2009 at 5:00 p.m.  
Registration for SDIPLA members: \$55.00;  
nonmembers: \$65.00  
(See page 3 for additional info.)

***Please Join Us On Thursday, February 26, 2009  
For This Exciting Panel Discussion!!!***

The SDIPLA thanks our Sponsors for the  
monthly meetings:

**Knobbe Martens Olson & Bear LLP  
[www.kmob.com](http://www.kmob.com)**

**Perkins Coie LLP  
[www.perkinscoie.com](http://www.perkinscoie.com)**

**Townsend and Townsend and Crew LLP  
[www.townsend.com](http://www.townsend.com)**

(listed alphabetically)

# Reservation Form for February 26, 2009 Dinner Meeting

## Featuring U.S. Magistrate Judges From The U.S. District Court for the Southern District of California

**Thursday, February 26th  
Dinner Meeting**

### Torrey Pines Lodge

Registration starts at 6:00 p.m.  
Cocktails at 6:00 p.m.  
Dinner starts at 6:45 p.m.  
Panel Discussion at 7:15 p.m.

**The Menu**

Spinach and Arugula Salad

With one of the following entrees:

Herb-Crusted Bone-in Chicken

With Sage Roasted Mushrooms and Potatoes

\*\* OR \*\*

Lime-Marinated Salmon

With Mango Relish, Almond Rice

\*\* OR \*\*

Portobello Napoleon, Eggplant, Tri-colored Peppers

Served with buffalo mozzarella, tomatoes, potatoes

Chocolate Velvet Bombe

Coffee and Tea

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:

John E. Peterson  
SDIPLA Secretary  
Perkins Coie, LLP  
1620 26th St., 6th Fl. South Tower  
Santa Monica, CA 90404  
(310) 788-3346  
Fax: (310) 788-1272  
JEPeterson@PerkinsCoie.com

On-line reservation available— go to [www.acteva.com](http://www.acteva.com) and search for SDIPLA or follow the link at [www.SDIPLA.org](http://www.SDIPLA.org)

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

### REMINDERS

- Please mail, fax, or e-mail your reservation to John Peterson at the address, fax, or e-mail address indicated for receipt **no later than February 24, 2009**.
- The reservation deadline is dictated by the hotel and not by the SDIPLA.

### NOTE MEAL PRICES

SDIPLA members: \$55.00

nonmembers: \$65.00

## Registration

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

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

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

Member of SDIPLA? (circle one) YES NO

Entrée Choice: \_\_\_\_\_ Chicken \_\_\_\_\_ Salmon \_\_\_\_\_ Vegetarian

**MEMBERSHIP/RENEWAL APPLICATION**

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

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

(required to receive newsletters)

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

Mailing Address: \_\_\_\_\_

City/State/Zip: \_\_\_\_\_

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

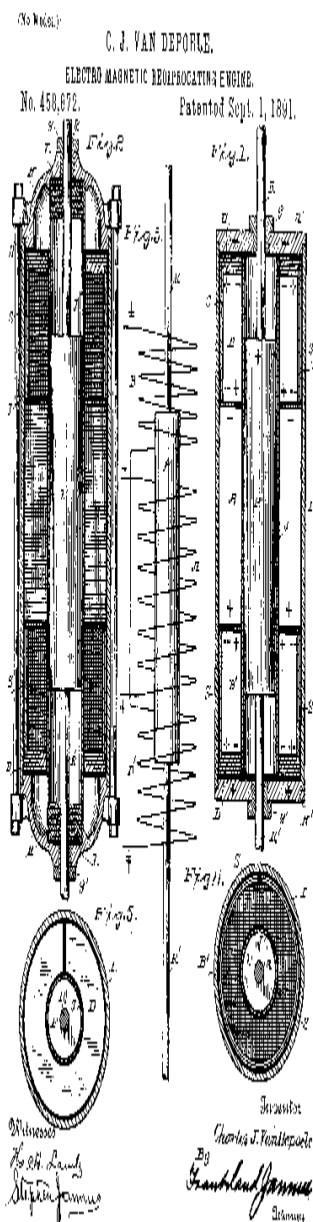
Send check or money order payable to SDIPLA Dues to: John E. Peterson

Attorney Member Dues: \$50/year SDIPLA Secretary

Non-Attorney/Retired Attorney Dues: \$25/year Perkins Coie, LLP

(e.g. law students, paralegals, patent agents, retired attorneys, etc.) 1620 26th St., 6th Fl. South Tower  
Santa Monica, CA 90404**Notes Regarding Your Membership**

- E-Mailing of newsletters and notices has replaced regular mailing.
- **On-line registration now available– visit [www.SDIPLA.org](http://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.



## Internet Sightings column for January/February 2009

Heading - *Internet Sightings* by Jim Hawes

This column highlights some of the more notable recent internet notices, newsletters and blogs dealing with IP prosecution issues. The full IS column, with compilations of some of the sources such as Hal Wegner's newsletter, is now up and available at [www.internetsightings.com](http://www.internetsightings.com). Check it out.

**Hal Wegner's** newsletter – a lot of great stuff – Contact: [hwegner@foley.com](mailto:hwegner@foley.com)

The 1/2/09 newsletter gives the first Top Ten listing in a new format. Subsequent listings were given on 1/4, 1/6, 1/9 (two), 1/12, 1/22, 1/24 and 1/28.

The 1/5/09 email reports a UCLA 1 hour plus audio interview with Chief Judge Michel of the CAFC about the presumption of validity, written disclosures, etc., and gives its online address.

The 1/8/09 message discusses the Kubin CAFC oral argument, and cites the web address for Dr. Noonan's summary of its obviousness and written description issues.

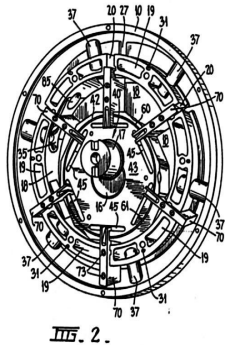
Another 1/8/09 email discusses two pending malpractice cases – Coin Acceptor (CAFC) and Parus Holdings (ND Ill).

A third 1/8/09 email addresses the split decision by the CAFC in the Vehicle IP case, and the ongoing claim construction mess.

Two 1/11/09 newsletters discuss BPAI petition decision difficulties identified by Pat-O, and the PTO's lame response.

The 1/12/09 email is one of a series discussing the PTO's possible move away from USPQ cites.

Another 1/12/09 email discusses the Frisket CAFC decision



denigrating secondary considerations as inadequate to overcome a strong showing of obviousness ( but this is dicta because the evidence was insufficient).

The 1/13/09 message considers the Comiskey en banc petition opinion in which a 103 rejection was ignored and a new 101 rejection was stated sua sponte. A dissent suggests that now any ground of rejection can be raised before an appellate court. See also Pat-O for 1/14/09 and Hal's 1/25/09 offering. The 1/21/09 email wonders if the Obama suspension of Exec. Branch rulemaking applies to PTO interpretations of recent court decisions.

The 1/22/09 message reports the three focii of the Obama administration in the IP area.

The 1/26/09 email states that the JPO has published in English the patent examination guidelines it uses and gives the web address.

**Patently-O** – a blog written by Dennis Crouch – [www.patentlyo.com](http://www.patentlyo.com).

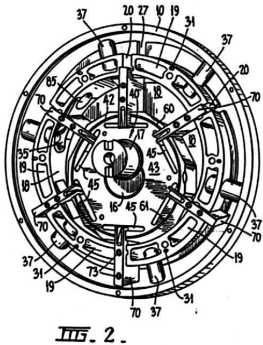
The 1/4/09 blog discusses the Sundown CAFC decision in which the Court rejected the trial testimony of a patent attorney as not from a qualified expert, but then because the art was “simple enough” found obviousness on its own.

The 1/5/09 posting documents the increasing number of appeals to the BPAI in recent years, and the dropping rate for examiner reversals (now about 20%).

The 1/8/09 email documents the “soaring” increase in appeals to the BPAI in recent years.

The 1/15/09 blog states that last year for the first time less than 50% of US patents issued to US applicants.

The 1/17/09 message reports the Boston Sci CAFC decision holding as obvious the combination of two embodiments of a prior art patent in spite of a jury's contra holding. So why bother with trial courts?



The 1/18/09 email (for those pat. litigators among us) cites a new patent case management guide for federal judges being developed for the Federal Judicial Center.

The 1/23/09 blog lists six easy suggestions to make the PTO more transparent to the public.

The 1/28/09 posting cites recent examples of the BPAI applying *Bilski* to reject business method claims.

The 1/29/09 message reports that deferred examination continues to be considered at the PTO beyond 37 CFR 1.103d.

The 1/31/09 blog discusses the Atkins BPAI decision holding *sua sponte* that certain system and method claims for converting a web address are not patentable under 101 for they don't require transformation of an article into a different state or thing.

**Carl Oppedahl** – emails of IP practice matters:  
[carl@oppedahl.com](mailto:carl@oppedahl.com).

Three 1/8/09 emails, and two on 1/9, discuss some PCT issues, with answers – eg filing fees, priority, new matter, etc.

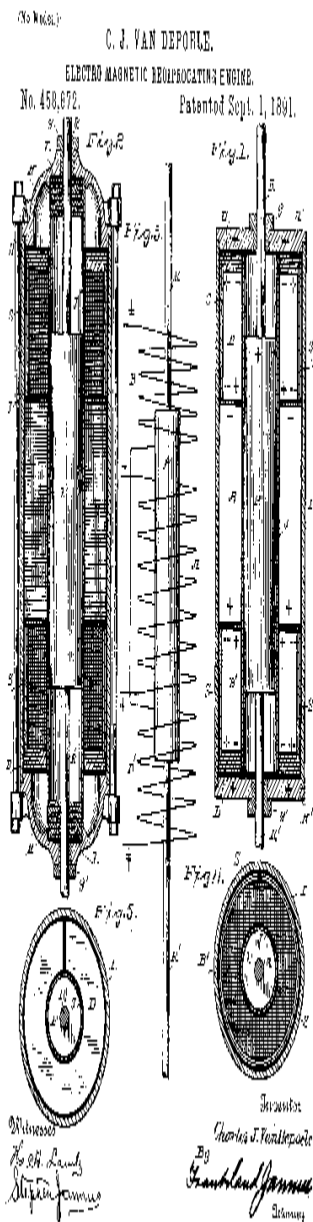
**Anticipate This** – emails from Jake Ward focusing on patent practice – web address: [www.anticipatethis.wordpress.com](http://www.anticipatethis.wordpress.com).

The 1/15/09 message reports the author's conclusions from attending a new PTO CEB program on current issues and practices.

**IP law 360** – a newsletter covering all IP, but focusing mainly on litigation – web address: [www.iplaw360.com](http://www.iplaw360.com)

The 1/21/09 newsletter includes a guest column that discusses the impact of the *Bilski* business method decision on life science inventions.

The 1/26/09 email includes a guest column that discusses the



recent Net Money CAFC decision re anticipation.

**Daily Dose of IP** – a grab-bag of various IP matters by Mark Reichel – [www.dailydoseofip.com](http://www.dailydoseofip.com).

The 1/5/09 bag focuses on WIPO's last '08 magazine; it summarizes various WIPO meetings and comments on software patentability.

The 1/12/09 email reviews recent PTO fee changes.

The 1/14/09 message reports that the US assignment data at the EPO is corrupted and is being replaced.

The 1/27/09 message gives the new EPO fee schedule effective 4/1/09.

**AIPLA Direct** – a newsletter issued from time to time [http://www.aipla.org/Content/ContentGroups/About\\_AIPLA1/AIPLA\\_Reports/AIPLA\\_Reports\\_TOC.htm](http://www.aipla.org/Content/ContentGroups/About_AIPLA1/AIPLA_Reports/AIPLA_Reports_TOC.htm)

A 1/21/09 notice announces an online seminar Feb. 4 re. Insurance for IP Litigation.

**WIPO** – [madrid@wipo.int](mailto:madrid@wipo.int)

On 1/14/09 WIPO published on its website information about some new rules under the Madrid Agreement.

On 1/14/09 WIPO also published its list of non-working days for 2009.

**Other Stuff** –

RP Bell offers a review and analysis of patent application practice changes during the last five years – see [robert-plattbell.com](http://robert-plattbell.com).

The joannascholer.com blog of 1/29/09 reports that the EPO will accept Internet Archive page date stamps as adequate evidence.

Legal Force, an online lawyer group, invites all to use the site for comment, debate, announcements, etc. See legal-





force.com.

LSI is offering a day-long “Patent Claim Construction Seminar” in Chicago on 2/13/09.

LSI is offering a “Departing Employees and IP” seminar in Palo Alto on 2/25/09.

LSI has announced a two day gamer technology law conference being held on 3/9-10/09 in Beverly Hills.

LSI will hold a two day conference, “IP Licensing,” in Austin 3/30-31/09.

Fordham announces its 17<sup>th</sup> IP conference at Cambridge UK on 4/15-16/09.

LSI will offer a copyright management conference 4/23-24/09 in Seattle.

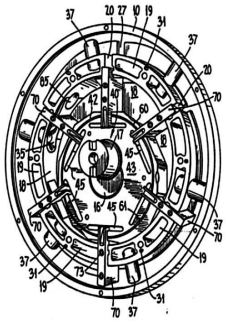


FIG. 2.

For more information about any of the patent topics mentioned consult *Patent Application Practice* published by West and updated twice a year.

