



# SDIPLA News

## SDIPLA ANNOUNCES THE 2009 INTELLECTUAL PROPERTY ACHIEVEMENT AWARD RECIPIENT

### DR. WILLIAM L. RESPESS

Please join us on Thursday, December 10, 2009 at the Lodge at Torrey Pines for the SDIPLA 2009 Holiday Party where the 2009 IP Achievement Award will be presented.

San Diego Intellectual Property Law Association  
<http://www.sdipla.org/index.htm>

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**Date/Time/Location:**

December 10, 2009  
6:00 p.m.—10:00 p.m.  
THE LODGE AT TORREY PINES  
11480 N. Torrey Pines Road  
La Jolla, CA 92037

**Directions:**

From I-5 exit Genesee  
Turn Right  
Genesee becomes North Torrey  
Pines Road

## THE FOLLOWING ARTICLE IS A SUMMARY OF DR. WILLIAM L. RESPESS' ACCOMPLISHMENTS

### **The Power of an Attorney to Shape the Future of Biotechnology** *by Douglas E. Olson and David M. Fortner*

An excellent example of how a lawyer can change society and the world is found right here in San Diego. Attorneys, working along with scientists and entrepreneurs, played a key role in starting the biotech revolution. Larry Respass is such an attorney. He helped establish San Diego as home to one of the largest biotechnology industries in the United States and the world. Of course, it could not have happened without the scientists. But, even the greatest inventive ideas need money, patents for commercial development, and protection from well-financed copiers. Without the patents and the likelihood that those patents could be enforced, there would have been far fewer scientist, entrepreneurs, and venture capitalists who would take the risk to start a fledgling biotechnology company.

The biotechnology revolution began in the early 80's when attorneys fought for and convinced the Supreme Court that patentable subject matter included biotechnology. *Diamond v. Chakrabarty*, 447 U.S. 303 (U.S. 1980). Six weeks later, San Diego attorney Larry Respass filed and prosecuted the application which later became Hybritech's 4,376,110 patent entitled: "Immunometric assays using monoclonal antibodies," which issued March 8, 1983. Respass, a former partner at the premier IP boutique, Lyon & Lyon, was no stranger to biotechnology. He had earned a Ph.D. in Chemistry at M.I.T. and was involved in writing the applications for the patents that launched Genentech as the first blockbuster biotechnology company. In fact, his connection with the Genentech start up team, including venture capitalist, Brook Byers, resulted in Respass working for Hybritech.

Howard Birndorf hired Respass as General Counsel for Hybritech. "I knew patents were going to be the key to our success at Hybritech and that Larry Respass was the person to make it happen," Birndorf recalls. Birndorf has since started many biotech companies. In fact, the New York Times has called him "The Johnny Appleseed of Biotechnology." (James Sterngold, *The Johnny Appleseed of a Biotechnology Forest*, N.Y. Times, August 18, 1996.) In doing so, he has almost always relied on the counsel of Respass to insure that strong patent protection was in place. Today they work together at Nanogen where Birndorf is the C.E.O. and Respass is the General Counsel.

## The Power of an Attorney to Shape the Future of Biotechnology

by Douglas E. Olson and David M. Fortner (cont'd)

Respass knew that the Hybritech product, monoclonal antibodies used for diagnosing major diseases, would be copied by major pharmaceutical companies who could drive the tiny Hybritech out of business. He thus developed a patenting and patent enforcement strategy to protect the Hybritech invention. The first step in carrying out his plan was to obtain a patent on the use of emerging technology, monoclonal antibodies, to diagnose disease. He then created a licensing strategy which resulted in many of the largest companies in the country taking a license from Hybritech. Finally, for those who would not take a license, he devised a litigation strategy aimed at getting the Hybritech patent validated on appeal to the Federal Circuit, the Court newly created to hear all patent appeals.

Although the trial court held the Hybritech patent invalid, Respass forged ahead with his strategy which he anticipated would not be vindicated until the case reached the appellate court. The Federal Circuit reversed the District Court and for the first time held a biotechnology patent to be infringed. *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367 (Fed. Cir. 1986). In doing so, the Federal Circuit took a page from the Respass playbook and ruled that the patent was valid because the substitution of monoclonal antibodies for polyclonal antibodies had led to unexpected advances in medical diagnosis.

This is the only case your author has ever been involved in where the client came with a game plan, not only for winning, but for creating new law. All I had to do was follow the script in order to change biotechnology patent law.

Testimony for the importance of patents and patent attorneys comes from Ted Green, a Renaissance man who is both an inventor and a venture capitalist. He was an inventor on the Hybritech patent and C.E.O. of Hybritech. He also founded Amylin Pharmaceuticals and is an inventor on one of Amylin's first patents. In reflecting on the Hybritech experience, Green stated, "If people had lost confidence in the patent system, venture capital would have dried up completely. Fortunately, with the Hybritech patent, we established that biotechnology inventions could be patented and that the courts would enforce them, thus protecting the huge investments necessary to bring biotechnology inventions to market." Mr. Green further explained that, "If venture capitalists didn't make investments, new medicines would not exist." "Patents are fundamental." Green stated.

Birndorf recalls early skepticism about the value of Hybritech's patent position. When asked about the impact of the successful defense of that patent, he thought for a moment and then mused "Our success helped open the funding tap of Big Pharma. Before that we had been courted mostly by Japanese companies. But after that, the doors of the corporate development departments at major pharmaceutical companies were open to us. I think that

***The Power of an Attorney to Shape the Future of Biotechnology  
by Douglas E. Olson and David M. Fortner (cont'd)***

has been one of the most, if not the most profound impacts on biotech. It helped us survive after launch with venture money and early IPO money until we were able to put products on the market.”

Brook Byers, a principal in the venture capital firm of Kleiner Perkins Caufield and Byers reflected on Hybritech, his first biotechnology company, stating, “Intellectual property is the foundation of the biotech industry. Using that foundation for my companies. Larry Respass, in my mind, is the Godfather of the biotechnology legal profession. He was instrumental in opening the door for venture funding of biotechnology.”

This was the first biotechnology patent held valid and infringed and showed the world that biotechnology intellectual property could indeed be protected and enforced. It vindicated the analysis by Respass when he joined Hybritech that the Hybritech technology could be protected by patents. The case was the pinnacle of Hybritech’s success and provided an inspiration to other start-up biotechnology companies. As Respass said, “I like to think that Hybritech’s success in obtaining and enforcing its patents gave those [biotechnology] companies the conviction that they could patent their inventions and protect them from the giant pharmaceutical companies.”

Hybritech proved to be an incredible environment for biotechnology talent with more than 50 San Diego biotechnology companies founded by former Hybritech employees including Gen-Probe, Idec Pharmaceuticals, Ligand Pharmaceuticals, Biosite, and Nanogen. Attorney Respass helped change San Diego from a sleepy, small community of biotechnology and patent firms into the powerhouse it is today.

One attorney truly can make a difference.

\* \* \*

**PLEASE JOIN US ON DECEMBER 10, 2009 TO HONOR AND  
CONGRATULATE DR. WILLIAM L. RESPASS FOR HIS  
ACCOMPLISHMENTS AND CONTRIBUTIONS TO THE  
INTELLECTUAL PROPERTY COMMUNITY**



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## REMINDERS

### Update Contact Info

Please submit changes of your contact information to Ken Jenkins: ([kejenkins@townsend.com](mailto:kejenkins@townsend.com))

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Please renew your membership at:  
<http://www.acteva.com/booking.cfm?bevaaid=95102>

### Articles/Advertising

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### Sponsorship

If your firm or company is interested in sponsoring a meeting, please contact Ken Jenkins:  
([kejenkins@townsend.com](mailto:kejenkins@townsend.com))

### The SDIPLA would like to thank our Sponsors for the monthly meetings:

Foley & Lardner LLP ([www.foley.com](http://www.foley.com))

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([www.townsend.com](http://www.townsend.com))

(listed alphabetically)



# December 10, 2009 Holiday Party/Awards Ceremony

Thursday December 10, 2009

Registration and payment is due  
no later than December 4, 2009.

**Holiday Party/Awards Ceremony**  
**The Lodge at Torrey Pines**  
**11480 N. Torrey Pines Road**  
**La Jolla, CA 92037**

*\* Space is Limited \**

**HAPPY HOLIDAYS!**

**Registration: 6:00 p.m.**  
**Cocktails: 6:00 p.m.**  
**Dinner: 7:00 p.m.**  
**Presentation: 7:30 p.m.**

**WE ENCOURAGE YOU TO BRING A  
GUEST TO THIS HOLIDAY EVENT**

Reserve your space online at:

[http://acteva.com/booking.cfm?  
binid=1&bevalD=194082](http://acteva.com/booking.cfm?binid=1&bevalD=194082)

Or register below and mail  
with your check made payable to 'SDIPLA' to:

Ken Jenkins, SDIPLA Secretary  
 Townsend and Townsend and Crew LLP  
 12730 High Bluff Drive, Suite 400  
 San Diego, CA 92130

**Menu:**

**Butternut Squash Soup**

**Bibb Lettuce w/Candied Walnuts, Grapes, Roquefort  
and Pear Vinaigrette**

**ROASTED PORK RIB ROAST**

**Maple Syrup Sweet Potatoes, Glazed Parsnips  
or**

**HORSERADISH CRUSTED SALMON**

**Green Beans, Crème Fraiche and Chives  
or**

**VEGETARIAN ENTREE**

**Crème Brulee**

**Coffee and Tea**

**MEAL PRICE**

\$98.00 per person

*(plus \$5.42 Acteva service fee)*

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

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

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

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

Member of SDIPLA? (circle one) YES NO

Entrée Choice: \_\_\_\_\_ Pork Roast \_\_\_\_\_ Salmon \_\_\_\_\_ Vegetarian



## EMPLOYMENT OPPORTUNITIES



### FITCH EVEN, TABIN & FLANNERY

FITCH, EVEN, TABIN & FLANNERY, a national Intellectual Property law firm, is expanding its Woodland Hills office. FETF also has offices in Chicago, San Diego, San Luis Obispo, Washington, D.C., and Boulder. We are seeking partners and associates who have established client relationships. FETF will consider merger opportunities.

To learn more about the firm and our practice, please visit us at: <http://www.fitcheven.com>

All submissions are held in confidence. For confidential discussion and consideration, please contact:

Barbara LaRocco  
 Recruitment Coordinator  
[blaro@fitcheven.com](mailto:blaro@fitcheven.com)

### Nydegger & Associates

San Diego intellectual property law firm near Balboa Park seeks an experienced patent attorney with a portable client base and an interest in potential partnership. The firm specializes in the prosecution and management of IP matters with emphasis on prosecuting complex patent applications in various areas of technology.

Membership in the California Bar and registration in the U.S. Patent and Trademark Office are required. Applicant should have at least 8 years experience. Practical engineering experience is preferred.

Send resume to: Administrator,  
[email@nydegger.com](mailto:email@nydegger.com)

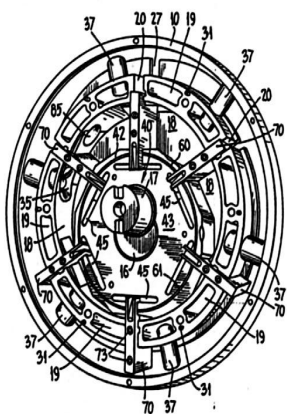


FIG. 2.

# EMPLOYMENT OPPORTUNITIES



DexCom, Inc, headquartered in San Diego, is committed to developing technologies and products that improve the lives of people with diabetes. DexCom has ambitious plans to keep learning and growing – and is seeking people who have the same goals for themselves. This business has grown with pride, integrity and a focused vision. DexCom Inc. is currently seeking a **Patent Attorney/Agent**.

**Position Description:**

Responsibilities will be widely varied and include preparing and prosecuting patent applications, working with outside counsel on reexamination and interference matters, developing and implementing offensive and defensive IP strategies, conducting various patent searches, conducting freedom-to-practice evaluations, preparing or obtaining appropriate opinions, conducting invalidity analyses, providing support for patent litigation, and providing timely counsel on intellectual property issues. Strong interpersonal skills are required, as the position entails regular interaction with legal, technical, and business teams.

**Qualifications (Basic):**

- Registered to practice before the U.S. Patent and Trademark Office.
- Bachelor's Degree in Physics, Electrical Engineering, Computer Science or related technology field required.
- A minimum of 3 years legal experience handling intellectual property law issues.

**Qualifications (Desired/Preferred):**

- A Juris Doctor from an accredited U.S. law school and licensed to practice in at least one state or the District of Columbia.
- Ideal candidate will have experience with biomedical, diagnostics, wireless technologies, and/or consumer-based electronic systems with a preference for medical device or health-care related electronics.
- Demonstrated ability to draft medical device electronics related patent applications.
- Highly motivated with desire to deliver outstanding professional work product.
- Work independently with minimal supervision and effectively contribute as a team player on legal, technical, and business teams.
- Possess superior writing and oral communication skills.
- Demonstrated creativity and success in strategizing, structuring, and obtaining robust IP specific to an area of technology or product, which includes offensive and defensive patent protection.
- Demonstrated ability to understand medical technology, with ability to apply it to an R & D effort with strong R&D interaction.

**Compensation:**

Base Salary of 125,000 USD/year plus stock options and opportunity to earn an annual bonus. We also offer an excellent benefits package including medical, dental, vision, life insurance and long term disability, 401(k), flexible spending account, a discounted employee stock purchase plan, paid time off, on-site fitness center, and a great work environment.

**About DexCom:**

DexCom Inc. is a publicly traded company listed in the NASDAQ stock exchange. We have been FDA approved and commercially released two generations of continuous glucose monitors. More company information is available at [www.dexcom.com](http://www.dexcom.com).

**To Apply:**

Please send resume to: [careers@dexcom.com](mailto:careers@dexcom.com) or fax to: 858-875-5330 and reference "Patent Attorney/Agent" in the subject line.



## EMPLOYMENT OPPORTUNITIES

### MINTZ LEVIN

Mintz Levin is looking for a patent engineer in our San Diego office. Ideal candidates will have a B.S. or higher in Electrical Engineering or Computer Science from a top science and engineering school. Must be admitted or eligible to be admitted to the USPTO. Candidate must be detail oriented, possess excellent written and oral communication skills.

We are seeking individuals with immediately transferable skills who have strong academic backgrounds who have major law firm experience and/or industry experience. The selected candidate will be responsible for patent prosecution, application drafting, invention harvesting, and assistance with patent landscapes and freedom to operate analysis in various high technology areas with emphasis on wireless, telecommunications, semiconductor, and computer science technologies.

**Please send your resume and cover letter to Megan Clouden, Lateral Associate Recruiting Manager, at [lateralrecruiting@mintz.com](mailto:lateralrecruiting@mintz.com).**

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