



SDIPLA News

SEPTEMBER 2012

Please join us for the September SDIPLA Dinner Meeting at the La Jolla Marriott

Featuring Patrick Elsevier (Jones Day), Ned Israelsen (Knobbe), Robert MacWright (Salk Institute), and Jessica Wolff (Wolff IP)

"Everything you know is wrong: Prometheus, Myriad and the Future of Biotech Patent Law."

Thursday, September 20, 2012
(More details on page 3)

San Diego Intellectual Property Law Association

<http://www.sdipla.org>

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Date/Time/Location:

September 20, 2012, 6:00 p.m.
La Jolla Marriott
4240 La Jolla Village Drive
La Jolla, CA 92037

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REMINDERS

Membership Renewal

Please renew your membership for 2012-2013 using the PayPal links on the SDIPLA website:

SDIPLA.org

Update Contact Info

Please submit changes of your contact information to Jo Dale Carothers: (jcarothers@cov.com)

Articles

If you have an article for the newsletter, please send it to Jo Dale Carothers: (jcarothers@cov.com)

Sponsorship

If your firm or company is interested in sponsoring a meeting, contact Jo Dale Carothers: (jcarothers@cov.com)

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

- Covington & Burling LLP (cov.com)
- Goodwin Procter LLP (www.goodwinprocter.com)
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(listed alphabetically)

<u>SDIPLA September 20, 2012 Dinner Meeting</u>									
<p style="text-align: center;">Featuring:</p> <p style="text-align: center;">Patrick Elsevier (Jones Day) Ned Israelsen (Knobbe) Robert MacWright (Salk Institute) Jessica Wolff (Wolff IP)</p> <p>"Everything you know is wrong: Prometheus, Myriad and the Future of Biotech Patent Law."</p> <p style="text-align: center;">Thursday, September 20, 2012</p> <p style="text-align: center;">Dinner Meeting</p> <table style="width: 100%; border: none;"> <tr> <td style="width: 30%;">Registration:</td> <td>6:00 p.m.</td> </tr> <tr> <td>Cocktails:</td> <td>6:00 p.m.</td> </tr> <tr> <td>Dinner:</td> <td>7:00 p.m.</td> </tr> <tr> <td>Discussion:</td> <td>7:30 p.m.</td> </tr> </table> <p style="text-align: center;">Menu:</p> <p style="text-align: center;">Fresh Seasonal Salad With one of the following entrees:</p> <p style="text-align: center;">Chicken-Salmon-Vegetarian</p> <p style="text-align: center;">Dessert</p> <p style="text-align: center;">Coffee and Tea</p>	Registration:	6:00 p.m.	Cocktails:	6:00 p.m.	Dinner:	7:00 p.m.	Discussion:	7:30 p.m.	<p style="text-align: center;">RSVP online at:</p> <p style="text-align: center;">SDIPLA.org</p> <p style="text-align: center;">Or register below and mail your form and CHECK MADE PAYABLE TO 'SDIPLA' TO:</p> <p style="text-align: center;">Jo Dale Carothers SDIPLA Secretary Covington & Burling, LLP 9191 Towne Centre Drive, 6th Floor San Diego, CA 92122 (858) 678-1802 jcarothers@cov.com</p> <p style="text-align: center;">MEAL PRICES</p> <p>SDIPLA members: \$65.00 (plus PayPal service fee) Non-members: \$85.00 (plus PayPal service fee)</p> <p style="text-align: center;">Dinner Registration and payment is due no later than 1 pm on September 18, 2012.</p>
Registration:	6:00 p.m.								
Cocktails:	6:00 p.m.								
Dinner:	7:00 p.m.								
Discussion:	7:30 p.m.								

Please fill out a separate form for Each Attendee

Name: _____

E-Mail Address: _____

Firm/Employer: _____

Telephone Number: _____

Member of SDIPLA? (circle one) YES NO

Entrée Choice: _____ Chicken _____ Salmon _____ Vegetarian

by Frederic M. Douglas and James E. Hawes

This column highlights some of the more notable recent internet notices, newsletters and blogs dealing with IP prosecution issues.

Hal Wegner's email newsletter – a lot of great stuff – Contact: hwegner@foley.com

* Hal's July 30, 2012 email discussed PTO Director David J. Kappos' blog statements endorsing the panel majority's view in *CLS Bank International v. Alice Corp. Pty. Ltd.*, ___ F.3d ___ (Fed. Cir., July 9, 2012) that patentability issues (§§ 102, 103, 112) should be addressed *before* patent-eligibility (§ 101).

* The August 14, 2012 email discussed *MagSil Corp. v. Seagate Tech.*, ___ F.3d ___ (Fed. Cir., Aug. 14, 2012) which affirmed a summary judgment of invalidity under 35 U.S.C. § 112, Paragraph 1. Hal stated that the court's ruling was based on the fact that the patentee chose broad claim scope at the peril of losing claims that were not enabled across the complete scope of claim coverage.

* On August 22, 2012 Hal reported on *Amkor Technology, Inc. v. ITC*, ___ F.3d ___ (Fed. Cir., Aug. 22, 2012) which held that an oral statement in the U.S. was enough to consider the invention made in the U.S. under 35 U.S.C. § 102(g)(2).

Hal's blog is now available at www.laipla.net/news-blog/blog/.

IPWatchdog – a patents and patent law blog – IPwatchdog.com

* The August 3, 2012 post describes the introduction of the Saving High-tech Innovators from Egregious Legal Disputes Act ("SHIELD Act") in Congress. The SHIELD Act proposes to make patentee plaintiffs for computer inventions pay when losing infringement litigation.

* On August 13, 2012 IP Watchdog announced that the USPTO published the final rules for administrative trials under the America Invents Act.

* IPWatchdog's August 25, 2012 post stated that the USPTO selected a central Denver location for one of its regional satellite offices.

Patent Docs – A patent blog – patentdocs.typepad.com/patent_docs

* On August 1, 2012 Kevin E. Noonan provided an article on the proper scope of DNA (or "Gene") patent claims.

* The August 23, 2012 post discusses examples of instances where claims to isolated DNA interfered with basic research.

Continued...

IP Spotlight – IP Spotlight provides news and practice tips relating to intellectual property. IP Spotlight is published by Jim Singer of Fox Rothschild, LLP – www.IPSpotlight.com.

* The July 30, 2012 post discussed the USPTO's published set of proposed rules to implement the first-to-file system.

* The post for August 27, 2012 announced that the USPTO issued a third extension of its First Action Interview Pilot Program, through November 16, 2012.

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

* On July 31, 2012, Professor Crouch introduced the new final rules for the statute of limitations for disciplinary proceedings against registered practitioners. Starting on August 30, 2012, the statute of limitations changed from five years to ten years, except for only one year after someone makes a written grievance to the Office of Enrollment and Discipline ("OED"). I guess that if the OED takes over a year to act on a written grievance, then you would be home free. Do you feel lucky?

* The August 14, 2012 post discusses how the AIA shifts Patent Office focus from inventors to assignees.

* The August 20, 2012 guest post by Carl Oppedahl provides a summary of the new inventor declaration forms.

USPTO - the PTO's website – uspto.gov

* On July 30, 2012 the PTO emailed a "Patent Alert: Delivery of U.S. Pre-Grant Results to EPO Without Delay Requires Timely Consent From Applicants." It seems that the European Patent Office requires applicants to file search results for patent application priority applications anywhere "without delay" after receiving the search results. The problem is that U.S. rules keep most applications confidential such that search results will not be sent to the EPO unless the U.S. applicant sends written permission. The PTO has a "Certification and Authorization Form PTO/SB/69" that can simplify abiding by the EPO rule. Filing the form in advance for each application before filing the EPO counterpart allows the PTO to electronically transmit the search results free of charge.

* The August 7, 2012 Official Gazette provided the final rule for third-party submissions, which becomes effective September 16, 2012.

* On August 31, 2012 the USPTO emailed the Director's Forum Blog, which announced "Text2PTO." No, you don't get to send text messages to your favorite examiner. It means that you will be able to file patent applications online as text documents. This is different from the current practice of submitting PDF documents. There will be other features, such as analytical reporting tools, permitting some formalities checks as well as information related to patent families, continuity, claim dependencies, and other application content.

Continued...

* On September 4, 2012 the USPTO announced that it seeks comment on a proposed fee schedule that will be at least 22% lower than current routine patent process fees. If you want to submit comments, the USPTO wants you to know that there will be a 60-day comment period. I have several clients asking that any comments suggesting a reversal in the planned lower fees be submitted no sooner than the 61st day.

AIPLA – the profession's national organization – see AIPLA.org

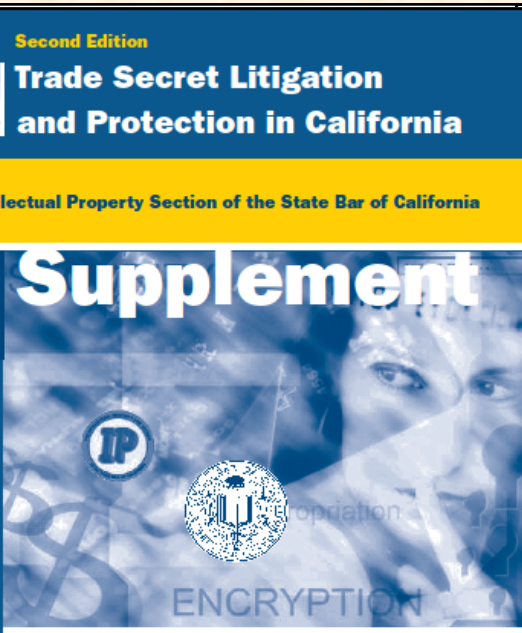
* AIPLA's annual meeting is October 25-27, 2012 in Washington, D.C. www.aipla.org/learningcenter/AM12/Pages/default.aspx.

Miscellaneous –

* The last Chisum Patent Academy was sold out. It is limited to ten attendees. The next one is February 20-22, 2013 in New York. Two more sessions will be held in Seattle in 2013. www.chisumpatentacademy.com.

For more information about any of the patent topics mentioned consult *Patent Application Practice*. Trademark topics are discussed in *Trademark Registration Practice*. Both are published by West and updated twice a year. For litigation questions, contact Fred Douglas at 949/293-0442 or by email at fdouglas@cox.net.

Second Edition



Trade Secret Litigation and Protection in California

The Intellectual Property Section of the State Bar of California

Supplement

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Announcing Publication of the Supplement to Trade Secret Litigation and Protection in California (Second Edition)

This new supplement has over 100 pages of analysis and discussion of recent developments in trade secret practice.

Updates include:

- Analysis of more than 50 new trade secret cases on misappropriation, preemption, identification of trade secrets, injunctions, damages, and attorneys fees;
- New content regarding social media policies; and
- New and updated CACI jury instructions from the Judicial Council

Available at www.ipsection.org

For questions, contact:

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