

San Diego Intellectual Property Law Association

# SDIPLA News

## European Patent Office Clamps the Lid Down on PCT Applications Filed by U.S. Tech Industry

by John M. Carson

The European Patent Office recently announced that after March 1, 2002, it will no longer examine patent applications filed under the Patent Cooperation Treaty (PCT) by U.S. applicants which relate to telecommunications. In addition, after that date no search or examination will be conducted on U.S.-

*(Continued on page 2)*

**November 7, 2002 Dinner Meeting:  
Recent Technical Corrections To 35 USC § 102(e) Pursuant To HR 2215:  
Fixing Flaws Introduced By The AIPA Of 1999**  
*Speaker: Bob Spar, Director, USPTO Office of Patent Legal Administration*

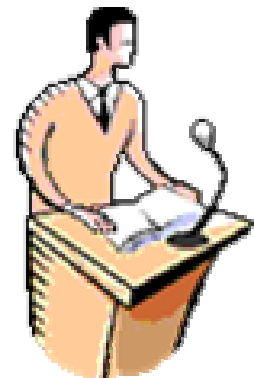
### About the topic:

Mr. Spar will discuss the recent technical corrections to 34 USC § 102(e) pursuant to HR 2215.

### About the speaker:

Robert J. Spar, a former examiner, is currently the Director of the Office of Patent Legal Administration (OPLA), formerly known as the Special Program Law

Office. Under the Deputy Commissioner for Patent Examination Policy at the U.S. Patent and Trademark Office, Mr. Spar's major responsibility is to develop and implement rules packages and policy initiatives involving patent examination processes.



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## ATTENTION: NEW MEETING LOCATION MARRIOTT DEL MAR

### Date/Time/Location:

**NOVEMBER 7, 2002**  
6:00 p.m.—8:30 p.m.  
Marriott Del Mar  
11966 El Camino Real  
San Diego, California 92130  
858-523-1700

### Directions:

**I-5 NORTH:** Exit Carmel Valley Road  
Right on Carmel Valley Road  
Left on El Camino Real

**I-5 SOUTH:** Exit Carmel Valley Road  
Left on Carmel Valley Road  
Left on El Camino Real

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## European Patent Office Clamps the Lid Down on PCT Applications Filed by U.S. Tech Industry

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originating PCT applications which relate to business methods or biotechnology.

The Patent Cooperation Treaty allows patent applicants to preserve the right to obtain foreign patents by filing a single, international application. It also provides a preliminary, non-binding opinion on patentability while deferring the significant expenses associated with filing the application in individual foreign countries or regions. Through the PCT, the applicant obtains a search for references pertinent to the patentability of the claimed invention. A preliminary examination of the application can also be requested. Filing foreign applications through the PCT delays the expensive national stage of foreign patenting for up to 30 months from the earliest priority date claimed in the application.

Applicants from the United States (i.e., U.S. citizens or corporations) can file their PCT applications in either the U.S. Patent and Trademark Office or the International Bureau in Geneva, Switzerland. In addition, prior to the announcement discussed below, all U.S. applicants had

the option of designating either the U.S. Patent and Trademark Office or the European Patent Office as the International Search Authority or the International Examining Authority. U.S. applicants would frequently designate the European Patent Office for search and examination so as to obtain a "second opinion" on patentability (in addition to the examination of the U.S. application) and to streamline the subsequent examination of the European application.

In response to a deluge of PCT applications from U.S. applicants, the European Patent Office recently announced that it would no longer conduct an international examination with respect to any PCT application relating to telecommunications, business methods or biotechnology filed by a national or resident of the United States of America in which the Demand for International Preliminary Examination is filed on or after March 1, 2002. Furthermore, no search will be conducted for PCT applications relating to business methods or biotechnology for such applicants where the PCT application is filed on or after March 1, 2002. Specifically, this announcement relates to PCT applications for such inventions filed in the U.S. Patent and Trademark Office or International Bureau in which at least one applicant is a U.S. national or

resident and none of the applicants are nationals or residents of a European Patent Convention (EPC) contracting state. More details, including the definition of what constitutes subject matter for which this ruling applies, can be found at [http://www.european-patent-office.org/epo/president/e/2001\\_12\\_11\\_e.htm](http://www.european-patent-office.org/epo/president/e/2001_12_11_e.htm).

Thus, while U.S. PCT applicants may still be able to obtain a European patent for such inventions (note that business method patents are not regularly granted) by filing a national application in the European Patent Office at the conclusion of the international PCT proceedings, they will no longer be able to obtain the benefits of having the European Patent Office conduct a preliminary search (telecommunications excepted) or examination of their applications. Nonetheless, for telecommunications inventions it is still possible and desirable for a U.S. applicant to request a search by the European Patent Office in conjunction with a PCT application. The PCT examination will then have to be conducted by the U.S. Patent and Trademark Office.

John M. Carson is a patent attorney and partner at Knobbe, Martens, Olson & Bear, LLP. Mr. Carson can be contacted at 619.687.8632 or [jcarson@kmob.com](mailto:jcarson@kmob.com).

## Applicants for SDIPLA Membership

The following individuals 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 December 31, 2002.



Amanda E. Carter	USD Law Student
Suiko Dam	X-Ceptor Therapeutics, Inc.
Donald R. Green	
Richard Allen Jarrett	
Scott W. Reid	Syrrx, Inc.

## Membership Dues

**Members who have not renewed membership by November 30, 2002, will be dropped from the regular mailing list.**

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.

### 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

### Robert J. Spar, Director, Office of Patent Legal Administration, USPTO Recent Technical Corrections To 35 USC § 102(e) Pursuant To HR 2215: Fixing Flaws Introduced By The AIPA Of 1999

Thursday, November 7, 2002

**SAN DIEGO MARRIOTT DEL MAR**

Mixer 6:00 p.m. (No Host Bar)

Dinner 6:30 p.m.

Presentation 7:00 p.m.-8:30 p.m.

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, 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

#### The Menu

Butter Nut Lettuce Salad  
*(Honey Glazed Walnuts, Star Krimson Pear and Gorgonzola Cheese)*

**Choose one of the following entrees:**

Tarragon & Rosemary Roasted Chicken Breast  
*(Warm Chino Farm Greens, Crispy Yukon Gold Potatoes, Whole Grain Mustard Jus)*

Grilled Scottish Salmon Fillet  
*(Truffle Risotto Cake, Saffron Shellfish Essence, Market Vegetables)*

Curried Cous Cous (vegetarian)  
*(Roasted Eggplant, Squash and Peppers in a Tomato Sauce)*

With  
Fresh Vegetables, Bakery Basket,  
Chef's Selection of Accompaniment,  
and  
Pastry Chef's Selection of Dessert

### REMINDERS

- Please mail, fax, or e-mail your reservation to Vicki Norton at the address, fax, or e-mail address indicated for receipt **no later than Monday, November 4, 2002**.
- 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.

#### NOTE INCREASE IN MEAL PRICES

**\$40.00 SDIPLA Member**

**\$45.00 Non-Member**

Please fill out a separate form for each attendee.

## Registration for November 7, 2002, SDIPLA Dinner NEW MEETING LOCATION: MARRIOTT DEL MAR

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

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

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

Dinner Choice:

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

Roasted Chicken

Member of SDIPLA? (circle one) YES NO

Salmon Fillet

Curried Cous Cous

**DEADLINE FOR REGISTRATION IS 5:00 P.M., MONDAY, NOVEMBER 4, 2002**  
*Reservations received after that time cannot be guaranteed a meal.*

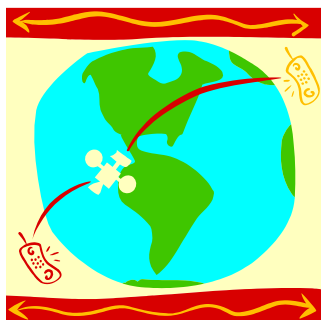
## Situations Wanted/Offered

### PATENT ATTORNEY/LIAISON WANTED

A San Diego-based pre-IPO leading wireless company with world recognition in creating innovative high-quality wireless products is seeking an Attorney/Liaison to assist in building and protecting its IP portfolio. Responsibilities will include managing patent portfolios, dealing with new disclosure, and drafting patents, and handling litigation matters. Assisting in the Company's trademark work and licensing will also be a component of the chosen individual's responsibilities. The qualified candidate will speak and write Japanese fluently, have at least three years' experience as a patent attorney possessing a degree in electrical engineering and/or computer science. The chosen individual shall report to the Director of Intellectual Property within the Company.

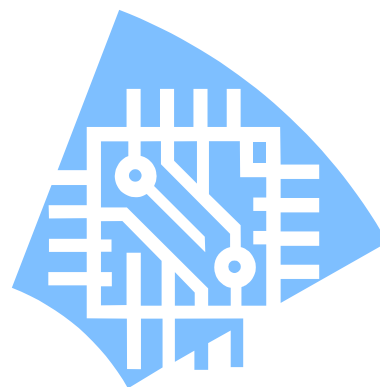
Please contact:

Shannon Hartwig  
Principal Agent  
Intellectual Property Confidants, LLC  
[www.ip-confidants.com](http://www.ip-confidants.com)  
[shannon@ip-confidants.com](mailto:shannon@ip-confidants.com)  
Telephone: 415-252-9470  
Facsimile: 415-252-9402



## Articles of Interest

The Editorial Committee is looking for articles of interest to the SDIPLA Membership for inclusion in the newsletter. Please submit articles or request info from Mark Wiczorek at [markw@innercool.com](mailto:markw@innercool.com).



## Announcements Page

This Announcements page is designed to better serve the needs of the membership. This page may be used to advertise for positions offered or desired, as well as to provide a forum for announcements of interest to the San Diego IP community. Please contact Vicki Norton if you would like to place an ad or announcement.

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](http://www.sdipla.org)**

## Upcoming SDIPLA Events

Date	Event	Topic
December 5, 2002	SDIPLA Holiday Party @ L'Auberge	
January 23, 2003	Dinner Meeting: TBA	TBA
February 27, 2003	Dinner Meeting Kay Chandler, Cooley Godward	TBA
March 21-22, 2003	OCPLA/SDIPLA Joint Meeting at Torrey Pines Hilton	TBA
April 24, 2003	Dinner Meeting Cecilia Gonzalez, Howrey, Simon, Arnold & White	TBA
May 2003	Dinner Meeting Frank Grassler, GlaxoSmithKline	TBA