



SDIPLA News

June 22, 2006 SDIPLA Dinner (MCLE 1hr)

“Patent Practice: Current Strategies and Future Trends”

By D. BENJAMIN BORSON

Of Counsel Fleisler Meyer LLP



Special points of interest:

- Election of the 2006-2007 SDIPLA Board will take place on June 22, 2006.
- June 28 and 29th, USPTO presents on their new EFS. Meeting to be held at the San Diego Library

Abstract:

Procuring meaningful patent protection in the US and in foreign countries requires understanding your client's business needs and differences in procedural and substantive patent law. Clients may need different scopes of protection for sales markets than for manufacturing locations. Differences in standards for patentable subject matter, for example, written disclosure (sufficiency) and obviousness (inventive step), can make coordinating prosecution in different countries challenging. Making informed decisions about what to protect and where to protect it can be very valuable to clients with worldwide presence.

Within the past several years, the USPTO has proposed new and sweeping changes to rules of patent practice. The USPTO is likely to finalize procedural and ethical rules for disciplining attorneys in the near future. Some USPTO rules may conflict with California Rules of Professional Responsibility.

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JUNE 22 DINNER MEETING: La Jolla Radisson

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Date/Time/Location:

June 22, 2006
6:00 p.m.– 8:30 p.m.

Radisson La Jolla
3299 Holiday Court
La Jolla, CA 92037

858 453-5500
www.radisson.com/
lajollaaca

directions:

From I-5, exit at La Jolla Village Drive

Proceed West and turn left at Villa La Jolla Drive

Turn left at Holiday Court.

Parking is free

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How a California attorney's ethical obligations can be met in both jurisdictions may be somewhat uncertain.

Additionally, proposed rules of continuation practice and claiming would limit continuation, continuation-in-part and claims practice. The period for public comment on these proposals has closed, and the USPTO is likely to finalize at least some of the proposed rules this year. How the new rules may affect patent practice is uncertain and when finalized, the new rules should be carefully studied.

Biography:

Dr. Borson is primary Intellectual Property Counsel for numerous start-up, small, and mid-sized US and foreign companies in the chemistry, life sciences and advanced materials industries. He provides legal, scientific, business and technical advice to help companies build and exploit business relationships and intellectual assets through developing IP and technology strategies, drafting and prosecution of patents, preparation of legal opinions and technology licensing. Current and past clients include those in the life sciences, pharmaceutical, biotechnology, advanced materials, superconductors, medical devices, instrumentation and semiconductor industries. Dr. Borson has worked with numerous universities and companies to develop and implement technology transfer strategies.

Dr. Borson has a Ph.D. degree from UC San Francisco and a J.D. Degree from the University of San Francisco. He has extensive experience as a research scientist in University and Corporate settings, and served on Editorial Boards of major peer review publications and Federal grant review committees. Previous to entering law, Dr. Borson held a faculty position in the Department of Physiology and the Cardiovascular Research Institute at the University of California, San Francisco, where he carried out a program in basic biomedical research. He authored over 70 primary research articles, reviews, book chapters, and abstracts and presented his research findings at numerous national and international scientific meetings.

Dr. Borson is a frequent author in IP law, with over a dozen publications in legal journals and has presented numerous lectures in legal matters to industry, academic organizations and the State Bar of California. Dr. Borson is licensed to practice law in the State of California, the Federal District Court for the Northern District of California and before the United States Patent and

The SDIPLA thanks our Sponsors for the
6/22/06 meeting:

Buchanan Ingersoll
www.bipc.com

Townsend and Townsend and Crew
www.townsend.com

(listed alphabetically)

Reservation Form for June 22, 2006 Meeting

“Patent Practice: Current Strategies and Future Trends”

By D. Benjamin Borson

Tuesday
June 22, 2006

La Jolla Radisson
Registration starts at 6:00 p.m.

The Menu

Caesar Salad

Grilled Vegetable Pasta

An array of sautéed & Grilled Seasonal Vegetables lightly tossed with Fresh Herbs, Spinach Fettuccini & Light Cream Sauce

Chicken La Jolla

Breast of Chicken marinated in Rosemary, Olive Oil & Garlic. Broiled. Rosemary & Lemon Zest garnish. Herbed Couscous accompaniment.

Halibut

Fresh Halibut with Crushed Macadamia Nuts. Presented with Rum Raisin Glaze and Served with Stir Fried Rice.

Desert

Chocolate Fudge Decadence Cake

Freshly Brewed Coffee, Decaffeinated Coffee, & Iced Tea

Cash Bar From 6-7:00PM

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:

Robert Prince
SDIPLA Secretary
14651 Woodhue Lane
Poway, CA 92064
(858) 320-8679
Fax: (858) 748-8201
rprince@sbcglobal.net

On-line reservation available– go to www.acteva.com and search for SDIPLA or follow the link at www.SDIPLA.org

Please fill out a separate form for each attendee.

REMINDERS

- Please mail, fax, or e-mail your reservation to Robert Prince at the address, fax, or e-mail address indicated for receipt **no later than 5:00 p.m. on Wednesday, June 16, 2006.**
- 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 MEAL PRICES

\$40.00 SDIPLA Member

\$50.00 Non-Member

Registration

Name: _____ E-Mail Address: _____

Firm/Employer: _____

Telephone Number: _____

Member of SDIPLA? (circle one) YES NO

Entrée Choice: _____ Chicken _____ Halibut _____ Vegetarian Pasta

RESERVATION DEADLINE IS 5:00 P.M., JUNE 16, 2006

The SDIPLA Board's Selection of Boris Zelkind and Jessica Mitchell as its Nominees for the Board:

The SDIPLA Board is pleased to announce its selection of Boris Zelkind and Jessica Mitchell as their nominees for the new members of the Board. The Board believes that Boris' willingness to assist SDIPLA this year, his previous experience in similar organizations and breadth of patent litigation experience will complement and prove a valuable resource to the SDIPLA Board. The Board believes that Jessica's consistent participation in SDIPLA, her initiative to help find speakers for SDIPLA meetings for next year and her enthusiasm for the organization will complement and prove a valuable resource to the SDIPLA Board.

SDIPLA NOMINEES:Statement Of Boris Zelkind

Background:

I would like to submit my name for the open officer position on the board of the SDIPLA. First, let me introduce myself. I started practicing law in the fall of 1994 at Kinney & Lange, P.A., an intellectual property boutique firm located in Minneapolis, Minnesota. I got involved in litigation fairly early in my career and litigation became the focus of my practice. I also prepared and prosecuted patent applications in various fields of technology from medical devices to data communications systems. I left Minneapolis in the summer of 2000 to join a small research & development company, here in San Diego, to help run its patent litigation matters. Before joining the San Diego office of Knobbe, Martens, Olson & Bear, LLP in 2005, I practiced law as a founding member of Zelkind & Shackelford LLP.

My litigation practice has included European patent infringement proceedings and nullity actions and presenting a number of oral arguments to the United States Court of Appeals for the Federal Circuit. I am admitted to practice in the States of California and Minnesota, the USPTO, the United States Supreme Court, the 8th, 9th, and Federal Circuit Courts and a number of District Courts. As part of my community involvement, I am a member of the Litigation Committee and the Rules Committee of the Federal Circuit Bar Association, and the Events and Awards Committee of SDIPLA.

Brief Statement:

The main reason for my interest in joining the board of SDIPLA is to give back to this legal community by helping San Diego IP practitioners, be they in private practice or in-house counsel, stay connected and involved. We are in a particularly dynamic time in the evolution of our patent system, and it is imperative that the membership stay current with these changes. Having worked both in-house and in firms, having run a small IP firm and now practicing at Knobbe Martens, I feel that I am in a unique position to understand and help address the needs and interests of our IP Community. I thank you for considering me for the board of SDIPLA.

Boris Zelkind

SDIPLA NOMINEES:

Statement Of Jessica Mitchell

Dear SDIPLA Board:

I write to express my intention to run for Treasurer of SDIPLA in the June 2006 election. I am interested in contributing further to the IP community in San Diego and believe that participating on the Board would further the SDIPLA's efforts to increase its membership and prestige.

Over the past few months, as a member of the Events and Awards Committee, I have worked at lining up guest speakers for our dinner meetings including judges at the United States Court of Appeals for the Federal Circuit. To date, Judge Rader has expressed his interest; I am awaiting his confirmation for a meeting date in 2007.

I believe my education and experience makes me a strong candidate. I earned a Bachelor of Science degree in biochemistry from San Francisco State University and a J.D. from California Western School of Law. Further, prior to law school, I worked as a research associate at University of California San Francisco Medical Center in its Hematology/Oncology Department. As a research associate, I worked with a team of physicians and researchers to conduct industry-sponsored prostate cancer clinical trials. In addition, during law school, I interned at IDEC Pharmaceuticals in its legal department with a focus on intellectual property law. Finally, as a patent attorney, I feel I can best represent all members of the organization since I have an appreciation of both prosecution and litigation patent issues, and topics of interest to in-house counsel and attorneys in private practice.

If elected Treasurer, my prospective development plan for the SDIPLA includes organizing events that continue to increase its profile. As an example, I would like to plan a symposium with members of the Patent Bars in China and Korea to highlight the growing importance of intellectual property protection in those countries.

Finally, I feel I am a strong candidate for Treasurer because of my intangible qualities, including a drive for excellence, commitment to dedicate the required time to accomplish tasks, and an enthusiastic attitude to do my part to favorably represent SDIPLA to the public.

Thank you for your time.

Sincerely,

Jessica S. Mitchell, Esq.

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

Election of the SDIPLA Board on June 22, 2006

On June 22, 2006, the SDIPLA will elect the Board members for the 2006-2007 term. **After careful consideration, the SDIPLA Board has selected *Boris Zelkind and Jessica Mitchell* as its nominees for Secretary and Treasurer for the 2006-2007 SDIPLA calendar year.**

Members who cannot attend the June 22, 2006 meeting may send their proxy vote (on p. 7), by Friday, June 19, 2006 to:

Rob Prince
SDIPLA Secretary
14651 Woodhue Lane
Poway, CA 92064
(858) 320-8679
fax: (858) 748-8201
e-mail: rprince@sbcglobal.net

Applications 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 August 1, 2006.

Michael Van Loy
James Herkenhoff

SDIPLA COMMITTEES: SDIPLA has Amicus, Awards, Editorial, Events, and Sponsorship committees. Please contact an officer if you are interested in joining a committee. Go to the SDIPLA website at www.sdipla.org for more information about these committees and SDIPLA.

ARTICLES: If you have an article for the newsletter, please send it to Rob Prince at rprince@sbcglobal.net.

DUES: To pay or renew your **membership dues:** Please use the form on the web page, or by using the on-line registration at www.actevia.com (search for SDIPLA).

SPONSORSHIP: If your firm or company is interested in sponsoring a meeting, please contact Tom Coverstone.

PROXY VOTE FOR SDIPLA BOARD 2006 ELECTION



Please mail or e-mail your proxy vote by Monday, June 19, 2006 to:

Robert Prince
SDIPLA Secretary
14651 Woodhue Lane
Poway, CA 92064
(858) 320-8679
fax: (858) 748-8201
e-mail: rprince@sbcglobal.net

POSITION

SDIPLA BOARD'S NOMINEE

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President

TOM COVERSTONE

Vice President

ROBERT PRINCE

Secretary

BORIS ZELKIND

Treasurer

JESSICA MITCHELL

Name: _____

Please check one of the boxes below:

- I vote to elect the SDIPLA Board's nominees for each Board position.
- I wish to vote for the SDIPLA Board's nominees except for the following write-in candidate(s) for the position listed:

(Position)

(Name)

(Position)

(Name)

(Position)

(Name)