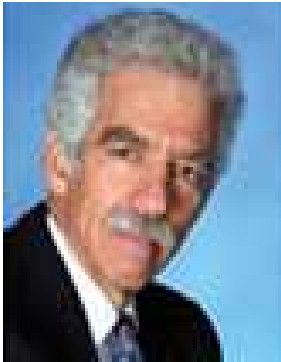




SDIPLA News



On April 27th at the La Jolla Marriott, **PROFESSOR PAUL GARDNER, ACADEMIC DIRECTOR OF THE PATENT RESOURCE GROUP**, will present a talk concerning the Federal Circuit's current proclivity for either narrowly interpreting broad claims or holding them invalid for lack of written

description. Mr. Gardner will discuss the impact of the recent Federal Circuit case law on patent drafting and prosecution strategy. His talk will include pointers on how to prepare for drafting a patent application, what should be included and excluded from the specification, how to draft claims which will literally cover competitors' products yet survive a validity challenge, and how to develop a protocol and philosophy for prosecuting the application. Additionally, his talk will highlight lessons for all patent lawyers including essential do's and don'ts for prosecutors and the Achilles' heels for opinion writers and litigators.

THURSDAY APRIL 27TH MEETING

"A View Of The Federal Circuit's Penchant For Either Narrowly Interpreting Broad Claims or Holding Them Invalid For Lack of Written Description"

BY: PROFESSOR PAUL L. GARDNER

Upcoming Events:

~May 25 - Chief Judge Damich - US Court of Claims

~May-Nominations for Treasurer Are Due

~June 22- TBA SDIPLA Board Member Elections

~July- August Summer Break

Professor Gardner is currently the Academic Director of Patent Resources Group (PRG) a position he has held since January 2000. Previous to PRG, he was in IP practice in Los Angeles for 25 years and Seattle for 8 years. He has also taught Patent and Trademark courses at the UCLA Law School (1990-1994) and the University of Washington Law School (1996-1999). Professor Gardner is licensed to practice law in Washington State and California. He received his J.D. from George Washington University in 1965 and his B.S. in engineering from the University of Missouri in 1962. He was also an Examiner at the United States Patent and Trademark Office for 2 years.

PRG is based in Charlottesville, Virginia. PRG, under the academic direction of Paul Gardner and Irving Kayton, provides a variety of courses and education materials, including patent bar reviews, patent workshops and advanced patent law courses.

April 27th Dinner Meeting-La Jolla Marriott

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Date/Time/Location:

April 27, 2006
6:00 p.m.– 8:30 p.m.

Marriott La Jolla
4240 La Jolla Village Drive
La Jolla, CA 92037

858 587-1414

Directions:

North on I-5, exit at La Jolla Village Drive

Turn right and head East

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

Parking is \$7.00

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Dodging a Bullet – Getting Out From Under Your Own Art in Australia

By Bill Bennett

This article was originally published in the March 2006 issue of Intellectual Property Today.

Introduction

It is not unusual for an inventor to make an improvement or modification to an invention subsequent to the first publication of the invention, and it is often the case that the improvement or modification is of marginal patentability over the original or “main” invention.

The availability of a grace period under US law has meant that it may still be possible to pursue protection for the improvement or modification, provided that a US application directed to the improvement or modification is filed within 12 months of the publication of the main invention.

However, problems often arise when seeking corresponding protection for the improvement or modification in foreign jurisdictions. Specifically, it is not unusual in foreign jurisdictions to have a situation arise in which the main invention is cited as prior art against the improvement or modification.

This article offers a solution that is available in Australia when such a situation arises.

Overcoming an Obviousness Rejection Based on Applicant’s Own Publication

It is, of course, preferable to traverse the obviousness rejection if possible. However, assuming this is not possible, the solution is to convert the later Australian application (which is directed to the improvement or modification) to be a “Patent of Addition” based on the earlier Australian application/patent (which is directed to the “main” invention).

The relevant provision¹ reads as follows:-

Where:

a patent for an invention (in this Chapter called the main invention) has been applied for or granted; and

(b) the applicant or patentee (or a person authorised by the applicant or patentee) applies for a further patent for an improvement in, or modification of, the main invention; and

(c) the application for that further patent is made in accordance with the regulations;

the Commissioner may, subject to this Act and the regulations, grant a patent of addition for the improvement or modification.

¹ Section 81

Cont. page 5

Reservation Form for April 27th Meeting (La Jolla Marriott)

"A View Of The Federal Circuit's Pendant For Either Narrowly Interpreting Broad Claims or Holding Them Invalid For Lack of Written Description"

PAUL GARDNER

Thursday- April 27, 2006

6:00-8:30 p.m.

The Menu

Crisp Wedge of Iceberg Lettuce with Vine Ripened Red and Yellow Tomatoes
Chipotle Ranch Dressing

Poultry

Roasted Breast of Chicken with Sun-dried Tomato Orzo and Lemon Caper Sauce
Steamed Asparagus and Ratatouille

Seafood

Spice Crusted Salmon
Blended Whole Grain Pilaf with Merlot Braised Root Vegetables

Vegetarian

Sautéed Spinach and Diced Oven Roasted, Zucchini, Yellow Squash
Eggplant, Carrots, Garlic and Onion with a Marinara Sauce
Encased in a Tender Pastry Crust

Desert

White Chocolate Espresso
Dark Chocolate Sponge Cake Drenched in a White Chocolate Filling
Topped with a Delightful Espresso Garnish

Freshly Brewed Coffee, Decaffeinated Coffee, & Iced 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:

Robert Prince
SDIPLA Secretary
14651 Woodhue Lane
Poway, CA 92064
(858) 722-4597
FAX: (858) 748-8201
rprince@sbcglobal.net

On-line registration available at www.sdipla.org or www.Acteva.com (search using the term SDIPLA)

Please complete 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 12:00PM, April 21, 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 .
- Meeting is at the La Jolla Marriott

NOTE Meeting PRICES

\$45.00 SDIPLA Member

\$60.00 Non-Member

Reservation Form for April 27TH Meeting

Name: _____

E-Mail Address: _____

Firm/Employer: _____

Telephone Number: _____

Member of SDIPLA? (circle one) YES NO

- Salmon**
 Chicken
 Vegetarian

DEADLINE FOR REGISTRATION IS 12:00PM, April 21, 2006

MEMBERSHIP RENEWAL

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: Robert Prince

Attorney Member Dues: \$50/year SDIPLA Secretary

Non-Attorney/Retired Attorney Dues: \$25/year 14651 Woodhue Lane

(e.g. law students, paralegals, patent agents, retired attorneys, etc.) Poway, CA 92064

Please Renew Your Membership for Fiscal 2005-2006

All SDIPLA members are asked to send in their membership dues, if they have not already, using the Membership Renewal form above.

- E-Mailing of newsletters and notices will replace regular mailing.
- SDIPLA had approximately 275 active members in 2004-2005.
- **On-line registration now available– visit 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.

Cont. from page 2

Importantly for the present scenario, it is further provided² that:-

Objection cannot be taken...in respect of an application for a patent of addition, and a patent of addition is not invalid, merely because the invention, so far as claimed, does not involve an inventive step, having regard to the publication or use of the main invention during the prescribed period.

“Prescribed period” is defined³ as follows:-

The prescribed period is the period that commences on the priority date of the claim of the specification of the main invention and ends immediately before the priority date of the relevant claim of the specification of the patent of addition.

The result is that publication of the main invention in the window of time between the priority date of the main Australian application/patent and the priority date of the later Australian application is excluded from the prior art base for the purpose of assessing obviousness.

Thus, in essence, the main invention ceases to be prior art, for obviousness, against the improvement or modification. The *quid pro quo* is that the term of the Patent of Addition is tied to the term of the main patent, and some patent term will be sacrificed in adopting this strategy.

Note that there is no restriction on when an application (or patent) may be converted from a normal application (or patent) to a Patent of Addition. Thus, the conversion may be made during the prosecution of the later application in response to a rejection based on the publication of the main invention. The only restriction on timing is that the initial or “main” application (or patent) must be in force at the time that the later application (or patent) is converted to be a Patent of Addition.

A small collateral benefit for the applicant resides in the fact that no maintenance fees are payable in relation to a Patent of Addition. The Patent of Addition is deemed to be maintained as long as the main Patent is maintained. In the event that the main patent is later abandoned or revoked, maintenance fees will again become payable in relation to the Patent of Addition. However, the term of the Patent of Addition remains linked to the term of the main patent and the forfeited term is not regained.

A Patent of Addition need not be more limited in scope than the main Patent. Put differently, the claims of the Patent of Addition need not be within the scope of the claims of the main Patent. Thus, a Patent of Addition may be used to broaden the scope of the main Patent. In a most extreme example, the Patent of Addition could be broader than the main Patent by complete omission of a claimed feature, with the omission constituting the improvement or modification⁴. Having said that, it should be borne in mind that the improvement or modification will still need to be novel over the main invention, and it may be difficult to make an argument that the broader claim is not anticipated by the publication of the main invention.

Summary

Converting the later Australian application to be a Patent of Addition has the effect of disqualifying the publication of the main invention as prior art for the purposes of assessing the obviousness of the improvement or modification.

The *quid pro quo* is that there will be some loss of patent term.

About the Author: Bill Bennett is an Australian and New Zealand Patent Attorney and Partner in the IP Boutique firm, Pizzeys Patent & Trademark Attorneys. He can be contacted at bbennett@pizzeys.com.au

² Section 25

³ Regulation 2.4

⁴ see *Hughes Tool Company v. Ingersoll-Rand Company Limited* [1977] FSR 406

Announcements

This Announcements section 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 Rob Prince if you would like to place an ad or announcement.

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Email resume and writing sample in confidence to recruiting@ifllaw.com.

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

SDIPLA COMMITTEES

SDIPLA has Amicus, Awards, Editorial, Events, and Sponsorship committees. **Members are needed for the sponsorship and events 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.

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 before May 1, 2006.

Scott Davison

Bruce Elder

Mary Fales

Ryan Blackstone-
Gardner

Mary Hardy

Chris Kim

Athar Kahn

Tamelah Morris

Anthony Smyth

Matthew Wahlrab

Lee Yung-Hui

ARTICLES: If you have an article for the newsletter, please send it to Rob Prince.

DUES: To pay or renew your **membership dues:** Please use the form on page 4, and send form via mail or fax to Rob Prince. - online registration now available - visit www.SDIPLA.org.

Announcements (continued)

This Announcements section 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 Rob Prince if you would like to place an ad or announcement.

Johnson & Johnson, headquartered in New Brunswick, New Jersey, offers exciting opportunities for motivated individuals. We are currently seeking an experienced patent attorney to serve with other attorneys on site at the La Jolla, California facility of Johnson & Johnson Pharmaceutical Research & Development, L.L.C. Johnson & Johnson, a Fortune 50 company with over 150 operating companies around the world, has combined annual sales of over \$50 billion and a strong commitment to research and its protection through a comprehensive patent program.

Patent Attorney

As a patent attorney, you will be responsible for all facets of patent practice, including preparing and prosecuting patent applications, conducting due diligence evaluations, drafting agreements, and performing freedom-to-operate and infringement studies. You will also counsel research personnel while interacting with all levels of management.

To qualify, you must be admitted to practice before the United States Patent and Trademark Office and to at least one state Bar (preferably California) as well as have 5+ years of patent preparation, prosecution and client counseling experience in organic chemistry (preferably focused on pharmaceuticals or small molecule technology). Experience with a law firm is strongly preferred.

Johnson & Johnson is an equal opportunity employer (EOE) committed to diversity, offering a competitive compensation package. Please send resume via electronic mail only to: SSalina2@prdus.jnj.com.

The SDIPLA thanks our Sponsors for the
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(listed alphabetically)