



SDIPLA News

SDIPLA Board of Directors for the 2007/2008 Term

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OCTOBER 11th DINNER MEETING FEATURING BOB SPAR

Robert J. Spar is the former Director of the Office of Patent Legal Administration, (OPLA), under the Deputy Commissioner for Patent Examination Policy at the U.S. Patent and Trademark Office (USPTO). A major responsibility of the OPLA is addressing policy initiatives involving the patent examination process. This includes developing, implementing and disseminating information about changes to patent examining practices and procedures via rulemaking, publishing notices in the Federal Register and the Official Gazette, modifying USPTO forms which are used both internally and externally, and distributing internal memoranda.

Mr. Spar will speak about the new USPTO Continuation and Claim rules.

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October 11, 2007 Dinner Meeting — La Jolla Marriott Hotel:

Date/Time/Location:

October 11, 2007
6:00 p.m.—9:00 p.m.
La Jolla Marriott Hotel
4240 La Jolla Village Drive
La Jolla, California

Notes:

This is a **dinner** meeting.
Speaker: Robert Spar

Directions:

From I-5 N to La Jolla Village Dr.;
Turn right on La Jolla Village Dr.;
U-turn at Genesee Ave.

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Internet Sightings

by Jim Hawes (continued on page 3)

I/P Updates – a blog by Bill Heinze – www.ip-updates.com

* The 9/20/07 blog reports that the Ocean Tomo Bank now specializes in helping IP owners leverage their IP assets.

AIPLA Direct – a newsletter issued from time to time – www.aipla.org

* The AIPLA now offers a series of online seminars for both members and non-members. Contact them to get on their notice distribution list.

PTO notices – www.uspto.gov/main/newsandnotices

* The 8/10/07 Fed. Register (72 FR 44992) includes a PTO proposed new rule permitting restriction between alternatives in a single claim.

- The 8/28/07 e-alert includes a “Did you know” reminding all that to use the USPTO/JPO/EPO automatic transfer of priority documents a Form SB-39 has to be on file in the US application.

The 9/11/07 OG includes two notices: (1) the use of electronic signatures, and (2) the final rules changing continuation application practices. Read both.

Copyright Office News – copynews@loc.gov -

- The 9/11/07 issue invites participation in beta testing of a new copyright online registration system.

The SDIPLA thanks our Sponsors for the monthly meetings:

Knobbe Martens Olson & Bear LLP
www.kmob.com

Paul, Hastings, Janofsky & Walker LLP
www.paulhastings.com

Townsend and Townsend and Crew LLP
www.townsend.com

(listed alphabetically)

Hal Wegner's newsletter – the best of a lot of great stuff - hwegner@foley.com –

- The second 8/30/07 newsletter attaches Donald Dunner's "Retrospective of the Federal Circuit's First 25 Years," essential reading for CAFC watchers.
- The 9/3/07 issue discusses the McFarling, Quantec, Nuijten and Pfizer appeals pending before the Supreme Court.
- The 9/4/07 newsletter cites more PTO notices about claim problems – esp. generic claims and claims "difficult to construe," and actions taken to oppose these practices.
- The 9/7/07 issue reports the CAFC's Gillespie decision expanding the scope of prosecution history estoppel.
- The 9/8/07 message cites a concise summary of the current patent legislation and its outlook for passage.
- If you have any doubt about the profitability of patent litigation practice, check Hal's 9/10/07 message reporting the AFG Bleak House, appellate ping-pong case filed 11 years ago and still going strong.
- **DON'T BELIEVE EXAMINERS** – Hal's 9/10/07 issue reports a Commissioner's decision in the Miller case holding that one can't rely on any oral statement by an examiner (here, that a new action would be issued).
- The 9/12/07 issue gives Hal's thoughts on prospects for patent reform in the current congress.
- Hal's 9/13/07 message blasts the exam. support document required by new rule 256 as a "sham." Good reading.
- Hal's 9/15/07 issue reports that only 15% of the acc. exam. petitions have been granted. I.e. – don't use them.
- The 9/21/07 newsletter reports the CAFC Paymentech decision holding that method claims require all steps to be performed by the infringer, and attaching a paper suggesting how to now draft such claims.
- Hal's 9/26/07 posting includes his current Top Ten cases on appeal list.
- The 9/24/07 issue discusses the CAFC's Mitchell decision holding that a means claim limitation requires disclosure of a specific embodiment. So never use means claims, I guess.
- Hal's second 9/26/07 posting reports that the PTO is offering a webinar for downloading that explains the new continuation rules.

Reservation Form for October 11, 2007 SDIPLA Meeting

OCTOBER 11, 2007 DINNER MEETING
"The New USPTO Continuation and Claim Rules"
Robert Spar
La Jolla Marriott Hotel

Thursday
October 11 2007

La Jolla Marriott Hotel

Registration starts at 6:00 p.m.
 Dinner starts at 6:45 p.m.
 Presentation starts at 7:15 p.m.

The Menu

Caesar Salad with Reggiano Cheese and Crostini

With one of the following entrees:

Grilled Chicken

With Mandarin orange glaze and couscous

** OR **

Roasted Salmon

On wilted greens, saffron cream sauce

** OR **

Vegetarian Selection

Vegetable Wellington

And

Chocolate velvet bombe

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:

Jessica Mitchell
 SDIPLA Secretary
 Neil, Dymott, Frank, McFall & Trexler
 1010 Second Avenue, Suite 2500
 San Diego, CA 92101
 (619) 238-1712
 Fax: (619) 238-1562
 jmitchell@neildymott.com

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 Jessica Mitchell at the address, fax, or e-mail address indicated for receipt **no later than October 8, 2007.**
- 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

\$50.00 SDIPLA Member

\$60.00 Non-Member

Registration

Name: _____ E-Mail Address: _____

Firm/Employer: _____

Telephone Number: _____

Member of SDIPLA? (circle one) YES NO

Entrée Choice: _____ Chicken _____ Salmon _____ Vegetarian



Federal Circuit Overrules Precedent - A Sea Change in the Law on Willfulness

by Lawrence Gotts, Bruce Wexler, Michael Bednarek and Aslan Baghdadi (cont. p. 6)

In a decision dated August 20, 2007, Seagate Technology, LLC (Miscellaneous Docket No. 830), the Court of Appeals for the Federal Circuit has reversed precedent dating almost to the inception of that Court, and raised the standard for proving that an adjudged infringer's conduct was willful (which could entitle the patent owner to up to treble damages and attorney fees). Under the Court's precedent, *Underwater Devices Inc. v. Morrison-Knudsen Co.*, 717 F.2d 1380 (Fed. Cir. 1983), a company with knowledge of a patent had an affirmative duty of care to avoid infringement. In its Seagate decision, the Federal Circuit reversed itself with regard to the affirmative duty to avoid infringement, which it likened to a negligence standard, in favor of a new standard requiring a showing of recklessness by clear and convincing evidence in order for the jury to conclude that the infringement was willful. Accordingly, patentees will have a higher burden to provide willfulness in future and pending litigation. *Id.* at 12 ("[T]o establish willful infringement, a patentee must show by clear and convincing evidence that the infringer acted despite an objectively high likelihood that its actions constituted infringement of a valid patent").

Under the new willfulness standard "a patentee must show by clear and convincing evidence that the infringer acted despite an objectively high likelihood that its actions constituted infringement." Seagate at 12. While this standard will be developed further in future decisions, it is clear that the failure of a party to obtain a written opinion of counsel is not sufficient grounds alone for finding of willfulness.

Companies that are alerted as to another company's patent are not automatically obligated to go to the expense of obtaining a competent opinion of counsel before continuing their activities. *Id.* ("Because we abandon the affirmative duty of due care, we also reemphasize that there is no affirmative obligation to obtain opinion of counsel."). Instead, courts will focus on what a reasonable company should have done under the circumstances.

The Court of Appeals also clarified last year's ruling in *Echostar Communications Corp.*, 448 F.3d 1294 (Fed. Cir. 2006), and held that a waiver of privilege with respect to an opinion prepared by an attorney retained solely to provide an opinion would not operate as a waiver of privilege for communications between trial counsel and his or her client on the subject matter of the opinion. *Id.* at 15 ("Therefore fairness counsels against disclosing trial counsel's communications on an entire subject matter in response to an accused infringer's reliance on opinion counsel's opinion to refute a willfulness allegation.").

If you have any questions concerning these developing issues, please do not hesitate to contact any of the following Paul Hastings lawyers:

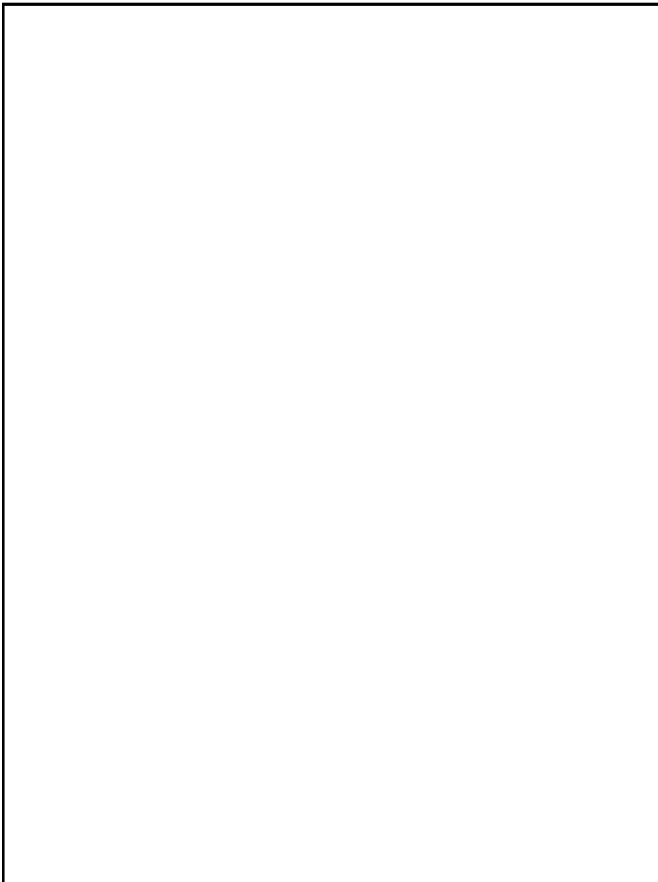
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Employment Situation Available (continued on p. 8)



Rayspan Corporation's core business is in licensing its proprietary Revolutionary Metamaterial Air Interface technology. We are seeking an experienced Intellectual Property attorney or agent to work with our management, technical team, and outside patent attorneys to build the company's IP foundation and licensing strategies. The ideal candidate will have experience in drafting, filing, maintaining, and licensing patents in the Radio Frequency domain.

Essential Duties:

The primary responsibilities of the patent Attorney/Attorney are:

- Secure Rayspan's IP by working closely with the R&D group and by establishing and leading a process to efficiently protect the company's breakthrough RF innovations and discoveries.
 - Prosecute and maintain existing patent portfolio.
-
- Work with external patent counselors.
 - Work with Rayspan's management to establish a strategy and process to license the company's IP to its direct and indirect customers.

Experience & Education

- 2+ years of U.S. and international patent drafting and prosecution
- Technical background in electrical engineering with RF focusAbility to apply innovative strategies to maximize value of the company's intellectual property.
- Excellent oral and written communication skills



Employment Situation Available (continued)

Rayspan Corporation's core business is in licensing its proprietary Revolutionary Metamaterial Air Interface technology. We are seeking an experienced Intellectual Property attorney or agent to work with our management, technical team, and outside patent attorneys to build the company's IP foundation and licensing strategies. The ideal candidate will have experience in drafting, filing, maintaining, and licensing patents in the Radio Frequency domain.

General Description:

Rayspan Corporation is the world's leading innovator of revolutionary Metamaterial Air Interface solutions for high performance wireless communication networks. Metamaterial designs are based on left-handed structures that exhibit negative index of refraction and other electromagnetic properties not found in natural media. These unique properties enable breakthrough improvements in communication system performance.

Rayspan is developing a broad line of metamaterial air interface devices including antennas, filters, diplexers, couplers, and matching networks. Its research and development activities encompasses analysis, design, modeling, simulation, and prototype development and test.

Send resume to career@rayspan.com. Please go to www.sdipla.com for complete information.

MEMBERSHIP/RENEWAL APPLICATION

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: Jessica S. Mitchell

Attorney Member Dues: \$50/year SDIPLA Secretary

Non-Attorney/Retired Attorney Dues: \$25/year Neil Dymott Frank McFall & Trexler, PC

(e.g. law students, paralegals, patent agents, retired
attorneys, etc.) 1010 Second Ave, Suite 2500

San Diego, CA 92101

Notes Regarding Your Membership

- E-Mailing of newsletters and notices has replaced regular mailing.
- **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.

USPTO Symposium on October 29, 2007 at the USD Joan B Kroc Institute for Peace and Justice

John LeGuyader, Director of TC 1600 and other top managers from Technology Center 1600 (pharmaceuticals, biotechnology and chemistry) will discuss:

Proposed changes to alternative claiming (Markush) practice (John Le Guyader, Director TC 1600);
Restriction practice (Julie Burke);
Patentability of stem cells and products (Ram Shukla);
Patentability of antibodies and methods for use (Bonnie Eyler); and
Patentability of genes and gene fragments (Doug Schultz).

Other topics may be included.

What you will learn: You will learn the latest information from top levels of the TC 1600 that will help you understand the changes in patent law in the life sciences.

Who should attend: Scientists, executives, attorneys, consultants and staff of companies involved in biotechnology, pharmaceuticals, or chemistry.

Lunch and written materials will be provided. CLE credit for California Attorneys will be requested

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

ARTICLES: If you have an article for the newsletter, please send it to Jessica.
DUES: To pay or renew your **membership dues:** Please use the form on page 9, and send form via mail or fax to Jessica Mitchell. - online registration now available - visit www.SDIPLA.org.

Date	Event	Speaker/Topic
October 29, 2007	USPTO symposium at USD	John LeGuyader, Director of TC 1600 and other managers at TC 1600