



# SDIPLA News

**June 24, 2010  
Legal Panel**

Please join us as we welcome District Judges The Hon. Rudi M. Brewster, the Hon. Marilyn L. Huff, The Hon. Janis L. Sammartino and, as Moderator, Qualcomm’s Senior Vice President and Deputy General Counsel Carol Lam (former San Diego Superior Court Judge and U.S. Attorney in the Southern District of California).

**Topics to Include:**

- ◆ Procedures on Markman Hearings
- ◆ Trends in limiting claims in S.D. Cal. Markman Hearings
- ◆ Practitioner tips for helping judges in patent trials
- ◆ Practitioner tips for winning patent cases

**San Diego Intellectual Property Law Association**  
<http://www.sdipla.org/index.htm>

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**Date/Time/Location:**

June 24, 2010  
 6:00 p.m.—9:00 p.m.  
 DEL MAR MARRIOTT  
 11966 El Camino Real  
 San Diego, CA 92130

**Directions:**

From I-5 exit Carmel Valley Road  
 East on Carmel Valley Road  
 North on El Camino  
 West on Valley Centre Drive

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Kenneth E. Jenkins

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Kenneth E. Jenkins

## REMINDERS

### Update Contact Info

Please submit changes of your contact information to Ken Jenkins: ([kejenkins@townsend.com](mailto:kejenkins@townsend.com))

### Membership Renewal

Please renew your membership at:  
<http://www.acteva.com/booking.cfm?bevaaid=95102>

### Articles/Advertising

If you have an article and/or advertising for the newsletter, please contact Ken Jenkins:  
([kejenkins@townsend.com](mailto:kejenkins@townsend.com))

### Sponsorship

If your firm or company is interested in sponsoring a meeting, please contact Ken Jenkins:  
([kejenkins@townsend.com](mailto:kejenkins@townsend.com))

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

Foley & Lardner LLP ([www.foley.com](http://www.foley.com))

Knobbe Martens Olson & Bear LLP ([www.kmob.com](http://www.kmob.com))

Perkins Coie LLP ([www.perkinscoie.com](http://www.perkinscoie.com))

Quant Economics ([www.quanteconomics.com](http://www.quanteconomics.com))

Townsend and Townsend and Crew LLP  
([www.townsend.com](http://www.townsend.com))

(listed alphabetically)

## Legal Panel

Please join us as we welcome District Judges The Hon. Rudi M. Brewster, the Hon. Marilyn L. Huff, The Hon. Janis L. Sammartino and, as Moderator, Qualcomm's Senior Vice President and Deputy General Counsel Carol Lam (former San Diego Superior Court Judge and U.S. Attorney in the Southern District of California)

Thursday, June 24, 2010

**Dinner Meeting  
Del Mar Marriott**

**Registration: 6:00 p.m.**  
**Cocktails: 6:00 p.m.**  
**Dinner: 7:00 p.m.**

**Menu:**

Fresh Seasonal Salad  
With one of the following entrees:

**Herb Roasted Chicken**  
**Salmon Dill Buerre Blanc**  
**Mushroom Pasta w/Vegetables**

**Dessert**  
**Coffee and Tea**

Registration and payment is due  
**no later than June 21, 2010**

**Early Registration Recommended**

Reserve your space online at:

[http://www.acteva.com/booking.cfm?  
binid=1&bevalD=203083](http://www.acteva.com/booking.cfm?binid=1&bevalD=203083)

Or register below and mail  
with your check made payable to 'SDIPLA' to:

Ken Jenkins, SDIPLA Secretary  
Townsend and Townsend and Crew LLP  
12730 High Bluff Drive, Suite 400  
San Diego, CA 92130

**MEAL PRICE**

SDIPLA members: \$55.00 per person  
(plus \$3.32 Acteva service fee)

Non-members/guests: \$65.00  
(plus \$3.77 Acteva service fee)

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

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

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

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

Member of SDIPLA? (circle one) YES NO

Entrée Choice: \_\_\_\_\_ Chicken \_\_\_\_\_ Salmon \_\_\_\_\_ Vegetarian



## **SDIPLA 2010-2011 BOARD ELECTION**



- ◆ **Election for Treasurer will be held at the June 24, 2010 dinner meeting. The SDIPLA Board is proud to endorse the candidacy of Marc T. Morley for 2010-2011 Treasurer. Mr. Morley's Statement of Candidacy is listed on page 6.**
- ◆ **If you are unable to attend the June 24th meeting, please fill out attached proxy form found on page 5 and send to Ken Jenkins ([kejenkins@townsend.com](mailto:kejenkins@townsend.com)).**

# PROXY VOTE FOR SDIPLA BOARD 2010-2011 ELECTION

*Please mail or e-mail your proxy vote by Tuesday, June 22, 2010 to:*

Ken Jenkins  
SDIPLA Secretary  
(kejenkins@townsend.com)  
Townsend and Townsend and Crew  
12730 High Bluff Drive, Suite 400  
San Diego, CA 92130



## POSITION

## SDIPLA BOARD'S NOMINEES

Past-President

Jessica Mitchell

President

John Peterson

Vice-President

Ken Jenkins

Secretary

Kurt Kjelland

Treasurer

Marc T. Morley

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

### **Statement of Marc T. Morley**

#### **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 2000 in the San Diego office of Knobbe, Martens, Olson and Bear LLP. I joined the partnership in 2006. I became involved in patent and trademark prosecution early in my career, and those have become the focus of my practice. My practice now also includes licensing, due diligence and opinion work related to intellectual property matters. I have prepared and prosecuted patent and trademark applications for clients in various fields of technology from life sciences and medical devices to clean technology and computer technology in both the U.S. and foreign countries. I am admitted to practice in the State of California, before the U.S. Patent & Trademark Office, the United States Supreme Court, the Federal Circuit Court of Appeals and a number of District Courts.

Prior to joining Knobbe Martens I was a summer law clerk for the U.S. Senate Judiciary Committee where I worked on legislative projects including the Omnibus Patent Reform Act of 1997, the Digital Millennium Copyright Act, and the Database Piracy Act. In 1999, I also served as a judicial extern to the Honorable D. Lowell Jensen, U.S. District Court, Northern District of California.

As part of my legal community involvement, I am an Adjunct Professor of Patent Law at the University of San Diego Law School and an Instructor of Biotechnology Patent Law at the UCSD Extension. My legal community involvement also includes serving as the co-chair of the Intellectual Property Section of the San Diego County Bar Association and a three year term as a member of the Alumni Board of Governors for the U.C. Hastings College of the Law. I also recently completed two years of service on the IPO Pharmaceutical Issues Committee.

#### **Brief statement:**

The main reason for my interest in joining the board of SDIPLA is to give back to San Diego legal community by helping fellow IP practitioners, whether they be 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. I feel that my time practicing at Knobbe Martens over the last 10 years, along with my legal community involvement, has put me in the 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.

Marc T. Morley

# INTERNET SIGHTINGS

By Jim Hawes

This column highlights some of the more notable recent internet notices, newsletters and blogs dealing with IP prosecution issues. The full IS column, with compilations of some of the sources such as Hal Wegner's newsletter, is now up and available at [www.internetsightings.com](http://www.internetsightings.com). Check it out.

**Hal Wegner's** newsletter – a lot of great stuff – Contact: [hwegner@foley.com](mailto:hwegner@foley.com)

- The 5/1/10 email reports the Boehringer EPO decision reversing a double patenting rejection as unsupported by the EPC.
- The 5/7/10 newsletter foresees the present PTO application backlog of 750K swelling to over 1M shortly if dramatic action is not taken.

**Patently-O** – a blog written by Dennis Crouch – [www.patentlyo.com](http://www.patentlyo.com).

- The 5/1/10 blog reports a pendency study for those patents issued 4/27/10. Average pendency ranged from 2.8 years for patents claiming both non-provisional and foreign priority, to 4.1 years for patents claiming neither. Ten percent of the patents resulted from applications filed more than six years earlier.
- The 5/2/10 offering reports that in 2009 the PTO issued an average of about 3200 utility patents per week. In April 2010 they issued about 4400 patents per week, which is about 220K per year.
- The 5/4/10 message discusses the Sec. of Commerce's view that the PTO needs control of its funding and an enhanced post-grant review.
- The 5/18/10 blog cites Prof. Chien's (Santa Clara Law School) prediction that the Supreme Court will hold Biliski's claim unpatentable. Her reasons seem sound.
- The 5/21/10 email published some patent issuance data showing a low bounce in 10/09 to 48% and a rise back to 64% in 4/10.
- The 5/27/10 post presents current patent grant rate data by tech center.

**Carl Oppedahl** – emails of IP practice matters: [carl@oppedahl.com](mailto:carl@oppedahl.com).

- The 5/17/10 email presents a PCT application multiple power of attorney best practice discussion.
- A second 5/17/10 email discusses restoration of priority in a PCT application.
- The 5/26/10 messages (2 posts) discuss how to pick an ISA.

**Cal Bar IP Section** – alerts when appropriate – Contact: [mitch.wood@calbar.ca.gov](mailto:mitch.wood@calbar.ca.gov)

- The May 2010 Journal reports that an attorney was fined and disbarred for representing former opposing clients, including lying to them.

*INTERNET SIGHTINGS* by Jim Hawes – continued

**AIPLA Direct** – a newsletter issued from time to time [http://www.aipla.org/Content/ContentGroups/About\\_AIPLA1/AIPLA\\_Reports/AIPLA\\_Reports\\_TOC.htm](http://www.aipla.org/Content/ContentGroups/About_AIPLA1/AIPLA_Reports/AIPLA_Reports_TOC.htm)

**PTO** – [www.uspto.gov/main/newsandnotices](http://www.uspto.gov/main/newsandnotices)

- Director Kappos has proposed a three track examination system: 1. an accelerated exam track for an extra fee, 2. a regular exam as now, and 3. a deferred exam track of up to 30 months. Any interest? The PTO announced on 5/20/10 a contingency option for EFS users (everyone?) when the primary EFS portal is down – see 75 FR 27986.

**TTABlog** – a blog written by John Welch – [www.TTABlog.com](http://www.TTABlog.com)

- The 5/13/10 blog discussed the Fred Beverages CAFC decision reversing a TTAB denial of a motion to add classes to a cancellation proceeding due to no fee being tendered; the applicable rule did not require a fee said the CAFC.
- The 5/21/10 email cites a paper on Bose, Fraud and the TTAB for those interested in that kind of stuff. The 5/26/10 issue discusses the Montecash TTAB decision holding that a registration more than 5 years old may not be challenged as generic. The design mark included “Montejio” which means pawn shop in Spanish.
- The 5/27/10 blog discusses the Anpath TTAB decision distinguishing between an advertising material specimen (not OK) and point of purchase material (OK) on some esoteric, psychic basis.

#### **Other Stuff –**

- The PLI will hold a claim drafting and amendment writing boot camp in SF on July 7-9. The Chisum Patent Academy will hold a patent law workshop on 7/29-31/10 in Seattle WA. Sure to be an outstanding event.

For more information about any of the patent topics mentioned consult *Patent Application Practice* published by West and updated twice a year.



## EMPLOYMENT OPPORTUNITIES

FITCH EVEN TABIN & FLANNERY, a national Intellectual Property law firm, is expanding its Woodland Hills office. This location is away from the traffic and congestion of downtown Los Angeles. FETF is seeking partners and associates who have established client relationships. We have offices in Chicago, San Diego, San Luis Obispo, Washington, D.C., and Boulder.

To learn more about the firm and our practice, please visit us at: <http://www.fitcheven.com>

All submissions are held in confidence. For confidential discussion and consideration, please contact:

Barbara LaRocco  
Recruitment Coordinator  
[blaro@fitcheven.com](mailto:blaro@fitcheven.com)  
FITCH EVEN TABIN & FLANNERY  
Suite 1600  
120 S. LaSalle Street  
Chicago, IL 60603  
(312) 577-7000  
(312) 577-7007 (Fax)



*The Intellectual Property Law  
Section of the State Bar of California  
announces publication of a new  
treatise and practice guide*

### Trade Secret Litigation and Protection in California

New Second Edition



25 Chapter Practice Guide

New Edition features:

- Reference to more than 65 new trade secret cases
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- New appendix with CACI trade secret jury instructions

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