



SDIPLA News

Upcoming Events:

September 23, 2010 Dinner Meeting

For the September Panel Discussion, SDIPLA presents:

“Inequitable Conduct Before the PTO: What Standard
Should Be Adopted by the Federal Circuit?”

1.0 MCLE Credit

Invited Panel Members:

- Hans Sauer-Deputy General Counsel for IP, BIO
- Professor Christian Mammen-University of California, Hastings
- Larry Respass-SDIPLA Amicus Committee Member
- Frederick F. Hadidi-Chao Hadidi Stark and Barker

San Diego Intellectual Property Law Association

<http://www.sdipla.org/index.htm>

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Date/Time/Location:

September 23, 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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REMINDERS

Membership Renewal

**Please renew your membership for 2010-2011 at:
<http://www.acteva.com/booking.cfm?bevoid=95102>**

Update Contact Info

Please submit changes of your contact information to
Kurt Kjelland: (kkjelland@foley.com)

Articles

If you have an article for the newsletter, please send it
to Kurt Kjelland: (kkjelland@foley.com)

Sponsorship

If your firm or company is interested in sponsoring a
meeting, contact Kurt Kjelland: (kkjelland@foley.com)

**The SDIPLA would like to thank our
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(listed alphabetically)

September 23, 2010 Dinner Meeting

“Inequitable Conduct Before the PTO:
What Standard Should Be Adopted By The Federal Circuit?”

Thursday September 23, 2010

**Dinner Meeting
Del Mar Marriott**

Registration: 6:00 p.m.
Cocktails: 6:00 p.m.
Dinner: 7:00 p.m.
Discussion: 7:30 p.m.

Menu:

Fresh Seasonal Salad

With one of the following entrees:

Chicken

Salmon

Vegetables

Dessert

Coffee and Tea

Reserve your space online at:

[http://www.acteva.com/booking.cfm?
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Or register below and mail

WITH YOUR CHECK MADE PAYABLE TO ‘SDIPLA’ TO:

Kurt M. Kjelland
SDIPLA Secretary
Foley & Lardner, LLP
3579 Valley Centre Drive, Suite 300
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MEAL PRICES

SDIPLA members: \$65.00 *(plus Acteva service fee)*

Non-members: \$85.00 *(plus Acteva service fee)*

**Dinner Registration and payment is due
no later than September 20, 2010.**

Please fill out a separate form for Each Attendee

Name: _____

E-Mail Address: _____

Firm/Employer: _____

Telephone Number: _____

Member of SDIPLA? (circle one) YES NO

Entrée Choice: _____ Chicken _____ Salmon _____ Vegetarian

STRATEGIES FOR LEVERAGING RECENT CHANGES TO THE USPTO'S COUNT AND DOCKETING SYSTEMS

By Patrick Jewik

The United States Patent and Trademark Office (USPTO) under Director David Kappos recently instituted a number of changes internally which will have a significant impact on how patent applications are processed. These changes were made to provide both USPTO examiners and patent applicants with incentives to address issues early in the examination process.

The first of these changes is to the USPTO's "count" system. The number of counts earned by an examiner during a patent examination is used to track his or her productivity. Historically, an examiner would receive one count for a non-final Office Action and one count for a "disposal," which may be obtained after an allowance, abandonment or appeal.

To incentivize examiners to deal with patentability issues early in the process, the count system has been revised to provide more counts earlier in the examination process and fewer counts later in the process. For example, under the new count system:

- 1.25 counts are given for a first Office Action in an original case, 0.25 counts are given to an examiner for a final rejection, and 0.5 counts are given to an examiner for an allowance or abandonment.
- One count is received for a first Office Action after a request for continued examination (RCE) filing and 0.75 counts are received for Office Actions prepared for subsequent RCE filings.

Now less credit is given for Office Actions issued after second and subsequent RCE filings, thus discouraging the practice of giving continuous final rejections in an application.

Because these changes encourage examiners to provide a more careful examination and resolve issues earlier in the examination process, the new "count" system would seem to favor applicants. However, the USPTO has also made significant changes to its docket management policy to pressure applicants to resolve issues quickly. The most significant change is that RCE filings are now placed on a "special new case docket" instead of an "amended docket." Previously, the USPTO would issue an Office Action within a few months of an RCE filing, since the RCE filing would be on the examiner's amended docket. Now, responses with RCE filings are put in a queue with new case filings, making it conceivable that the USPTO could take as long as 1-3 years (or more) to issue an Office Action after an RCE filing. This is in addition to the 1-3 years it takes to receive a first Office Action in a new patent application.

Such potential delays can be problematic for applicants needing patent protection quickly. To plan for this possible eventuality, applicants should consider changing the way that prosecution is normally conducted by doing the following:

- Be prepared to pay more costs up front in order to prepare higher quality patent applications.
- Increase the number of interviews conducted to resolve issues more quickly.
- Consider filing applications under the USPTO's accelerated examination process.
- Increase the use of continuation applications to obtain broader claims.
- Consider vigorously petitioning any improper final rejections and taking improperly rejected cases on appeal more often, rather than filing RCES to resolve issues in patent applications.

Implementing these practice changes may initially result in more expense and effort. But in a competitive business environment, when time is of the essence, adjustments and changes to conventional patent practices will be necessary in order to account for the recent changes at the USPTO.

[Patrick Jewik](#) is a partner at Townsend and Townsend and Crew and leads the firm's Electronics and Software Group. He was a former patent examiner at the USPTO and has extensive experience helping clients build strategic patent portfolios, design around patents, and achieve maximum business advantage with their patents.

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 is now up and available at www.internetsightings.com. Check it out.

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

The 8/2/10 newsletter discusses the Larson Mfg. decision of the DC-SD concerning certain inequitable conduct issues.

The 8/5/10 email cites the Adams Resp. CAFC decision holding that words of approximation (“at least”) do not prevent application of the doctrine of equivalents.

The 8/6/10 posting discusses the Rung Plus CAFC decision showing once again why not including background information is a good idea.

The 8/9/10 message concerns the Golden Hour CAFC decision reminding all to write each process claim so that only one party performs all acts necessary to violate the claim. There's no joint infringement. Now aren't you glad you read Internet Sightings?

The 8/12/10 email reports the Baran CAFC decision reaffirming that “means” claims mean narrower scope. So stop using “means.”

The 8/23/10 newsletter notes an IPO objection to the proposed three track examination option as violating at least 3 international treaties.

The 8/30/10 post reports the Princo CAFC decision and its conflicting views concerning patent misuse. See also Pat-O for 8/30.

Patently-O – a blog written by Dennis Crouch – www.patentlyo.com.

The 8/4/10 blog reports the Enovsys CAFC decision holding an inventor's ex-wife to have a community property interest in the invention and the patent being sued on. Oh-oh, better watch out.

The 8/6/10 posting discusses the Intervet CAFC decision – another trial court reversal; the dissent by Judge Dyk argues that isolated genes should not be patentable. Another outstanding example of how the CAFC scrambles IP law.

The 8/10/10 email also reports the Golden Hour case – see Hal, supra, 8/9/10. – but at greater length.

The 8/11/10 post discusses Dennis' article on design patents, trademarks and trade dress, and their use to enhance each other.

The 8/18/10 blog concerns the Baran CAFC decision holding the *name* of a means (“release means for. . .”) added a functional limitation to the claim. Nuts. Better use “alpha means” or “first means” until the Court holds that language to limit the claim too.

The 8/19/10 email discusses a recent study showing that examiners rarely apply applicant cited prior art. So why is withholding it inequitable conduct?

The 8/21/10 post reports a study revealing that the top tech schools for patent attys. are the U of Ill., MIT, U of Mich and Cornell.

The 8/25/10 blog says that the percentage of registered patent practitioners who were attorneys dropped from about 80% in the years prior to 2000, to about 40% currently.

INTERNET SIGHTINGS

By: Jim Hawes (cont.)

Carl Oppedahl – emails of IP practice matters: carl@oppedahl.com.

The 8/1/10 email offers a webinar on Sept. 14 and 15, 2010, about using the PCT-Patent Prosecution Highway to handle applications in certain countries.

On 8/20/10 Carl reported that the PTO's "sportal" server went down, stopping PrivatePAIR. Try <https://epfportal.uspto.gov/efile/portal/efs-contingency>.

IP Watchdog – a blog by Gene Quinn focusing on patent matters – IPWatchdog.com.

The 8/25/10 blog discusses the standing requirement for an ITC action.

Cal Bar IP Section – alerts when appropriate – Contact: mitch.wood@calbar.ca.gov

The California State Bar will hold its Annual Meeting 9/23-26/10 in Monterey.

AIPLA Direct – a newsletter issued from time to time <http://www.aipla.org>

The AIPLA will hold its Annual Meeting this year on Oct. 21-23 at the Marriott Wardman Park Hotel in DC.

The Trademark Committee reported on 8/19/10 that India and New Zealand are one step closer to joining the Madrid Protocol.

The Trademark Comm., in an 8/30 post, seeks comments for the TTAB about ideas to improve its Acc. Case Resolution program.

PTO – www.uspto.gov/main/newsandnotices

In a notice published at 75FR36063, the PTO has extended to all applicants and to the end of 2010 the abandon one - get one special program.

An 8/12/10 press release reports that the PTO is now on Facebook.

On 8/20/10 the PTO published the agenda for the 9/8/10 BCP meeting.

TTABlog – a blog written by John Welch – www.TTABlog.com

The 8/4/10 blog reports the Cartier TTAB decision holding certain 2(f) evidence sufficient to warrant registration of a watch design.

Other Stuff –

The August 2010 issue of Intellectual Property Today includes an article discussing how to obtain prompt refunds from the PTO.

The Canadian Patent Office offers its free, downloadable 268 pp. Manual of Patent Office Practice at dsp-psd.pwgsc.gc.ca/Collection/RG42-3-1998E.pdf.

The Licensing Executives Society will hold its Annual Meeting in Chicago on 9/26-29/10.

PLI is holding an Advanced Patent Licensing seminar in SF on 10/25.

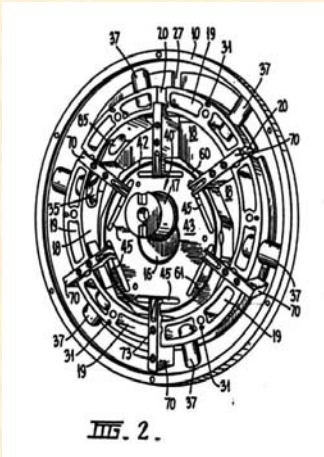
The National Inventors Hall of Fame was featured in the Newsweek July 19 cover story.

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