

LAIPLA BULLETIN

Los Angeles Intellectual Property Law Association

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In This Issue

President's Message & Washington in the West Notice	1
Article: Changing the Rules of the Game: Preissuance Submissions	2
Article: Limiting E-Discovery in TTAB Proceedings	3
Article: 2 PCT Written Opinions for the Price of 1	4
Employment Opportunities	6
Intellectual Property Services	8
LAIPLA Sponsor Opportunities	10
Washington in the West Brochure	11
Membership Applications	14

Upcoming Events

Washington in the West
February 14, 2012
Hyatt Regency Century Plaza

Judges' Night
March 27, 2012
Millennium Biltmore Hotel

Spring Seminar
June 8-10, 2012
Lodge at Torrey Pines

President's Message

by Brian G. Arnold

Greetings and welcome to LAIPLA 2012. As LAIPLA's President, I am enthusiastic about the many outstanding programs that LAIPLA will offer this year, and I hope that you can join us for some or all of them.

LAIPLA kicked off the year on January 26 at The California Club with an informative, well-attended dinner presentation regarding patent damages by Bill Rooklidge and Martha Gooding of Jones Day. Bill and Martha detailed the important and evolving state of reasonable royalty patent infringement damages, focusing on litigation and trial strategy in light of recent Federal Circuit jurisprudence. Thanks to Bill and Martha for the presentation, and to the Monthly Meetings Committee for organizing the event.

LAIPLA will maintain its momentum throughout the next five months, featuring outstanding events every month. Please mark your calendars for the following events that you won't want to miss:

February 14: What could be more romantic than LAIPLA's **Washington in the West** event on Valentine's Day? Grab your sweetheart and join us at the Hyatt Regency Century Plaza for this annual event, bringing together practitioners, in-house counsel, professors, and representatives from the United States Patent and Trademark Office for a day of presentations and networking opportunities. In case your Valentine doesn't find IP romantic, the event will conclude early enough for you to enjoy a romantic dinner.

March 27: LAIPLA's annual **Judges' Night** returns to the Biltmore Hotel and will again be co-sponsored by the Judge Paul R. Michel Intellectual Property American Inns of Court. The evening will honor the judiciary and will feature a panel of distinguished judges, including the Honorable Richard A. Paez and the Honorable Milan D. Smith, Jr., from the Court of Appeals for the Ninth Circuit, and also the Honorable S. James Otero and the Honorable Andrew J. Guilford from the Central District of California.

Continued on page 2

Event Notice: Washington in the West 2012

February 14, 2012
Hyatt Regency Century Plaza
2025 Avenue of the Stars
Los Angeles, CA 90067

LAIPLA is pleased to announce our fifteenth annual **Washington in the West** program will be held on Tuesday, February 14, 2012 at the Hyatt Regency Century Plaza. LAIPLA is bringing together practitioners, in-house counsel, professors, and representatives from the United States Patent and Trademark Office for a day of presentations and networking opportunities. We encourage you to invite your colleagues and plan to attend this informative program. Register today by using the brochure attached to this Bulletin or visit www.laipla.net. We look forward to seeing you on the 14th.

President's Message

Continued from page 1

In April (date TBD), LAIPLA will host another luncheon **Litigation Roundtable**. A panel of local in-house counsel will discuss patent infringement cases from the in-house prospective and give tips to outside counsel.

In May (date TBD), we'll enjoy another dinner presentation at The California Club, with attorneys from Alston + Bird discussing practice pointers for cases before the International Trade Commission.

June 8-10: The highlight of the LAIPLA year is always the **Spring Seminar**, which will be at the beautiful Lodge at Torrey Pines. Your Spring Seminar Committee is hard at work in lining up speakers and sponsors, and we look forward to another outstanding weekend of education and relaxation in lovely La Jolla.

If you have not yet renewed your membership for 2011-12, please take this opportunity to visit www.laipla.org and complete the member or firm application. Remember that a firm application grants membership privileges to an unlimited number of listed individuals from your firm or company, and that all members enjoy reduced rates at LAIPLA events.

Finally, if you have any interest in getting involved with LAIPLA, or in sponsoring any of our events, please contact me at (310)282-2160 or barnold@loeb.com. We have opportunities available for committee involvement and sponsorship for all of the events listed above.

Thank you for your continued support as a member of the organization, and I hope to see you at some of our events in the upcoming months.

Article: Changing the Rules of the Game: Preissuance Submissions

By: Patrick R. Jewik
Kilpatrick Townsend & Stockton LLP

The view and opinions expressed in this article are those solely of the author(s) and are not of the Los Angeles Intellectual Property Law Association or its members.

Law360, New York (January 23, 2012, 1:02 PM ET) — On Jan. 5, 2012, the U.S. Patent and Trademark Office published proposed rules^[1] relating to preissuance submissions^[2] under the America Invents Act of 2011. Preissuance submissions are submissions of prior art by third parties in pending patent applications, and are expected to change the rules of the patenting game. They can be filed in any nonprovisional utility, design and plant application, as well as in any continuing or reissue application. Preissuance submissions will reduce the risk that unpatentable claims will be allowed by examiners who are unfamiliar with the prior art. This new process is expected to improve the quality of issued patents.

Prior to the passage of the America Invents Act, the patent examination process was primarily an ex parte process. Submissions of prior art by third parties were allowed, but the third parties were not allowed to comment on the prior art. Many practitioners were reluctant to submit prior art without the ability to comment, because it was possible that the examiners would not apply the cited prior art in the manner desired by the third parties. As a result, submissions of prior art by third parties in patent applications during ex parte prosecution were rare. Preissuance submissions by third parties will change the patent examination process into a quasi-inter partes process by allowing third parties to submit prior art to the USPTO and provide concise explanations of relevance. This can be done while remaining anonymous.

Preissuance submissions must also be filed at the beginning of the application process. The goal is to give the examiners the best prior art prior to issuance of the first office action on the merits. Specifically, any preissuance statements must be filed before (1) the date a notice of allowance is given or mailed in the application for patent; or (2) the later of — six months after the date on which the application for patent is first published, or the date of the first rejection of any claim by the examiner during the examination process. After these time periods, preissuance submissions are no longer allowed during the examination process.

Preissuance submissions must include a listing of the prior art being submitted, as well as “a concise statement of relevance.” According to the supplementary information accompanying the proposed rules, a third party “may present the

Continued on page 3

Article: Changing the Rules of the Game: Preissuance Submissions

Continued from page 2

concise description in a format that would best explain to the examiner the relevance of the accompanying document, such as in a narrative description or a claim chart.” The concise statement of relevance provides an explanation of how the prior art would be applied to the claims. It would seem possible for third parties to propose prior art rejections for the examiners, thereby allowing the examiners to accept or reject those proposed prior art rejections.

Third parties will want to take advantage of the preissuance submission process, as there are significant advantages over other processes for challenging patent claims. First, unlike conventional patent re-examination proceedings, as well as the new post-issuance review and inter partes review proceedings under the AIA, third parties submitting preissuance submissions can remain anonymous. Thus, it is possible to challenge the validity of an applicant’s patent claims without fear of retaliation by the applicant.

Second, unlike conventional patent re-examination proceedings, as well as the new post-issuance review and inter partes review proceedings, there is no estoppel. For example, under 35 U.S.C. 315(c), a third-party requester in an inter partes reexamination proceeding “is estopped from asserting at a later time, in any civil action ... the invalidity of any claim finally determined to be valid and patentable on any ground which the third-party requester raised or could have raised” during the inter partes re-examination proceedings. The practical effect of this is that the best prior art known to the third party must be supplied by the third party in the inter partes re-examination proceeding. The third party cannot submit a piece of prior art in a reexamination proceeding and withhold better prior art for subsequent litigation. In contrast, preissuance submissions by third parties do not result in the same estoppel. Consequently, it is possible for a third party to supply prior art in a preissuance submission, while reserving better prior art for a post-issuance challenge.

Third, the cost and burden of filing a preissuance submission is significantly less than that of post-issuance procedures. The supplementary information accompanying the proposed rules suggests that no fee is required for the submission of three or fewer documents in a preissuance submission. A relatively small fee is required if more than three documents are submitted.[3] The official fee associated with a preissuance submission is at most a few hundred dollars compared to thousands of dollars for post-issuance proceedings such as inter partes reexamination.[4]

Fourth, the ability to potentially invalidate claims and generate prosecution history estoppel early in the examination of patent applications will provide greater certainty as to risk associated with pending patent applications. This can be important for individual inventors and corporations as they proceed to bring their products to market.

In conclusion, preissuance submissions will result in higher quality patents and greater certainty as third parties familiar with the prior art will be allowed to participate in the patent process.

Article: Limiting E-Discovery in TTAB Proceedings

By: Andrew Baum & David A. Copland
Foley & Lardner LLP

The view and opinions expressed in this article are those solely of the author(s) and are not of the Los Angeles Intellectual Property Law Association or its members.

Law360, New York (January 20, 2012, 12:15 PM ET) — The U.S. Patent and Trademark Office’s Trademark Trial and Appeal Board recently held that expansive discovery of electronically stored information will normally not be necessary in registration proceedings. Although the scope of discovery in TTAB cases is defined by Rule 26, Fed. R. Civ. P and is technically identical to the scope of discovery in civil actions, the TTAB held that, due to the narrower scope of issues to be determined, “the burden and expense of e-discovery will weigh heavily against requiring production in most [trademark opposition and cancellation proceedings],” *Frito-Lay North America Inc. v. Princeton Vanguard LLC*, 100 U.S.P.Q.2d 1904 (TTAB 2011). The TTAB did, however, note that ESI must be produced “where appropriate.” The decision also highlights the importance of parties agreeing in advance on ESI-related issues rather than engaging in motion practice after the fact.

In this case, Frito-Lay opposes the application by Princeton Vanguard to register “pretzel crisps” for “pretzel crackers” on the grounds that the term is generic or merely descriptive. In responding to the opposer’s discovery, the applicant initially identified more than 1.6 million electronic files of potential relevance and claimed that its attorneys manually reviewed more than 85,000 of these files, incurring attorneys’ fees of approximately \$200,000 in doing so. At the time of the motion, applicant had produced more than 137,000 pages of documents.

In turn, Princeton Vanguard sought documents from Frito-Lay regarding, inter alia, the internal communications of

Continued on page 4

Article: Limiting E-Discovery in TTAB Proceedings

Continued from page 3

Frito-Lay's business staff to learn what terms they used when discussing the relevant products and market. Frito-Lay's production, in response, was much less robust. Frito-Lay identified document custodians and asked them to search their own files and computers, but its ultimate production included no emails and few internal, nonpublic documents. In conferring prior to the filing of Princeton Vanguard's motion to compel, Frito-Lay claimed that a broad attorney-supervised search and retrieval of electronic data would have cost up to \$100,000. In its response to Princeton Vanguard's motion to compel, Frito-Lay argued that the expense of this effort would far outweigh any benefit.

In its decision, the TTAB noted the parties' failure to reach an agreement on electronic discovery during their mandated initial discovery conference. "Having failed to reach agreement with opposer on many of the most crucial ESI-related issues in advance of parties' productions," said the TTAB, "applicant cannot fairly insist now, after the fact, that opposer must start its ESI search and production over, this time engaging in a process similar to applicant's, especially where opposer characterizes applicant's efforts as excessive rather than merely extensive." The mere fact that the applicant chose to engage in disproportionate document collection and review does not mandate that the opposer do the same.

The TTAB focused on the issue of "proportionality," and cited to the Federal Circuit's recently issued e-discovery model order, which questions "the practice of gathering huge amounts of information at the front of a case and running broad key searches as the issues emerge" — precisely what the applicant was advocating. The model order also states that "email production requests shall only be propounded for specific issues, rather than general discovery of a product or business." The TTAB therefore held that due to "the narrowness of the issues" it must decide, and the concerns expressed by the Federal Circuit, the "burden and expense of e-discovery will weigh heavily against requiring production in most cases." However, the TTAB went on to hold inadequate Frito-Lay's response to certain targeted requests, concerning how they internally referred to the product category and its decision to offer a product in that category. It ordered production of "representative samples" of such documents within 30 days.

The TTAB's decision in Frito-Lay offers some helpful guidance to parties perplexed about the TTAB's expectations concerning discovery of ESI. While it does not impose bright-line rules, it suggests that a party seeking massive and expensive ESI discovery will have an uphill fight in justifying that effort and expense. The decision also cautions parties to take seriously their obligations to meet and confer on ESI issues during the mandatory initial discovery conference. A party is unlikely to compel an extensive ESI search after an initial production if it did not address that issue at the outset of the case. Where electronic discovery is needed, the TTAB makes clear that parties should "be precise in their requests and to have as their first consideration how to significantly limit the expense of such production."

Article: 2 PCT Written Opinions for the Price of 1

By: Stuart A. Schanbacher
Conda Roccia LLP

The view and opinions expressed in this article are those solely of the author(s) and are not of the Los Angeles Intellectual Property Law Association or its members.

Law360, New York (January 26, 2012, 12:50 PM ET) — On Aug. 31, 2011, the European Patent Office issued new procedures making it much easier to get a second written opinion in Patent Cooperation Treaty patent applications. The new procedures are applicable when the EPO is the International Preliminary Examining Authority (IPEA) and are effective for applications in which the International Preliminary Examination Report (IPER) is due after Dec. 1, 2011. Subject to certain conditions, the EPO will issue a second written opinion when an applicant files a substantive reply to a first written opinion established by the EPO. The procedural changes pose a strategic challenge for patent practitioners and applicants to decide how best to prosecute PCT and national applications.

For those not familiar with typical PCT prosecution, the process may involve two chapters. In Chapter 1, the International Searching Authority (ISA) issues a search report and a written opinion. Then, in Chapter 2, an applicant files a demand that is usually accompanied by arguments and perhaps amendments under Article 34. The IPEA considers the Article 34 filing, and then issues an IPER. The IPER is the final decision of the IPEA regarding the novelty, inventiveness, and industrial applicability of the claimed subject matter, effectively ending examination of the PCT application. Although the PCT Rules have allowed the IPEA to issue a second written opinion and perform interviews before issuance of the IPER, this rarely occurred. Typically, the IPEA simply issued an IPER after receiving the demand and Article 34 amendment.

Now, however, the EPO as IPEA will issue a second written opinion as a rule in Chapter 2 prosecution. To get a second written opinion, the applicant simply must have filed a substantive reply to the first written opinion and there must be an outstanding objection that would result in a negative IPER. It should be noted that the EPO will not issue a second written opinion if a telephonic interview has been granted to an applicant. The examiner has discretion whether or not to grant an

Continued on page 5

Article: 2 PCT Written Opinions for the Price of 1

Continued from page 4

interview. However, because the examiner would not issue a second written opinion after an interview, it seems likely that applicant requested interviews are likely to be granted under the new procedures.

The new procedures provide certainty relating to additional examination opportunities that are available when the EPO is the IPEA, which raises several strategy questions. The following are some scenarios in which an applicant may consider changing its current strategy: (1) a company would not normally file a PCT application at all; (2) a company would normally file a PCT application, but designate an IPEA other than the EPO; and (3) a PCT application is being examined by the EPO under the new procedures.

Filing a PCT application may now be a better strategy than only filing one or more national applications. For example, previously a company may have filed a U.S. nonprovisional application and foregone the filing of a PCT application. This strategy may have been followed because of the limited ability to present arguments and amendments in Chapter 2. However, by providing additional examination, PCT applicants will be in a better position to determine patentability in the international phase. This benefit may be compounded in cases where the U.S. Patent and Trademark Office backlog is long because the EPO may provide meaningful patentability feedback faster than in U.S. prosecution. Furthermore, the patent prosecution highway is available for expedited U.S. prosecution when a positive written opinion or IPER is received.

For those who do file PCT applications, it may now be beneficial to designate the EPO as the IPEA if they had not done so before. For example, a company may have previously designated the office in which they are most likely to file a national stage application in order to reduce the chance of new art being cited when filing a national stage application. Alternately, an applicant may have previously designated an office with which they are most familiar or an office with the lowest fees. The strategy question to answer is whether having “a second bite at the apple” in the international examination stage overcomes those other considerations.

For applicants that file national stage applications in multiple jurisdictions, it is likely that the additional examination that is available in the international examination stage will favor designating the EPO as the IPEA. The additional examination opportunities may result in less prosecution in subsequent individual national stage applications. In addition, worries about a particular office citing different art may be less important for those filing multiple national stage applications. Also, the PPH is now available for many countries when a positive written opinion or IPER is received in PCT prosecution.

Once a decision has been made to file a PCT application and designate the EPO as the IPEA, the applicant needs to decide how best to take advantage of the expanded PCT prosecution afforded under the EPO procedures. Unlike typical patent prosecution, the applicant will have to decide between receiving a second written opinion and conducting an interview with the examiner. Strategy will of course have to be decided on a case-by-case basis. However, there may be strong reasons for proceeding with one or the other based on the ability to amend the claims.

When an applicant can amend the claims to overcome a rejection and still have acceptable claim coverage, the best course of action typically will be to file amendments and arguments in order to solicit a second written opinion or a positive IPER. The reasoning here is that an examiner is more likely to drop or amend a rejection in response to claim amendments than in response to arguments alone. If a second written opinion is issued, another round of arguments and amendments is available.

A more difficult decision is presented when the applicant does not want to amend the claims. Assuming that there is disagreement about the scope of the asserted art, the best course of action typically will be to perform an interview and forego a second written opinion. The interview / argument combination may be the most persuasive option. In the interview, the applicant can determine how the examiner is interpreting the asserted art, identify arguments that may be successful with the examiner, and persuade the examiner on the merits. The applicant can then follow up with arguments in writing that focus on subjects identified in the interview. This strategy also avoids the possibility of the claims being thrice rejected. For example, if the applicant solely files arguments and the examiner is not persuaded, the claims will be rejected a second time in a second written opinion. Unless the examiner is convinced that his first two rejections were wrong, the claims will be rejected a third time in the IPER. Instead, by choosing the interview / argument combination the applicant has the best chance of being successful at the international stage, and in any event, will still be able to pursue the claims in national stage applications.

It is important to understand a client's patent prosecution goals. Then, the advantages relating to the different types of filings and examination options should be identified in the context of those goals. Patent practitioners may find that the new EPO procedures will change the filing or prosecution advice they provide to their clients.

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Employment Opportunities

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Department

Agents in the patent group work on a variety of projects, including: drafting and prosecuting patents, preparing invalidity and non-infringement opinions, analyzing patents in support of litigation and adversarial licensing, and performing due diligence for corporate transactions and technology transfers.

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LAIPLA

Los Angeles Intellectual Property Law Association

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LAIPLA Announces Sponsor Opportunities

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We have several opportunities for firms or companies to publicize their organization by being a sponsor at one of our upcoming events. Sponsors are needed for our Monthly Meetings (one sponsor allowed each month), at the Washington in the West Program (4-5 sponsors needed), at our Annual Spring Seminar (7-8 sponsors needed), and at Judges' Night. If you are interested in being a sponsor by contributing to the general budget, by contributing to a specific event, or by being a tabletop sponsor at the Washington in the West, Spring Seminar or Judges' Night, please contact Scott Hansen at 310-824-5555 or shansen@fulpat.com. Show your support, and feature your firm or company at the same time.

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LA IPLA

Los Angeles Intellectual Property Law Association

Presents

Washington In The West

bringing together practitioners, in-house counsel, professors, and representatives from the United States Patent and Trademark Office for a day of presentations and networking opportunities.

Hyatt Regency Century Plaza

2025 Avenue of the Stars, Los Angeles, CA 90067

8:00 a.m. – Registration & Continental Breakfast

8:45 a.m. (Sharp) Meeting & Program

12:15 p.m. Luncheon

Tuesday, February 14, 2012

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Los Angeles Intellectual Property Law Association

presents

The Fifteenth Annual Washington in the West Conference

February 14, 2012

Hyatt Regency Century Plaza
2025 Avenue of the Stars, Los Angeles, CA 90067

8:00 a.m. Registration & Continental Breakfast

8:45 a.m. Opening Remarks

◆ **Greer N. Shaw, Esq.**

*Snell & Wilmer LLP
Washington in the West
2012 Chairperson*

9:00 a.m. Patent Reform 2012: Update on the America Invents Act

Discussion by USPTO officials regarding the impact and implementation of the America Invents Act (AIA) by the United States Patent and Trademark Office.

◆ **Remy Yucel, Esq.**

United States Patent & Trademark Office

9:45 a.m. Broadening the Base: Best Practices in Reissues

Discussion by USPTO officials regarding best practices before the USPTO related to patent reissues.

◆ **Jean Witz, Esq.**

United States Patent & Trademark Office

10:45 a.m. Morning Break

11:00 a.m. State of the Union: Legal Update on KSR and *Bilski* Issues

Moderated panel considering the state of obviousness and subject matter patentability.

◆ **Remy Yucel, Esq.**

United States Patent & Trademark Office

◆ **Ketan Vakil, Esq.**

Snell & Wilmer LLP

◆ **Jean Witz, Esq.**

United States Patent & Trademark Office

◆ **Moderator: Professor Lee Petherbridge**

Loyola Law School

12:15 p.m. Luncheon sponsored by:



1:00 p.m. Getting into the Act: Third Party Procedures

Moderated panel addressing current and anticipated third party procedures, with an emphasis on the new post-grant review and opposition process introduced by the AIA, and best practices in advising clients contemplating third party procedures.

◆ **Jean Witz, Esq.**

United States Patent & Trademark Office

◆ **Professor Karl Manheim**

Loyola Law School

◆ **Remy Yucel, Esq.**

United States Patent & Trademark Office

◆ **Moderator: Tom Runk, Esq.**

Fulwider Patton LLP

2:20 p.m. On the Fast Track: Accelerated Examination Processes

Discussion by USPTO officials regarding accelerated patent prosecution processes, including traditional accelerated process, Track 1 examinations, pilot programs under the AIA, and the Patent Prosecution Highway.

◆ **Jean Witz, Esq.**

United States Patent & Trademark Office

3:45 p.m. Afternoon Break

4:00 p.m. Reexamination – From Basics to Best Practices

Moderated panel considering the state of reexaminations before the USPTO, from administrative, prosecution, and litigation perspectives, with an emphasis on prospective changes in view of the AIA.

◆ **Remy Yucel, Esq.**

United States Patent & Trademark Office

◆ **Rabi Narula, Esq.**

Knobbe Martens Olson & Bear LLP

◆ **Moderator: Guy Ruttenberg, Esq.**

Kirkland & Ellis LLP

5:30 p.m. Concluding Remarks

◆ **Brian G. Arnold, Esq.**

*Loeb & Loeb LLP
LAIPLA President*

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THURSDAY
MARCH 15, 2012

USC GOULD SCHOOL OF LAW

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Hon. David Folsom (E.D. Tex.), Hon. Dean Pregerson (C.D. Cal.),
Hon. Christina Snyder (C.D. Cal.), Hon. Margaret Morrow (C.D. Cal.)
and Hon. Andrew Guilford (C.D. Cal.)

PROMINENT ACADEMICS: Professors Lemley, McCarthy, Nimmer and Schultz



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