

LAIPPLA BULLETIN

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President's Message

by Alexander R. Schlee

Welcome to the April issue of the LAIPLA Bulletin. Our annual Judges' Night, this year co-sponsored by the State Bar of California IP Section, was a big success. We had close to 90 attendees. On behalf of LAIPLA and the local IP community, my special thanks again to Laura Burson from Kirkland Ellis and Vice President/President Elect Brian Arnold from Thomas Whitelaw for making this great event happen. At the State Bar IP Section's end, also our special thanks to Judge Lorelei Ritchie, who was very helpful in putting this distinctive Judges Panel together.

Although we are gradually approaching the end of our busy meeting season marked by our Spring Seminar, we are not quite there yet. Until then, our meeting pace continues. Our monthly meeting chair, Scott Hansen from Fulwider Patton, has organized the next monthly dinner meeting for April 12 in The California Club. Mr. Laurence Pretty will present "Issues Currently In Flux In Patent Law", a topic that should be of interest to most of us and provides in an efficient manner an overview of what you need to know.

The first 10-15 minutes of this April meeting will serve as our annual meeting, introducing and voting on the new slate of board members and officers. Details about this process can be gathered from our Bylaws which are posted on our LAIPLA website. Thanks to Frank Kang from Latham Watkins we have a clean version now on our website. Briefing about the nominating process, a nominating committee is appointed by the president and consists of 3 LAIPLA members excluding active board members. The nominating committee interviews the board members, solicits their opinions, and comes to a decision about the nominations. Apart from that, if possible, we observe a policy of only one board member per firm serving simultaneously on the board. Our nominating committee this year consisted of the LAIPLA past Presidents Paul Tripodi of Sidley Austin, Gary Nelson of Christie Parker & Hale, and Jason Feldmar of Gates & Cooper. I would like to thank them for having taken on this time-consuming task. Please be assured that we try to fill the board and officer positions with the best performers. Sometimes we have more good performers than board positions, in total 10 including the officers. Every year 3 new board members are appointed for a term of 2 years. In addition, we always have good committee positions to fill, are dependent as an organization on their good work, and

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Event Notice: April 12, 2011 Dinner

Issues Currently In Flux In Patent Law
April 12, 2011
The California Club
538 S. Flower Street, Los Angeles

LAIPLA is pleased to announce our next monthly meeting will be held on Tuesday April 12, 2011 at The California Club in Los Angeles. We will begin with a non-hosted reception at 6:00 p.m., followed by dinner and program at 6:45 p.m. Mr. Laurence Pretty will be our guest speaker and will discuss "Issues Currently In Flux In Patent Law." The event flyer and registration form are attached to this Bulletin. Register today and don't miss out on this great event. We look forward to seeing you on the 12th.

Event Summary: Judges' Night

By: Brain Arnold, Thomas Whitelaw & Tyler
and Laura Burson, Kirkland & Ellis

LAIPLA's Annual Judges' Night event, held on March 21 at the Millennium Biltmore Hotel in downtown Los Angeles, was a success once again. Co-sponsored by the IP Section of the State Bar, the evening began with a panel discussion by four federal judges—Judge Arthur Gajarsa, Circuit Judge, Court of Appeals for the Federal Circuit; Judge Lourdes Baird, Retired Judge, U.S. District Court for the Central District of California; Judge Andrew Guilford, District Judge, U.S. District Court for the Central District of California; and Judge Ronald Lew, District Judge, U.S. District Court for the Central District of California. The panel was moderated by Lorelei Ritchie of the Trademark Trial and Appeal Board, and Laura Burson of Kirkland & Ellis. The panel addressed the standard for intent under section 271(b) induced infringement claims and the Global-Tech vs. SEB case, recently argued before the United States Supreme Court. The discussion ranged from why the panelists believed the Supreme Court was interested in the "intent" issue, to what the proper standard should be for the "intent" prong of section 271(b) claims. Although no consensus was reached on how to articulate the proper standard, all agreed that the facts of Global-Tech would most likely fit any standard on finding liability. Also present at the program Judge Dolly M. Gee, Judge Fernando M. Olguin, Judge Gary A. Feess, Judge Andrew J. Guilford, and Judge Audrey B. Collins. The event concluded with a cocktail reception and dinner.

LAIPLA Announces LinkedIn Groups

We have created a **LAIPLA Group on LinkedIn**. Join the group to connect with other LAIPLA members and add them to your professional network. We will be publicizing events through LinkedIn.

Join the LAIPLA Group: www.tinyurl.com/LAIPLAGroup
Alternatively, search "LAIPLA" in "GROUPS" in LinkedIn.

Join the LAIPLA/SDIPLA Spring Seminar Group: www.tinyurl.com/SpringSeminar2011
Alternatively, search "LAIPLA" in "GROUPS" in LinkedIn.

President's Message

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active involvement in committees will finally almost inevitably result in a board nomination. I will report about our committee activities in a later issue, but so much for now: We have the committee roster posted on our LAIPLA website at <http://www.laipla.net/committee-roster.html>. Please check whether you can find anything you might be interested in taking on for LAIPLA, we will fill the committee positions over the next few months.

Our June 3 to 5 Spring Seminar keeps shaping up nicely. Please find attached our latest flyer. The event will take place in the famous "Del" on Coronado Island in San Diego. Our Spring Seminar Committee has done a fine job in finding sponsors and distinctive speakers, among these immediate past Federal Circuit Chief Judge Michel and current PTO Director David Kappos. We are currently working on putting together a good in-house counsel panel. Also, we are working on increasing the overall in-house counsel attendance, with help from our immediate LAIPLA Past President Keith Newbury of Edwards Lifesciences. Also, this is a joint meeting with the San Diego Intellectual Property Law Association SDIPLA. We try hard to accommodate increased networking opportunities with an excellent program of high-profile speakers, as well to make this event social and family friendly - in short, a worthwhile way to spend your weekend. We hope the event will find your support. LAIPLA, this year actively helped by SDIPLA, is taking pride in keeping this annual homemade Southern California IP event alive.

Article: Are Bayh-Dole's Best Days Over?

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.

By: Robert M. Gerstein
Marshall Gerstein & Borun LLP

Law360, New York (March 23, 2011) — The parties in *Stanford v. Roche* present the Supreme Court with vastly different visions of the scope of the Bayh-Dole Act. *Stanford* would have the court rule that the act has broad scope, sweeping within its ambit any invention that has been touched by federal funding. *Roche* construes the act more narrowly, so narrowly the act would be irrelevant to its contest with *Stanford* over patents that arose, at least in part, from federally funded research. The court's decision will not only decide when issues of ownership are controlled by the act, but may also determine whether the act will be central to the partnership between industry and nonprofit research institutions as it has been for the past several decades.

Bayh-Dole was enacted in 1980 to allow research institutions to own patents covering certain "subject inventions" that had been created with federal funding. Previously, the U.S. government took title to a majority of those patents, but almost universally failed to commercialize them. Allowing research institutions, referred to as "contractors" under the act, to own and largely control those patents has resulted in a dramatic increase in commercialization of federally funded research, as was expected when the law was passed.

Under Section 202 of the act, a subject invention is "any invention of the contractor conceived or first actually reduced to practice in the performance of work under a [federal] funding agreement." The contractor is required to report any subject invention to the fund granting agency, such as the National Institutes of Health (NIH), but may "elect to retain title to any subject invention."

In exchange for title, the act places a variety of requirements on the nonprofit contractor, including: filing a patent application; attempting to commercialize the inventions, with certain preferences to small business firms and manufacturers in the U.S.; limiting assignment of the patents; sharing royalties with the inventors; and granting a nonexclusive license to the government. The government may also exercise "march-in rights" to license or force the contractor to license the rights under certain circumstances and may even take title if the contractor fails to live up to its obligations or does not elect to take title initially.

The dispute between *Stanford University* and *Roche Molecular Systems Inc.* grew out of conflicting agreements in which a *Stanford* researcher-inventor ostensibly assigned the same patent rights to both *Stanford* and a *Roche* predecessor, *Cetus*. In the late 1980s researchers at *Stanford* were attempting to develop an assay to measure levels of HIV in a patient to determine the effectiveness of various anti-viral treatments. Some of that research was accomplished using funding from the NIH. The researchers had signed *Stanford's* standard patent agreement where they "agree[d] to assign" to *Stanford* rights to patents resulting from their research.

One of the *Stanford* researchers visited *Cetus* over a nine-month period in 1989 to gain knowledge about polymerase chain reaction (PCR) techniques *Cetus* had invented that could be useful in developing the HIV assay. Prior to visiting *Cetus* and learning about PCR, the researcher signed an agreement in which he "hereby assigns to *Cetus* my right" to any invention that resulted from his access to *Cetus*.

Stanford eventually filed patent applications on use of an assay for determining the amount of HIV present in a patient to determine the effectiveness of HIV therapies. The patents issuing from those applications indicate that they were supported by government funding and that the inventors include the researcher who had entered into the agreement with *Cetus*.

Cetus/Roche developed and began selling an assay kit for monitoring HIV levels. After a period of negotiation, *Stanford* filed suit against *Roche* alleging that use of the *Roche* assay infringed the *Stanford* patents. *Roche's* response included the defense that *Roche* should have been an owner of the relevant patents through the agreement between *Cetus* and one of the inventors, and therefore could not be liable for infringement. The district court held that the agreement which purported to assign rights to *Cetus* was ineffective because such an assignment would be inconsistent with Bayh-Dole, which the court believed requires title be held solely by *Stanford*.

The Court of Appeals for the Federal Circuit reversed, finding that contract principles vested title with *Cetus/Roche* because *Cetus* had received a present assignment of the researcher's rights through the "hereby assign" language. The agreement with *Stanford*, although earlier in time, vested only equitable title in *Stanford* because it was only "an agreement

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to assign," not an actual assignment transferring legal title. The Federal Circuit then held that the act did not override the relevant contract law because it only applied to patents for which the contractor would have title under contract law. Roche was effectively a co-owner and the suit, therefore, had to be dismissed because Stanford lacked standing to bring the suit without a co-owner. The Supreme Court granted certiorari to determine whether the act should take precedence over the agreements of an inventor.

Under Stanford's view of the act, patents arising from federally funded research are automatically covered by the act's provisions that permit the research institution to elect title. Under this interpretation, neither the inventors nor the institution can enter into agreements that would circumvent the procedures in the act. To do so would call into question ownership of patents on subject inventions, making it more difficult to license those patents, thereby undercutting the primary purpose of the act. Allowing inventors or institutions to "contract around" Bayh-Dole would also lead to the government losing many of its other rights, including the ability to direct commercialization to small businesses or U.S. manufacturers, the government's own license and march-in rights, as well as the right to ensure that the fruits of federal funding are diligently commercialized for the public benefit.

Roche counters that under the act, the institution is only able to elect to "retain" title, meaning that the act only applies to patents for which it would otherwise have ownership under applicable employment or contract law. If the act were to trump other areas of law, it would necessarily impinge on the rights of entities other than the funded institution and its inventors, which Roche asserts was not Congress's intent and could also raise constitutional issues. Roche foresees little chance that institutions or their inventors will be able to or even attempt to contract around the act. For instance, the government could require institutions to obtain ownership from their inventors by avoiding the problematic "agree to assign" language, minimizing the chance for circumvention of the act, and, in any event, every institution has a strong incentive to preserve the government's rights, lest the institution risk losing its most important research funding source.

At oral argument before the Supreme Court on Feb. 28, 2011, some of the justices seemed to be searching for a way to limit the case to its unusual facts, without having to address the breadth of the act. That would appear to be an unlikely result, given that most of the facts have already been set in the record that the breadth of the Bayh-Dole Act is the only issue for which certiorari was granted, and that at this stage, Stanford's success or failure relies entirely on whether the act is applicable.

Much of the argument, particularly the questioning of the solicitor general, dealt with the potential loss of the government's rights if the contracts of inventors could effectively avoid the restrictions of the act, thereby undercutting the value to the government and the public of the research they fund. Many of those rights, however, are rarely applied; the government has never used its march-in rights and may waive other rights and restrictions under the act. If the Supreme Court finds for Stanford based on the rationale of preserving the government's rights, it may correctly have interpreted Congress's intent, but would be side-stepping other important results of the act supporting Stanford's position, namely the relationship between institutions and their licensees.

If the court were to find for Roche, particularly with a broadly worded decision, it could have significant impact on the future licenses involving research institutions. Most universities treat the requirements of Bayh-Dole as sacrosanct and apply them even in licenses for inventions not funded by the government.

The importance of Bayh-Dole to research institutions is largely because the federal government is the major source of research funding and Bayh-Dole has been an important driver of their ability to reap benefits from their research, but also because the Bayh-Dole requirements are aligned with their mission to benefit the public and their obligations under federally funded grants. Prospective licensees find many of the Bayh-Dole-driven restrictions to be foreign to the for-profit world, but generally agree to them because of the assumed breadth of the act. A research institution's arguments about what needs to be included in a license are far more persuasive when they can point to the act and argue that without compliance, not only the institution, but also the licensee can lose its rights in the unlikely event that the government decides to use its march-in rights or takes ownership to the licensed patents.

For-profit companies knowledgeable about the strings that come with licensing inventions from government funded research often minimize the impact of Bayh-Dole on their businesses by restricting research institutions from comingling government funding in projects the company funds. If *Stanford v. Roche* creates other avenues to avoid the restrictions of

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Bayh-Dole, such as by entering into contracts that vest title with an entity other than the government funded institution, prospective licensees may push for deal structures that create tension with the institution's perceived or actual obligations under their grants, the act or their mission to benefit the public. That could lead to greater risks for those institutions if they proceed with such deal structures, or fewer deals if institutions decide not to bear those risks.

To date, there is little case law construing Bayh-Dole, and that fact may also be a cause for what appeared to be a struggle on the part of the justices during the oral argument to construe some of its minimally defined provisions. The parties used other passages of the act to buttress their arguments about the meaning of the language that is central to their dispute, but those other passages themselves have little or no case law from which to ground their meaning.

The paucity of case law on the act is one of the reasons that a decision in *Stanford v. Roche* is eagerly anticipated by research institutions and their licensees. Even if the majority attempts to draft a narrow opinion, the lack of other case law means the decision will undoubtedly be cited in any future dispute over the act, including disputes that do not relate to ownership. Whether *Stanford* or *Roche* prevails, the case will likely impact the work under every federally funded grant and the billions of dollars to the U.S. economy that result from scientific research, whether public, private or, as in *Stanford v. Roche*, through a combination of the two.

Article: Calif. Judge Sets Sights On Patent Local Rules

By: Erin Coe

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 (March 23, 2011) — While the U.S. District Court for the Central District of California remains a popular spot for patent litigation, it has not adopted local rules for patent cases like many other courts across the U.S. — and one district judge may be looking to change that.

When Judge Andrew J. Guilford is not hearing cases in the Central District's Santa Ana courthouse or writing 123-page opinions, he is considering formulating rules for his court that would aim to streamline often complex disputes over patents and give greater certainty to the parties involved. Currently, judges in the district each handle patent cases in their own way, and some even decide to follow the patent local rules of the Northern District of California or another court. But Judge Guilford sees advantages to putting a set of rules in place that would lay out a schedule for when parties have to file their infringement, invalidity and claim construction contentions and address other issues unique to patent suits. Patent local rules would provide a level of standardization so that each judge would administer patent cases in the same way and would help litigants know what to expect when filing or defending against suits in the Central District of California, he said. "I like the idea of considering the unique needs of our patent bar and writing rules for our community rather than adopting the rules of another court," Judge Guilford said. "Most of the leading districts for patent law have patent local rules, so maybe there is a good reason to have them."

Although the Central District of California nudged aside the Eastern District of Texas as the top forum for patent filings in 2009, with 276 suits compared with the Texas court's 249, the Eastern District of Texas regained the lead by a huge margin in 2010, with 636 patent filings, many of which were likely false patent marking suits, according to Greg Upchurch, director of research at litigation analysis firm LegalMetric. The other top jurisdictions for patent litigation in 2010 lagged far behind — with the District of Delaware listing 259 patent filings, the Northern District of California taking in 257 suits, the Northern District of Illinois reporting 250 filings, and the Central District of California listing 235 cases, according to LegalMetric.

Among the five most popular courts for patent cases last year, the Eastern District of Texas, the Northern District of California and the Northern District of Illinois have adopted patent local rules. When courts adopt such rules, cases tend to take less time, but the workload for attorneys and judges increases, according to Upchurch's review of jurisdictions with rules in place for at least four years. Two years after rules were implemented, the time patent cases were pending decreased by 2 1/2 months in comparison to four years earlier, according to Upchurch. However, the average number of docket entries in patent actions — a measure of how much activity occurs in a case — rose by 27 percent for those courts with rules, he said.

While some lawyers say it's about time the Central District of California establishes patent local rules, others think the jurisdiction remains an attractive spot for patent litigation because of their absence. Charles Barquist, an intellectual property partner of Morrison & Foerster LLP, said the potential adoption of patent local rules would be a boon for the Central District of California because it could set the stage for the district to handle bigger, more significant patent disputes.

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"There are a lot of patent cases filed here, but they tend to be Mickey Mouse cases, with all deference to Disney," he said. "We have fewer massive cases that can involve big teams of lawyers and all the activity that goes along with that." Barquist said the Central District of California would be higher on most companies' lists of places to file a patent case if they had a better sense of how the district's dozens of judges were going to structure the proceeding. "If companies file in Texas or San Francisco, they have more certainty, whereas the factor of uncertainty goes against filing in the Central District of California," he said. "I think consistency and predictability are helpful to lawyers and their clients to know how a case will proceed."

However, when patent local rules are implemented in a district court, they are often applied stringently, and attorneys have almost no leeway to depart from them, according to Gary Clark, an IP partner of Sheppard Mullin Richter & Hampton LLP, where Guilford worked as a trial lawyer before becoming a judge. "The rules put lawyers involved in a case in a strait-jacket, and they govern no matter what kind of a case," he said.

Patent local rules often call for a separate Markman hearing to deal with claim construction issues, but it can be a waste of time for the court and the parties, according to Clark. "Separate Markman hearings almost always are held independent of summary judgment motions and the merits of the case," he said. "I'm in favor of the prevalent practice in our district of collapsing the Markman hearing with summary judgment motions so that when the judges are presented with the parties' infringement and invalidity positions, they understand what will be the impact of their claim construction ruling."

The rules tend to put more pressure on parties earlier in the case and can sometimes be burdensome on defendants caught off guard by a lawsuit and forced to file invalidity contentions before fully investigating the prior art or getting a better handle on the case, Clark said. "Parties have to accelerate all efforts to do the best job they can to make their contentions and positions," he said. "When there are no patent local rules, parties can let the case develop before they form definitive views on issues."

Courts with patent local rules also are stricter about allowing parties to amend or supplement their contentions, according to Clark. "Parties are not as smart as they are later in the case," he said. "Attorneys are still discovering things about their case as they get close to trial, and they may realize more about the patents than before, but because of the rules, they may or may not be allowed to change their contentions in the later stage of a case."

Many courts applying patent local rules decline to consider claim construction issues until briefing is completed on preliminary issues, but patent cases filed in the Central District of California vary in complexity, and a standard set of rules may not fit all cases, according to Joseph Re, an IP litigation partner of Knobbe Martens Olson & Bear LLP. "Judges in the Central District of California care about processing their cases quickly, and sometimes patent local rules don't make the case go by faster," he said. "When the Central District of California gets a simple patent case, it can decide it without going through a long process, and many like that flexibility."

Some cases do require more customization depending on the size of the parties and the patents involved, but flexibility can be built into the rules, according to Barquist. "The rules don't have to be the same as those in San Francisco or Texas, but if we at least have a starting point in common, it will help with the predictability of how cases are handled here," he said.

Judge Guilford acknowledged that one size does not fit all and said he is studying several courts' patent local rules to determine what rules might work best for the Central District. His main concern is to make sure that any rules that are implemented are outcome neutral. "I don't want rules that are favoring one side or the other," he said. "Each case should be decided on its merits, not on the rules."

While Judge Guilford is concentrating on what rules could be applied in his court, he may see if other judges are willing to follow them and may present the rules to the entire district for consideration. He said he is one of a couple judges working on this issue and has no set deadline for creating any rules. "I'm doing this in my spare time, and there's not a lot of that," he said.

However, the judge may get some help from other advocates pushing for patent local rules in the Central District of California. Shashi Kewalramani, an attorney with Lee Jorgensen Pyle & Kewalramani PC, said he planned on contacting prominent patent attorneys in Orange County to gauge their interest in drafting patent local rules to present to district judges. "I think rules are a good idea because they would bring the Central District of California within the mainstream of other districts that have them, and they would provide some certainty for discovery," he said.

Article: Strictly Speaking

By: Tracy-Gene G. Durkin and Anbar F. Khal
Sterne Kessler Goldstein & Fox PLLC

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 (March 21, 2011) — Recently, when the Federal Circuit has had a chance to restate the patent law as it applies to design patents, they seize the opportunity to reevaluate even long-standing precedent. A prime example is the court's 2008 decision in *Egyptian Goddess v. Swisa*, 543 F.3d 665, in which the decades-old "points-of-novelty" prong of the test for design patent infringement was tossed out. However, in the recent decision in *Vanguard Identification Systems Inc. v. Kappos and Bank of America Corp.*, the court let stand the very high bar to prove the obviousness of a design.

The Vanguard case involves Bank of America Corp.'s 2002 design patent (D467,247) for a credit card with a magnetic strip on one surface and a hole near one of the edges. The patent actually discloses and claims five embodiments of the design. The embodiments are all identical except for placement of the hole, which varies between the bottom corners, sides and center bottom of the card. In 2004, Vanguard filed a third-party request for inter partes re-examination of the patent.

After the design was finally rejected by the patent examiner as being obvious in view of several prior art references, Bank of America appealed the rejection to the Board of Patent Appeals and Interferences in 2007. On July 31, 2009, the board issued a decision reversing the examiner's rejections and, on March 23, 2010, issued a decision denying Vanguard's request for rehearing. Vanguard then appealed to the Federal Circuit.

The main issue in the appeal was whether the board properly determined that the prior art designs applied by the patent examiner were "inadequate" to serve as proper primary references in an obviousness rejection before the U.S. Patent and Trademark Office. The Federal Circuit affirmed the board's decision without opinion.

Two prior art designs were used by the examiner as primary references to reject the design: U.S. Patent No. 6,196,594 to Keller and U.S. Patent No. 4,711,996 to Drexler. Both showed a rectangular data card with rounded corners and a magnetic strip. The data cards of Keller and Drexler, however, did not include a hole. Nonetheless, the examiner rejected the claimed card design as obvious based on either Keller or Drexler, in combination with several prior art card designs which did have a hole.

In reversing the examiner's obviousness rejection, the board concluded that Keller and Drexler were inadequate as primary references. According to the board, the presence of the hole in the claimed card design was critical to the overall appearance. Both Keller and Drexler lacked a hole, and therefore were considered inadequate primary references.

The board reached this conclusion under the obviousness standard set forth in *In re Rosen*, 673 F.2d 388 (Fed. Cir. 1982). This long-standing obviousness principle requires there be a primary reference whose visual effect as a whole is basically the same as the claimed design. According to *In re Rosen*, the primary reference cannot be something that might be brought into existence by selecting individual features from the prior art and combining them. Such a primary reference is necessary whether a determination of obviousness is based on the primary reference alone or on the primary reference in combination with modifications suggested by other prior art designs.

In *In re Rosen*, the Federal Circuit reversed the board's determination that a design for a table was obvious in view of a design for a desk. According to the court, the prior art desk design had a different overall appearance and aesthetic appeal than the claimed table. In particular, the claimed table had a round glass top with three V-shaped legs that formed notches where they joined the table top, whereas the primary reference, a desk, had an opaque semi-circular top with three V-shaped legs, but no notches.

Secondary references teaching a circular glass top and notched v-shaped legs were combined by the examiner to reject the claimed design. According to the court, the appearance of the claimed design must be viewed as a whole and compared with something in existence — not with something that might be brought into existence by selecting individual features from various prior art designs and combining them, particularly where combining them would require them to be further modified. The court also noted that the fundamental characteristics of the prior art desk design, such as the clean, unobstructed top surface and notched leg joints, would be destroyed if modified to become the claimed table design.

The board was not swayed by Vanguard's argument that requiring the hole to be found in the primary reference was tantamount to anticipation and would never result in a finding of obviousness. According to the board, there could be a hypothetical primary reference which gives the same visual impression as the claimed design, but which has a different

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card design, strip and/or hole. Such a hypothetical design would not anticipate the patented design because it would need to be modified to achieve the patented design. The board also refused to consider Vanguard's argument that the hole was functional and cannot be relied upon to support patentability because this issue was not before the board on appeal. Though this point was disputed by Vanguard in its briefs to the Federal Circuit, the board observed that Vanguard could have proposed a specific rejection based on functionality in its request for re-examination, but chose not to.

The Vanguard case also represents the first time the Federal Circuit has reviewed a decision by the board arising out of an inter partes re-examination[1], raising the issue of the standard of review. Specifically, whether the board's determination of the inadequacy of the prior art designs should be reviewed by the court as a question of fact or a question of law. Factual determinations are deferentially reviewed by the court under the substantial evidence standard, whereas legal determinations are reviewed by the court de novo.

Because the court's decision in the Vanguard case was an affirmation without opinion, it is not clear which standard the court employed. In Bank of America's view, the board performed its own review of Keller and Drexler and disagreed with the factual findings of the examiner as to the significance of the hole of the claimed design. Bank of America argued that the board had substantial evidence to find that Keller and Drexler were inadequate as primary references. Vanguard countered that the primary reference determination is part of the ultimate determination of obviousness, which is a legal issue reviewed de novo. Vanguard argued that the dispute is over the overall visual impression created by the claimed design, which is similar to claim construction which is reviewed de novo.

In the end, the court's affirmation leaves in place the long-standing and strict primary reference requirement for proving obviousness of a design. The decision upholding this strict "Rosen reference" approach is positive for patent holders defending a design patent against a validity challenge because the Rosen reference standard makes it harder to prove that a design is obvious. While this much is clear, the question of the standard of review will have to wait for another case.

Employment Opportunities

Morrison & Foerster PATENT AGENT

Marketing Statement

Morrison & Foerster LLP is a premier global law firm committed to delivering success for our clients around the world. We achieve that by hiring the best talent for every position in our firm. Our progressive workplace policies and our commitment to diversity and collegiality create an environment ideally suited to teamwork and collaboration. We are proud of our numerous workplace awards, including being named to FORTUNE's 2006 list of Best Companies to Work For, American Lawyer's 2006 "A" list, and for several years running, have been the Vault survey's #1 law firm for diversity.

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.

Qualifications

Morrison & Foerster LLP is seeking to hire an exceptional patent agent. This is an extraordinary opportunity to join one of the finest law firms representing companies involved in developing and commercializing highly-innovative technologies in the marketplace. Morrison & Foerster works closely with clients from the earliest stages of their technical development, offering valuable advice about how to protect their inventions and ideas in view of business strategies. The successful candidate must have a strong scientific background in electrical engineering with at a minimum of 1-4 years of work experience as a patent agent. Strong writing skills and admission to the USPTO is required.

Availability

Available Immediately

How to Apply

Apply online or through mail.

Recruiting Contact

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EEO Statement

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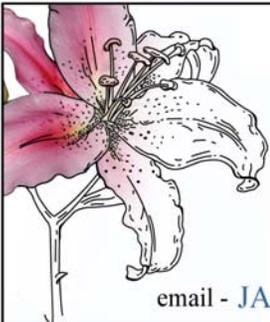
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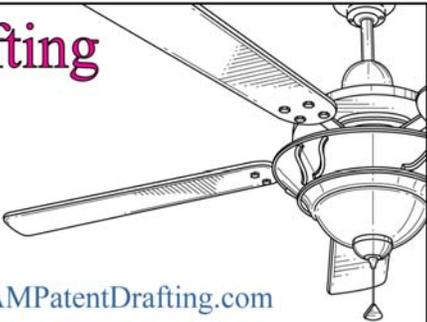
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Issues Currently In Flux In Patent Law

in co-ordination with the Federal Bar Association - Orange County Chapter



Mr. Laurence Pretty

Tuesday, April 12, 2011 - Dinner Program

The California Club

538 S. Flower Street, Los Angeles, CA 90071

Member Host: Roger Wacker

**Dress Code: Business Attire - Coat/Tie for Men
and**

Thursday, April 14, 2011

Panel also featuring Hon. Andrew J. Guilford

on Patent Litigation in the Central District

UC Irvine, School of Law

401 E. Peltason Dr., Irvine, CA 92697

Los Angeles

Registration/No-Host Reception - 6:00 p.m.

Dinner - 6:45 p.m.

Program - 7:30 p.m.

Orange County

Registration/Reception - 6:00 p.m.

Program - 7:00 p.m.

LAIPLA is pleased to announce our next dinner event will be held on Tuesday, April 12, 2011 at The California Club in downtown Los Angeles. Mr. Laurence Pretty will discuss "Issues Currently In Flux In Patent Law". Please note that this is also LAIPLA's Annual Meeting where we introduce our nominations for the new slate of Board members and officers and vote on these nominations.

Laurence Pretty will give a talk which he very recently delivered at Suffolk Law School's Annual IP Seminar in Boston. Laurence was a partner for many years in Pretty, Schroeder, Brueggemann & Clark and other LA patent firms where he practiced in litigation and prosecution. He is the Editor and co-author of the PLI Treatise PATENT LITIGATION. For approximately ten years, he taught patent law as an adjunct lecturer at UCLA Law School. Since 2007 he has been in sole practice, frequently acting as an expert witness. He is a former President of this Association and a former Chair of the State Bar IP Section.

We encourage you to invite your colleagues to join you for this informative event and look forward to seeing you on the 12th!

PLEASE USE THE RESERVATION FORMS ON PAGE 2 or 3.

If you are interested in attending the event in Orange County on Thursday, April 14, 2011, please use the Orange County Registration form on page 3. Judge Andrew J. Guilford will join the OC panel and speak on the status of patent litigation in the C.D. Cal.

This notice is available online at www.LAIPLA.net

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Issues Currently In Flux In Patent Law

Tuesday, April 12, 2011

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State of Patent Litigation in Re Central District and Issues Currently In Flux In Patent Law

Thursday, April 14, 2011

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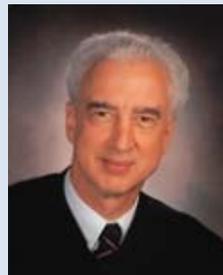
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