



## IP Blogs

Bloggers featured on our website:

### Professor Hal Wegner

⇒ *Wegner's Writings.*

⇒ *Wegner's Top Ten.*

### Justin Gray

⇒ *Gray on Claims — A Claim Construction & Patent Law Blog.*

### John Welch

⇒ *John Welch's The TTABBlog® — Keeping Tabs on ttab.™*

## Upcoming Events

- **Trademark Bootcamp**  
Thursday, October 24, 2013, 9 am – 5 pm.  
Irell & Manella, Century City.
- **LACBA: Federal Practice in the Central District (Co-Sponsored by LAIPLA)**  
Tuesday, November 12, 2013, 4 – 7:30 pm.  
Hilton DoubleTree Hotel, Downtown Los Angeles.
- **November Meeting: Social Media in Litigation**  
Thursday, November 21, 2013, 6 – 8 pm; Young Lawyers Meeting 5 – 6 pm.  
California Club, Downtown Los Angeles.
- **December Holiday Party: LAIPLA Members Only**  
Thursday, December 12, 2013, 6 – 8 pm.  
Bergamot Station, Santa Monica.
- **January: Washington in the West**  
Information on Washington in the West will be available soon.  
Check our website for updates.
- **June: Spring Seminar 2014**  
Friday, June 6 to Sunday, June 8, 2014.  
Ojai Valley Inn & Spa, Ojai, California.

To register for any of the above events or for more information, go to [www.laipla.net](http://www.laipla.net).

## Thank You, Sponsors,

for making LAIPLA great:

### Welcome Back Mixer

Sponsored exclusively by Thomson

Reuters Expert Witness Services

### October Meeting

Platinum: Thomson Reuters Expert

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### Trademark Bootcamp

Gold: ForensisGroup

Host: Irell & Manella LLP

### Website

Spotlight: TSG Reporting

Platinum: TSG Reporting

Gold: Murgitroyd & Company

Silver: Orange Legal Technologies

If you are interested in sponsoring an

event, please email Keith Newbury:

[Keith\\_Newbury@Edwards.com](mailto:Keith_Newbury@Edwards.com).

ISSUE

2013

FALL

LAIPLA Los Angeles Intellectual Property Law Association

## Event Recaps

### WELCOME BACK MIXER

Thanks to the generous support of our sponsor, Thomson Reuters Expert Witness Services ("TREWS"), our September 10 welcome back mixer was a tremendous success.

The mixer was held at McCormick & Schmick's in downtown LA. Around 60 IP professionals mingled over snacks and cocktails to kick off the 2013/2014 year. Wine tastings were also provided, courtesy of TREWS.

### OCTOBER MEETING

The Young Lawyers held a meet and greet before the reception, and then LAIPLA hosted its first dinner meeting of the year, *Tried and True Strategies for Working with Expert Witnesses: Advice from the Trenches*, at the California Club in downtown Los Angeles. Close to 70 IP professionals came to hear the lively panel discussion about tips on working with technical and damages experts at different stages of high-stakes patent litigation. Atlantis Langowski from TREWS moderated the distinguished and diverse panel, featuring Paul Tripodi of Wilson Sonsini, Karen Vogel Weil of Knobbe Martens, Lisa Buccino of SAP, and Dr. Richard Blanchard, veteran technical expert from TREWS. LAIPLA heartily thanks TREWS for its support.



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## President's Message

Greetings!

Welcome to LAIPLA's 80th year of serving the Southern California intellectual property community.

Monica Scheetz, our immediate past president, did an amazing job during her tenure. She promised significant and ambitious changes and delivered. Among her feats are:

- a rebuilt website with many new features, including a blog by Hal Wagner;
- free membership to in-house counsel and their companies;
- an in-house counsel outreach program;
- training sessions and other special events for young lawyers;
- new opportunities to interact with LAIPLA on LinkedIn, Facebook, and Twitter; and
- meetings in new locations.

She closed out the year with a terrific Spring Seminar at the Four Seasons, Las Vegas. Thanks, Monica, for your hard work, as both a director and officer. The Board will build on your successes.

We've got a great year planned. On **Thursday, October 24**, we present Trademark Bootcamp, a day-long seminar covering changes in trademark law and successful strategies in trademark protection. On **Tuesday, November 12**, the LACBA and LAIPLA are co-sponsoring *Federal Practice in the Central District: Changes, Trends and Updates*. Our **Thursday, November 21** dinner meeting will feature Claude Stern of Quinn Emmanuel, speaking on the use of social media in litigation, and our first formal Young Lawyers program of the year will take place that day before the reception. On **Thursday, December 12**, we'll have a holiday mixer at the Bergamot Station in Santa Monica. With January comes Washington in the West, and we've already lined up an impressive group of speakers. Spring Seminar 2014 will be held at the Ojai Valley Inn and Spa June 6-8. So save those dates!

All of the LAIPLA committees are hard at work and would welcome assistance, so please take a look at the committee descriptions on our website and get involved!

*Marsha Mullin is the 2013-2014 President of LAIPLA and a member of Alston & Bird's Intellectual Property Group in the Los Angeles office. Her practice primarily focuses on patent litigation.*



LAIPLA Newsletter Fall 2013

LAIPLA Los Angeles Intellectual Property Law Association

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Senior IP attorney from out of state with growing SoCal practice wishes to establish "Of Counsel" or similar relationship with well-regarded and collegial LA area IP group to attract mutually beneficial business and better serve his clients. "av" rated and elected to "Super Lawyers" in his home state. Law review editor, visiting scholar at the Max Planck Institute for Patent, Copyright and Competition Law and CLE contributor. Admitted to practice in several states, including California, and before United States Patent and Trademark Office, as well as a number of federal district courts, the Ninth Circuit and the Federal Circuit. Substantial experience in patent and other IP litigation, Federal Circuit appeals, inter partes proceedings in the USPTO and patent prosecution. BSEE and MS Optical Sciences. Full bio and references provided on request.

Please email  
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to open a dialogue.

## Vance Woodward's IP Law Update

### A sampling of recent significant IP cases.

#### Patents

In *High Point Design LLC v. Buyers Direct, Inc.*, 2013 WL 4826282 (Fed. Cir. Sept. 11, 2013), the federal court of appeal reversed the Southern District of New York's grant of summary judgment against defendant/patentee BDI because the district court applied the wrong standards in finding that BDI's design patent was invalid for being (1) obvious and (2) primarily functional.

The appeal court stated that, in evaluating obviousness, the analysis must focus on the distinctive visual appearances of the claimed design and add sufficient detail to its verbal

description thereof to evoke a visual image consonant with that design. In this instance, the district court merely described BDI's design as "slippers with an opening for a foot that can contain a fuzzy (fleece) lining and have a smooth outer surface," and as having "a smooth exterior and a fuzzy interior," which the appeal court found to be too high a level of abstraction because it failed to focus on the distinctive visual appearance of the claimed design.

Regarding functionality, an inventor can obtain a design patent for "any new, original and ornamental design for an article of manufacture" 35 U.S.C. § 171. Accordingly, a design patent can be declared invalid if the claimed design is primarily functional rather than primarily ornamental, i.e., if the claimed design is dictated by the utilitarian purpose of the article. To properly evaluate whether the claimed design is dictated by functional considerations, the focus is not on the article as a whole but on the claimed design. A "distinction exists between the functionality of an article or features thereof and the functionality of the particular design of such article or features thereof that perform a function." In other words, the functionality analysis turns on whether the claimed design was "primarily functional or primarily ornamental," not on whether the "design's primary features can perform functions."

#### Copyrights

In *Dash v. Mayweather*, 2013 WL 4766854 (4th Cir. Sept. 26, 2013), the Fourth Circuit upheld a grant of summary judgment against music producer Dash for failing to show any dispute of fact regarding damages. Dash sued Floyd Mayweather, World Wrestling Entertainment and others, alleging they violated his copyright by playing a work derivative of his own during Wrestlemania XXIV.

The court found that Dash failed to

show that "a willing buyer would have been reasonably required to pay a willing seller" for his work, that being the threshold standard against which actual damages are established. (Statutory damages were unavailable because Dash registered his copyright after the alleged infringements.) Dash failed to meet this standard because he (1) had not previously commercially exploited his allegedly infringed work, (2) failed to show that he had ever "sold one of his beats" prior to the alleged infringement, and (3) failed to produce evidence of comparable artists being compensated in comparable situations. This rendered Dash's damages too speculative to show that "a reasonable jury could return a verdict" in his favor on his damages claim. That other composers were paid royalties in connection with WWE events was not germane because those other artists were well-known composers.

Moreover, Dash's expert failed to expressly conclude that Dash's work had any market value, which apparently would have been fatal to Dash's damages claim even if the supporting evidence had not been too speculative.

This case highlights the difficulty new artists have in protecting their copyrights, and the importance of properly crafting expert reports.

#### Trademarks/Trade Dress

In *Groeneveld Transport Efficiency, Inc. v. Lubecore Intern., Inc.*, 2013 WL 4838792 (6th Cir. Sept. 12, 2013), plaintiff Groeneveld sued Lubecore for product-design trade-dress infringement in connection with Lubecore's sale of a grease pump that looked virtually identical to Groeneveld's.

To prevail on a claim for product-design trade-dress infringement, a plaintiff must prove that its product design is protectable and has been

infringed. The court found that Groeneveld's product-design trade dress was neither protectable nor infringed.

Trade dress is protectable if it is nonfunctional (its overall shape "is [not] essential to the use or purpose of the article") and has acquired secondary meaning ("in the minds of the public, the primary significance of a product feature or term is to identify the source of the product rather than the product itself"). Here, the court found that the pump design was functional, and therefore not protectable, because every part of the pump was essential to its use. Groeneveld argued that competitors other than Lubecore used different designs for their grease pumps, suggesting that Groeneveld's particular design was unnecessary and therefore nonfunctional. The court rejected this argument, finding that the appropriate question is not whether the design was necessary but whether the actual design was in fact essential to the use or purpose of the article.

Turning to infringement, the test is whether the trade dress is confusingly similar to the allegedly infringing product design, which turns on "whether an ordinary consumer would confuse the products at issue, which in fact come from different sources, as emanating from a single source or from associated sources." Here, although the pumps were nearly identical, each company put its own "unmistakably different" labels on them. The court concluded that "no reasonable consumer would think that the two grease pumps belong to the same company." Consequently, the appeal court upheld the lower court's judgment as a matter of law against the plaintiff.

According to the court, "[t]his result is consonant with the public policy underlying the functionality doctrine, which is to channel the legal protec-

tion of useful designs from the realm of trademark to that of patent."

#### Trade Secrets

In *In re Google Inc. Gmail Litigation*, 2013 WL 5366963 (N.D. Cal. Sept. 25, 2013), the court sealed portions of a complaint against Google because they contained trade secrets.

Generally, "sealing may be justified to prevent judicial documents from being used as sources of business information that might harm a litigant's competitive standing." Google moved the court to seal portions of the complaint that revealed aspects of Google's Gmail that could, if disclosed, enable competitors to duplicate features of Gmail and enable hackers and spammers to circumvent aspects of Gmail's anti-virus and anti-spam mechanisms. Noting that the Ninth Circuit has not yet ruled on whether the appropriate standard for sealing a complaint is "good cause" or "compelling reasons," the district court applied the latter standard and credited Google's contention that it would suffer competitive harm from the disclosure while also finding a lack of strong public interest in disclosure because the to-be-sealed material was unlikely to be critical to the substantive issues of the case.

This can be contrasted with *Apple Inc. v. Samsung Electronics Co., Ltd.*, 2013 WL 4487610 (Fed. Cir. Aug. 23, 2013), where the Federal Circuit, applying California law, found that the "good cause" standard applies to the sealing of trade secrets contained in documents filed with non-dispositive motions.

*Vance is a jury-trial-experienced lawyer and patent attorney serving tech and media clients primarily in IP, insurance coverage and employment matters. He welcomes feedback. You can reach him at vance@woodwardlawfirm.com.*

#### AMGEN Patent Coordinator – Thousand Oaks, CA (#21792BR)

Amgen (NASDAQ:AMGN), a biotechnology pioneer, discovers, develops and delivers innovative human therapeutics. Our medicines have helped millions of patients in the fight against cancer, kidney disease, rheumatoid arthritis and other serious illnesses. With a deep and broad pipeline of potential new medicines, we continue to advance science to serve patients.

#### Job Summary:

We are seeking a highly organized, self-motivated patent coordinator to provide administrative support to the Intellectual Property Law team. The successful candidate will provide support to the Intellectual Property team by assisting with the preparation, filing, prosecution, and maintenance of patent applications both U.S. and Foreign. The Patent Coordinator will also prepare interference and opposition files, draft correspondence, conduct reference research and ordering, prepare for meetings, order file histories and set-up files and databases, prepare IDS and other prosecution documents, and proofread.

The role includes word processing, copying, faxing, scanning, preparing expense reports, maintaining filing systems and calendars, scheduling meetings and coordinating travel arrangements, and utilizing on-line services (document orders, shipping, office supplies, etc).

This position will be located at Amgen's headquarters in Thousand Oaks, CA.

#### Basic Qualifications:

Associate's degree & 2 years of directly related experience  
OR  
High school diploma / GED & 4 years of directly related experience

#### Preferred Qualifications:

Recent patent prosecution experience in a law firm or corporate law department; a minimum of 3-5 years of experience in a law firm; strong computer, word processing and proofreading skills.

To learn more about this opportunity, and to apply, please visit us online at [www.amgen.com](http://www.amgen.com) and apply for job #21792BR

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Arizona, Florida, Illinois, Massachusetts, Nevada, New Jersey, New York, Ohio, Oregon, Texas, Washington

## Law School OUTREACH

LAIPLA is wrapping up another successful season of the Law School Outreach Program. This season, we organized panel discussions about careers in IP law at six law schools:

- LOYOLA LAW SCHOOL
- PEPPERDINE UNIVERSITY
- SOUTHWESTERN
- UCLA
- USC GOULD SCHOOL OF LAW
- WHITTIER

Each panel included a mix of big-firm, small-firm, and in-house lawyers who work in the fields of IP litigation (copyright, patent and trademark) and prosecution. Student attendance and enthusiasm were high this year,

and several students expressed interest in joining LAIPLA. Panelists usually find the experience rewarding as well; many of them have participated in the program for several years.

LAIPLA thanks all of the panelists and the career services staff at the law schools for making this year's Law School Outreach Program a success. A special thank you goes out to this year's committee chair, Ryan Malloy, as well as Shouvik Biswas, André De La Cruz, Victor de Gyrfas, Alan Laquer, Steven Smyrski, Paul Tripodi II, and Vision Winter, who were responsible for arranging and moderating the panels. We look forward to doing it again next year!