



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®*

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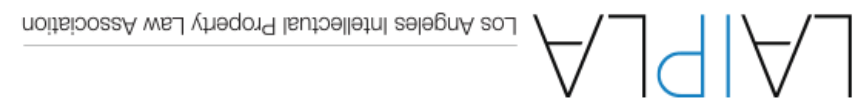
LAIPLA Spring Seminar

June 6 - 8, 2014

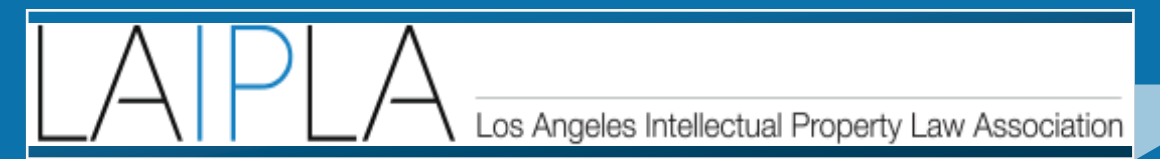
Ojai Valley Inn

See article on page 6 for a summary of this year's planned Spring Seminar, LAIPLA's pinnacle event of the year. For more information or to register, go to www.laipla.net.

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Event Recaps

TRADEMARK BOOTCAMP

On October 24, 2014, LAIPLA held a Trademark Bootcamp. Offering six hours of MCLE credits, the seminar was jam-packed with information that benefitted attorneys at all levels of practice.

NOVEMBER MEETING

On November 21, 2013, Claude M. Stern of Quinn Emanuel Urquhart & Sullivan LLP spoke on "Social Use of Media in Litigation: During Discovery and As Evidence." The meeting was preceded by a Young Lawyers Committee presentation by Jeffrey G. Sheldon, a founding partner of Sheldon Mak & Anderson, who offered practical tips from young lawyers on the art of taking and defending depositions in IP litigation.

DECEMBER MIXER

On December 11, 2013, LAIPLA held an exclusive, members-only holiday mixer at Bergamot Station in Santa Monica at the Ruth Bachofner gallery. The event was free to LAIPLA members and featured food, drink, art, and good conversation.

(Recaps continued on page 4.)



this issue

- President's Message **P.1**
- Event Recaps **P.1**
- IP Article **P.3**
- Upcoming Events **P.6**
- Sponsor Acknowledgements **P.7**
- Blog List **P.8**

President's Message

Greetings!

LAIPLA's 80th year of serving the Southern California intellectual property community has been a great success to date, with our signature event just around the corner – Spring Seminar 2014 June 6-8 at the fabulous Ojai Valley Inn & Spa in beautiful Ojai, California. If you haven't already registered, I encourage you to do so soon, as our room block is almost full! We're mixing things up a bit, with the Year In Review sessions on Friday instead of Sunday, the addition of both ethics and substance abuse MCLE credits, and some terrific Saturday dinner entertainment. We're also bringing back Saturday lunch and continuing the Past Presidents luncheon tradition Brian Arnold started during his tenure.

LAIPLA's successful year is due wholly to the work of its committees. Committee membership is a great way to get involved with LAIPLA, and it's a lot of fun. I encourage all of you to take a look at the committee descriptions on our website and sign up for a committee whose work interests you. You won't be sorry!

My presidency is, sadly, drawing to a close. It has been an honor to have served as LAIPLA's president. I have worked with some wonderful folks and made more friends than I can count. I will continue my participation in LAIPLA's events as the organization moves forward, and urge you to do the same.

See you all at Spring Seminar!

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.





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SOFTWARE Work for Hire AGREEMENTS

by Craig Robson

Regardless of your industry, chances are likely that you or your firm will at some point need to procure software products or services. Many times, instead of licensing that software using an off-the-shelf solution, it actually makes financial and strategic sense to either develop customized software in-house through qualified professionals within your organization or to engage the services of an outside software development firm. In both circumstances of software development, it is critical to answer the fundamental question: "Who owns this software?" A firm wishing to answer this question in its favor will likely need to analyze the circumstances through the "work for hire" doctrine as applicable to copyright law.

What Does "Work for Hire" Mean?

Section 101 of the Copyright Act of 1976 (17 U.S.C.A. § 101) defines a "work made for hire" as either: (a) one prepared by an employee within the scope of his or her employment; or (b) one of nine specified categories of specially ordered or commissioned works, provided that the parties expressly agree in writing that the work is made for hire. In the software context generally, this means that copyrights in a software program created by an em-

ployee while doing his job are owned by the firm. If the firm decides to hire an independent contractor, there must be a written agreement for the copyrights in the software program to be owned by the firm. The classification of a software program as a "work for hire" is not trivial—it determines initial copyright ownership, registration rights, infringement remedies, copyright duration, renewal rights, and distribution and import rights.

Accordingly, in the context of the firm's relationship with its employees or its independent contractors, a few points should be kept in mind.

Ensure That Your Employees' Scope of Duties Cover Software Development.

Most employees, particularly those developing software programs, are at-will employees and so it is likely that your firm does not have an employment contract that specifically commissions the development of a specific software program. A firm can, however, in developing a broad scope of duties and job description documentation, ensure that it is clear that the particular employees' respective duties include software development. This may require a customized analysis of your work force so as to not "miss" employees that may be developing software. A classic example is found in *Quinn v. City of Detroit*, 988 F. Supp. 1044 (E.D. Mich. 1997), in which a city staff attorney wrote a case management computer program. Even though the attorney

was presumably using the software programs at work for the benefit of his employer, the court did not classify this development as a "work for hire". The court reached this conclusion because the attorney was not hired to design computer programs, the program was not specific to the law department, and the attorney designed the program at home using a software package that he purchased with his own funds. Though most firms' experiences in this scenario are not likely to be as dire, it also makes sense to ensure that you are adequately classifying and fulfilling the requirements of your obligations as an employer, lest your employees be deemed independent contractors.

Prepare Clear Agreements for Independent Contractors.

The engagement of an independent contractor to create software programs as "work for hire" also raises issues—most notably the necessity of a written agreement (aka a Software Development Agreement) to vest any and all ownership in the firm. Absent a written agreement that specifically delineates the ownership in the software program, a firm is often left to the mercy of a court's (costly and lengthy) determination. In most cases, as in *Jou v. Accurate Research, Inc.*, 73 Fed. Appx. 964 (9th Cir. 2003), the results are typically in favor of the independent contractor. In *Jou*, the programmers were independent contractors rather than employees of the firm, and the court held their work product was not

"work for hire" because the firm did not control the manner or means by which programmers performed their work, did not treat programmers as employees for tax purposes, and did not provide any employee benefits to them. *Id.* In fact, the failure to execute a written agreement is so critical, some case law suggests that even if the firm continued to use a programmer to create software programs on the firm's own campus, his independent contractor status (as evidenced by no deductions in taxes from paychecks and other circumstances) would vest the copyrights created in the software program in the programmer himself. *BPI Systems, Inc. v. Leith*, 532 F. Supp. 208 (W.D. Tex. 1981).

Because of the nature of this issue in both the employee and independent contractor frameworks, firms serious about protecting and expanding their software IP portfolios should engage the services of a qualified attorney to help provide effective counsel to navigate the "work for hire" waters.

Craig Robson is an experienced Commercial and Business litigation attorney with Michelman & Robinson, LLP in Irvine, California, specializing in business litigation, real estate, construction defect, employment, and insurance matters. He has 12 years of law and motion experience before both Federal and State courts and has significant trial experience, including: first and co-chair on two court trials and second chair on two jury trials.

EVENT RECAPS (CONT'D)

WASHINGTON IN THE WEST 2014

On January 24, 2014, LAIPLA hosted its annual Washington in the West conference at the beautiful and intimate Luxe Sunset Boulevard Hotel. Nearly 100 attendees gathered to hear thought-provoking presentations on topics including *The Changing Patent Landscape*, *Hot Topics for In-House Patent Practitioners*, *TTAB Best Practices*, and *Ethical Considerations in Today's Patent Practice*. The Honorable Raymond T. Chen, of the U.S. Court of Appeals for the Federal Circuit, was the event's keynote speaker. Other distinguished speakers and panelists included Andrew Byrnes (Chief of Staff for the USPTO) and Teresa Stanek Rea (Former Acting Director of the USPTO).



Washington in the West 2014 photo. From left to right: Honorable Raymond T. Chen (U.S. Court of Appeals, Federal Circuit), Phil Lam (Intellectual Property Counsel, City of Los Angeles), Andrew Byrnes (Chief of Staff for the United States Patent and Trademark Office), Greer Shaw (Snell & Wilmer LLP), Theresa Stanek Rea (Crowell & Moring LLP, former Acting Under Secretary of Commerce for Intellectual Property and former Acting Director of the United States Patent and Trademark Office), Seth Weisberg (Chief Legal Officer, Stamps.com Inc.), and Joseph Lipner (Irell & Manella LLP).

JUDGES' NIGHT 2014

On February 19, 2014, over 150 people attended Judges' Night at the Biltmore Hotel. The event was co-sponsored by The Judge Paul R. Michel Intellectual Property American Inn of Court. After a cocktail hour, Chief Magistrate Judge Suzanne H. Segal was presented with the First Annual LAIPLA Distinguished Public Service Award. Following dinner, Judge Kathleen O'Malley of the Federal Circuit delivered a keynote address that touched on the recent legislative proposals in Congress concerning "patent trolls." After the keynote address, Judge O'Malley joined in a panel discussion with the Honorable S. James Otero and the Honorable George H. Wu, two of the "patent pilot" judges in the Central District. The discussion was moderated by LAIPLA member Ted Chandler and covered several recent developments in the law, including the impact of "patent trolls" on district court litigation, claim construction and deference to trial judges, the patent pilot project, the impact of the post-AIA proceedings in the Patent Office on district court litigation, and practice pointers when arguing in the Central District and the Federal Circuit.



Judges' Night 2014 photo. From left to right: Vern Schooley (President, The Judge Paul R. Michel Intellectual Property American Inn of Court, and Partner, Fulwider Patton LLP), Honorable George H. Wu (U.S. District Court, C.D. Cal.), Honorable S. James Otero (U.S. District Court, C.D. Cal.), Honorable Kathleen M. O'Malley (U.S. Court of Appeals, Fed. Cir.), Honorable Gary A. Feess (U.S. District Court, C.D. Cal.), and Ted Chandler (Partner, Sidley Austin LLP).

EVENT RECAPS (CONT'D)

MARCH MONTHLY MEETING

On March 9, 2014, LAIPLA held a dinner meeting on "Best Practices in Patent Prosecution" at the California Club in downtown Los Angeles. The meeting featured Robert Evora of Munchkin, Inc., Milan Kapadia of CoreLogic, and Kenton Abel of Allergan, who spoke about their own personal best practices as in-house patent prosecutors. Some of the highlights included tips for conducting examiner interviews and business development tips for outside counsel.

Reception attendees at the March Monthly Meeting.



LITIGATION ROUNDTABLE

On April 8, 2014, David Quinto of Kupferstein, Manuel & Quinto LLP spoke on trade secrets at LAIPLA's Litigation Roundtable, held at Morton's in Beverly Hills. Joanna Ardalan, the Trademark and Copyright committee chair, and members of the audience asked David about his tactics and strategies for winning a trade secret case. David set forth various factors for the strategic trade secret litigator to consider, many of which are also explained in his practice guide *Trade Secrets: Law and Practice*, which is co-authored by Stuart Singer.

From left to right: Scott Commerson (Quinn Emanuel), Phyllis Kupferstein (Kupferstein Manuel & Quinto), and David Quinto (Kupferstein Manuel & Quinto).

COPYRIGHT COCKTAIL HAPPY HOUR

On April 22, 2014, LAIPLA hosted a copyright cocktail hour at McCormick & Schmick's in downtown Los Angeles. About 40 people came to hear Ronald Wheeler, Senior Vice President, Content Protection, Fox Entertainment Group; Professor Doug Lichtman, Professor of Law at UCLA School of Law; and Bryant Yang, Irell & Manella LLP, discuss application of the First-Sale Doctrine to digitized copyrighted material.

From left to right: Doug Lichtman (Professor of Law, UCLA School of Law), Ronald Wheeler (Senior Vice President, Content Protection, Fox Entertainment Group), and Bryant Yang (Irell & Manella LLP).



AND STILL TO COME...

MAY ANNUAL MEETING

LAIPLA's Annual Meeting will be held on May 13, 2014, at the Omni Hotel in downtown Los Angeles. Pursuant to Article VIII, Sections 8.1 and 8.2 of the LAIPLA Bylaws, the LAIPLA Nominating Committee selected the following slate of nominees for presentation at the Annual Meeting:

- President: Darren M. Franklin, Sheppard Mullin Richter & Hampton LLP
- Vice President: Scott R. Hansen, Fulwider Patton LLP
- Secretary: Bitu Rahebi, Morrison & Foerster LLP
- Treasurer: Mark A. Treitel, Quinn Emanuel Urquhart & Sullivan, LLP
- Director: Theodore W. Chandler, Sidley Austin LLP
- Director: Joanna Ardan, Kulik Gottesman & Siegel LLP
- Director: Greer N. Shaw, Snell & Wilmer LLP

Directors serving the second year of their two-year term are Sarah S. Brooks, Stradling Yocca Carlson & Rauth, P.C.; Laura M. Burson, Sheppard Mullin Richter & Hampton LLP; and Bryant Y. Yang, Irell & Manella LLP.

In addition, the May Annual Meeting will feature a discussion on "Hot Topics in Privacy Law." The scheduled panelists are Tanya Forsheit, Founding Partner of InfoLawGroup LLP; Sari Heller Ratican, Chief Privacy Officer, Worldwide Compliance and Business Ethics, Amgen; and Chris Pahl, Privacy Compliance Program Leader, Southern California Edison. The panelists, all of whom are Certified Information Privacy Professionals, will discuss a number of issues, including privacy concerns raised by the "Internet of Things," such as wearable technology; recent trends in class action litigation under the Telephone Consumer Protection Act; evolving law and practices raised by smart grid technology; and the business impact of California's new Do-Not-Track disclosure requirements.

SPRING SEMINAR 2014

Spring Seminar 2014 will be held June 6-8, 2014, in beautiful Ojai, California, at the Ojai Valley Inn. The schedule of sessions is as follows:

FRIDAY

- ⇒ Copyright Year in Review
- ⇒ Trademark Year in Review
- ⇒ Patent Year in Review

SATURDAY

- ⇒ What's Going on at the PTAB? Recent Developments in Post-AIA Proceedings
- ⇒ When the Patents Hit the FRAND—Litigating Standards Essential Patents
- ⇒ Is the System Broken? Identifying Good and Bad Behaviors in Licensing

SUNDAY

- ⇒ Inequitable Conduct—Unwinding the Tangled Web of Deceit
- ⇒ Substance Abuse in the Legal Profession: Prevention, Detection, and Treatment

These sessions will be led by a number of judges, academics, and nationally renowned practitioners, including the following:

CONFIRMED SPEAKERS

- | | | |
|---|--|---|
| ⇒ Mehran Arjomand—Morrison & Foerster | ⇒ Jay Kesan—University of Illinois School of Law | ⇒ David Nimmer—Irell & Manella |
| ⇒ Ian Ballon—Greenberg Traurig | ⇒ Stephen Korniczky—Sheppard Mullin | ⇒ Hon. James L. Robart—W.D. Wash. |
| ⇒ David Dillard—Christie, Parker & Hale | ⇒ Eeva Hakoranta—Nokia Corporation | ⇒ David Rosmann—Acacia Research Group |
| ⇒ Phil Hartstein—Finjan | ⇒ David Mann—The Other Bar | ⇒ David Teece—UC Berkeley |
| ⇒ Michael Kallus—RPX | ⇒ Mark McCarty—Alston & Bird | ⇒ Harold C. Wegner, Foley & Lardner |
| | | ⇒ Mark Wine, Orrick, Herrington & Sutcliffe |

In addition to the educational sessions listed above, there will be plenty of networking opportunities, including receptions, a poker tournament, breakfasts, and lunch as well as dinner on Saturday. Don't miss out! Go to www.laipla.net to register or for more information.

MANY THANKS TO OUR SPONSORS

Without sponsors, many of LAIPLA's events and services would not be possible. We sincerely thank all of the following organizations for financially supporting LAIPLA.

TRADEMARK BOOTCAMP

- **Host:** Irell & Manella LLP
- **Gold:** ForensisGroup
- **Silver:** Kulik Gottesman & Siegel LLP

NOVEMBER MEETING

- **Bronze:** Stradling Yocca Carlson & Rauth, P.C.

DECEMBER HOLIDAY MIXER

- **Silver:** Advanced Depositions
- **Silver:** Advanced Discovery
- **Silver:** TSG Reporting
- **Bronze:** Computer Packages, Inc.
- **Bronze:** Esquire Deposition Solutions

WASHINGTON IN THE WEST 2014

- **Platinum:** Kroll Ontrack
- **Gold:** 3C Advisors & Associates Inc.
- **Gold:** Christie Parker Hale LLP
- **Gold:** Irell & Manella LLP
- **Gold:** O'Melveny & Myers LLP
- **Silver:** Computer Packages Inc.
- **Silver:** Esquire Deposition Services
- **Silver:** Forensis Group
- **Silver:** Merrill Corporation
- **Silver:** Sheppard, Mullin, Richter & Hampton LLP
- **Silver:** Veritext Legal Solutions

JUDGES' NIGHT 2014

- **Gold:** Epiq Systems
- **Gold:** Snell & Wilmer
- **Bronze:** Computer Packages, Inc.

COPYRIGHT COCKTAIL HOUR

- **Silver:** Advanced Depositions
- **Silver:** Advanced Discovery
- **Bronze:** Irell & Manella LLP

SPRING SEMINAR 2014 (SO FAR...)

- **Saturday Cocktail Party:** Murgitroyd & Company
- **President's Party:** Berkeley Research Group, LLC
- **Platinum:** TSG Reporting, Inc.
- **Gold:** Alston & Bird
- **Gold:** Nathan Associates, Inc.
- **Gold:** Snell & Wilmer
- **Silver:** Christie Parker Hale LLP
- **Silver:** Navigant
- **Silver:** Veritext
- **Bronze:** Computer Packages, Inc.
- **Bronze:** Inovia
- **Bronze:** McKool Smith
- **Bronze:** Morrison & Foerster LLP

There is still time to sign up as a Spring Seminar Sponsor. You can do so today by contacting Keith Newbury, Keith_Newbury@Edwards.com or (949) 250-6803.

TIME TO RENEW YOUR MEMBERSHIP AND GET MORE INVOLVED WITH LAIPLA

LAIPLA's membership year runs from July 1 to June 30, so it's time to think about renewing. If you renew before July 1, 2014, you will receive an early-bird discount. For details on membership rates and to join or renew, go to the Membership page on LAIPLA's website.

When you think about renewing your membership, also consider joining a LAIPLA committee if you have not done so already. Like with any organization, the more you put into LAIPLA, the more you personally benefit. There are many ways in which you can volunteer. For information on our various committees, check out the Get Involved menu items on LAIPLA's website.

ON THE COVER

Wondering who the people are in the cover photo? That's the Central District of California's Chief Magistrate Judge Suzanne H. Segal (center, holding award) at Judges' Night 2014 with LAIPLA board members (from left to right) Mark Treitel (Quinn Emanuel), Bitu Rahebi (Morrison & Foerster), Greer Shaw (Snell & Wilmer), Sanjesh Sharma (Intellectual Property Counsel, Abbott Medical Optics), Scott Hansen (Director, Senior IP Counsel, Western Digital), and Sarah Brooks (Stradling Yocca Carlson & Rauth).