



# December 2012 Newsletter

## The Federal Bar Association, San Diego Chapter

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### SAN DIEGO HOSTS THE FEDERAL BAR ASSOCIATION'S ANNUAL MEETING AND CONVENTION

**JOE LEVENTHAL, LEVENTHAL LAW**

The San Diego Chapter of the Federal Bar Association hosted the Association's national meeting and convention from September 20-22, 2012. The meeting and convention, which was held at the Manchester Grand Hyatt in downtown San Diego, attracted approximately 400 federal judges and practitioners from across the country.

The convention included 16 CLE sessions on topics of interest to federal practitioners. As one example, the attendees learned about effective advocacy from distinguished panelists that included Judges J. Clifford Wallace, Michael Daly Hawkins, and Irma E. Gonzalez. Attendees also heard a review of the key cases decided by the U.S. Supreme Court from constitutional scholar Erwin Chemerinsky. Other CLE topics focused on legal issues affecting international, environmental, class action, tribal, immigration, criminal, labor and employment, patent, and bankruptcy practitioners. The convention also featured a session targeting younger lawyers and two sessions addressing discovery issues, including social media and the proliferation of electronic data. The San Diego convention offered more CLE sessions than any other convention in recent memory.

In addition to the annual business meetings, the convention had a host of awards ceremonies including the Younger Federal Lawyers Awards Luncheon and the FBA Awards Luncheon. The San Diego Chapter was proud that local attorney Peter Mazza, of the U.S. Attorney's Office, received a Younger Lawyer Award for his impressive career.

The San Diego Chapter also received several awards at the FBA Awards Luncheon.



**Ninth Circuit Judge Michael Daly Hawkins and District Judge Irma Gonzalez speak at the FBA Convention**

Having the convention in San Diego allowed the host committee to showcase some of San Diego's highlights. On Thursday evening, the convention held a social reception on the U.S.S. Midway, one of our nation's longest-serving aircraft carriers. The event emphasized the history and importance of the military to our region. Guests had the opportunity to take guided tours and to test their skills in the carrier's flight simulators.

On Friday evening, the host committee held an open air fiesta by the San Diego Bay. Attendees were entertained by a mariachi band and enjoyed Mexican food in perfect San Diego weather.



**San Diego Assistant U.S. Attorney Pete Mazza, 4th from left, with other recipients of the FBA's Younger Federal Lawyer Award**

The annual convention ended with the Presidential Installation Banquet on Saturday evening, which saw the Association install Robert J. DeSousa of Pennsylvania as its president. The San Diego host committee recognized the convention's honorary co-chairs at the Installation Banquet. The honorary co-chairs were Southern

District Judges Gonzalez and Anthony Battaglia and former national president Lawrence Baca, all of whom continue to be solid supporters of the Federal Bar Association and the San Diego Chapter.

As the host of the national meeting and convention, the San Diego chapter will receive some additional funds that it will use for ongoing CLE events in San Diego.

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**FBA Chapter President Katie Parker, AUSA Rebecca Kanter, and District Judge Anthony Battaglia at the USS Midway reception**



## THE FEDERAL CIRCUIT TACKLES “DIVIDED” PATENT INFRINGEMENT

BY: **BRYAN BLUMENKOPF**  
**FISH & RICHARDSON P.C.**

Patent infringement is a tort with a scope defined in 35 U.S.C. § 271. Some patents cover a process or method of carrying out certain steps. A party who practices all the steps of a patented method is said to “directly” infringe the patent under § 271(a). A party who actively induces someone else to practice all of the steps of a patented method is liable for indirect infringement under § 271(b). But what about a situation where two (or more) parties together practice all the steps of a method yet no party performs all of the steps itself? This type of “divided infringement” has presented problems for the courts because it seems to fall through the cracks of § 271. Section 271(a) may not apply if nobody practices all of the elements; section 271(b) may not apply if nobody actively induces someone else’s infringing actions. The Court of Appeals for the Federal Circuit, which handles all patent appeals, recently revamped its approach to “divided infringement” in its *en banc* decision in two consolidated cases: *Akamai Techs., Inc. v. Limelight Networks, Inc.* and *McKesson Techs., Inc. v. Epic Sys. Corp.*<sup>1</sup>

### BACKGROUND ON THE PROBLEM

Divided infringement became a real issue in the 1990s and 2000s, when the patent system experienced an influx of patents on methods, many related to networked computer systems, whose steps could easily (and often most naturally) be divided up and performed by different actors. One example might be a patent covering a method of searching for information on the Internet. Some steps of the method—like inputting a search string—would be performed by an individual user. But other steps—like processing the search request and retrieving results based on it—would be performed by a host computer at Google or Yahoo! Such patents were effectively unenforceable because, in practice, no single actor would perform all the steps of the method. Other patents didn’t necessarily involve multiple actors, but were easy to circumvent by simply arranging for someone else to perform one of the steps. Owners of these patents took to the courts in the 2000s, looking to hold someone liable for divided infringement.

### DIVIDED INFRINGEMENT CASES LEADING UP TO

#### AKAMAI AND MCKESSON

The Federal Circuit initially resisted attempts to hold divided infringers liable for inducement under § 271(b). It held, in cases like *Dynacore Holdings Corp. v. U.S. Philips Corp.*, that indirect infringement under § 271(b) requires some underlying direct infringement.<sup>2</sup> The court tightened this requirement in *BMC Resources, Inc. v. Paymentech, L.P.*, by endorsing the so-called “single entity rule” – in order to find indirect infringement under § 271(b), the patentee must show that the underlying direct infringement was performed by some single entity.<sup>3</sup>

In *BMC Resources*, the court further explained that when multiple infringing parties are involved, direct infringement only exists where one of the parties, acting as a “mastermind”, exercises sufficient “control or direction” over the other parties’ acts.<sup>4</sup> The Federal

Circuit later strengthened this control or direction requirement in *Muniauction, Inc. v. Thomson Corp.*, holding that merely controlling access to an infringing system, and instructing users on its use, did not need the requirement.<sup>5</sup> Under *Muniauction*, the control or direction requirement is only met where traditional principles of vicarious liability would hold a controlling party liable—for example, when one party is acting as an agent of the other.

### THE NEW RULE OF AKAMAI AND MCKESSON

The Federal Circuit recently revisited *BMC Resources* and *Muniauction* in an *en banc* opinion in *Akamai* and *McKesson*, two separate cases which it consolidated for decision. The district courts in both cases had followed *BMC Resources* and *Muniauction* to find noninfringement where no single entity had performed all steps of a patented method.<sup>6</sup> In *Akamai*, the defendant had been held not to infringe the plaintiff’s patent on a method of delivering web content, because the defendant’s customers—not the defendant itself—performed one of the requisite steps of the method. Similarly, in *McKesson*, the plaintiff’s patented method of electronic communication between doctors and patients was held not infringed because the steps of the method were shared between the doctors and the patients.

The Federal Circuit expressly overruled *BMC Resources* and reversed the district court rulings in both *Akamai* and *McKesson*. Noting that “[r]equiring proof that there *has been* direct infringement as a predicate for induced infringement is not the same as requiring proof that a single party would be *liable* as a direct infringer”, the court disposed of the single entity rule:

If a party has knowingly induced others to commit the acts necessary to infringe the plaintiff’s patent and those others commit those acts, there is no reason to immunize the inducer from liability for indirect infringement simply because the parties have structured their conduct so that no single defendant has committed all the acts necessary to give rise to liability for direct infringement.<sup>7</sup>

The court further decided that inducement need not involve an agent of the inducer, or a party acting under the inducer’s control or direction. The court analogized divided infringement of a patent to aiding and abetting in criminal law: if an accomplice assists another in committing a crime, the accomplice can be convicted of that crime regardless of whether he exercises any control or direction over the principal. The accomplice need only intentionally aid or encourage the principal. Similarly, in tort law, as the court noted, joint tortfeasors need not exert control or direction to be held liable for joint torts:

*Continued on Page 8*

1 692 F.3d 1301 (Fed. Cir. 2012) (en banc).  
2 *Dynacore Holdings Corp. v. U.S. Philips Corp.*, 363 F.3d 1263 (Fed. Cir. 2004).  
3 *BMC Resources, Inc. v. Paymentech, L.P.*, 498 F.3d 1373 (Fed. Cir. 2007).  
4 *Id.* at 1381.

5 *Muniauction, Inc. v. Thomson Corp.*, 532 F.3d 1318 (Fed. Cir. 2008).  
6 *Akamai Techs., Inc. v. Limelight Networks, Inc.*, 614 F. Supp. 2d 90 (D. Mass. 2009); *McKesson Info. Solutions LLC v. Epic Sys. Corp.*, 2009 U.S. Dist. LEXIS 88158 (N.D. Ga., Sept. 6, 2009).  
7 *Akamai*, 692 F.3d at 1308-09 (emphasis in original).

## JUDGES DISCUSS JURY INSTRUCTIONS, THE PATENT PILOT PROJECT, AND SETTLEMENT AND DISCOVERY AT THE EIGHTH ANNUAL JUDITH KEEP SEMINAR

BY JENNIFER MCCOLLOUGH, 3L  
THOMAS JEFFERSON SCHOOL OF LAW

The Eighth Annual Judith N. Keep Federal Civil Practice Seminar was held on September 13, 2012 in the Jury Lounge of the U.S. District Courthouse. Presented by the U.S. District Court and the San Diego Chapter of the Federal Bar Association, the annual seminar is dedicated to the memory of District Judge Judith N. Keep, who served as a United States District Judge in the Southern District for California for over 20 years, and as the District's first female chief judge from 1991 to 1998. This year's seminar attracted a record crowd of approximately 275 attendees.

Katie Parker, San Diego Chapter President, welcomed the group and gave a tribute to District Judge Rudi M. Brewster, one of the "greats" of the San Diego legal community, who had passed away shortly before the Seminar. Judge Brewster was an avid advocate for the construction of the new federal courthouse annex, and spoke at the inaugural Keep Seminar in 2005. He will be missed by all.

Following a moment of silence for Judge Brewster, a tribute video to Judge Keep was shown. This year's video included memories and stories from Superior Court Judge (ret.) Patricia Cowett, California Appellate Justice Judith McConnell, U.S. District Judge Jeffrey Miller, U.S. Magistrate Judge (ret.) Louisa Porter, and Ninth Circuit Judge

Mary Schroeder. For those who had the privilege of knowing and practicing before Judge Keep, the video was a reminder and fitting tribute to her lasting influence on the San Diego legal community.

Prior to the program, Chief Judge Barry Ted Moskowitz remarked that the Keep Seminar is the flagship event for the San Diego Chapter, and opined that there is no event like it. Judge Moskowitz



Judges Huff, Gonzalez, Sabraw, and Benitez discuss the first year of the Southern District of California's participation in the Patent Pilot Project

also thanked District Judge Anthony Battaglia for again spearheading this year's program. The substance of the seminar then began, and included three panel discussions and an update from the Clerk of Court regarding the new Courthouse Annex.

The first panel, moderated by Magistrate Judge Jan Adler, focused on Jury Instructions and the intricacies of FRCP 51 and local rule 51.5. Joining Judge Adler as panelists were Chief Judge Moskowitz

and District Judges Jeffrey Miller, Thomas Whelan, and Anthony Battaglia. The judges discussed their varying preferences regarding the timing of jury instruction submission, and the difficulties involved in settling jury instructions. The panel also discussed sources to use when drafting jury instructions. Discussing his time working on the Ninth Circuit Jury Instruction Committee, Judge Miller indicated that it is one of the hardest working committees in the Circuit, constantly

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## U.S. MAGISTRATE JUDGE DAVID H. BARTICK – “FROM LITIGATOR TO FACILITATOR”

ROSA CATANIA, SPECIAL ASSISTANT U.S. ATTORNEY

After an impressive 26-year career as a prominent criminal defense attorney, David H. Bartick took the bench as a United States Magistrate Judge in the Southern District of California in April of 2012. Judge Bartick has aptly characterized this transition in his career as moving “from litigator to facilitator.” He is excited by the opportunity to serve the legal community that has served him so well for the last three decades. In doing so, Judge Bartick is quickly adjusting to his new role in and out of the courtroom and truly relishing the opportunity.

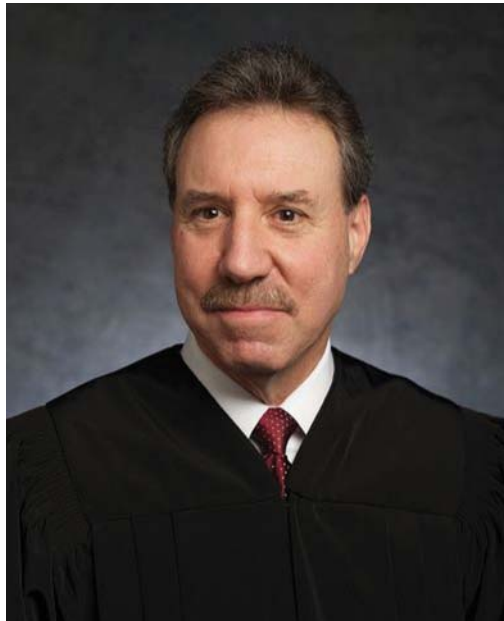
As a criminal defense attorney, Judge Bartick litigated some of the most complex and serious cases prosecuted in the United States. His vast trial experience includes cases such as “Operation Casablanca,” the largest money laundering case ever prosecuted in the United States, “The A’s Bandit,” the largest bank robbery case ever prosecuted in the Southern District of California, and the “Russian Boat Case,” in which Judge Bartick’s client was ultimately acquitted in the largest maritime drug seizure case in the United States.

In addition, Judge Bartick litigated multiple death penalty cases, including a high profile DNA murder case which received international recognition and was featured on ABC television’s “20/20,” and in the crime novel, *True Story of Murder and DNA, Pointing From the Grave*, by Samantha Weinberg. Judge Bartick also represented notorious cartel leader Francisco Arellano Felix in one of the first federal death penalty prosecutions in the Southern District of California.

While many of Judge Bartick’s cases as a defense lawyer were high-profile, the cases that had the most impact on him were not those which garnered the media’s attention. Rather, he reflects most fondly on the numerous, less infamous cases that reinforced his faith in the justice system and, in doing so, renewed his appreciation for the law. For example, Judge Bartick warmly recalls a mistaken identity case in state court years ago in which the prosecutor withdrew all charges against his client on the eve of trial, realizing that the government had charged the wrong man. Another memorable case involved a defendant in a murder trial whose son lived across the country in Chicago and was suffering with a degenerative disease. Judge Bartick recalls working closely with the Court to help his client get to Chicago to visit his ailing son. These cases, along with countless others, remain fresh in Judge Bartick’s memory because they are illustrative of a court system that is not only fair and just, but also one that can truly help people.

It is that same appreciation and faith in the justice system that led Judge Bartick to take the next step in his career and become a U.S. Magistrate Judge.

One might think that the transition from a criminal litigator to a U.S. Magistrate Judge—with more than 250 civil cases to manage—would be an onerous one. Judge Bartick, however, welcomes the challenge. He admits that the learning curve is steep, and that he is “working harder than ever” to get up to speed on all of the cases he inherited. In his days as a trial lawyer, he became skilled at jumping head-first into a case, and enjoyed fully immersing himself in a new area of the law. That skill, coupled with his desire to fully invest himself in his cases has lent itself well to tackling his new case load. Judge Bartick credits his smooth transition to the bench to the hard work and support of his chambers staff, his courtroom deputy, his law clerks, his fellow judges, and to the impressive caliber of civil lawyers who have practiced before him thus far. However, it is evident to those who have had the opportunity to practice before Judge Bartick that his own passion for the law, diligent work ethic, communication skills, and hands-on approach have also surely contributed to his successes as a member of the judiciary thus far.



Judge Bartick

It should also be noted that the role of judge was not a completely foreign concept for Judge Bartick when he took the bench in April. He gained valuable judicial and elective service experience while serving as a pro tem judge with the San Diego Superior Court for more than fifteen years, and as a Presiding Arbitrator for the San Diego County Bar Association for thirteen years. He credits both of those experiences with preparing him for success in his new position.

Judge Bartick’s philosophy as a Magistrate Judge is simple: it’s all about accessibility and facilitation. He believes the Court is in a unique position to serve the legal community by being accessible and taking an active role in facilitating the resolution

of cases. To meet that end, Judge Bartick takes a hands-on approach in the management of his cases. He views his role as that of a facilitator who assists parties in working towards a resolution of their case by making himself readily available to counsel as needed. Along those lines, Judge Bartick points to settlement conferences as the highlight of his new position thus far. He appreciates the opportunity as a Magistrate Judge to work directly with the parties, drawing upon his past experiences to assist and encourage conflict resolution.

Judge Bartick’s legal career has been defined by his hard work, his passion for the law and his appreciation for the judicial system. After leaving a lasting legacy as one of the our community’s most successful criminal defense attorneys, Judge Bartick is energized in his new role as a facilitator, a role in which he will surely continue to have a positive effect on the legal community. Welcome to the bench, Judge Bartick.



## MEET THE HONORABLE CATHY ANN BENCIVENGO, U.S. DISTRICT JUDGE

OLGA MAY, FISH & RICHARDSON P.C.

Judge Bencivengo has spent her entire legal career in the San Diego legal community. She started out as a summer associate at what was then known as Gray, Cary, Ames & Frye and after graduation, joined the firm as a litigation associate. She spent the first two years developing experience in civil litigation ranging from environmental torts to business disputes. When the firm formed its intellectual property group, then an area of law just gaining popularity, she was one of the first attorneys to join it. During the next 15 years, she became a leader in that practice area, representing technology companies in patent litigation and such clients as Dr. Seuss Enterprises in copyright cases.

She was one of the few female attorneys in the field. (When an attorney joining Gray Cary from another firm, who had never met Cathy Bencivengo, was advised to get her insight on a patent case, he spent several hours trying to track down a guy named “Ben Shivengo.”)

Quickly rising through the ranks, she became the National Co-Chair of the Patent Litigation Group at what eventually became DLA Piper Rudnick Gray Cary LLP.

Judge Bencivengo first joined the Southern District federal bench in 2005 as a magistrate judge (when the court security at the entrance innocently inquired of the fresh-faced newcomer if she was a new law clerk). Seventeen years of civil law practice had her well prepared for the civil side of her new job: case management, discovery disputes, and settlement conferences. It did not take her long to master the steep learning curve on the criminal side, either.

Judge Bencivengo’s energy, intellectual curiosity, and passionate interest in her job and the people around her immediately made her one of the most active participants in the District’s activities. She became an active part of the magistrate bench, joined the Southern District’s Patent Advisory Committee which had promulgated the Local Patent Rules, and, of course, started going to the courthouse yoga classes.

Judge Bencivengo’s genuine interest and investment in her work were instantly obvious to everyone around her. She studied every case, pored over the best and fairest solution, and was infinitely patient when untangling discovery disputes and maneuvering a case through the maze of legal, business, and personal obstacles to settlement. This was no easy task, considering that, as a part of her initial caseload, she inherited several large and complex cases several years into litigation. As a result, for the toughest cases, she did whatever it took to resolve

the dispute: stayed with the parties long past the office hours to hammer out a deal, drove to a site inspection out in the county at the crack of dawn, and, sometimes, brought coffee and doughnuts to ease the dialogue.

Having left her magistrate judge position, Judge Bencivengo still misses contact with the parties, a chance to be more personally involved in the case, and the camaraderie of the close-knit magistrate judges’ bench. But she is enjoying the new challenges of her present position.

Since her swearing-in in February 2012, she has already had eight civil trials with more scheduled, and has ruled on countless motions. Her cumulative private practice and judicial experience has led her to adopt a few guidelines and recognize certain things as priority. As her district judge tenure continues, she may come to modify these or adopt new ones.

Overall, Judge Bencivengo expects counsel to be professional, prepared, and courteous. In her courtroom, there is little place for “gotcha litigation”—she does not believe it serves the best interest of the parties or the court. She much prefers the parties focus on the merits, prepare their case, and lay it out with support in the briefing or present well at trial. Courtesy, both to the opposing counsel and to the court and her staff, is expected at all times.

For civil motions, mindful of the counsel’s desire to present their case but also of the limitations on her calendar, she will generally hold oral argument for a claim-dispositive motion, such as for summary judgment, but typically not for a motion to dismiss, unless it may be granted with prejudice. Counsel will be notified of whether an oral argument will be held by an advance minute order.

Judge Bencivengo’s background has always made for an interesting mix of curios in her office: against the usual backdrop of the Federal Reporter volumes, she had early patents hanging on her walls, Dr. Seuss characters sitting on the shelves, and, last but not least—a picture of Rosie the Riveter with the “We can do it!” daily reminder. It is this “we can do it” attitude that makes Judge Bencivengo’s elevation to a district judge no surprise and a particular inspiration to every female lawyer.



Judge Bencivengo

## CHIEF JUDGE MOSKOWITZ DISCUSSES THE STATE OF THE DISTRICT

Federal judges and practitioners gathered for the annual State of the District luncheon on Wednesday, November 14 at the Westin Gaslamp Quarter. Attendees included keynote speaker Chief Judge Barry Ted Moskowitz, Presiding U.S. Magistrate Judge Nita L. Stormes, Chief U.S. Bankruptcy Judge Laura Taylor, Clerk of Court Sam Hamrick, U.S. Attorney Laura Duffy, and Shereen Charlick representing Federal Defenders of San Diego. Also in attendance was Superior Court Judge David M. Gill, who was honored with a plaque commemorating his 50 years of membership in the San Diego Chapter of the Federal Bar Association.



**District Judges Michael Anello, Janis Sammartino, and William Enright**

Chief Judge Moskowitz, who assumed the Chief Judgeship in January 2012, presented his first State of the District address during the luncheon. Judge Moskowitz acknowledged the numerous changes in the San Diego federal judiciary during 2012, including the unfortunate passing in September of Senior Judge Rudi M. Brewster, whose contributions to the Court and the San Diego community were immeasurable. Judge Moskowitz also welcomed new U.S. District Judges Cathy Ann Bencivengo and Gonzalo Curiel, new U.S. Magistrate Judges Karen Crawford and David Bartick, and new U.S. Bankruptcy Judge Christopher Latham. As Judge Moskowitz noted, there are no judicial vacancies in the Southern District, and the Court is currently “playing with a full deck.”

Judge Moskowitz then discussed the new United States Courthouse Annex, the planning for which has been underway for approximately 20 years. Judge Moskowitz discussed the logistical changes that will come with the Court being spread over two buildings rather than one, including that the entrance to the existing Schwartz courthouse will

move to the west side of that building, and that the Magistrate Judges with chambers in 101 W. Broadway will move to the new building.

Judge Moskowitz also explained the conditions imposed by GSA that led to the Court ultimately seeing a reduction, rather than increase, in its number of total courtrooms.

Addressing a topic of substantial current public concern, Judge Moskowitz discussed the dramatic automatic federal spending cuts set to occur on January 1, 2013. Judge Moskowitz expressed his personal belief that these cuts, if not averted, would drive the nation into another recession and possibly a depression, and that it is highly

unlikely Congress would allow this to happen. He stated therefore that the Court is not devoting undue time and effort to planning for the fiscal cliff. He did state however, his emphatic intention to keep the Southern District up and running even should court funding be slashed, citing the court’s obligation to serve the legal community. While many chief judges have announced that courts will close should the fiscal cliff become a reality, Judge Moskowitz will hold court, even if it means taking notes himself should the funding for court reporters be unavailable.



**Chief Judge Barry Ted Moskowitz addresses State of the District attendees**



**Cynthia Cwik, Bob Brewer, Elizabeth Smith-Chavez, and William Kammer**

Even with the many changes underway in the Southern District, the Court energetically partnered with the FBA to put on numerous educational events this year, and Judge Moskowitz highlighted some of those during his address, including the January Passing of the Gavel Ceremony, the Introduction to Federal Court seminar featuring James Wagstaffe in July, Erwin Chemerinsky’s Supreme Court review, and the Eighth Annual Judith N. Keep Civil Practice Seminar.

Chief Judge Moskowitz concluded his address by announcing that the State of the District is “good.” Indeed it is, in no small part due to the exceptional leadership of Chief Judge Moskowitz, his predecessors as chief judge, and all of their colleagues.



## PRESIDENT'S MESSAGE: 2012 IN REVIEW

By **KATIE PARKER**  
2012 PRESIDENT, SAN DIEGO CHAPTER

2012 is quickly drawing to a close, and it has been a whirlwind year for the San Diego FBA. Our chapter began the year by assisting the Court in preparing the January 26, 2012 Passing of the Gavel Ceremony, which included a historical overview of the role of chief judge in the Southern District. Our Chapter was fortunate to have Judge Gonzalez's support over her seven years as chief judge, and Judge Moskowitz has continued this partnership between the District Court and the FBA. It has been my privilege to work with Judge Moskowitz during his first year as Chief Judge, and the FBA and the court partnered on numerous CLE events this year.

Several judges joined the Court in 2012. Judge Cathy Ann Bencivengo, who had been a Magistrate Judge in this District since 2005, was confirmed by the Senate as a U.S. District Judge. We hosted a brown bag discussion with Judge Bencivengo in her courtroom in March. Judge Karen Crawford and Judge David Bartick joined the Court as U.S. Magistrate Judges earlier this year, and our chapter hosted a brown bag discussion with them in June. This fall, Gonzalo Curiel was confirmed to a seat on the District Court, and Christopher Latham, who had been a member of our Chapter's Advisory Board, became a U.S. Bankruptcy Judge. We look forward to hosting CLE events with them in the future.

In July, we partnered with the District Court to sponsor a new CLE program, an "Introduction to Federal Court" seminar aimed at recently admitted attorneys. This seminar opened with a humorous and educational presentation by James Wagstaffe on federal jurisdiction and venue. Magistrate Judges Stormes, Dembin, and Bartick then discussed Early Neutral Evaluations, settlement

conferences, and discovery disputes. The seminar concluded with a discussion by District Judges Moskowitz, Huff, and Battaglia on motion practice and oral argument. Over one hundred attorneys attended, and we look forward to continuing this seminar as an annual event. In August, our chapter hosted Dean Erwin Chemerinsky of the UC Irvine School of Law, who presented a review and discussion of the key criminal law decisions from the Supreme Court's 2011-12 term.

September was another busy month for our chapter. The Eighth Annual Judith N. Keep Federal Civil Practice Seminar attracted a record audience of 275 people. The following week, the Federal Bar Association National Annual Meeting and Convention took place here in San Diego after over two years of planning. Both events are discussed in more detail elsewhere in this newsletter.

Our chapter also hosted or co-hosted CLE seminars focused on the ethics of social networking, bankruptcy, arbitration law, patent infringement damages, and immigration practice in 2012. Our chapter is looking forward to another busy year in 2013. Hugh Kim of Wilson Turner Kosmo will be our Chapter President and he has a number of excellent events in the works. Starting in February, we will present a four-part series on Disclosure and Discovery in the Southern District. This series was quite successful in 2011, and we look forward to presenting it with a new group of speakers in 2013. Our goal is to provide CLE that is timely and relevant to your federal practice. If there are specific topics or speakers you would like us to present in the coming year, please don't hesitate to reach out and provide us with your suggestions.

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The First Restatement of Torts, which was in effect at the time the 1952 Patent Act was enacted, draws an even sharper line than the Second Restatement between vicarious liability for tortious conduct and liability for inducing tortious conduct by others . . . . It states that a person is liable if he “orders or induces [tortious] conduct, knowing of the conditions under which the act is done or intending the consequences which ensue,” or if he “knows that the other’s conduct constitutes a breach of duty and gives substantial assistance or encouragement to the other so to conduct himself.”<sup>8</sup>

Accordingly, the court concluded that in patent law, liability for inducement of divided infringement under § 271(b) requires that all steps of the patented method claim be performed, and that the inducer “act with knowledge that the induced acts constitute patent infringement”; but not that the steps be performed by a single entity, or by entities with any particular agency or control relationship with the inducer.<sup>9</sup>

#### **IMPLICATIONS OF AKAMAI AND MCKESSON**

The *Akamai/McKesson* decision strengthens method claims, because parties can no longer escape liability under § 271(b) by simply coordinating a division of the steps of the method. Under *BMC Resources* and *Muniauction*, this was not patent infringement as long as all parties involved disclaimed control or direction over the others – even if the parties’ intent to circumvent liability was clear. But after *Akamai/McKesson*, it suffices for liability that one or more inducing parties act with knowledge that their combined acts would constitute patent infringement.

But it’s not clear whether the *Akamai/McKesson* opinion closed a loophole, or simply rewarded inartfully drafted patent claims with expanded scope. If some method claims are rendered vulnerable to divided infringement, is that a structural flaw of the patent system? Or is it just a failure of patentees to describe their inventions in “full, clear, concise, and exact terms”?<sup>10</sup> As the Federal Circuit had noted in *BMC Resources*, if divided infringement is a problem, the prudent patent drafter may be in the best position to address it:

The concerns over a party avoiding infringement by arms-length cooperation can usually be offset by proper claim drafting. A patentee can usually structure a claim to capture infringement by a single party. See Mark A. Lemley et al., *Divided Infringement Claims*, 33 AIPLA Q.J. 255, 272-75 (2005). In this case, for example, BMC could have drafted its claims to focus on one entity. The steps of the claim might have featured references to a single party’s supplying or receiving each element of the claimed process. However, BMC chose instead to have four different parties perform different acts within one claim. BMC correctly notes the difficulty of proving infringement of this claim format. Nonetheless, this court will not unilaterally restructure the claim or the standards for joint infringement to remedy these ill-conceived claims. See *Sage Prods. Inc. v. Devon Indus. Inc.*, 126 F.3d 1420, 1425 (Fed. Cir. 1997) (“[A]s between the patentee who had a clear opportunity to negotiate broader claims but did not do so, and the public at large, it is the patentee who must bear the cost of its failure to seek protection for this foreseeable alteration of its claimed structure.”)<sup>11</sup>

If the unenforceability of the claims at issue in *Akamai/McKesson* can be attributed to drafting error, then *Akamai/McKesson* represents a departure from previous decisions where the Federal Circuit, as noted above in *BMC Resources*, has refused to save the patentee from its own mistakes. For example, in *Chef Am., Inc. v. Lamb-Weston, Inc.*, an unfortunate patent claiming a method of cooking dough recited heating the dough “to a temperature in the range of about 400° F. to 850° F.” —a step that would result in the dough being burned “to a crisp.”<sup>12</sup> The Federal Circuit acknowledged that the patent was effectively worthless, but nonetheless refused to rewrite the claim to read “at” a temperature, rather than “to” a temperature: “[t]his court . . . repeatedly and consistently has recognized that courts may not redraft claims, whether to make them operable or to sustain their validity.”<sup>13</sup> While the court in *Akamai/McKesson* did not engage in “redrafting” claims that might have been more carefully written, it did change the rules to make them operable.

And so *Akamai/McKesson* creates a perverse incentive for patent drafters: draft method claims to be ambiguous as to which parties perform which steps of the method. If the patentee’s end of the patent bargain is to clearly identify the scope of patented technology, and to teach the public how to practice it, rewarding ambiguity in patent claim language arguably encourages patentees to cheat the system. Of course, the possibility of Supreme Court review of *Akamai/McKesson* remains, particularly given the narrow 6-5 ruling of the Federal Circuit, and forceful dissents by Judges Linn and Newman. While patent holders might celebrate the Federal Circuit’s recent enlargement of their property rights, all are advised to let the dust settle on divided infringement before betting on patents that invite a group performance.

Congratulations to District Judge Gonzalo Curiel and Bankruptcy Judge Christopher Latham on their recent confirmations. Please look for profiles of these Judges in the next issue.

### **WELCOME NEW MEMBERS TO THE SAN DIEGO CHAPTER OF THE FEDERAL BAR ASSOCIATION**

Nicole Baldwin	Martha Knutson
Katherine DiDonato	Ronald Lenert
Gary Eastman	James Leonard
David Finn	Lauren Rinsky
Joshua Goodrich	Edward Vogel
Rebecca Kanter	Jeremy Warren
David Knudson	Shirli Weiss

8 *Id.* at 1312-13.

9 *Id.* at 1308.

10 35 U.S.C. § 112(a).

11 *BMC Resources*, 498 F.3d at 1381.

12 *Chef Am., Inc. v. Lamb-Weston, Inc.*, 358 F.3d 1371, 1373 (Fed. Cir. 2004).

13 *Id.* at 1374.

*The Eight Annual Judith Keep Seminar  
(continued from page 3)*

striving to reflect the latest changes in substantive law. Since they are constantly updated, Judge Miller indicated that they should be used and augmented as necessary. The panel also discussed special verdict forms, and Judge Battaglia recommended asking a spouse or significant other to read over them to ensure they work after taking the time to go through the questions carefully.

The second substantive panel addressed the first year of the “Patent Pilot Project” in the Southern District. District Judge Cathy Ann Bencivengo moderated this panel, which included all of the District’s Pilot Project Judges: Judges Marilyn Huff, Irma Gonzalez, Dana Sabraw, Roger Benitez, and Janis Sammartino. The



**Judges Crawford and Bartick participate in their first Keep Seminar, discussing settlement and discovery in the Southern District**

goal of the Patent Pilot Project is to reduce the nation’s ever-growing backlog of intellectual property cases, which can be notoriously technical and time-consuming. The Patent Pilot Program was implemented in the Southern District on September 19, 2011. Every case filed in the District is still randomly issued to a judge, however, judges not participating in the Program may transfer a patent case to a separate “patent deck” within 28 days.

The judges noted that between September 2010 and September 2011, 81 patent cases were filed in the Southern District. In the year following implementation, the number of patent cases filed was 130, a 60.5 percent increase. Generally, patent cases make up five percent of a judge’s docket, but for pilot project judges, patent cases are ten percent of their docket.

The Patent Pilot Project Judges discussed in detail proposed changes to the Southern District’s Patent Local Rules. Since the Seminar, these changes have now been circulated for public comment, and will become effective in February 2013. The proposed changes can

be found in General Order # 621 on the Southern District’s website, and the public comment period runs through January 18, 2013. These

changes include modifications to the ENE requirements, case deadlines, and the joint claim construction chart, as well as adoption of a model protective order and model ESI order.

Following the patent pilot project discussion, Clerk of Court W. Samuel Hamrick, Jr. provided an update regarding

the new federal courthouse annex. Since the seminar, judges have begun moving into the new building. Updates regarding the locations of all of the judges can be found on the Southern District’s website, [www.casd.uscourts.gov](http://www.casd.uscourts.gov).

The Seminar’s final panel was a lively discussion of settlement and discovery in the Southern District, moderated by Presiding Magistrate Judge Nita L. Stormes, and featuring Magistrate Judges David Bartick, Karen Crawford, Mitchell Dembin, and William Gallo. This panel provided an opportunity for attendees to learn more about the District’s newest Magistrate Judges; for all but Judge Stormes, this was their first appearance as a Keep Seminar panelist. Judge Bartick came to the bench following a career as a criminal defense attorney in the federal and state courts. Judge Crawford had focused on civil litigation, spending time at the U.S. Attorney’s Office Civil Division, and law firm Duane Morris before joining the bench. Judge Dembin spent time as a federal prosecutor and working in private industry before becoming a Magistrate Judge. Judge Gallo had served in the U.S. Marines and as a federal prosecutor before his appointment to the bench in 2009. The judges discussed best practices and their chambers preferences for settlement conferences, ENEs, and discovery disputes.

The seminar concluded with a reception and an opportunity for speakers and attendees to socialize and discuss the many topics addressed. The FBA looks forward to hosting the Ninth Annual Judith N. Keep Seminar during the afternoon of September 12, 2013.



**Chief Judge Moskowitz, Judge Miller, Judge Whelan, and Judge Battaglia present the panel in Instructing the Jury, moderated by Judge Adler**



**Chief Judge Moskowitz welcomes attendees to the Eighth Annual Judith N. Keep Federal Civil Practice Seminar**

**UPCOMING FEDERAL BAR  
ASSOCIATION –  
SAN DIEGO CHAPTER EVENTS**

- **ESI Forum on Fundamentals of Forensics for eDiscovery,  
January 10, 2013, 12:00-1:00 p.m.,  
U.S. District Court, Courtroom 1**
- **Brown Bag with Judge Gonzalez,  
January 30, 2013, 12:00-1:00 p.m.,  
U.S. District Court, Courtroom 1**
- **Disclosure and Discovery Series  
U.S. District Court, Courtroom 1**
  - **Session 1: Getting your Case Started:  
Rules 16 and 26  
February 13, 2013, 12:00-1:30 PM**
  - **Session 2: Written Discovery,  
March 13, 2013, 12:00-1:30 PM**
  - **Session 3: Deposition Practice,  
April 17, 2013, 12:00-1:30 PM**
  - **Session 4: Working with Expert Witnesses,  
May 15, 2013, 12:00-1:30 PM**

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