

# 15<sup>th</sup> Annual Advanced Patent Law Institute

## March 12-13, 2020 • United States Patent and Trademark Office • Alexandria, VA

### Thursday Morning, Mar. 12, 2020

#### Presiding Officer:

**William LaMarca**, U.S. Patent and Trademark Office, Office of the Solicitor - Alexandria, VA

7:30 am	<b>Registration Opens</b>  Includes continental breakfast.
8:20 am	<b>Welcoming Remarks</b>
8:30 am 1.00 hr	<b>Global Enforcement Trends</b>  Patent enforcement is often global in two or more jurisdictions requiring a deep understanding of the laws and practices of each jurisdiction, competent counsel in each jurisdiction, and on-going close cooperation between the litigation teams in each jurisdiction. This panel focuses on effective patent litigation in the largest economies after the USA - China, Japan, Germany, and the UK.  Moderator: Robert Greene Sterne, Sterne, Kessler, Goldstein & Fox P.L.L.C. - Washington, DC Panelists: Atsushi Sato, TMI Associates - San Mateo, CA Tobias Wuttke, Meissner Bolte - Munich, Germany James Zhu, JunHe LLP - Shanghai, China
9:30 am 0.75 hr	<b>Preparing High Quality Patent Applications</b>  From biotech to computer software, gain insight on preparing high quality patent applications that are enforceable. Explore the challenges pertaining to patent eligibility, written description, and enablement from drafting through enforcement.  Bradley Forrest, Schwegman Lundberg & Woessner - Minneapolis, MN Daniel J. Pereira, Oblon, McClelland, Maier & Neustadt, L.L.P. - Alexandria, VA
10:15 am	<b>Break</b>
10:30 am 1.25 hrs	<b>Section 101: High Tech v. Life Sciences</b>  The U.S. patent statutes apply equally to all patent applications, but the application of the patent eligibility requirement of Section 101 varies across technologies. Discuss, compare and contrast eligible and non-eligible claims in different fields, review the current examination guidance, and hear an update on legislative reform efforts.  Moderator: Stephen G. Kunin, Maier & Maier PLLC - Alexandria, VA Panelists: Courtenay C. Brinckerhoff, Foley & Lardner LLP - Washington, DC June Cohan, U.S. Patent and Trademark Office - Alexandria, VA Dale S. Lazar, DLA Piper LLP US - Reston, VA

11:45 am 0.75 hr	<b>Section 101 Issues in Patent Litigation</b>  In many contexts “101” is used to mean something basic and easily understandable, but recently Section 101 of the Patent Act has been anything but. Explore the myriad of issues that patentable subject matter uncertainty has caused in patent litigation, touch on lessons learned, and explore what developments may be on the horizon.  James M. Heintz, DLA Piper LLP US - Reston, VA Matthew J. Rizzolo, Ropes & Gray LLP - Washington, DC
12:30 pm	<b>Pick Up Lunch</b>  Included in registration.

## Thursday Afternoon, Mar. 12, 2020

### Presiding Officer:

**J. Devlin Hartline**, Antonin Scalia Law School, George Mason University - Arlington, VA

### KEYNOTE LUNCHEON PRESENTATION

12:50 pm 0.50 hr	<b>Update from the USPTO</b>  Hear about the current priorities, programs, and initiatives underway at the Office.  Andrei Iancu, Under Secretary of Commerce for Intellectual Property and Director, U.S. Patent and Trademark Office - Alexandria, VA
1:20 pm	<b>Break</b>
1:35 pm 1.00 hr ethics	<b>Ethics Issues Facing USPTO Practitioners: A View from the Inside</b>  Focus on the ethics rules issued by the USPTO in 2013 and how they are applied and enforced by today’s Office of Enrollment and Discipline. New developments will be discussed, including current cases and the new Diversion Program.  Dahlia George, U.S. Patent and Trademark Office, Office of Enrollment and Discipline - Alexandria, VA Bernie Knight, BK Consulting - Washington, DC
2:35 pm 1.00 hr	<b>Potpourri of Hot Design Patent Issues: Practical Implications</b>  Gain insight on maximizing total profit damages in spite of <i>Samsung v. Apple</i> ; using single-view drawings; choosing a good title for your application; countering aesthetic functionality and patent exhaustion defenses when asserting spare parts infringement; and praying that reason prevails in Section 103 analysis after federal circuit kicks the can down the road.  Perry Saidman, Saidman DesignLaw Group, LLC - Silver Spring, MD
3:35 pm	<b>Break</b>

3:45 pm 0.75 hr	<p><b>SEPs and FRAND</b></p> <p>Discuss recent developments related to standard essential patents, including cutting edge technologies, fair reasonable and non-discriminatory licensing issues, and an overview of government agency views.</p> <p>Moderator: Christian Hannon, U.S. Patent and Trademark Office - Alexandria, VA</p> <p>Panelists: T. Andrew Culbert, Perkins Coie LLP - Seattle, WA Isabella Fu, Microsoft Corporation - Redmond, WA</p>
4:30 pm 1.00 hr	<p><b>Judicial Panel</b></p> <p>Distinguished judges discuss their experiences hearing and trying patent cases.</p> <p>Moderator: William LaMarca, U.S. Patent and Trademark Office, Office of the Solicitor - Alexandria, VA</p> <p>Panelists: Hon. Liam O'Grady, U.S. District Court, Eastern District of Virginia - Alexandria, VA Hon. Leonard P. Stark, U.S. District Court, District of Delaware - Wilmington, DE</p>
5:30 pm	<p><b>Adjourn</b></p>

## Friday Morning, Mar. 13, 2020

### Presiding Officer:

**Stephen G. Kunin**, Maier & Maier PLLC - Alexandria, VA

8:00 am	<p><b>Conference Room Opens</b></p> <p>Includes continental breakfast.</p>
8:30 am 0.75 hr	<p><b>On Sale Bar / Impact of Helsinn - 102 Nuts and Bolts</b></p> <p>Gain insight on the <i>Helsinn Healthcare S.A. v. Teva Pharmaceuticals USA, Inc.</i> on-sale bar decision and interpretation under the AIA, along with a nuts and bolts look at the resulting practical implications for patent application timing and supply agreement structuring considerations.</p> <p>William LaMarca, U.S. Patent and Trademark Office, Office of the Solicitor - Alexandria, VA Jeffrey A. Wolfson, Haynes and Boone, LLP - Washington, DC</p>
9:15 am 0.50 hr	<p><b>Obviousness-Type Double Patenting Issues: Best Practices and Current Trends</b></p> <p>Understand issues and evolving case law relating to double patenting, as well as best practices for addressing double patenting rejections during examination, and pitfalls to avoid. Discuss the impact of double patenting on Patent Term Extension under 35 USC §156, portfolio management, validity, and enforcement after grant.</p> <p>Whitney Remily, Birch Stewart Kolasch &amp; Birch, LLP - Falls Church, VA</p>

9:45 am 0.50 hr	<p><b>After Final Rejection Practice</b></p> <p>Understand the various available options to reply to a final office action from the USPTO as well as their advantages and disadvantages and chances of success. Topics include QPIDS, pre-appeal brief program, AFCP2.0, as well as amendments, affidavits under rule 41.33.</p> <p>Kery Fries, U.S. Patent and Trademark Office - Alexandria, VA</p>
10:15 am	<b>Break</b>
10:30 am 0.50 hr	<p><b>PTAB Update</b></p> <p>Hear an update on PTAB appeals and trial proceedings.</p> <p>Hon. Jacqueline Bonilla, U.S. Patent and Trademark Office, Patent Trial and Appeal Board - Alexandria, VA</p>
11:00 am 1.00 hr	<p><b>Recent Developments in Practice Before the Patent Trial and Appeal Board (PTAB)</b></p> <p>Discuss new developments impacting practice before the Board, including evolving standards on discretionary institution based on prior petitions for review and/or developments in other forums; increasing guidance from the Board in the form of precedential and/or informative decisions and updates to the Trial Practice Guide; the new pilot program on motions to amend that provides earlier feedback to the parties; the impact of Federal Circuit precedent on PTAB practice; and other topics of interest.</p> <p>Moderator: Teresa Stanek Rea, Crowell &amp; Moring, LLP - Washington, DC</p> <p>Panelists: Jonathan Bowser, Haynes and Boone, LLP - Washington, DC Hon. Kalyan Deshpande, U.S. Patent and Trademark Office, Patent Trial and Appeal Board - Alexandria, VA Jessica L.A. Marks, Unified Patents, LLC - Washington, DC Angela Oliver, Haynes and Boone, LLP - Washington, DC Hon. Michael Tierney, U.S. Patent and Trademark Office, Patent Trial and Appeal Board - Alexandria, VA</p>
12:00 pm 0.50 hr	<p><b>Section 101 Challenges in AIA Trials at the PTAB</b></p> <p>Gain insight on strategic use of AIA trials (CBM, PGR, IPRs) to raise Section 101 issues; raising Section 101 issues in connection with IPR motions to amend and claim construction; and implications of 2019 Patent Eligibility Guidance on PTAB.</p> <p>Andrew S. Baluch, Smith Baluch LLP - Washington, DC</p>
12:30 pm	<b>Break for Lunch - Presentations Resume at 1:00 p.m.</b>

## Friday Afternoon, Mar. 13, 2020

### Presiding Officer:

**John W. Ryan**, Owens & Minor - Mechanicsville, VA

### LUNCHEON PRESENTATION

1:00 pm 0.50 hr	<p><b>View from the Federal Circuit</b></p> <p><i><b>This presentation, originally scheduled to be presented by Hon. Kathleen O'Malley, has been CANCELLED.</b></i></p>
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1:00 pm 0.75 hr	<p><b>A Year In Review: Recent Decisions from the Supreme Court and Federal Circuit</b></p> <p>A review of the most important cases from the Federal Circuit and the Supreme Court in the past year that every practitioner should know.</p> <p><i>This presentation was originally scheduled at 1:45 p.m.</i></p> <p>J. Michael Jakes, Finnegan, Henderson, Farabow, Garrett &amp; Dunner, LLP - Washington, DC</p>
1:45 pm 1.00 hr ethics	<p><b>Practical IP Ethics Problems</b></p> <p>Using film, animations, and even clips from a patent lawyer-turned stand-up comic, this session addresses conflicts of interest, competently policing trademark infringement without harming your client's brand, and how to competently and ethically represent clients with IP needs.</p> <p><i>This presentation was originally scheduled at 2:30 p.m.</i></p> <p>David Hricik, Mercer University School of Law - Macon, GA</p>
2:45 pm	<p><b>Adjourn</b></p>