

2005

# ADVANCED PATENT LAW INSTITUTE

*A unique series of presentations by senior USPTO officials,  
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November 17-18, 2005  
USPTO–Main Auditorium  
Alexandria, Virginia

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UNITED STATES PATENT AND TRADEMARK OFFICE

2005

# ADVANCED PATENT LAW INSTITUTE

November 17-18, 2005 • United States Patent and Trademark Office • Alexandria, VA

Earn up to 13.50 Hours of Credit Including 1.25 Hour of Ethics Credit

## THURSDAY MORNING, NOV. 17, 2005

**Presiding Officer: Stephen G. Kunin, Director of JD and LLM Programs in Intellectual Property Law, George Mason University School of Law, Alexandria, VA**

### 8:00 a.m. Registration Opens

Includes continental breakfast.

### 8:45 a.m. Welcoming Remarks

James A. Toupin, Office of the General Counsel, USPTO, Alexandria, VA

### 9:00 a.m. 1.00 hr

#### Effective Patent Prosecution: Critical Choices, Drafting Techniques and Strategies

Patent law has changed drastically over the past ten years. Has your style of application drafting and prosecution? Learn how to optimize protection for your client in today's legal environment.

Dale S. Lazar, DLA Piper Rudnick Gray Cary, Reston, VA

#### INSIDE THE BLACK BOX OF THE USPTO: WHAT'S HAPPENING WITH MY APPLICATION

### 10:00 a.m. .67 hr

#### The Search Process at the USPTO—Discovering Prior Art

How do the USPTO examiners search for prior art; databases and new search tools? What can or should practitioners learn about this process?

Marian C. Knode, Supervisory Patent Examiner, Technology Center 2600, USPTO Alexandria, VA

Commentator: Dale S. Lazar, DLA Piper Rudnick Gray Cary, Reston, VA

### 10:40 a.m. Break

### 11:00 a.m. .50 hr

#### USPTO Communications with Practitioners: Standards of Review, Requests, Responses and Rejections

The panel will focus on the various types of communications prepared by the USPTO, the authority of the individuals signing the communications and how work product is reviewed for quality assurance. The governing rules of practice and examination policies will be discussed as well as how quality reviews are conducted within and outside of the Technology Centers.

Joseph J. Rolla, Jr., Deputy Commissioner for Patent Examination Policy, USPTO Alexandria, VA

Commentator: Dale S. Lazar, DLA Piper Rudnick Gray Cary, Reston, VA

### 11:30 a.m. .33 hr

#### Quality Assurance Processes and Procedures at the USPTO

A discussion of the USPTO's Quality Assurance Program for allowance and in-process reviews, second pair of eyes program and patentability and appeals conferences.

George C. Elliott, Director, Technology Center 1600, USPTO, Alexandria, VA

### 11:50 a.m. .33 hr

#### Concluding Discussion and Q & A

Opportunities for Q & A with a panel of speakers from the morning presentations.

### 12:10 p.m. Lunch on Your Own

## THURSDAY AFTERNOON, NOV. 17, 2005

**Presiding Officer: David L. McCombs, Haynes and Boone, LLP, Dallas, TX**

#### INFRINGEMENT AND LITIGATION ISSUES

### 1:15 p.m. .50 hr ethics

#### Pre-filing Considerations in Patent Cases

An exploration and discussion of pre-filing obligations and standards of inquiry, with particular emphasis on satisfying requirements under Rule 11.

Esther H. Lim, Esq., Partner, Finnegan, Henderson, Farabow, Garrett & Dunner, L.L.P., Washington, DC

### 1:45 p.m. .75 hr ethics

#### Opinion Letters and Scope of Privilege Waivers

Given the "new" role of opinion letters in patent cases after Knorr, how do you assess the risks of waiving the attorney-client privilege by producing the opinion?

Donald C. Templin, Haynes and Boone, LLP, Dallas, TX

### 2:30 p.m. .50 hr

#### Transnational Patent Enforcement: Lessons from *Voda v. Cordis*

Global patent forum shopping to find the best court in Europe or Japan to enforce—or attack—a patent; one stop transnational world patent enforcement.

Harold C. Wegner, Partner, Foley and Lardner LLP, Washington, DC

### 3:00 p.m. .50 hr

#### Litigating Against the USPTO

A view from the Office of the Solicitor on litigation against the USPTO.

John M. Whealan, Deputy General Counsel for Intellectual Property and Solicitor, USPTO, Alexandria, VA

### 3:30 p.m. Break

#### THE INTERSECTION OF ANTITRUST AND PATENT LAW

### 3:45 p.m. .25 hr

#### Overview: Antitrust Meets Patent Law

An overview of the law and economics of the interface between patent and antitrust law.

Bruce H. Kobayashi, George Mason University School of Law, Arlington, VA

### 4:00 p.m. .50 hr

#### The Risk and Rewards of Participating in Standard-Setting Organizations

Standard-setting and patents—where are the lines, where are the landmines? Where are the courts going and how to deal with uncertainty in a changing world.

David J. Healey, Weil, Gotshal & Manges LLP, Houston, TX

### 4:30 p.m. .50 hr

#### Patent Pooling

Patent pools have become a popular way to collect royalties using a company's patents. The lecture will concern how one goes about establishing a patent pool, what type of claims and patents are best suited for patent pools, and what are the dangers to a patent portfolio, which can result from participation in a patent pool.

James Kulbaski, Oblon, Spivak, McClelland, Maier & Nuestadt, Alexandria, VA

### 5:00 p.m. .50 hr

#### Practical Antitrust Involving Patents: Inequitable Conduct and Licensing Agreements (*Illinois Toolworks Case*)

A practical discussion of current patent/antitrust issues, including the Federal Circuit's decision in *Illinois Tool Works* and other recent case law.

Christopher J. Renk, Banner & Witcoff, Ltd., Chicago, IL

### 5:30 p.m. Adjourn

**FRIDAY MORNING, NOV. 18, 2005**

**Presiding Officer:**

**Hon. Roderick R. McKelvie, Washington, DC**

**REMEDIES AND FORUMS**

**8:30 a.m. .75 hr**

**Making Effective Use of the BPAI Appeals Process**

Practice before the Board of Patent Appeals and Interferences has undergone not only procedural change but substantive change as well. The Patent and Trademark Office has recently issued new rules of practice that have changed the practice before the Board. Also, the U.S. Court of Appeals for the Federal Circuit has provided many important rulings on issues of Board practice, claim interpretation and deference to Board's fact findings that have impacted practice before the Board. Practitioners who are unaware of these changes might find themselves at a disadvantage. Administrative Patent Judge Michael R. Fleming and Andrew J. Dillon will discuss these changes from the viewpoints of the Board and of the practitioner and give pointers to avoid common pitfalls.

Andrew J. Dillon, Managing Partner, Dillon & Yudell LLP, Austin, TX

Hon. Michael R. Fleming, Board of Patent Appeals and Interferences, USPTO, Alexandria, VA

**9:15 a.m. .50 hr**

**Patent Lemmings: Forum Shopping**

This session discusses variations among the district courts in how they resolve patent cases procedurally and substantively. Where are you most likely to survive summary judgment and get to trial? Which district has the highest patent holder win rate? Where do most plaintiffs file?

Kimberly A. Moore, George Mason University School of Law, Arlington, VA

**9:45 a.m. Break**

**10:00 a.m. .25 hr**

**Overview—Relationships between Forums and Remedies**

Selecting a forum: What are the limitations on and advantages of seeking relief in the ITC, The Court of Claims, or a District Court?

Hon. Roderick R. McKelvie, Partner, Covington & Burling, Washington, DC

**10:15 a.m. .75 hr**

**Section 337: A Mid-Twentieth Century Remedy for a Twenty-First Century Problem**

Section 337 of the Smoot-Hawley Tariff Act of 1930, revived as a contributor to the Great Depression is, in today's "globalized" economy, a "remedy of choice" to curb infringements of IP rights affecting imports.

Peter D. Ehrenhaft, Miller and Chevalier Chartered, Washington, DC

Hon. Paul J. Luckern, United States International Trade Commission, Washington, DC

**11:00 a.m. .50 hr**

**Options in the Court of Federal Claims**

A discussion of patent litigation in the Court of Federal Claims.

Hon. Loren A. Smith, Senior Judge, United States Court of Federal Claims, Washington, DC

**11:30 a.m. .50 hr**

**Options at the District Court**

A leading Federal District Court Judge discusses effective litigation strategies in the Eastern District of Virginia.

Hon. T.S. Ellis, III, United States District Court, Eastern District of Virginia, Alexandria, VA

**12:00 p.m. Box Lunch Presentation .75 hr**

**Effective Advocacy before the U.S. Court of Appeals for the Federal Circuit**

Hon. Richard Linn, U.S. Court of Appeals for the Federal Circuit, Washington, DC

**Comments and Questions:**

Hon. Roderick R. McKelvie, Partner, Covington & Burling, Washington, DC

Richard L. Rainey, Finnegan, Henderson, Farabow, Garrett & Dunner, LLP, Washington, DC

**FRIDAY AFTERNOON, NOV. 18, 2005**

**Presiding Officer:**

**Joseph J. Rolla, Jr., Alexandria, VA (invited)**

**PATENT REFORM INSIDE AND OUTSIDE THE USPTO**

**1:30 p.m. .75 hr**

**What's Happening with Patent Reform?**

Public interest in patent reform has never been more intense. Whether Congress passes legislation this session, some changes are coming. This presentation will examine the forces behind the winds of change and what direction they might take.

James Pooley, Milbank, Tweed, Hadley & McCloy LLP, Palo Alto, CA

**2:15 p.m. .50 hr**

**USPTO's Patents Strategic Direction—Overview of New Pendency, Quality and Human Capital Initiatives**

Prior efforts by the USPTO to simply hire its way out of workload problems in the face of historically inconsistent funding has failed to keep pace with growing filings. A new strategic direction is being developed to turn the pendency corner and improve quality, while hiring more, training better, and driving down attrition.

John J. Doll, Deputy Commissioner for Patent Resources and Planning, USPTO, Alexandria, VA

**2:45 p.m. Break**

**GLOBAL PROTECTION OF IP**

**3:00 p.m. 1.5 hr**

**Global Protection of Patents**

A discussion of developing trends, problems and responses to protecting patents in a global environment, including potential changes to U.S. law, recent changes in foreign laws—with particular emphasis on India and China. The panel will conclude with a discussion of concrete steps and strategies that have proven effective in key foreign markets.

Ron Epperson, Practice Leader, Ernst & Young, LLP, Houston, TX

Phillip Johnson, Johnson & Johnson, New Brunswick, NJ

Donal B. Tobin, Vice President Intellectual Property, The Gillette Co., Boston, MA

**4:30 p.m. Adjourn**

**Advanced Patent Law Institute**

Each program uniquely tailored to its locale

**Austin, TX – Oct. 26-28, 2005  
Four Seasons Hotel**

Join leading practitioners, academics and in-house counsel from the Southwest and Silicon Valley in Austin, Texas for two days of presentations on a rich array of prosecution and litigation topics. Cool weather, great city, great music and food—at the Four Seasons Austin.

**Alexandria, VA – Nov. 17-18, 2005  
USPTO—Main Auditorium**

This conference—offered at the USPTO—provides unique insights into the search process, standards of review, quality assurance, forum shopping and forum selection, global protection of IP, patent reform and USPTO strategic initiatives. Join USPTO senior staff, leading practitioners, academics and members of the federal judiciary from a variety of courts and forums in the Washington DC area, for two days at the USPTO. The conference is jointly sponsored with the George Mason University School of Law.

**San Jose, CA – Dec. 1-2, 2005  
The Fairmont San Jose**

Come to the heart of Silicon Valley, and join leading practitioners and in-house counsel from Apple, Cisco, Google, Intel, Genentech, Intellectual Ventures, and more at the Fairmont San Jose. This conference is jointly sponsored by the Berkeley Center for Law and Technology at Boalt Hall School of Law, and Stanford Law School.

## HOW TO REGISTER

The University of Texas  
School of Law  
Attn: CLE - PV05  
P.O. Box 7759  
Austin, TX 78713-7759

**WEB: [www.utcle.org](http://www.utcle.org)**

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## 2005 ADVANCED PATENT LAW INSTITUTE

PV05

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### REGISTRATION

**Includes Course Binder and Friday Box Lunch Presentation.**

- ☐ Early Registration Fee due by Wed. Nov. 9, 2005 ..... \$595.00
- ☐ Registration Fee after Wed. Nov. 9, 2005 ..... \$645.00
- ☐ USPTO Special Registration Fee ..... \$250.00  
(increases to \$300 after Nov. 9, 2005)
- ☐ GMU School of Law Student Rate ..... \$125.00  
(increases to \$150 after Nov. 9, 2005)

### CONFERENCE PUBLICATIONS AND MEDIA

**Allow 2-4 weeks from conference date for delivery.**

- ☐ Course Binder Without Conference Registration ..... \$200.00  
*Note: Conference registration includes Course Binder.*
- ☐ Audio CD Set ..... \$175.00
- ☐ eBinder on CD (PDF format) ..... \$200.00/\$50.00  
( \$200 purchased alone, \$50 with registration or purchase of Course Binder or Audio CD Set )

### IN-HOUSE CLE: Bring the conference in-house and learn at your convenience.

**Allow 2-4 weeks from conference date for delivery.**

- ☐ In-House CLE for 2 – Includes Audio Set and Course Binder ..... \$750.00
- \_\_\_\_\_ Add participants (includes Course Binder) for \$200 each ..... \$ \_\_\_\_\_

TOTAL ENCLOSED ..... \$ \_\_\_\_\_

### METHOD OF PAYMENT

- ☐ Check (make checks payable to: **The University of Texas at Austin**)
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USPTO Campus • Alexandria, VA

• • • • • Phone: 512-475-6700 Fax: 512-475-6876



# Top Reasons to Attend APLI at the USPTO

## The Venue—Inside the USPTO in Alexandria, VA

See the beautiful new USPTO campus, and collections, with presentations in the Main Auditorium of the Madison building in Alexandria.

Easy access via Metro with great shopping and restaurants in Old Town Alexandria.

## USPTO Searches—The Inside Story

Learn how USPTO examiners search for prior art. What can or should practitioners learn about the process?

## Opportunities to Hear from and Speak with Senior USPTO Officials and Staff

Senior USPTO staff, from examinations, appeals, review and more will be presenting and in attendance at this major conference.

## Forum Selection and Options—Views from the Judges

Hon. Roderick McKelvie moderates a full morning series of presentations and discussions from judges of the ITC, the Court of Federal Claims, the District Court, and the Court of Appeals for the Federal Circuit—don't miss it!

## Inside the Black Box of the USPTO— What's Happening with My Application

What forms are used and who has signing authority? The definitive presentations on quality assurance, in process reviews, second pair of eyes, and appeals conferences.

## Patent Reform: Inside and Outside the USPTO

Leading players discuss what is happening in Congress, and new strategic initiatives inside the USPTO to decrease pendency and increase quality.

## Global Protection of Patents— India and China

Practical advice and suggested strategies from three leading international experts.

## The Intersection of Antitrust and Patents

Standard setting, economics, patent pooling, strategies, and practical solutions for tough issues—it's all here, presented by leading academics and practitioners.

## CONFERENCE FACULTY

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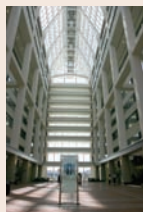
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M  
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E

This course has been approved for Minimum Continuing Legal Education credit by the State Bar of Texas Committee on MCLE in the amount of 13.50 hours, of which 1.25 credit hour will apply to legal ethics/professional responsibility credit. The state of Texas is an approved jurisdiction for California credit. MCLE credit applied for in the states of Virginia and New York.

## ALEXANDRIA, VA

November 17-18, 2005  
CONFERENCE LOCATION



**USPTO—Main Auditorium**  
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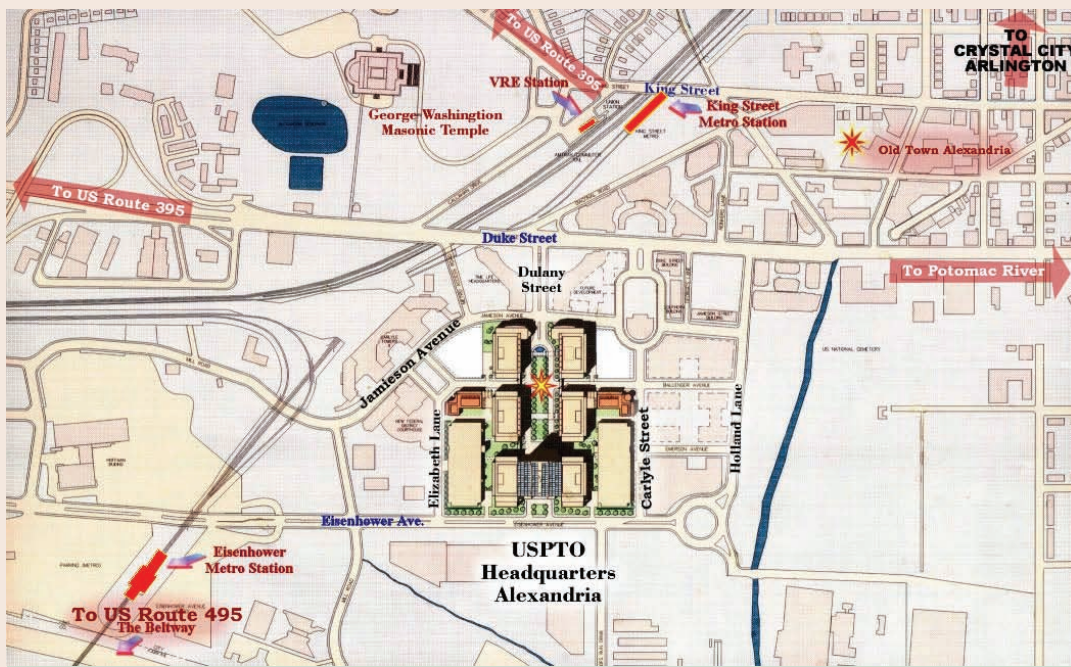
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703-548-5474

### KEY DATES

Registration and Cancellation

- November 9, 2005, 5 p.m.**  
• last day for early registration  
add \$50 for registrations  
received after this time
- November 11, 2005, 5 p.m.**  
• last day for full refund
- November 14, 2005, 5 p.m.**  
• last day for partial refunds  
\$50 processing fee applied
- November 17, 2005**  
• conference begins at 8:45 a.m.



## Other Advanced Patent Law Programs

### PATENT LAW IN AUSTIN

October 26-28, 2005

Four Seasons Hotel, Austin, TX

Join leading practitioners, academics and in-house counsel from the Southwest and Silicon Valley in Austin, Texas for two days of presentations on a rich array of prosecution and litigation topics. Cool weather, great city, great music and food—at the Four Seasons Austin.

For registration information, visit [www.utcle.org](http://www.utcle.org).

### PATENT LAW IN SAN JOSE

December 1-2, 2005

The Fairmont San Jose, San Jose, CA

Come to the heart of Silicon Valley, and join leading practitioners and in-house counsel from Apple, Cisco, Google, Intel, Genetech, Intellectual Ventures, and more at the Fairmont San Jose. This conference is jointly sponsored by the Berkeley Center for Law and Technology at Boalt Hall School of Law, and Stanford Law School.

For registration information, visit [www.utcle.org](http://www.utcle.org).

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November 17-18, 2005

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