

**2005 Advanced Patent Law Institute**  
**November 17-18, 2005 • United States Patent and Trademark Office •**  
**Alexandria, VA, VA**

**Thursday Morning, Nov. 17, 2005**

**Presiding Officer:**

**Stephen G. Kunin**, Oblon, Spivak, McClelland, Maier & Nuestadt - Alexandria, VA

9:00 am 1.00 hr	<p><b>Effective Patent Prosecution: Critical Choices, Drafting Techniques and Strategies</b></p> <p>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.</p> <p>Dale S. Lazar, DLA Piper - Reston, VA</p>
10:00 am 0.67 hr	<p><b>The Search Process at the USPTO—Discovering Prior Art</b></p> <p>How do the USPTO examiners search for prior art; databases and new search tools? What can or should practitioners learn about this process?</p> <p>Marian C. Knode, USPTO - Alexandria, VA Dale S. Lazar, DLA Piper - Reston, VA</p>
11:00 am 0.50 hr	<p><b>USPTO Communications with Practitioners: Standards of Review, Requests, Responses and Rejections</b></p> <p>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.</p> <p>Dale S. Lazar, DLA Piper - Reston, VA Joseph J. Rolla, USPTO - Alexandria, VA</p>
11:30 am 0.32 hr	<p><b>Quality Assurance Processes and Procedures at the USPTO</b></p> <p>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.</p> <p>George C. Elliott, USPTO - Alexandria, VA</p>
11:50 am 0.32 hr	<p><b>Concluding Discussion Q&amp;A</b></p> <p>Opportunities for Q&amp;A with a panel of speakers from the morning presentations.</p> <p>George C. Elliott, USPTO - Alexandria, VA Marian C. Knode, USPTO - Alexandria, VA Dale S. Lazar, DLA Piper - Reston, VA Joseph J. Rolla, USPTO - Alexandria, VA</p>

## Thursday Afternoon, Nov. 17, 2005

### Presiding Officer:

**David L. McCombs**, Haynes & Boone, LLP - Dallas, TX

1:15 pm 0.50 hr	<p><b>Pre-filing Considerations in Patent Cases</b></p> <p>An exploration and discussion of pre-filing obligations and standards of inquiry, with particular emphasis on satisfying requirements under Rule 11.</p> <p>Esther H. Lim, Finnegan Henderson Farabow - Washington, DC</p>
1:45 pm 0.75 hr	<p><b>Opinion Letters and Scope of Privilege Waivers</b></p> <p>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?</p> <p>Donald C. Templin, Haynes &amp; Boone - Dallas, TX</p>
2:30 pm 0.50 hr	<p><b>Transnational Patent Enforcement: Lessons from Voda v. Cordis</b></p> <p>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.</p> <p>Harold C. Wegner, Foley &amp; Lardner - Washington, DC</p>
3:00 pm 0.50 hr	<p><b>Litigating Against the USPTO</b></p> <p>A view from the Office of the Solicitor on litigation against the USPTO.</p> <p>John M. Whealan, USPTO - Alexandria, VA</p>
3:45 pm 0.25 hr	<p><b>Overview: Antitrust Meets Patent Law</b></p> <p>An overview of the law and economics of the interface between patent and antitrust law.</p> <p>Bruce H. Kobayashi, George Mason University School of Law - Arlington, VA</p>
4:00 pm 0.50 hr	<p><b>The Risk and Rewards of Participating in Standard-Setting Organizations</b></p> <p>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.</p> <p>David J. Healey, Weil, Gotshal &amp; Manges, LLP - Houston, TX</p>
4:30 pm 0.50 hr	<p><b>Patent Pooling</b></p> <p>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.</p> <p>James J. Kulbaski, Oblon, Spivak, Mc Clelland, Maier &amp; Neus - Arlington, VA</p>

5:00 pm 0.50 hr	<p><b>Practical Antitrust Involving Patents: Inequitable Conduct and Licensing Agreements (Illinois Toolworks Case)</b></p> <p>A practical discussion of current patent/antitrust issues, including the Federal Circuit's decision in Illinois Tool Works and other recent case law.</p> <p>Christopher J. Renk, Banner &amp; Witcoff, Ltd. - Chicago, IL</p>
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## Friday Morning, Nov. 18, 2005

### Presiding Officer:

**Hon. Roderick R. McKelvie**, Covington & Burling - Washington, DC

8:30 am 0.75 hr	<p><b>Making Effective Use of the BPAI Appeals Process</b></p> <p>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.</p> <p>Andrew J. Dillon, Dillon &amp; Yudell LLP - Austin, TX Hon. Michael R. Fleming, USPTO - Alexandria, VA</p>
9:15 am 0.50 hr	<p><b>Patent Lemmings: Forum Shopping</b></p> <p>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?</p> <p>Kimberly A. Moore, George Mason University - Arlington, VA</p>
10:00 am 0.25 hr	<p><b>Overview—Relationships between Forums and Remedies</b></p> <p>Selecting a forum: What are the limitations on and advantages of seeking relief in the ITC, The Court of Claims, or a District Court?</p> <p>Hon. Roderick R. McKelvie, Covington &amp; Burling - Washington, DC</p>
10:15 am 0.75 hr	<p><b>Section 337: A Mid-Twentieth Century Remedy for a Twenty-First Century Problem</b></p> <p>Section 337 of the Smoot-Hawley Tariff Act of 1930, reviled 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.</p> <p>Peter D. Ehrenhaft, Miller and Chevalier Chartered - Washington, DC Paul J. Luckern, U.S. International Trade Comm., Off. Of - Washington, DC</p>
11:00 am 0.50 hr	<p><b>Options in the Court of Federal Claims</b></p> <p>A discussion of patent litigation in the Court of Federal Claims.</p> <p>Hon. Loren A. Smith, United States Court of Federal Claims - Washington, DC</p>

11:30 am 0.50 hr	<p><b>Options at the District Court</b></p> <p>A leading Federal District Court Judge discusses effective litigation strategies in the Eastern District of Virginia.</p> <p>Hon. T S. Ellis III, US District Court - Alexandria, VA</p>
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## Friday Afternoon, Nov. 18, 2005

### Presiding Officer:

**Joseph J. Rolla**, USPTO - Alexandria, VA

12:00 pm 0.75 hr	<p><b>Box Lunch Presentation: Effective Advocacy before the U.S. Court of Appeals for the Federal Circuit</b></p> <p>Hon. Roderick R. McKelvie, Covington &amp; Burling - Washington, DC  Randall R. Rader, Court Of Appeals For The Federal Circuit - Washington, DC  Richard Rainey, Finnegan, Henderson, Farabow, Garrett &amp; - Atlanta, GA</p>
1:30 pm 0.75 hr	<p><b>What's Happening with Patent Reform?</b></p> <p>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.</p> <p>James Pooley, Pooley &amp; Oliver, LLP - Palo Alto, CA</p>
2:15 pm 0.50 hr	<p><b>USPTO's Patents Strategic Direction—Overview of New Pendency, Quality and Human Capital Initiatives</b></p> <p>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.</p> <p>John J. Doll, USPTO - Alexandria, VA</p>
3:00 pm 1.50 hrs	<p><b>Global Protection of Patents</b></p> <p>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.</p> <p>Ron Epperson, Ernst &amp; Young, LLPs - Houston, TX  Bernard F. Plantz, Johnson &amp; Johnson - New Brunswick, NJ  Donal B. Tobin, The Gillette Company - Boston, MA</p>