

2006

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November 16-17, 2006

USPTO – Main Auditorium

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2006

ADVANCED PATENT LAW INSTITUTE

November 16-17, 2006 • USPTO – Main Auditorium • Alexandria, VA

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THURSDAY MORNING, NOV. 16, 2006

Presiding Officer: Stephen G. Kunin
Oblon, Spivak, McClelland, Maier & Nuestadt
Alexandria, VA

8:00 a.m. Registration Opens

Includes continental breakfast.

8:50 a.m. Welcoming Remarks

Stephen G. Kunin, Oblon, Spivak,
McClelland, Maier & Nuestadt, Alexandria, VA
Jay P. Lucas, United States Patent and
Trademark Office, Alexandria, VA

9:00 a.m. .50 hr

Patent Quality Initiatives at the USPTO

The presentation will focus on the objectives of the Community Patent Review project for third party submission of prior art references to patent examiners under Rule 1.99. A pilot for the project is expected to begin in 2007.

Jack B. Harvey, United States Patent and
Trademark Office, Alexandria, VA
Manny W. Schecter, IBM Corporation
Armonk, NY

9:30 a.m. .50 hr

Patent Process Reform at the USPTO

This session includes a discussion of some of the USPTO's efforts to reform patent process through initiatives such as the "patent suite of products," accelerated examination of patent applications, and peer review of published patent applications.

Jay P. Lucas, United States Patent and
Trademark Office, Alexandria, VA

10:00 a.m. .50 hr

E-Filing and E-Commerce at the USPTO

An overview of the USPTO's e-filing system, as well as other e-commerce initiatives.

James E. Beyer, Dinsmore & Shohl LLP
Dayton, OH

Jay P. Lucas, United States Patent and
Trademark Office, Alexandria, VA

William Stryjewski, United States Patent and
Trademark Office, Alexandria, VA

10:30 a.m. Break

10:45 a.m. .50 hr ethics

Opinions, Willfulness, Scope of Privilege, Waiver

A discussion of key practical and ethical issues arising from drafting exculpatory patent opinions and special problems involving waiver of privilege, including implications of *Knorr Bremse*.

Steven P. Weihrouch, Oblon, Spivak,
McClelland, Maier & Neustadt, P.C.
Alexandria, VA

11:15 a.m. .75 hr

Current Developments in Claim Construction

The Federal Circuit is one year post *Phillips v AWH*. Where does the court appear to be on claim construction (including single embodiment, power of the specification, and FH effects), and what the trial courts are doing at the "first instance"/real-world level will be the focus of this session.

Kenneth R. Adamo, Jones Day, Dallas, TX

12:00 p.m. Lunch on Your Own

THURSDAY AFTERNOON

Presiding Officer: Jay P. Lucas
United States Patent and Trademark Office
Alexandria, VA

1:15 p.m. .75 hr

Patentable Subject Matter and Examination Guidelines

This topic will focus primarily on the current USPTO guidelines for the examination of business method and e-commerce patents, in light of recent Federal Circuit rulings.

Edward J. Kessler, Sterne, Kessler, Goldstein &
Fox, P.L.L.C., Washington, DC

2:00 p.m. .75 hr

Obviousness

A discussion of the current state of obviousness law, including the pending *KSR Int'l Co. v. Teleflex, Inc.* case before the Supreme Court and recent developments at the United States Patent and Trademark Office.

Christopher A. Cotropia, University of
Richmond School of Law, Richmond, VA

Hon. Michael R. Fleming, United States
Patent and Trademark Office, Alexandria, VA

2:45 p.m. .75 hr

Standard-Setting and Pooling

An overview of the IP, antitrust and other legal implications of establishing and participating in standard-setting organizations, including a review of the recent decision by the Federal Trade Commission in the *Rambus* case.

Adam C. Hemlock, Weil, Gotshal &
Manges LLP, New York, NY

3:30 p.m. Break

3:45 p.m. .50 hr

Strategies for Operating Under the New Continuing Application and Claim Rules

The USPTO has proposed new rules that will severely restrict the patent applicant's ability to file continuing applications or requests for continued examination, and limit the number of examined claims without the submission of an examination support document. These proposed rules will have a profound effect on patent prosecution. The panelists will discuss the key features of the proposed rules and provide suggestions for how to best practice under these proposed rules, should the USPTO issue them as final without substantial revision.

Stephen G. Kunin, Oblon, Spivak,
McClelland, Maier & Nuestadt, Alexandria, VA
Charles E. Van Horn, Finnegan, Henderson,
Farabow, Garrett & Dunner, L.L.P.,
Washington, DC

REEXAMINATION LITIGATION STRATEGIES AND PROCESSES

4:15 p.m. .75 hr

Inside the USPTO's Central Reexamination Unit

A discussion of the new Central Reexamination Unit's internal structure and operations, how the Unit deals with requesters and patent owners, and their experience and results to date.

How to Make Reexamination Filings Examiner-Friendly

USPTO and practitioner perspectives on format, organization, exhibits and presentation of arguments that may be considered in reexamination.

Moderator: David L. McCombs
Haynes and Boone, LLP, Dallas, TX

Robert A. Clarke, United States Patent and
Trademark Office, Alexandria, VA

Lissi Mojica Marquis, United States Patent and
Trademark Office, Alexandria, VA

David M. O'Dell, Haynes and Boone, LLP
Richardson, TX

5:00 p.m. .50 hr

The Strategic Use of Reexams during the Course of Litigation

A discussion of pre-litigation issues, *ex parte* vs. *inter partes* filings, motions to stay pending reexamination, post verdict considerations, and case study reviews of recent high profile matters.

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

David L. McCombs, Haynes and Boone, LLP
Dallas, TX

5:30 p.m. Adjourn

FRIDAY MORNING, NOV. 17, 2006

Presiding Officer: John F. Witherspoon,
Law Office of John Witherspoon,
Washington, D.C.

7:30 a.m. Conference Room Opens
Includes continental breakfast.

8:30 a.m. .75 hr

Designing Products and Processes to Avoid Infringement

The Federal Circuit has been shrinking the literal scope of patents, as well as the protection provided by the doctrine of equivalents. As a result, with careful planning, patent infringement can be avoided with near certainty. Learn a systematic, step-by-step approach for designing products and processes that avoid infringement.

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

9:15 a.m. .50 hr

Indirect Infringement

A discussion of indirect infringement and its effect on participants of today's business climate. This session will explore the differing legal standards for establishing active inducement and provide some specific suggestions when litigating a claim on indirect infringement.

H. Keeto Sabharwal, Blank Rome LLP
Washington, DC

9:45 a.m. .50 hr

Responding to Patent Infringement Claims on Essential Patents

A discussion of the counterclaims available to a defendant accused of infringing a patent that has been declared essential in a standard-setting context.

Hilda C. Galvan, Jones Day, Dallas, TX

10:15 a.m. Break

10:30 a.m. .75 hr

Remedies and Injunctions

A practical discussion of current issues relating to remedies in patent infringement actions, including the changing landscape of injunctive relief in view of the U.S. Supreme Court's decision in *eBay Inc. v. MercExchange LLC*, and recent district court decisions applying *eBay*.

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

11:15 a.m. .50 hr

Fundamentals and Trends in Section 337 Investigations at the ITC: A Practitioner's Perspective

Joshua Lathrop, Navigant Consulting, Inc.
New York, NY

Bert C. Reiser, Howrey, LLP, Washington, DC

LUNCHEON PRESENTATION

11:45 a.m. Pick Up Box Lunch

12:15 p.m. .75 hr

View from the Federal Circuit

A discussion of 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, Covington &
Burling LLP, Washington, DC

Richard L. Rainey, Covington & Burling LLP
Washington, DC

FRIDAY AFTERNOON

Presiding Officer: Hon. Roderick R. McKelvie
Covington & Burling
Washington, DC

1:15 p.m. .50 hr

Options at the District Court

A leading district court judge discusses effective litigation strategies.

Hon. Liam O'Grady, United States District
Court for the Eastern District of Virginia,
Alexandria, VA

Comments and Questions:

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

Richard L. Rainey, Covington &
Burling LLP, Washington, DC

1:45 p.m. .75 hr

Patent Suits Against the Government in the Court of Federal Claims: A Practitioner's Perspective

This discussion focuses on suits against the United States pursuant to 28 U.S.C. §1498 for unauthorized manufacture or use of a patented invention. It notes both similarities and differences between practices in the Court of Federal Claims for these suits and in district courts for patent infringement cases.

John Fargo, U.S. Department of Justice
Washington, DC

David Schlitz, Baker Botts LLP, Washington, DC
Hon. Loren A. Smith, United States Court of
Federal Claims, Washington, DC

2:30 p.m. Break

2:45 p.m. 1.00 hr ethics

Ethical Considerations in Rendering Patent Opinions

The presentation examines the ethics, art and philosophy of rendering patent opinions, including ethical requirements which compel a balanced, complete and suitably qualified opinion. Also discussed is the impact of the *Knorr-Bremse* case on the ethics of opinion practice.

Samuel C. Miller III, Buchanan Ingersoll &
Rooney PC, Alexandria, VA

3:45 p.m. .75 hr including .25 hr ethics

Electronic Discovery Landmines to Avoid

The new electronic discovery rules take effect December 1, 2006: this session covers key issues under the new rules and key case law developments of interest to all practitioners.

Alan D. Albright, Fish and Richardson P.C.
Austin, TX

4:30 p.m. Adjourn

About the Conference

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 Advanced Patent Law Institute provides unique insights into claim construction; standard-setting and pooling; avoiding patent infringement; remedies and injunctions; the search process; patent reform and USPTO patent quality initiatives. The conference is jointly sponsored by George Mason University School of Law and The University of Texas School of Law.

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.

New Initiatives and Reform at the USPTO

Get the insider's perspective on patent quality initiatives, patent process reform, plus e-filing and e-commerce at the USPTO.

Opportunities to Hear 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.

How to Make Reexamination Filings Examiner-Friendly

A two-part discussion by USPTO staff and practitioners explores (1) the new Central Reexamination Unit's internal structure and operations and (2) format, organization, exhibits and presentation of arguments that may be considered in reexamination.

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

KENNETH R. ADAMO
Jones Day
Dallas, TX

ALAN D. ALBRIGHT
Fish and Richardson P.C.
Austin, TX

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United States Patent and
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Intellectual Property Institute
University of Richmond School of Law
Richmond, VA

JOHN FARGO
Director, Intellectual Property Staff
Commercial Litigation Branch,
Civil Division
Department of Justice
Washington, DC

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United States Patent and
Trademark Office
Board of Patent Appeals
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JAY P. LUCAS
Deputy Commissioner for Patent
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United States District Court for the
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United States Court of Federal Claims
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The Advanced Patent Law Institute generates a definitive IP resource guide. Don't miss updated case law, current developments, articles and planning strategies — over 500 pages of practical materials.

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Includes Course Binder and Friday Box Lunch Presentation

☐ Early Registration Fee due by Wednesday, Nov. 8, 2006 \$595.00

☐ Registration Fee after Wednesday, Nov. 8, 2006 \$645.00

☐ USPTO Special Registration Rate \$250.00
(increases to \$300 after Nov. 8, 2006)

CONFERENCE PUBLICATIONS AND MEDIA

Allow 2-4 weeks from the 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)

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ALEXANDRIA, VA

November 16-17, 2006
CONFERENCE LOCATION



USPTO—Main Auditorium
Concourse Level of the Madison
Building (Main Building on the
USPTO Campus)
600 Dulany Street
Alexandria, VA 22313-1450

Please visit
www.uspto.gov/main/visiting.htm
for directions and information about
public transportation.

Nearby accommodations:
Embassy Suites Hotel Alexandria (Old Town)
1900 Diagonal Road
Alexandria, VA 22314
703-684-5900

SPECIAL RATE \$229 (subject to availability)
good through October 16, 2006.
Parking: \$16 overnight
(subject to change)

KEY DATES

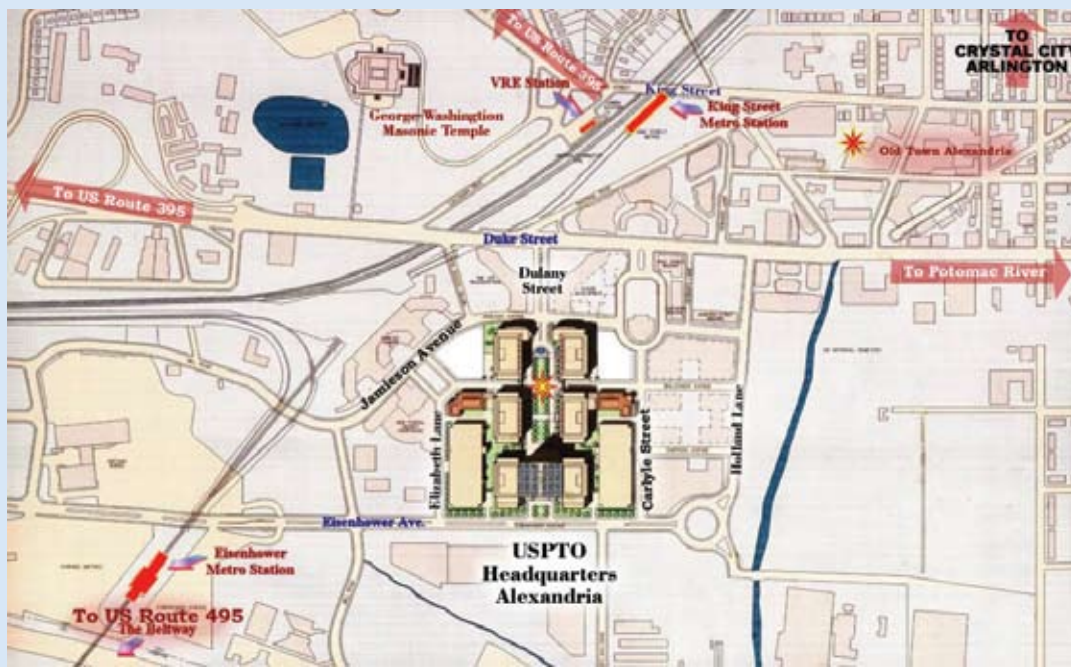
Registration & Cancellation

November 8, 2006—5 p.m.
last day for early registration
add \$50 for registrations
received after this time

November 10, 2006—5 p.m.
last day for full refund

November 13, 2006—5 p.m.
last day for partial refunds
\$50 processing fee applied

November 16, 2006—9 a.m.
conference begins



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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.

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November 29-December 1, 2006

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2006

ADVANCED PATENT LAW INSTITUTE

November 16-17, 2006 • USPTO – Main Auditorium • Alexandria, VA

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