

2006 Advanced Patent Law Institute
November 16-17, 2006 • United States Patent and Trademark Office •
Alexandria, VA, VA

Thursday Morning, Nov. 16, 2006

Presiding Officer:

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

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| 9:00 am 0.50 hr | <p>Patent Quality Initiatives at the USPTO</p> <p>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.</p> <p>Jack B. Harvey, United States Patent and Trademark Office - Alexandria, VA Manny W. Schechter, IBM Corporation - Yorktown Heights, NY</p> |
| 9:30 am 0.50 hr | <p>Patent Process Reform at the USPTO</p> <p>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.</p> <p>Robert W. Bahr, U.S. Patents and Trademark Office - Washington, DC</p> |
| 10:00 am 0.50 hr | <p>E-Filing and E-Commerce at the USPTO</p> <p>An overview of the USPTO's e-filing system, as well as other e-commerce initiatives.</p> <p>James E. Beyer, Dinsmore & Shohl, LLP - Dayton, OH William Stryjewski, United States Patent and Trademark Office - Alexandria, VA</p> |
| 10:45 am 0.00 hr 0.50 hr ethics | <p>Opinions, Willfulness, Scope of Privilege, Waiver</p> <p>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.</p> <p>Steven P. Weihrouch, Oblon, Spivak, McClelland, Maier, Et Al - Arlington, VA</p> |
| 11:15 am 0.75 hr | <p>Current Developments in Claim Construction</p> <p>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.</p> <p>Kenneth R. Adamo, Jones Day - Dallas, TX</p> |

Thursday Afternoon, Nov. 16, 2006

Presiding Officer:

Jay P. Lucas, US Patent and Trademark Office - Alexandria, VA

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| 1:15 pm 0.75 hr | <p>Patentable Subject Matter and Examination Guidelines</p> <p>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.</p> <p>Edward J. Kessler, Sterne Kessler Goldstein & Fox PLLC - Washington, DC</p> |
| 2:00 pm 0.75 hr | <p>Obviousness</p> <p>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.</p> <p>Christopher A. Cotropia, Intellectual Property Institute - Richmond, VA Hon. Michael R. Fleming, USPTO - Alexandria, VA</p> |
| 2:45 pm 0.75 hr | <p>Standard-Setting and Pooling</p> <p>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.</p> <p>Debra Pearlstein, Weil, Gotshal & Manges LLP - New York, NY</p> |
| 3:45 pm 0.50 hr | <p>Strategies for Operating Under the New Continuing Application and Claim Rules</p> <p>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.</p> <p>Stephen G. Kunin, Oblon, Spivak, McClelland, Maier & Nuest - Alexandria, VA</p> |
| 4:15 pm 0.75 hr | <p>Inside the USPTO's Central Reexamination Unit</p> <p>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.</p> <p>Robert Clarke, USPTO - Alexandria, VA Lissi Mojica Marquis, United States Patent and Trademark Office - Alexandria, VA David L. McCombs, Haynes & Boone - Dallas, TX David M. O'Dell, Haynes And Boone, LLP - Richardson, TX</p> |
| 5:00 pm 0.50 hr | <p>The Strategic Use of Reexams during the Course of Litigation</p> <p>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.</p> <p>David J. Healey, Weil, Gotshal & Manges, LLP - Houston, TX David L. McCombs, Haynes & Boone - Dallas, TX</p> |

Friday Morning, Nov. 17, 2006

Presiding Officer:

John F. Witherspoon, Law Office Of John F. Witherspoon - Washington, DC

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| 8:30 am 0.75 hr | <p>Designing Products and Processes to Avoid Infringement</p> <p>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.</p> <p>Dale S. Lazar, DLA Piper - Reston, VA</p> |
| 9:15 am 0.50 hr | <p>Indirect Infringement</p> <p>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.</p> <p>H. Keeto Sabharwal, Blank Rome LLP - Washington, DC</p> |
| 9:45 am 0.50 hr | <p>Responding to Patent Infringement Claims on Essential Patents</p> <p>A discussion of the counterclaims available to a defendant accused of infringing a patent that has been declared essential in a standard-setting context.</p> <p>Scott W. Burt, Jones Day - Chicago, IL</p> |
| 10:30 am 0.75 hr | <p>Remedies and Injunctions</p> <p>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.</p> <p>Christopher J. Renk, Banner & Witcoff, Ltd. - Chicago, IL</p> |
| 11:15 am 0.50 hr | <p>Fundamentals and Trends in Section 337 Investigations at the ITC: A Practitioner's Perspective</p> <p>Joshua Lathrop, Navigant Consulting, Inc. - New York, NY Bert C. Reiser, Howrey, LLP - Washington, DC</p> |

Friday Afternoon, Nov. 17, 2006

Presiding Officer:

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

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| 12:15 pm 0.75 hr | <p>Luncheon Presentation: View from the Federal Circuit</p> <p>A discussion of effective advocacy before the U.S. Court of Appeals for the Federal Circuit.</p> <p>Hon. Richard Linn, U.S. Court of Appeals for the Federal Ci - Washington, DC</p> <p>Commentators: Hon. Roderick R. McKelvie, Covington & Burling - Washington, DC</p> <p>Commentators: Richard Rainey, Finnegan, Henderson, Farabow, Garrett & - Atlanta, GA</p> |
| 1:15 pm 0.50 hr | <p>Options at the District Court</p> <p>A leading district court judge discusses effective litigation strategies.</p> <p>Commentators: Hon. Roderick R. McKelvie, Covington & Burling - Washington, DC Hon. Liam O'Grady, United States District Court for the Eas - Alexandria, VA</p> <p>Commentators: Richard Rainey, Finnegan, Henderson, Farabow, Garrett & - Atlanta, GA</p> |
| 1:45 pm 0.75 hr | <p>Patent Suits Against the Government in the Court of Federal Claims: A Practitioner's Perspective</p> <p>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.</p> <p>John Fargo, Department Of Justice, Civil Division - Washington, DC David Schlitz, Baker Botts LLP - Washington, DC Hon. Loren A. Smith, United States Court of Federal Claims - Washington, DC</p> |
| 2:45 pm 0.00 hr 1.00 hr ethics | <p>Ethical Considerations in Rendering Patent Opinions</p> <p>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.</p> <p>Samuel C. Miller III, Buchanan Ingersoll & Rooney PC - Alexandria, VA</p> |
| 3:45 pm 0.00 hr 0.25 hr ethics | <p>Electronic Discovery Landmines to Avoid</p> <p>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.</p> <p>Barry K. Shelton, Fish & Richardson P.C. - Austin, TX</p> |