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2008

ADVANCED PATENT LAW INSTITUTE

January 10-11, 2008 • USPTO – Main Auditorium • Alexandria, VA

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THURSDAY MORNING, JANUARY 10, 2008

Presiding Officer:

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

8:00 a.m. Registration Opens

Includes continental breakfast.

8:50 a.m. Welcoming Remarks

9:00 a.m. .75 hr

Pitfalls in Claims Drafting and Filings

This session covers common, and not so common, mistakes in claims drafting, including drafting language and strategies after *KSR*, tips on handling problematic drafting issues, effective communication with USPTO examiners, anticipation of examiner objections, and discussion of how examiners look at applications in light of the USPTO training modules.

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

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

9:45 a.m. .75 hr

Developments in Claims Construction

Overshadowed by the U.S. Supreme Court/ Federal Circuit colloquy, this core issue has percolated along quietly. This year's pitfalls and construction trends of the moment will be explored, with an eye towards a more tactical approach to *Markman* mechanisms responsive to those trends. The Federal Circuit still controls the keys to the kingdom, but are the locks secure?

Kenneth R. Adamo, Jones Day, Dallas, TX

10:30 a.m. Break

10:45 a.m. .75 hr

USPTO Initiatives

A discussion of current USPTO Initiatives, including expedited patent prosecution, pre-appeal process, the patent highway pilot program, the patent "suite of products", external quality metrics, and more.

John J. Love, United States Patent and Trademark Office, Alexandria, VA

Commentator: Nicholas P. Godici, Birch, Stewart, Kolasch & Birch, LLP, Falls Church, VA

11:30 a.m. 1.00 hr

USPTO Practice Rules: Continuations and Claims

What does the PTO want you to know about the new rules? What strategies need to be considered to best represent clients under the new rules? This presentation will address the new rules from both perspectives.

Robert Bahr, United States Patents and Trademark Office, Alexandria, VA

Dale S. Lazar, DLA Piper, Reston, VA

12:30 p.m. Lunch on Your Own

THURSDAY AFTERNOON

Presiding Officer:

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

1:30 p.m. .75 hr

Effective Appeals Practice

A discussion of the new board rules from both a PTO and practitioner perspective.

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

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

2:15 p.m. .50 hr

Statutory Subject Matter Developments

This session will cover recent Federal Circuit and Board of Patent Appeals and Interferences decisions relating to subject matter eligibility under 35 U.S.C. section 101. Coverage will include the patentability of signal claims and business methods that do not employ technological means for their implementation.

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

Stephen Walsh, United States Patent and Trademark Office, Alexandria, VA

2:45 p.m. .50 hr ethics

Inequitable Conduct, Subject Matter Conflicts, and McKesson

A discussion of practical and ethical issues as well as techniques for minimizing subject matter conflicts, complying with the duty of disclosure, and avoiding inequitable conduct during the course of patent prosecution.

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

3:15 p.m. Break

3:30 p.m. .50 hr ethics

Defending Against Willful Patent Infringement Claims: Competent Opinion of Counsel and the Risk of Privilege Waiver

Defendants facing allegations of willful infringement in a patent infringement suit need no longer face the Hobbesian Choice of choosing between using pre-litigation opinions of counsel analyzing the risk of patent infringement, and waiving their trial counsel's attorney-client and work product privileges. *In re Seagate*, decided by the Federal Circuit in August of 2007, overruled standing precedent that the use of such opinions waives trial counsel's privileges related to all documents and communications discussing the opinions. This presentation discusses the importance of competent opinion of counsel in defending against an allegation of willful infringement of a patent, the strength of a defendant's ability to rely on such opinions, and what remains of the risk of privilege waiver after *Seagate*.

Jeffrey D. Feldman, Feldman Gale, Miami, FL

4:00 p.m. .50 hr ethics

Prefiling Investigations

Filing a patent infringement lawsuit is the first item on the docket sheet, but not the first step in the process. This session discusses what information/evidence is needed, what analysis should be done, and some additional prefiling concerns that need to be addressed before signing your name to the Complaint.

Phillip B. Philbin, Haynes and Boone, LLP, Dallas, TX

4:30 p.m. .50 hr

Licensing and Declaratory Relief after *Medimmune*

Have the floodgates of litigation been opened after the Supreme Court's holding in *Medimmune*? Or rather, did *Medimmune* merely clarify when an actual controversy exists and when does a licensee have standing to bring suit? This session will also discuss what issues remain after *Medimmune*, what post-*Medimmune* cases have taught us, and what is in store for future licensees.

John W. Ryan, Crowell & Moring, LLP, Washington, DC

Commentator: Kenneth J. Dow, Centocor, Inc., Radnor, PA

5:00 p.m. .50 hr

USPTO Developments in Reexaminations

This session will discuss potential reexamination strategies and recent empirical data.

Cynthia Nessler, United States Patent and Trademark Office, Alexandria, VA

5:30 p.m. Adjourn

FRIDAY MORNING, JANUARY 11, 2008

Presiding Officer:

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

8:00 a.m. Conference Room Opens

Includes continental breakfast.

8:30 a.m. .50 hr

Impact of KSR on Patent Litigation and Prosecution

The implications of the Supreme Court's decision in *KSR* on both patent litigation and prosecution are examined. Particular attention is placed on recent applications of *KSR* by the Federal Circuit and the Board of Patent Appeals and Interferences.

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

9:00 a.m. .50 hr

Remedies and Injunctions after eBay

The U.S. Supreme Court's decision in *eBay Inc. v. MercExchange LLC*, changed the landscape of patent remedies. The presentation will examine *eBay*'s effect on preliminary injunctions, permanent injunctions, and the calculation of damages, including the determination of royalties and the terms of compulsory licenses.

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

9:30 a.m. .75 hr

Damages

This session opens with a discussion of recent developments and issues involving damages, including apportionment, entire market value, and calculation of damages involving provisional patents. The session concludes with a discussion by two valuation experts on the theories and data available to plaintiff and defense counsel in pursuing or defending such claims.

H. Jonathan Redway, Dickinson Wright PLLC, Washington, DC

Commentators:

Rodney J. Bosco, Navigant Consulting, Inc., Washington, DC

Walt Bratic, CRA International, Inc., Houston, TX

10:15 a.m. Break

10:30 a.m. .75 hr

Effective Practice before the ITC

Practicing before the ITC differs in significant ways from the federal courts. We will consider some of these differences and provide some practical guidance for preparing, pursuing and defending cases in the ITC, including a discussion of the resources available in ITC investigations.

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

Steven R. Borgman, Vinson & Elkins L.L.P., Houston, TX

11:15 a.m. 1.00 hr

Options at the District Court including the Eastern District of Texas

In a time of an evolving patent landscape and increased activity in the Supreme Court, legislature and Patent and Trademark Office, a panel of distinguished District Court Judges discuss their experiences with, and thoughts on, managing, hearing and trying patent cases.

Moderator: Katherine Kelly Lutton, Fish & Richardson P.C., Redwood City, CA

Hon. Chad Everingham, United States District Court, Eastern District of Texas, Marshall, TX

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

Hon. Patti B. Saris, United States District Court of Massachusetts, Boston, MA

FRIDAY AFTERNOON

Presiding Officer:

David W. Hill, Finnegan, Henderson, Farabow, Garrett & Dunner, L.L.P., Reston, VA

LUNCHEON PRESENTATION

12:15 p.m. Pick up Box Lunch

Included in conference registration fee.

12:30 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. Paul R. Michel, United States Court of Appeals for the Federal Circuit, Washington, DC

1:15 p.m. Break

1:30 p.m. .75 hr

Indirect Infringement: How to Effectively Litigate a Case of Active Inducement

This session provides some background about the law of active inducement, including a discussion of the most recent Federal Circuit case

law addressing this issue. It will also provide specific advice about how to effectively litigate a claim of active inducement from both the plaintiff's and the defendant's perspective.

H. Keeto Sabharwal, Blank Rome LLP, Washington, DC

2:15 p.m. .75 hr ethics

How to Avoid Disciplinary Action by the USPTO

The various ethical requirements imposed by the PTO Code of Professional Responsibility will be reviewed as they relate to patent prosecution.

Harry Moatz, United States Patent and Trademark Office, Alexandria, VA

3:00 p.m. .75 hr ethics

Electronic Discovery Landmines to Avoid

This session covers key issues under the new rules and key case law developments.

Barry K. Shelton, Fish & Richardson P.C., Austin, TX

3:45 p.m. Adjourn

COMMENTS FROM PAST INSTITUTES

"An excellent conference—well-done!"

"The presenters are really at the top of the field. Great idea to have it at the PTO."

"Excellent coverage of current topics of interest in patent practice. I attended last year's conference, and look forward to next year!"

"One of the best conferences and best group of speakers."

"This has been the best law conference I have ever attended. (I've been registered to practice before the USPTO for 25 years.) Thank you."

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REGISTRATION:

Includes Course Binder and Friday Box Lunch Presentation

- ☐ Early Registration Fee due by Thursday, Jan. 3, 2008 \$595.00
- ☐ Registration Fee after Thursday, Jan. 3, 2008 \$645.00
- ☐ USPTO Special Registration Rate \$250.00
(increases to \$300 after Jan. 3, 2008)

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ALEXANDRIA, VA

January 10-11, 2008
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KEY DATES

Registration & Cancellation

January 3, 2008—5 p.m.

last day for early registration
add \$50 for registrations
received after this time

January 4, 2008—5 p.m.

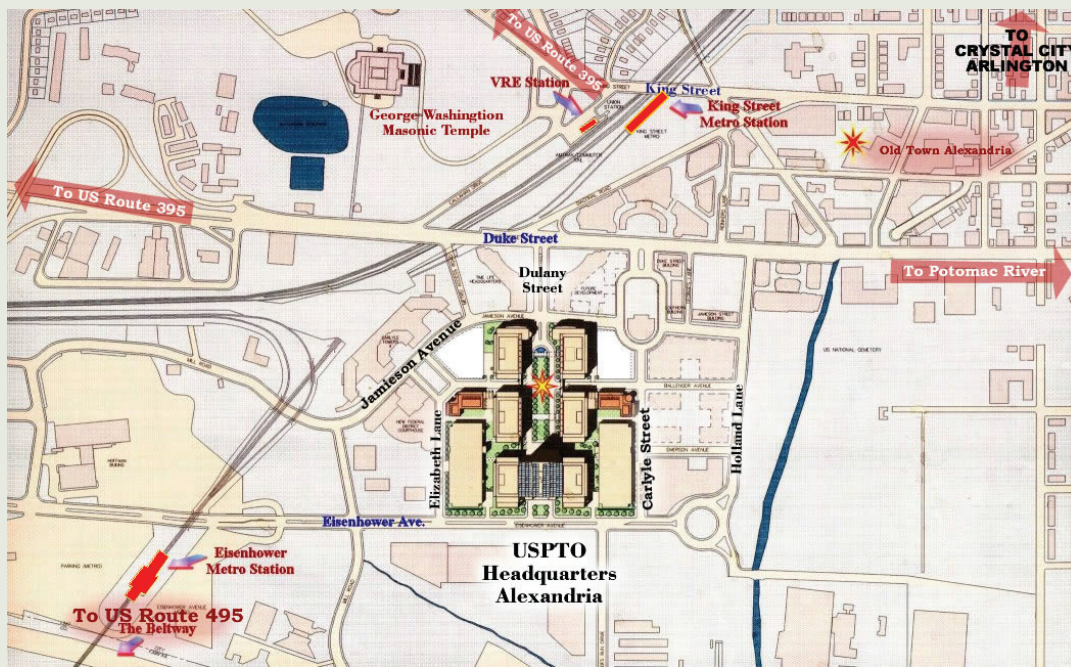
last day for full refund

January 7, 2008—5 p.m.

last day for partial refunds
\$50 processing fee applied

January 10, 2008—9 a.m.

conference begins



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Get both a PTO and practitioner's perspective on the new rules, including strategies on how to best represent your client under the rules.

Opportunities to Hear and Speak with the Judiciary

Don't miss Hon. Paul J. Luckern from the ITC, Hon. Paul Michel of the U.S. Court of Appeals for the Federal Circuit, and a panel discussion by District Court Judges, including Hon. Chad Everingham, Hon. Liam O'Grady, and Hon. Patti B. Saris.

USPTO Officials and Experienced Practitioners

Many presentations pair a USPTO staff member's insider viewpoint with a practitioner's questions and commentary.

Analysis and Tools for Advanced Patent Lawyers

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