

4th Annual Advanced Patent Law Institute - Virginia
November 13-14, 2008 • United States Patent and Trademark Office •
Alexandria, VA, VA

Thursday Morning, Nov. 13, 2008

Presiding Officer:

Samson Vermont, George Mason University School of Law - Arlington, VA

8:00 am	Registration Opens Includes continental breakfast.
8:45 am	Welcoming Remarks
8:50 am 1.00 hr	Disasters in Litigation: What Patent Prosecutors Could Have Done to Prevent the Carnage Ten case histories, with disastrous results for the patentee, will be discussed. In each instance there will be suggestions as to what the patent prosecutor could have done to avoid the bad result. Richard A. Killworth, Dinsmore & Shohl, LLP - Dayton, OH Dale S. Lazar, DLA Piper - Reston, VA
9:50 am 0.75 hr	The Morning After KSR: Examiner and Practitioner Perspectives This session will include an explanation of the USPTO KSR examination guidelines with Technology Center specific examples. Also discussed will be observations on the USPTO practice from a practitioner's perspective. Andrew J. Dillon, Dillon & Yudell LLP - Austin, TX John J. Love, U.S. Patent and Trademark Office - Alexandria, VA
10:35 am	Break
10:50 am 0.50 hr	New USPTO Appeal Rules The new BPAI appeal rules provide new requirements and clarifications that will help to streamline the appeal process and lead to more timely Board decisions. Chief Judge Fleming will provide a step-by-step explanation of the ex parte appeal process under the new rules, from the Notice of Appeal through the Request for Rehearing. Hon. Michael R. Fleming, U.S. Patent and Trademark Office - Alexandria, VA
11:20 am 0.67 hr	Statutory Subject Matter and Section 101 Panelists will discuss recent Federal Circuit and BPAI decisions on patent eligible subject matter as well as USPTO examination guidelines. Raymond T. Chen, U.S. Patent and Trademark Office - Alexandria, VA Bradley D. Lytle, Oblon, Spivak, McClelland, Maier & Nuestadt - Alexandria, VA

Thursday Afternoon, Nov. 13, 2008

Presiding Officer:

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

	LUNCHEON PRESENTATION Sponsored by Feldman Gale
12:00 pm	Pick up Box Lunch
12:15 pm 0.75 hr	Patent Notice Failure Professor Meurer will present evidence that the patent system fails to provide good notice of patent-based property rights. This failing causes patents to actually discourage innovation in most industries. He will sketch out the sort of reforms that are needed to improve notice and mitigate the harm caused by fuzzy patent scope. Michael J. Meurer, Boston University School of Law - Boston, MA
1:00 pm	Break
1:15 pm 0.50 hr ethics	Balancing the Proposed IDS Rules and <i>McKesson v. Bridge</i> Over the Rule 56 Duty of Disclosure. The tension between existing Federal Circuit jurisprudence following <i>McKesson v. Bridge</i> and the PTO's position and proposed IDS Rules will present a significant conundrum and expense for patent applicants and their counsel. The proposed rules will make it nearly impossible to comply with existing disclosure obligations, creating an obstacle course to obtaining and enforcing patent rights. This upcoming problem and its potential ethical implications will be considered, along with various tools that may be capable of cutting some of that tension. Jeffrey A. Wolfson, Haynes and Boone, LLP - Washington, DC
1:45 pm 1.50 hrs	Patent Litigation: Key Issues and Considerations This panel will provide expert advice regarding critical strategic and legal issues which span the life of a patent case. Topics include an analysis of recent case law regarding declaratory judgment actions; key considerations in selecting the proper forum to file your patent case; how to launch a successful obviousness challenge; and how to obtain injunctive relief and maximize your monetary remedies. Moderator: H. Keeto Sabharwal, Blank Rome LLP - Washington, DC Raymond A. Kurz, Hogan & Hartson LLP - Washington, DC Christopher J. Renk, Banner & Witcoff, Ltd. - Chicago, IL
3:15 pm	Break

3:30 pm 0.75 hr	<p>Developments in Claims Construction</p> <p>With apparent claim construction peace declared between the Federal Circuit and the Supreme Court, the Federal Circuit has dug in and potentially opened a new front in its O2 decision. Other old-favorite construction rules and trends have gone off on new loops and tangents as well. These new fronts and trends will be discussed, how to handle them in Markman constructions will be explored, and the new pitfalls and "gotchas" will be flagged.</p> <p>Kenneth R. Adamo, Jones Day - Dallas, TX</p>
4:15 pm 0.75 hr	<p>Remedies at the ITC</p> <p>The Supreme Court's <i>eBay v. MercExchange</i> changed the rules for injunctive relief in U.S. District Court. The ITC may now be an attractive forum for plaintiffs seeking to remove alleged infringers' products from the market. For Section 337 Actions at the ITC, exclusion orders remain available as a post-verdict remedy. This session will focus on remedies available at the ITC, including what is required to present the basis for requesting an exclusion order, the range of breadth of exclusion orders and other issues related to the decision whether filing a 337 Action at the ITC is a preferable alternative in certain circumstances.</p> <p>Wasif Qureshi, Fish & Richardson P.C. - Houston, TX Shirley Webster, CRA International - Houston, TX</p>
5:00 pm 0.50 hr ethics	<p>Understanding Objective Recklessness Under <i>Seagate</i>: Are We There Yet?</p> <p>Over the last year, practitioners have discovered that the Federal Circuit's "objective recklessness" standard for establishing willful infringement is much easier to recite than apply. The <i>Seagate</i> standard has also raised a number of procedural questions that were not necessarily answered or anticipated by the decision. Now armed with the benefit of hindsight, the current application of the two-part <i>Seagate</i> test will be examined, including its evolving relationship to pleading standards, dispositive motion practice, pre- and post-litigation conduct, preliminary injunction results and the continuing role of opinions in ascertaining enhanced damages.</p> <p>Gregory L. Hillyer, Feldman Gale - Bethesda, MD</p>
5:30 pm	<p>Adjourn</p>

Friday Morning, Nov. 14, 2008

Presiding Officer:

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

8:30 am 0.50 hr	<p>Patent Exhaustion in Light of <i>Quanta</i></p> <p>The Supreme Court held in <i>Quanta</i> that the licensed sale of a product exhausts any patents--including method patents--that are practiced by the sold product. Where does this leave patent owners who wish to enforce post-transfer restrictions on the use of patented products? We will grapple with this difficult question.</p> <p>Chris Newman, George Mason University School of Law - Arlington, VA</p>
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9:00 am 1.00 hr	<p>Reexamination and Litigation: A Two-Way Street?</p> <p>A panel discussion examining both how reexamination impacts patent litigation and how patent litigation impacts reexamination.</p> <p>James T. Canfield, Finnegan, Henderson, Farabow, Garrett & Dunner, LLP - Palo Alto, CA Eric Keasel, U.S. Patent and Trademark Office - Alexandria, VA Robert Greene Sterne, Sterne, Kessler, Goldstein & Fox, P.L.L.C. - Washington, DC</p>
10:00 am	Break
10:15 am 1.00 hr 0.25 hr ethics	<p>Judicial Panel</p> <p>A panel of distinguished judges discuss their experiences with, and thoughts on, managing, hearing and trying patent cases.</p> <p>Moderator: Gregory A. Castanias, Jones Day - Washington, DC Hon. Carl Charneski, U.S. International Trade Commission - Washington, DC Hon. Ron Clark, U.S. District Court, Eastern District of Texas - Beaumont, TX Hon. Timothy B. Dyk, U.S. Court of Appeals for the Federal Circuit - Washington, DC</p>
11:15 am 0.75 hr	<p>Antitrust and SSO Developments</p> <p>In light of recent activity by the U.S. antitrust authorities and private litigants, it has become increasingly important for participants in standard setting organizations (SSO's) to understand the potential antitrust risks of their conduct. These experienced practitioners will review the recent developments and provide clear, practical guidance on the "do's and don'ts" of working with an SSO.</p> <p>Robert A. Lipstein, Crowell & Moring LLP - Washington, DC</p>

Friday Afternoon, Nov. 14, 2008

Presiding Officer:

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

	<p>LUNCHEON PRESENTATION</p> <p>Sponsored by Banner & Witcoff, Ltd.</p>
12:00 pm	Pick up Box Lunch
12:15 pm 0.75 hr	<p>The Role of a Judge</p> <p>A discussion of the role of a judge and the state of the court.</p> <p>Hon. Kimberly A. Moore, U.S. Court of Appeals for the Federal Circuit - Washington, DC</p>
	Break

1:15 pm 0.50 hr ethics	<p>Mediation at the Federal Circuit</p> <p>A discussion of the relatively new mandatory Mediation Program at the U.S. Court of Appeals for the Federal Circuit from the Chief Circuit Mediator and his deputy, the Circuit Mediation Officer.</p> <p>James M. Amend, U.S. Court of Appeals for the Federal Circuit - Washington, DC Wendy L. Dean, U.S. Court of Appeals for the Federal Circuit - Washington, DC</p>
1:45 pm 0.33 hr	<p>First Action Interview Pilot Program</p> <p>A discussion of the U.S. Patent and Trademark Office's pilot program which enables certain applicants to receive the results of a prior art search conducted by the examiner, and then interview with the examiner to discuss the prior art before the examiner issues an Office action on the merits.</p> <p>Andrew H. Hirshfeld, U.S. Patent and Trademark Office - Alexandria, VA</p>
2:05 pm 1.00 hr ethics	<p>How to Avoid Disciplinary Action at the USPTO</p> <p>The various ethical requirements imposed by the PTO Code of Professional Responsibility will be reviewed as they relate to patent prosecution.</p> <p>James Silberman, U.S. Patent and Trademark Office - Alexandria, VA</p>
3:05 pm	<p>Adjourn</p>