

5TH ANNUAL ADVANCED PATENT LAW INSTITUTE

A unique series of presentations by senior USPTO officials, leading academics, practitioners, and members of the judiciary.



January 21–22, 2010

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January 21 – 22, 2010 • USPTO – Main Auditorium, Madison Building • Alexandria, Virginia

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THURSDAY MORNING, JAN. 21, 2010

Presiding Officer:

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

8:00 a.m. Registration Opens

Includes continental breakfast.

8:50 a.m. Welcoming Remarks

Hon. James T. Moore, Board of Patent Appeals and
Interferences, U.S. Patent and Trademark Office,
Alexandria, VA

9:00 a.m. .50 hr

Obviousness in the Wake of KSR

The Federal Circuit has decided a number of obviousness appeals since the Supreme Court's *KSR* decision. How has the court interpreted and applied *KSR*? When is "obvious to try" a viable test for obviousness? Has any trend emerged with respect to holding patents in certain technical fields obvious or non-obvious? The presentation examines the impact of *KSR* as reflected in the Court's recent decisions.

Michael J. Flibbert, Finnegan, Henderson, Farabow,
Garrett & Dunner, LLP, Washington, DC

9:30 a.m. 1.00 hr

Strategic Patent Prosecution: How to Draft Winning Patent Claims

Recent case law that impacts the preparation of patent applications, particularly with regard to claim drafting strategies, is discussed. Eight techniques for crafting and drafting the strongest claims possible in scope and validity are presented.

Dale S. Lazar, DLA Piper, Reston, VA

10:30 a.m. Break

10:45 a.m. .75 hr ethics

Inequitable Conduct: Alive, Struggling, Despite Slow Death Attempts... What Happens Next?

Is *Exergen Corp. v. Wal-Mart Stores, Inc.* the stake through inequitable conduct's heart that early commentators claim or hope it proves to be? Or must Congress still finish the job? Should the Federal Circuit stretch further itself? Everyone agrees "fraud on PTO" was and remains bad for

the system. Is that right or simply momentum talking? These issues are vetted and a potentially contrary way forward is discussed.

Kenneth R. Adamo, Jones Day, Dallas, TX

11:30 a.m. .50 hr

Drafting Effective License Provisions: Patent Exhaustion and Patent Pools

In light of the Supreme Court's *Quanta v. LG* decision, is it possible to avoid patent exhaustion when licensing IP? Licensing and patenting approaches are discussed, including the effect of covenants not to sue. In addition, this session looks at patent pools, which typically require the licensors to license all essential patents owned by the licensor. Can this requirement be avoided by transferring the patents to a trust? The issues of using such a patent trust are explored with respect to *MPEG LA v. Multimedia Patent Trust*.

James J. Kulbaski, Oblon, Spivak, McClelland,
Maier & Neustadt, L.L.P., Alexandria, VA
Michael Q. Lee, Sterne, Kessler, Goldstein & Fox
P.L.L.C., Washington, DC

THURSDAY AFTERNOON

Presiding Officer:

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

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**Sterne, Kessler, Goldstein & Fox
P.L.L.C.**

12:00 p.m. Pick up Box Lunch

LUNCHEON PRESENTATION

12:15 p.m. .75 hr

USPTO Update: View from the Director

The new Director of the U.S. Patent and Trademark Office discusses the state of the USPTO and his goals for the agency.

David Kappos, Director, U.S. Patent and Trademark
Office, Alexandria, VA

1:00 p.m. Break

1:15 p.m. 1.00 hr

Patentable Subject Matter and Practice Strategies in the Shadow of *Bilski*

In re Bilski, now on appeal to the Supreme Court, has already sent shockwaves throughout the patent community and may change our fundamental notions of patentable subject matter. The panelists discuss the immediate impact of the Federal Circuit decision, provide predictions for treatment at the Supreme Court, and offer both prosecution and litigation strategies in view of this important case.

Moderator:

Dawn-Marie Bey, King & Spalding, Washington, DC

Panelists:

Stephen G. Kunin, Oblon, Spivak, McClelland, Maier
& Neustadt, Alexandria, VA
Moshe Malina, Citigroup, New York, NY
Eric Saphir, King & Spalding, Washington, DC

2:15 p.m. .50 hr

Section 112, the Written Description Requirement, and *Ariad v. Eli Lilly*

The Federal Circuit has focused significantly on Section 112 defenses as of late, including the en banc review of the written description requirement in *Ariad v. Eli Lilly*. The presentation concentrates on these developments and how they impact patent prosecution and patent litigation.

Christopher A. Cotropia, Intellectual Property Institute,
University of Richmond School of Law, Richmond, VA

2:45 p.m. .50 hr

Let's Do It This Way: Raise Your Hand If You Think You Are NOT an Inventor on This Patent

In today's complex business environment, patent inventorship can have a direct and lasting effect on the financial fitness, competitive superiority and future success of large corporations, small entities, and entrepreneurs. For employees and academics, inventorship can also increase compensation, contribute to career advancement and provide industry recognition. For these reasons, inventorship determinations are often challenging, complicated and contentious. These determinations are evaluated with a particular focus on controlling authority, common misconceptions and considerations of the prior art. Certain complications presented by inter- and intra-company joint inventorship are also explored.

Gregory L. Hillyer, Feldman Gale, Bethesda, MD

3:15 p.m. Break

3:30 p.m. .50 hr ethics

Willfulness after *Seagate*: Tips and Pitfalls for Drafting Opinions

In *re Seagate* removed the affirmative obligation to obtain opinions of counsel, and increased the burden of finding willfulness in a direct patent infringement case. The case did not, however, remove the necessity of obtaining opinions. This session explores issues an opinion addresses, some of the reasons seeking an opinion is still essential, levels of opinion formality, the uses of opinions, and updating opinions.

Jeffrey A. Wolfson, Haynes and Boone, LLP,
Washington, DC

4:00 p.m. 1.00 hr

Reexamination and Concurrent Patent Litigation

A tour of the parallel universe of patent reexamination and concurrent patent litigation in the district courts and the USITC. Hot button topics to be addressed include PTO stats and timelines, the SNQ requirement, request requirements, ex parte interviews, responses to Office Actions and the use of declaration evidence, KSR issues, petition practice, protective orders and the duty of disclosure, stays, use of reexam developments in trial, difference standards between reexams and the courts, and concurrency issues between tribunals.

Moderator:

Robert Greene Sterne, Sterne, Kessler, Goldstein & Fox, P.L.L.C., Washington, DC

Panelists:

Morgan Chu, Irell & Manella LLP, Los Angeles, CA
Hon. Kathleen M. O'Malley, U.S. District Court,
Northern District of Ohio, Cleveland, OH

5:00 p.m. .50 hr

Operations Update and Current USPTO Initiatives

Peggy Focarino, U.S. Patent and Trademark Office,
Alexandria, VA

5:30 p.m. Adjourn

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FRIDAY MORNING, JAN. 22, 2010

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

8:00 a.m. Conference Room Opens

Includes continental breakfast.

8:45 a.m. 1.00 hr ethics

Top 10 Prosecution Ethics Issues

Malpractice and conflict of interest claims based upon patent prosecution are growing in number and severity of settlement. This session addresses ten issues that should be of concern to patent practitioners.

David Hrick, Mercer University School of Law, Macon, GA

9:45 a.m. .50 hr

Design Patent Litigation and Procurement *Post-Egyptian Goddess*

The Federal Circuit's decision to eliminate the "point of novelty" element of design patent infringement proof impacts the way in which design patents now are procured and litigated. This presentation examines design patent procurement and litigation issues *post-Egyptian Goddess*.

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

10:15 a.m. Break

10:30 a.m. .75 hr

State of the Board

The Chief Judge of the Board of Patent Appeals and Interferences provides a review of the prior year's accomplishments, plus a look ahead to the Board's challenges and an action plan to address those challenges.

Hon. Michael R. Fleming, U.S. Patent and Trademark
Office, Alexandria, VA

11:15 a.m. .75 hr

Effective Practice before the Board of Patent Appeals and Interferences

Serial continuations and incremental amendments are a thing of the past in a post-*Festo* world. If you believe an examiner's rejection is not well founded and the technology is important to your client, you need to file an appeal. This presentation addresses effective practice before the Board of Patent Appeals and Interferences, including practice tips and tactics.

Andrew J. Dillon, Dillon & Yudell LLP, Austin, TX
Hon. James T. Moore, U.S. Patent and Trademark
Office, Alexandria, VA

FRIDAY AFTERNOON

Presiding Officer:
John W. Ryan, Sullivan & Worcester LLP,
Washington, DC

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12:00 p.m. Pick up Box Lunch

LUNCHEON PRESENTATION

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. Pauline Newman, U.S. Court of Appeals for the
Federal Circuit, Washington, DC

1:00 p.m. Break

1:15 p.m. 1.00 hr including .25 hr ethics

Judicial Panel

A panel of distinguished judges discuss their experiences with, and thoughts on, managing, hearing and trying patent cases.

Moderator:

William L. LaFuze, Vinson & Elkins LLP, Houston, TX

Panelists:

Hon. Richard Linn, U.S. Court of Appeals for the
Federal Circuit, Washington, DC
Hon. Paul J. Luckern, U.S. International Trade
Commission, Washington, DC
Hon. Liam O'Grady, U.S. District Court, Eastern District
of Virginia, Alexandria, VA

2:15 p.m. .75 hr

Post-Judgment Royalties and Damages Apportionment

A panel of attorneys and valuation experts provides insight into recent trends and developments in IP damages including apportionment and approaches to determining post-judgment royalty rates.

Charles Baker, Fulbright & Jaworski L.L.P., Houston, TX
Rodney J. Bosco, Navigant Consulting, Inc.,
Washington, DC
Shirley Webster, Charles River Associates, Houston, TX

3:00 p.m. .50 hr ethics

Effective Loss Prevention Procedures for IP Counsel

This session addresses the types and sources of malpractice claims that arise most often, and covers procedures that firms are adopting to help avoid claims. It includes suggestions for steps to take if an error is discovered, and how to avoid creating a claim where none exists.

James F. Gottman, Dinsmore & Shohl LLP, Dayton, OH

3:30 p.m. Adjourn



The topics were all timely. Speakers were top notch. The quality of this program far exceeds any I have attended in the past.

The program included a broad range of topics from various backgrounds of sources (i.e., government and law firms). All topics were discussed in depth. Excellent program!

As always, the program is well done with good topics and presenters.

This is the most wide-ranging array of professionals from government, private sector and judiciary.

Great lineup as usual.

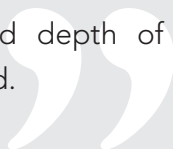
This CLE is always a very nice update of recent developments from the past year, and the focus is good. I appreciate the complexity of analysis.

Topics very up-to-date.

Excellent and timely topics—things I can use in my practice.

The topics were pertinent to the times and of great interest to IP practitioners.

Excellent breadth and depth of subject matter covered.



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Federal Circuit
Washington, DC

HON. PAUL J. LUCKERN
U.S. International Trade
Commission
Washington, DC

MOSHE MALINA
Citigroup
New York, NY

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U.S. Court of Appeals for the
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Washington, DC

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Alexandria, VA

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*planning committee member

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☐ Early Registration Fee due by Monday, January 11, 2010\$625.00

☐ Registration Fee after Monday, January 11, 2010\$675.00

USPTO Employee Registration

☐ Early Registration Fee due by Monday, January 11, 2010\$250.00

☐ Registration Fee after Monday, January 11, 2010\$300.00

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Allow 3–5 weeks from the conference date for delivery.

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ALEXANDRIA, VIRGINIA

January 21–22, 2010

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
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ACCOMMODATIONS

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Special Room Rate: \$219
good through December 29, 2009
(subject to availability)

Parking: \$10/day, \$24/overnight
(subject to change)

KEY DATES

January 11, 2010, 5 p.m.

last day for early registration

add \$50 for registrations received after this time

January 13, 2010, 5 p.m.

last day for full refund

January 15, 2010, 5 p.m.

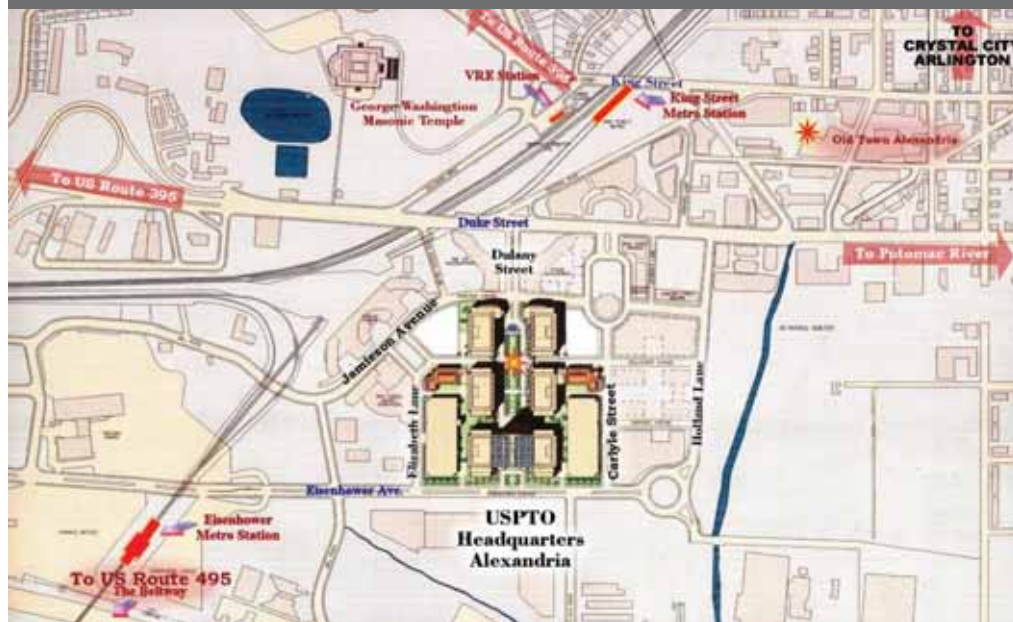
last day for partial refunds

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January 21, 2010, 9 a.m.

Institute begins

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ADVANCED PATENT LAW INSTITUTE IN PALO ALTO, CA



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