

5th Annual Advanced Patent Law Institute - Virginia
January 21-22, 2010 • United States Patent and Trademark Office • Alexandria,
VA, VA

Thursday Morning, Jan. 21, 2010

Presiding Officer:

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

8:00 am	Registration Opens Includes continental breakfast.
8:50 am	Welcoming Remarks Hon. James T. Moore , Board of Patent Appeals and Interferences, U.S. Patent and Trademark Office - Alexandria, VA
9:00 am 0.50 hr	Obviousness in the Wake of KSR The Federal Circuit has decided a number of obviousness appeals since the Supreme Court's <i>KSR</i> decision. How has the court interpreted and applied <i>KSR</i> ? 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 <i>KSR</i> as reflected in the court's recent decisions. Michael J. Flibbert, Finnegan, Henderson, Farabow, Garrett & Dunner, LLP - Washington, DC
9:30 am 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 am	Break
10:45 am 0.75 hr ethics	Inequitable Conduct: Alive, Struggling, Despite Slow Death Attempts...What Happens Next? <i>Is Exergen Corp. v. Wal-Mart Stores, Inc.</i> 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. <i>This session was previously scheduled for 10:45 am Thursday.</i> Kenneth R. Adamo, Jones Day - Cleveland, OH

11:30 am
0.50 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, Jan. 21, 2010

Presiding Officer:

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

LUNCHEON PRESENTATION

Sponsored by Sterne, Kessler, Goldstein & Fox P.L.L.C.

12:00 pm

Pick up Box Lunch

12:15 pm
0.75 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, U.S. Patent and Trademark Office - Alexandria, VA

1:00 pm

Break

1:15 pm
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

Panelists:

Moshe Malina, Citigroup - New York, NY

Panelists:

Eric Saphir, King & Spalding - Washington, DC

2:15 pm 0.50 hr	<p>Section 112, the Written Description Requirement, and <i>Ariad v. Eli Lilly</i></p> <p>The Federal Circuit has focused significantly on Section 112 defenses as of late, including the en banc review of the written description requirement in <i>Ariad v. Eli Lilly</i>. The presentation concentrates on these developments and how they impact patent prosecution and patent litigation.</p> <p>Christopher A. Cotropia, Intellectual Property Institute, University of Richmond School of Law - Richmond, VA</p>
2:45 pm 0.50 hr	<p>Let's Do It This Way: Raise Your Hand If You Think You Are NOT An Inventor on This Patent</p> <p>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.</p> <p>Gregory L. Hillyer, Feldman Gale - Bethesda, MD</p>
3:15 pm	Break
3:30 pm 0.50 hr ethics	<p>Willfulness After <i>Seagate</i>: Tips and Pitfalls for Drafting Opinions</p> <p><i>In re Seagate</i> 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.</p> <p>Jeffrey A. Wolfson, Haynes and Boone, LLP - Washington, DC</p>
4:00 pm 1.00 hr	<p>Reexamination and Concurrent Patent Litigation</p> <p>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, <i>KSR</i> 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.</p> <p>Moderator: Robert Greene Sterne, Sterne, Kessler, Goldstein & Fox, P.L.L.C. - Washington, DC Panelists: Gary N. Frischling, Irell & Manella LLP - Los Angeles, CA Panelists: Hon. Liam O'Grady, U.S. District Court, Eastern District of Virginia - Alexandria, VA</p>
5:00 pm 0.50 hr	<p>Operations Update and Current USPTO Initiatives</p> <p>Peggy Focarino, U.S. Patent and Trademark Office - Alexandria, VA</p>
5:30 pm	Adjourn

Friday Morning, Jan. 22, 2010

Presiding Officer:

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

8:00 am	Conference Room Opens Includes continental breakfast.
8:45 am 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 Hricik, Mercer University School of Law - Macon, GA
9:45 am 0.50 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- <i>Egyptian Goddess</i> . Christopher J. Renk, Banner & Witcoff, Ltd. - Chicago, IL
10:15 am	Break
10:30 am 0.75 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 am 0.75 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- <i>Festo</i> 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. <i>This session was previously scheduled for 11:15am Friday.</i> Andrew J. Dillon, Dillon & Yudell LLP - Austin, TX Hon. James T. Moore, U.S. Patent and Trademark Office - Alexandria, VA

Friday Afternoon, Jan. 22, 2010

Presiding Officer:

John W. Ryan, Sullivan & Worcester LLP - Washington, DC

	LUNCHEON PRESENTATION Sponsored by Banner & Witcoff, Ltd.
12:00 pm	Pick up Box Lunch
12:15 pm 0.75 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 pm	Break
1:15 pm 1.00 hr 0.25 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 Panelists: Hon. Paul J. Luckern, U.S. International Trade Commission - Washington, DC Panelists: Hon. Liam O'Grady, U.S. District Court, Eastern District of Virginia - Alexandria, VA
2:15 pm 0.75 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 S. Baker, Fulbright & Jaworski L.L.P. - Houston, TX Shirley Webster, Charles River Associates - Houston, TX
3:00 pm 0.50 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 pm	Adjourn