

6th Annual Advanced Patent Law Institute - USPTO
January 20-21, 2011 • United States Patent and Trademark Office • Alexandria,
VA, VA

Thursday Morning, Jan. 20, 2011

Presiding Officer:

Andrew H. Hirshfeld, U.S. Patent and Trademark Office - Alexandria, VA

8:00 am	Registration Opens Includes continental breakfast.
8:50 am	Welcoming Remarks
	Prior Art: Where Are We Now?
9:00 am 0.75 hr	Non-Obviousness Post-KSR A discussion of the current state of obviousness law, focusing on the application of <i>KSR</i> by courts and the USPTO, including practical tips discernable from these decisions. Christopher A. Cotropia, Intellectual Property Institute, University of Richmond School of Law - Richmond, VA
9:45 am 0.50 hr	Effective Affidavit Practice Affidavit practice tips to help swear behind references under Rule 131 and to rebut secondary factors of obviousness under Rule 132. The session includes submission of data showing surprising and unexpected results, commercial success and more. The related risks to a resulting patent are also discussed. Jeffrey A. Wolfson, Haynes and Boone, LLP - Washington, DC
10:15 am	Break
10:30 am 0.50 hr ethics	The Ethics of Disclosure and Related Applications after <i>McKesson</i> The USPTO rules force patent practitioners to file and prosecute multiple applications simultaneously to obtain comprehensive patent protection for complex inventions. In <i>McKesson</i> , the Federal Circuit repeated that it is the practitioners' duty to advise each USPTO examiner of the events in co-pending applications, and their failure to do so may render any resulting patents unenforceable, and expose the practitioners to sanctions. E. Robert Yoches, Finnegan, Henderson, Farabow, Garrett & Dunner, LLP - Washington, DC

11:00 am 0.75 hr ethics	<p>Patent Opinion Writing: An Update</p> <p>This session opens with a discussion of recent developments and issues involving patent opinion writing including a discussion on the extent to which <i>Seagate</i> has altered opinion practice. It also explores clearance and pre-drafting strategies, oral and written opinions, and litigation considerations such as privilege waiver and the use of patent opinions at trial.</p> <p>James E. Ledbetter, Dickinson Wright PLLC - Washington, DC H. Jonathan Redway, Dickinson Wright PLLC - Washington, DC</p>
11:45 am 0.75 hr	<p>Examiner Interviews: When, Why and How</p> <p>Interviews with examiners can advance common understanding of an invention, resolve conflicts in interpreting claims and prior art, and efficiently move cases toward allowance, but few practitioners receive training or think strategically about effective interview structure and presentation. This presentation provides tips from both the practitioner and USPTO perspective.</p> <p>Timothy (Tim) Callahan, U.S. Patent and Trademark Office - Alexandria, VA Paul E. Dietze, Attorney at Law - Washington, DC</p>

Thursday Afternoon, Jan. 20, 2011

Presiding Officer:

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

12:30 pm	Pick up Box Lunch
	<p>LUNCHEON PRESENTATION</p> <p>Sponsored by Sterne, Kessler, Goldstein & Fox, P.L.L.C.</p>
12:45 pm 0.75 hr	<p>USPTO Update: View from the Director</p> <p>David Kappos, U.S. Patent and Trademark Office - Alexandria, VA</p>
1:30 pm	Break
1:45 pm 0.50 hr ethics	<p>The Law of Inequitable Conduct after <i>Therasense</i></p> <p>This presentation explores the law of inequitable conduct as it has changed or may change in light of <i>Therasense v. Bayer Healthcare</i>.</p> <p>William L. LaFuze, Vinson & Elkins LLP - Houston, TX</p>
2:15 pm 0.75 hr ethics	<p>Supplemental Examinations to Consider, Reconsider or Correct Information: A Tangled Web, Indeed</p> <p>"Supplemental examinations" would give patent owners a forum for effectively purging the potential taint associated with failing to disclose or misrepresenting information during prosecution. This presentation examines ethics-related implications of supplemental examinations, including potential ethics and discipline-related considerations for practitioners and related implications for the USPTO, the courts and the patent system generally.</p> <p>Lisa A. Dolak, Syracuse University College of Law - Syracuse, NY</p>

3:00 pm	Break
3:15 pm 0.75 hr	<p>Prosecution Issues Post-Bilski</p> <p>The Supreme Court's decision in <i>Bilski v. Kappos</i> holds that <i>per se</i> rules excluding inventions from patentable subject matter—such as the business method exclusion and the machine-or-transformation rule—are inconsistent with the text of section 101 of the Patent Act. Yet <i>Bilski</i> also holds that "abstract ideas" remain excluded from patentable subject matter, and the Court declined to articulate a clear test for deciding whether a claimed invention constitutes an abstract idea. The Court's decision thus puts a premium on attorneys' skills in drafting patent claims that do not cover mere abstractions. This presentation reviews techniques for drafting patentable claims and discusses the underlying legal theories that make certain claim forms more or less likely to survive scrutiny under the Supreme Court's case law and the PTO's new guidelines.</p> <p>Commentator: Caroline Dennison, U.S. Patent and Trademark Office - Alexandria, VA John F. Duffy, George Washington University Law School - Washington, DC</p>
4:00 pm 1.00 hr	<p>Top 10 Practice Tips before the Board of Patent Appeals and Interferences</p> <p>The panel presents and explores tips for improving practice before the Board of Patent Appeals and Interferences. Tips cover both written and oral advocacy, in appeals and contested cases, from both the Board and the practitioner perspectives.</p> <p>Moderator: Hon. Richard L. Torczon Jr., U.S. Patent and Trademark Office - Alexandria, VA Panelists: Andrew J. Dillon, Of Counsel, Dillon & Yudell LLP - Austin, TX Panelists: Hon. Karen M. Hastings, U.S. Patent and Trademark Office - Alexandria, VA Panelists: Hon. Linda E. Horner, U.S. Patent and Trademark Office - Alexandria, VA Panelists: Hon. Terry J. Owens, U.S. Patent and Trademark Office - Alexandria, VA</p>
5:00 pm	Adjourn

Friday Morning, Jan. 21, 2011

Presiding Officer:

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

8:00 am	<p>Conference Room Opens</p> <p>Includes continental breakfast.</p>
8:30 am 0.75 hr	<p>Patent Operations Update and Initiatives</p> <p>This presentation provides a Patent Operations update and a summary of ongoing initiatives at the USPTO.</p> <p>Robert (Bob) Oberleitner, U.S. Patent and Trademark Office - Alexandria, VA</p>

9:15 am 0.75 hr	<p>The Importance of Synchronizing the Scope of Your Claims and the Scope of Your Specification</p> <p>We understand the concept of broad claims versus narrow claims. But when we write broad claims, do we understand the necessity of having a broad specification? This presentation examines how the Federal Circuit has treated patent owners (read: patent practitioners) who haven't grasped the importance of synchronizing the claims and the specification. Application drafting tips that help to ensure that the patent practitioner has achieved synchronism are also discussed.</p> <p>Dale S. Lazar, DLA Piper - Reston, VA</p>
10:00 am 0.50 hr	<p>Functional Claiming and Functional Disclosure</p> <p>Patent drafters sometimes seek to capture broad claim scope by claiming inventions based on the functions that they perform, instead of claiming their structure. This presentation explores potential strategies for and pitfalls of such claiming techniques.</p> <p>Bradley C. Wright, Banner & Witcoff, Ltd. - Washington, DC</p>
10:30 am	<p>Break</p>
10:45 am 1.00 hr	<p>Prosecution, Reexam and Concurrent 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, 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.</p> <p>Moderator: Robert Greene Sterne, Sterne, Kessler, Goldstein & Fox, P.L.L.C. - Washington, DC Panelists: Gregory L. Hillyer, Feldman Gale - Bethesda, MD Panelists: Hon. James M. Rosenbaum, U.S. District Court, District of Minnesota (Retired) - Minneapolis, MN</p>
11:45 am 0.50 hr	<p>Interplay of Markman Hearing Claim Construction and PTO Claim Construction During Reexam and Concurrent Litigation</p> <p>The effects—if any—of ex parte/inter partes reexamination of litigation-based Markman claim construction (and vice versa), including "dos and don'ts" for both patent owners and patent challengers.</p> <p>Kenneth R. Adamo, Jones Day - Dallas, TX Eric Keasel, U.S. Patent and Trademark Office - Alexandria, VA</p>

Friday Afternoon, Jan. 21, 2011

Presiding Officer:

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

12:15 pm	<p>Pick up Box Lunch</p>
	<p>LUNCHEON PRESENTATION</p> <p>Sponsored by Banner & Witcoff, Ltd.</p>

12:30 pm 0.75 hr	Update from the Federal Circuit Hon. Randall R. Rader, U.S. Court of Appeals for the Federal Circuit - Washington, DC
1:15 pm	Break
1:30 pm 1.00 hr	Judicial Panel A panel of distinguished 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 Panelists: Hon. James F. Holderman, U.S. District Court, Northern District of Illinois - Chicago, IL Panelists: Hon. Elizabeth D. Laporte, U.S. District Court, Northern District of California - San Francisco, CA Panelists: Hon. Lee Yeakel, U.S. District Court, Western District of Texas - Austin, TX
2:30 pm 0.75 hr	Recent Trends in Patent Infringement Remedies Recent Federal Circuit decisions require district court judges and litigants to ensure that damage awards fit the economic context and marketplace realities within which the patent and infringing products exist. This session analyzes how remedies are being determined by courts today, offers guidance in view of developments at the Federal Circuit, and predicts a continuing trend of evidence-driven efforts to minimize speculation in damages awards. Erik S. Maurer, Banner & Witcoff, Ltd. - Chicago, IL
3:15 pm	Adjourn