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7TH ANNUAL ADVANCED PATENT LAW

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



January 19–20, 2012

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Special Rules Apply in VA: 11.75 Hours of MCLE Credit including 2.00 Hours of Ethics Credit Pending

THURSDAY MORNING, JAN. 19, 2012

Presiding Officer:

Hon. James Smith, U.S. Patent and Trademark Office, Alexandria, VA

8:00 a.m. Registration Opens

Includes continental breakfast.

8:50 a.m. Welcoming Remarks

Hon. James Smith, Chief Judge, Board of Patent Appeals and Interferences, U.S. Patent and Trademark Office, Alexandria, VA

9:00 a.m. .75 hr

Patentable Subject Matter in 2012: Where Are We?

The panel discusses the current state of the law in light of recent case precedent.

Gregory A. Castanias, Jones Day, Washington, DC
Raymond T. Chen, U.S. Patent and Trademark Office, Alexandria, VA

9:45 a.m. .75 hr

Developments in Claim Construction

Despite marked changes in other areas of IP law driven by the Federal Circuit and the Court, and the onset of the leadership and personnel shift on the Federal Circuit bench, the Copernican centrality of claim construction to preparation, prosecution and litigation remains seemingly unchallengeable. The state of play, whether attempts have been made to move off *Phillips* or simply to focus and refine, is addressed, discussed and queried.

Kenneth R. Adamo, Kirkland & Ellis LLP, Chicago, IL

10:30 a.m. Break

10:45 a.m. .75 hr

Claims Drafting Practice Tips: Recent Examiner Training Topics and Avoiding Practitioner Pitfalls

The USPTO recently conducted examiner training to highlight certain areas of concern relating to indefinite claim language. These areas are reviewed with an emphasis on what examiners have been instructed to look for when analyzing claims for definiteness, and what it then means for practitioners.

Caroline Dennison, U.S. Patent and Trademark Office, Alexandria, VA
Luke K. Pedersen, Baker Botts L.L.P., Washington, DC

11:30 a.m. .75 hr

Synchronizing Specification and Claims for Strong (Valid) Patents

The inventor creates the invention. But who creates the claims? The inventor? The patent practitioner? Implicit in Federal Circuit decisions is that the Court is more confident that the inventor created the described embodiments/examples than the claims. If the claims reach too far beyond the disclosed embodiments/examples, the claims are often construed more narrowly than the ordinary meaning of the claims would suggest, or the claims are held invalid for lack of written description support. This session discusses what needs to be done with patent specifications so that broad claims are interpreted broadly and found to be valid.

Dale S. Lazar, DLA Piper, Reston, VA

12:15 p.m. Break for Lunch

Included in conference registration fee.

THURSDAY AFTERNOON

Presiding Officer:

Adam Mossoff, George Mason University School of Law, Arlington, VA

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KEYNOTE LUNCHEON PRESENTATION

12:35 p.m. .67 hr

USPTO Update: View from the Director

David Kappos (Invited), Under Secretary of Commerce for Intellectual Property and Director, U.S. Patent and Trademark Office, Alexandria, VA

1:15 p.m. Break

1:30 p.m. .75 hr

IP Development in China: Practical Issues and Strategic Significance

China is a mega-trend altogether—not just in IP—but the strategic significance of China as an IP trend is overriding and it informs the future of IP altogether. This panel discusses practical issues concerning IP development and enforcement in China and the larger strategic significance of Chinese IP altogether. In particular, the panel discusses the Silicon Valley perspective and the question of whether California is becoming the East Coast of Asia.

Christopher J. Byrne, Tessera Technologies, San Jose, CA
Hoo-min D. Toong, IPVision, Silicon Valley, USA

2:15 p.m. .75 hr

Strategic Use of Design Patents

This presentation covers three distinct, but related, topics in design patent law: (1) the overlap between design patents and utility patents, i.e., how design patents can be used to protect functional features of products and how utility patents can be used to protect ornamental features; (2) an update on the aftermath of the Federal Circuit's landmark *Egyptian Goddess* design patent infringement decision; and (3) tips on how to use design patents effectively in a modern design enforcement program.

Perry Saidman, Saidman DesignLaw Group, LLC, Silver Spring, MD

3:00 p.m. Break

3:15 p.m. .75 hr

Joint Infringement

In two pending *en banc* Federal Circuit cases, the Court is grappling with the scope of joint/divided infringement: "If separate entities each perform separate steps of a method claim, under what circumstances would the claim be directly infringed...?" This presentation examines the prosecution and litigation strategies for dealing with joint/divided infringement issues.

Moderator:

John W. Ryan, Thompson Hine LLP, Washington, DC

Panelists:

Phillip B. Philbin, Haynes and Boone, LLP, Dallas, TX
Hans Sauer, Biotechnology Industry Organization, Washington, DC

4:00 p.m. .75 hr

Damages and Injunctive Relief: Remedies from a Prosecution Perspective

A discussion of how to write specifications and draft claims with an eye toward maximizing damages and obtaining injunctive relief in patent litigation. Topics include identifying base inventive concepts and drafting claims of varying scope.

James M. Heintz, DLA Piper, Reston, VA

4:45 p.m. .75 hr ethics

Ethics in a Post-Issue Review World

The America Invents Act creates many new types of post-issuance review. Each procedure has different deadlines, allows challenges based on different grounds, and creates different preclusion consequences for unsuccessful petitioners (and for the "real party in interest" or "privy" of a petitioner). Practitioners will need to consider their duties of care and diligence in advising their clients, as well as their duties to the PTO, when invoking these new procedures.

Ragesh K. Tangri, Durie Tangri LLP, San Francisco, CA

5:30 p.m. Adjourn

FRIDAY MORNING, JAN. 20, 2012

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.

PATENT REFORM: 2012 GUIDE FOR PRACTITIONERS

8:15 a.m. .50 hr

An Overview of the Prosecution and Litigation Landscape after Patent Reform

The America Invents Act is one of the most major patent reforms since 1952. This presentation provides an overview of the Act, focusing on the big changes patent prosecutors and patent litigators should know.

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

8:45 a.m. .75 hr

New Rules Packages: The USPTO's Implementation of the America Invents Act

USPTO officials discuss the agency's implementation of various provisions of the America Invents Act, including proposed rules related to supplemental examination, third-party submission of prior art, post-grant review, and inter partes review.

Robert Bahr, U.S. Patent and Trademark Office, Alexandria, VA
Janet Gongola, U.S. Patent and Trademark Office, Alexandria, VA
Hon. Michael Tierney, U.S. Patent and Trademark Office, Alexandria, VA

9:30 a.m. 1.00 hr

The Corporate Response to New Legislation: Changes in Portfolio Development and Patent Defense Strategies

The panel discusses how corporations are adjusting their portfolio development and patent defense strategies in response to the new legislation. Topics include internal education and modifications to in-house procedures; new filing and claiming techniques, including practical advice on how to effectively practice under the proposed rules; maximizing availability of new defenses to infringement; proactive use of post-grant review proceedings; litigation changes; and continued reform through rule-making, industry collaboration, and ongoing AIA studies.

Moderator:

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

Panelists:

Jeffrey D. Feldman, Feldman Gale, Miami, FL
Stephen G. Kunin, Oblon, Spivak, McClelland, Maier & Neustadt, LLP, Alexandria, VA
David L. Marcus, Comcast Cable Communications, LLC, Philadelphia, PA
Bradley C. Wright, Banner & Witcoff, Ltd., Washington, DC

10:30 a.m. Break

10:45 a.m. .83 hr

Reexam and Its Impact on Enforcement, Monetization and Valuation of Patents

Current inter partes and ex parte reexamination and the soon to be instituted post grant review, inter partes review, pre-issuance submissions, supplemental examination and derivations proceedings at the USPTO are having or will have a profound impact on U.S. patents. These proceedings and the interface with the Federal Courts and the USITC are reviewed.

Moderator:

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

Panelists:

James W. Morando, Farella Braun + Martel, LLP, San Francisco, CA
Hon. James Smith, U.S. Patent and Trademark Office, Alexandria, VA

11:35 a.m. .75 hr

Processes and Trends at the U.S. Supreme Court

This presentation discusses the Supreme Court's increased willingness to take on patent-related cases and what seems to be of interest to the Court.

Seth P. Waxman, Wilmer Cutler Pickering Hale and Dorr LLP, Washington, DC

12:20 p.m. Break for Lunch

Included in conference registration fee.

FRIDAY AFTERNOON

Presiding Officer:

John W. Ryan, Thompson Hine LLP, Washington, DC

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KEYNOTE LUNCHEON PRESENTATION

12:40 p.m. .67 hr

Update from the Federal Circuit

Hon. Timothy B. Dyk, U.S. Court of Appeals for the Federal Circuit, Washington, DC

1:20 p.m. Break

1:30 p.m. 1.00 hr

Judicial Panel

A panel of distinguished judges from both the District Court and ITC discuss their experiences hearing and trying patent cases, highlighting some of the similarities and differences in patent litigation practice between the two venues.

Moderator:

Raymond A. Kurz, Hogan & Hartson LLP, Washington, DC

Panelists:

Hon. Garrett E. Brown, U.S. District Court, District of New Jersey, Trenton, NJ
Hon. Theodore Essex, U.S. International Trade Commission, Washington, DC
Additional Judge TBD

2:30 p.m. 1.25 hrs ethics

Prosecution Ethics: *Therasense* Helped Some

This session explores the impact of *Therasense* on disclosure obligations at the PTO and litigation of inequitable conduct defenses. In addition, the session describes ethical and liability issues that persist in prosecution practice.

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

3:45 p.m. Adjourn

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- ☐ Early Registration Fee due by Monday, January 9, 2012 \$645
☐ Registration Fee after Monday, January 9, 2012 \$695

USPTO Employee Registration

- ☐ Early Registration Fee due by Monday, January 9, 2012 \$250
☐ Registration Fee after Monday, January 9, 2012 \$300

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

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January 19–20, 2012

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Concourse Level of the Madison Building
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Alexandria, VA 22313-1450

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KEY DATES

January 9, 2012, 5 p.m.

last day for early registration

add \$50 for registrations received after this time

January 11, 2012, 5 p.m.

last day for full refund

January 13, 2012, 5 p.m.

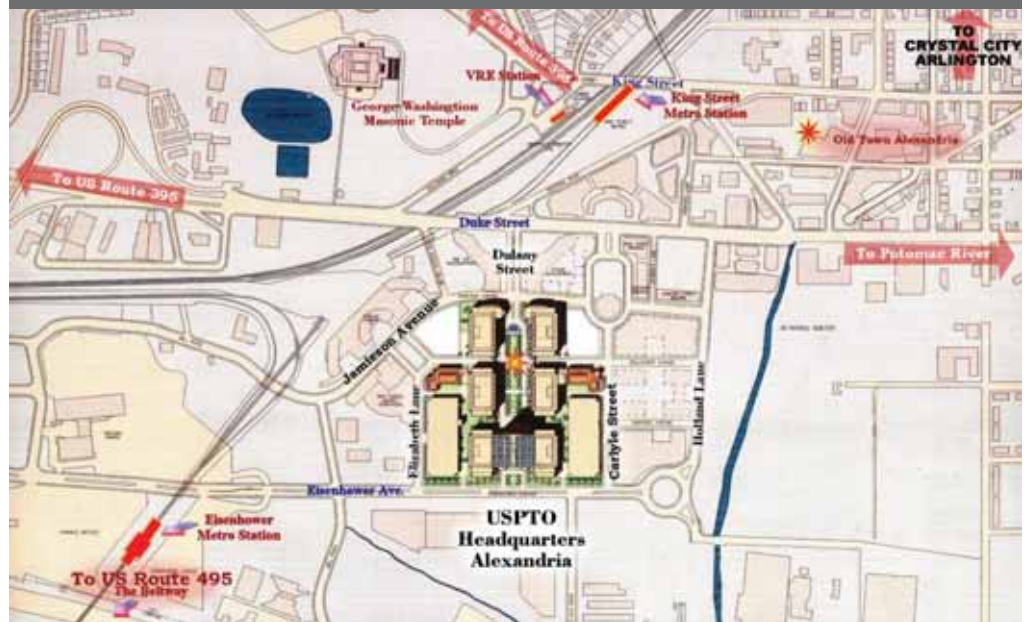
last day for partial refund

\$50 processing fee applied

January 19, 2012, 9 a.m.

Institute begins

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December 8–9, 2011

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