

8th Annual Advanced Patent Law Institute
January 24-25, 2013 • United States Patent and Trademark Office • Alexandria,
VA, VA

Thursday Morning, Jan. 24, 2013

Presiding Officer:

Hon. James Smith, Chief Judge, Patent Trial and Appeal Board, U.S. Patent and Trademark Office - Alexandria, VA

7:30 am	<p>Registration Opens</p> <p>Includes continental breakfast.</p>
8:20 am	<p>Welcoming Remarks</p> <p>Hon. James Smith, Chief Judge, Patent Trial and Appeal Board, U.S. Patent and Trademark Office, Alexandria, VA</p>
8:30 am 1.00 hr	<p>Patentable Subject Matter</p> <p>Can you patent that? A discussion of the patent-eligibility of business methods, personalized medicine and DNA under 35 USC 101, through a review of recent Supreme Court and Federal Circuit decisions (<i>Bilski</i>, <i>Mayo v. Prometheus</i>, <i>Myriad</i>) and USPTO guidelines.</p> <p>Courtenay C. Brinckerhoff, Foley & Lardner LLP - Washington, DC James M. Heintz, DLA Piper - Reston, VA Thomas W. Krause, U.S. Patent and Trademark Office - Arlington, VA</p>
9:30 am 1.00 hr	<p>Prosecution Strategies Around the First-to-Invent Transition</p> <p>The AIA creates a first inventor to file system, more akin to the patent systems of the rest of the world. A review of the new law of first inventor to file and the supporting USPTO rules. The discussion includes practitioner strategies under the new system, including the "new" one year grace period and the dangers associated with relying on it.</p> <p>Robert Bahr, U.S. Patent and Trademark Office - Alexandria, VA Dale S. Lazar, DLA Piper - Reston, VA Adam Mossoff, George Mason University School of Law - Arlington, VA</p>
10:30 am	<p>Break</p>
10:45 am 0.50 hr	<p>Post-Grant Procedures Progress to Date</p> <p>A look at the post-grant review provision of the AIA that went into effect on September 16 and results to date, including the impact of the new requirements compared to provisions already in place, numbers of petitions filed and issues both anticipated and observed.</p> <p>Hon. James T. Moore, U.S. Patent and Trademark Office - Alexandria, VA Hon. Michael Tierney, U.S. Patent and Trademark Office - Alexandria, VA</p>

<p>11:15 am 1.00 hr</p>	<p>Post-Grant Patentability Review in the PTO: The New Landscape Ahead</p> <p>A look at post-grant review strategies under the AIA and their relationship to parallel U.S. District Court and Federal Circuit proceedings. The discussion focuses on the new AIA contested programs: post-grant review, inter partes review and transitional review for covered business method patents. Post AIA reexamination practice including supplemental examination, ex parte reexamination and legacy inter partes reexamination proceedings is also discussed. The panel addresses the procedural and substantive differences among these programs, their potential risks and rewards and their implementation and administration in the USPTO before the new Patent Trial and Appeal Board (PTAB), the Central Reexamination Unit and the Office of Patent Legal Administration.</p> <p>Moderator: Jeffrey D. Feldman, Feldman Gale, P.A. - Miami, FL</p> <p>Panelists: Nathan Kelley, U.S. Patent and Trademark Office - Alexandria, VA</p> <p>Panelists: Hon. Paul R. Michel, United States Court of Appeals for the Federal Circuit - Washington, DC</p> <p>Panelists: Robert Greene Sterne, Sterne, Kessler, Goldstein & Fox - Washington, DC</p>
<p>12:15 pm</p>	<p>Pick Up Lunch</p> <p>Included in conference registration fee.</p>

Thursday Afternoon, Jan. 24, 2013

Presiding Officer:

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

	<p>KEYNOTE LUNCHEON PRESENTATION</p>
<p>12:35 pm 0.75 hr</p>	<p>USPTO Update</p> <p>Teresa Stanek Rea, U.S. Patent and Trademark Office - Alexandria, VA</p>
<p>1:20 pm</p>	<p>Break</p>
<p>1:30 pm 0.50 hr</p>	<p>Claims Construction Standards</p> <p>Claims construction is a key component of any patent proceeding. The increased focus on the new post grant proceedings of the Patent Trial and Appeal Board has placed an even greater emphasis on the interplay between district court claims construction practices and the broadest reasonable claim interpretation (BRI) methodologies of the USPTO. An exploration of the differences between these standards.</p> <p>Stephen G. Kunin, Oblon, Spivak, McClelland, Maier & Neustadt, LLP - Alexandria, VA</p>
<p>2:00 pm 0.75 hr ethics</p>	<p>Inequitable Conduct</p> <p>A look at the new standards for proving inequitable conduct with a focus on whether supplemental examination should be used in light of the impact of <i>Therasense</i> or if there are other less-costly approaches to take.</p> <p>Stephen G. Kunin, Oblon, Spivak, McClelland, Maier & Neustadt, LLP - Alexandria, VA</p>

2:45 pm	Break
3:00 pm 1.00 hr	<p>Litigation Strategies after the AIA</p> <p>A review of the impact of the AIA on patent litigation and the new opportunities and strategies emerging for both patent owners and challengers. Learn about the latest tactical developments in multidefendant litigation in view of joinder restrictions, the expansion of defenses based on prior commercial use and new definitions of prior art, restrictions on evidence of willfulness, options for patent owners using supplemental examination and expedited prosecution, the use of parallel PTAB proceedings to contest validity and overall case management considerations involving the interplay between PTAB, district court and ITC proceedings.</p> <p>Moderator: David L. McCombs, Haynes and Boone, LLP - Dallas, TX</p> <p>Panelists: Jared Bobrow, Weil, Gotshal & Manges LLP - Redwood City, CA</p> <p>Panelists: Ronald E. Cahill, Nutter McClennen & Fish LLP - Boston, MA</p> <p>Panelists: Matthew C. Gaudet, Duane Morris LLP - Atlanta, GA</p>
4:00 pm 0.50 hr	<p>Experimental Use Exception</p> <p>A look at whether there is still a viable exception for experimental use in U.S. patent law. How will or should courts interpret the AIA's failure to specifically enumerate an experimental use exception with the other exceptions in new Section 102? Isn't such an experimental use "otherwise available to the public"?</p> <p>Philip G. Hampton II, Haynes and Boone, LLP - Washington, DC</p>
4:30 pm 0.50 hr	<p>Willful Infringement—An Evolving Test</p> <p>A look at the development of the law of willful infringement in the aftermath of <i>Seagate Technologies</i>, including <i>Bard Peripheral Vascular Inc. v. W.L. Gore Assoc Inc.</i> and <i>Spectralytics, Inc. v Cordis Corp.</i>, with statistics on the frequency of willfulness findings.</p> <p>Jennifer Librach Nall, Vinson & Elkins LLP - Austin, TX</p>
5:00 pm	Adjourn

Friday Morning, Jan. 25, 2013

Presiding Officer:

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

7:30 am	<p>Conference Room Opens</p> <p>Includes continental breakfast.</p>
8:00 am 0.50 hr	<p>Current USPTO Programs and Procedures</p> <p>An overview and explanation of current programs and initiatives at the USPTO, such as the Patent Prosecution Highway and the Ombudsman Program, and how these programs are designed to assist applicants in the patent examination process.</p> <p>Brian E. Hanlon, U.S. Patent and Trademark Office - Alexandria, VA</p>

<p>8:30 am 0.50 hr</p>	<p>Reissue: Practice Highlights and Recent Developments</p> <p>A discussion of reissue highlights, including changes to reissue in view of the AIA, noting any reissue exceptions to AIA implementation, with an overview of some recent developments in reissue case law.</p> <p>Kenneth Schor, U.S. Patent and Trademark Office - Alexandria, VA</p>
<p>9:00 am 0.50 hr</p>	<p>Preissuance Submissions Under 37 CFR 1.290: USPTO Final Rule and Practitioner Perspective</p> <p>A look at the USPTO's rule on third-party preissuance submissions and a practitioner's guide to the possible pros and cons of using such submissions.</p> <p>Nicole D. Haines, U.S. Patent and Trademark Office - Alexandria, VA Sung Kim, Microsoft Corporation - Washington, DC Joseph G. Piccolo, U.S. Patent and Trademark Office - Alexandria, VA</p>
<p>9:30 am 0.75 hr</p>	<p>Modernizing Section 337 Investigations</p> <p>A review and analysis of many new developments and recent rule changes, as well as the ITC's approach to non-practicing entities (NPEs), the enhanced focus on the public interest and the extraterritorial reach of trade secret protection.</p> <p>Hon. Robert K. Rogers Jr., U.S. International Trade Commission - Washington, DC Tom M. Schaumberg, Adduci, Mastriani & Schaumberg, LLP - Washington, DC</p>
<p>10:15 am</p>	<p>Break</p>
<p>10:30 am 0.50 hr</p>	<p>Strategic Use of Standard Essential Patents—Antitrust Agency and Judicial Reaction</p> <p>A discussion of recent FTC/DOJ views and investigations, including those recently expressed in the context of ITC proceedings that sought exclusion orders to ban imports of products that infringe on RAND-encumbered SEPs. The presentation includes an overview of recent litigations involving claims for injunctions based on infringement of SEPs.</p> <p>John E. Scribner, Weil, Gotshal & Manges LLP - Washington, DC</p>
<p>11:00 am 0.75 hr</p>	<p>Damages and Remedies</p> <p>The patent litigation remedies landscape has been in a rapid state of change since the Supreme Court's 2006 decision in <i>Ebay v. Merc Exchange</i>. A discussion of the current state of the landscape, including the impact of the Federal Circuit's remedies jurisprudence on pre-trial and post-trial damages theories, proofs and case management issues.</p> <p>Moderator: Christopher J. Renk, Banner & Witcoff, Ltd. - Chicago, IL Panelists: Brian M. Fogarty, Nike, Inc. - Beaverton, OR Panelists: Paul K. Meyer, TM Financial Forensics, LLC - San Francisco, CA</p>
<p>11:45 am 0.50 hr</p>	<p>International Patent Litigation Strategies and Forum Shopping</p> <p>Where to win based on the new age of data metrics and how to value your patent infringement claim in any country.</p> <p>Michael C. Elmer, Finnegan, Henderson, Farabow, Garrett & Dunner, LLP - Palo Alto, CA</p>

12:15 pm

Pick Up Lunch

Included in conference registration fee.

Friday Afternoon, Jan. 25, 2013

Presiding Officer:

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

KEYNOTE LUNCHEON PRESENTATION

12:35 pm
0.75 hr

Update from the Federal Circuit

Hon. Kathleen M. O'Malley, U.S. Court of Appeals for the Federal Circuit - Washington, DC

1:20 pm

Break

1:30 pm
1.00 hr

Judicial Panel

Distinguished District Court and ITC judges discuss their experiences hearing and trying patent cases, noting similarities and differences between the venues, and examine the status and results of the Pilot Program.

Moderator:

Donald R. Dunner, Finnegan, Henderson, Farabow, Garrett & Dunner, LLP - Washington, DC

Panelists:

Hon. Theodore Essex, U.S. International Trade Commission - Washington, DC

Panelists:

Hon. Faith S. Hochberg, U.S. District Court, District of New Jersey - Newark, NJ

Panelists:

Hon. Liam O'Grady, U.S. District Court, Eastern District of Virginia - Alexandria, VA

Panelists:

Hon. T. John Ward, U.S. District Court, Eastern District of Texas, Ward & Smith Law Firm - Longview, TX

2:30 pm
1.25 hrs ethics

Prosecution Ethics Issues

It is unethical for a firm to be adverse to a current client of the firm. An examination of what "adversity" means in patent practice, from the easy case of suing a current client to the thorny issues in litigation, opinion work and patent prosecution.

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

3:45 pm

Adjourn