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9TH ANNUAL
**ADVANCED PATENT LAW
INSTITUTE**



January 23–24, 2014
United States Patent and Trademark Office
Alexandria, Virginia

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THURSDAY MORNING, JAN. 23, 2014

Presiding Officer:

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

7:30 a.m. Registration Opens

Includes continental breakfast.

8:15 a.m. Welcoming Remarks

8:30 a.m. .50 hr

**Patentable Subject Matter:
Life Sciences**

Review of the Supreme Court decisions, *Mayo v. Prometheus* and *Association for Molecular Pathology v. Myriad Genetics*; plus related Federal Circuit Court decisions and USPTO guidance on the patent eligibility of biotech and personalized medicine inventions.

Courtenay C. Brinckerhoff, Foley & Lardner LLP,
Washington, DC

9:00 a.m. .50 hr

**Patentable Subject Matter:
Software and Business Methods**

Discussion of the patent-eligibility of software and business methods, with analysis of *CLS Bank v. Alice Corporation* and other recent decisions.

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

9:30 a.m. .75 hr

Functional Claiming

Patent attorneys sometimes broadly claim inventions in terms of the functions that they perform, rather than reciting detailed structural features. This can lead to problems during the patent application process or later in litigation. The USPTO has recently provided additional training to patent examiners providing guidance in this area.

Andrew H. Hirshfeld, Deputy Commissioner for
Patent Examination Policy, U.S. Patent and
Trademark Office, Alexandria, VA
Bradley C. Wright, Banner & Witcoff, Ltd.,
Washington, DC

10:15 a.m. Break

10:30 a.m. .50 hr

**ITC Developments:
Standards-Essential Patents and the
Domestic Industry Requirement**

The United States Trade Representative's recommendations concerning the ITC exclusion orders issued against Apple and Samsung, as well as recent developments in the application of the ITC's domestic industry requirement as it relates to patent assertion and NPEs.

Lore Unt, Office of the Solicitor, U.S. Patent and
Trademark Office, Alexandria, VA
T. Cy Walker, Kenyon & Kenyon, Washington, DC

11:00 a.m. .50 hr

**Antitrust and FRAND Patents:
Development and Current Issues**

A focus on Judge Robart's analysis of factors in evaluating rate setting in FRAND cases, the recent GAO report on Standard Setting Organizations and the availability of injunctive relief in cases involving standard essential patents.

Robert L. Stoll, Drinker Biddle & Reath LLP,
Washington, DC

11:30 a.m. .50 hr

The New Landscape for Design Patents

Examination of the new landscape that is taking shape in the field of U.S. design patent law, including new matter/written description in light of *In re Owens*, obviousness and functionality in light of *High Point Design v. Buyers Direct*, and post-grant proceedings and claim construction in view of *ATAS International v. Centria*. Also, a look at recent international developments and the implications of the U.S. moving closer to officially being a member of the Hague system.

Tracy-Gene G. Durkin, Sterne, Kessler,
Goldstein & Fox P.L.L.C., Washington, DC
David Gerk, Office of Policy and International Affairs,
U.S. Patent and Trademark Office, Alexandria, VA

12:00 p.m. .50 hr

Patent Law Treaty Implementation

In December 2013, the U.S. becomes a party to the Patent Law Treaty (PLT), which harmonizes and streamlines formal procedural requirements pertaining to the filing and processing of patent applications. Review the changes to the patent law and USPTO's rules of practice that were made in accordance with the U.S. becoming a party to the PLT.

Matthew J. Kohner, Office of External Affairs,
U.S. Patent and Trademark Office, Alexandria, VA

12:30 p.m. Pick Up Lunch
Included in registration.

THURSDAY AFTERNOON

Presiding Officer:

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

KEYNOTE LUNCHEON PRESENTATION

12:50 p.m. .50 hr

USPTO Update

Margaret A. "Peggy" Focarino, Acting Deputy Under
Secretary of Commerce for Intellectual Property
and Deputy Director of the USPTO,
Alexandria, VA

1:20 p.m. Break

1:30 p.m. 1.00 hr

**First-Inventor-To-File:
Problems, Ambiguities and Practical Solutions**

The new Section 102 is shorter if not simpler than the former establishment, though not without subtleties and ambiguities that can be a trap for the unwary. The USPTO's interpretation of the new Section 102 is presented, along with alternative interpretations and practical solutions for practitioners for addressing the problems and ambiguities.

Moderator:

Dale S. Lazar, DLA Piper LLP US, Reston, VA

Panelists:

Kathleen Fonda, Office of Patent Legal Administration,
U.S. Patent and Trademark Office, VA
Brad D. Pedersen, Patterson Thunete Pedersen, P.A.,
Minneapolis, MN

2:30 p.m. .50 hr

Obviousness

This presentation aims to reaffirm the importance of evaluating objective evidence in the obviousness analysis. Objective evidence of nonobviousness is too often treated as 'secondary considerations.'

Michael W. O'Neill, Novak Druce Connolly Bove &
Quigg LLP, Washington, DC

3:00 p.m. Break

3:15 p.m. .75 hr

Divided Infringement after *Akamai*

Discussion of the *Akamai* decision and how it impacts litigation strategy.

Gianni Minutoli, DLA Piper LLP US, Washington, DC
Phillip B. Philbin, Haynes and Boone, LLP, Dallas, TX

4:00 p.m. .75 hr

Patent Damages Today—but What about Tomorrow?

Review of recent Federal Circuit Court decisions providing guidance on acceptable patent damages methodology, with highlights of District Court orders giving insight into the continuing evolution of patent damages.

Shirley Webster, Ocean Tomo, LLC, Houston, TX
Gregory L. Hillyer, Feldman Gale, P.A., Philadelphia, PA

4:45 p.m. .75 hr

Issues with Patent NPEs

Is there a problem with NPEs in patent litigation? If so, what are alternative possible solutions? A discussion of the economic consequences of the proliferation of NPE litigation in recent years, the pros and cons of proposed patent legislation, rule and case management changes involving fee-shifting, pleading requirements, disclosure of real parties in interest and other issues.

Moderator:

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

Panelists:

Donald R. Dunner, Finnegan, Henderson, Farabow, Garrett & Dunner, LLP, Washington, DC
Philip S. Johnson, Johnson & Johnson, New Brunswick, NJ
Phyllis Turner-Brim, Intellectual Ventures, Bellevue, WA

5:30 p.m. Adjourn

FRIDAY MORNING, JAN. 24, 2014

Presiding Officer:

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

7:30 a.m. Conference Room Opens

Includes continental breakfast.

8:30 a.m. .75 hr

AIA Practice Tips before the Patent Trial and Appeal Board

Tips for improving practice in AIA cases before the Patent Trial and Appeal Board are presented and explored. Tips address both written and oral advocacy, from both the Board and the practitioner perspectives.

Moderator:

Hon. Scott Boalick, Patent Trial and Appeal Board, U.S. Patent and Trademark Office, Alexandria, VA

Panelists:

Hon. Jennifer Bisk, Patent Trial and Appeal Board, U.S. Patent and Trademark Office, Alexandria, VA
Hon. Thomas L. Giannetti, Patent Trial and Appeal Board, U.S. Patent and Trademark Office, Alexandria, VA

9:15 a.m. 1.00 hr

Post-Grant Proceedings, Strategies and Practice

Post-grant patent proceedings were pursued in record number at the USPTO in 2013 and the rate of new petition filings continues to accelerate beyond initial expectations. Emerging trends, notable outcomes, and best practices are identified relative to the 700+ proceedings filed with the PTAB. Both petitioner and patentee perspectives are analyzed relative to current and future USPTO practices, including contemplated legislative and/or rule based developments.

Scott A. McKeown, Oblon, Spivak, McClelland, Maier & Neustadt, L.L.P., Alexandria, VA
Robert Greene Sterne, Sterne, Kessler, Goldstein & Fox P.L.L.C., Washington, DC

10:15 a.m. Break

10:30 a.m. 1.00 hr | 1.00 hr ethics

Harmonization and Enforcement of USPTO Ethical Standards in the AIA Era

Present day ethical issues affecting attorneys and agents who practice before the USPTO, including ethical standards under the Proposed New USPTO Rules of Professional Conduct, modeled on the ABA's Model; the mechanics of OED's complaint and investigative process; the ethical impact of the AIA on practitioners and OED; and the practical examples and statistics relating to OED enforcement.

William R. Covey, Deputy General Counsel and Director, Office of Enrollment and Discipline, U.S. Patent and Trademark Office, Alexandria, VA

11:30 a.m. .75 hr

Claims Construction

Lighting Ballast and *de novo* review (and how it changes strategies) and broadest reasonable construction standard.

Edward R. Reines, Weil, Gotshal & Manges LLP, Redwood City, CA
Nathan Kelley, Office of the Solicitor, U.S. Patent and Trademark Office, Alexandria, VA

12:15 p.m. .50 hr

Ex Parte Reexam in View of *Fresenius*—A Hail Mary Pass Which Should Be in Every Playbook

Due to typically lengthy District Court litigation, accused patent infringers may file an *ex parte* reexamination request as a final opportunity to cancel the claims of an asserted patent. The AIA replaced the much maligned *inter partes* reexamination with a more streamlined *inter partes* review having a quick trigger estoppel provision. However, the AIA left *ex parte* reexamination intact, which means that parties such as *Fresenius* still have the ability to take advantage of the difference between the evidentiary standards applied in district court and at the USPTO.

W. Todd Baker, Oblon, Spivak, McClelland, Maier & Neustadt, L.L.P., Alexandria, VA

12:45 p.m. Pick Up Lunch

Included in registration.

FRIDAY AFTERNOON

Presiding Officer:

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

KEYNOTE LUNCHEON PRESENTATION

1:15 p.m. .75 hr

View from Federal Circuit

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

2:00 p.m. Break

2:15 p.m. 1.00 hr

Judicial Panel

Distinguished judges discuss their experiences hearing and trying patent cases.

Moderator:

Hon. Paul R. Michel, Chief Judge (Retired), U.S. Court of Appeals for the Federal Circuit, Washington, DC

Panelists:

Hon. James F. Holderman, U.S. District Court, Northern District of Illinois, Chicago, IL
Hon. Charles E. Bullock, U.S. International Trade Commission, Washington, DC
Hon. J. Rodney Gilstrap (Invited), U.S. District Court, Eastern District of Texas, Marshall, TX

3:15 p.m. 1.00 hr | 1.00 hr ethics

Ethics in Doing Deals and Settling IP Suits

Using video cartoons to examine ethical issues in negotiation, this presentation addresses issues of client identity, the line between "puffing" and "material misrepresentations," the duty of disclosure and interaction between the rule against *ex parte* contacts, the client's right to talk directly to the other side, and the lawyer's obligation not to induce the client to engage in acts the lawyer is barred from doing.

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

4:15 p.m. Adjourn

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Alexandria, VA

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the Federal Circuit
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REASONS TO ATTEND ADVANCED PATENT LAW INSTITUTE

The 9th Annual Advanced Patent Law Institute at the U.S. Patent and Trademark Office offers a unique opportunity to join USPTO senior staff, leading practitioners, academics and members of the federal judiciary from a variety of courts and forums area for two days of presentations on the latest developments in patent law, including:

- The impact of key patentable subject matter cases in both software and life sciences
- Current issues in antitrust and FRAND patents
- Post-grant proceedings and strategies one year after AIA; plus practice tips from the Patent Trial and Appeal Board
- Developments in claim construction and potential impact of Lighting Ballast
- The new landscape for U.S. design patent law and the implications of the U.S.'s likely membership in the Hague System
- "First-to-File" final rules and the USPTO's interpretation of the new Section 102
- Strategies and tactics for dealing with the increasing influence of patent NPEs
- The popular Judicial Panel, moderated this year by Former Chief Judge of the Federal Circuit, Paul R. Michel
- Earn up to 2.00 hours of ethics including a Keynote Presentation by David Hricik of Mercer University School of Law—Ethics in Doing Deals and Settling IP Suits.

The Institute is presented by The University of Texas School of Law, the U.S. Patent and Trademark Office and George Mason University School of Law.

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USPTO

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ALEXANDRIA, VIRGINIA

January 23–24, 2014

CONFERENCE LOCATION

USPTO – Main Auditorium

Concourse Level of the Madison Building
 (Main Building on the USPTO Campus)
 600 Dulany Street
 Alexandria, VA 22314

Visit www.uspto.gov/main/visiting.htm
 for directions and information
 about public transportation

ACCOMMODATIONS

The Westin Alexandria

400 Courthouse Square
 Alexandria, VA 22314
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Special Room Rate: \$179

good through December 23, 2013
 (subject to availability)

Valet Parking: \$10 daily, \$26 overnight

KEY DATES

January 15, 2014

last day for early registration
 add \$50 for registrations received after this time

January 17, 2014

last day for cancellation (full refund)

January 20, 2014

last day for cancellation (partial refund)
 \$50 processing fee applied

January 23, 2014, 8:15 a.m.

Institute begins

ADVANCED PATENT LAW INSTITUTE ACCREDITATION

CALIFORNIA—14.75 hrs | 2.00 hrs ethics

The University of Texas School of Law is a State Bar of California approved MCLE provider (#1944).

DELAWARE—14.80 credits | 2.00 credits ethics

This course has been approved for 14.80 credits, including 2.00 Enhanced Ethics credits by the Delaware Commission on Continuing Legal Education.

ILLINOIS—14.75 MCLE general credit hours

This course has been approved by the Minimum Continuing Legal Education Board of the Supreme Court of Illinois for 14.75 MCLE general credit hours.

NEW JERSEY—15.00 hrs | 2.00 hrs ethics

As The University of Texas School of Law is a State Bar of Texas approved MCLE provider (Sponsor #13), our courses are presumptively approved for MCLE credit based on a 50-minute credit hour, and in accordance with the Regulations of the Supreme Court of New Jersey Board on Continuing Legal Education.

NEW YORK—17.50 hrs | 2.00 hrs ethics

As The University of Texas School of Law is a State Bar of California approved MCLE provider (#1944), our courses are presumptively approved for MCLE credit based on a 50-minute credit hour, and in accordance with the Program Rules and the Regulations and Guidelines of the New York State Bar Association.

OTHER STATES

Many jurisdictions accept conferences offered by The University of Texas School of Law, and approved by the State Bar of Texas, for CLE credit. Please check with your jurisdiction's regulatory authority. A Certificate of Attendance and credit reporting documentation will be provided at the conference.

OHIO—14.75 hrs | 2.00 hrs ethics (Expected)

This course has been submitted to the Supreme Court of Ohio Commission on Continuing Legal Education for 14.75 total CLE hours, with 2.00 of ethics instruction.

OKLAHOMA—17.50 hrs | 2.00 hrs ethics

The University of Texas School of Law is an Oklahoma Bar Association presumptively approved provider (#169).

PENNSYLVANIA—14.50 hrs | 2.00 hrs ethics (Expected)

This program has been submitted to the Pennsylvania Continuing Legal Education Board for 14.50 hours of substantive law, practice and procedure CLE credit and 2.00 hours of ethics, professionalism or substance abuse CLE credit.

TEXAS—14.75 hrs | 2.00 hrs ethics

This course has been approved for Minimum Continuing Legal Education credit by the State Bar of Texas Committee on MCLE in the amount of 14.75 hours, of which 2.00 credit hours will apply to legal ethics/professional responsibility credit.

VIRGINIA—12.50 hrs | 2.00 hrs ethics (Expected)

This course has been submitted for MCLE approval to the Virginia Mandatory Continuing Legal Education Board by Sponsor, George Mason University School of Law.