

9th Annual Advanced Patent Law Institute
January 23-24, 2014 • United States Patent and Trademark Office • Alexandria, VA

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 am	Registration Opens Includes continental breakfast.
8:15 am	Welcoming Remarks
8:30 am 0.50 hr	Patentable Subject Matter: Life Sciences Review of the Supreme Court decisions, <i>Mayo v. Prometheus</i> and <i>Association for Molecular Pathology v. Myriad Genetics</i> ; 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 am 0.50 hr	Patentable Subject Matter: Software and Business Methods Discussion of the patent-eligibility of software and business methods, with analysis of <i>CLS Bank v. Alice Corporation</i> and other recent decisions. Christopher A. Cotropia, Intellectual Property Institute, University of Richmond School of Law - Richmond, VA
9:30 am 0.75 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 am	Break
10:30 am 0.50 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 am 0.50 hr	<p>Antitrust and FRAND Patents: Development and Current Issues</p> <p>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.</p> <p>Robert L. Stoll, Drinker Biddle & Reath LLP - Washington, DC</p>
11:30 am 0.50 hr	<p>The New Landscape for Design Patents</p> <p>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 <i>In re Owens</i>, obviousness and functionality in light of <i>High Point Design v. Buyers Direct</i>, and post grant proceedings and claim construction in view of <i>ATAS International v. Centria</i>. Also, a look at recent international developments and the implications of the US moving closer to officially being a member of the Hague system.</p> <p>Tracy-Gene G. Durkin, Sterne, Kessler, Goldstein & Fox P.L.L.C. - Washington, DC William LaMarca, Office of the Solicitor, U.S. Patent and Trademark Office - Alexandria, VA Commentator: Amy J. Nelson, Office of the Solicitor, U.S. Patent and Trademark Office - Alexandria, VA</p>
12:00 pm 0.50 hr	<p>Patent Law Treaty Implementation</p> <p>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.</p> <p>Robert Bahr, U.S. Patent and Trademark Office - Alexandria, VA</p>
12:30 pm	<p>Pick Up Lunch</p> <p>Included in registration.</p>

Thursday Afternoon, Jan. 23, 2014

Presiding Officer:

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

Keynote Luncheon Presentation

12:50 pm 0.50 hr	<p>USPTO Update</p> <p>Peggy Focarino, U.S. Patent and Trademark Office - Alexandria, VA</p>
1:20 pm	<p>Break</p>

1:30 pm 1.00 hr	<p>First-Inventor-To-File: Problems, Ambiguities and Practical Solutions</p> <p>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.</p> <p>Moderator: Dale S. Lazar, DLA Piper LLP US - Reston, VA</p> <p>Panelists: Kathleen Fonda, Office of Patent Legal Administration, U.S. Patent and Trademark Office - Alexandria, VA Brad D. Pedersen, Patterson Thuente Pedersen, P.A. - Minneapolis, MN</p>
2:30 pm 0.50 hr	<p>Obviousness</p> <p>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.'</p> <p>Michael W. O'Neill, Novak Druce Connolly Bove & Quigg LLP - Washington, DC</p>
3:00 pm	<p>Break</p>
3:15 pm 0.75 hr	<p>Divided Infringement After <i>Akamai</i></p> <p>Discussion of the <i>Akamai</i> decision and how it impacts litigation strategy.</p> <p>Gianni Minutoli, DLA Piper LLP US - Washington, DC Phillip B. Philbin, Haynes and Boone, LLP - Dallas, TX</p>
4:00 pm 0.75 hr	<p>Patent Damages Today - but What about Tomorrow?</p> <p>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.</p> <p>Shirley Webster, Ocean Tomo, LLC - Houston, TX Gregory L. Hillyer, Feldman Gale, P.A. - Philadelphia, PA</p>
4:45 pm 0.75 hr	<p>Issues with Patent NPEs</p> <p>Is there a problem with NPEs in patent litigation? And if so, what are alternative possible solutions? This panel discusses 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.</p> <p>Moderator: William L. LaFuze, Vinson & Elkins LLP - Houston, TX</p> <p>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</p>
5:30 pm	<p>Adjourn</p>

Friday Morning, Jan. 24, 2014

Presiding Officer:

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

7:30 am	Conference Room Opens Includes continental breakfast.
8:30 am 0.75 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. Justin Arbes, U.S. Patent and Trademark Office, Patent Trial and Appeal Board - Alexandria, VA 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 am 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 am	Break
10:30 am 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 am 0.75 hr	Claims Construction <i>Lighting Ballast</i> and <i>de novo</i> 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 pm 0.50 hr	<p><i>Ex Parte</i> Reexam in View of <i>Fresenius</i> - A Hail Mary Pass Which Should Be in Every Playbook</p> <p>Due to typically lengthy District Court litigation, accused patent infringers may file an <i>ex parte</i> reexamination request as a final opportunity to cancel the claims of an asserted patent. The AIA replaced the much maligned <i>inter partes</i> reexamination with a more streamlined <i>inter partes</i> review having a quick trigger estoppel provision. However, the AIA left <i>ex parte</i> reexamination intact, which means that parties such as <i>Fresenius</i> still have the ability to take advantage of the difference between the evidentiary standards applied in district court and at the USPTO.</p> <p>W. Todd Baker, Oblon, Spivak, McClelland, Maier & Neustadt, L.L.P. - Alexandria, VA</p>
12:45 pm	<p>Pick Up Lunch</p> <p>Included in registration.</p>

Friday Afternoon, Jan. 24, 2014

Presiding Officer:

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

Keynote Luncheon Presentation

1:15 pm 0.75 hr	<p>View from Federal Circuit</p> <p>Hon. Pauline Newman, U.S. Court of Appeals for the Federal Circuit - Washington, DC</p>
2:00 pm	<p>Break</p>
2:15 pm 1.00 hr	<p>Judicial Panel</p> <p>Distinguished judges discuss their experiences hearing and trying patent cases.</p> <p>Moderator: Hon. Paul R. Michel, Chief Judge, Retired, United States Court of Appeals for the Federal Circuit - Washington, DC</p> <p>Panelists: Hon. Charles E. Bullock, U.S. International Trade Commission - Washington, DC Hon. T. S. Ellis III, U.S. District Court, Eastern District of Virginia - Alexandria, VA Hon. Joseph J. Farnan Jr., Former U.S. District Court Judge, Farnan LLP - Wilmington, DE</p>
3:15 pm 1.00 hr ethics	<p>Ethics in Doing Deals and Settling IP Suits</p> <p>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 <i>ex parte</i> 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.</p> <p>David Hricik, Mercer University School of Law - Macon, GA</p>
4:15 pm	<p>Adjourn</p>