

# THE UNITED STATES PATENT AND TRADEMARK OFFICE GEORGE MASON UNIVERSITY SCHOOL OF LAW THE UNIVERSITY OF TEXAS SCHOOL OF LAW



### 10<sup>TH</sup> ANNUAL

# ADVANCED PATENT LAW INSTITUTE



March 12–13, 2015
United States Patent and Trademark Office ■ Alexandria, Virginia

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Special Rules Apply in VA: 12.50 Hours of MCLE Credit Including 2.00 Hours of Ethics

MCLE Credit Including Ethics Credit Expected for OH and PA

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Special Rules Apply in VA: 12.50 Hours of MCLE Credit Including 2.00 Hours of Ethics

MCLE Credit Including Ethics Credit Expected for OH and PA

#### **THURSDAY MORNING, MAR. 12, 2015**

#### **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

#### Patent Eligible Subject Matter: Key Cases and Current Requirements

Details from recent Federal Circuit, District Court, and PTAB decisions applying the Supreme Court's decisions in *Alice*, *Myriad*, and *Prometheus* and how they might determine the current contours of Section 101.

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

9:00 a.m. .50 hr

#### Patent Eligible Subject Matter: Interpretations and Guidelines from the USPTO

A discussion of the Office's efforts to implement recent court decisions that impact standards for patent eligibility under Section 101.

Drew Hirshfeld, Deputy Commissioner for Patent Examination Policy, U.S. Patent and Trademark Office, Alexandria, VA

9:30 a.m. .50 hr

#### Patent Eligible Subject Matter: Practical Guidance for Patent Practitioners in a Post-Alice, Prometheus and Myriad World

How to successfully navigate patent subject matter eligibility in a post-*Alice, Prometheus* and *Myriad* world, including guidance on how to draft robust patent specifications and claims, and prosecution tips for addressing Section 101 claim rejections.

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

Stephen G. Kunin, Oblon, Spivak, McClelland, Maier & Neustadt, L.L.P., Alexandria, VA

10:00 a.m. Break

#### 10:15 a.m.

.75 hr

#### Patent Drafting and Claim Definiteness

A look at both substantive and procedural issues relating to the recent cases on indefiniteness, *Nautilus v. Biosig* and *In re Packard*, plus tips to applicants on how to draft claims that meet 35 U.S.C. § 112(b)'s requirement to "particularly point out" and "distinctly claim" the subject matter of the invention.

Kristi L. R. Sawert, Office of the Solicitor, U.S. Patent and Trademark Office, Alexandria, VA Harold C. Wegner, Foley & Lardner, Washington, DC

11:00 a.m. .75 hr

# First Inventor to File: Navigating the Complexities and Ambiguities

For the past two years we have been filing patent applications where what is or is not prior art is based on post-AIA Section 102. Now we are starting to receive Office Actions in these post-AIA applications. We will discuss changes to our practice as we transition from Pre-AIA to Post-AIA Section 102. We will also discuss aspects of Post-AIA Section 102 that are clear and aspects that remain open for debate and judicial resolution.

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

11:45 a.m. .50 hr

#### Current Quality Initiatives at the USPTO

A look at how the Office is taking advantage of a sustainable funding model to provide the best quality products and services at every stage of the patent process, improve the customer experience through an emphasis on excellent customer service, and engage the public in partnership to educate and seek input.

Peggy Focarino, Commissioner for Patents, U.S. Patent and Trademark Office, Alexandria, VA

12:15 p.m. Pick Up Lunch

 $Included\ in\ registration.$ 

#### THURSDAY AFTERNOON

#### **Presiding Officer:**

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

#### **LUNCHEON PRESENTATION**

12:35 p.m.

.50 hr

#### **Update from the USPTO**

Hon. Michelle K. Lee, Deputy Under Secretary of Commerce for Intellectual Property and Deputy Director, U.S. Patent and Trademark Office, Alexandria, VA (Invited)

1:05 p.m. Break

1:20 p.m.

.75 hr

#### Update on Patent Litigation before the ITC

A review of the major legal developments affecting patent cases before the ITC, including the Federal Circuit's upcoming *en banc* rehearing in *Suprema* and its potential impact on future investigations involving method claims, changes and clarifications to the domestic industry requirement, and recent decisions relating to the enforcement of consent orders.

Lynn I. Levine, Morrison & Foerster LLP, Washington, DC

T. Cy Walker, Kenyon & Kenyon, Washington, DC

2:05 p.m.

.75 hr

#### Design Patents:

#### The Good, The Bad, and The Ugly

To cover the landscape of hot design patent topics, including recent Federal Circuit decisions clarifying functionality and obviousness, the USPTO's proposed written description requirement for designs, and design patent damages, i.e., the entire profits rule as framed in *Apple v. Samsung*.

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

2:50 p.m.

.50 hr

#### **Claims Construction**

What is the standard of review for patent claim constructions in light of recent cases, including the impact of the Supreme Court's Teva Pharmaceuticals case?

Edward D. Manzo, Husch Blackwell LLP, Chicago, IL

3:20 p.m.

Break

3:30 p.m.

.50 hr

#### Update from the PTAB: Report on Public Comments and Proposed Rules

Hon. Scott R. Boalick, Deputy Chief Judge (Acting), Patent Trial and Appeal Board, U.S. Patent and Trademark Office, Alexandria, VA

4:00 p.m.

.75 hr

#### Lessons Learned: Tips and Strategies for Practicing Before the PTAB

A discussion of PTAB trial mechanics as seen from the perspectives of judges, petitioners, and patent owners. The panel shares their experiences from real cases on what works most effectively, mistakes to avoid, and how to best position a case for appeal to the Federal Circuit.

#### Moderator:

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

#### Panelists:

Scott A. McKeown, Oblon, Spivak, McClelland, Maier & Neustadt, L.L.P., Alexandria, VA

Hon. Grace Obermann, Patent Trial and Appeal Board, U.S. Patent and Trademark Office, Alexandria, VA Hon. Teresa Stanek Rea, Crowell & Moring, LLP, Washington, DC

4:45 p.m.

.75 hr

## Impact of PTAB Proceedings on Patent Practice and Patent Owners

The new contested proceedings have fundamentally changed the patent enforcement, licensing and monetization environment. How is this playing out in patent practice?

#### Moderator:

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

#### Panelists:

Hon. Paul R. Michel, Chief Judge, Retired, United States Court of Appeals for the Federal Circuit, Washington, DC

Kevin G. Rivette, 3LP Advisors LLC, Palo Alto, CA Hon. James D. Smith, Chief Judge, Patent Trial and Appeal Board, U.S. Patent and Trademark Office, Alexandria. VA

5:30 p.m.

Adjourn

#### FRIDAY MORNING, MAR. 13, 2015

#### **Presiding Officer:**

William LaMarca, Office of the Solicitor, U.S. Patent and Trademark Office, Alexandria, VA

**7:30 a.m.** Conference Room Opens Includes continental breakfast.

8:30 a.m.

.50 hr

# Inside the USPTO's Office of the General Counsel

Sarah T. Harris, Office of the General Counsel, U.S. Patent and Trademark Office, Alexandria, VA

9:00 a.m.

1.00 hr ethics

# The Duty of Candor in USPTO Contested Proceedings

A discussion of the "old" and "new" candor obligations of practitioners—their sources, their reach and applicability, and the potential consequences for their breach—in the context of the representation of clients in the new USPTO post-grant contested proceedings.

Lisa A. Dolak, Syracuse University College of Law, Syracuse, NY

10:00 a.m.

.50 hr

#### Feeshifting under Section 285

A discussion about what makes the case "exceptional" after *Octane Fitness* and *Highmark*.

Jeffrey D. Feldman, Feldman Gale, P.A., Miami, FL

**Break** 

10:30 a.m.

10:45 a.m.

.50 hr

#### **Damages and Remedies**

An update on acceptable patent damages methodology reflecting insights from recent decisions and the thoughts of damages experts.

Shirley Webster, Ocean Tomo, LLC, Houston, TX

11:15 a.m.

1.00 hr

#### **Judicial Panel**

Distinguished judges discuss their experiences hearing and trying patent cases.

#### Moderator:

Hon. Paul R. Michel, Chief Judge, Retired, United States Court of Appeals for the Federal Circuit, Washington, DC

#### Panelists:

Hon. Leonard Davis, U.S. District Court,
Eastern District of Texas, Tyler, TX
Hon. James F. Holderman, U.S. District Court,
Northern District of Illinois, Chicago, IL
Hon. Liam O'Grady, U.S. District Court,
Eastern District of Virginia, Alexandria, VA

12:15 p.m. Pick Up Lunch

Included in registration.

#### **FRIDAY AFTERNOON**

#### **Presiding Officer:**

John W. Ryan, Shipman & Goodwin LLP, Washington, DC

#### **LUNCHEON PRESENTATION**

12:45 p.m.

.75 hr

#### View from the Federal Circuit

Hon. Kimberly A. Moore, U.S. Court of Appeals for the Federal Circuit, Washington, DC

#### Moderators:

Jeremiah S. Helm, Office of the Solicitor, U.S. Patent and Trademark Office, Alexandria, VA John F. Murphy, Baker & Hostetler LLP, Philadelphia, PA

Hon. Beth Z. Shaw, Patent Trial and Appeal Board, U.S. Patent and Trademark Office, Alexandria, VA

1:30 p.m. Break

1:45 p.m.

.50 hr

#### Due Diligence in IP M&A Transactions

A discussion of IP diligence post-AIA, and the resulting considerations in planning, conducting diligence, and negotiating M&A transactions.

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

2:15 p.m.

1.00 hr

#### Key Issues for In-House Counsel

In-house patent counsel balance many issues around portfolio management and costs to file, prosecute and maintain patents, post-grant patent proceedings, litigation and other dispute resolution processes, outside counsel management, etc. Explore these challenges across several industries and hear best practices from those who have faced them.

#### Moderator:

P. Michael Walker, DuPont, Wilmington, DE

#### Panelists:

Stasia Ogden, Baxter Healthcare Corporation, Deerfield, IL

Manny W. Schecter, IBM Corporation, Armonk, NY

3:15 p.m.

1.00 hr ethics

#### Ethics: Send Ethics, Lawyers, and Money?

A range of ethical issues relating to finances has arisen. Lawyers need to consider the impact of *Octane* on their practice. They need to understand the ethical issues that can arise from alternative fee arrangements, such as flat and capped fees, both in litigation and prosecution. There are also thorny issues such as choice of law that come with multi-state federal litigation.

David Hricik, Mercer University School of Law and Taylor English Duma LLP, Macon and Atlanta, GA

4:15 p.m. Adjourn

#### ABOUT THE COVER

Pink Japanese Cherry blossoms on branches overhanging the Tidal Basin in Washington, DC. Veer/Backyard Productions

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Mercer University School of Law and
Taylor English Duma LLP

Macon and Atlanta, GA

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

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for Intellectual Property and Deputy
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Alexandria. VA

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#### **INSTITUTE HIGHLIGHTS**

The 10th 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:

- An in depth look at patentable subject matter: current requirements, interpretations and guidelines from the USPTO and practical guidance for patent practitioners
- Hot topics in design patent law
- Developments in claim construction and the potential impact of Teva Pharmaceuticals
- PTAB proceedings: Practice tips and strategies and the impact on patent practice and patent owners
- Key Issues for In-House Counsel
- Special presentation by the USPTO General Counsel
- Presentations from members of the judiciary including a Federal Circuit Keynote Presentation and the popular Judicial Panel, moderated by former Chief Judge of the Federal Circuit, Hon. Paul R. Michel, with Hon. Leonard Davis (EDTX), Hon. James F. Holderman (NDIL) and Hon. Liam O'Grady (EDVA)
- Earn up to 14.75 hours of credit including 2.00 hours of ethics with presentations by David Hricik, Mercer University School of Law and Lisa A. Dolak, Syracuse University College of Law

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March 12–13, 2015

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#### ALEXANDRIA, VIRGINIA

March 12-13, 2015

#### **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

#### **ACCOMODATIONS**

#### The Westin Alexandria

400 Courthouse Square Alexandria, VA 22314 866.837.4210

#### Valet Parking:

\$10 daily; \$26 overnight (subject to change)

#### **KEY DATES**

March 4, 2015

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

March 6, 2015

last day for cancellation (full refund)

#### March 9, 2015

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

March 12, 2015, 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—13.50 credits | 2.00 credits ethics

This course has been approved for 13.50 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—15.00 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.

#### OHIO—14.75 total 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 hours of ethics instruction.

#### OKLAHOMA—17.50 hrs | 2.50 hrs ethics

This course has been approved for Minimum Continuing Legal Education credit by the Oklahoma Bar Association in the amount of 17.50 hours, of which 2.50 hours will apply to legal ethics credit.

# PENNSYLVANIA—12.50S hrs | 2.00E credits (Expected)

This program has been submitted to the Pennsylvania Continuing Legal Education Board for 12.50 credits of substantive law, practice and procedure CLE and 2.00 credits 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.

#### 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.

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