

13TH ANNUAL
**ADVANCED PATENT LAW
INSTITUTE**



March 1–2, 2018

United States Patent and Trademark Office ■ Alexandria, Virginia

Earn up to 14.50 Hours of MCLE Credit, Including 2.00 Hours of Ethics Credit (Approved in TX, CA, and OK)

MCLE Credit Expected in DE, FL, IL, OH, PA, and VA - Hours Vary by State

MCLE Credit Available Via State Reciprocity in NJ and NY

13TH ANNUAL
ADVANCED PATENT LAW INSTITUTE

March 1–2, 2018 ■ United States Patent and Trademark Office ■ Alexandria, Virginia

Earn up to 14.50 Hours of MCLE Credit, Including 2.00 Hours of Ethics Credit (Approved in TX, CA, and OK)

MCLE Credit Expected in DE, FL, IL, OH, PA, and VA - Hours Vary by State

MCLE Credit Available Via State Reciprocity in NJ and NY

THURSDAY MORNING, MAR. 1, 2018

Presiding Officer:

Hon. David P. Ruschke, U.S. Patent and Trademark Office, Patent Trial and Appeal Board, Alexandria, VA

7:30 a.m. Registration Opens

Includes continental breakfast.

8:20 a.m. Welcoming Remarks

8:30 a.m. 1.00 hr

The Global Patent Landscape

Discuss current issues around patenting, licensing, enforcing, and monetizing patents in the U.S., and look at what the EU, China, and UK are experiencing and the impact on U.S. patent environment.

Moderator:

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

Panelists:

Mark Cohen, U.S. Patent and Trademark Office, Alexandria, VA
Hon. Paul R. Michel, Chief Judge, Retired, United States Court of Appeals for the Federal Circuit, Washington, DC
James Pooley, James Pooley PLC, Menlo Park, CA
Wayne P. Sobon, PAX Labs, Inc., San Francisco, CA
Robert P. Taylor, RPT Legal Strategies PC, San Francisco, CA

9:30 a.m. .75 hr

Standard Essential Patents and FRAND

Hear industry and academic perspectives on some current issues relating to SEPs being debated at various standards development organizations, as well as a case law update relating to the same. Issues include transparency and declarations, the right to license versus the right to access, the willingness of a licensee, the right to injunctive relief, and others.

Andy Culbert, Perkins Coie LLP, Seattle, WA
John Kolakowski, Nokia Technologies, Washington, DC
Kristen Osenga, University of Richmond School of Law, Richmond, VA

10:15 a.m. Break

10:30 a.m. .75 hr

Section 101: Software and High Tech

Alice v. CLS changed the way we, the Federal Circuit, and the USPTO look at Section 101. The law is developing in our common law tradition. But it's important to stay up to date with the latest case law to most effectively refute Section 101 rejections. Review the current state of the law in this evolving area.

Dale S. Lazar, DLA Piper LLP US, Reston, VA
USPTO Speaker TBD

11:15 a.m. .75 hr

Section 101: Life Sciences

The United States (U.S.) America Invents Act (AIA) of 2011 did not amend the patent subject matter eligibility standards under 35 U.S.C. § 101. Yet, despite the AIA's goal to provide greater global patent law harmonization, the current state of patent subject matter eligibility law in the U.S. is decidedly not aligned with this long-standing effort. Review the current status of U.S. subject matter eligibility for life sciences, hear how it compares with major international jurisdictions, and explore proposed legislative solutions to address the ongoing negative impact on the U.S. life sciences industry.

Leslie Fischer, Novartis Pharmaceuticals Corporation, East Hanover, NJ
USPTO Speaker TBD

12:00 p.m. Pick Up Lunch

Included in registration.

THURSDAY AFTERNOON

Presiding Officer:

Devlin Hartline, Antonin Scalia Law School, George Mason University, Arlington, VA

LUNCHEON PRESENTATION

12:20 p.m. .50 hr

Update from the USPTO

Hear about the current priorities, programs, and initiatives underway at the Office.

Joseph Matal, U.S. Patent and Trademark Office, Alexandria, VA

12:50 p.m. Break

1:05 p.m. 1.00 hr ethics

Brave New World: Technology Advances Create Ethical Risks For Patent Practitioners

Technological developments have fundamentally changed how IP legal services are delivered. From virtual offices to outsourced services, patent and other IP services can be provided faster and cheaper, and lawyers can have greater flexibility in where and how they work. Applying old ethics rules to new technologies can create risks for the unwary practitioner. Address how regulatory agencies, including the USPTO's Office of Enrollment and Discipline, apply the Rules of Professional Conduct to modern technologies and evolving practice environments.

Michael E. McCabe Jr., McCabe Law LLC, Potomac, MD

2:05 p.m. .50 hr

Changes to the Patent Venue Rules and Enforcement

The U.S. Supreme Court's ruling in *TC Heartland* has changed the landscape for patent venue. What constitutes a company's "regular and established place of business" is now the question before many courts.

John W. Ryan, Washington, DC

2:35 p.m. .50 hr

Licensing Issues

Explore current licensing and tech transfer considerations including PTAB university and tribal sovereign immunity, patent exhaustion, and licensor/licensee provisions.

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

3:05 p.m. Break

3:15 p.m. .50 hr

PTAB Update

Hear an update on PTAB appeals and trial proceedings.

Hon. David P. Ruschke, U.S. Patent and Trademark Office, Patent Trial and Appeal Board, Alexandria, VA

3:45 p.m. .75 hr

PTAB: Practice Tips and "Pet Peeves"

As the PTAB continues to evolve, several best practices have been identified—as well as possible landmines to avoid. Hear practitioners and PTAB personnel share their experiences from real cases on what works most effectively (and what doesn't) in practicing before the Board.

- Eldora L. Ellison, Sterne, Kessler, Goldstein & Fox P.L.L.C., Washington, DC
- Hon. William Fink, U.S. Patent and Trademark Office, Patent Trial and Appeal Board, Alexandria, VA
- Jeffrey P. Kushan, Sidley Austin LLP, Washington, DC
- Hon. Michael Zecher, U.S. Patent and Trademark Office, Patent Trial and Appeal Board, Alexandria, VA

4:30 p.m. 1.00 hr

PTAB: Proposed Legislation and Reforms

Future patent reform may include legislative changes to the post-grant proceedings included in the AIA. Consider constitutional issues as well as sovereign immunity and explore possible changes that may improve and support innovation.

- Moderator:**
Hon. Teresa Stanek Rea, Crowell & Moring, LLP, Washington, DC
- Panelists:**
Philip S. Johnson, Johnson & Johnson, New Brunswick, NJ
- Stephen G. Kunin, Oblon, McClelland, Maier & Neustadt, L.L.P., Alexandria, VA
- Kevin H. Rhodes, 3M Innovative Properties Company, Saint Paul, MN

5:30 p.m. Adjourn

FRIDAY MORNING, MAR. 2, 2018

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

7:30 a.m. Conference Room Opens

Includes continental breakfast.

8:30 a.m. .50 hr

USPTO Quality and Pilot Programs

Providing high-quality, efficient examination of patent applications is paramount to the mission of the USPTO. Hear about some of the USPTO quality programs including Quality Metrics, Training, Examination Time Analysis, as well as recent and current pilot programs that promote and support the improvement of USPTO products, processes, and services.

- Greg Vidovich, U.S. Patent and Trademark Office, Alexandria, VA

9:00 a.m. .50 hr

Ex Parte Appeals

When is a case ready for appeal? What types of issues should be highlighted in an appeal brief? How do you make the best use of your oral hearing time? Hear insights on these questions and other keys to winning *ex parte* appeals.

- Courtenay C. Brinckerhoff, Foley & Lardner LLP, Washington, DC
- Hon. Romulo H. Delmendo, U.S. Patent and Trademark Office, Patent Trial and Appeal Board, Alexandria, VA
- Hon. Bruce Wieder, U.S. Patent and Trademark Office, Patent Trial and Appeal Board, Alexandria, VA

9:30 a.m. 1.00 hr

Prosecution of High Quality Patents

Get practical tips for drafting and prosecuting patent applications, which can withstand scrutiny at the Patent Trial and Appeal Board (PTAB). Hear strategic advice for the patent practitioner regarding how to strengthen patent applications, including the importance of considerations regarding claim drafting, claim construction, and the use of declarations.

- W. Todd Baker, Oblon, Spivak, McClelland, Maier & Neustadt, L.L.P., Alexandria, VA
- Stefanos Karmis, U.S. Patent and Trademark Office, Alexandria, VA
- Whitney Remily, Haynes and Boone, LLP, Washington, DC

10:30 a.m. Break

10:45 a.m. .75 hr

Determining "Total" Profit for Design Patent Infringement after *Samsung v. Apple*

After *Samsung v. Apple*, the unchanged language of 35 U.S.C. 289 awards "total profit" on "any article of manufacture" to which a patented design has been applied, but the Court said the relevant article on which "total profit" is based could be less than the entire infringing product sold, e.g., just a component. This presentation covers issues around determining the relevant "article of manufacture" and "total profit" under 35 U.S.C. 289, including guidance for design patent prosecution after *Samsung v. Apple*.

- George Raynal, Saidman DesignLaw Group, LLC, Silver Spring, MD

11:30 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. David Folsom, Jackson Walker LLP, Texarkana, TX
- Hon. Amos L. Mazzant III, U.S. District Court, Eastern District of Texas, Sherman, TX
- Hon. Liam O'Grady, U.S. District Court, Eastern District of Virginia, Alexandria, VA

12:30 p.m. Pick Up Lunch

Included in registration.

FRIDAY AFTERNOON

Presiding Officer:
Hon. Teresa Stanek Rea, Crowell & Moring, LLP, Washington, DC

LUNCHEON PRESENTATION

1:00 p.m. .50 hr

A View from the Federal Circuit

- Hon. Sharon Prost, Chief Judge, U.S. Court of Appeals for the Federal Circuit, Washington, DC

1:30 p.m. Break

1:45 p.m. .50 hr

Patent Exhaustion and *Lexmark*

In *Lexmark v. Impression Products*, the U.S. Supreme Court dramatically upended long-established Federal Circuit precedent regarding exhaustion of U.S. patent rights for products sold either domestically or internationally, irrespective of any conditions of sale.

- Timothy C. Meece, Banner & Witcoff, Chicago, IL

2:15 p.m. .75 hr

Year in Review: Recent Decisions from the Federal Circuit and U.S. Supreme Court

Discuss the major patent decisions made this past year and their possible impacts on patent practice, including those from the Supreme Court and the Federal Circuit.

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

3:00 p.m. 1.00 hr ethics

Patent Prosecution and Malpractice

Understand conflicts of interest and other forms of liability and risk that can arise during patent prosecution, addressing recent cases, and potential means to reduce exposure.

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

4:00 p.m. Adjourn

ECONFERENCES

Experience the full conference online and earn CLE credits – on your time.

Preorder conferences and earn credit in Texas and California.

utcle.org/econferences

INSTITUTE FACULTY

W. TODD BAKER Oblon, Spivak, McClelland, Maier & Neustadt, L.L.P. Alexandria, VA	DAVID HRICIK Mercer University School of Law and Taylor English Duma LLP Macon and Atlanta, GA	HON. PAUL R. MICHEL Chief Judge, Retired United States Court of Appeals for the Federal Circuit Washington, DC	JOHN W. RYAN Washington, DC
COURTENAY C. BRINCKERHOFF Foley & Lardner LLP Washington, DC	PHILIP S. JOHNSON Johnson & Johnson New Brunswick, NJ	HON. LIAM O'GRADY U.S. District Court, Eastern District of Virginia Alexandria, VA	WAYNE P. SOBON PAX Labs, Inc. San Francisco, CA
MARK COHEN U.S. Patent and Trademark Office Alexandria, VA	STEFANOS KARMIS U.S. Patent and Trademark Office Alexandria, VA	KRISTEN OSENGA University of Richmond School of Law Richmond, VA	ROBERT GREENE STERNE Sterne, Kessler, Goldstein & Fox P.L.L.C. Washington, DC
CHRISTOPHER A. COTROPIA Intellectual Property Institute, University of Richmond School of Law Richmond, VA	JOHN KOLAKOWSKI Nokia Technologies Washington, DC	JAMES POOLEY James Pooley PLC Menlo Park, CA	ROBERT P. TAYLOR RPT Legal Strategies PC San Francisco, CA
ANDY CULBERT Perkins Coie LLP Seattle, WA	STEPHEN G. KUNIN Oblon, McClelland, Maier & Neustadt, L.L.P. Alexandria, VA	HON. SHARON PROST Chief Judge U.S. Court of Appeals for the Federal Circuit Washington, DC	GREG VIDOVICH U.S. Patent and Trademark Office Alexandria, VA
HON. ROMULO H. DELMENDO U.S. Patent and Trademark Office, Patent Trial and Appeal Board Alexandria, VA	JEFFREY P. KUSHAN Sidley Austin LLP Washington, DC	GEORGE RAYNAL Saidman DesignLaw Group, LLC Silver Spring, MD	HON. BRUCE WIEDER U.S. Patent and Trademark Office, Patent Trial and Appeal Board Alexandria, VA
ELDORA L. ELLISON Sterne, Kessler, Goldstein & Fox P.L.L.C. Washington, DC	DALE S. LAZAR DLA Piper LLP US Reston, VA	HON. TERESA STANEK REA Crowell & Moring, LLP Washington, DC	JEFFREY A. WOLFSON Haynes and Boone, LLP Washington, DC
HON. WILLIAM FINK U.S. Patent and Trademark Office, Patent Trial and Appeal Board Alexandria, VA	JOSEPH MATAL U.S. Patent and Trademark Office Alexandria, VA	WHITNEY REMILY Haynes and Boone, LLP Washington, DC	HON. MICHAEL ZECHER U.S. Patent and Trademark Office, Patent Trial and Appeal Board Alexandria, VA
LESLIE FISCHER Novartis Pharmaceuticals Corporation East Hanover, NJ	HON. AMOS L. MAZZANT III U.S. District Court, Eastern District of Texas Sherman, TX	KEVIN H. RHODES 3M Innovative Properties Company Saint Paul, MN	
HON. DAVID FOLSOM Jackson Walker LLP Texarkana, TX	MICHAEL E. MCCABE JR. McCabe Law LLC Potomac, MD	HON. DAVID P. RUSCHKE U.S. Patent and Trademark Office, Patent Trial and Appeal Board Alexandria, VA	
	TIMOTHY C. MEECE Banner & Witcoff Chicago, IL		

PLANNING COMMITTEE

W. TODD BAKER Oblon, Spivak, McClelland, Maier & Neustadt, L.L.P. Alexandria, VA	STEPHEN G. KUNIN Oblon, McClelland, Maier & Neustadt, L.L.P. Alexandria, VA	ADAM MOSSOFF Antonin Scalia Law School, George Mason University Arlington, VA	JOHN W. RYAN Washington, DC
HON. SCOTT BOALICK U.S. Patent and Trademark Office Alexandria, VA	WILLIAM L. LAFUZE McKool Smith Houston, TX	CHRIS NEWMAN Antonin Scalia Law School, George Mason University Arlington, VA	PERRY SAIDMAN Saidman DesignLaw Group, LLC Silver Spring, MD
COURTENAY C. BRINCKERHOFF Foley & Lardner LLP Washington, DC	WILLIAM LAMARCA U.S. Patent and Trademark Office, Office of the Solicitor Alexandria, VA	HON. TERESA STANEK REA Crowell & Moring, LLP Washington, DC	ROBERT GREENE STERNE Sterne, Kessler, Goldstein & Fox P.L.L.C. Washington, DC
ELIZABETH L. DOUGHERTY U.S. Patent and Trademark Office Alexandria, VA	DALE S. LAZAR DLA Piper LLP US Reston, VA	WHITNEY REMILY Haynes and Boone, LLP Washington, DC	SHIRLEY WEBSTER Ocean Tomo, LLC Houston, TX
KARIN FERRITER U.S. Patent and Trademark Office Alexandria, VA	DAVID L. MCCOMBS Haynes and Boone, LLP Dallas, TX	HON. DAVID P. RUSCHKE U.S. Patent and Trademark Office, Patent Trial and Appeal Board Alexandria, VA	JEFFREY A. WOLFSON Haynes and Boone, LLP Washington, DC
JOANNA JEFFERSON The University of Texas School of Law Austin, TX			BRADLEY C. WRIGHT Banner & Witcoff, Ltd. Washington, DC

HOW TO REGISTER

Online:

www.utcle.org/conferences/PV18

Mail:

The University of Texas
School of Law
Attn. CLE
PO Box 7759
Austin, TX 78713-7759

Fax:

512.475.6876

Questions? 512.475.6700

If you have dietary requirements or would like to request accommodations under the ADA, please contact Customer Service at 512.475.6700 or service@utcle.org at least 10 business days prior to the conference.

REGISTRATION BENEFITS

Before the Conference: Access course materials—downloadable PDFs of papers and slides—and speaker and attendee roster in "Your Briefcase" 48 hours before the conference.

After the Conference: Unlimited access to final, complete course materials—downloadable PDFs of papers and slides—in "Your Briefcase."

eConference: Complimentary access to the eConference—with papers, slides, and audio—for CLE credit (TX and CA) you may have missed at the live conference. Available in "Your Briefcase" 6–8 weeks after the conference.

TX MCLE Credit Reporting: UT Law CLE can report credit on your behalf directly to the State Bar of Texas. Track your Texas MCLE credit claimed and reported through UT Law CLE in "Your Account."

Your Account: Activate "Your Account" online at www.utcle.org. Your UT Law CLE Account is created for you as a first-time conference registrant (mail and fax registrations) with the email address you provide.

ECONFERENCE AND COMPLETE CONFERENCE MATERIALS

eConference

Complete eConference package includes all conference materials for download from "Your Briefcase" at www.utcle.org.

Complete Conference Materials

Comprehensive Binder and Audio products from the live conference—for research and self-study. Available for download and shipping.

REGISTRATION FORM

PLEASE PRINT CLEARLY

PV18

Bar Card# _____ TX Other State: _____ N/A

Name [Mr. / Ms.] _____

Firm _____

Address _____

City _____ State _____ Zip _____

Telephone _____ Fax _____

Registrant's Email (required) _____

Assistant's Email (optional) _____

Invoices, confirmations, and receipts are emailed to these addresses.

REGISTRATION—Includes Electronic Course Materials, Thursday Luncheon Presentation, and Friday Luncheon Presentation

Special group registration rates available. Call 512.475.6700.

Select Registration Type

Individual registration by February 21 \$725

Individual registration after February 21 \$775

USPTO Employee

Employee registration \$250

Printed course binder available for an additional fee through February 16

Conference registration includes Electronic Course Binder Download (PDF) in "Your Briefcase" at www.utcle.org.

Printed Course Binder \$37.89

Price includes 8.25% Sales Tax

Printed Course Binder for tax exempt registrants \$35

(e.g., government employees and nonprofits)

ECONFERENCE—For Texas MCLE Credit

Complete eConference package includes all conference materials for download from "Your Briefcase" at utcle.org. Available 6–8 weeks after the live conference date.

Individual eConference \$675

Call (512) 475-6876 to register additional participants

COMPLETE CONFERENCE MATERIALS[†]—For Research and Self-Study

Comprehensive Binder and Audio products from the live conference.

Available for delivery 4–6 weeks after conference date. Shipping included.

eBinder Download (PDF) \$225

Printed Binder \$275

Audio Download (MP3) \$175

[†]Texas customers—add 8.25% sales tax or include an Exemption Certificate \$ _____

Sales tax will be invoiced separately on taxable orders for which payment does not include tax.

TOTAL \$ _____

METHOD OF PAYMENT

Check (make check payable to The University of Texas at Austin)

VISA MasterCard American Express P.O.

Card /P.O. # _____ Exp. Date _____ / _____
(mm/yy)

Authorized Signature _____

If you have dietary requirements or would like to request accommodations under the ADA, please contact Customer Service at 512.475.6700 or service@utcle.org at least 10 business days prior to the conference.

Visit
www.utcle.org

Email
service@utcle.org

Call
512.475.6700

Follow [@UTLawCLE](https://twitter.com/UTLawCLE)

ALEXANDRIA, VIRGINIA

March 1–2, 2018

CONFERENCE LOCATION

USPTO – Main Auditorium

Concourse Level of the Madison Building
 (Main Building on the USPTO Campus)
 600 Dulany Street
 Alexandria, VA 22313-1450

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

ACCOMMODATIONS

The Westin Alexandria

400 Courthouse Square
 Alexandria, VA
 866.837.4210 (reservations)

KEY DATES

February 21, 2018

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

February 23, 2018

last day for cancellation (full refund)

February 26, 2018

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

March 1, 2018, 8:20 a.m.

Institute begins

ADVANCED PATENT LAW INSTITUTE ACCREDITATION

CALIFORNIA—14.50 hrs | 2.00 hrs ethics

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

DELAWARE—14.50 hrs | 2.00 hrs ethics (Expected)

This Course is pending review by the Commission on Continuing Legal Education of the Supreme Court of Delaware for 14.50 total CLE hours, including 2.00 hours of enhanced ethics credit.

FLORIDA—17.50 hrs | 2.50 hrs ethics (Expected)

This course is pending review by the Florida Bar Legal Specialization and Education Department for 17.50 total CLE hours, including 2.50 hours of ethics credit.

ILLINOIS—14.50 hrs | 2.00 hrs ethics (Expected)

This course is pending review by the Minimum Continuing Legal Education Board of the Supreme Court of Illinois for 14.50 total CLE hours, including 2.00 hours of professional responsibility credit.

NEW JERSEY

The University of Texas School of Law is a State Bar of Texas approved MCLE provider (Sponsor #13). New Jersey attorneys who are satisfying the CLE requirement of another mandatory CLE state or who take courses approved in another mandatory CLE state will receive 1:1 credit for courses approved in that jurisdiction through reciprocity based on a 50-minute credit hour and in accordance with the rules and regulations of the Supreme Court of New Jersey Board on Continuing Legal Education.

NEW YORK

A New York attorney who completes an eligible approved jurisdiction course or program may claim New York CLE credit based on a 50-minute credit hour for the course or program in accordance with the requirements of the Program Rules and New York's Regulations and Guidelines. Texas is a Group "B" New York Approved Jurisdiction designated by the CLE Board, effective November 1, 2014.

OHIO—14.50 hrs | 2.00 hrs ethics (Expected)

This course is pending review by the Supreme Court of Ohio Commission on Continuing Legal Education for 14.50 total CLE hours, including 2.00 hours of ethics credit.

OKLAHOMA—17.50 hrs | 2.50 hrs ethics

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

PENNSYLVANIA—13.50 hrs | 2.00 hrs ethics (Expected)

This course is pending review by the Supreme Court of Pennsylvania Continuing Legal Education Board for 13.50 total CLE hours, including 2.00 hours of ethics credit.

TEXAS—14.50 hrs | 2.00 hrs ethics

This course has been approved by the State Bar of Texas Committee on MCLE in the amount of 14.50 hours, including 2.00 hours of legal ethics/professional responsibility credit.

VIRGINIA—12.50 hrs | 2.00 hrs ethics (Expected)

This course is pending review by the Virginia Mandatory Continuing Legal Education Board for 12.50 total CLE hours, including 2.00 hours of ethics credit.

OTHER STATES

If you wish to satisfy MCLE requirements in another state (other than those listed above) by taking a program offered by the University of Texas School of Law, please check with the state bar or other licensing authority in that state. Many jurisdictions accept conferences offered by The University of Texas School of Law, which are approved by the State Bar of Texas for MCLE credit. A Certificate of Attendance will be provided at the conference.