

# 13<sup>th</sup> Annual Advanced Patent Law Institute

## March 1-2, 2018 • United States Patent and Trademark Office • Alexandria, VA

### Thursday Morning, Mar. 1, 2018

#### Presiding Officer:

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

7:30 am	<b>Registration Opens</b>  Includes continental breakfast.
8:20 am	<b>Welcoming Remarks</b>  By Drew Hirshfeld, Commissioner for Patents, U.S. Patent and Trademark Office
8:30 am 1.00 hr	<b>The Global Patent Landscape</b>  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, 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 am 0.75 hr	<b>Standard Essential Patents and FRAND</b>  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 Materials By: Kristen Osenga, University of Richmond School of Law - Richmond, VA
10:15 am	<b>Break</b>
10:30 am 0.75 hr	<b>Section 101: Software and High Tech</b>  <i>Alice v. CLS</i> 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.  Robert Bahr, U.S. Patent and Trademark Office - Alexandria, VA Dale S. Lazar, DLA Piper LLP US - Reston, VA

11:15 am 0.75 hr	<p><b>Section 101: Life Sciences</b></p> <p>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.</p> <p>Leslie Fischer, Novartis Pharmaceuticals Corporation - East Hanover, NJ Courtney Stopp, U.S. Patent and Trademark Office - Alexandria, VA</p>
12:00 pm	<p><b>Pick Up Lunch</b></p> <p>Included in registration.</p>

## Thursday Afternoon, Mar. 1, 2018

### Presiding Officer:

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

### LUNCHEON PRESENTATION

12:20 pm 0.50 hr	<p><b>Update from the USPTO</b></p> <p>Hear about the current priorities, programs, and initiatives underway at the Office.</p> <p>Joseph Matal, U.S. Patent and Trademark Office - Alexandria, VA</p>
12:50 pm	<p><b>Break</b></p>
1:05 pm 1.00 hr ethics	<p><b>Brave New World: Technology Advances Create Ethical Risks For Patent Practitioners</b></p> <p>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.</p> <p>Michael E. McCabe Jr., McCabe Law LLC - Potomac, MD</p>
2:05 pm 0.50 hr	<p><b>Changes to the Patent Venue Rules and Enforcement</b></p> <p>The U.S. Supreme Court's ruling in <i>TC Heartland</i> 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.</p> <p>John W. Ryan, Washington, DC</p>

2:35 pm 0.50 hr	<p><b>Licensing Issues</b></p> <p>Explore current licensing and tech transfer considerations including PTAB university and tribal sovereign immunity, patent exhaustion, and licensor/licensee provisions.</p> <p>Jeffrey A. Wolfson, Haynes and Boone, LLP - Washington, DC</p>
3:05 pm	<p><b>Break</b></p>
3:15 pm 0.50 hr	<p><b>PTAB Update</b></p> <p>Hear an update on PTAB appeals and trial proceedings.</p> <p>Hon. David P. Ruschke, U.S. Patent and Trademark Office, Patent Trial and Appeal Board - Alexandria, VA</p>
3:45 pm 0.75 hr	<p><b>PTAB: Practice Tips and "Pet Peeves"</b></p> <p>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.</p> <p>Eldora L. Ellison, Sterne, Kessler, Goldstein &amp; 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</p>
4:30 pm 1.00 hr	<p><b>PTAB: Proposed Legislation and Reforms</b></p> <p>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.</p> <p>Moderator:  Hon. Teresa Stanek Rea, Crowell &amp; Moring, LLP - Washington, DC  Panelists:  Philip S. Johnson, Johnson &amp; Johnson - New Brunswick, NJ  Stephen G. Kunin, Oblon, McClelland, Maier &amp; Neustadt, L.L.P. - Alexandria, VA  Kevin H. Rhodes, 3M Innovative Properties Company - Saint Paul, MN</p>
5:30 pm	<p><b>Adjourn</b></p>

## Friday Morning, Mar. 2, 2018

### Presiding Officer:

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

7:30 am	<p><b>Conference Room Opens</b></p> <p>Includes continental breakfast.</p>
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8:30 am 0.50 hr	<p><b>USPTO Quality and Pilot Programs</b></p> <p>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.</p> <p><b>Canceled due to weather and closure of Federal offices on March 2.</b></p> <p>Greg Vidovich, U.S. Patent and Trademark Office - Alexandria, VA</p>
9:00 am 0.50 hr	<p><b>Ex Parte Appeals</b></p> <p>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 <i>ex parte</i> appeals.</p> <p><b>Canceled due to weather and closure of Federal offices on March 2.</b></p> <p>Courtenay C. Brinkerhoff, Foley &amp; 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</p>
9:30 am 1.00 hr	<p><b>Prosecution of High Quality Patents</b></p> <p>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.</p> <p><b>Canceled due to weather and closure of Federal offices on March 2.</b></p> <p>W. Todd Baker, Oblon, Spivak, McClelland, Maier &amp; Neustadt, L.L.P. - Alexandria, VA  Stefanos Karmis, U.S. Patent and Trademark Office - Alexandria, VA  Whitney Remily, Haynes and Boone, LLP - Washington, DC</p>
10:30 am	<p><b>Break</b></p>
10:45 am 0.75 hr	<p><b>Determining "Total" Profit for Design Patent Infringement after <i>Samsung v. Apple</i></b></p> <p>After <i>Samsung v. Apple</i>, 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 <i>Samsung v. Apple</i>.</p> <p><b>Canceled due to weather and closure of Federal offices on March 2.</b></p> <p>George Raynal, Saidman DesignLaw Group, LLC - Silver Spring, MD  Commentator:  Lore Unt, U.S. Patent and Trademark Office, Office of the Solicitor - Alexandria, VA</p>

11:30 am 1.00 hr	<b>Judicial Panel</b>  Distinguished judges discuss their experiences hearing and trying patent cases.  <b>Canceled due to weather and closure of Federal offices on March 2.</b>  Moderator: William L. LaFuze, McKool Smith - Houston, TX and 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 pm	<b>Pick Up Lunch</b>  Included in registration.

## Friday Afternoon, Mar. 2, 2018

### Presiding Officer:

**Hon. Teresa Stanek Rea**, Crowell & Moring, LLP - Washington, DC

### LUNCHEON PRESENTATION

1:00 pm 0.50 hr	<b>A View from the Federal Circuit</b>  <b>Canceled due to weather and closure of Federal offices on March 2.</b>  Hon. Sharon Prost, Chief Judge, U.S. Court of Appeals for the Federal Circuit - Washington, DC
1:30 pm	<b>Break</b>
1:45 pm 0.50 hr	<b>Patent Exhaustion and <i>Lexmark</i></b>  In <i>Lexmark v. Impression Products</i> , 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.  <b>Canceled due to weather and closure of Federal offices on March 2.</b>  Timothy C. Meece, Banner & Witcoff - Chicago, IL
2:15 pm 0.75 hr	<b>Year in Review: Recent Decisions from the Federal Circuit and U.S. Supreme Court</b>  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.  <b>Canceled due to weather and closure of Federal offices on March 2.</b>  Christopher A. Cotropia, Intellectual Property Institute, University of Richmond School of Law - Richmond, VA

3:00 pm  
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.

**Canceled due to weather and closure of Federal offices on March 2.**

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

4:00 pm

**Adjourn**