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14TH ANNUAL

ADVANCED PATENT LAW INSTITUTE



March 21–22, 2019
United States Patent and Trademark Office ■ Alexandria, Virginia

Earn up to 14.00 Hours of Credit Including 2.00 Hours of Ethics (hours vary by state)

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THURSDAY MORNING, MAR. 21, 2019

Presiding Officer: Presiding Officer TBD

7:30 a.m. Registration Opens

Includes continental breakfast.

8:20 a.m. Welcoming Remarks

8:30 a.m. .50 hr

Update from the USPTO

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

Andrei Iancu, Under Secretary of Commerce for Intellectual Property and Director, U.S. Patent and Trademark Office, Alexandria, VA

9:00 a.m. 1.00 hr

The Global Patent Landscape

Discuss post-issuance patent validity reviews and enforcement realities, including post-verdict royalty determinations and availability of post-verdict injunctions, in the U.S., and then compared with those in Europe and in China. Explore motions to invalidate in court under Section 101, and use of stays of infringement suits during parallel proceedings in the PTO, with a comparison of these practices in Europe and Asia.

Moderator:

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

Panelists:

Damon C. Matteo, Fulcrum Strategy, Foster City, CA Hon. Paul R. Michel, Chief Judge, Retired, United States Court of Appeals for the Federal Circuit, Alexandria, VA

Wayne P. Sobon, Juul Labs, San Francisco, CA Robert P. Taylor, RPT Legal Strategies PC, San Francisco, CA

10:00 a.m. Break

10:15 a.m.

.75 hr

Navigating Patent Subject Eligibility Challenges in High Technology Cases

Understand the requirements for meeting the criteria for patent subject matter eligibility by applying the contours of recent Federal Circuit cases to claimed inventions in the software arts.

Stephen G. Kunin, Maier & Maier PLLC, Alexandria, VA

Matthew Sked, U.S. Patent and Trademark Office, Alexandria, VA

11:00 a.m. .50 hr

Drafting and Prosecution Under Current Section 101 Guidance: Technology

Brush up on current USPTO guidance on Section 101 and what to do and not do when drafting and prosecuting applications based on current guidance.

Tom Chen, Haynes and Boone, LLP, Costa Mesa, CA

11:30 a.m. .50 hr

Section 101 Updates: Lifesciences

Title 35, § 101 of the United States code governs patent subject matter eligibility, which, over the last several years, has significantly (and negatively) impacted technologies in fields as diverse as artificial intelligence, mechanical devices, and the life sciences. Explore recent subject matter eligibility decisions in the life sciences arena from the U.S. Court of Appeals for the Federal Circuit and U.S. District Courts, along with new USPTO guidelines and memoranda addressing patent subject matter eligibility.

June Cohan, U.S. Patent and Trademark Office, Alexandria, VAD

Leslie Fischer, Novartis Pharmaceuticals Corporation, East Hanover, NJ

12:00 p.m.

.50 hr

Section 101 and Drafting Implications: Lifesciences

Discuss recent developments relating to patent subject matter eligibility, with a focus on new guidelines expected to be published by the USPTO by the end of 2018, and developments in the Courts and on the Hill.

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

12:30 p.m. Pick Up Lunch

Included in registration.

THURSDAY AFTERNOON

Presiding Officer:

Chris Newman, Antonin Scalia Law School, George Mason University, Arlington, VA

LUNCHEON PRESENTATION

12:50 p.m. .50 hr

PTAB Update

Hear an update on PTAB appeals and trial proceedings.

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

1:20 p.m. Break

1:35 p.m.

1.25 hrs

The Evolution of PTAB Practice Strategies in Light of Recent Developments

Changes are occurring at a rapid rate at the PTAB. Hot topics that have the attention of both Judges and stakeholders include emerging trends—identifying what is both different and the same—in petition and preliminary response strategies, printed publication issues, claim construction, and discovery.

Moderator:

Teresa Stanek Rea, Crowell & Moring, LLP, Washington, DC

Panelists:

Vanessa Bailey, Intel Corporation, Washington, DC Hon. Thomas L. Giannetti, U.S. Patent and Trademark Office, Patent Trial and Appeal Board, Alexandria, VA

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

Hon. Grace Obermann, U.S. Patent and Trademark Office, Patent Trial and Appeal Board, Alexandria, VA

PARTIAL GOVERNMENT SHUTDOWN STATUS

As of the printing of this brochure, the institute is scheduled to proceed as planned at the U.S. Patent and Trademark Office. Should this situation change, registrants will be contacted and revised venue information will be available on our website.

Ex Parte Appeals Practice

Examine the ex parte appeal process, and hear insights and suggestions to maximize your chances for success on appeal, including when to pursue an appeal, what to include in your briefs, and how to prepare for an oral hearing.

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

3:35 p.m.

Break

3:45 p.m.

.75 hr

.75 hr

Design Patent Practitioners: What Guidance Can You Glean from the Board?

A review of IPR and PGR decisions involving design patent challenges reveal surprising results that suggest important lessons for examiners and applicants when it comes to prosecuting design patent applications at the USPTO.

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

4:30 p.m.

1.00 hr ethics

Patent Law Ethics and Recent Developments

Discuss what a patent practitioner can expect if they get a letter from the OED, as well as developments in patent law ethics and practice before the PTO. Topics include an explanation of the PTO's attorney disciplinary process including appeals from ALJ decisions; OED statistics; do's and don'ts for responding to an OED inquiry; recent revisions to ethical rules and regulations; the OED's new diversion program including remediation to avoid discipline; and proposed new rules regarding practitioner fees.

Moderator:

Michael A. Messina, Miles & Stockbridge P.C., Tysons Corner, VA

Panelists:

Dahlia George, U.S. Patent and Trademark Office, Office of Enrollment and Discipline, Alexandria, VA Bernie Knight, BK Consulting, Washington, DC Cameron K. Weiffenbach, Miles & Stockbridge, P.C., Tysons Corner, VA

5:30 p.m.

Adjourn

FRIDAY MORNING, MAR. 22, 2019

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.

USPTO Practice Update: Pilot Programs and Quality Initiatives

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 and Internal and External Training, 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.

.75 hr

.75 hr

.50 hr

Preparing and Prosecuting 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, Vorys, Sater, Seymour and Pease LLP, Washington, DC

9:45 a.m.

Impact of Your Specification on Claim Validity/Scope

Broad claims require a broad specification. But how do you make a specification broad? Examiners are interpreting many claim elements under 112(f), altering the intended scope of our claims. What can we do about it?

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

Break

10:45 a.m.

Developments on SEP/FRAND Issues in the U.S. and Abroad

With the growth of the internet of things and 5G, SEP licensing is becoming relevant outside traditional sectors. Review the recent developments concerning standards-essential patent issues in the U.S. and abroad, including activity at DOJ and FTC.

David K. Djavaherian, PacTech Law, P.C., San Clemente, CA

John Kolakowski, Nokia Technologies,

the Solicitor, Alexandria, VA

Washington, DC Lore Unt, U.S. Patent and Trademark Office, Office of

11:30 a.m. .50 hr

Patent Insurance: "Protect Yourself At All Times"

Intellectual property insurance enables companies to defend products, assert patents, and manage the financial risk associated with both. Using this boxing maxim, discover whether your company is the well-conditioned athlete standing with his hand in the air or the unprepared pugilist on the canvas wondering what hit him.

Gregory L. Hillyer, Hillyer Legal, PLLC, Washington, DC

12:00 p.m. Pick Up Lunch

Included in registration.

FRIDAY AFTERNOON

Presiding Officer:

John W. Ryan, Owens & Minor, Mechanicsville, VA

LUNCHEON PRESENTATION

12:30 p.m. 1.00 hr

Judicial Panel

Distinguished judges discuss their experiences hearing and trying patent cases, including ruling on stays in the context of IPRs, post-verdict injunctions and damages determinations, and motions to dismiss based on alleged ineligible subject matter.

Moderator:

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

Panelists:

Hon. Alan D Albright, U.S. District Court, Western District of Texas, Waco, TX

Hon. T. S. Ellis III, U.S. District Court, Eastern District of Virginia, Alexandria, VA

Hon. S. James Otero, U.S. District Court, Central District of California, Los Angeles, CA

Hon. Sue L. Robinson (Ret.), Farnan LLP, Wilmington, DE

1:30 p.m.

Break

1:45 p.m.

.75 hr

A Year in Review: Recent Decisions from the Federal Circuit and the Supreme Court

Review some of the key cases in the courts in the past year concerning patent eligibility, patents as public rights and the PTAB, prior art after the AIA, and other issues.

Adam Mossoff, Antonin Scalia Law School, George Mason University, Arlington, VA

2:30 p.m.

1.00 hr ethics

Practicing IP Law Ethically in the Cloud: From the Mundane to the Ethics of Al

Learn how to practice competently and ethically, including maintaining client confidentiality, avoiding conflicts of interest, and safely using social media. In addition, examine the questions that lawyers should ask before using computer-augmented legal services, such as automated contract review, legal research, and patent application drafting services.

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

3:30 p.m.

Adjourn

REASONS TO ATTEND

- Update from the USPTO from Andrei lancu, Under Secretary of Commerce for Intellectual Property and Director of the USPTO
- Global Patent Landscape including the influence of countries like China and others on the U.S. patent system and patent enforcement
- Section 101 and recent decisions impacting the drafting of patents in the life-sciences and software/technology sectors
- Key patent decisions in the Federal Circuit and Supreme Court and their impact on patent practice
- Recent developments and changes in PTAB practices including an update from Acting Chief Judge Scott Boalick
- How SEP/FRAND issues and are evolving at home and abroad with the growth of the internet of things
- Insight from members of the federal judiciary as part of the popular Judicial Panel

INSTITUTE FACULTY AND PLANNING COMMITTEE

HON. ALAN D ALBRIGHT U.S. District Court, Western District of Texas Waco, TX

VANESSA BAILEY Intel Corporation Washington, DC

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GREGORY L. HILLYER* Hillyer Legal, PLLC Washington, DC

DAVID HRICIK Mercer University School of Law Macon, GA

ANDREI IANCU Under Secretary of Commerce for Intellectual Property and Director, U.S. Patent and Trademark Office Alexandria, VA JOANNA JEFFERSON*
The University of Texas School of Law

Austin, TX

STEFANOS KARMIS

U.S. Patent and Trademark Office Alexandria, VA

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HON. PAUL R. MICHEL Chief Judge, Retired United States Court of Appeals for the Federal Circuit Alexandria, VA

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ANDREW NALVEN* U.S. Patent and Trademark Office Alexandria, VA

CHRIS NEWMAN* Antonin Scalia Law School, George Mason University Arlington, VA

HON. GRACE OBERMANN U.S. Patent and Trademark Office, Patent Trial and Appeal Board Alexandria, VA

HON. S. JAMES OTERO U.S. District Court, Central District of California Los Angeles, CA TERESA STANEK REA* Crowell & Moring, LLP Washington, DC

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ROBERT P. TAYLOR RPT Legal Strategies PC San Francisco, CA

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ELAINE TUNG-LIN WU* U.S. Patent and Trademark Office, Office of Policy and International Affairs Alexandria, VA

*Planning Committee member

HOW TO REGISTER

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After the Institute: 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 video—for CLE credit (TX and CA) you may have missed at the live Institute. Available in "Your Briefcase" 4–6 weeks after the event.

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While nothing can replace the experience and networking opportunities of the live event, you can still catch up on all the latest developments in Patent Law trends with the eConference.

The online eConference includes papers, slides and video – and CLE credit (TX and CA) – from this year's live Institute. Available in "Your Briefcase" through the user's account at www.utcle.org 4-6 weeks after the live event.

REGISTRATION FORM

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PV19

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March 21-22, 2019

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

March 8, 2019

Last day to order a printed binder

March 13, 2019

Last day for early registration Add \$50 for registrations received after this time

March 15, 2019

Last day for full refund cancellation

March 18, 2019

Last day for partial refund cancellation \$50 processing fee applied

March 21, 2019, 8:20 a.m.

Institute begins

ADVANCED PATENT LAW INSTITUTE ACCREDITATION

CALIFORNIA—14.00 hrs | 2.00 hrs ethics

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

DELAWARE—14.00 hrs | 2.00 hrs ethics

This Course has been approved by the Commission on Continuing Legal Education of the Supreme Court of Delaware for 14.30 total CLE hours, including 2.00 hours of enhanced ethics credit.

FLORIDA—17.00 hrs | 2.50 hrs ethics

This course is pending review by the Florida Bar Legal Specialization and Education Department for 17.00 total CLE hours, including 2.50 hours of ethics credit.

ILLINOIS—14.00 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 14.25 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—14.00 hrs | 2.00 hrs ethics (Expected)

This course is pending review by the Supreme Court of Ohio Commission on Continuing Legal Education for 14.25 total CLE hours, including 2.00 hours of ethics credit.

OKLAHOMA—17.00 hrs | 2.50 hrs ethics

This Course has been approved by the Oklahoma Bar Association for 17.00 total CLE hours, including 2.50 hours of enhanced ethics credit. The University of Texas School of Law is an Oklahoma Bar Association presumptively approved provider (#169).

PENNSYLVANIA—14.00 hrs | 2.00 hrs ethics

This course is has been approved by the Supreme Court of Pennsylvania Continuing Legal Education Board for 14.00 total CLE hours, including 2.00 hours of ethics credit.

TEXAS—14.00 hrs | 2.00 hrs ethics

This course has been approved by the State Bar of Texas Committee on MCLE in the amount of 14.25 hours, including 2.00 hours of legal ethics/ professional responsibility credit.

VIRGINIA-12.00 hrs | 2.00 hrs ethics (Expected)

This course is pending review by the Virginia Mandatory Continuing Legal Education Board for 12.25 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.