

14th Annual Advanced Patent Law Institute
March 21-22, 2019 • United States Patent and Trademark Office • Alexandria, VA

Thursday Morning, Mar. 21, 2019

Presiding Officer:

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

7:30 am	Registration Opens Includes continental breakfast.
8:20 am	Welcoming Remarks
8:30 am 0.50 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 am 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 am	Break
10:15 am 0.75 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 am 0.50 hr	<p>Drafting and Prosecution Under Current Section 101 Guidance: Technology</p> <p>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.</p> <p>Tom Chen, Haynes and Boone, LLP - Costa Mesa, CA</p>
11:30 am 0.50 hr	<p>Section 101 Updates: Lifesciences</p> <p>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.</p> <p>June Cohan, U.S. Patent and Trademark Office - Alexandria, VA Leslie Fischer, Novartis Pharmaceuticals Corporation - East Hanover, NJ</p>
12:00 pm 0.50 hr	<p>Section 101 and Drafting Implications: Lifesciences</p> <p>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.</p> <p>Robert L. Stoll, Drinker Biddle & Reath LLP - Washington, DC</p>
12:30 pm	<p>Pick Up Lunch</p> <p>Included in registration.</p>

Thursday Afternoon, Mar. 21, 2019

Presiding Officer:

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

LUNCHEON PRESENTATION

12:50 pm 0.50 hr	<p>PTAB Update</p> <p>Hear an update on PTAB appeals and trial proceedings.</p> <p>Hon. Scott Boalick, U.S. Patent and Trademark Office, Patent Trial and Appeal Board - Alexandria, VA</p>
1:20 pm	<p>Break</p>

1:35 pm 1.25 hrs	<p>The Evolution of PTAB Practice Strategies in Light of Recent Developments</p> <p>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.</p> <p>Moderator: Teresa Stanek Rea, Crowell & Moring, LLP - Washington, DC</p> <p>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</p>
2:50 pm 0.75 hr	<p>Ex Parte Appeals Practice</p> <p>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.</p> <p>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</p>
3:35 pm	Break
3:45 pm 0.75 hr	<p>Design Patent Practitioners: What Guidance Can You Glean from the Board?</p> <p>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.</p> <p>Perry Saidman, Saidman DesignLaw Group, LLC - Silver Spring, MD</p>
4:30 pm 1.00 hr ethics	<p>Patent Law Ethics and Recent Developments</p> <p>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.</p> <p>Moderator: Michael A. Messina, Miles & Stockbridge P.C. - Tysons Corner, VA</p> <p>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</p>
5:30 pm	Adjourn

Friday Morning, Mar. 22, 2019

Presiding Officer:

7:30 am	Conference Room Opens Includes continental breakfast.
8:30 am 0.50 hr	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 am 0.75 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 am 0.75 hr	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
10:30 am	Break
10:45 am 0.75 hr	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 Christian Hannon, USPTO - Alexandria, VA John Kolakowski, Nokia Technologies - Washington, DC
11:30 am 0.50 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 pm	Pick Up Lunch Included in registration.
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Friday Afternoon, Mar. 22, 2019

Presiding Officer:

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

LUNCHEON PRESENTATION

12:30 pm 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 pm	Break
1:45 pm 0.75 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 pm 1.00 hr ethics	Practicing IP Law Ethically in the Cloud: From the Mundane to the Ethics of AI 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 pm	Adjourn