

18th Annual Advanced Patent Law Institute
March 23-24, 2023 • United States Patent and Trademark Office • Alexandria,
VA
March 23-24, 2023 • Live Webcast

Thursday Morning

	<i>This agenda is still in development. Updates to topics and speakers will be posted as available.</i>
	AGENDA IS IN EASTERN TIME
7:30 am	Registration Opens Includes continental breakfast.
8:20 am	Welcoming Remarks
8:30 am 1.00 hr	Section 101 This panel provides a review on the USPTO plan to update its Patent Examination Guidelines on Patent Subject Matter Eligibility (PSME) based on public comments. Includes a survey of recent Federal Circuit PSME cases with practice tips as well as highlights of a bill to revise PMSE law. Stephen G. Kunin, Maier & Maier PLLC - Alexandria, VA Matthew Sked, U.S. Patent and Trademark Office - Philadelphia, PA
9:30 am 1.00 hr	SEPs and License Agreements Moderator: Adam Mossoff, Antonin Scalia Law School, George Mason University - Arlington, VA Panelists: Isabella Fu, Microsoft Corporation - Redmond, WA Christian Hannon, U.S. Patent and Trademark Office - Alexandria, VA
10:30 am	10-Minute Break
10:45 am 1.00 hr	Written Description and Enablement: Current Cases and Pending Decisions Carla Ji-Eun Kim, Sterne Kessler Goldstein & Fox - Washington, DC Nick Panno, DLA Piper LLP US - Reston, VA

<p>11:45 am 0.75 hr</p>	<p>Drafting Claims That Will Be Infringed</p> <p>When you draft claims, what are you thinking about? Our clients want us to focus on covering their invention, but we know that a patent creates a negative right. It doesn't give your client the right to practice its invention, only to exclude others. In one school of thought, clients want patents that protect their businesses, this means using patents to keep competitors away from our clients' patent properties. This discusses ways of drafting claims that maximize the chances of covering competitors; that are difficult to design around.</p> <p>Dale S. Lazar, Antonin Scalia Law School George Mason University - Arlington, VA</p>
<p>12:30 pm In Alexandria Only</p>	<p>Pick Up Lunch (in Alexandria)</p>

Thursday Afternoon

LUNCHEON PRESENTATION

<p>12:50 pm 0.50 hr</p>	<p>Keynote Presentation: View from the USPTO</p> <p>Kathi Vidal, Under Secretary of Commerce for Intellectual Property and Director, U.S. Patent and Trademark Office - Alexandria, VA (Invited)</p>
<p>1:20 pm</p>	<p>10-Minute Break</p>
<p>1:30 pm 0.50 hr</p>	<p>PTAB Update from Chief Judge</p> <p>Hear an update from the Chief Judge on recent trends and developments in PTAB appeal and trial proceedings.</p> <p>Hon. Scott R. Boalick, Chief Judge, Patent Trial and Appeal Board, U.S. Patent and Trademark Office - Alexandria, VA</p>
<p>2:00 pm 0.75 hr</p>	<p>Practice Before the PTAB, Part I: Changes to the Director Review Procedures and Discretionary Denial Practice</p> <p>Teresa Stanek Rea, Crowell & Moring, LLP - Washington, DC Hon. Michael Tierney, U.S. Patent and Trademark Office - Alexandria, VA Hon. Amanda Wieker, U.S. Patent and Trademark Office, Patent Trial and Appeal Board - Richmond, VA</p>
<p>2:45 pm 0.75 hr</p>	<p>Practice Before the PTAB, Part II: Joinder, Estoppel, Motions to Amend, and More</p> <p>W. Todd Baker, Kirkland & Ellis LLP - Washington, DC Hon. Melissa Haapala, U.S. Patent and Trademark Office, Patent Trial and Appeal Board - Boulder, CO Hon. Miriam L. Quinn, U.S. Patent and Trademark Office, Patent Trial and Appeal Board - Dallas, TX</p>
<p>3:30 pm</p>	<p>15-Minute Break</p>

3:45 pm 0.75 hr	<p>Patenting Issues Applicable to AI Inventions</p> <p>Susan Krumplitsch, DLA Piper LLP US - East Palo Alto, CA Nalini Mummalaneni, U.S. Patent and Trademark Office - Alexandria, VA</p>
4:30 pm 1.00 hr ethics	<p>Ethics Issues Facing USPTO Practitioners</p> <p>Michael E. McCabe Jr., McCABE/ALI LLP - Potomac, MD Tim Rooney, U.S. Patent and Trademark Office, Office of Enrollment and Discipline - Alexandria, VA</p>
5:30 pm	<p>Adjourn</p>

Friday Morning

	<p><u>AGENDA IS IN EASTERN TIME</u></p>
8:30 am	<p>Conference Room Opens</p>
9:00 am 1.00 hr	<p>Implications of Unified Patents and the Unified Patent Court</p> <p>Moderator: Robert Greene Sterne, Sterne, Kessler, Goldstein & Fox P.L.L.C. - Washington, DC Panelists: Florian Meyer, Meissner Bolte mbB - Munich, Germany Mario Pozzi, SIB LEX s.t.a. - Milan, Italy Gwilym Roberts, Kiburn & Strode - London, United Kingdom</p>
10:00 am	<p>15-Minute Break</p>
10:15 am 0.75 hr	<p>Challenges to Obviousness Type Double Patenting, Including patents with PTE or PTA</p> <p>Obviousness-type double patenting is a judicial creation designed to preclude improper time extension of patent rights by proscribing the issuance of claims in a second patent that are directed to subject matter that is “different but not patentably distinct from the subject matter claimed in the prior patent.” But there must be some clear evidence to establish why the invention's variation in the second patent or application would have been obvious. This presentation discusses responding to OTDP rejections, as well as the implications when the patent in question has PTE or PTA.</p> <p>Kakoli Caprihan, U.S. Patent and Trademark Office, Office of the General Counsel - Alexandria, VA Tom Irving, Finnegan, Henderson, Farabow, Garrett & Dunner, LLP - Washington, DC</p>
11:00 am 0.75 hr	<p>Very Hot Topics in Design Patents</p> <p>There are two major questions of first impression pending before the Federal Circuit. Design patent scope has been turned on its head by <i>In re: Surgisil</i>, greatly affecting not only patentability but infringement analysis (<i>Columbia v. Serius</i>). Regarding obviousness, the Federal Circuit in <i>LKQ v. GM</i> is grappling with the unresolved issue of whether KSR applies to design patents, potentially overturning years of case law.</p> <p>Perry Saidman, Saidman DesignLaw Group, LLC - Silver Spring, MD</p>

11:45 pm
In Alexandria
Only

Pick Up Lunch (in Alexandria)

Friday Afternoon

LUNCHEON PRESENTATION

12:15 pm
1.00 hr

Federal Circuit Judicial Panel

Hear from a panel of judges from the Court of Appeals for the Federal Circuit as they discuss their experiences hearing and trying patent cases.

Moderator:

Hon. Kathleen M. O'Malley (Ret.), Irell & Manella LLP - Washington, DC

Hon. Alan D. Lourie, U.S. Court of Appeals for the Federal Circuit - Washington, DC

Hon. Pauline Newman, U.S. Court of Appeals for the Federal Circuit - Washington, DC

Panelist:

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

1:15 pm

15-Minute Break

1:30 pm
1.00 hr

Federal Circuit and SCOTUS Year in Review

A review of the most important cases from the Federal Circuit and the Supreme Court in the past year that every practitioner should know.

Joe Matal, Haynes Boone, LLP - Washington, DC

2:30 pm
1.00 hr ethics

Ethics in IP Practice

This session covers conflicts of interest in patent litigation, opinions, and prosecution.

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

3:30 pm

Adjourn