

10th Annual Advanced Patent Law Institute

March 12-13, 2015 • United States Patent and Trademark Office • Alexandria, VA

Thursday Morning, Mar. 12, 2015

Presiding Officer:

Hon. James D. Smith, Chief Judge, Patent Trial and Appeal Board, U.S. Patent and Trademark Office - Alexandria, VA

7:30 am	Registration Opens Includes continental breakfast.
8:15 am	Welcoming Remarks
8:30 am 0.50 hr	Patent Eligible Subject Matter: Key Cases and Current Requirements Details from recent Federal Circuit, District Court, and PTAB decisions applying the Supreme Court's decisions in <i>Alice</i> , <i>Myriad</i> , and <i>Prometheus</i> and how they might determine the current contours of Section 101. Christopher A. Cotropia, Intellectual Property Institute, University of Richmond School of Law - Richmond, VA
9:00 am 0.50 hr	Patent Eligible Subject Matter: Interpretations and Guidelines from the USPTO A discussion of the Office's efforts to implement recent court decisions that impact standards for patent eligibility under Section 101. Drew Hirshfeld, Deputy Commissioner for Patent Examination Policy, U.S. Patent and Trademark Office - Alexandria, VA
9:30 am 0.50 hr	Patent Eligible Subject Matter: Practical Guidance for Patent Practitioners in a Post-<i>Alice</i>, <i>Prometheus</i> and <i>Myriad</i> World How to successfully navigate patent subject matter eligibility in a post- <i>Alice</i> , <i>Prometheus</i> and <i>Myriad</i> world, including guidance on how to draft robust patent specifications and claims, and prosecution tips for addressing Section 101 claim rejections. Courtenay C. Brinckerhoff, Foley & Lardner LLP - Washington, DC Stephen G. Kunin, Oblon, McClelland, Maier & Neustadt, L.L.P. - Alexandria, VA
10:00 am	Break
10:15 am 0.75 hr	Patent Drafting and Claim Definiteness A look at both substantive and procedural issues relating to the recent cases on indefiniteness, <i>Nautilus v. Biosig</i> and <i>In re Packard</i> , plus tips to applicants on how to draft claims that meet 35 U.S.C. § 112(b)'s requirement to "particularly point out" and "distinctly claim" the subject matter of the invention. Kristi L. R. Sawert, Office of the Solicitor, U.S. Patent and Trademark Office - Alexandria, VA Harold C. Wegner, Wegner IP Consulting - Naples, FL

11:00 am 0.75 hr	<p>First Inventor to File: Navigating the Complexities and Ambiguities</p> <p>For the past two years we have been filing patent applications where what is or is not prior art is based on post-AIA Section 102. Now we are starting to receive Office Actions in these post-AIA applications. We will discuss changes to our practice as we transition from Pre-AIA to Post-AIA Section 102. We will also discuss aspects of Post-AIA Section 102 that are clear and aspects that remain open for debate and judicial resolution.</p> <p>Dale S. Lazar, DLA Piper LLP US - Reston, VA</p>
11:45 am 0.50 hr	<p>Current Quality Initiatives at the USPTO</p> <p>A discussion of how the Office is taking advantage of a sustainable funding model to provide the best quality products and services at every stage of the patent process, improve the customer experience through an emphasis on excellent customer service, and engage the public in partnership to educate and seek input.</p> <p>Valencia Martin-Wallace, Deputy Commissioner for Patent Quality, U.S. Patent and Trademark Office - Alexandria, VA</p>
12:15 pm	<p>Pick Up Lunch</p> <p>Included in registration.</p>

Thursday Afternoon, Mar. 12, 2015

Presiding Officer:

William L. LaFuze, Vinson & Elkins LLP - Houston, TX

LUNCHEON PRESENTATION

12:35 pm 0.50 hr	<p>Update from the USPTO</p> <p>Russell Slifer, Director, Rocky Mountain Region, U.S. Patent and Trademark Office - Denver, CO</p>
1:05 pm	<p>Break</p>
1:20 pm 0.75 hr	<p>Update on Patent Litigation before the ITC</p> <p>A review of the major legal developments affecting patent cases before the ITC, including the Federal Circuit's upcoming <i>en banc</i> rehearing in <i>Suprema</i> and its potential impact on future investigations involving method claims, changes and clarifications to the domestic industry requirement, and recent decisions relating to the enforcement of consent orders.</p> <p>Lynn I. Levine, Morrison & Foerster LLP - Washington, DC T. Cy Walker, Kenyon & Kenyon - Washington, DC</p>
2:05 pm 0.75 hr	<p>Design Patents: The Good, The Bad, and The Ugly</p> <p>To cover the landscape of hot design patent topics, including recent Federal Circuit decisions clarifying functionality and obviousness, the USPTO's proposed written description requirement for designs, and design patent damages, i.e., the entire profits rule as framed in <i>Apple v. Samsung</i>.</p> <p>Perry Saidman, Saidman DesignLaw Group, LLC - Silver Spring, MD</p>

2:50 pm 0.50 hr	<p>Claims Construction</p> <p>What is the standard of review for patent claim constructions in light of recent cases, including the impact of the Supreme Court's <i>Teva Pharmaceuticals</i> case?</p> <p>Edward D. Manzo, Husch Blackwell LLP - Chicago, IL</p>
3:20 pm	Break
3:30 pm 0.50 hr	<p>Update from the PTAB: Report on Public Comments and Proposed Rules</p> <p>Hon. Scott Boalick, Deputy Chief Judge (Acting), Patent Trial and Appeal Board, U.S. Patent and Trademark Office - Alexandria, VA</p>
4:00 pm 0.75 hr	<p>Lessons Learned: Tips and Strategies for Practicing Before the PTAB</p> <p>A discussion of PTAB trial mechanics as seen from the perspectives of judges, petitioners, and patent owners. The panel shares their experiences from real cases on what works most effectively, mistakes to avoid, and how to best position a case for appeal to the Federal Circuit.</p> <p>Moderator: David L. McCombs, Haynes and Boone, LLP - Dallas, TX</p> <p>Panelists: Scott A. McKeown, Oblon, McClelland, Maier & Neustadt, L.L.P. - Alexandria, VA Hon. Grace Obermann, Patent Trial and Appeal Board, U.S. Patent and Trademark Office - Alexandria, VA Hon. Teresa Stanek Rea, Crowell & Moring, LLP - Washington, DC</p>
4:45 pm 0.75 hr	<p>Impact of PTAB Proceedings on Patent Practice and Patent Owners</p> <p>The new contested proceedings have fundamentally changed the patent enforcement, licensing and monetization environment. How is this playing out in patent practice?</p> <p>Moderator: Robert Greene Sterne, Sterne, Kessler, Goldstein & Fox P.L.L.C. - Washington, DC Christopher C. Gallagher, New Venture Advisors - Washington, DC</p> <p>Panelists: Hon. Paul R. Michel, Chief Judge, Retired, United States Court of Appeals for the Federal Circuit - Washington, DC Kevin G. Rivette, 3LP Advisors LLC - Palo Alto, CA Hon. James D. Smith, Chief Judge, Patent Trial and Appeal Board, U.S. Patent and Trademark Office - Alexandria, VA</p>
5:30 pm	Adjourn

Friday Morning, Mar. 13, 2015

Presiding Officer:

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

7:30 am	<p>Conference Room Opens</p> <p>Includes continental breakfast.</p>
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8:30 am 0.50 hr	Inside the USPTO's Office of the General Counsel Sarah T. Harris, Office of the General Counsel, U.S. Patent and Trademark Office - Alexandria, VA
9:00 am 1.00 hr ethics	The Duty of Candor in USPTO Contested Proceedings A discussion of the "old" and "new" candor obligations of practitioners—their sources, their reach and applicability, and the potential consequences for their breach—in the context of the representation of clients in the new USPTO post-grant contested proceedings. Lisa A. Dolak, Syracuse University College of Law - Syracuse, NY
10:00 am 0.50 hr	Feeshifting under Section 285 A discussion about what makes the case "exceptional" after <i>Octane Fitness</i> and <i>Highmark</i> . Jeffrey D. Feldman, Feldman Gale, P.A. - Miami, FL
10:30 am	Break
10:45 am 0.50 hr	Damages and Remedies An update on acceptable patent damages methodology reflecting insights from recent decisions and the thoughts of damages experts. Shirley Webster, Ocean Tomo, LLC - Houston, TX
11:15 am 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. Leonard Davis, U.S. District Court, Eastern District of Texas - Tyler, TX Hon. James F. Holderman, U.S. District Court, Northern District of Illinois - Chicago, IL Hon. Liam O'Grady, U.S. District Court, Eastern District of Virginia - Alexandria, VA
12:15 pm	Pick Up Lunch Included in registration.

Friday Afternoon, Mar. 13, 2015

Presiding Officer:

John W. Ryan, Shipman & Goodwin LLP - Washington, DC

LUNCHEON PRESENTATION

12:45 pm 0.75 hr	<p>View from the Federal Circuit</p> <p>Hon. Kimberly A. Moore, U.S. Court of Appeals for the Federal Circuit - Washington, DC</p> <p>Moderators: Jeremiah S. Helm, Office of the Solicitor, U.S. Patent and Trademark Office - Alexandria, VA John F. Murphy, Baker & Hostetler LLP - Philadelphia, PA Hon. Beth Z. Shaw, Patent Trial and Appeal Board, U.S. Patent and Trademark Office - Alexandria, VA</p>
1:30 pm	<p>Break</p>
1:45 pm 0.50 hr	<p>Due Diligence in IP M&A Transactions</p> <p>A discussion of IP diligence post-AIA, and the resulting considerations in planning, conducting diligence, and negotiating M&A transactions.</p> <p>Jeffrey A. Wolfson, Haynes and Boone, LLP - Washington, DC</p>
2:15 pm 1.00 hr	<p>Key Issues for In-House Counsel</p> <p>In-house patent counsel balance many issues around portfolio management and costs to file, prosecute and maintain patents, post-grant patent proceedings, litigation and other dispute resolution processes, outside counsel management, etc. Explore these challenges across several industries and hear best practices from those who have faced them.</p> <p>Moderator: P. Michael Walker, DuPont - Wilmington, DE</p> <p>Panelists: Stasia Ogden, Baxter Healthcare Corporation - Deerfield, IL Kevin H. Rhodes, 3M Innovative Properties Company - Saint Paul, MN Manny W. Schechter, IBM Corporation - Armonk, NY</p>
3:15 pm 1.00 hr ethics	<p>Ethics: Send Ethics, Lawyers, and Money?</p> <p>A range of ethical issues relating to finances has arisen. Lawyers need to consider the impact of <i>Octane</i> on their practice. They need to understand the ethical issues that can arise from alternative fee arrangements, such as flat and capped fees, both in litigation and prosecution. There are also thorny issues such as choice of law that come with multi-state federal litigation.</p> <p>David Hricik, Mercer University School of Law and Taylor English Duma LLP - Macon and Atlanta, GA</p>
4:15 pm	<p>Adjourn</p>