

12TH ANNUAL
**ADVANCED PATENT LAW
INSTITUTE**



March 9–10, 2017

United States Patent and Trademark Office ■ Alexandria, Virginia

Earn up to 15.00 Hours of Credit Including 2.00 Hours of Ethics Credit
Approved in TX, CA, DE, FL, IL, OH, and PA. Reciprocity in NJ and NY.

Expected in OK and VA.

Special rules apply in VA: 13.00 Hours of MCLE Credit including 2.00 Hours of Ethics (Expected)

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Approved in TX, CA, DE, FL, IL, OH, and PA. Reciprocity in NJ and NY.
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THURSDAY MORNING, MAR. 9, 2017

Presiding Officer:

Hon. David P. Ruschke, U.S. Patent and Trademark Office, Patent Trial and Appeal Board, Alexandria, VA

7:30 a.m. Registration Opens

Includes continental breakfast.

8:20 a.m. Welcoming Remarks

8:30 a.m. 1.25 hrs

The Current Patent Landscape in the U.S. and Abroad

Discuss current issues around patenting, licensing, enforcing, and monetizing patents in the U.S., and look at what the UK, EU, and China are experiencing and the impact on U.S. patent practice.

Moderators:

Robert Greene Sterne, Sterne, Kessler, Goldstein & Fox P.L.L.C., Washington, DC
Hon. Paul R. Michel, Chief Judge, Retired, United States Court of Appeals for the Federal Circuit, Washington, DC

Panelists:

Paul Evans, Vivint, Inc, Provo, UT
Damon C. Matteo, Fulcrum Strategy, Palo Alto, CA
Julie Mar-Spinola, Finjan Holdings, Inc, East Palo Alto, CA
Paul A. Stone, 5AM Ventures, Menlo Park, CA

9:45 a.m. Break

10:00 a.m. .75 hr

Section 101: Recent Decisions and the Impact on Software and High Technology Claims

Review significant *post-Alice v. CLS Bank* cases addressing patent subject matter eligibility of software and high technology claims, with an emphasis on lessons learned. Hear practice tips gleaned from the guidance provided by Federal Circuit opinions in *DDR Holdings*, *Enfish*, *BASCOM*, *McRo*, and *Amdocs*.

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

10:45 a.m. .75 hr

Section 101 and Lifesciences: Current U.S. and International Perspectives

The United States 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 subject matter eligibility law in the U.S. is decidedly not aligned with this long-standing effort. Examine the current status of U.S. subject matter eligibility for life sciences, understand how it compares to other major international jurisdictions, and explore how the U.S. Patent and Trademark Office might navigate current U.S. case law without devastating the life sciences industry.

Leslie Fischer, Novartis Pharmaceuticals Corporation, East Hanover, NJ

11:30 a.m. .50 hr

Recent Developments in Design Patents

Hear recent developments in design patent law in the U.S. and abroad, including best practices for filing design applications. Discuss recent trends such as protection of graphical user interface, the Hague System, and the U.S. Supreme Court appeal of the *Apple v. Samsung* case.

Tracy-Gene G. Durkin, Sterne, Kessler, Goldstein & Fox P.L.L.C., Washington, DC

12:00 p.m. Pick Up Lunch

Included in registration.

THURSDAY AFTERNOON

Presiding Officer:

Jeffrey A. Wolfson, Haynes and Boone, LLP, Washington, DC

LUNCHEON PRESENTATION

12:20 p.m. .50 hr

Update from the USPTO

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

Brian E. Hanlon, U.S. Patent and Trademark Office, Alexandria, VA

12:50 p.m. Break

1:05 p.m. .75 hr

USPTO Special Programs for Patent Prosecution

Review special programs for patent prosecution, including Track 1, Patent Prosecution Highway, First Action Interview, AFCP 2.0, P3, and Pre-Appeal Brief programs; followed by Patent Office and practitioner perspectives on the programs and when each one may be most useful.

Courtenay C. Brinckerhoff, Foley & Lardner LLP, Washington, DC
Irem Yucel, U.S. Patent and Trademark Office, Alexandria, VA

1:50 p.m. .50 hr ethics

Changes to the Duties of Disclosure and Implications of Using the Global Dossier

Learn about an ongoing project regarding use of possible IT solutions as an aid in compliance with the duty of disclosure requirements for filers at the USPTO. The ultimate aim is to reduce the administrative costs of this burden to the innovation community, while ensuring legally effective fulfillment of applicants' duty to disclose. Updates include an overview of the issues, comments received to date, and next steps.

Mark R. Powell, U.S. Patent and Trademark Office, Alexandria, VA

2:20 p.m. .50 hr

PTAB Update

Hear an update on PTAB appeals and trial proceedings.

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

2:50 p.m. .50 hr

The Federal Circuit on PTAB Patent Trials: An Overview of Recent Decisions

Examine recent litigation addressing AIA Proceedings at the PTAB: including an overview of recent decisions interpreting the AIA (IPR/PGR proceedings), the agency's rules, and PTAB's application of those rules in specific cases.

Speaker TBD

3:20 p.m. Break

3:30 p.m. 1.00 hr

PTAB Practice and Impacts of Recent Federal Circuit Decisions

While the PTAB evolves and continues to evolve, a number of best practices have been identified. Hear practitioners and judges provide insight and predictions for the future.

Moderator:

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

Panelists:

Scott A. McKeown, Oblon, Spivak, McClelland, Maier & Neustadt, L.L.P., Alexandria, VA
Hon. Stacy B. Margolies, U.S. Patent and Trademark Office, Alexandria, VA
Hon. Kristi L. R. Sawert, U.S. Patent and Trademark Office, Alexandria, VA

4:30 p.m. 1.00 hr

Concurrent Proceedings before PTAB and District Courts

The interplay between PTAB and District Court proceedings is the new reality in patent cases, with trends and lessons continually emerging for both patent owners and challengers. Discuss issues relating to overall case management considerations, timing, stays, intermingled discovery, claim construction, admissibility, weight given to rulings in counterpart proceedings, race to finality, estoppel, and the impact of the Federal Circuit review.

Moderator:

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

Panelists:

Monica Grewal, Wilmer Cutler Pickering Hale and Dorr, Boston, MA
Anthony J. Fitzpatrick, Duane Morris LLP, Boston, MA
Christopher J. Lewis, FLIR Systems, Inc., Wilsonville, OR
Rachel MacGuire, Oracle Corporation, Broomfield, CO

5:30 p.m. Adjourn

FRIDAY MORNING, MAR. 10, 2017

Presiding Officer:

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

7:30 a.m. Auditorium Opens

Includes continental breakfast.

8:30 a.m. .75 hr

Recent Developments at the ITC

Explore several important developments in Section 337 litigation at the ITC, including: the increased number of Section 101 rulings at the ITC in 2016, the ITC's accelerated disposition programs, the effect of the Federal Circuit's decision in *ClearCorrect v. ITC*, and the impact of PTAB proceedings on ITC investigations.

Daniel P. Muino, Morrison & Foerster LLP, Washington, DC
Anne Goalwin, U.S. International Trade Commission, Washington, DC

9:15 a.m. .75 hr

Claims Construction

Claim construction remains pivotal for patent preparation/prosecution, trials, appeals, and AIA post grant review proceedings. Focus on the latest post-Teva Federal Circuit cases and the PTAB's claim construction "rules, practices and so-forth," including Dell/SAS and APA restrictions.

Kenneth R. Adamo, Kirkland & Ellis LLP, Chicago, IL

10:00 a.m. .50 hr ethics

Harmonization and Enforcement of USPTO Ethical Standards in the AIA Era

Explore present day ethical issues affecting attorneys and agents who practice before the USPTO, including ethical standards under the USPTO Rules of Professional Conduct, the mechanics of OED's complaint and investigative process, the ethical impact of the AIA on practitioners and OED, and practical examples and statistics relating to OED enforcement.

Speaker TBD

10:30 a.m. Break

10:45 a.m. .75 hr

Willful Patent Infringement After the Supreme Court's Opinion in *Halo v. Pulse* and its Progeny

Assess the impact of *Halo's* new standard for finding willfulness and awarding enhanced damages, the new burden of proof, the new standard for appellate review, opinions of counsel, and related litigation strategy issues.

William L. LaFuze, McKool Smith, Houston, TX

11:30 a.m. 1.00 hr

Judicial Panel

Distinguished judges discuss their experiences hearing and trying patent cases, with a focus on concurrent proceedings, stays, and IPRs, as well as a review on new FRCP regarding eDiscovery.

Moderator:

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

Panelists:

Hon. T. S. Ellis III, U.S. District Court, Eastern District of Virginia, Alexandria, VA
Hon. Faith S. Hochberg, U.S. District Judge (ret.), Judge Hochberg ADR, New York City, NY
Hon. Gregory M. Sleet, U.S. District Court, District of Delaware, Wilmington, DE

12:30 p.m. Pick Up Lunch

Included in registration.

FRIDAY AFTERNOON

Presiding Officer:

John W. Ryan, Gordon Rees Scully Mansukhani, LLP, Washington, DC

LUNCHEON PRESENTATION

1:00 p.m. .50 hr

View from the Federal Circuit

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

1:30 p.m. Break

1:45 p.m. 1.00 hr

The New Section 102

Explore the new Section 102, while focusing on the two areas of uncertainty within the new Section: does prior art need to be "available to the public" (see *Helsinn Healthcare v. Teva Pharmaceuticals*, on appeal to the Federal Circuit); and whether the one-year grace period under the new section is as robust as the one-year grace period under the previous section (or whether it is too soon to tell)?

Robert Bahr, U.S. Patent and Trademark Office, Alexandria, VA
Dale S. Lazar, DLA Piper LLP US, Reston, VA

2:45 p.m. .75 hr

Year in Review: Other Key Cases from the Federal Circuit and Supreme Court

Discuss the major patent decisions made this past year and their possible impact on patent practice, including those from the Supreme Court and the Federal Circuit.

Christopher A. Cotropia, Intellectual Property Institute, University of Richmond School of Law, Richmond, VA

3:30 p.m. 1.00 hr ethics

Privilege in Patent Cases: What's New?

Analyze the patent agent-client privilege, privilege problems when in-house counsel is registered by the USPTO or a state to advise an employer (but not licensed in the state), and recurring problems when patents are assigned.

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

4:30 p.m. Adjourn

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INSTITUTE HIGHLIGHTS

The 12th Annual Advanced Patent Law Institute at the U.S. Patent and Trademark Office offers a unique opportunity to join USPTO senior staff, leading practitioners, academics, and members of the federal judiciary for two days of presentations on the latest developments in patent law, including:

- A discussion on the current patent landscape in the U.S. and overseas, with an emphasis on the state of licensing, enforcing and monetizing patents in the U.S., as well as a look at the impact of practices and policies in the UK, EU, and China
- Section 101 and the impact of recent decisions on software and technology claims, as well as current U.S. and international perspectives on patent eligibility in lifesciences
- PTAB updates and proceedings: a look at recent decisions from the Federal Circuit, practice tips and tactics based on those decisions, and considerations and strategies in concurrent proceedings before the PTAB and District Courts
- An examination of ITC and Section 337 Jurisdiction and the impact of recent Federal Circuit decisions affecting IPRs
- Developments in design patents
- Willful infringement and the impact of *Halo*, including discussion on enhanced damages, opinion letters, and attorney's fees
- Topics in USPTO practice, including a look at the USPTO's special programs for Patent Prosecution, changes to the duties of disclosure and the implications of using the Global Dossier, plus enforcement of the USPTO's ethical standards
- Presentations from members of the judiciary including a keynote presentation by a Federal Circuit Judge and the popular *Judicial Panel*
- Up to 15.00 hours of credit (13.00 hours in Virginia), including 2.00 hours of ethics

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Invoices, confirmations, and receipts are emailed to these addresses.

REGISTRATION—Includes Electronic Course Materials, Thursday Luncheon Presentation, and Friday Luncheon Presentation

Special group registration rates available. Call 512.475.6700.

Select Registration Type

- Individual registration by March 1. \$695
 Individual registration after March 1. \$745

USPTO Employee

- Employee registration \$250

Printed course binder available for an additional fee through March 1

Conference registration includes Electronic Course Binder Download (PDF) in "Your Briefcase" at utcle.org.

- Printed Course Binder \$27.06
Price includes 8.25% Sales Tax
 Printed Course Binder for tax exempt registrants. \$25
(e.g., government employees and nonprofits)

ECONFERENCE—For Texas MCLE Credit

Complete eConference package includes all conference materials for download from "Your Briefcase" at utcle.org. Available 6–8 weeks after the live conference date.

- Individual eConference \$645
Call (512) 475-6876 to register additional participants

COMPLETE CONFERENCE MATERIALS[†]—For Research and Self-Study

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- eBinder Download (PDF) \$225
 Printed Binder. \$275
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ALEXANDRIA, VIRGINIA

March 9–10, 2017

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 1, 2017

*last day for early registration
 add \$50 for registrations
 received after this time*

March 3, 2017

last day for cancellation (full refund)

March 6, 2017

*last day for cancellation (partial refund)
 \$50 processing fee applied*

March 9, 2017, 8:20 a.m.

Institute begins

ADVANCED PATENT LAW INSTITUTE ACCREDITATION

CALIFORNIA—15.00 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 ethics

The 12th Annual Advanced Patent Law Institute, scheduled for March 9-10, 2017 in Alexandria, has been approved for 14.00 credits, including 2.00 Enhanced Ethics credits, by the Delaware Judiciary Commission on CLE.

ILLINOIS—15.00 hrs | 2.00 ethics

This course has been submitted for CLE approval by the Minimum Continuing Legal Education Board of the Supreme Court of Illinois for 15.00 total general CLE (including Professional Responsibility).

NEW JERSEY—16.80 hrs | 2.40 ethics

As The University of Texas School of Law is a State Bar of Texas approved MCLE provider (Sponsor #13), our courses are presumptively approved for MCLE credit based on a 50-minute credit hour, and in accordance with the Regulations of the Supreme Court of New Jersey Board on Continuing Legal Education.

NEW YORK—18.00 hrs | 2.50 ethics

As The University of Texas School of Law is a State Bar of California approved MCLE provider (#1944), our courses are presumptively approved for MCLE credit based on a 50-minute credit hour, and in accordance with the Program Rules and the Regulations and Guidelines of the New York State Bar Association.

OHIO—13.00 hrs | 2.00 hrs ethics

This course has been submitted to the Supreme Court of Ohio Commission on Continuing Legal Education for 15.00 total CLE hours, with 2.00 of ethics instruction.

OKLAHOMA—18.00 hrs | 2.50 ethics (Expected)

The University of Texas School of Law is an Oklahoma Bar Association presumptively approved provider (#169).

PENNSYLVANIA—14.00 hrs | 2.00 ethics

This program has been submitted to the Pennsylvania Continuing Legal Education Board for 14.00 hours of substantive law, practice and procedure CLE credit and 2.00 hours of ethics, professionalism or substance abuse CLE credit.

TEXAS—15.00 hrs | 2.00 hrs ethics

This course has been approved for Minimum Continuing Legal Education credit by the State Bar of Texas Committee on MCLE in the amount of 15.00 hours, of which 2.00 credit hours will apply to legal ethics/professional responsibility credit.

VIRGINIA—13.00 hrs | 2.00 ethics (Expected)

This course has been submitted for MCLE approval to the Virginia State Bar Mandatory Continuing Legal Education Board.

OTHER STATES

Many jurisdictions accept conferences offered by The University of Texas School of Law, and approved by the State Bar of Texas, for CLE credit. Please check with your jurisdiction's regulatory authority. A Certificate of Attendance and credit reporting documentation will be provided at the conference.