7TH ANNUAL

ADVANCED PATENT LAW

A unique series of presentations by senior USPTO officials, leading academics, practitioners, and members of the judiciary.

January 19–20, 2012
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Madison Building, Main Auditorium

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### THURSDAY MORNING, JAN. 19, 2012

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<table>
<thead>
<tr>
<th>Time</th>
<th>Event</th>
<th>Duration</th>
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<tbody>
<tr>
<td>8:00 a.m.</td>
<td>Registration Opens</td>
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<td></td>
<td>Includes continental breakfast</td>
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<td>8:50 a.m.</td>
<td>Welcoming Remarks</td>
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<tr>
<td>9:00 a.m.</td>
<td>Patentable Subject Matter in 2012: Where Are We?</td>
<td>.75 hr</td>
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<td>The panel discusses the current state of the law in light of recent case precedent.</td>
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<td>Gregory A. Castanias, Jones Day, Washington, DC</td>
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<td>9:45 a.m.</td>
<td>Developments in Claim Construction</td>
<td>.75 hr</td>
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<td>Despite marked changes in other areas of IP law driven by the Federal Circuit and the Court, and the onset of the leadership and personnel shift on the Federal Circuit bench, the Copernican centrality of claim construction to preparation, prosecution and litigation remains seemingly unchallengeable. The state of play, whether attempts have been made to move off Phillips or simply to focus and refine, is addressed, discussed and queried.</td>
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<td>Kenneth R. Adamo, Kirkland &amp; Ellis LLP, Chicago, IL</td>
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<tr>
<td>10:30 a.m.</td>
<td>Break</td>
<td>.75 hr</td>
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<tr>
<td>10:45 a.m.</td>
<td>Claims Drafting Practice Tips: Recent Examiner Training Topics and Avoiding Practitioner Pitfalls</td>
<td>.75 hr</td>
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<td>The USPTO recently conducted examiner training to highlight certain areas of concern relating to indefinite claim language. These areas are reviewed with an emphasis on what examiners have been instructed to look for when analyzing claims for definiteness, and what it then means for practitioners.</td>
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<td>Caroline Dennison, U.S. Patent and Trademark Office, Alexandria, VA</td>
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### 11:30 a.m.  
**Synchronizing Specification and Claims for Strong (Valid) Patents**  
**.75 hr**

The inventor creates the invention. But who creates the claims? The inventor? The patent practitioner? Implicit in Federal Circuit decisions is that the Court is more confident that the inventor created the described embodiments/examples than the claims. If the claims reach too far beyond the disclosed embodiments/examples, the claims are often construed more narrowly than the ordinary meaning of the claims would suggest, or the claims are held invalid for lack of written description support. This session discusses what needs to be done with patent specifications so that broad claims are interpreted broadly and found to be valid.

Dale S. Lazar, DLA Piper, Reston, VA

### 12:00 p.m.  
**USPTO Update: View from the Director**  
**.67 hr**

**12:35 p.m.**  
**Keynote Luncheon Presentation**

**1:15 p.m.**  
**Break**

### 1:30 p.m.  
**IP Development in China: Practical Issues and Strategic Significance**  
**.75 hr**

China is a mega-trend altogether—not just in IP—but the strategic significance of China as an IP trend is overriding and it informs the future of IP altogether. This panel discusses practical issues concerning IP development and enforcement in China and the larger strategic significance of Chinese IP altogether. In particular, the panel discusses the Silicon Valley perspective and the question of whether California is becoming the East Coast of Asia.

Christopher J. Byrne, Tessera Technologies, San Jose, CA  
Hoo-min D. Toong, IPVision, Silicon Valley, USA

### 2:15 p.m.  
**Strategic Use of Design Patents**  
**.75 hr**

This presentation covers three distinct, but related, topics in design patent law: (1) the overlap between design patents and utility patents, i.e., how design patents can be used to protect functional features of products and how utility patents can be used to protect ornamental features; (2) an update on the aftermath of the Federal Circuit’s landmark Egyptian Goddess design patent infringement decision; and (3) tips on how to use design patents effectively in a modern design enforcement program.

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

### 3:00 p.m.  
**Break**

### 3:15 p.m.  
**Joint Infringement**  
**.75 hr**

In two pending en banc Federal Circuit cases, the Court is grappling with the scope of joint/divided infringement: “If separate entities each perform separate steps of a method claim, under what circumstances would the claim be directly infringed?” This presentation examines the prosecution and litigation strategies for dealing with joint/divided infringement issues.

**Moderator:**  
John W. Ryan, Thompson Hine LLP, Washington, DC

**Panelists:**  
Phillip B. Philbin, Haynes and Boone, LLP, Dallas, TX  
Hans Sauer, Biotechnology Industry Organization, Washington, DC
4:00 p.m.  .75 hr
Damages and Injunctive Relief: Remedies from a Prosecution Perspective
A discussion of how to write specifications and draft claims with an eye toward maximizing damages and obtaining injunctive relief in patent litigation.
Topics include identifying base inventive concepts and drafting claims of varying scope.
   James M. Heintz, DLA Piper, Reston, VA

4:45 p.m.  .75 hr ethics
Ethics in a Post-Issue Review World
The America Invents Act creates many new types of post-issuance review. Each procedure has different deadlines, allows challenges based on different grounds, and creates different preclusion consequences for unsuccessful petitioners (and for the “real party in interest” or “privo” of a petitioner). Practitioners will need to consider their duties of care and diligence in advising their clients, as well as their duties to the PTO, when invoking these new procedures.
   Ragesh K. Tangri, Durie Tangri LLP, San Francisco, CA

5:30 p.m.  Adjourn
FRIDAY MORNING, JAN. 20, 2012
Presiding Officer:
Edward J. Kessler, Sterne, Kessler, Goldstein & Fox, P.L.L.C., Washington, DC

8:00 a.m.  Conference Room Opens
Includes continental breakfast.

PATENT REFORM:
2012 GUIDE FOR PRACTITIONERS

8:15 a.m.  .50 hr
An Overview of the Prosecution and Litigation Landscape after Patent Reform
The America Invents Act is one of the most major patent reforms since 1952. This presentation provides an overview of the Act, focusing on the big changes patent prosecutors and patent litigators should know.
   Christopher A. Cotropia, Intellectual Property Institute, University of Richmond School of Law, Richmond, VA

8:45 a.m.  .75 hr
New Rules Packages: The USPTO’s Implementation of the America Invents Act
USPTO officials discuss the agency’s implementation of various provisions of the America Invents Act, including proposed rules related to supplemental examination, third-party submission of prior art, post-grant review, and inter partes review.

9:30 a.m.  1.00 hr
The panel discusses how corporations are adjusting their portfolio development and patent defense strategies in response to the new legislation. Topics include internal education and modifications to in-house procedures; new filing and claiming techniques, including practical advice on how to effectively practice under the proposed rules; maximizing availability of new defenses to infringement; proactive use of post-grant review proceedings; litigation changes; and continued reform through rule-making, industry collaboration, and ongoing AIA studies.
   Moderator:
   David L. McCombs, Haynes and Boone, LLP, Dallas, TX
   Panelists:
   Jeffrey D. Feldman, Feldman Gale, Miami, FL
   Stephen G. Kunin, Oblon, Spivak, McClelland, Maier & Neustadt, LLP, Alexandria, VA
   David L. Marcus, Comcast Cable Communications, LLC, Philadelphia, PA
   Bradley C. Wright, Banner & Witcoff, Ltd., Washington, DC

10:30 a.m.  Break

10:45 a.m.  .83 hr
Reexam and Its Impact on Enforcement, Monetization and Valuation of Patents
Current inter partes and ex parte reexamination and the soon to be instituted post grant review, inter partes review, pre-issuance submissions, supplemental examination and derivations proceedings at the USPTO are having or will have a profound impact on U.S. patents. These proceedings and the interface with the Federal Courts and the USITC are reviewed.
   Moderator:
   Robert Greene Sterne, Sterne, Kessler, Goldstein & Fox, P.L.L.C., Washington, DC
   Panelists:
   James W. Marondo, Farella Braun + Martel, LLP, San Francisco, CA

11:35 a.m.  .75 hr
Processes and Trends at the U.S. Supreme Court
This presentation discusses the Supreme Court's increased willingness to take on patent-related cases and what seems to be of interest to the Court.
   Seth P. Waxman, Wilmer Cutler Pickering Hale and Dorr LLP, Washington, DC

12:20 p.m.  Break for Lunch
Included in conference registration fee.
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Includes Course Binder and Thursday and Friday Sponsored Luncheon Presentations

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☐ Registration Fee after Monday, January 9, 2012 ........................................................................ $695

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☐ Early Registration Fee due by Monday, January 9, 2012 .......................................................... $250
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Alexandria, Virginia
January 19–20, 2012

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USPTO – Main Auditorium
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(subject to availability)

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Key Dates
January 9, 2012, 5 p.m.
last day for early registration
add $50 for registrations received after this time

January 11, 2012, 5 p.m.
last day for full refund

January 13, 2012, 5 p.m.
last day for partial refund
$50 processing fee applied

January 19, 2012, 9 a.m.
Institute begins

December 8–9, 2011
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Come to Palo Alto in the heart of Silicon Valley and join leading judges and practitioners from major corporations such as Nike, Google, and Cisco. The Institute is jointly presented with the Berkeley Center for Law and Technology at UC Berkeley and the Stanford Program in Law, Science and Technology.