



U.S. Update – Effective Strategies for making the most of the AIA and Supreme Court Changes in U.S. Patent Law

19 – 20 april

The U.S. Patent system is undergoing great reform by recent acts of the U.S. legislative and judicial branches of government. Congress has recently passed the America Invents Act (AIA), an Act which will implement sweeping changes to the core of the U.S. Patent system. The Supreme Court, over the last five years, has also taken a much more active role to impose its will upon the U.S. Patent system. This two-day seminar is intended to provide participants with an in-depth understanding of the legislatively enacted AIA and of judicially imposed Supreme Court mandates over the last half decade, to better enable participants to effectively strategize patent filing, application drafting and prosecuting, as well as post-grant enforcing of patents.

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U.S. Legislative Reform: Congress has recently enacted the America Invents Act (the AIA), implementing extensive patent reform of the U.S. patent laws which are being phased in over an 18 month period. An in-depth study of the AIA, USPTO implementation of the Act and recommended strategies for drafting and prosecuting U.S. applications in light of the America Invents Act will be provided.

09.30 – 09.45 Introduction

09.45 – 11.00 Session 1 - AIA overview

- Overall discussion of the America Invents Act
- First look into potential AIA ramifications regarding Patent practice in the United States

11.00 – 11.15 Break

11.15 – 12.30 Session 2 - USPTO updates on AIA implementation

- USPTO proposed rules/guidelines/procedures developed to deal with Patent Reform under the AIA
- What are the fee changes proposed by the USPTO?
- PTO goals regarding fee changes
 - USPTO goal - 10 months first OA/ 20 months pendency
 - The AIA authorizes the USPTO to set or adjust fees by rule for a period of 7 years
- Oath/Declaration issues – Assignee filing
- Post-grant procedures
 - *Supplemental examination*
 - *Post-grant review*
- Other new issues

12.30 – 13.30 Lunch

13.30 – 15.30 Session 3 - Strategies for drafting, filing and prosecuting applications in view of the AIA

- Effects of first to invent or disclose system under the AIA
- Potential Traps:
 - *Significance of March 16, 2013*
 - *Circumventing the AIA before filing in the U.S.*
- Importance of correct assignments
- Filing/prosecuting strategies in view of proposed fee changes
- Application and Claim drafting/revising strategies to shorten patent prosecution
- After March 16, 2013:
 - *Applicable law to applications and issued patents*
 - *What becomes prior art?*
 - *Being prepared before the critical date*

15.30 – 15.45 Break

15.45 – 16.30 Session 4 - Third party involvement under the AIA

- Prior art submissions
- Post-grant attacks, etc.

U.S. Judicial Reform: The U.S. Supreme Court has become more active in recent years, exerting their influence over U.S. Patent Laws. An in-depth look at U.S. Supreme Court decisions over the last five years and analysis of their effects on U.S. Patent drafting and prosecution, and post-grant issues will be provided. Upcoming precedential decisions and what the future holds will also be discussed.

08.45 – 10.45 **Session 1 – Post-KSR Obviousness**

- Overview of KSR v. Teleflex
- KSR-Obviousness Guidelines set forth by the USPTO
- Post-KSR decisions
 - *Mechanical/Electrical cases and strategies for overcoming obviousness rejections*
 - *Chemical/Biotech cases and strategies for overcoming obviousness rejections*
- Discussions of U.S./European differences

10.45 – 11.00 Break

11.00 – 12.15 **Session 2 – Post-Grant Invalidity/Infringement Issues**

- *Medimmune Inc. v. Genentech Inc: Is a breach or termination of a license agreement needed to assert non-infringement, invalidity, or unenforceability?*
- *Microsoft v. I4i Limited Partnership: Is “clear and convincing” evidence needed for invalidity?*
- *Quanta Computer Inc. et. al. v. LG Electronics, Inc: Does a sale of a device exhaust a patented method?*
- *Microsoft v. ATT: What is needed to qualify as an infringing export?*
- *Global-Tech v. SEB: How does willful blindness affect inducement to infringe?*
- *Stanford v. Roche: What is the effect of an insufficient assignment of rights?*

12.15 – 13.15 Lunch

13.30 – 15.30 **Session 3 - §101 Patentable Subject Matter Issues**

- Overview of *Bilski v. Doll*
- Post-Bilski decisions and ramifications
- Guidelines set forth by the USPTO
- Strategies for claiming/drafting electrical/mechanical applications
- The chemical/biotech perspective on patentable subject matter
 - *Mayo Collaborative Services v. Prometheus Laboratories*
 - *Myriad v. The Association of American Pathology*
 - *Classen Immunotherapies v. Biogen Idec.*
- Strategies for claiming/drafting chemical/biotech applications

14.30 – 14.45 Break

14.45 – 15.30 **Session 4 - Upcoming Supreme Court Decisions**

- *Caraco Pharmaceutical Laboratories Ltd. v. Novo Nordisk A/S*
- *Kappos v. Hyatt*



Donald J. Daley, Principal

Donald J. Daley is one of the founding principals of Harness Dickey's Reston Virginia office. Mr. Daley's practice involves preparing and prosecuting domestic, international and PCT patent applications in the electrical/computer arts, patent litigation, client counseling, and drafting various types of intellectual property agreements and expert opinions of counsel. While in law school, Mr. Daley worked as a patent examiner at the United States Patent and Trademark Office, examining patent applications in the technical fields of image data compression/coding, neural network and expert systems, pattern recognition, and various aspects of digital image processing.



John W. Fitzpatrick, Principal

John W. Fitzpatrick has over fifteen years of experience in intellectual property law. Mr. Fitzpatrick's practice includes patent application preparation and prosecution in a wide variety of technical areas including electrical switches; medical imaging devices; semiconductors including semiconductor structure, semiconductor wafer processing and equipment and semiconductor fabrication and packaging; display devices such as LCD, LED and plasma displays; digital cameras; wireless communication systems; global positioning navigation and satellite communication systems; fiber optic systems; digital image processing and audio and video consumer electronics. Other areas of Mr. Fitzpatrick's practice include providing non-infringement and invalidity opinions, licensing strategies and the preparation of related agreements. Prior to joining the firm, he gained valuable experience working as in-house counsel.



Leanne M. Rakers, Senior Associate

Leanne Rakers is a senior Associate at Harness Dickey. Ms. Rakers' patent practice concentrates on preparing and prosecuting patent applications in pharmaceutical, life science and biotechnological arts, including small molecule chemistry, organometallic chemistry, therapeutic methods and diagnostics, recombinant DNA technology, biofuel production and process & analytical chemistry. She prepares legal opinions, including patent infringement, freedom-to-practice, and due-diligence assessments. Ms. Rakers also has patent and FDA regulatory experience including Patent drug FDA expertise, Patent Term Extension applications and Orange book assessments. Ms. Rakers studied cell cycle inhibitors and suppressors of cytokine signaling at Pennsylvania State University and GlaxoSmithKline Pharmaceuticals. Subsequently, Ms. Rakers focused on recombinant protein expression at Sigma-Aldrich Corporation.

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