



Effective Strategies for Preparing for and Surviving both Legislative (the AIA) and Judicial (the Supreme Court) Changes in U.S. Patent Law **18 – 19 September**

Overview – The U.S. Patent system is undergoing great reform by recent acts of the U.S. legislative and judicial branches of government. Congress passed the America Invents Act (AIA) on September 16, 2011, an Act which will implement sweeping changes to the core of the U.S. Patent system. At the time that this two-day seminar takes place, the AIA will be one year old and only about six (6) months will remain before the critical transition of the U.S. patent system, from a first to invent system to a first inventor to publish or file system under the AIA. Further, the Supreme Court, over the last five years, has also taken a much more active role in imposing its will upon the U.S. Patent system.

This two-day seminar is intended to timely provide participants with an in-depth understanding of the legislatively enacted AIA prior to the March 16, 2013 critical date 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; and to effectively understand and appreciate post-grant effects on patents.

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18 september

U.S. Legislative Reform: Congress enacted the America Invents Act (the AIA) nearly one year ago, implementing extensive patent reform of the U.S. patent laws which are being phased in over an 18 month period, ending March 16, 2013. An in-depth study of the AIA, post-grant proceedings, 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.

08.45 – 09.00 Introduction

09.00 – 10.45 Session 1 - AIA overview

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

10.45 – 11.00 Break

11.00 – 12.15 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
- Oath/Declaration issues – Assignee filing
- Pressuance submissions
- Post-grant procedures
 - *Upplemental examination*
 - *Post-grant review*
- Other new issues

12.15 – 13.15 Lunch

13.15 – 15.15 Session 3 - Strategies for drafting, filing and prosecuting applications in view of the AIA

- Application drafting/claim drafting strategies
- Filing strategies
 - *Understanding Difference of First to File/Disclose vs. First to Invent*
 - *Controlling the applicable law*
 - *Post 16 March 2013 filing strategies*
- Prosecution Strategies to Combat Potential Fee Increases under the AIA
 - *Understanding why Examiners desire RCEs*
 - *Understanding proper/improper final rejections*
 - *Understanding the Pre-Appeal Process*
- Understanding the Value of U.S. Continuation practice
- Tracking correct application of old law and new law

15.15 – 15.30 Break

15.30 – 17.00 Session 4 - Third party involvement under the AIA

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

19 September

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 – 11.00 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*

11.00 – 11.15 Break

11.15 – 12.45 Session 2 – Post-Grant Invalidity Issues

- Infringement – Exhaustion of Patent Rights and Extra-territorial extensions of U.S. patent laws:
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?); and Global-Tech v. SEB (Willful blindness and the knowledge requirement for inducement to infringe); and
- Standing and other evidentiary issues:
Medimmune Inc. v. Genentech Inc. (Standing to assert non-infringement, invalidity, or unenforceability); Stanford v. Roche (Sufficiency of assignment of rights); Kappos v. Hyatt (Submission of new evidence in a District Court appeal from the BPAI); and Microsoft v. I4i Limited Partnership (Invalidity standards).

12.45 – 13.45 Lunch

13.45 – 15.15 Session 3 - §101 Patentable Subject Matter Issues

- Overview of Bilski v. Kappos
- Post-Bilski decisions and ramifications
- Strategies for claiming/drafting electrical/mechanical applications

15.15 – 15.30 Break

15.30 – 17.00 Session 4 –Chemical/Bio-tech Issues

- Caraco Pharmaceutical Laboratories, Ltd. v. Novo Nordisk (Hatch-Waxman and use codes)
- Overview of Mayo Collaborative Services v. Prometheus Laboratories (Patentability of method claims in the chemical/bio-tech world)
- Myriad v. The Association of American Pathology (Gene patents)
- Strategies for claiming/drafting chemical/biotech applications



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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