



Session Description

Details by Day

(revised June 9th, 2015)

SATURDAY PRE-CONFERENCE

Challenges and Opportunities of IP in the Cannabis Industry

Professors Viva Moffat and Sam Kamin

Marijuana law is in a state of flux in the United States – while it remains prohibited at the federal level, an increasing number of states are allowing its *use* by some adults. This dual legal status affects employment, contract, banking, and family law matters. An under-explored area of tension, however, is the fact that federal intellectual property protections are for the most part unavailable to the marijuana industries. Because the bulk of IP law is federal, the federal prohibition on marijuana means that many of the federal protections and regulatory benefits (and burdens) of that body of law are unavailable to those in the marijuana industry and to those interacting with that industry. This has two unexpected results. One is that state-level IP-like rights will be put under pressure. To the extent that federal protection is absent or ineffective, producers, consumers, and competitors will increasingly rely on state intellectual property rights, state consumer protection laws, and so on. This is unlikely to be a stable or effective system. The second result is – or may be – that we can learn something about innovation in the absence of intellectual property rights. While this may be an interesting experiment for academics, it is just one more way in which legal gray areas persist for the marijuana industries.

Patents Around the World: India, China, EU

India, Raj Acharya

This session will include points that would help in prosecuting patent application in India successfully. This presentation will provide information about “Do’s” and “Taboo” considering different requirements under the Indian Patent Law e.g. Indian National Phase entry; jurisdiction; statement and undertaking regarding foreign application; examination request and examination report’s reply; divisional application; amendments; transfer of Patent and statement regarding working of patent in India.

China, *Chenyang Wu*

An overview of old examination guidelines will be described. At the end of 2014, the Chinese Patent Office implemented new guideline for examining business method related patent applications. The new guideline is more objective. The main hurdles to overcome for a business method related patent application are patentable subject matter, novelty test and inventive step test. Under what circumstances, a business method related patent application is rejected under non-patentable subject matter. What is business method per se? How does this new guideline affect patent applications? What should you put into the application when you draft an application to be filed in China?

Europe, *David Dickerson*

Europe represents roughly a quarter of the world's economy, yet continues to pose complex challenges to entities seeking protection of their IP in the European market. Of those many challenges, it is one simple idiosyncrasy of the EPO that devastates a substantial percentage of all applications filed with the EPO: their concept of added subject matter. This compact, fast-paced session will explain the EPO's concept of added subject matter, examine why it is such a frequent and dangerous pitfall and look at strategies for drafting applications that can survive EPO examination, opposition and beyond.

The Hague Agreement

Carl Oppedahl

On May 13, 2015 the United States joined the Hague Agreement for protection of industrial designs. Learn how the Hague Agreement works, and how to file an international design application through the Hague system. Learn the advantages and disadvantages of the Hague approach as compared with the old-fashioned Paris Convention filing approach.

SUNDAY NUTS & BOLTS

Disclosure Interview; Evaluating IP Options

Curtis Droege and Gary Maze

The "Disclosure Interview / Evaluating IP Options" session will cover the initial stages of representation - the range of options and concerns that practitioners must consider when engaging examiners in a disclosure interview. The topics may include:

- Innovation space (prior art; competitors' known and suspected intellectual property; "best mode" and non-preferred variants; included and excluded alternatives)
- Logistic details (inventorship / authorship, dates of conception and reduction to practice, handling past or future disclosures)
- Apprising the inventors and client of the realities and constraints of intellectual property systems (delays, costs, potential pitfalls, inventors' familiarity with intellectual property, handling inventors' discomfort about intellectual property)
- Finding a nexus between intellectual property protection and the applicant's interests and business model (licensing, defense, product protection, locking down a technology space, preventing knockoffs, covering "kit" development, the challenges of enforcement: contributory infringers and infringement by competitors' customers)
- Developing an IP protection plan that meets all of the client's goals (timing, nationality, breadth, budget, etc.)

Patent Application Preparation

David Grossman

Part I: Claim Drafting

Patent Application Preparation can be a daunting task for new practitioners. This presentation will go over the nuts and bolts of the process of drafting a commercially valuable patent application.

Part II: Specification Drafting

David Grossman with Richard Kirkpatrick

Let the Drawings "Speak for Themselves" U.S. District Judge in the Apple-Samsung case says patent drawings can 'speak for themselves'. Jurors are asked to base their decision on the overall design and to give "such attention as a purchaser usually gives." It is our job as a draftsman to provide the detail and the consistency in the drawings so that "the eye of the ordinary observer" cannot misinterpret the invention and also pass the examiner's office! Tips and tricks are mentioned in an effort to save, client attorney and draftsman both time and money. We will show strategic practices that help to increase the likelihood of drawings passing examination and how some companies are pushing the limits with various design drawings to protect their product and beat out the competition!

Patent Prosecution, *David Ladner and Chirag Patel*

Chemical/Pharmaceutical Patent Prosecution, *David Ladner*

Prosecution in the Chemical/Pharmaceutical Arts has its own idiosyncrasies and recurring themes. While many difficulties can be avoided by drafting a solid application, more often than not, a practitioner has to run with what is provided and hope for the best. Searching, especially substructure searching, is a powerful pre-emptive tool to avoid novelty rejections and being ready for obviousness rebuttals. One challenge is that because of long product development times, the applicant often does not know exactly which embodiment of his or her broad chemical class will be the most commercially important. As a result, the initial claim set is often overly broad both in terms of chemical structure and methods of use, leading to 112 rejections. Other rejections typical in the course of a chemical patent prosecution will be discussed, and strategies to get to a notice of allowance will be suggested.

Patent Prosecution for Software/Business methods/Electrical Art

Chirag Patel

Patent preparation and prosecution in each of the software, business methods, and electrical art offers unique challenges. For example, given the recent decisions by the Supreme Court with respect to software patent applications, applicants need to pay special attention in drafting the claims such that they do not get rejected under 101. Similarly, an application for a business methods must be drafted carefully so as to avoid being treated as a covered business method patent. The prosecution of applications in these arts also requires the applicant to use each and every tool that they can use. It is shown that conducting interviews with the Examiner under first action interview pilot program generally allows an applicant to define the tone of the rest of the prosecution. Similarly, using request for after final reconsideration under pilot program, pre-appeal brief request for review, in person interview at one of the satellite offices, etc., allows applicant to get speedy and on average more favorable results. Finally, well drafted and focused appeals shifts the burden on the Examiner to sustain the rejections and should be used when the Examiner is not reasonable.

Get Patents Fast! PPH/International Issues

Carl Oppedahl

There are nine ways to get patents fast at the USPTO. Carl will explain these nine ways and their advantages and disadvantages.

MONDAY USPTO DAY

USPTO Developments

Robin Evans, with other guest speakers from the USPTO tba.

Alice/101 Update and Discussion

Raul Tamayo and Louis Hoffman

Recent Supreme Court cases about the eligibility of inventions for patent protection under 35 USC 101 have profoundly impacted the patent community. Patent applicants and practitioners have struggled to determine how to draft new applications to comply with the Supreme Court's requirements, and how to strengthen pending and issued patents against invalidation. Patent examiners and the USPTO have sought to develop clear guidance to aid applicants and examiners in understanding the current state of 101 case law, and to apply these guidelines to pending applications.

This session will begin with an overview of recent 101 cases by Louis Hoffman, the legal representative of DDR Holdings, Inc., which to date remains the only patent to have survived review by the Federal Circuit in the aftermath of the Alice v. CLS Bank decision. The session will then feature a presentation by Raul Tamayo, Senior Legal Advisor for the USPTO Office of Patent Legal Administration, about the USPTO Interim Guidance on Subject Matter Eligibility. The session will conclude with a discussion between Louis and Raul of open questions and emerging trends in this important area of patent law.

Examiner Interview Tactics

Sudhanshu Pathak and David Stein

This session will cover the role of interviews in patent examination and prosecution, through observations from a supervising patent examiner and a patent practitioner.

During application pendency, applicants and examiners typically communicate their positions through the exchange of office actions and replies. However, the formality of these communications often fails to convey essential details, such as how claim terms are being interpreted and why a reference is interpreted in a particular manner, and can result in protracted pendency and dissatisfaction of all involved parties. Examiner interviews can be effectively utilized to improve the mutual understanding of the invention and its examination, and can expedite the process of reaching an agreement or clarifying the legal issue for appeal.

During this session, David Stein will present an overview of examiner interview practice from the practitioner's perspective, and Supervising Examiner Sudhanshu Pathak will present observations about how examiners prepare for and participate in interviews.

PTAB Appeals Panel: Addressing Questions from NAPP Members

Judges Kristina Kalan, Greg Anderson, Patrick Boucher

Professional Responsibility Before the Office of Enrollment and Discipline

William Griffin, Deputy Director, Office of Enrollment and Discipline

The presentation will provide descriptions and data regarding OED's disciplinary operations as well as an overview of recent cases. The presentation will also include a discussion of hypothetical ethical scenarios touching on several ethical topics relevant to the IP legal community.

TUESDAY PRACTICE UPDATE PART II

Our Changing Practice: Decisions from the Federal Court

Priya Cloutier

The role of a patent prosecutor involves more than just helping clients obtain patents -- patent prosecutors must help clients obtain patents that are enforceable. The concepts of patentability and enforceability change every year depending on the whims of the courts. This presentation will provide patent prosecutors with an insight of how courts have changed the rules of patent prosecution this year, and how to respond to those changes in their day-to-day practice.

Case Hypotheticals - Interactive Client Counseling for Licensing, Monetizing and Alternatives to Patents

Louis Hoffman, Lisa Adelson, Danny Sherwinter, with David Stein as Moderator

This session will involve a panel review of a set of hypothetical inventions that expose unusual and interesting areas of intellectual property law, and, in some cases, mutually exclusive options for consideration. The panelists will express their evaluation and options for each invention, and the considerations and pitfalls in recommending each of these options to protect the client's intellectual property.

Ethical Considerations for Patent Practitioners

Diane Gardner

Every practitioner knows that maintaining ethical standards is important. However, questions concerning ethical standards often arise because we receive far less training in that area than in areas relating to technological expertise or patent drafting and prosecution. This session will discuss some common areas in which ethical considerations arise in typical patent practices.

On Your Radar: Docketing Systems Reviewed

Bruce Young

Several different docketing systems will be described and compared. A standard set of questions will be answered for each system, including costs, and then special features will be highlighted for the various systems. The primary focus will be on patent practice, but some trademark practice features will be mentioned. An initial list of systems compared includes AppColl, CTS/Flextrac, DocketTrak, PATTSY, RevaTrademark, and Fileye (subject to change). Time will be left at the end for attendees to share their own experiences with docketing systems.