

**Former Commissioner for Patents Stoll; Circuit Judge Linn of the  
Federal Circuit; former Deputy Under Secretary Barner  
Headline Naples Patent Conference February 4-5  
at the Naples Ritz Carlton**

By Hal Wegner  
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Naples, FL – The Naples Ritz Carlton is the venue for a Midwinter Patent Experts Conference that will be held Monday evening and all day Tuesday, February 4-5th, featuring an all star lineup of domestic and international patent experts. The Conference is sponsored by the Akron University Law School.

Domestic experts include former United States Commissioner for Patents Robert Stoll, Circuit Judge Richard Linn of the Federal Circuit and Supreme Court patent specialist, Associate Dean Timothy Holbrook of Emory University Law School. International experts include British patent solicitor Paul Cole, German Patentanwalt Heinz Goddar and Japanese Benrishi Shoichi Okuyama.

A corporate patent litigation management perspective is provided by Cummins Vice President Sharon R. Barner, a former Deputy Under Secretary of Commerce, and Richard Rainey, head of GE Worldwide Patent Litigation and former partner at Covington & Burling.

The complete program and list of speakers and other information is available at <http://www.uakron.edu/law/ip/naples-midwinter.dot>

Conference details:

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## Naples Midwinter Patent Law Experts Conference

The Naples Midwinter Patent Law Experts Conference has been planned as a small, intimate gathering of leaders of the profession including corporate, private and academic sectors with a *maximum* participation of no more than eighty persons at the exclusive Ritz Carlton directly on the Gulf of Mexico in Pelican Bay (Naples). Come early on Monday to meet colleagues and prepare for the Tuesday all day working session. An opening reception will be held 8:30 – 10:00 PM at the Ritz on Monday evening.

Participants wishing to stay at the Ritz should reserve early as the conference is right in the peak season for Naples. There are also numerous alternate locations particularly for an extended stay in Naples, some on the beach within walking distance of the Ritz. (One can walk along the beach to get to the Ritz.) Greater Southwest Florida Airport (RSW) is 40 minutes away.

The Naples Midwinter Patent Law Experts Conference represents a rare opportunity for *expert level* patent practitioners, managers and scholars to be enriched by a small interactive event. *No other parallel sessions will be run at this conference.*

### **Part I: The AIA and Changes at the Patent Office; New Legislation?**

**The Honorable Robert Stoll**, *former Commissioner for Patents, USPTO; Partner, Drinker, Biddle & Reath LLP* (morning keynote address)

**Michael R. Dzwonczyk**, *Partner, Sughrue Mion, PLLC ; Adjunct Professor of Law, George Washington University Law School*

**Matthew A. Smith**, *Partner and Post Grant Practice Group Co-Chair, Foley & Lardner LLP; Adjunct Professor of Law, George Washington University Law School.*

Analysis of the latest practice developments at the PTAB; tactics being used both by patent challenges and patentees, impact of proposed and likely proposals for rules changes. Affidavit evidence practice; strictness of the application of the *Federal Rules of Civil Procedure*.

Is *additional* patent legislation necessary? Consideration of the “technical amendments” and other proposals. Will they, *should* they be enacted?

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## Part II: The “Unified” European Patent

As early as next year a brand new “unified” patent system will be in place for up to 25 countries of the European Union with a single grant procedure at the European Patent Office and a *single* enforcement by the “unified” court system. What *practical* value does this system have for American applicants, particularly during the “opt out” transition period for the first several years? What safeguards (vel non) will ensure a quality patent judiciary?

## Part III: The Supreme Court and the Federal Circuit

**The Hon. Richard Linn**, *Circuit Judge, U.S. Court of Appeals for the Federal Circuit* (keynote luncheon speech)

**Professor Timothy Holbrook**, *Associate Dean of Faculty and Professor of Law, Emory University School of Law* (detailed address)

Consideration of *pending* cases and *likely* issues for future grant of *certiorari*; the *certiorari* process and why some petitions will or won't be granted, and how to craft “Questions Presented” to facilitate grant; consideration of likely issues for Supreme Court review.

## Part IV: Obviousness/Inventive Step at the PTAB, A Comparative View

**Shoichi Okuyama**, *Okuyama & Sasajima, President, Japan Patent Attorneys Association*, Opening Address.

**Paul Gilbert Cole**, Lucas & Co., Visiting Professor, Bournemouth University; editor of the leading treatise on British patent law, the *C.I.P.A. Guide to the Patents Acts*.

**Prof. Dr. Heinz Goddar**, Boehmert & Boehmert, is Hon. Prof., University of Bremen and on the faculty of the Munich Intellectual Property Law Center.

**Harold C. Wegner**, *IP Advisory Council Member, Akron Law; Partner, Foley & Lardner LLP*

Post-KSR there has been a split within the Federal Circuit on nonobviousness standards. Both approaches will be considered from a comparative view of “obviousness” and “inventive step” in global practice; lessons that can be learned as part of “patent worksharing” and the goal for a common standard of “inventive step”/nonobviousness.

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“Obviousness” at the PTAB may be far different from the *ex parte* appeals practice of yesteryear; determination of the “level of ordinary skill in the art” through affidavit testimony; greater importance of *KSR* and *Graham* vis a vis *ex parte* Board and Federal Circuit precedent; challenging affidavit presentations under the Federal Rules of Evidence.

### Part V: A Corporate Management Perspective on Global IP Litigation

**The Hon. Sharon R. Barner**, *former Deputy Under Secretary of Commerce and Deputy Director, USPTO; Vice President and General Counsel, Cummins, Inc.*

**Richard L. Rainey**, *Executive Counsel in charge of global IP Litigation, General Electric; former Law Clerk to the Honorable Roderick McKelvie and the Honorable Randall R. Rader*

**Moderator: Professor Jeffrey M. Samuels**, *Director, Center for Intellectual Property Law and Technology, Akron Law.*

A practical view of the changes in patent law and practice and the impact on global patent procurement and enforcement strategies.

### Topics included within the Discussions

**The First-to-File Transition**: “Lab notebooks” *will* be needed to establish conception and inventorship to avoid prior art status for pre-filing events while daily “diligence” tracking has lesser import; simplified filing strategies are needed both for early filing dates but also to mitigate third party challenges prior to and after prosecution.

**Will there (should there be) a new patent law in 2013?** Voices have been raised for further reforms *sub nom* “technical amendments”. What are they? Should they be enacted? What changes *should* be made (if any)?

**Global Patenting Strategies – the Emerging Importance of Asia**: For both procurement, enforcement and patent challenges, the patent world particularly in East Asia is rapidly changing; pressures mount for “patent work sharing” but critical misunderstandings exists as to fundamental principles of “non obviousness” vs. “inventive step”; the role of “prima facie” obviousness and rebuttal evidence versus an “advance in the art”. Drafting strategies must consider creating a simple, bullet-proof application to deal with the subtle differences in common patenting requirements.

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**Global Patenting Strategies – the “Unified “European Union Patent:** As early as next January the new European unified patent system may be in place with a single grant and enforcement procedure. The expected benefits and detriments of the system will be considered, including alleged cost savings and the situations where applicants will wish to “opt out” of the new system for the transitional period that will impact all filing decisions in the coming few years.

**Pharmaceutical issues** including impact of the *Myriad* (DNA patent-eligibility) case that will be argued in April, *Bowman v. Monsanto* (“exhaustion” of self-replication biotechnology inventions) to be argued in February, *Ninestar* (international patent exhaustion) where a *certiorari* vote is imminent; and ANDA relationship to Inter Partes Review which may selectively help – or hurt – a parallel ANDA proceeding.

**Comparative students of the law** will note the comparative approach of Professor Holbrook and other panelists to provide a better view of what happens in parallel situations in Europe and Asia from the standpoint of applying lessons from overseas to common factual challenges under U.S. patent practice.

**Ethics (1 hr. CLE):** Post-*Therasense* “duty of disclosure”; “Supplemental Examination” under the AIA; the *continued* “best mode” requirement even though not a statutory defense.

**CLE Materials, Pre-Conference Documentation:** Each participant *before coming to the conference* will receive a set of materials for advance study including new patent rules changes and Federal and Supreme Court case material, including an extensive presentation from Professor Timothy Holbrook on Supreme Court issues in the pipeline. Such advance materials should be particularly advantageous for the patent manager without immediately recent hands on experience or who possibly has not been involved with Federal Circuit or Supreme Court appeals. The CLE materials will permit advance study to come up to speed for active participation in this conference.

**Who Should Attend:** Corporate and private practitioners as well as academics, all at the expert level, will benefit from this conference which focuses upon new cutting edge issues including upcoming but already announced rules changes to implement new laws as well as the latest issues before the Federal Circuit and Supreme Court and how individual organizations should deal with these appellate bodies.

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Corporate patent managers who plan procurement and litigation strategies to take into account both statutory and regulatory changes at the Patent Office, the sharp increase in Supreme Court patent precedent and implications for procurement, enforcement and challenges; and the changing face of the Federal Circuit which by the end of 2014 will have only two of its 12 members appointed before 2010 who will not be retirement eligible (Prost, Moore, JJ.).

Practitioners (Litigation and Procurement): need to understand the current domestic and global patent situation including simplified patent drafting to mitigate impact of Third Party Submissions and Inter Partes Review; precision usage of post grant challenge procedures and prophylactic protection against such actions; and East Asian patenting strategies under the “Patent Prosecution Highway”.