

The Leahy-Smith America Invents Act (AIA)

Saturday, 22 October 2011 9:30AM-2PM
Room C, Johnson Center
George Mason University
4400 University Drive
Fairfax, VA

An exposition of the largest change in patent law since 1870 with an emphasis towards helping inventors and engineering managers mitigate risks, protect their inventions, and adapt their R&D and business practices to this new law.

AGENDA

9:30AM – 9:50AM Introduction and overview of America Invents Act
Keith Grzelak, Wells St. John P.S.; Co-Chair, IEEE Intellectual Property Professionals Initiative and Past Chair, IEEE-USA Intellectual Property Policy Committee

Impact of Pre-Issuance Changes

9:50AM – 10:15AM First Inventor To File, Diminished Grace Period and Prior Art Issues
David Boundy, Cantor Fitzgerald

10:15AM – 10:40AM Derivation law, Prior User Rights and Related Implications
Charles Gholz, Oblon, Spivak, McClelland, Maier & Neustadt, L.L.P.

10:40AM – 11:00AM Patent Office Procedures, Appropriations, User Fees & Prioritized Examination – Adapting prosecution strategies to the AIA.
Harold Wegner, Foley & Lardner LLP.

The Post Issuance Conundrum and Patent Challenges during Prosecution

11:00AM – 11:25AM Post Grant Review, Reexamination & Supplemental Examination
Robert Sterne, Sterne, Kessler, Goldstein & Fox P.L.L.C.

11:25AM – 11:50AM USPTO Regulatory Agenda
Janet Gongola, Patent Reform Coordinator, USPTO

11:50AM – 12:15AM Impact on Patent Litigation
Michael Flibbert, Finnegan, Henderson, Farabow, Garrett & Dunner, LLP.

12:15PM – 1:00PM **LUNCH BREAK**

Putting it all together

1:00PM – 1:25PM Company Perspectives, Procedures and Best Practices
TBD

1:25PM – 1:55PM Panel Discussion and Q&A
ALL

1:55PM-2:00PM Closing

SPEAKER BIOGRAPHIES



David E. Boundy is Vice President and Assistant General Counsel for Intellectual Property at Cantor Fitzgerald in Boston. Previously he was in private practice with Fish & Richardson, Shearman & Sterling, and Willkie Farr & Gallagher. In June, 2007, Mr. Boundy argued as the designated representative of 25 high technology companies at a White House regulatory review of the Patent Office's proposals to limit continuation practice and complexity of claims, and led teams that convinced the Office of Management and Budget to block overreaching regulatory changes sought by the Office.

Mr. Boundy has lawyered the intellectual property portions of dozens of deals, with total value over \$10 billion, including formations, financing rounds, mergers, acquisitions, spin-offs, and refinancings. Mr. Boundy has represented startups through their formative stages, investors who are studying companies' patents to decide whether or not to invest, and in arranging financing. In litigation matters, Mr. Boundy defended IBM in a non-practicing entity suit, and Exxon, Shell, Texaco, and Bloomberg LP. Mr. Boundy has also represented a number of small and startup companies who used their patents to grow their businesses.

Mr. Boundy's first career was as a computer engineer, building compilers, operating systems, diagnostics, and process control systems at Apollo Computer and others during the Massachusetts Rte. 128 period. Mr. Boundy has a J.D. from Columbia University, New York, graduate studies at M.I.T., Cambridge MA, an M.S. from the University of Michigan, Ann Arbor MI, and a B.S. triple major in mathematics, physics, and computer science from Hope College, Holland MI.



Michael J. Flibbert is a partner in the law firm of Finnegan, Henderson, Farabow, Garrett & Dunner, LLP. He focuses on patent litigation before U.S. district courts and the U.S. Court of Appeals for the Federal Circuit. He has handled cases involving a range of technologies primarily in the areas of pharmaceuticals, biotechnology, chemistry, agriculture, and materials science. Mr. Flibbert has extensive experience in representing pharmaceutical patent holders in Paragraph IV Abbreviated New Drug Application (ANDA) litigations arising under the Hatch-Waxman Act. He has participated in both bench and jury patent trials in federal district courts as well as several appeals before the Federal Circuit.

In his patent litigation practice, Mr. Flibbert has served as lead counsel and participated in all aspects of discovery, trial, post-trial, and appellate proceedings. As litigation counsel, he regularly formulates trial and appellate strategies, performs pre-suit investigations, takes and defends fact and expert depositions, represents clients in claim construction and summary judgment hearings, examines and cross-examines witnesses at trial, and argues pre-trial and post-trial motions. He also counsels clients on a range of intellectual property and litigation matters, including patent infringement, validity, enforceability, appeals, jurisdiction, and remedies. In addition, Mr. Flibbert has experience in antitrust law, licensing, mediation, and settlement proceedings. He holds a J.D. with honors from George Washington University, and a B.S. from Georgetown University.



Charles (Chico) L. Gholz is a partner at the law firm Oblon, Spivak, McClelland, Maier & Neustadt, L.L.P. He practices in the Litigation and Patent Interferences groups, specializing in patent interferences. In addition to general patent litigation, he is particularly skilled at handling patent interferences under 35 USC § 135 before the Board of Patent Appeals and Interferences (BPAI) and court review of decisions by the BPAI in interferences. He handles both appeals to the Federal Circuit under 35 USC § 141 and civil actions in district courts under 35 USC § 146.

Mr. Gholz represents a wide variety of domestic and foreign clients across a range of technologies including biotech, chemical, electronics, computers and lasers. He regularly appears before the BPAI, the Federal Circuit, and various district courts. He also counsels on patent validity and patentability, and he has appeared as an expert witness on patent issues.

Prior to joining the firm, Mr. Gholz served as an assistant technical advisor to the Honorable Giles S. Rich of the U.S. Court of Customs and Patent Appeals (1970-1972). A former Lecturer in Law at George Mason University School of Law, he has written and lectured widely on patent law. In addition, he co-authored "Court of Appeals for the Federal Circuit: Practice and Procedure," LexisNexis, and "Patent Practice," Patent Resources Institute.



Janet Gongola is the Patent Reform Coordinator at the U.S. Patent and Trademark Office (USPTO). In this capacity, she manages all aspects of patent reform implementation for the agency. Ms. Gongola has been an Associate Solicitor in the Office of the Solicitor at the USPTO where she provided legal advice to agency officials and defended decisions of the Board of Patent Appeals and Interferences and the Trademark Trial and Appeal Board before the U.S. Court of Appeals for the Federal Circuit as well as district courts across the country.

Before joining the USPTO, Ms. Gongola served as a law clerk for Chief Judge Paul R. Michel at the Federal Circuit and for Chief Judge Sue L. Robinson in the U.S. District Court for the District of Delaware. Ms. Gongola previously worked as a patent attorney, patent agent, and research chemist at Eli Lilly and Company in Indianapolis, Indiana. Ms. Gongola graduated summa cum laude with a J.D. from Indiana University School of Law—Indianapolis, and she received B.S. degrees in Chemistry, Mathematics, and English from Muskingum University.

Ms. Gongola is an officer of the Giles S. Rich American Inn of Court. She has served as an adjunct professor at the George Mason University School of Law and currently teaches at the George Washington University Law School.



Keith Grzelak, is a Principal in private practice with a Spokane, Washington Intellectual Property firm, Wells St. John PS. He is the Co-Chair of IEEE-USA's IP Professional's Initiative and Past Chair, IEEE-USA Intellectual Property Policy Committee. He focuses his practice on counseling, procurement and portfolio management of intellectual property rights in the U.S. and abroad. He is responsible for intellectual property counseling for technology clients including patent and trademark portfolio management, procurement, and rendering of opinions. Areas of practice also include general counseling for startup and growth companies. Technical areas of emphasis include computers (hardware/software), Internet and electronic commerce, semiconductor devices, control systems, medical devices and processes, and various complex electromechanical systems.

Mr. Grzelak is a former automotive safety and crashworthiness expert, and past inventor. In addition to counseling clients on IP strategy, he has been a frequent lecturer to both engineering organizations and state bar associations on forward-thinking patent policy issues and legislation. He holds a M.S.E.E. from Wayne State University, with specialty in bio-instrumentation; J.D. from Detroit College of Law; M.S.E.M. from Michigan Technological University; thesis in bio-mechanics; and a B.S.M.E. from Michigan Technological University.



Robert Greene Sterne is a founding director of Sterne, Kessler, Goldstein & Fox PLLC. Mr. Sterne is recognized as a thought leader on the law of obviousness and corporate IP best practices. He specializes in the areas of intellectual property for cutting-edge technologies in the electronics and computer arenas, the monetization of patents, patent litigation and patent licensing. Mr. Sterne is well known for his work across a number of technology spaces, including hardware, software, bioinformatics, wireless, computer architecture, analogue electronics, semiconductors, medical devices and business method patents.

Mr. Sterne is also one of the leading patent attorneys in patent re-examination and concurrent patent litigation in the United States. He is the author of many articles, webcasts and interviews on the topic, and is a frequent speaker on this topic at recognized venues. He has been the lead attorney for some of the most significant re-examinations. He serves as chair of the editorial board of The Reexamination

Center (www.reexamcenter.com), the leading website on patent re-examination.

Clients rely on Mr. Sterne's negotiation skills and big-picture approach to patent procurement and protection, and he is a sought-after expert witness. Mr. Sterne has served as a special master for Judge Marvin J Garbis in a case involving patent inventorship, patent ownership, US and foreign patent applications and prosecution, and a failed joint technology venture. Mr. Sterne is internationally recognized as an expert on software and business method patents, having been the lead attorney for IBM in the Federal Circuit test case *In re Beauregard* (1995), which led to the US Patent and Trademark Office Software Patent Guidelines. He also served as the lead patent lawyer for Teleflex at the US Supreme Court in *KSR v Teleflex* (2007), which led to the current legal test for patent obviousness. Mr. Sterne is an electrical engineer by training, holding BSEE and MS degrees from Tufts University, as well as a JD from the University of Maryland Law School.



Harold C. (Hal) Wegner continues his patent practice as a partner at Foley & Lardner LLP, while retaining his affiliation with the George Washington University Law School where he had been Director of the Intellectual Property Law Program and Professor of Law.

Prof. Wegner's patent career commenced with service at the U.S. Department of Commerce as a Patent Examiner. In 1980 he founded his own law firm; in 1994 he merged his practice into the Foley firm. He spent three years at the Max-Planck-Institut für Geistiges Eigentum in Munich where he was a *Wissenschaftliche Mitarbeiter*. He then became a *Kenshuin* at the Kyoto University Law Faculty under Dr. Kitagawa. His involvement with other academic institutions has included service as a Visiting Professor at Tokyo University.

Prof. Wegner was selected by his peers for inclusion in The Best Lawyers in America® 2010 and 2011 editions, for his work in the field of intellectual property law. He is a graduate of Northwestern University (B.A.) and the Georgetown University Law Center (J.D.); at Georgetown, he launched his teaching career as an Adjunct Professor of Law teaching International Licensing.