

Prior Art & Obviousness 2010: Current Trends in Sections 102 & 103

New York City, July 7, 2010

San Francisco, September 15, 2010

Live Webcast, September 15, 2010 — www.pli.edu

Why You Should Attend

35 USC 102 (Prior Art) continues to be re-understood and re-interpreted by the PTO and CAFC to account for the unforeseen in how the concept of “prior art” and circumstance collide in the 21st century. Prior Art on the web - here today, gone tomorrow, but always recoverable – maybe; on sale, or “ready for patenting” in the age of biotech and nanotech, what is truly enabled? For every practitioner, it is a necessity to stay current on the touchstone of patentability: 35 USC 102.

And, let’s not overlook the most common reason any application is rejected or patent held invalid: 35 USC 103, Obviousness. The Pandora’s box of *KSR* or “what in the world were they thinking when they wrote that opinion” will be explored from inside and outside the PTO. Are the *KSR* effects uniform, or do they vary subject to subject in the PTO and Courthouse?

The first 2 hours of the course are devoted to the PTO view of 102 and 103, i.e., what Examiners are using and relying on in examination and found in the most current edition of the MPEP. The remainder of the program is devoted to recent case law decided by the CAFC and Supreme Court as it relates to each segment of 102 and 103. The final hour is spent on 102(e).

What You Will Learn

Patent practitioners are obliged to live with Section 102 because it just “is.” The language in the respective Sections (a)-(g) seems to bump into itself and can almost never be simply read and applied quickly and easily. For those wanting to have a working understanding of Section 102, including recent re-interpretations, you must attend this program. Then, you will become the “go-to” office resource for PTO and litigation analysis of Section 102 issues.

- When is a patent a “patent” under the statute?
- Public accessibility – on the web, on the shelf, in the mail, “routine” practices
- Four steps to the abyss of (d)
- Ex parte 102 (g); abandon, suppress, conceal
- Actual vs. constructive reduction to practice (where (e) trumps (g))
- What have they done to 102 (e)?
- The issues raised by successive common owner filings
- A walk through the “guidelines” and “timelines”
- Impact of proper/improper benefit claims on: a) prior art date of a reference, and b) effective filing date of the application being examined

Everyone thought they knew how to apply 35 USC 103. Start with *Graham v. John Deere*, add a pinch of teaching/suggestion/motivation, and finish with secondary considerations. Well...not anymore. It is a new day; *KSR* is plowing through the PTO, District Courts, and CAFC. You need to know what’s happening subject by subject. Come find out...from PLI.

Who Should Attend

The program is geared to patent lawyers who have some familiarity with 35 USC Sections 102/103 and work with the statute in either litigation or patent prosecution. The course will advance the knowledge of all attendees from their respective starting points and provide new insight into the statute, recent amendments, and case law.

FACULTY



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PROGRAM SCHEDULE

Please plan to arrive with enough time to register before the conference begins. A networking breakfast will be available upon your arrival.

Morning Session: 9:00 a.m. – 12:15 p.m.

9:00

Introduction

NYC: John M. White

SF & WEB: John M. White

9:15

Section 102 and the MPEP, from (a) to (g) (or What Isn't in the Statute But Is in the Law?)

- "Public knowledge" v. "public use", "in this country"
- When is a patent a "patent": (a) v. (b) v. (d)
- Availability on the "web", on the shelf, and routine practices
- The "invention" & "experimental use"
- Date of "invention"
- Abandonment under (c) and (g)
- The foreign origin C.I.P. trap; "claimed or could have claimed"
- Derivation: "authorship" v. "inventorship"
- 102(g): Inter-parte and ex-parte and NAFTA/WTO

Section 103 and the PTO KSR Guidelines

- From Jefferson to Graham v. John Deere: A brief history—how we got here
- The CAFC and the BPAI
- KSR—our just desserts; can we recover? The PTO Guidelines

NYC: Jonathan A. Harris, Gary A. Walpert, Carl B. Wischhusen

SF & WEB: Jennifer R. Bush, Karen Canaan, Paul Davis

11:00 Networking Break

11:15

Section 102(a) – (d)

A. 102(a) & (b) and the CAFC 2008

- "Public" availability is the vanguard of (a) and (b)
- When is a patent a "patent" under the statute?
- Prior art date for "cancelled" subject matter
- Public accessibility—on the Web, on the shelf, in the mail, "routine" practices
- Effects of "confidentiality"
- Third party public use of inventor's own work
- "On sale" by whom and under what circumstances

B. 102(c) & (d): Abandonment & the "Four Steps"

- "Abandonment" and intent of the inventor
- Deliberate surrender of rights
- Four steps to the abyss of (d)
- Do the foreign and U.S. claims have to be the same for (d) to apply
- The C.I.P. trap
- "Allowed applications" vs. "patents" under (d)

NYC: Annemarie Hassett, Rebecca Goldman Rudich

SF & WEB: Rebecca Goldman Rudich, Leonard R. Svensson

12:15 Lunch

Afternoon Session: 1:30 p.m. – 4:45 p.m.

1:30

102(f) & (g): Joint Ventures and Co-Development

- Derivation
- "Authorship" vs. "inventorship"
- Conception and communication to "another"
- Ex-parte 102(g); abandon, suppress, conceal
- Actual vs. constructive reduction to practice (where (e) trumps (g))
- Diligence
- 102(f) and (g) under 103(c)

NYC: Aaron B. Bernstein, Benjamin C. Hsing

SF & WEB: Otis B. Littlefield

2:30

35 USC 103 and the CAFC

- KSR in 2008 in the District Courts
- KSR as implemented by the CAFC
- Where do we go from here?

NYC, SF & WEB: Rebecca Goldman Rudich

3:30 Networking Break

3:45

102(e) and the 9 Most Common Timelines: Effects of Priority Under 119, 120, 121, 365

- What have they done to 102(e)?
- The issues raised by successive common owner filings
- The published U.S. application
- The published international application
- The issued U.S. patent
- Priority under 119, 120, or 365
- A walk through the "guidelines" and "timelines"
- Ethical requirements under 102(a) through (g)

NYC, SF & WEB: Robert J. Spar, John M. White

4:45 Adjourn

**Reserve your place today,
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