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Los Angeles Intellectual Property Law Association

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Washington in the West
Luxe Hotel, Los Angeles

February 25, 2011
Litigation Roundtable

March 21, 2011
Judges' Night

President's Message

by Alexander R. Schlee

Welcome to the January issue of the LAIPLA Bulletin. We took it easy over the holidays. Initially, we planned to have our annual Judges Night in December, but for several reasons it just did not work out. Since everybody is busy in the holiday season anyway, we allowed for a little rest. This did not keep us from organizing a lot of great events for next year.

On January 27, we will have our annual Washington in the West program. We will be moving away from the Skirball Cultural Center this year to the nearby Luxe Hotel, located off the 405 Freeway, west on the Sunset exit. As for the program, we have speaking commitments from: PTO Director David Kappos; PTO Deputy General Counsel for IP Law and Solicitor Raymond Chen; PTO Director of Art Unit 2100 James Dwyer; TTAB Judge Gerald F. Rogers; and, WIPO Director of the PCT Legal Division Matthew Bryan. LAIPLA members Joshue Villalta and David Weiss co-chair this program, and member Gregg Koch is helping with much of the nuts and bolts work. Lauren Schneider is the Board Liaison.

On February 25, we will have our annual Litigation Roundtable. We created this program just a few years ago, and it has been quite successful. This is a lunch program and will this time be at the offices of Jones Day in downtown Los Angeles and will feature Professor Robert Merges of the U.C. Berkeley School of Law. LAIPLA member Brent Sokol chairs this program with support from Committee member Sanjesh Sharma. I understand that Professor Merges authored the first textbook on patents and has written a new book about Non-Practicing Entities and selling IP Portfolios. This subject has not lost its current concern, and it will be very interesting to hear his newest research results.

The next big event will be our annual Judges Night taking place on March 21 featuring, in addition to a Judges Panel, Federal Circuit Judge Gajarsa. We will follow up with details later, but please save the date!

And last not least, another save-the-date notice: Our Annual Spring Seminar will take place from June 3 to 6 in the famous "Del" on Coronado Island in San Diego. We look forward to seeing you all during these excellent events in 2011.

Event Notice: Washington in the West 2011

14th Annual Washington in the West
January 27, 2011
The Luxe Hotel, Los Angeles, CA

Happy New Year! LAIPLA is pleased to announce our 14th Annual Washington in the West program will be held on Wednesday, January 27, 2011 at the Luxe Hotel, 11461 Sunset Blvd, Los Angeles, CA 90049.

Details and registration information are attached to this Bulletin. Register today and don't miss out on this great event! We look forward to seeing you on the 27th!

Article: Case Study: Nightingale v. Anodyne

By: Anuj Desai
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The view and opinions expressed in this article are those solely of the author(s) and are not of the Los Angeles Intellectual Property Law Association or its members.

Law360, New York (December 6, 2010) — A recent opinion from the Seventh Circuit Court of Appeals — *Nightingale Home Healthcare Inc. v. Anodyne Therapy LLC* — attempts to clarify when the prosecution or defense of a Lanham Act suit renders the case “exceptional,” so as to allow for an award of attorneys’ fees to the prevailing party. In doing so, the court addressed the increasing trend of businesses in bringing or defending trademark infringement and false advertising lawsuits against competitors solely to obtain a competitive advantage independent of the outcome of the case. The court held that where a party is guilty of such “abuse of process,” an award of attorneys’ fees would be warranted. This article further elaborates upon the court’s reasoning and why businesses must exercise caution in bringing or defending against intellectual property claims under the Lanham Act.

The Court’s Opinion

Anodyne, the seller of a medical device, was the prevailing party in the underlying false advertising lawsuit brought against it by its customer, Nightingale. The trial court awarded Anodyne the attorneys’ fees it incurred pursuant to a specific provision of the Lanham Act, which allows for an award to the prevailing party in “exceptional cases.” Nightingale appealed this award to the Seventh Circuit Court of Appeals.

In tackling whether the case was exceptional enough to sustain the award of attorneys’ fees, the court was perplexed by the varying standards used by the other circuit courts of appeals to make this determination and that those standards were often too vague to be applied objectively. Taking a step back to find some clarity, the court looked to the policy behind the Lanham Act’s provision for attorneys’ fees and found that a “practical concern is the potential for businesses to use Lanham Act litigation for strategic purposes — not to obtain a judgment or defeat a claim but to obtain a competitive advantage independent of the outcome of the case by piling litigation costs on a competitor.” In light of this policy, the court arrived at the following conclusion as to when a case under the Lanham Act is to be deemed exceptional so as to warrant an award of attorneys’ fees: 1) If the defendant prevails and the plaintiff was guilty of abuse of process; or 2) If the plaintiff prevails and the defendant had no defense, but persisted in trademark infringement or false advertising to impose costs on the plaintiff.

In further explaining this standard, the court explained that abuse of process is the use of litigation for an improper purpose, whether or not the claim is colorable, often to compel the victim to yield on some matter not involved in the suit. The court found that predatory initiation of a suit is the same as predatory resistance to valid Lanham Act claims. To justify an award, the party seeking it must show that his opponent’s claim or defense was “objectively unreasonable.” In other words, the claim or defense was pursued not to obtain a favorable judgment, but only to impose disproportionate costs on his opponent or for purposes of extortion.

In addressing the facts of the case before it, the court noted that Nightingale had brought a Lanham Act claim that had no merit. The court held that what made the case exceptional, however, was the fact that Nightingale had initiated the claim only to coerce Anodyne into reducing the price of its medical devices sold to Nightingale. The court sustained the award of attorneys’ fees to Anodyne.

What This Means For You

Though this opinion is binding only in the Seventh Circuit, other jurisdictions may certainly heed its well-reasoned approach. Courts do not look kindly upon businesses that use litigation to improperly gain a market advantage. If your business is faced with the prosecution or defense of Lanham Act claims, it would be prudent to take a step back and carefully examine the merits and reasonableness of each side’s respective positions to determine whether the case is merely an abuse of process.

Article: The Fed. Cir. Stance in Hyatt v. Kappos

The view and opinions expressed in this article are those solely of the author(s) and are not of the Los Angeles Intellectual Property Law Association or its members.

By: Monte Cooper and Robert M. Isackson
Orrick Herrington & Sutcliffe LLP

Law360, New York (December 3, 2010) — The Federal Circuit recently issued an en banc ruling setting forth the standard governing the admissibility of evidence in a district court action filed under 35 USC § 145 by a patent applicant who is seeking to challenge a decision by the U.S. Patent and Trademark Office's Board of Patent Appeals and Interferences (BPAI) denying a patent. In *Hyatt v. Kappos*, No.2007-1066 (Fed. Cir. Nov. 8, 2010) the Federal Circuit held that the admissibility of evidence in these § 145 actions is to be governed by the same rules on admissibility of evidence as in any civil action — that is, according to the Federal Rules of Evidence and of the Federal Rules of Civil Procedure. Significantly, the Federal Circuit rejected the more stringent admissibility standard that the district court had applied, which excluded evidence that the applicant could have submitted to the examiner during prosecution, but did not. Consequently, the court of appeals clarified that in civil actions for review of patent application rejections under § 145, the applicant now may submit new evidence that was never before considered by the USPTO examiner or the BPAI. This case will present significant strategic considerations and consequences to applicants in those rare patent applications that proceed to a district court review under § 145.

By way of background, a patent applicant who is unsuccessful in obtaining a patent during prosecution may challenge an adverse final rejection of an examiner by appeal to the BPAI. If the BPAI sustains the rejection in whole, or in part, the applicant then may choose one of two paths for judicial review — either to appeal the adverse ruling of the BPAI directly to the Federal Circuit (in accordance with 35 U.S.C. § 141), or to challenge the USPTO's determination in a civil action brought in the U.S. District Court for the District of Columbia pursuant to 35 U.S.C. § 145. If the applicant chooses the latter approach, a civil action is commenced, and the court is to “adjudge” whether the “applicant is entitled to receive a patent for his invention ... as the facts in the case may appear.” 35 U.S.C. § 145. The administrative record before the USPTO and the BPAI becomes evidence in the case. However, an applicant also has the opportunity to submit new evidence and have witnesses testify in person before the court. The USPTO does not permit such live witness testimony.

The question before the en banc court of appeals in *Hyatt v. Kappos* centered on to what extent new evidence is admissible and where district courts should draw the line in permitting it to be considered in Section 145 actions. It was not disputed that in a civil action brought pursuant to 35 U.S.C. 145, no new legal issues could be raised. Nor was it disputed that for those fact findings made by the USPTO for which no new evidence is submitted, the reviewing court must apply the test under the Administrative Procedure Act (APA) and defer to the USPTO's fact findings if supported by substantial evidence. Rather, the issue concerned whether the new evidence was properly submitted and admissible, such that the district court would then be required to perform a de novo review of the old and new evidence in deciding the case.

In the case at hand, the inventor Gilbert Hyatt (who is credited as the inventor of one of the very first patents on a microcontroller) had sought a patent on a memory architecture with 117 claims, and asserted priority to a 1975 application. The pending application was filed at a time when, if granted as a patent, the patent term would run for 17 years from the date of issuance. The extensive and unusually complicated prosecution ultimately resulted in the examiner issuing 2,546 separate rejections of the various claims on several grounds.

Hyatt appealed to the BPAI, which actually reversed the vast majority, but not all, of the examiner's rejections (about 93 percent of the rejections, according to the court of appeals). In particular, the BPAI sustained one enablement/written description rejection for each of 79 claims. This resulted in Hyatt filing a civil action against the USPTO director pursuant to §145 in the District of Columbia district court. The director then sought summary judgment based on the USPTO administrative record of the prosecution and BPAI appeal.

Hyatt opposed the motion and proffered a declaration in which he identified portions of the specification which he contended supported the written description of limitations challenged by the director and overcame the rejections. The district court excluded the declaration, however, because it had never previously been submitted to the USPTO or BPAI, and because Hyatt had offered no explanation for why it had not previously been submitted in the prior proceedings. The district court therefore ruled in favor of the director on summary judgment.

Hyatt then appealed the district court's judgment to the federal circuit. A divided three-judge panel of the court affirmed the district court. Reconsideration en banc was requested and granted, and the en banc Federal Circuit reversed.

Article: The Fed. Cir. Stance in Hyatt v. Kappos

Continued from page 3

Writing for a majority of the Federal Circuit, Judge Kimberly A. Moore analyzed extensively the legislative history of the statute, as well as the prior historic actions in equity under earlier patent laws for review of USPTO decisions, and rules that 35 USC §145 imposes no limitation on an applicant's right to introduce new evidence before the district court, apart from the same evidentiary limitations that are applicable to all civil actions contained in the Federal Rules of Evidence and the Federal Rules of Civil Procedure. She rejected the USPTO director's argument that only "new evidence that could not reasonably have been provided to the agency in the first instance" is admissible in a §145 action as without basis in the statute or in the antecedent practice. However, Judge Moore's opinion cautions that while the proceedings before the patent office do not limit the admissibility of new evidence in the district court, they may be considered by the district court if they cast doubt on the reliability of late-produced evidence, as with inconsistent statements or new recollections of previously forgotten events. In other words, as with any evidence introduced in a civil action, the district court as fact finder has discretion and may give less weight to new evidence introduced by an applicant in a §145 action if the district court questions its credibility or reliability. On the facts of the case, because the district court abused its discretion when it excluded Hyatt's declaration under the wrong legal standard of admissibility, the Federal Circuit vacated the original district court decision and remanded for further proceedings under the correct standard.

The court also discussed the concern raised by the director that a broad admissibility standard will lead to procedural gaming by applicants who will save the "best" evidence for the court. The court noted that applicants are generally desiring of obtaining patents as quickly and cost effectively as possible and are not likely to withhold evidence that would be helpful to achieving that goal. The court also reasoned that such gaming was unlikely because of the heavy economic burden placed on the patent applicant by the statute which requires the patent applicant to pay all of the expenses of the district court proceeding, regardless of the outcome.

While the Hyatt en banc decision addresses a form of action that arises only in a patent prosecution context, and is not all that common, it nonetheless liberalizes the ability of an applicant to challenge adverse BPAI rulings, and therefore is an important new development in intellectual property practice. In the meantime, the Hyatt decision has some interesting ramifications. For example, to avoid the deference to be given to USPTO fact determinations under the APA, as expressed in the Supreme Court's Zurko decision, and now confirmed by the Hyatt en banc court, fact determinations may now be challenged in a §145 action merely by the submission of new evidence and/or live testimony. This will obtain a de novo review on that fact issue. Practitioners thus may need to be diligent and thorough in their regular patent prosecution to make sure that the appropriate legal issues are raised to preserve the opportunity to introduce new evidence on that issue and obtain de novo review in a §145 action.

Further, in those cases where an applicant is facing an obviousness rejection, given the passage of time that accompanies an appeal, an applicant may have more persuasive evidence of secondary considerations of nonobviousness to submit to a court than was available during regular prosecution. If the practitioner has properly raised the legal issue during prosecution, an applicant will have the valuable ability to introduce this new and more persuasive evidence, by live testimony and documentary support, at a § 145 trial.

Similarly, the ability to have an expert testify live about the prior art and an argument made during prosecution to overcome a prior art rejection, and to be able to cross examine the examiner or the USPTO's expert, would be advantageous. These are some of the reasons why an applicant might seek to pursue a §145 action over a direct Federal Circuit appeal under § 141.

Article: Stopping Improper Patenting of Traditional Knowledge

The view and opinions expressed in this article are those solely of the author(s) and are not of the Los Angeles Intellectual Property Law Association or its members.

By: Scott A. Herbst and Jeremy S. Forest
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Law360, New York (December 10, 2010) — Nov. 23, 2009, marked the U.S. Patent and Trademark Office's watershed announcement that the government of India had granted that agency's patent examiners access to India's "Traditional Knowledge Digital Library" (TKDL), a digital repository of traditional Indian knowledge. USPTO 9-30 Press Release. Several years earlier, during a meeting of the World Intellectual Property Organization in Geneva, the USPTO had professed its support of proposals designed to protect traditional knowledge and folklore and its agreement with the Indian government seemed to show that the USPTO was taking action to back up its words. In this article, the authors first discuss how such information-sharing partnerships have the potential to go a long way toward preventing the improper patenting of traditional knowledge by helping expand the class of patent-defeating "printed publications" under 35 U.S.C. §§ 102(a)-(b), and further consider the extent to which the USPTO's newfound access to databases such as the TKDL may give rise to more validity challenges under a sister provision of the U.S. code, i.e., the "inventorship" condition for patentability that is codified in Section 102(f).

"Traditional knowledge" may generally refer to a country's indigenous methods and products, such as an Amazonian tribe's treatment for an illness using a combination of endemic flora. Even though such treatments may be centuries old, their use in the Amazon will not alone bar a U.S. patent covering the same treatment given the "in this country" language of 35 U.S.C. §§ 102(a)-(b) that excludes such extraterritorial uses from the "prior art" that can be considered in assessing patentability. Presumably, the TKDL and other such new digital libraries of traditional knowledge will help close such geographic loopholes by providing content that may qualify as patent-defeating "printed publications" under those code provisions (or point to where such publications can be found). Several questions remain, however, as to whether databases like the TKDL will present any real hurdle to someone in the U.S. who seeks to patent another country's traditional knowledge.

While instances of individuals attempting to get a U.S. patent on some foreign-sourced traditional knowledge seem relatively uncommon, several notable cases have received international attention. For example, in 1995, two Indian-American scientists from the University of Mississippi obtained a patent covering the "use of turmeric in wound healing." See U.S. Patent No. 5,401,504. They did so even though the uses that they laid claim to had in fact been used for centuries in India, including in the preparation of certain cosmetics and as insect repellants. A subsequent re-examination provided the USPTO with information on such ancient uses in the form of published references that it had not considered during the original prosecution, leading to the cancellation of all of the patent's claims. See Reexamination Certificate for U.S. Patent No. 5,401,504.

That such patents even issue in the first place is not necessarily surprising, given for example that Section 102(a) is triggered only if the prior knowledge or use was "in this country." Section 102(b) features a similar geographic limitation, expressly restricting the universe of relevant prior public uses capable of preventing the issuance of a U.S. patent to those done "in this country." Such gaps do not exist in every patent system. The European Patent Convention (EPC), for example, defines prior art to include oral disclosures and use without geographical limitation. Article 54(2) EPC (2000).

Those code sections, however, treat "printed publications" differently, allowing consideration of those types of items whether from "this or a foreign country." Thus, at least in the U.S., the success of such new electronic sources of information like the TKDL in preventing the improper patenting of traditional knowledge depends in large part on whether what they contain constitutes a "printed publication" for purposes of Section 102. See, e.g., *SRI Int'l Inc. v. Internet Sec. Sys. Inc.*, 511 F.3d 1186, 1194-95 (Fed. Cir. 2008) (discussing the "printed publication bar" of Section 102(b), noting its public accessibility aspect). In addition, in order to qualify as prior art under Section 102, the information relied upon must provide an enabling disclosure, even though not written in the English language. See, e.g., *Orion IP LLC v. Hyundai Motor America*, 605 F.3d 967, 974-75 (Fed. Cir. 2010). Those requirements might hamper the TKDL from fulfilling its primary objective. To be most effective, storehouses of traditional knowledge should feature original teachings that pass muster under Sections 102(a) and (b).

There are, however, other patentability conditions recited in Section 102 that may help protect traditional knowledge from improper patenting. Beyond Sections 102(a)-(b) lies Section 102(f), which states that a person can be awarded a patent unless "he did not himself invent the subject matter sought to be patented." In announcing its access to the TKDL, the PTO

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stated that “[i]f a patent application attempts to claim an invention within the existing traditional knowledge, a patent examiner will reject the application provided they can find evidence proving the prior existence of that knowledge.” USPTO 9-30 Press Release. In the authors’ eyes, it stands to reason that “evidence proving the prior existence of that [traditional] knowledge” puts inventorship into play. The question, however, is whether databases like the TKDL have what the law requires to establish that an applicant for a U.S. patent that would cover traditional knowledge is not the proper “inventor” of the subject matter at issue. The requirements of Section 102(f) stand independent of what Sections 102(a)-(b) require. Thus, traditional knowledge that may not constitute a “printed publication” for purposes of Sections 102(a)-(b) may still be considered for purposes of Section 102(f). For example, Section 102(f) “does not require an inquiry into the relative dates of a reference and the application.” MPEP § 2137.

However, as promising as all that may make Section 102(f) sound as a viable tool for protecting traditional knowledge through inventorship challenges, decisions from both the USPTO and the Federal Circuit raise some noteworthy obstacles to databases such as the TKDL making any real difference. Well-settled precedent establishes that “most, if not all, determinations under section 102(f) involve the question of whether one party derived an invention from another.” See, e.g., *Ex parte Kusko*, 215 USPQ 972, 974 (Bd. App. 1981). In other words, even though a member of the aforementioned Amazonian tribe may be the real inventor of using endemic flora to treat an illness (Inventor A), Section 102(f) will not bar someone else (Inventor B) from obtaining a U.S. patent on the same flora-based treatment absent sufficient proof that Inventor B derived his “invention” from Inventor A. And “derivation,” says the Federal Circuit, requires not only proof of 1) a prior conception of the invention, but also 2) communication of that invention to the applicant. See, e.g., *Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573, 1577 (Fed. Cir. 1997). Loosely stated, Section 102(f) poses no hurdle to Inventor B absent proof that Inventor A thought of it first and shared it to some extent with Inventor B. Even though Section 102(f) applies to derivations that “may never become public” (see *OddzOn Products Inc. v. Just Toys Inc.*, 122 F.3d 1396, 1401-02 (Fed. Cir. 1997)), the requirement of proving that there was some “communication” between Inventor A and Inventor B may not be an easy one to satisfy (even under a broad definition of that word).

Moreover, the Board of Patent Appeals and Interferences requires “strong evidence” that an applicant is not the “sole inventor” before it will sustain a rejection under Section 102(f). See, e.g., *Ex parte Kusko*, 215 USPQ at 974 (“Where an applicant by oath or declaration states that he is the sole inventor of a particular invention, strong evidence is required to reach a contrary conclusion.”). It is of course the applicant’s burden “to provide a satisfactory showing [that] would lead to a reasonable conclusion that he is the sole inventor” which can be satisfied through, for example, an affidavit or declaration that he is the “sole inventor of the subject matter described and claimed in his application.” *In re Katz*, 215 USPQ 14, 18 (CCPA 1982).

The guardians of traditional knowledge can at least take some comfort knowing that the relevance of Section 102(f) information is not limited to determinations of novelty. The Federal Circuit squarely addressed that issue in *OddzOn Products Inc. v. Just Toys Inc.*, 122 F.3d 1396 (Fed. Cir. 1997), in the context of considering whether disclosures that constituted patent-defeating subject matter under Section 102(f), but were confidential (nonpublic), could still be relied upon with other prior art for purposes of an obviousness challenge. The court concluded that “subject matter derived from another not only is itself unpatentable to the party who derived it under Section 102(f), but, when combined with other prior art, may make a resulting obvious invention unpatentable to that party under a combination of Sections 102(f) and 103.” *OddzOn*, 122 F.3d at 1403-04.

In sum, databases like the TKDL will provide examiners with a powerful new tool for referencing traditional knowledge, including information and documents that were previously inaccessible, as prior art under Sections 102(a)-(b). Such databases may also provide new grounds for rejections under Section 102(f), but the evidentiary requirements (proving conception and communication) seem to favor the U.S. patent applicant over the Amazonian tribesman.

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Department

Agents in the patent group work on a variety of projects, including: drafting and prosecuting patents, preparing invalidity and non-infringement opinions, analyzing patents in support of litigation and adversarial licensing, and performing due diligence for corporate transactions and technology transfers.

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All submissions are held in confidence. For confidential discussion and consideration, please contact:

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LAIPLA Announces Sponsor Opportunities

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LAIPLA

Los Angeles Intellectual Property Law Association

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Present

Washington In The West

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Undersecretary of Commerce and Director of the USPTO, David Kappos

Assistant Deputy Commissioner of Patent Operations, James Dwyer

Acting Chief Administrative Trademark Judge, Gerard F. Rogers

Administrative Trademark Judge, Lorelie Ritchie

Deputy General Counsel IP Law and Solicitor, Raymond Chen

Director of PCT Legal Division, WIPO, Matthew Bryan

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11461 Sunset Blvd., Los Angeles, CA 90049

8:15 a.m. – Registration & Continental Breakfast

8:55 a.m. (Sharp) Meeting & Program

12:30 p.m. Luncheon

Thursday, January 27, 2011

Present

The Fourteenth Annual Washington in the West Conference

January 27, 2011

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11461 Sunset Blvd., Los Angeles, CA 90049

8:15 a.m. Registration & Continental Breakfast

8:55 a.m. Opening Remarks

◆ **David Weiss/Josué Villalta**

*Knobbe Martens Olson & Bear LLP
Los Angeles, CA
Conference Chairpersons*

9:00 a.m. Examination of Software Patents

◆ **James Dwyer**

*Assistant Deputy Commissioner for Patent
Operations*

10:00 a.m. Accelerated Examination

◆ **Bill Bunker**

*Knobbe Martens Olson & Bear LLP
Irvine, CA*

◆ **Patrick R. Jewik**

*Kilpatrick Townsend & Stockton LLP
San Francisco, CA*

11:00 a.m. Morning Break

11:15 a.m. Work Sharing and Prioritizing Examination Initiatives: WIPO's Contribution and Views, Including Patent Prosecution Highway

◆ **Matthew Bryan**

Director of PCT Legal Division, WIPO

◆ **Carl Oppedahl**

Member of the Board of Directors of AIPLA

12:30 p.m. Luncheon Speaker on USPTO Policies and Programs

◆ **David Kappos**

*Undersecretary of Commerce for Intellectual
Property and Director of the USPTO*

2:00 p.m. Best Practices before the Trademark Trial and Appeals Board – Accelerated Case Resolution and Practice Tips for Inter Partes Cases

◆ **Judge Gerard F. Rogers**

Acting Chief Administrative Trademark Judge

◆ **Judge Lorelei Ritchie**

Administrative Trademark Judge, TTAB

3:00 p.m. Inequitable Conduct : *Therasense v. Becton et al.* (Fed. Cir. 2010)

◆ **Raymond Chen**

*Deputy General Counsel for IP Law and
Solicitor, USPTO*

◆ **Rachel Krevans**

Morrison & Foerster, San Francisco, CA

4:00 p.m. Concluding Remarks

◆ **Alexander R. Schlee**

*Schlee IP International, P.C.
LAIPPLA President*

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