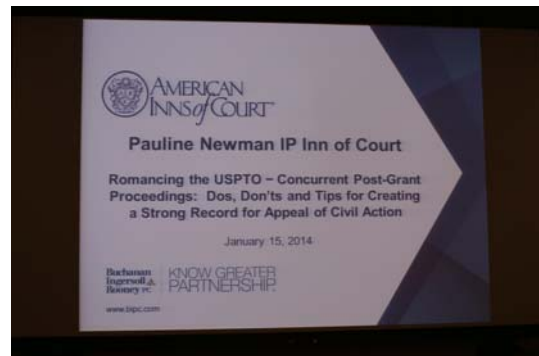




ORGANIZATIONAL MEETING RECAP
THE PAULINE NEWMAN
IP AMERICAN INN OF COURT
WEDNESDAY, JANUARY 15, 2014



The first Inn meeting of the 2014 calendar year took place in the Auditorium below the Atrium in the Madison Building of the headquarters of the U.S. Patent & Trademark Office in Alexandria, Virginia. There was an initial reception beginning at 5:30 p.m. at which drinks only were served. The presentation began at 6:16 p.m.



The format of the presentation was a panel discussion. Erin Dunston served as the moderator. The panel members were Todd Walters, Oliver Ashe, Jr., Judge Scott Boalick, Judge Michael Tierney, Judge Liam O'Grady, Don Coulman, Ph.D., Philip Hirschhorn, and Judge Pauline Newman (who sat with the audience, rather than behind the table on the stage with the other panelists).



Inn President Judge Liam O'Grady opened the program. The focus of the program was on post-grant proceedings, including inter partes reviews (IPRs), post-grant reviews (PGMs), covered business methods (CBMs), and derivation proceedings, which were outlined by Erin Dunston. There are umbrella trial rules for all the post-grant proceedings, and rules for each type of proceeding. The fact pattern involving Dr. Rube Goldberg was continued.

In post-grant proceedings, claims will be given their broadest reasonable interpretation. Claim charts should be prepared. If you are combining references, you should explain why they should be combined. Because of page limitations, it may be necessary to file multiple IPRs on the same patent. Petitions need to be focused. Despite the high PTO fees, IPRs are much less expensive than litigation, and much quicker. IPRs cannot be filed one day more than one year from the date that a complaint is filed in court.



Post-grant proceedings are front-loaded, so you must plan in advance. The patent owner can object to evidence immediately, and must do so to be able to move to strike it later. Evidence cannot be supplemented later. There are three discovery periods: a patent owner discovery period, a petitioner discovery period, and another patent owner discovery period. There may be discovery before the trial is instituted, if there is a question regarding real party in interest. Minor defects in a petition may be pointed out in a preliminary response. The motion to amend process is much more restrictive than in ex parte prosecution.

Make sure that your witnesses will be available in time. Expert witnesses are subject to the Daubert standard.



Lead counsel must be a registered patent attorney, but backup counsel may be admitted pro hac vice. Unless there are reasons not to bring counsel in, the PTAB will generally look in favor of litigants being able to choose their counsel

The Eastern District of Virginia may be less likely to grant stays of litigation for post-grant proceedings than other districts. Estoppel may apply to both petitioners and patent owners. Patent owners want finality.

Judge Newman addressed the Inn last. She explained that the purpose of the new procedures is to reduce uncertainty about patents by providing finality. The costs of justice in the patent system can defeat its purpose.

The program concluded at 7:38 p.m. After the program, members socialized at the main reception, with both food and drink, until about 8:30 p.m. Catering was done by Grand





Cuisine of Grand Hyatt Washington. Social Co-Chairs Judge Hung Bui and John Williamson handled the purchasing and stocking of wine and beer, negotiated the contract with the caterer, and supervised the caterer.

*Photographs were taken by Doug Pearson
Assistant Secretary-Treasurer*

Respectfully submitted,

Stephen Christopher Swift
Secretary-Treasurer