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American Conference Institute's Advanced Summit on

# Global Patenting Strategy & Practice

The Definitive Guide on Effective World-Wide Patent Prosecution and Opposition/Cancellation

July 15–16, 2013, The Carlton Hotel New York, NY



## Distinguished Co-Chairs:

### Cheree Johnson

Chief Innovation Officer  
H.J. Heinz Europe  
(Nijmegen, Netherlands)

### Tom Irving

Partner  
Finnegan, Henderson, Farabow,  
Garrett & Dunner, L.L.P.  
(Washington, DC)

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Leading in-house experts and internationally renowned patent counsel, representing companies in a broad swath of industry sectors, unite to share difficult-to-come-by guidance and best practices to help you:

- DEVELOP a **global patenting strategy** to protect the commercial embodiment of your product in critically important markets around the world
- DETERMINE the impact of **patent harmonization efforts** on your ability to protect your IP in foreign jurisdictions
- REVIEW and UNDERSTAND the standards for **patentability, filing requirements, claim** construction, and obviousness or **inventive step** in major markets like the EU, China, Japan, Korea, and more
- CONTRAST the **opposition procedures** utilized in the US post-America Invents Act, at the EPO, in China, and elsewhere
- UTILIZE the ITC as a forum for litigating international patent disputes
- CRAFT effective strategies for **protecting trade secrets** in numerous countries, whether they have robust IP protections in place or not

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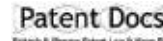
**WORKSHOP A:** Mastering the Foreign Patent Law and Regulatory Requirements for Life Sciences Companies in a Global Context

**WORKSHOP B:** The Interactive Working Group Session: Negotiating the Obstacles and Challenges Associated with Patenting a Product in Numerous Jurisdictions

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# Your Marketplace is Global – Ensure that Your Patent Protection is Too

As businesses increasingly look to global markets to increase their market share in a rapidly evolving and more-competitive-than-ever worldwide marketplace, it is imperative that companies racing to get their products on shelves around the globe ensure that proper IP protections are always in place first. However, despite harmonization efforts, the difficulty in developing an effective international patenting strategy is that patenting systems around the world have standards for patentability, inventive step, or opposition procedures that are not fully aligned. With so many available jurisdictions, each with their own concepts of what patents are and their own local rules and customs, it can be extremely difficult for even seasoned patent counsel to develop systems for advising clients on how to safely take products from national to international markets and ensure that their products will be protected in every market they enter.

## Receive the Expert Instruction Needed to Synthesize a Fully Informed Patenting Strategy to Maximize Global Market Share

**American Conference Institute's Advanced Summit on Global Patenting Strategy & Practice** unites seasoned counsel with experience practicing in critical jurisdictions to share their wealth of knowledge and help you understand not only the mechanics of obtaining patents around the world, but also strategies for the most effective and efficient means of protecting IP in a global marketplace. Representing companies in an array of industry sectors, our expert faculty will address questions like:

- How do you select the right local counsel depending on your needs?
- What jurisdictions provide effective patent protection for your products and which ones do not and what are the specific costs involved?
- How to reconcile the issues that arise when coordinating with inventors in numerous countries simultaneously?
- Which safeguards must multinational entities put into place when marketing and selling products protected by trade secrets?
- How do inventor compensation issues impact decisions to patent in one country or another?
- How do you draft claims broadly enough in different countries to cover all commercial embodiments and reasonably foreseeable competitive challenges?
- What written description requirements meet the standards required by multiple jurisdictions including the EU and Asian countries?
- When do outcomes from opposition proceedings in one jurisdiction impact the ability to protect a product in others?
- Can evidence obtained in one country be used in litigation for other countries?

And much more!

## Enhance your conference experience by attending the post conference workshops:

- **Mastering the Foreign Patent Law and Regulatory Requirements for Life Sciences Companies in a Global Context and the Post Conference Interactive Working Group Session**
- **Negotiating the Obstacles and Challenges Associated with Patenting a Product in Numerous Jurisdictions**

This forum will enhance your understanding of patent practice in foreign jurisdictions and help you make more fully informed recommendations for your business and clients. Reserve your spot at this critically important conference by calling 888-224-2480, by fax at 877-927-1563, or online at [www.americanconference.com/PatentingStrategy](http://www.americanconference.com/PatentingStrategy).

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- Chief Patent/IP Counsel
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8:00 **Registration and Continental Breakfast**

8:45 **Co-Chairs' Opening Remarks**

*Cheree Johnson*

Chief Innovation Officer

H.J. Heinz Europe (Nijmegen, Netherlands)

*Tom Irving*

Partner

Finnegan, Henderson, Farabow, Garrett & Dunner, L.L.P.  
(Washington, DC)

**Spotlight on Strategic Planning:  
Understand the Global IP Environment  
to Maximize Product Value**

9:00 **Understanding the Importance of Developing  
a Global Strategy for Your Patent Portfolio**

*Cheree Johnson*

Chief Innovation Officer

H.J. Heinz Europe (Nijmegen, Netherlands)

*Kevin Noonan*

Partner

McDonnell, Boehnen, Hulbert & Berghoff, L.L.P.  
(Chicago, IL)

Before companies can begin the process of filing for patent protection around the world, they must establish a sound strategy for protecting their IP most successfully. Nevertheless, crafting a truly effective strategy is not always straightforward and may often not even be practically possible, and this session will unite senior counsel and in-house experts to discuss best practices for creating a patenting world-wide strategy that will help attendees devise world wide patenting strategies to optimize protection for their product portfolios. Our faculty will share their thoughts on:

- Understanding the commercial embodiment of your product
  - Drafting claims broadly enough to cover embodiments in numerous jurisdictions
  - Recognizing when narrow claims are the best strategy and in what jurisdictions
  - Ensuring that you can remain flexible when prosecuting patents so that you can account for changes in your product's commercial embodiment, as well as account for design arounds by competitors
- Determining which countries provide effective patent protection for your product
  - Analyzing markets to make a decision on where to file
  - Considering the patent protection available in varying jurisdictions when determining whether to file there
- Does the national patent office examine patents or register them?
- Average time and cost of prosecution
- Are there effective national enforcement mechanisms to make patents worthwhile in that market?
  - Exploring options and necessity for obtaining a Foreign Filing License
- What products require that patenting entities obtain a Foreign Filing License?
  - Devising a mechanism to control world-wide prosecution costs

- Employing a robust methodology for firm selection when prosecuting patents
- Engage a global law firm to file everywhere? or have a managing firm directing local lawyers?
- When should you retain local firms in different jurisdictions?

10:00 **An Alignment of Interests: Determining  
the Impact of Patent Harmonization  
Efforts on IP Protection**

*Samson Helfgott*

Of Counsel

Katten Muchin Rosenman, L.L.P. (New York, NY)

*John Pegram*

Senior Principal

Fish & Richardson, P.C. (New York, NY)

*John Richards*

Partner

Ladas & Parray, L.L.P. (New York, NY)

- Surveying harmonization efforts in different jurisdictions
  - Reviewing the America Invents Act's impact in harmonizing Title 35 U.S.C. with other patent codes
  - Investigating the EU's Unified Patent Court
- What is the current status of this effort?
  - Understanding the push for more IP uniformity in court systems
  - Outlining the differences and similarities in harmonization efforts in different countries
  - Exploring the TRIPS and WIPO issues associated with harmonization efforts
  - Recognizing key TRIPS provisions affecting patent procurement
  - How do the Trans-Pacific partnerships play into harmonization efforts?
  - Investigating how patent term extension and adjustment regimes are being impacted by harmonization endeavors

11:00 **Morning Coffee Break**

11:15 **Devising Effective Strategies for Working  
with Inventors in Foreign Jurisdictions**

*Edouard G. Lebel*

Associate Director

Boehringer Ingelheim Pharmaceuticals Inc.  
(Ridgefield, CT)

- Addressing the filing requirements based on the jurisdiction where the inventive activity occurred
  - What constitutes joint inventorship for purposes of these filing rules?
  - Grasping the importance of knowing who can be considered an inventor
  - How common are these sorts of filing requirements? Are they on the upswing?
  - What are some best practices for avoiding situations where inventorship will require a particular filing strategy?
  - Exploring the impact of an inventor's nationality on filing requirements
- What are the filing requirements for discoveries in particular jurisdictions?

- What are the employee-employer rules for inventorship?
- Investigating inventor remuneration issues in different jurisdictions
  - Surveying remuneration requirements in major jurisdictions
  - Determining when remuneration requirements are sufficiently onerous to preclude filing there
- Managing inventors in different jurisdictions
  - Establishing ground rules for communication
  - Ensuring that all parties communicate effectively

## 12:15 Networking Lunch

### The Prosecution Boot Camp: Drilling Down Into the Details of Global Patent Procurement

#### 1:30 A Review of Guidelines for Patentability and Novelty in Different Patent Offices

*Tom Irving*

Partner

Finnegan, Henderson, Farabow, Garrett & Dunner, L.L.P.  
(Washington, DC)

*Albrecht v. Menges, Ph.D.*

Partner

Uexkull & Stolberg (Hamburg, Germany)

*Marc V. Richards*

Shareholder

Brinks, Hofer, Gilson & Lione (Chicago, IL)

- Surveying patentability requirements around the world
  - Business method patents
  - Process patents generally
  - Biological and life science inventions
  - Software patents
- Exploring the different standards for patentability in various jurisdictions
- Evaluating methods for determining where to file based on patentability
  - Filing directly in the country of choice
- Addressing examiner arguments geared towards filing in the home jurisdiction
- Patentability and novelty standards as compared to the US in:
  - The EU
  - China
  - Japan
  - Korea

#### 2:30 Comparing Claim Drafting and Construction Standards in Important Jurisdictions

*Yoshiaki Ishida (Invited)*

Officer, Associate General Counsel,

Head of Intellectual Property Department

Eisai, Ltd. (Japan)

- Exploring claim construction in the EU
  - Employing multiply dependent claims and stating prior art in claims
  - Comprehending the emphasis on essential features
  - Recognizing the constraints imposed by limiting independent claims

- Utilizing alternatives in claim drafting
- Understanding the importance of using functional claim language
- Investigating the impact of disparate claim construction of different types of claims
  - Process and method claims
  - Claims on software inventions
  - Composition of matter claims
- Grasping the different views on claim drafting in different jurisdictions
  - Avoiding the use of many claims as per practice in the US
- Comparing and contrasting claiming strategies in Asian countries
- Drafting claims broadly enough to cover all commercial embodiments and reasonably foreseeable competitive challenges

#### 3:30 Afternoon Refreshment Break

#### 3:45 Exploring Obviousness and Inventive Step Concepts Around the World

*Amy Feng*

Partner

Liu, Shen & Associates (Beijing, China)

*Vincent J. Gnoffo*

Shareholder

Brinks, Hofer, Gilson & Lione (Chicago, IL)

- Reviewing the current state of the obviousness standard under US law
- Comparing the US obviousness standard to the standard employed in the EU
  - Understanding the problem-solution analysis
  - Grasping the importance of the “inventive step” to obviousness analysis in the EU
  - How do you prove to an examiner that there has been an “inventive step”?
  - What constitutes a “technical effect” in this analysis?
- Investigating the obviousness standard globally
  - China
  - Japan
  - Korea
  - India
  - Australia

#### 4:45 Analyzing Written Description and Specification Requirements Across Different Patent Regimes

*Gordon Wright*

Partner

Elkington & Fife, L.L.P. (Kent, UK)

This session will focus on ensuring that the written description and specification for patents filed in multiple jurisdictions meet the standards required by each jurisdiction. Particular focus will be paid to the US, EU, Australia, and Asian countries.

#### 5:30 Conference Adjourns to Day 2

8:00 **Continental Breakfast**

8:45 **Co-Chairs' Opening Remarks**

**Focus on Global Opposition and Litigation Practices**

9:00 **Comparing and Contrasting Opposition Proceedings in the US and EU**

*Filip De-Corte*

Attorney  
Cargill (Belgium)

*Bryan Diner*

Partner  
Finnegan, Henderson, Farabow, Garrett & Dunner, L.L.P.  
(Washington, DC)

- Reviewing the new opposition proceedings made available in the US by the America Invents Act
  - Inter partes review
  - Post grant review
- Contrasting the opposition practice now available in the US with the established opposition mechanisms at the EPO
- To what extent is opposition in the EU binding on courts in subsequent examination?

10:00 **Navigating the "Ins" and "Outs" of Opposition Practice Across the World**

*WonSang Lee*

Partner  
First Law, P.C. (Seoul, Korea)

*Michael Wise*

Partner  
Perkins Coie, L.L.P. (Los Angeles, CA)

*Debra Yin Foo*

Partner  
Phillips Ormonde Fitzpatrick (Melbourne, Australia)

- Understanding which challenges can legitimately be made to a patent under current opposition practice protocols in:
  - China
  - India
  - Japan
  - Korea
- Crafting a pre-opposition checklist
  - How will the file history be looked at from an opposition standpoint?
  - How will the U.S. file history be viewed?
- Ensuring that a comprehensive prior art search is conducted during opposition to safeguard your patent's validity during opposition proceedings

11:00 **Morning Coffee Break**

11:15 **Managing Unique Challenges and Investigating Emerging Trends in Foreign Patent Litigation**

*D. Christopher Ohly (Invited)*

Partner  
Schiff Hardin, L.L.P. (Washington, DC)

- Choosing counsel in foreign jurisdictions
  - Understanding the role of individual trial counsel
- Coordinating numerous global actions
  - Taking a consistent position in multiple jurisdictions
  - Grasping how decisions in one jurisdiction affect a patent in other jurisdictions
  - Utilizing forum shopping to gain an advantage
- Examining multinational litigation through case study
- Exploring methods for obtaining an order to pursue discovery in various jurisdictions
  - Evaluating what forms of discovery are available in the country in which you are litigating
- Contrasting discovery in the US with seizure of evidence in other nations
  - Seeking discovery on the basis of a foreign patent
  - Becoming familiar with foreign discovery timetables
- Determining when evidence obtained in one country can be used in litigation in other countries
  - Investigating the latest trends in patent disputes in jurisdictions around the world
  - The EU
  - India
  - China

12:15 **Networking Lunch**

1:30 **Using the International Trade Commission (ITC) as a Venue for Global Patent Conflicts**

*Mark L. Whitaker*

Partner  
Baker Botts, L.L.P. (Washington, DC)

- Identifying situations where the ITC is the appropriate venue for your patent dispute
- The similarities and differences between ITC and District Court proceedings
- Why are technology companies increasingly turning to the ITC?
- What lessons can we take away from the Apple v. Samsung proceeding?

**Spotlight on Alternative IP Protection and Emerging Issues**

2:30 **Crafting Effective Strategies for Protecting Trade Secrets in Multiple Jurisdictions**

*Glen Belvis*

Chief Intellectual Property Counsel  
Foro Energy, Inc. (Littleton, CO)

### Scott McBride

Shareholder

McAndrews, Held & Malloy, Ltd. (Chicago, IL)

This session will explore the challenges associated with protecting IP as a trade secret in jurisdictions around the world. While case law in the US has been evolving towards increased protection for trade secrets, their treatment in other nations has been wildly disparate. Points of discussion will include a survey of current trade secret protection in numerous jurisdictions, discussing best practices from protecting them, how multinational entities can protect the same trade secret in various jurisdictions, and more.

### 3:30 Afternoon Refreshment Break

### 3:45 Addressing the Challenges Presented by Compulsory Licensing Provisions Abroad

#### Noreen Johnson

Vice President and Chief Patent Counsel  
Medtronic Spine (Minneapolis, MN)

As globalization continues to heighten disparities between richer and developing countries, employment of compulsory licensing to ensure that products are available to the domestic market in many developing nations has become more commonplace. This session will explore:

- Increasing use of compulsory licensing
  - Why do jurisdictions utilize these licenses?
  - What are the types of products that are impacted by compulsory licenses?
- Which jurisdictions use these mechanisms frequently
- How to address their use
  - The possibility of negotiating licensing provisions
  - Calculating the cost/benefit of submitting to compulsory

### 4:45 Conference Concludes

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## WORKSHOP A

### Mastering the Foreign Patent Law and Regulatory Requirements for Life Sciences Companies in a Global Context

8:30 **Registration and Continental Breakfast**

9:00 **Workshop Commences**

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*Bert Oosting*

Partner

Hogan Lovells, L.L.P. (Amsterdam, Netherlands)

Focusing on the unique challenges associated with patenting life sciences products abroad, this session will utilize the expertise of patent counsel well versed in obtaining IP protection in the EU and important Asian countries. Presenting a comprehensive overview, this session will review the basics of patent protection and regulatory approval necessary for the commercial viability of valuable life sciences products in these critical markets. Points of discussion will include:

- Available and pending remedies for enforcing intellectual property rights
- Exploring the interplay between patent law and regulatory requirements when there is no patent linkage but patent law is embedded within the regulatory framework
- Understanding the subject matter patentability issues for life sciences products abroad
  - Gene patenting
  - Antibody patents
  - Polymorph patents
  - Diagnostic method patents
  - Methods for treatment/second medical use patents
- Investigating the foreign data exclusivity regimes comparable to Hatch Waxman laws in the US

12:00 **Workshop Concludes**

Lunch Available for Attendees of Both Workshops

## Workshop B

### The Interactive Working Group Session: Negotiating the Obstacles and Challenges Associated with Patenting a Product in Numerous Jurisdictions

1:00 **Registration**

1:30 **Workshop Commences**

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In this highly interactive working group session, experienced patent counsel will use hypothetical scenarios to demonstrate typical challenges associated with pursuing global patent protection. Our faculty of expert practitioners will present attendees with a model company developing a novel product, and walk them through the steps of obtaining patent protection in numerous foreign jurisdictions, highlighting the choices that can be made and common pitfalls occurring at each step of prosecution. Framing the process as a series of consequential decisions, the scenario will help attendees develop best practices in an open discussion. Topics to be covered will include:

- Identifying the jurisdictions that will be most critical to protecting your product's IP
- Establishing mechanisms for cost control in prosecution
- Understanding the filing requirements in each country
- Comprehending the examination process in various jurisdictions
- Crafting claims that are broadly applicable to your product in numerous countries
- Utilizing the PCT application's priority and search report to improve your case when filing abroad
- Ensuring that nonobviousness and inventive step requirements are met in applications
- Retaining the best counsel to file in various jurisdictions
- Conducting effective freedom to operate searches globally
- Investigating the communications and relationships that may be formed with examiners abroad

4:30 **Workshop Concludes**

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WEDNESDAY, JULY 17, 2013

**WORKSHOP A: Mastering the Foreign Patent Law and Regulatory Requirements for Life Sciences Companies in a Global Context**

**WORKSHOP B: The Interactive Working Group Session: Negotiating the Obstacles and Challenges Associated with Patenting a Product in Numerous Jurisdictions**

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