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AIPLA DAILY REPORT

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Why Waco is the place to be

INTERVIEW Page 2



Barbara Fiacco on 'giving back to this special community'

INTERVIEW Page 4



Andrei Iancu: 'The office has to be funded'

I'm shocked to find that folks do not like fees to be increased," joked Andrei Iancu, Director of the USPTO, at yesterday's Opening Plenary Session.

He was speaking with Sheldon Klein, President of AIPLA, in a fireside chat. The two were discussing proposed fee increases by the USPTO for both patents and trademarks.

"The office has to be funded," Iancu said, speaking more seriously about a proposed annual practitioner's fee for patents. "We only have one source of fees and that is the application fee paid by inventors. The question is, shouldn't those funds come directly from practitioners that benefit or deal with the particular office that regulates them? So the idea is to raise the fees directly for the practitioners that are members of our bar. All the state bars that folks are members of have fees significantly higher than what we have proposed."

Iancu said that the USPTO has also proposed having a discount on fees for practitioners if they met certain CLE requirements.

"We are not proposing to make [CLE] mandatory. It's purely voluntary. Right now there is nothing, but we are proposing a voluntary CLE requirement, and if you do it, you would get the discount on the fee so that we can encourage folks to do the CLE," he said. "That goes towards increasing the level of edu-



cation in this very complex and fast-changing area of law and therefore increasing the quality of applications we get at the Office and the folks who practice before us."

He added that on the trademark side, a proposal would introduce fees for those who deleted goods after an audit.

"If you're deleting [goods] based on an audit because you got caught, there would be a fee on that," he said.

Klein and Iancu also discussed the importance of artificial intelligence (AI). In addition to providing value within the USPTO, such as improving accuracy of classification and helping the office route applications to the right

examiners, Iancu said that AI raises questions about patentability.

"Just recently we received an application that claims to have been invented entirely by a machine," Iancu said. "So questions come up such as 'can a machine be an inventor?'. Under current law, inventors must be actual persons. What about a machine? Who would be the owner of this new technology or this patent? Is the machine the owner, or the owner of the machine, or the folks who created the machine or fed data into the machine? Who is it?"

Iancu added that the Office published a federal notice seeking comments on a variety of AI questions in August.

"One of the questions is, 'are there other questions we should be asking?'. The deadline is November 8, so please send in comments," he said.

During the chat, the two also discussed the importance of diversity. In addition to highlighting the importance of women and other underrepresented demographics in IP and innovation, Iancu said that geographical diversity was important.

"We need to reach out not just demographically but also geographically. We need to enable communities around the US, not just in concentrated areas. We need to work with local communities to incentivize additional innovation from those communities. We need to partner with local governments, with local universities and academia to create innovation hubs in cities around the nation."

Iancu also discussed the importance of pro bono work and the role that those in the room could play in promoting it.

"Very few people in the community know about the significant pro bono resources that are out there so we need to do more to spread the word. Folks in this room can go back to law firms and make [this information] available to your lawyers, to your partners, to your associates. When they have to fulfill their pro bono requirement, let them know there is an IP option to fulfill those requirements," he said.

We will follow examples of late IP legends, says President

AIPLA President Sheldon Klein pledged to follow the examples of late IP legends Don Martens and Donald Dunner at the Opening Plenary Session of this year's AIPLA Annual Meeting yesterday.

Martens, who co-founded law firm Knobbe Martens, and Finnegan partner Dunner, both of whom were once AIPLA President, died recently at the ages of 85 and 88 respectively.

After a moment's silence for the two men, Klein said it was important for AIPLA to follow in their footsteps and be a driver of thought leadership in the IP community.

"Following the example of these great leaders, AIPLA is determined to be a change agent for IP," he said.

The President noted that AIPLA will act

as a beacon for positive change by continuing to advocate for the IP community. The organization has been part of agency hearings and roundtables, and submitted comment letters and amicus briefs.

He said that two notable advocacy highlights were Senate testimony on Section 101 reform and a submitted brief that was quoted by Justice Sotomayor in her concurrence in the *Mission Product Holdings* trademark bankruptcy case.

Klein added that the AIPLA Annual Meeting itself is another example of how the organization drives education, communication and change in the IP community.

The President went on to recognize the USPTO Commissioner for Trademarks, Mary Boney Denison, who is leaving her role at the end of the year, and emphasized

her exceptional service in that role over the past five years.

Attendees applauded Denison for keeping the critical operations of the Trademark Office running smoothly and developing innovative practices and procedures designed to root out 'deadwood' and ensure the integrity of the register.

Denison, who was then invited onto the stage, said she was profoundly touched to be acknowledged by such an esteemed organization.

"I've worked with many of you over the years, and it has been one of the highlights of my career. The collaboration AIPLA promotes among lawyers in private and corporate practice, government and academia provides an immeasurable benefit to the IP community and the public.

"Every time I have called AIPLA to work



with us, they have immediately agreed. The USPTO has benefitted enormously from the opportunity to partner with members and hearing directly from customers."

Why Waco is the place to be

When Judge Alan Albright joined the US District Court for the Western District of Texas, he was clear on one thing: the venue should become an attractive forum for patent litigation.

He got to work immediately. The 59-year-old – who was sworn in last September after being nominated by US President Donald Trump – set about putting in place procedures to ensure that the court, based in the town of Waco, hears cases efficiently and fairly.

“I wanted to provide an alternative venue that folks could take their cases to. Lawyers like predictability, and so I’ve tried to ensure that while also making sure cases run smoothly,” he says.

One of the first things he did – using contacts from his 20 years in private practice as a patent litigator – was create a committee of attorneys from both sides (defendant and claimant) to help craft procedural rules for the court.

The rules include a commitment to address claim construction and conduct a Markman hearing – a pre-trial hearing in which a judge examines evidence on the appropriate meaning of a patent claim – in sufficiently quick time.

“We want to ensure a Markman hearing takes place within six to seven months and that there is also a quick decision after that so that parties and lawyers know early on in a trial what the claim construction will be,” says Albright.

“Generally, we will try and have a trial within 12 to 14 months of the Markman hearing, so trials are taking place within 18 to 20 months of a case being filed.”



“I would say that puts us among the quickest for hearing a case,” Albright says, adding that in the US District Court for the District of Delaware (another popular venue for patent disputes) it tends to take around 30 months for a case to reach trial.

The listening judge

Another feature of his court that has helped bring speedy resolutions is his preference for both sides to submit audio recordings, he says.

“I think I am unique in this regard.”

“For all Markman hearings, I like to receive audio and written submissions. After listening to submissions as well as reading them, I find that by the time I get to the full hearing my level of attention is better.”

Albright says he first benefited from this tactic when going through the process of becoming a judge.

“I knew it [the process] would involve appearing before the Senate Judiciary Committee [which confirms judge nominations] and that they would ask about certain things including Supreme Court rulings. I started listening back to Supreme Court arguments and it occurred to me that I absorbed more by listening.”

His tactics seem to be working too.

Albright says he hears anywhere between 15 and 20 patent cases a month. Prior to his appointment, only 10 patent litigation cases were filed in Waco in the entire history of that division.

For the moment that is “probably about what one judge can handle,” Albright says, adding: “I don’t want to have too many cases that I can no longer handle them efficiently or become overburdened.”

TC Heartland

Albright is right to be wary of being overburdened. Before the US Supreme Court’s 2016 ruling in *TC Heartland v Kraft Foods Group Brands*, the Eastern District of Texas became bogged down with patent cases.

The ruling upheld a determination from 1957 that patent infringement cases must be heard in the district in which a defendant is incorporated.

However, after the original 1957 ruling, subsequent changes led courts to rule that infringement cases could be brought anywhere where the defendant conducted business considered to be infringing.

In practice, this resulted in claimants arguing that defendants who sold products anywhere in the US were technically doing business in that court’s jurisdiction and could be sued there.

It was this interpretation that resulted in the Eastern District of Texas becoming overburdened with cases from so-called forum-shopping plaintiffs – particularly non-practicing entities – who perceived the court’s procedural rules to be advantageous.

The question of venue was not raised again until the *TC Heartland* ruling, which tightened the rules in line with the 1957 decision.

However, Albright says he doesn’t put the popularity of his court down to ‘forum-shopping.’

There is “no question” that *TC Heartland* has had an effect on cases, but the Western District of Texas is a bona fide venue for many disputes, Albright says.

He points out that the city of Austin and its surrounding areas (which fall under the court’s jurisdiction) are home to offices and facilities belonging to many of the country’s largest technology companies.

Albright says: “It’s fair that parties get sued where they are demonstrably doing

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business and not where they are only selling things. It wouldn’t be fair to say Amazon is doing business in a place simply because you can buy their products on a computer in that place.”

Sense of perspective

Although he has some prior experience on the bench – he was a Magistrate Judge in Austin from 1992 to 1999 – much of Albright’s career has been spent on the litigator’s side.

But his short time in court has shown him that this role has changed somewhat over the years.

Lawyers, he says, are now more “belligerent” and continue to make a point even if a judge has suggested it may not be relevant.

“It’s almost never effective to do this,” Albright warns. “When I was a litigator, if a judge implied it was time to move on, I would.”

The number one mistake lawyers make is to not listen to a judge’s question, says Albright.

“Lawyers tend to be prepared to say only what they want to say. They have their themes and their notes but if I ask something that falls outside the script there is a tendency to give an answer that suggests they have not heard the question.”

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IP Prosecution Infringement Litigation

Lawyers discuss patent trial best practices

If you're a jerk, don't stop being a jerk when you testify," said Nicholas Groombridge, a New York-based Partner at Paul Weiss, about the importance of witnesses being themselves on the stand.

He was speaking on "The Importance of Witnesses" during yesterday's panel "How to Prepare a Patent Case for Trial: Tips from the Trenches."

His ultimate point was about credibility – if a witness comes across as fake on the stand, it could undermine credibility with judges and juries.

"I would say all other things being equal, and if I had a choice, I wouldn't pick the obnoxious one, but it may be that I don't have a choice," he added in response to an audience question on whether picking an obnoxious witness in the first place would be risky.

Garrard Beeney, a New York-based partner at Sullivan & Cromwell, agreed during the Q&A session that credibility was important, as is ensuring that a witness's personality is consistent during direct examination and cross-examination.

"The worst thing you can get if you get a witness who might not be the most likable person is that they're [not] the same person in direct and cross-examination. Just make sure it's the same material," he said.

Speaking on "Overcoming Evidentiary Landmines at Trial," Tanya Chaney, a Texas-



based Of Counsel at Shook Hardy & Bacon, ran through several cases where there was debate over whether evidence was considered admissible.

In one case, an inventor came up with a device that allowed a user to get in and out of a vehicle. The claim language said that a portion of the handle would extend "exteriorly from the vehicle" and in the picture the device was extended perpendicularly from the car.

However, a competitor came up with Car Cane, a similar device but which ran parallel to the car instead.

Chaney said the device was even designed so that if you tried to put the device perpendicularly into a doorframe, it wouldn't

fit correctly. Because of this, lawyers advised the creators of Car Cane that it would not infringe the patent of the other device.

Still, the patent owner of the original device had provided evidence of the device being used in a perpendicular orientation. The evidence included photos and Amazon reviews to that effect.

It was later determined, however, that the photos were not of real users; they had been staged.

"It should really come as no surprise that these photos were inadmissible," Chaney said.

Speaking on "Strategic Discovery for Trial," Michael Huget, a Michigan-based Ho-

nigman partner, emphasized the importance of being able to explain a case concisely. He said that lawyers should have a 25-word story to explain a case.

He recalled a case where he was hired to do an appeal on a patent infringement gone awry.

When he reviewed the original trial, he could see that the lawyer had difficulty explaining the case concisely.

"The defense lawyer got up and said, 'there are 16 reasons why this patent is not valid or not infringed,' and the lawyer proceeded to go through all 16 reasons for what seemed like days," he recalled.

"I said, 'okay, I kind of missed it, what was your 25-word story?'. I got, 'well we had 16 reasons why the patent was not valid or not infringed.' There was no story. It was a really good lawyer. It was a really good 'best mode case,' so they had one really good theme, but they just sort of buried it."

Huget added that during depositions, it is important to stick to the 'seven-hour rule.'

"For trial purposes, depositions tend to be the most useful tool that we have, but only if they're targeted," he said.

"If I hear an opposing lawyer tell me, 'oh, we're going to need more than seven hours for each of your witnesses, my first reaction is, 'you've never tried a case before,'" he said. "You don't need more than seven hours with a witness unless it's the most complex case that's ever existed."



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Barbara Fiacco on ‘giving back to this special community’

After 18 years of involvement in AIPLA, Barbara Fiacco is stepping into the role of President, taking up the mantle from Sheldon Klein.

Fiacco is a Massachusetts-based Partner with Foley Hoag, where she has worked since 1997, and focuses her practice on patent litigation and PTAB matters. She first got involved in AIPLA when a colleague at the time, Denise DeFranco (who later served as President of AIPLA), took her along to a meeting.

Fiacco says that her first leadership role with the Association was as Vice-Chair of the Membership Committee and that she worked with Sharon Israel, who also later became President.

“When I was offered the opportunity to join the Executive Committee and ultimately serve as President, there was no question in my mind that I wanted to continue to serve this Association,” Fiacco says. “It has helped shape me as an IP attorney, and I want to give back to this special community and its mission of ensuring a balanced and effective IP system.”

Getting involved

To lawyers who are considering running for senior roles at AIPLA, Fiacco says, “Do it!”

She says that lawyers in leadership roles can plan webinars or programs, draft responses to requests for comments by the USPTO and other IP entities, represent AIPLA at meetings, lead delegation trips abroad and author amicus briefs.

“You will learn new leadership skills and have the opportunity to work with thought leaders from around the world on a range of IP issues,” she says.

AIPLA offers a range of resources, but its online communities are one resource that Fiacco says could stand to see more engagement. Each committee at AIPLA has an online community.

“They serve as a vibrant hub of the committee,” she says. “Many of our substantive committees offer a great deal of practical, and very current, content as well as a place for discussion. As more and more people join the discussion, the content and level of discourse will continue to grow.”

Influencing policy

Fiacco believes that AIPLA plays a key role in IP advocacy.

“I want AIPLA to continue to be an effective advocate for a balanced and effective IP system in a global economy. Because of the diverse practices of our members, we provide an important balanced perspective on IP issues before the USPTO and other agencies, the courts, Congress and around the world.”

She adds that Section 101 advocacy will continue to be a significant issue for the Association. This past year Fiacco testified before the Senate Judiciary’s Subcommittee on Intellectual Property, on subject matter eligibility.

AIPLA also considers artificial intelligence (AI) to be a key issue, Fiacco says.

“The appropriate way to incentivize and protect AI-developed inventions will challenge our existing legal framework. The USPTO has recognized the need for forward-thinking policies with its recently issued ‘Request for Comments on Patenting Artificial Intelligence Inventions,’” she says. “As an



organization with members practicing in the areas of patent, copyright, trade secret and data protection, we are well-suited to analyze and engage policymakers on these challenges.”

AIPLA is hosting events to further address this issue. The Association co-organized a Colloquium on AI with the International Federation of Intellectual Property Attorneys and AIPPI in Turin, Italy in March. Additionally, AIPLA will host an AI Roadshow in Silicon Valley on November 12.

It’s important for AIPLA to be proactive on advocacy matters, according to Fiacco.

“Going forward, on the advocacy front, I would like us to continue to focus on proactively raising issues, as we did with the AIPLA/Intellectual Property Owners Association joint-proposed amendment to Section 101.”

She adds that finding the time to be proactive can sometimes be a challenge when the Association is responding to ongoing activity and its leaders are balancing their full time jobs.

Looking inward and forward

One notable internal change for AIPLA is the expansion of the mission of its Professionalism and Ethics Committee, which will be renamed the Committee on the Profession.

Fiacco says that the Committee will expand its mission to also focus on substance abuse and the mental health and well-being of IP practitioners. The Committee will provide education and resource lists to help address these issues.

“[We want to] recognize the challenges that we have in the Bar. It can be a difficult profession at times, and it can be very stressful. It’s really important to figure out ways we can all support each other and make the profession rewarding, enjoyable and supportive throughout our entire careers.”

In the coming year, Fiacco says that AIPLA will provide more opportunities for IP professionals to come together and discuss issues that matter to them.

“I want AIPLA to continue to be the place for IP professionals to stay at the cutting-edge of their practices,” she says. “Each of us may change jobs multiple times over the course of our careers and shift the focus of our practices as technology and the market change. Through it all, AIPLA should always be a place where we can learn from each other, develop leadership skills and support each other throughout our careers.”

Should not could: the dilemma of design rights

“When I think about design prosecution strategies abroad and some of the requests made by our clients, I’m reminded of the film, one of my favorites, Jurassic Park,” said Thomas Moga, a Michigan-based Senior Counsel at Dykema.

He was speaking in yesterday’s panel titled “The State of Design Rights – Fall 2019” about ethical considerations in design patent practice.

He was referring to a quote from the movie where a character says: “Your scientists were so preoccupied with whether or not they could, they didn’t stop to think if they should.”

He said: “When we view our strategy abroad on the design front, I think we often find ourselves in a position where we are so concerned about making sure that we develop that proper portfolio that we don’t always ask ourselves the question of what we are really doing there.”

“As a result we sometimes lose focus and are persuaded sometimes by the client who is very anxious to develop a portfolio, to file applications that maybe aren’t worthy of design registration.”

Moga referenced the statement that inventors in the US are required to sign: “I believe that I am the original inventor or an original joint inventor of a claimed invention.”

“We’re pretty alone in that regard,” he said. “You don’t see other countries using that.”

Moga mentioned that several years ago he prepared a document for the US Chamber of Commerce on the utility patent system in China. He said the study included room for recommendations on remedying abuse of the system.

When preparing the recommendations, he asked some Chinese associates if a declaration like the one in the US could help curb abuse of the system in China.



“To a person, the responses I got back from my associates, people whose honor and credibility I have great respect for, was, ‘this just isn’t going to work here.’”

Moga said that while some people might be under the impression that China and

other countries are trying to sidestep their obligations, this is not the case. Rather, he argued that many countries are focused on providing a system that is low-cost and high-speed.

At the end of his talk, Moga reminded the audience that while lawyers might not be able to fix the system, they can take care in the choices they make.

“I do have to remind everyone of our duty. The obligation runs with you. If you’re confronted, as I have been, with a client who is overly enthusiastic, ask yourself, ‘Should I be doing this?’ not ‘Could I be doing this?’”

Other speakers at the panel included George Raynal, Principal of Saidman DesignLaw Group, Dunstan Barnes, a Chicago-based Partner at McAndrews Held & Malloy, Justin DeAngelis, a Chicago-based Associate at Quarles & Brady, and Michael Hages, a Michigan-based Partner at Price Heneveld.

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Dos and don'ts of US patent prosecution

In Thursday's first session, "Beyond Drafting the Perfect Specification," patent attorneys revealed the dos and don'ts for prosecuting in the US.

The discussion kicked off with Kirk Damman, a Member at Lewis Rice, handing down his self-described 10 commandments for application data sheet (ADS) applications.

"ADSs are both your best friend and your worst enemy," he said. "Why? They are your best friend because they allow you to provide all sorts of very specific data, but they are your worst enemy because of typos.

"Anything that goes into an ADS is basically taken literally by the USPTO, and mistakes can cost massive amounts of time and money."

For example, he said, a typo cost a security firm in Japan \$340 million when it incorrectly sold 610,000 shares for one yen (roughly \$0.009) each, instead of a sale price of 610,000 yen (\$5,616) per share.

Some rules to keep in mind then, Damman noted, are that if an ADS is improperly filed, there is no ADS; that the USPTO will search through other documents to find necessary bibliographic data if an ADS is not provided; and that a paper ADS must be corrected, marked up, scanned and sent.

Following this presentation, Mueeting, Raasch & Gebhardt Attorney Rakhi Nikhanj

revealed some helpful pointers on what to do when mistakes are inevitably made during the filing process.

"I know you didn't make the mistake – because you are a perfect practitioner," she said to the audience. "However, our clients and other people within the process can make mistakes."

"These mistakes come up, and we have to fix them."

The types of errors that might arise because of such mistakes are non-substantive ones in a substantive context, substantive errors, and errors in the formalities.

Having asked the Office of Petitions what its employees would like to see for the purposes of error avoidance and correction, Nikhanj said a key pointer is to use e-petitions. These automate the petitioning process and ensure that you immediately receive a decision.

"As a patent practitioner, I see it as my duty to limit the amount of time to get a patent reinstated because it is my job to reduce the risk associated with my client's patent portfolio. So if I am fixing a mistake – not mine, but someone else's – I want to file an e-petition."

Matthew Bryan, Director of the Patent Cooperation Treaty Legal Division at WIPO, went on to speak about what his organization



would like to see from PCT filers.

"Today is the opportunity for the tables to turn to our side and for us to let you know what we wish you knew about the PCT system, and the things you should do because it is in your own interest to do so."

One thing he joked was that WIPO wished filers would do is never make mistakes when filing, such as uploading the wrong set of claims to the wrong description, or vice versa. He noted that PCT filers should give all electronic files clear and dis-

tinctive names, endeavor to double-check that the correct files have been attached, and check for possible file-conversion errors.

When it comes to post-filing, Bryan added, applicants should check what they filed immediately after filing on the date of submission through electronic file access systems. And when submitting documents, he said, filers must ensure that the correct documents have been submitted to the correct authority.

Medler Ferro Woodhouse & Mills Of Counsel Melissa Pytel wrapped up the session with a presentation on strategies for dealing with restriction requirements. One of her key points was to talk to clients and not to make assumptions on whether they considered restriction requirements to be a good or bad thing.

"On the pro and cons of restriction requirements, a lot of my clients don't want to avoid restriction requirements. They like them. If they have some sort of out-licensing or monetization strategy, and they want different inventions and patents that they can just shove off in different directions, they're completely happy.

"Equally, there are a lot of costs associated with restriction requirements. So, if you have a cost-sensitive client, such as a solo inventor or start-up, they may not have the money."

Friday's sessions at a glance

Friday morning gets off to a flying start with plenty of topics up for discussion including USPTO trademark tips and practices, and a session on trade secrets litigation.

Mary Prendergast, Associate at Morrison Foerster, is moderating the trade secrets panel in Concurrent Track 3 called: "Winning Strategies and Practical Tips for Trade Secrets Litigation and Agreements."

"Our session covers recent issues in trade secrets law from both a litigation and corporate perspective," Prendergast says.

"Companies are at constant risk of losing sensitive information both as a result of employees moving to new opportunities, and when current employees travel abroad and are exposed to high-risk environments for data theft."

Scott Allison, Chief IP Counsel at Delos Living, will discuss how companies can ensure their sensitive information remains protected when employees travel abroad, while Daniel Hart, Partner at Seyfarth Shaw, will cover best practices for drafting employment and confidentiality agreements for multistate employers.

Hart says he hopes the session will provide a "high-level overview" of the best practices that companies should consider when preparing and administering restrictive covenant agreements in the employment context, including practical drafting tips and state laws that should be considered when preparing template agreements to be used in multiple states.

"This is an extremely timely topic because the last several months have seen an unusually large number of laws passed by several states restricting the use of employee non-competes," he says.

Shaw adds: "I hope that participants will gain a better appreciation for the many issues to consider when implementing employment agreements, and I hope that the presentation will provide practical strategies for navigating these considerations."

Prendergast adds: "We will have additional time for questions during this session given the variety of topics to be discussed, and my hope is that both litigators and corporate lawyers will learn something valuable that they can put to immediate use."

Also in the morning will be a global overview of how to manage an IP portfolio, during Concurrent Track 2.

Speakers include Brian Daley, Partner at Norton Rose Fulbright, who will update attendees on Canada's soon-to-be-implemented changes to IP law.

Daley says the main changes are in the areas of patents, trademarks and industrial designs.

"Many of these changes are substantive. Anyone who has or plans to obtain IP rights (or who plans to challenge another party's IP rights) needs to understand these changes."

In the afternoon, during Concurrent Track 2, Jeoyuh Lin of Lin IP Consulting will moderate an ethics-based discussion called "Lawyers Behaving Badly: Avoiding Messy Transitions and Complying with Your Ethical Obligations."

The session will cover three aspects: the practical and ethical considerations unique to start-ups and the success of solo firms, subject matter conflicts, and avoiding unauthorized practice of law over multiple jurisdictions in the digital age.

The session, Lin says, will be delivered in a "very practical way," with scenarios of real-world, on-the-job encounters, by a panel of seasoned attorneys with experience in dealing with the issues.

"Ethics in legal practice is extremely important because it affects every IP attorney's practice every day, whether in prosecution, litigation, or transaction, over an entire attorney's career," Lin says.

The issues become even more important when an attorney decides to start a solo law firm practice, which has become more common since the 2008 global economic meltdown, he says, adding that an attorney's actions may not be shielded from dangers by his or her colleagues and superiors.

Lin adds: "We hope to help attorneys – whether they are newly trained, in the prime

of their practice or retired – become mindful of the ethical issues that may arise."

In Concurrent Track 3, Lesley Grossberg, Counsel at Baker Hostetler, will look at "branding disasters" from both a PR and IP perspective, distinguishing between the two and offering practical tips for avoiding them.

"With both litigation and re-branding efforts posing substantial costs, it is incumbent upon companies to get brand selection and launch right the first time. My hope is that attendees will take away strategies that will help their clients reach that result," Grossberg says.

Later in the afternoon, Shubhrangshu Sengupta, Patent Agent at US Conec, will provide an overview of patent agents' relations at the USPTO.

Sengupta says the session will present different aspects of getting insights into inventors' thought processes and interaction with USPTO examiners.

"Primarily, the session plans to bring forward panelists' experiences as patent practitioners and examiners to improve the overall invention gathering and patent procurement practice."

He adds: "The questions practitioners pose to inventors, and to examiners, could make or break a patent during prosecution, as well as post-issuance. Issues like subject matter eligibility, indefiniteness, written description requirement and enablement are at the forefront. This session will attempt to provide various views on how to approach these and other issues."

Personnel and secrets drive autonomous car IP strategies

Deciding whether to patent inventions or keep them as trade secrets, and ensuring that increasingly mobile employees do not leak confidential information to competitors or in journals, are key concerns for autonomous car companies, according to a panel at this year's AIPLA Annual Meeting.

Catherine Tornabene, Head of IP at driverless vehicle firm Aurora Innovation, pointed out that companies must keep an eye on the future of mobility when they are considering whether to patent an invention or keep it secret.

While something like a black-boxed machine-learning algorithm that helps run a car might not be detectable now, she said, that does not mean that it will not be within the next decade.

"For me, every time we look at patenting trade secrets, it is a pretty serious decision. What we can tell right now about machine learning is really different than what we could tell 10 years ago.

"You have to be thinking about 10 to 15 years in the future. It is hard to see much further than that but it is something to think about."

Christopher Nalevanko, General Counsel at driverless car start-up Zoox, said that choosing whether to patent something or keep it as a

secret was an important matter for his firm as well, and for many of the same reasons.

Tornabene went on to say that where a company chooses to keep inventions confidential, they must consider the challenges of managing an increasingly mobile workforce. Many of the people who work at driverless car companies are highly educated and skilled in a fast-growing industry, and are therefore seen as a competitive asset in the automotive and tech industries.

"They can move around," she said, "and when you approach your IP strategy, you must consider what happens as someone comes in and out." She added that not only do firms not want their trade secrets to be handed over to a competitor, they do not want to be in a situation where they have unwittingly incorporated secrets from another company into a project.

Nalevanko added that many of these employees are also interested in the academic space and publishing their work in journals. The risk is that staff will publish something and inadvertently disclose a critical piece of technology. As such, businesses should work with employees to enable them to publish in academic journals while reducing the risk of disclosure.

"Driverless cars is a hugely academic area and you need some sort of process to allow employees to engage with academia," he said.



Later in the session, Dechert Partner Diane Siegel Danoff spoke about the lessons that can be learned from the infamous autonomous vehicle trade secret case *Waymo v. Uber* around how to better manage trade secrets.

Businesses looking to protect trade secrets can use e-alerts to detect suspicious activity, she noted, and conduct computer forensic checks after learning of employees' plans to go to a competitor. She advised that companies should not exempt executives from this scrutiny or allow employees to start up competing ventures on the side.

"The people at the top can easily be the ones stealing your stuff," she said. "And the point about not letting employees start up side ventures seems obvious, but it needs to be said."

Danoff added that there are plenty of les-

sons that need to be learned when it comes to companies taking on staff from competitors. They should require written confirmation from said employees that they have not taken any documents from their previous employer or will not use any written or unwritten trade secrets from that business.

"You should also consider limiting the new hire's role and erecting ethical walls to prevent the transference of secrets. That is something that the judge was very concerned with in the *Waymo v. Uber* case."

Nalevanko noted that it is becoming increasingly important for his business to manage its use of open source technologies. While Zoox is keen to contribute its data and tech to open projects, it has to be careful to ensure that its proprietary property is protected.



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COMMITTEE MEETINGS

7:00 AM – 8:45 AM Women in IP Law Committee Breakfast Meeting
Potomac Ballroom C

7:45 AM – 8:45 AM Amicus (Committee Members Only)
Chesapeake G

SPOUSE/GUEST TOUR

9:30 AM – 1:30 PM US Botanic Gardens & National Arboretum
Meet at Concierge Desk at 9:15am for a 9:30am Departure

CONCURRENT MORNING TRACKS

9:00 AM – 12:00 PM Track 1: Part I: Patent Trial and Appeal Board Live Hearing (PTAB)
Maryland Ballroom BD, 4-6

9:00 AM – 10:00 AM Track 2: USPTO Trademark Tips and Best Practices
Cherry Blossom Ballroom

10:00 AM – 10:15 AM Track 2: Networking Break
Cherry Blossom Ballroom

10:15 AM – 12:00 PM Track 2: Managing Your Global IP Portfolio
Cherry Blossom Ballroom

9:00 AM – 10:00 AM Track 3: Know Thy Client: Practical Tips for Strengthening the Outside/Inside Counsel Relationship
Woodrow Wilson BCD

10:00 AM – 10:15 AM Track 3: Networking Break
Woodrow Wilson BCD

10:15 AM – 12:00 PM Track 3: Winning Strategies and Practical Tips for Trade Secrets Litigation and Agreements
Woodrow Wilson BCD

LUNCHTIME EVENTS

12:00 PM – 12:30 PM Lunch Reception (open to all attendees)
Maryland Ballroom AC Lobby & 1-6 Foyer

12:30 PM – 2:00 PM Luncheon: Why You Should File Your Next Patent Case Across the Street from the "HEY SUGAR"
Maryland Ballroom AC, 1-3

1:45 PM – 2:00 PM Annual Association Business Meeting
Maryland Ballroom AC, 1-3

COMMITTEE MEETINGS

2:15 PM – 3:15 PM 2020 Mid-Winter Institute Planning Committee Meeting (Planning Committee Members Only)
Chesapeake A&B

CONCURRENT AFTERNOON TRACK

2:15 PM – 3:45 PM Track 1: Copyright
Maryland Ballroom BD, 4-6

2:15 PM – 3:45 PM Track 2: Ethics
Cherry Blossom Ballroom

2:15 PM -3:45 PM Track 3: Corporate
Woodrow Wilson BCD

COMMITTEE EDUCATIONAL SESSION

3:55 PM – 4:55 PM Patent Agents/ Patent-Relations with USPTO
Woodrow Wilson BCD

COMMITTEE MEETINGS

3:55 PM - 4:55 PM AIPPI-US Meeting
National Harbor 13

3:55 PM - 4:55 PM AIPLA Fellows
Chesapeake A & B

3:55 PM - 4:55 PM Diversity in IP Law
Chesapeake G

3:55 PM - 4:55 PM IP Law Associations
Chesapeake H&I

3:55 PM – 4:55 PM IP Practice in the Far East
Chesapeake J

3:55 PM – 4:55 PM Trade Secret Law
Chesapeake C

3:55 PM - 5:30 PM Copyright Law (Meeting and Reception)
Chesapeake F

3:55 PM - 6:00 PM Patent Litigation/PTAB Trial (Joint Committee Meeting)
Chesapeake K&L

3:55 PM - 6:00 PM Development Task Force (Committee Members Only)
Chesapeake C

5:00 PM - 6:00 PM Membership (Committee Members Only)
Chesapeake G

5:00 PM - 6:00 PM Special Committee on Publications (Committee Members Only)
Chesapeake J

EVENING EVENTS

5:00 PM – 6:00 PM International Networking Reception
National Harbor 12

8:00 PM – 10:00 PM Dinner, Entertainment and Dancing (Black Tie Optional)
Maryland Ballroom AC, 1-3

10:00 PM – 12:00 AM Dessert Reception (Open to All Attendees)
Cherry Blossom Ballroom



We don't just
practice
Mexican Law.
We help shape it.

In an uncertain legal environment, we are one law firm that is not content simply to accept the status quo. We work constantly to influence the evolving body of Mexico's intellectual property laws, with the goal of ultimately bringing them in line with international standards. While we continue to make great strides in this regard, clients from all over the world rely on us to prosecute, manage, and defend their IP portfolios under the laws that exist today. In other words, we work effectively within the system, even as we seek to change it.



PATENTS | TRADEMARKS | COPYRIGHTS | IP LITIGATION, CIVIL AND COMMERCIAL LITIGATION, ALTERNATIVE DISPUTE RESOLUTION
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FRANCHISING | ADMINISTRATIVE LAW | REGULATORY LAW