



2018 TOKYO IP CONFERENCE:
Global Relationships In Flux – How Would You Redraw Your IP Strategy Map?

October 11, 2018 • Tokyo, Japan

Agenda

Time	Topic	Speakers
12:45 pm – 1:15 pm	Registration	
1:15 pm – 1:25 pm	Opening remarks and introduction of speakers	Etsuo Doi
1:25 pm – 2:25 pm	<p>Latest Patent Litigation and IPR Considerations for Japanese Companies and Related Implications</p> <p>The U.S. Supreme Court (SCOTUS), the U.S. Court of Appeals for the Federal Circuit (CAFC), and the USPTO continue to reshape U.S. Patent Law, significantly affecting how companies utilize patents or defend against patent assertions. Recent patent decisions and new regulations require that companies continuously evolve their patent and business strategies. We will cover the practical impact of these decisions, such as:</p> <ul style="list-style-type: none"> ▪ Updates on <i>TC Heartland</i>. It has been almost 1 ½ years since the SCOTUS decision on patent venue. We will address changes in venue trends, lessons learned and further implications for patent litigations strategies. ▪ <i>WesternGeco LLC v. ION Geophysical Corp.</i>, No. 16-1011, 2018 WL 3073503 (2018). We will address the Supreme Court’s ruling that recovering foreign lost profits attributable to domestic acts of infringement under 35 U.S.C. § 271(f)(2) does not violate the presumption against extraterritorial application of U.S. statutes. ▪ <i>Oil States Energy Services, LLC v. Greene’s Energy Group, LLC</i>, 138 S. Ct. 1365 (2018)(4/24/18). <i>Inter partes</i> reviews are constitutional. ▪ <i>Saint Regis Mohawk Tribe, Allergan, Inc. v. Mylan Pharmaceuticals Inc., Teva Pharmaceuticals USA, Inc., AKORN, Inc.</i>, 896 F.3d 1322 (Fed. Cir. 2018). Tribal sovereign immunity cannot be asserted to avoid an IPR. ▪ <i>Aqua Prods. v. Matal</i>, 872 F.3d 1290 (Fed. Cir. 2017). How has motion to amend practice changed since the burden of persuasion was lifted from the Patent Owner? ▪ <i>SAS Institute Inc. v. Iancu</i>, 138 S. Ct. 1348 (2018)(4/24/18). When the USPTO institutes <i>Inter partes</i> review to reconsider an already-issued patent claim, under 35 U.S.C. §§311-319, it must decide the patentability of all of the claims the petitioner has challenged. 	Pavan Agarwal Steve Maebius Liane Peterson Chase Brill



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2:25 pm – 3:00 pm	<p>The US ITC Has Become a Very Successful Venue For Patent Owners, Including NPEs; Now a Venue for Patent Owners to Reconsider</p> <p>While the US ITC has always been available to patent owners who can meet the threshold requirements, in recent years, the US ITC has become increasingly used as a strategic enforcement tool. One reason is that those requirements have undergone some redefinition.</p> <ul style="list-style-type: none"> ▪ Patent owners’ Success Rate has reached 90% ▪ Recent updates to the definition of “domestic-industry requirements” and the other requirements. When to choose the USITC 	Liane Peterson George Beck
3:00 pm – 3:20 pm	Break	
3:20 pm – 4:15 pm	<p>Artificial Intelligence: The Next Technology Wave and Patent Strategies To Not to be Left Behind</p> <p>We have heard about AI for many years. Stephen Hawking predicted that AI would destroy mankind. In the meantime, AI is here, so how can we patent it?</p> <ul style="list-style-type: none"> ▪ What is “artificial intelligence” and why is it important to your industry (and all industries)? ▪ How can AI be protected by patents? ▪ How will the USPTO and other patent offices consider applications with claims incorporating AI? ▪ What patent strategies should your company consider for AI? 	Pavan Agarwal Steve Maebius Kristel Schorr
4:15 pm – 4:45 pm	<p>Update on Patent Eligibility, Section 101 after <i>Alice</i></p> <p>Patent eligibility of software inventions, computer-centered inventions, business method inventions, and even testing methods has a constant source of confusion since the seminal decision of <i>Alice Corp. Pty. Ltd. v. CLS Bank Int’l</i>, 573 U.S. __ (2014). This presentation will try to work through some of that confusion.</p> <ul style="list-style-type: none"> ▪ What do the most recent USPTO Guidelines teach? How do they differ from the earlier Guidelines? ▪ What do legal decisions teach us about what makes subject matter eligible versus not eligible? ▪ Strategies for increasing patenting chances. 	George Beck Benny Berkowitz
4:45 pm – 5:00 pm	Move to breakout sessions	



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5:00 pm – 6:00 pm	<p><i>Pharma & Biotech Breakout:</i></p> <p>Advanced Strategy for Protecting Personalized Medicine Inventions Based on The USPTO’s 2018 <i>Vanda</i> Guidance, FDA Labeling Requirements & New Joint Infringement Precedent</p> <ul style="list-style-type: none"> ▪ How the Federal Circuit distinguished the Supreme Court’s <i>Mayo v. Prometheus</i> decision as to eligibility of a personalized medicine claim ▪ Impact of the USPTO’s <i>Vanda v. Westward</i> guidance memo dated June 17, 2018 ▪ How infringement was found despite separate actors performing the diagnostic and treatment steps ▪ Lessons for U.S. prosecution strategy of personalized medicine inventions ▪ Prospects for protecting and enforcing personalized medicine patents in the U.S. <p>Updates on the CRISPR Patent Interference</p>	Kristel Schorr Steven Maebius Benny Berkowitz
5:00 pm -6:00 pm	<p><i>Electronics Breakout:</i></p> <p>Strategic Considerations and Practical Tips for Patent Portfolio Development Affecting Software, Information Technology, IoT, Embedded Systems and Telecom industries:</p> <p>The breakout session will provide an overview of strategic developments affecting these industries and discuss practice tips based on recent case law and USPTO examination guidelines to reduce costs during prosecution and minimize the risk of validity challenges.</p>	Pavan Agarwal George Beck
6:00 pm – 6:05 pm	Closing remarks	Etsuo Doi
6:05 pm – 7:45 pm	Reception	