

NAPP AMC 2017 PROGRAM



From the President's Desk



Dear Participants:

Greetings and welcome to San Jose!

We appreciate all your hard work in preparing for this meeting, look forward to productive meetings with leading practitioners from near and far and welcome to our 2017 Annual Meeting. Participants will take part in three days of education, networking, and social events. A special thank you to our meeting venue host the USPTO Silicon Valley, Regional Director, John Cabeca and the entire USPTO Silicon Valley team.

Enclosed are the following:

- Meeting details for each day
- Agenda
- Speaker and Presentation Topic Overview
- Sponsors and Exhibitor information
- And social events

Please review our agenda daily, including information of each daily schedule. We will gather each morning at the USPTO Silicon Valley office. You will be required to check in with USPTO and also be provided NAPP name badge at the NAPP Registration desk, which we ask that you wear to all of our meetings. Have fun and let us know if you have questions or suggestions.

Best regards,
Jeff Wendt

Thank you to our sponsors

Welcome Reception



Social Event



Networking Meal



Anaqua

Networking Break



Murgitroyd RWS inovia

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NAPP Sponsor Information

[Anaqua, Inc. www.anaqua.com](http://www.anaqua.com)

IP Management system, from capturing ideas, identifying potential partners, application submission and prosecution. Services identify potential infringement; objective process to decide to renew or abandon; find IP to acquire.

[Cloutier Ortega www.cotechlaw.com](http://www.cotechlaw.com)

Cloutier Ortega is a full service technology law firm which provides legal collaboration for start-ups, emerging companies, and closely held corporation.

[Dominion Insurance Services www.dominioninsurance.com](http://www.dominioninsurance.com)

Insurance Broker serving NAPP member's coverage needs since 1997.

[Herbert L. Jamison & Co., L.L.C. www.jamisongroup.com](http://www.jamisongroup.com)

The Jamison Insurance Group is a leading insurance and risk management resource for intellectual property lawyers. We offer innovative professional liability insurance, business & personal insurance, customized risk management programs, employee benefit programs and retirement planning.

[Lincoln Law School of San Jose www.lincolnlawsj.edu](http://www.lincolnlawsj.edu)

The Intellectual Property Clinic at Lincoln Law School of San Jose is a pro-bono clinic providing patent and trademark services. The USPTO-approved clinic trains students who in turn provide the services for free to the community. This hands on approach allows students to gain real clinic experience prior to graduating. Mentors to the students are practicing patent agents/attorneys or trademark attorneys.

[Murgitroyd www.murgitroyd.com](http://www.murgitroyd.com)

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NAPP Sponsor Information

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Prepare Design and Utility drawings.

RWS inovia inovia.com

RWS inovia is the world's leading expert in foreign patent filing, IP translation and search services.

TurboPatent www.turbopatent.com

TurboPatent is bringing the patent process into the 21st century by augmenting human-centered patenting practices with a state-of-the-art, technology-centered approach. The TurboPatent Machine was designed from the ground-up by a team of patent professionals, entrepreneurs, and developers dedicated to inventing a new way. The TurboPatent technology incorporates patent-specific Natural Language Processing, Machine Learning, and Big Data analytics to create the best quality assurance and control solution in the patent industry. TurboPatent has more than 10 years of experience in streamlining and automating the patent process.

Wilson Dutra, PLLC wilsondutra.com

Wilson Dutra is a fun first virtual law firm based out of Jacksonville, FL, with two attorneys who are passionate about collaborating with inventors and empowering innovators. They are a transactional firm that focuses completely on innovation, working with clients on their patent and trademark protection strategies. More specifically, they work with entrepreneurs and startups who want to be the next and catalytic tech companies who want to stay on the cutting edge of a restless industry.



JULY 27-29, 2017
USPTO SV SAN JOSE

2017 Candidate for Director



Richard Baker

NAPP Member since: Nov 02, 2015

Total Years in Practice: 16

Practitioner Type: Agent

Describe your previous involvement with NAPP (examples:

Committee work, volunteer work, involvement : My participation on the NAPP board would be likened to that of an outside director. I am new to the NAPP, joining two years ago. However, I have extensive board experience and many new ideas to bring to the organization.

Why you would like to serve as a NAPP Director (what are your personal objectives?): I have a strong desire to serve the communities in which I reside. The patent community is an area that has provided me with much over the past 20 years as an inventor, a patent agent, and a licensing executive. I hope to give back to this community through the NAPP by providing a broad insight of the industry based on my work for large companies and individual inventors in a number of distinct fields. I just finished serving 6 years (maximum term) on the Licensing Executives Society (USA&Canada) Board of Trustees, and I am looking for other opportunities to serve the patent community.

What you would like to accomplish as a NAPP Director (what are your objectives for the organization : As an NAPP Director, I would like to expand awareness of the organization and to increase membership. With my experience as a small business owner and a politician, I have extensive experience with building brands and selling organizations as is needed to grow the NAPP. In addition, I would like to increase the influence of the NAPP in Washington, finding opportunities to testify to Congress about the importance of the US patent system and to write Amicus briefs on cases of specific interest to the NAPP.

Do you think that you would bring a unique or useful perspective to the board (for example, cultural: I have a very unique background that includes 20 years of involvement with patents as an inventor, a patent owner, a patent agent, a licensing executive, a patent broker, and an expert witness. In addition, I have the experience of running several major political campaigns as a candidate for the US House of Representatives and for the Massachusetts Governor's Council. I have a deep Rolodex of contacts in the political and in the patent arenas. Furthermore, I have board experience with the Licensing Executives Society, the Pentucket Regional School Board, and the West Newbury Board of Assessors. I have written extensively and have regularly presented on subjects related to patents.

2017 Candidate for Director



William Campbell

NAPP Member since: Feb 08, 2016

Total Years in Practice: 2

Practitioner Type: Patent Attorney

Describe your previous involvement with NAPP (examples: Committee work, volunteer work, involvement): Involved with blog and message board.

Why you would like to serve as a NAPP Director (what are your personal objectives?): I am interested in further developing my technical skills as they relate to patent preparation and prosecution. I am also interested in getting involved in projects that may implicate issues related to post grant proceedings before the USPTO.

What you would like to accomplish as a NAPP Director (what are your objectives for the organization): I would like to work to extend the NAPP's reach by expanding the amicus program. I would also like to assist in developing and providing more guidance on new legislative efforts.

Do you think that you would bring a unique or useful perspective to the board (for example, cultural): I am a businessman with a technical background, who has experience managing (among other things) product development efforts, and now I am a patent attorney. The bulk of my professional experience involves the management of commercial ventures. For 30+ years, I have been more a user of legal services than I have been a provider of legal services. I estimate that this unique perspective might be valuable to the NAPP board and the NAPP membership.



JULY 27-29, 2017

USPTO SV SAN JOSE

2017 Candidate for Director



Priya Cloutier

NAPP Member since: Feb 19, 2008

Total Years in Practice: 20

Practitioner Type: Patent Attorney

Describe your previous involvement with NAPP (examples: Committee work, volunteer work, involvement) : I chaired the Governmental Affairs

Committee for several years and have been a speaker at the Annual conference since 2011. I am an active member of the listserv.

Why you would like to serve as a NAPP Director (what are your personal objectives?): NAPP is the one organization that I call home. I have made life-long friends, have learned many lessons, and grown as an attorney. My personal objective would be to grow the number of members that NAPP has by leveraging my exceptional group of colleagues and the general feeling of home I have in this organization.

What you would like to accomplish as a NAPP Director (what are your objectives for the organization) : I would like to be involved in providing quick learning guides (strategy to overcome 101 rejections, for example) and quarterly CLEs or as needed CLEs to the members.

Do you think that you would bring a unique or useful perspective to the board (for example, cultural): Cloutier Ortega is a full services technology law firm. My experience, over the last twenty years, has been with clients of all sizes. I've done everything from litigation, to patent prosecution, to merger & acquisition work. This broad experience has helped me grow my own practice from a one-person firm in 2015 to a multiple office and discipline firm in 2017. I believe this experience will help me grow the NAPP membership as well by marketing to potential members or markets that NAPP has not considered. As an aside, I am a woman and a person of color. I believe this allows me to provide a perspective that may help in pipeline requirement of a diverse NAPP membership.

2017 Candidate for Director



George Chen

NAPP Member since: Oct 13, 2016

Total Years in Practice: 17

Practitioner Type: Agent

Describe your previous involvement with NAPP (examples:

Committee work, volunteer work, involvement : I have previously served on the Government Affairs Committee and the

Annual Meeting Committee. I have also been a candidate for vice-president and director.

Why you would like to serve as a NAPP Director (what are your personal

objectives?): I would like to mentor fellow practitioners and share best practices. I would like to increase visibility of patents with elected officials in government, especially in Congress.

What you would like to accomplish as a NAPP Director (what are your ob-

jectives for the organization : I would like to expand membership, advocate for further reform in the patent system, and share expertise with other members. We should recruit more foreign associates, particularly in China and EPO. Face-to-face meetings ought to be encouraged, especially locally. Outreach to potential inventors in the community may be offered, such as through public libraries, community centers, and high schools. Workshops and classes for CLE would help raise visibility of NAAP. NAPP can try to work more with AIPLA. We can also assist people who want to take the Patent Bar exam.

Do you think that you would bring a unique or useful perspective to the board (for example, cultural:

My background is both broad and deep. The roles in engineering included quality, characterization, design, development, and manufacturing : 14 years at IBM, 1 year at Ultratech, and 13 years at Intel. My patent experience includes 7 years in-house (very large corporate legal department), 3 years at a major IP boutique law firm, 7 years solo contract/consulting, and 1 year as the only in-house patent practitioner (small memory design company). I am a co-inventor in about 24 patent applications. I work with foreign associates in China and EPO. Foreign language skills include Chinese, some French, and some Spanish. I have served as vice-president of marketing and communications for an alumni association, vice-president of infrastructure for a different alumni association, and board director and secretary for yet another alumni association. I have been a judge and team leader (for science and engineering projects by 12th grade high school students) for the Synopsys Science Fair. It is important to encourage study of STEM, especially by women and under-represented minority students. I interview applicants to Yale College and the College of Engineering at the University of Michigan. I have volunteered to maintain trails in county parks for the Trail Center, to serve in kitchen of Sacred Heart Community Service, and to participate in the annual day of service for Immigration Station at Angel Island. I have also volunteered for summer regional and national DCI competition of Santa Clara Vanguard Cadets.

2017 Candidate for Director



Dan Krueger

NAPP Member since: Aug 07, 2014

Total Years in Practice: 21

Practitioner Type: Patent Attorney

Describe your previous involvement with NAPP (examples: Committee work, volunteer work, involvement :

NAPP member since 2014. Active NAPP forum contributor since 2015. Marketing Committee

Chair since 2016. Shadow-member of Board since 2016. Caselaw review team volunteer starting 2017.

Why you would like to serve as a NAPP Director (what are your personal objectives?):

NAPP is a good organization that fulfills a need in the professional community, but it is not living up to its full potential. I believe I can help NAPP become THE professional organization of choice for patent prosecution folks.

What you would like to accomplish as a NAPP Director (what are your objectives for the organization :

To foster more networking and participation by members. To grow the membership and create better name recognition among patent prosecution professionals.

Do you think that you would bring a unique or useful perspective to the board (for example, cultural:

I would bring: a sense of specificity and accountability for goal setting and achievement; a knowledge of large and small firm needs; experience as both patent agent and patent attorney; and (small scale) experience organizing opportunities for patent prosecution folks to get together to network and share work-related knowledge.



JULY 27-29, 2017

USPTO SV SAN JOSE

2017 Candidate for Director



Louis Hoffman

NAPP Member since: Sep 21, 1998

Total Years in Practice: 33

Practitioner Type: Patent Attorney

Describe your previous involvement with NAPP (examples: Committee work, volunteer work, involvement :

I have been a member of the Board of Directors for many years. I have been Chairman of the

Board since that position was established in 2012. I chaired the Government Affairs Committee for about five years. I chaired the Legal Affairs Committee for about three years. I have served for about four years on the Governance Committee and from time to time as interim chair. I have written several comments to PTO rules and on legislation, and several amicus briefs, for NAPP. I have been a speaker at most NAPP conventions. I have attended nearly all NAPP annual meetings and conventions. I joined NAPP only a few years after it began.

Why you would like to serve as a NAPP Director (what are your personal objectives?): I enjoy contributing to certain organizations in a pro bono capacity. I enjoy the collegiality of NAPP. I think that NAPP can help improve the quality of patent prosecution, including my own work. I believe that we have a chance to make the voices of patent prosecutors heard better via an association structure. I also receive referrals from fellow NAPP members from time to time.

What you would like to accomplish as a NAPP Director (what are your objectives for the organization : I have been frustrated that we have grown NAPP only modestly through the years and think that more growth is achievable, especially through more marketing. I would like to have NAPP remain stable, continue to provide effective services to its members, and even add new services.

Do you think that you would bring a unique or useful perspective to the board (for example, cultural: NAPP was an agent's group for many years, and I bring the perspective of an attorney. Also, my practice includes not only patent-application work but also patent commercialization (sales, licensing, and enforcement) and contested proceedings in the PTO. I am able to see first-hand how patent prosecution impacts patent value later.

Schedule for Thursday, July 27th

8:45 am -5:00 pm - General Sessions

7:30 am-5:30 pm - Registration

8:00 am- 8:45 am - Breakfast, brought to you by 

9:00 am-9:45am

- Introduction, goals of meeting, agenda for 3 Days, speakers today.

Speaker: Lisa Adelson, AMC Chair.

9:05 am - 9:45 am

-20,000 foot overview of current challenges and USPTO plans/programs for response . 30 minutes for discussion, 10 minutes for any questions.

Speaker: John Cabeca.

9:45 am-10:30 am

- Design Challenges: Rejections being made, status of 112 guidelines, 171 functionality Hague. Speaker: Garth Rademaker

10:30 am-10:45 am - Break Brought to you in part by: **Murgitroyd**

10:45 am-12:15 pm

- Panel Examiners. Panel software and biotech issues, 101, 112, etc. What are some helpful tips? What are the thorny issues today? What does the PTO want to see from applicants/practitioners. Speaker: Karen Young, Chau Nguyen,

William Krynski, Jerrah Edwards, Neveen Abel-Jalil

12:15 pm-1:30 pm - Lunch, Beginning at 12:15,

Lunch brought to you in part by: **Anaqua**

1:30 pm-3:00 pm

- Panel of PTAB judges. Both software and biotech issues 101,112, etc. Help ful tips. What are the thorny issues today? What does the PTO want to see from applicants/practitioners. Speaker: Adam Pyonin, J. Charles Boudreau, and Tawen Chang. Moderator: Bill Richards

3:00 pm-3:15 pm - Break Brought to you in part by: **Murgitroyd**

3:15 pm-4:15 pm - Professional Responsibility and Practice Before the USPTO. Speaker: William J. Griffin

4:15 pm-5:00 pm - Pilot Programs available. Speaker: Raul Tamayo (WEBINAR)

6:00 pm-8:00pm - NAPP Welcome Reception at the San Jose Marriott brought to you in part by



Welcome Reception at The San Jose Marriot

Thursday Night Welcome
Reception brought to you
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Following the last presentation on Thursday, please plan to join us in the Almaden room at 6PM for a cocktail reception at the San Jose Marriott, located at 301 S Market St, San Jose, CA 95113

Social Event at The Tech Museum of Innovation

Friday Night Social Event brought to you in part by
the following:



Join us for NAPP at the Tech Museum of
Innovation event. Small bites and beverages will
be served. Event starts at 7PM located in the
Cyber Detectives Gallery at 201 S Market St, San
Jose, CA 95113

Schedule for Friday, July 28th

8:45 am-5:00 pm - General Sessions

7:30 am-5:30 pm - Registration


8:00 am-8:45 am - Breakfast

9:00 am-9:45 am

NAPP Announcements.

9:45 am-10:45 am

Uncertainty in Patent Law (Its not done yet) Speaker: Russ Slifer

10:45 am-11:00 am - Break, Brought to you in part by:  **lincolnlaw**school
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11:15 am-12:15 am

-Design challenges: 171(opposite of 101!) and 112 issues.
Speaker: Karl Hanson.

12:15 pm-1:15 pm -Lunch. Speaker: Marshall Phelps


Lunch brought to you in part by:



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1:15 pm-3:00 pm

Addressing 101 Issues | How to Address / Fix 35 U.S.C. §101 Issues.
Speakers: Dr. Bernard Greenspan and Michael Borella.

3:00 pm-3:15 pm - Break, Brought to you in part by:  **lincolnlaw**school
OF SAN JOSE

3:15 pm-4:15 pm

When things go wrong. Speaker: Mike Jacobs

4:15 pm-5:00 pm

Patent Monetization: Buy, Sell, License, Hold? Speaker: Kent Richardson.

7:00 pm-10:00pm - Event: The Tech Museum of Innovation.

NAPP Social Event brought to you in part by the following:



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Welcome Reception



Social Event



Networking Meal



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Networking Break



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Schedule for Saturday, July 29th.

8:00 am-9:00 am

NAPP Annual Meeting (Members)

8:00 am-9:00 am

Breakfast.

9:00 am-10:30 am

U.S. Case Law Updates

Federal Patent Law Year In Review

Biotech and pharma

Speakers: Priya Cloutier, and Diane Gardner.

10:30 am-10:45 am—Break, brought to you in part by: **RWS inovia**

10:45 am-11:15 am

-United States Case Law updates. Design.

Speaker: Lisa Adelson.

11:15 am-11:45 am

-Patenting for the small company.

Speaker: Jonah Probell.

11:45 am-1:15 pm - Lunch. Running your own business.

Speaker: Bruce Young.

1:15 pm-2:45 pm - Foreign Practice:

Mavis Gallenson - PCT/Int'l | Timing – When Filing Both US And Pct Applications For A Client's Invention

Takashi Fujita - JP Practice | Outline of Opposition and invalidation trial

David Dickerson - EP Practice | EPO equivalents of 35 USC 101 UPC

Kenny Ko - CN Practice | Strategies for Patenting Software-based Inventions in China

2:45 pm-3:00 pm - Break, brought to you in part by: **RWS inovia**

3:00 pm-3:45 pm - Privilege and ethical issues related to patent agents: What agents and attorneys need to know. Speaker: Louis Hoffman

3:45 pm-4:30 pm

Issues and client counseling. -Software -Biotech -TS -TM -Design.

Moderator: Jeff Wendt

Speakers:



Lisa Adelson

Lisa Adelson is a counsel with the Intellectual Property Group in Crowell & Moring LLP's Washington, D.C. office. Lisa is a seasoned patent practitioner with numerous years of experience representing biotechnology, pharmaceutical, and design clients in all aspects of patent prosecution and counseling.

Lisa has extensive experience managing patent portfolios and conducting analyses related to major due diligence and patent litigation matters. Lisa has represented clients before the U.S. Patent and Trademark Office, the Patent Trial and Appeal Board (formerly the Board of Patent Appeals and Interferences), and the U.S. Court of Appeals for the Federal Circuit.

Before joining Crowell & Moring, Lisa spent many years as a patent attorney at a leading AmLaw 100 firm in Washington, D.C. In that role, Lisa assisted in a wide array of biotechnology and pharmaceutical clients with their patent-related needs, including preparation, prosecution, counseling, litigation, due diligence, and related regulatory work. Lisa also has significant experience in the field of design patent law, having practiced alongside one of the pioneers in this field at a Washington-area boutique.

Lisa earned her J.D. from Georgetown University Law School and her B.A., magna cum laude, from Colgate University, where she was a Colgate University Alumni Memorial Scholar, a Dana Scholar, and a lifetime member and president of Phi Eta Sigma Honor Society. She also received the Dean's Award for Academic Excellence. Additionally, Lisa has received the Bausch and Lomb Science Prize, American Chemical Society Award, and Harvard Book Award.

Lisa is a strategic thinker who has represented individual and multinational clients at all phases of development. She is a frequent lecturer on current topics in intellectual property law and has published various articles in the field of patent law.



Speakers:



Michael Borella

Michael S. Borella is a partner with McDonnell Boehnen Hulbert & Berghoff LLP and serves as Chair of the firm's Software & Business Methods Practice Group. Dr. Borella provides legal and technological advice in support of validity, infringement, patentability analyses,

and litigation matters. His expertise includes networking, Internet telephony, wireless communication technologies, telecommunications, cloud computing, routing, TCP/IP, computer graphics and imaging, voice and facial recognition, robotics, and mobile applications.

Dr. Borella has drafted or been involved in the prosecution of hundreds of patents in the U.S., as well as in other jurisdictions. He has experience in numerous phases of patent litigation, including invalidity analysis, discovery, motion practice, and claim construction. His practice also includes patentability, validity, and infringement analyses, as well as client counseling with respect to the procurement of all types of intellectual property rights.

Dr. Borella has written extensively on the patent-eligibility of computer-implemented inventions, and has been a featured presenter for several seminars on the topic as well.

Prior to joining MBHB, Dr. Borella served on the management teams of Fastmobile, UT-Starcom, and 3Com, and was in charge of several large software engineering projects, managing over 75 software engineers on two continents. He also held the position of adjunct professor at Northwestern University, and has lectured on patent law at the Chicago-Kent College of Law. Dr. Borella is a named inventor on more than seventy U.S. patent applications and has authored a similar number of academic and technical papers related to networking, telecommunications, and computer science.



JULY 27-29, 2017
USPTO SV SAN JOSE

Speakers:



Priya Cloutier: Founder of Cloutier Global, Priya, focuses her practice on the procurement and enforcement of domestic and international patents, trademarks and copyrights. Her experience includes various technical areas such as aerospace, hybrid and electrical engines/motors, architecture and construction, medical devices, agriculture, food, and energy systems. Priya devotes much of her time to managing and coordinating global patent portfolios of various clients, both domestic and international companies, including the preparation and prosecution of patent applications before the U.S. Patent and Trademark Office. She also counsels clients in avoiding infringement of patents of others and frequently opines with regard to the infringement and/or validity of individual patents, or advises as to a strategy for avoiding the patent portfolios of others. Priya has been a Washington Super Lawyer, in the field of Intellectual Property, since 2013.



David Dickerson

David Dickerson has over 20 years' experience in the realm of international patent prosecution. His track history includes the prosecution of many hundreds of applications before the European Patent Office, including its Opposition Divisions and Boards of Appeal. Before founding his own firm in 2010, David worked hand-in-hand with several of Germany's most respected patent attorneys as well as in-house. Born and raised in the United States, David earned his graduate degree in Electrical Engineering at the University of Hannover, Germany. He thus has particular expertise in the electrical, computer and mechanical arts. David is registered to practice before the European Patent Office, the German Patent and Trademark Office, the USPTO and the European Union Intellectual Property Office (EUIPO), formerly known as the OHIM. He is equally fluent in English and German.

Speakers:



Takashi Fujita

Mr. Fujita holds a Bachelors of Science in Biology and Biophysics, as well as a Masters of Biophysics from Kyoto University. In 1985 he began working in the Japan Patent office as an examiner; overseeing the Food Processing and Biology division, and Examination Standards Office. From 1994-1997 Mr. Fujita was a Consulate General of Japan in Munich, Germany. In 2001 Mr. Fujita became the vice president of Hiraki and Associates, a Patent Law Firm. He was also sent to Washington, D.C. in the United States as a visiting scholar to study US patent practice, and later was dispatched to Munich, where his tasks included acting as a liaison between the JPO and the EPO.



Mavis Gallenson

Mavis Gallenson is a Partner of Ladas & Parry and the Managing Partner of the firms Los Angeles office. She is a member of the California State Bar and a registered U.S. patent attorney.

Mavis has practiced patent and trademark law both in the U.S. and Germany. She received her B.S. and J.D. degrees from the University of Utah and studied electrical engineering at the University of California, Los Angeles and University of California, San Diego.

She has over twenty five years of practice in the field of intellectual property law and is experienced in the prosecution of patents and trademarks around the world. She has lectured on various aspects of intellectual property law in both the U.S. and abroad, is a past lecturer on PCT practice through Silicon Valley Seminars, the author of the book □The PCT and The PCT Practice□ and is past Chair of the Intellectual Property Section of the State Bar of California Executive Committee. Mavis is also past Chair of and liaison to the California State Bar Patent Standing Committee and past member of the California State Bar Council of Sections.

Speakers:



Diane Gardner

Diane's legal career spans twenty-seven years - beginning first as a patent examiner, and then moving to roles in-house and in private practice. Diane founded Mastermind IP Law in 2004, which practice includes work in the areas of patent, trademark, copyright, and design. Diane is a long-standing member of NAPP and a former Vice President of the organization.



Bernard J Greenspan, Ph.D.

Bernie is an independent consultant in intellectual property. He has over 30 years experience in life sciences and drug delivery research, and in developing IP strategies and lifecycle plans for pharmaceutical products, diagnostic tests, and medical devices.

From 2010 to 2017, he was the Senior Director of Intellectual Property at Prometheus Laboratories Inc., a diagnostics and therapeutics company in San Diego, CA, and a subsidiary of Nestlé Health Sciences.

Prior to joining Prometheus, Bernie held positions as Director of IP Strategy Management for Pfizer La Jolla Laboratories, Senior Director of Intellectual Property at Verus Pharmaceuticals, and as an independent IP consultant to life science and medical device companies.

Before moving into IP, he was actively engaged in aerosol science and respiratory drug delivery research. His research positions have included Director of Aerosol Research at Dura Pharmaceuticals and Elan Pharmaceuticals, and Staff Scientist at Battelle Pacific Northwest National Laboratory.

He received his BA in physics from Clark University and his MS and Ph.D. in biophysics from the University of Rochester School of Medicine and Dentistry. Bernie is an inventor on 11 issued US patents and is registered to practice at the USPTO as a patent agent.

Speakers:



Karl Hanson

I am Senior Intellectual Property Counsel, 3M Company. For 15 of my 27 years at 3M, I had been Division Counsel for the second largest division at 3M, the Personal Safety Products Division. Before that I worked at IP firm of Keil & Weinkauff in Washington, D.C. I am the author of "Intellectual Property Strategies for Protecting the Looks of New Products", published December 1999 in the Journal of the Patent & Trademark Office Society and have spoken on a number of occasions on design patent law and its developments. I have written and issued over a 100 design patents in my near 30 years of practice. And am one of only three lawyers who have been awarded two Carpenter Circle awards for patent issuance by the 3M Company.



Louis Hoffman

Louis Hoffman is the president and founder of the Hoffman Patent Firm and a partner and founder of IP Protection Law Group. He is Chairman of the Board of NAPP. Louis has been an intellectual-property lawyer for more than 30 years. Louis's law practice focuses on commercialization through sales, licensing and enforcement of valuable patents, patent portfolio development, and patent prosecution. His clients include inventors, operating companies, and start-ups. He has a particular knack at identifying and securing patent claims that can provide added value to patent portfolios. Louis has substantial experience managing litigation and licensing programs of all sizes. Aside from patent matters, Louis sometimes works on copyrights and trademarks (U.S. and foreign), license drafting, and contract matters. Louis is a patent attorney licensed to practice law in California and Arizona, before numerous U.S. District Courts, before the Federal Circuit and Ninth Circuit Courts of Appeals, before the United States Supreme Court, and in the U.S. Patent & Trademark Office. Louis is a graduate of Princeton University and Harvard Law School, both with honors, and an alum of a nationally known IP firm in Phoenix, Arizona called Brown & Bain. Louis was born and raised in Wilmington, Delaware. Louis has been active over the years in pro-invention activities, has consulted with members of Congress on patent legislation. He is an inventor on four U.S. Patents. Louis is also a former member and chair of the State of Arizona's Citizens Clean Election Commission and authored Arizona's Clean Elections Act, passed by voter initiative in 1998.

Speakers:



Michael H. Jacobs

Michael H. Jacobs is a partner in the Intellectual Property Group in the firm's Washington, D.C. office and currently serves as the Group's vice-chair. He focuses on patent, trademark, trade secret, and copyright infringement litigation, post-grant patent proceedings, intellectual property portfolio management, patent procurement, counseling, and licensing.

Mr. Jacobs has litigated patent disputes before district courts throughout the United States, the U.S. Patent and Trademark Office's Patent Trial and Appeal Board (formerly the Board of Patent Appeals and Interferences), the U.S. International Trade Commission, and the U.S. Court of Appeals for the Federal Circuit. Mr. Jacobs has extensive experience with post-issuance proceedings at the USPTO, managing all aspects of these cases from the pre-declaration stage through final judgment and appeal.

Mr. Jacobs' counseling work has involved assisting both large and small clients with the creation and implementation of intellectual property protection and procurement programs, as well as in evaluating infringement and validity issues for patentees and third parties. He has also worked with clients to develop creative solutions to managing intellectual property assets, including the development of portfolio-valuation tools.

Based on his professional and academic experiences, Mr. Jacobs has a broad and deep technical background. As an attorney, he has worked on matters involving digital and analog circuits and systems, Internet and other computer-software applications, video-display devices, wireless communications, polymers, catalytic chemistry, tissue grafts, fibroblast mitogenesis, aptamers, and various mechanical systems. Prior to attending law school, he worked as an engineer on technologies including sonar signal processing, biomedical signal processing and instrumentation, and computer-assisted tomography. Mr. Jacobs' research work included mathematical modeling of evoked potentials, analog circuit design, and image processing.



Kenny Ko

Kenny Ko, Esq. Patent Attorney (SIPO) Attorney at Law (New York)
Managing Partner KENNYs IP Adjunct Professor University of
International Business and Economics

Speakers:



Marshall Phelps

Marshall Phelps possesses a unique blend of policy and business acumen. As head of IBM's Technology Policy Office in Washington, D.C. during the 1980s, he helped found the Council on Competitiveness, a non-partisan leadership organization composed of high-tech CEOs that was instrumental in restoring US competitiveness in the face of growing foreign competition, and in strengthening the US patent system. Then a decade later, as Corporate Vice President of Intellectual Property at IBM, Mr. Phelps grew patent revenues from less than \$21 million to an astonishing \$2 billion annually within five years. Ten years after that, he went on to achieve the same outstanding success at global technology powerhouse Microsoft, after being personally recruited by Bill Gates. Mr. Phelps has thus led the two largest private sector intellectual property organizations in the world, managing departments that employed thousands of people. Mr. Phelps' influence extends beyond his policy initiatives or his bottom-line results. As a preeminent thought leader on US intellectual property challenges, Mr. Phelps is widely considered to be the father of modern intellectual property strategy, and was the very first inductee into the Intellectual Property Hall of Fame in 2006. He is an influential advisor to Washington policy makers on patent reform matters, has testified numerous times before Congress, and has excellent relationships with the national media. He also serves on the National Academy of Sciences Intellectual Property Committee. Mr. Phelps is a consummate deal-maker, having negotiated agreements with many of the most important companies and governments in the world. A highly sought-after advisor and consultant on intellectual property and innovation challenges, Mr. Phelps has advised some of the world's largest companies, including General Electric, United Technologies, SAP, Samsung, and Boeing. He sits on several corporate boards, and is an Executive in Residence at Duke's Fuqua School of Business as well as Distinguished Practitioner in Residence at Cornell Law School. The acclaimed author of *Burning the Ships: Intellectual Property and the Transformation of Microsoft*, Mr. Phelps also writes a monthly column on intellectual property and innovation issues for *Forbes* magazine. He holds a Bachelor of Arts from Muskingum College, a Master of Science degree from Stanford's Graduate School of Business, a doctorate from Cornell Law School.



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Kent Richardson: Kent Richardson counsels clients on a variety of patent and business matters including patent buying, selling, licensing, valuation, prosecution and operations. Kent has licensing and marketing patent portfolio experiences resulting in more than \$600M of patent license bookings. Kent has served as an expert witness on patent monetization and licensing practices in cases in England and the United States. Prior to founding the ROL Group, Kent was the General Manager of ThinkFire Services USA, Ltd's Silicon Valley office. Kent has worked in various senior management roles with such growth businesses as Sezmi, Constellation Capital, Rambus, Numerical Technologies. Kent is a member of the California Bar and a United States Patent and Trademark Office registered patent attorney, and holds five US patents.



Bruce Young

Bruce Young is currently an independent patent agent in solo practice serving the intellectual property needs of a variety of clients. He has a broad engineering background with 30 years of experience in both Fortune 100 and small companies, including Jabil, Gateway, Intel, Lucasfilm/Pixar, HP, and several start-ups. Mr. Young has been involved in nearly every aspect of electronic product design and manufacturing at some point in his career including the development of several industry-standard specifications such as PCI, the backbone of modern PC architecture and has been named as an inventor on 40 issued US Patents. Mr. Young holds a Bachelor of Science degree in Computer Engineering from Iowa State University, and a Master of Science degree in Electrical Engineering from Stanford University. He currently lives in Le Mars, IA with Debra, his wife of over 35 years where they enjoy keeping up with their four grown children, 2 dogs, and 2 cats.



Russell Slifer

Russell Slifer is experienced in leading, managing, and developing professional teams in law firms, corporations and the federal government. He served President Obama as the *Deputy Under Secretary of Commerce for Intellectual Property* and *Deputy Director of the United States Patent and Trademark Office* and as the first Director of the Rocky Mountain United States Patent and Trademark Office. Russ was a long time member of the board of directors of Intellectual

Property Owners Association and past-president of the Association of Corporate Patent Counsel. Prior to his government service, he was Chief Patent Counsel for Micron Technology where he developed and implemented patent and world-wide IP strategies. He was a Principal at Schwegman, Lundberg & Woessner, PA focusing on IPR practice, expert testimony and complex patent portfolio development in electrical, mechanical, software and integrated circuit related inventions. Russ has a J.D. from Northern Illinois University and a B.S.E.E from Iowa State University.

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