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**2024 NAPP
ANNUAL MEETING & CONFERENCE**
UNIVERSITY OF MINNESOTA LAW SCHOOL
MINNEAPOLIS, MINNESOTA
JULY 17-19, 2024

ANNUAL CONFERENCE PROGRAM





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MESSAGE FROM THE PRESIDENT



Welcome to the 2024 NAPP Annual Meeting and Conference. We are thrilled that you have come to join us on the beautiful campus of the University of Minnesota Law School for three days of networking, learning, and sharing the art of patent practice. We are very thankful to the University for sharing their facilities with us, and to Professor Chris Turoski for coordinating this meeting with the Law School.

I also want to thank the NAPP Annual Meeting Committee, headed by Kirby Drake, for inviting a stellar cast of speakers and instructors. They have created an outstanding program and brought a growing group of sponsors and exhibitors to Minneapolis. You will find their tools and offerings helpful to your practice.

NAPP is growing, and we are happy to have you here to grow with us. The NAPP AMC program is designed to move each of us to a new level in our craft. This year's NAPP AMC program features The Nuts-and-Bolts of Patent Drafting and Prosecution program, designed to help new patent practitioners improve their game. NAPP also has a very strong mentorship program, to help you grow through one-on-one learning. The NAPP Forum continues to act as “your neighbor down the hall” answering questions and providing tips for addressing issues with your patent practice.

As our exhibitors have grown, so has our list of vendors providing discounts for patent practice tools. See “Discounts” under the “Benefits” section of the NAPP webpage.

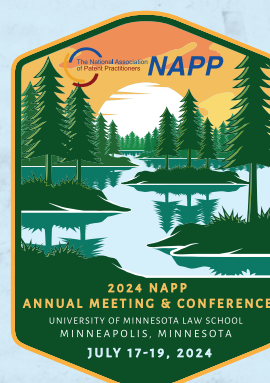
NAPP is also improving our profession through our advocacy program, filing Amicus Briefs, and advocating for our profession in Congress and in the USPTO. We are growing our relationships with key members of the Senate Judiciary Committee and the USPTO Management team.

Please stop by and say hi to me and the NAPP Board members during your time in Minneapolis. We want to be part of your network as it grows through your NAPP membership.

Enjoy the meeting!!

A handwritten signature in blue ink, appearing to read 'R. Baker'.

Rich Baker



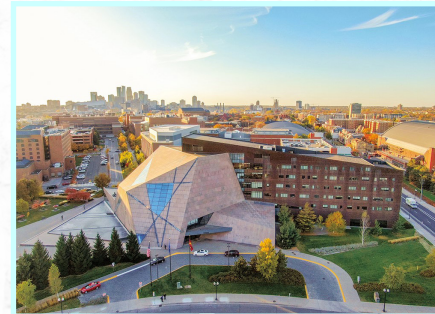
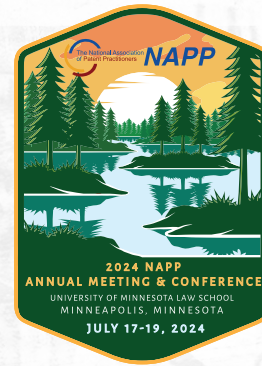
CONFERENCE EVENTS

Social Activities

Opening Reception

July 17th, 6:30 PM - 8:30 PM - McNamara Alumni Center

All attendees are invited to the Welcome Reception following Day 1 of the AMC (July 17) from 6:30-8:30 pm at the McNamara Alumni Center on the University of Minnesota Campus. Round-trip transportation is included after the Welcome Reception to and from the McNamara Alumni Center. There will be live music from the Crazy Larry Band as well as food and drink.



Affinity Dinner

All attendees are encouraged to attend the affinity dinners after Day 2 of the AMC (July 18). Dinner is included as part of attendee registration. This year, NAPP will have multiple affinity tables at the same restaurant (Crooked Pint Ale House), which will allow attendees to engage with attendees that join their respective affinity table as well as attendees at other tables. Crooked Pint Ale House is a modern urban pub offering food and drink options for every taste, including the best Lucys (two burger patties with a slice of cheese in the middle – a Minnesota classic) in town.



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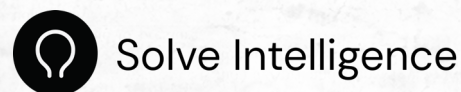
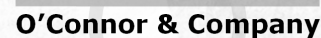
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SCHEDULE AT A GLANCE

15.5 hours of CLE, including
3.5 hours of ethics credit!

*Schedule is subject to change.

Wednesday, July 17th

START TIME	END TIME	SUBJECT(S)
7:00 AM	5:00 PM	Registration
8:00 AM	12:00 PM	Nuts & Bolts Session - What you need to know about patent prosecution (but no one taught you) Priya Sinha Cloutier, David Grossman, David Ladner, David Boundy **
8:00 AM	12:00 PM	Exhibitor Set Up
12:30 PM	1:00 PM	White Space Patenting Chris Frank
1:05 PM	1:35 PM	Getting AI Patents Allowed Mike Carey
1:40 PM	2:10 PM	Patent Licensing/Transactions Jorge Contreras
2:15 PM	2:45 PM	FTO and Patent Opinion Best Practices Meredith Struby
2:45 PM	3:00 PM	Break
3:00 PM	4:00 PM	Federal Circuit Patent Law: A Year in Review Gale "Pete" Peterson
4:05 PM	4:35 PM	Analytical & Repeatable Patent Drafting Techniques for New & Seasoned Practitioners Alike - Tom Bassolino
4:40 PM	5:10 PM	Obvious Guidance: Growth in Articulated Reasoning Mike Locklar
5:15 PM	5:45 PM	Enforcement via Amazon, Ebay, etc. Alternative Dispute Resolution Programs Aaron Williams
6:30 PM	9:00 PM	Welcome Reception at McNamara Alumni Center

Thursday, July 18th

START TIME	END TIME	SUBJECT(S)
7:00 AM	5:00 PM	Registration
7:30 AM	8:30 AM	USPTO Roundtable
8:30 AM	9:30 AM	OED Ethics Will Covey
9:35 AM	10:05 AM	Design Patent Practice Margaret Polson
10:05 AM	10:20 AM	Break
10:20 AM	10:50 AM	Increasing Quality & Diversity in Patent Practice Braxton Davis

SCHEDULE AT A GLANCE



Thursday, July 18th

*Schedule is subject to change.

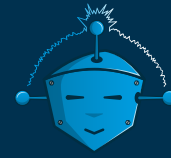
* An additional 4 hours of CLE credit is available with the Nuts & Bolts program.

START TIME	END TIME	SUBJECT(S)
10:55 AM	11:55 AM	Fireside Chat Emil Ali, Dan Smith, Will Covey
11:55 AM	12:00 PM	Welcome Message from UMN Law School Associate Dean Tom Cotter
12:00 PM	12:30 PM	USPTO AI Initiatives Charles Kim
12:30 PM	1:40 PM	Annual Meeting & Lunch
1:45 PM	2:30 PM	Advanced Patent Prosecution Strategies Kip Werking
2:35 PM	2:55 PM	Continuation Practice: Takeaways and Tips Paul Parins
3:00 PM	3:30 PM	Inequitable Conduct/Taking Over Prior Case(s) Emil Ali
3:30 PM	3:50 PM	Break
3:55 PM	4:40 PM	What Keeps In-House Patent Counsel Up at Night Katie Scholz, Katrina Witschen
4:45 PM	5:15 PM	Unitary Patents, the UPC and EPO oppositions Jeremy Smith
5:20 PM	5:50 PM	Preparing Your Patent for Litigation Gary Sorden
6:00 PM	9:00 PM	Affinity Group Dinners at Crooked Pint Brewery

Friday, July 19th

START TIME	END TIME	SUBJECT(S)
8:00 AM	12:00 PM	Registration
7:30 AM	8:30 AM	Breakfast
8:30 AM	9:30 AM	Re-Issue Practice - Bruce Young
9:35 AM	10:05 AM	Including Canada in Foreign Filing Strategy? Practice Between Canada & US - Melanie Schultz
10:05 AM	10:20 AM	Break
10:25 AM	10:55 AM	Career Patent Agent – The Law Firm Perspective - Angela Parsons
11:00 AM	11:30 AM	Avoiding/Escaping the Double Patenting Trap - Dan Krueger
11:35 AM	12:05 PM	Conducting Persuasive Examiner Interviews - Josh Snider

**Nuts & Bolts is an add-on program. Sign up when registering for the annual meeting.



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– NAPP board member Dan Krueger

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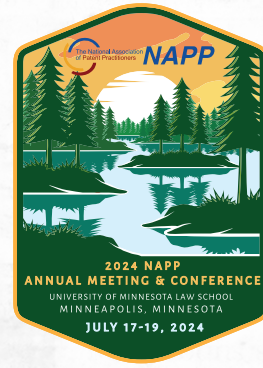
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www.minneapolis.org/summer-dont-miss-list/

Recommendations:

- Take a “loop around the lake”, noting locals “prefer the lakes”.
- Key stops: Highpoint Center for Printmaking, Owamni, Open Book and Marty’s Deli.
- Attractions: Berlin, Mixed Blood, Lake of the Isles, Bde Make Ska, Bryant Lake Bowl and the Walker Art Center.
- Restaurants and Bars: Spoon and Stable, Meteor, Laune Bread, Indeed Brewing Company, Pyres Brewing Company, Kim’s, and Bronto Bar.



CONFERENCE SPEAKERS



Emil J. Ali

Emil J. Ali is a partner at McCabe & Ali, LLP where he focuses his practice on helping lawyers understand their obligations under state and federal law. As a registered patent attorney, a significant focus of his practice involves advising lawyers and law firms on all aspects of the intersection of IP and ethics matters. Emil's work includes counseling clients on lateral transitions, malpractice avoidance, expert opinion and testimony, and respondent's defense work before various bars and courts. You can view his musings on IP ethics issues at www.ipethicslaw.com.



Tom Bassolino

Tom Bassolino is a U.S. patent attorney and the founder of Bass Patent Law, LLC based in Frederick, MD. Tom's practice includes patent preparation, prosecution, and related services for startups, Fortune 500 companies, and everything in-between, mostly in the mechanical and electrical arts. Before founding Bass Patent Law, Tom worked in the New York City office of a large general practice firm (aka "biglaw") and a boutique patent prosecution firm thereafter. Prior to practicing patent law, Tom was a mechanical engineer in New York City where he designed advanced plumbing and fire protection systems for high-rise buildings. Tom has been a member of NAPP for over 10 years, previously serving on the Board of Directors (2019–2022) and Conference Planning Committee (2018–2022). Tom is the proud father of two small children, and a devoted husband to an amazing middle school math teacher. For more information on Tom, his firm, and his practice, please visit www.basspatent.com.



Mike Carey

Mr. Carey is a Member of F. Chau & Associates, and has been a part of the NAAP since 2017. Mr. Carey prepares and prosecutes patents with an emphasis on artificial intelligence. Mr. Carey also develops technology and processes to increase the efficiency of patent preparation and prosecution. Prior to becoming a patent attorney, Mr. Carey was an officer in the Air Force, attaining the rank of Major. He flew a C-130 in multiple combat deployments, and also served as a Judge Advocate in the Air Force Reserve.



Priya Cloutier

Priya Cloutier established leader in building strategies to support meaningful outcomes for technology companies. Deep experience in all aspects of intellectual property protection, strategy and law; and its intersection with product development and product commercialization.

She spent 26 years representing start-ups and closely held corporations. She currently leads the IP Group of UC San Diego, one of the largest IP portfolios in the UC system.

Priya has advanced degrees in both Nuclear Engineering and mathematics. Priya is an endurance athlete and mountaineer.

CONFERENCE SPEAKERS



Jorge L. Contreras

Jorge L. Contreras is the James T. Jensen Endowed Professor for Transactional Law and Director of the Program on Intellectual Property and Technology Law at the University of Utah S.J. Quinney College of Law, and has recently served as a visiting fellow to the London School of Economics and Political Science (2023) and Tilburg University (2018). Prof. Contreras's academic research focuses on intellectual property, antitrust law, technical standardization and science policy. He is an elected member of the American Law Institute and the former co-chair of the National Conference of Lawyers and Scientists. He received his JD from Harvard Law School, earned his BSEE and BA in English at Rice University and clerked for Chief Justice Thomas R. Philips of the Texas Supreme Court.



Tom Cotter

Professor Thomas F. Cotter joined the University of Minnesota Law School faculty in 2006. He received his B.S. and M.S. degrees in economics from the University of Wisconsin-Madison, and in 1987 graduated magna cum laude from the University of Wisconsin Law School, where he served as Senior Articles Editor of the Wisconsin Law Review and was elected to the Order of the Coif.



Will Covey

Will Covey is the Deputy General Counsel and Director for the Office of Enrollment and Discipline (OED) at the United States Patent and Trademark Office (USPTO). As Deputy General Counsel, Mr. Covey is responsible for ensuring that the nation's patent attorneys and agents are of good moral character and sufficiently knowledgeable to practice before the USPTO. Mr. Covey has held a number of key positions at the USPTO, including Acting General Counsel and Deputy General Counsel for the Office of General Law. Mr. Covey received his undergraduate degree from Fordham University (magna cum laude, Phi Beta Kappa) and earned his J.D. from Fordham University Law School in 1991. He graduated from Harvard University's JFK School of Government (Senior Executive Fellowship) in 2005 and the U.S. Army War College with an M.S. in Strategic Studies in 2010.



David Grossman

David Grossman is the Senior Director of Technology Transfer and Industry Collaboration at George Mason University. David also supervises pro bono patent cases at the Glushko-Samuels Intellectual Property Law Clinic at the American University Washington College of Law. In addition, he has founded -- and also worked with -- several successful start-up companies and non-profit organizations, as well as monetizing numerous technologies (including several of his own 24 plus patents), some with extremely large multi-national companies. David received a Juris Doctor, magna cum laude, from the American University Washington College of Law and a Bachelor of Science in Electrical Engineering from The Pennsylvania State University.

CONFERENCE SPEAKERS



David W. Ladner

Following 22 years with American Cyanamid in Princeton, NJ, where he was a named inventor on 22 U.S. patents, David became a Patent Agent in 2000 and was hired as the Patent Manager for Bayer Pharmaceuticals in West Haven, CT. From 2005-2008 he served as IP Manager at several small Biotech and Pharmaceutical startups.

Since 2009, David has provided similar services as the solo practitioner of Ladner Patent Management, LLC, and also serves on the faculty of the Patent Institute of Training.

David is a native of Pennsylvania, and has a B.S. in Chemistry from Penn State, a Ph.D. in Organic Chemistry from the University of Georgia, and an M.B.A from Fairleigh Dickinson University.



Michael G. "Mike" Locklar

Michael G. "Mike" Locklar represents clients in a variety of fields, including chemicals, oil & gas, software, computers and computer hardware, electronics, consumer products, and medical devices. In his 25 years of IP practice, Mike's practice has included litigation, prosecution, and transactional work. Mike has co-authored briefings to the Federal Circuit and the United States Supreme Court. He has also written and prosecuted patent applications in a variety of technical areas, including chemicals, oil field exploration and production tools and equipment, data communications, power generation systems, heat transfer equipment, fuel cells, post-tension concrete, and seismic equipment.

Mike is a Past Chair of the IP Section of the State Bar of Texas, and a past President of the Houston Intellectual Property Law Association.



Paul J. Parins

Paul is a partner at Kagan Binder, PLLC, and is an Adjunct Professor/Faculty Member at the University of Minnesota Law School teaching patent law and practice with an emphasis on legal, business, and technical strategies with respect to patent application drafting and prosecution, and oral advocacy. Paul has a degree in chemical engineering and handles a wide variety of chemical, physics, material science, biotechnology, mechanical, and electro-mechanical technologies.



Gale R. "Pete" Peterson

Gale R. "Pete" Peterson retired as an equity shareholder in 2014 from the San Antonio law firm of Cox & Smith after 35+ years of practice in both general and IP litigation, as well as IP prosecution, licensing, acquisition, and consulting. And, after retirement, in select cases primarily as a court-appointed special master (75+ cases, overseeing discovery, claim construction, and summary judgment motions, for various federal district courts), expert witness (30+ cases), and mediator/arbitrator (50+ cases, including international arbitrations before the International Court of Arbitration). Before entering private practice, Pete served as Technical Advisor to Chief Judge Howard Markey, U.S. Court of Customs and Patent Appeals (predecessor to the Federal Circuit), as well as examiner in the USPTO (laser, electron beam and plasma arts) and law clerk to the PTO Board of Appeals.

CONFERENCE SPEAKERS



Margaret Polson

Margaret Polson is founder and principal attorney for Polson Intellectual Property Law. Overseeing the preparation and prosecution of utility and design patent applications, trademarks, and copyrights, she also assists clients with licensing and intellectual property strategy and management.

In the United States, Ms. Polson has drafted, prosecuted and enforced utility patents for diverse clients and obtained patents in a wide variety of technical areas, from drilling tools to computer controlled rock saws, complex amusement rides, and vegetable-based engine oil. She helps multinational corporations protect their intellectual property worldwide, including IP strategy, patent portfolio management, and enforcement.



Katie Scholz

Katie Scholz has over 10 years of experience drafting and prosecuting patent applications, with the last 5 years as an in-house counsel for 3M Company. Katie has experience drafting in a variety of technology areas including software, materials, mechanical and robotics.

Katie received her Bachelor of Chemical Engineering degree from the University of Minnesota-Twin Cities, and her Juris Doctor degree from the University of Minnesota Law School in Minneapolis, MN.



Melanie Schultz

Melanie is a Canadian patent practitioner who in 2021, after 13 years in the IP profession, co-founded Altitude IP, a Canadian IP firm focusing on patent, design and trademark prosecution. Melanie's practice centers around patent drafting, prosecution, and advising on issues of patentability, infringement and validity. She works with many U.S. associates and Canadian companies to strategize and secure IP protection in Canada and abroad, giving her an in-depth understanding of the differences between Canadian and U.S. practice.



Jeremy Smith

Jeremy is a European and UK patent attorney and is a Partner at Kilburn & Strode, based in London. He specialises in oppositions and appeals at the European Patent Office. As well as leading cases at the EPO, he has provided litigation support for corresponding cases at the Unified Patent Court (UPC) and in European national courts, working closely with litigators in various countries, including being part of the team for a successful preliminary injunction trial in Denmark. At the EPO, Jeremy has had success in defending and attacking patents when acting against entities such as the European Union, the European Space Agency, some of the world's largest medical device companies and the largest companies in the Swiss watch industry.



CONFERENCE SPEAKERS



Josh Snider

Josh is a licensed attorney with 25 years of experience representing large corporations, government entities, universities, and entrepreneurs in all areas of intellectual property and related business matters. Josh has been a registered Patent Attorney since 2000, and has prosecuted over two thousand patents before the USPTO. Prior to becoming a Patent Attorney, Josh was an Assistant Public Defender with the Cook County Public Defender's Office in Chicago, and a former research scientist degreed in Electrical Engineering and Computer Engineering.



Gary Sorden

Gary specializes in intellectual property disputes and has tried numerous commercial litigation disputes in forums across the country. He serves as lead counsel on intellectual property matters related to patent, copyright, DMCA, trade secret, trademark, and trade dress issues. He has extensive experience advising clients on both sides of the aisle in federal and state matters as well as alternative dispute resolution forums.

Through his trial experience, Gary has developed a reputation as a "go to" dealmaker in intellectual property license disputes and transactions regarding intellectual property. Gary regularly assists clients in licensing negotiations and transactions involving intellectual property with substantial deal values.



Meredith Struby

Meredith Struby is the managing partner of Meunier Carlin & Curfman LLC, an intellectual property boutique firm in Atlanta, GA. Her practice focuses on patent asset creation and portfolio management and counseling regarding third party owned patents for mechanical, electro-mechanical, textile, and medical device technologies. Meredith has a strong commitment to serving underrepresented groups in IP law and STEM fields.



Kip Werking

Kip has been practicing intellectual property law for over 15 years and is registered before the United States Patent and Trademark Office. Kip previously worked with multiple patent law boutiques where he assisted dozens of technology companies in preparing and prosecuting patent applications. He has extensive experience working with the following technology areas: displays, projectors, xerography, electric vehicles and batteries, digital cameras and optics, games and artificial intelligence, cellular networks, cybersecurity, virtual/augmented reality, and semiconductors.

In his practice, Kip has conducted hundreds of personal interviews with examiners on location at the U.S. Patent and Trademark Office, as well as obtained hundreds of issued patents for clients. Additionally, Kip has extensive experience with appeals from patent examination rejections before the Patent Trial and Appeal Board. Kip has also managed and trained new attorneys and patent agents in the patent prosecution process. During law school, Kip had a summer internship with the Office of Unfair Import Investigations helping the federal government in patent litigation before the International Trade Commission.



CONFERENCE SPEAKERS



Aaron M. Williams

Aaron is a partner in the Vorys Cleveland office and is a member of the litigation and intellectual property groups. His practice focuses on representing clients in connection with the defense or prosecution of their intellectual property rights, including cases involving patent and trademark infringement, trade secrets, and non-competition agreements. Aaron has litigated cases before the American Arbitration Association, state and federal trial courts, the Federal Circuit and the International Trade Commission involving various technologies, including consumer goods and electronics, software and mobile applications, and a number of different mechanical designs, systems and processes.



Katrina Witschen

Katrina Witschen is in-house counsel for Boston Scientific based in the Twin Cities area. As a Senior Legal Director of Intellectual Property, Katrina and her team manage Boston Scientific's Electrophysiology and Cardiac Rhythm Management and Diagnostics IP portfolios. Katrina received her Biomedical Engineering degree in 1997 and her law degree in 2003. She started her career working as an engineer for Medtronic before transitioning to Medtronic's legal department. Katrina then spent several years at a boutique IP law firm in the Twin Cities before going back in-house for Boston Scientific, where she has been for the past nine years taking on roles of increasing responsibility. Katrina is a Minnesota native and enjoys life in the country in Monticello, MN with her husband of nearly 25 years and their seven children.



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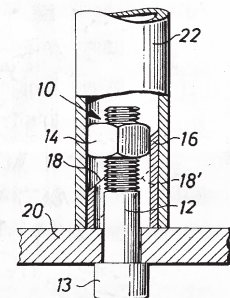
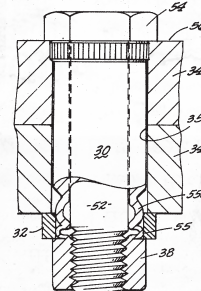
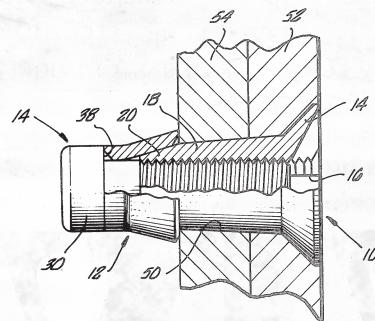
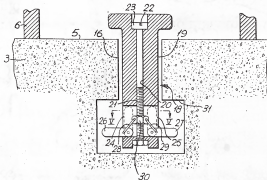
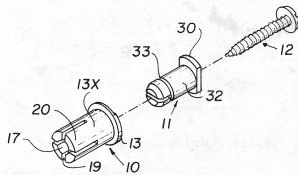
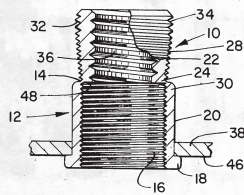
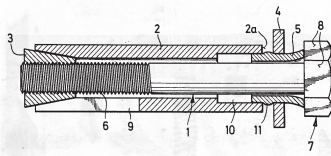
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NUTS & BOLTS

Wednesday, July 17th
8:00 AM - 12:00 PM

**The Nuts & Bolts program is an add-on session*

New to patent practice? Or just want a refresher on patent prosecution?

Join us at the NAPP Annual Meeting for "Nuts & Bolts - What You Need to Know About Patent Prosecution (But No One Taught You), an add-on session by Priya Sinha Cloutier, David Grossman, David Ladner, and David Boundy.

The patent application you write today will live for 20-25 years. Your inventors may stake a fortune on how well you do... have you done the best possible job drafting the application? Four experts in patent preparation and prosecution will explore strategies and pitfalls in the drafting of patent claims, patent specifications, drawings, forms and office action responses. For a detailed outline of the program, please see below.

Client Counseling David Ladner

- A. Preliminaries
- B. Timing
- C. Cost Consideration
- D. Value \$\$\$
- E. Patentability
- F. Materials from the Client
- G. What order to do things?

Claim Drafting David Grossman

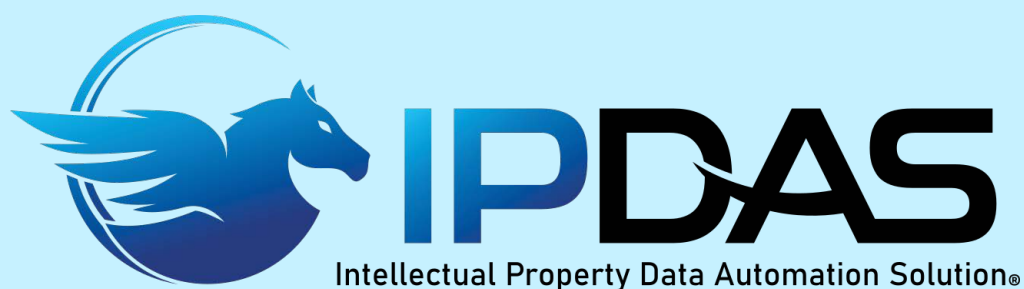
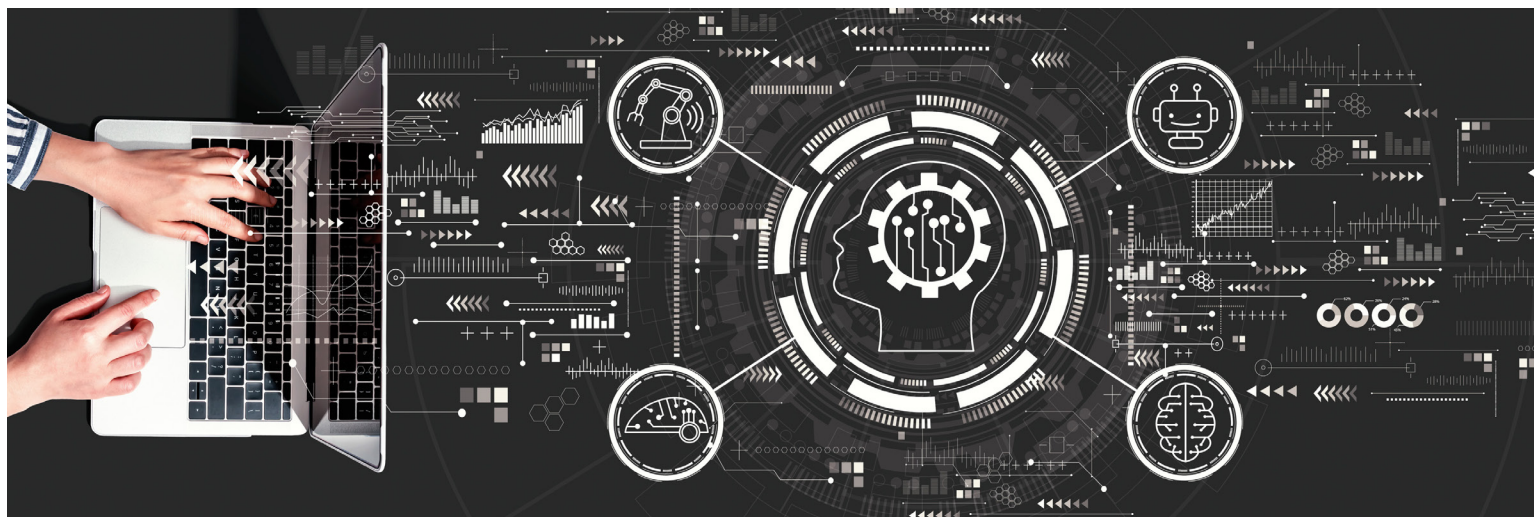
- A. Importance
- B. What and How Many Inventions Are there?
- C. Essential to Cover the Key Aspects and Embodiments
- D. US vs EP Practice?
- E. Approaches
- F. Terms of Art
- G. Types of Claims (Utility)
- H. Structural Layout

Drawings and Specification David Boundy

- A. What's the purpose of the drawings?
- B. What's the purpose of the specification?
- C. Background
- D. Stuff to write in the last hour, after the rest is done, and you're on final approach for filing

Prosecution Priya Sinha Cloutier

- A. Pre-Exam
- B. Examination on the merits
- C. Rejections and strategies to overcome them



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