



# Alice Five Years Later

## Program Agenda\*

<b>Monday, June 24, 2019</b>	
8:00am to 8:30am	Registration & Breakfast
8:30am to 8:45am	<b>Gene Quinn:</b> Welcome & Introductions
Session #1 8:45am to 9:45am	<b>Setting the Stage: The Wrath that Alice Wrought – By the Numbers</b> <i>Kate Gaudry, PhD, partner, Kilpatrick Townsend</i> <p>The initial response by the USPTO to <i>Alice</i> resulted in an expected increase in the percentage of eligibility rejections from business-method art units. Three years after <i>Alice</i>, eligibility rejections became much more common across the remaining computer-related technology centers (i.e. 2100, 2400, and 2600). The sudden increase in eligibility rejections from other computer-related technology centers can be attributed to the Federal Circuit expanding the application of <i>Alice</i> to inventions that appear abstract despite not being directed to a traditional business-method concept, and the USPTO responding to that shifting change in interpretation by the Federal Circuit. In this first Session, we will take a look at the full impact of <i>Alice</i> on patent application in the U.S.</p> <p><i>Moderated by John White</i></p>
9:45am to 10:00am	BREAK
Session #2 10:00am to 11:15am	<b>An Introduction to the Current State of Patent Eligibility in the United States</b> <i>Chief Judge Paul Michel (CAFC, ret.)</i> <i>Sherry Knowles, Managing Partner, Knowles Intellectual Property Strategies, LLC</i> <p>(1) Reconciling the Irreconcilable: Attempting to make sense of Supreme Court patent eligibility precedent. This session will go case by case through Supreme Court decisions on patent eligibility, discussing the rulings in <i>Morse</i>, <i>Funk Brothers</i>, <i>Benson</i>, <i>Flook</i>, <i>Diehr</i>, <i>Chakrabarty</i>, <i>Bilski</i>, <i>Mayo</i>, <i>Myriad</i> and <i>Alice</i>.</p>

\* DRAFT as of May 20, 2019. The Agenda is subject to change.

	<p>(2) An Unconstitutional Application of 101 by the Supreme Court. The U.S. Constitution grants Congress the power to protect inventions or discoveries, which they statute does. The Supreme Court has ruled discoveries are not patent eligible, which creates a constitutional infirmity.</p> <p><i>Moderated by Gene Quinn</i></p>
11:15am to 11:30pm	BREAK
Session #3 11:30pm to 12:45pm	<p><b>Patent Eligibility and the Federal Circuit</b></p> <p><i>Meredith Addy, Partner, AddyHart, PC</i></p> <p><i>Gene Quinn, President &amp; CEO, IPWatchdog, Inc.</i></p> <p>Patent Eligibility at the CAFC 2014-2019: Exploring the Federal Circuit's handling of 35 U.S.C. 101 post <i>Alice v. CLS Bank</i>.</p> <p><i>Moderated by Gene Quinn</i></p>
12:45pm to 2:00pm	LUNCH
Session #4 2:00pm to 3:15pm	<p><b>The value of software patents post-Alice.</b></p> <p><i>Efrat Kasznik, President, Foresight Valuation Group</i></p> <p><i>Jack Jianqing Lu, PhD, CFA, Partner &amp; Chief Economist of IPMAP, LLC and Sr. VP for Economic Analysis &amp; Survey, Licensing Executives Society USA-Canada</i></p> <ul style="list-style-type: none"> <li>(1) The impact of <i>Alice</i> on royalty pricing in the licensing market and in software IP licensing in particular.</li> <li>(2) Monetization strategies for software patent holders.</li> <li>(3) Intellectual property strategies for start-up technology companies.</li> </ul> <p><i>Moderated by John White</i></p>
3:15pm to 3:30pm	BREAK
Session #5 3:30pm to 4:45pm	<p><b>How the U.S. Patent and Trademark Office is Handling Patent Eligibility</b></p> <p><i>Bob Stoll, partner, Drinker Biddle</i> <i>Former Commissioner for Patents, USPTO</i></p> <p><i>James Carmichael, Carmichael IP; Former Administrative Patent Judge</i></p> <ul style="list-style-type: none"> <li>(1) The <i>Berkheimer</i> Memorandum and Examiner Training (re: Step 2B of <i>Alice/Mayo</i>)</li> <li>(2) Revised 101 Guidance (re: Step 2A); and</li> <li>(3) Significance of the Revised 112 Guidance;</li> <li>(4) PTAB handling of CBM and <i>ex parte</i> appeals re: application of 101 Guidance.</li> <li>(5) Special cases: Artificial Intelligence.</li> </ul>

	Moderated by John White
4:45pm to 5:30pm	<b>TBA</b>
6:00pm to 9:00pm	Cocktail Reception w/ Hors d'oeuvres followed by Dinner @ The District Chop House.

<b>Tuesday, June 25, 2019</b>	
8:00am to 8:45am	Continental Breakfast
8:45am to 9:45am	<b>Keynote Presentation:</b> Grant Philpott, Principal Director and Chief Operating Officer Information & Communications Technology, European Patent Office <b>TITLE:</b>
9:45am to 10:00am	BREAK
Session #6 10:00am to 11:15am	<b>Software Patent Application Best Practices</b> Grant Philpott, COO ICT, European Patent Office Gene Quinn, President & CEO, IPWatchdog, Inc. Strategies for preparing a robust patent application for software implemented inventions that adequately protect innovations in both the United States and Europe.  Moderated by John White
11:15am to 11:30am	BREAK
Session #7 11:30am to 12:45pm	<b>A Patent Owners Perspective</b> Kirupa Pushparaj, Director of Intellectual Property, Square, Inc. Phil Hartstein, CEO, Finjan Holdings, Inc. Real world perspectives on protecting and monetizing the innovations of tomorrow from corporate patent owners in the high-tech sector. This panel will discuss the threat presented by serial patent challenges at Patent Trial and Appeal Board, the challenges presented in building and maintaining a patent portfolio built to protect computer implemented innovations.  Moderated by Gene Quinn
12:45pm to 2:00pm	LUNCH
Session #8 2:00pm to 3:15pm	<b>Protecting Graphical User Interfaces</b> Tracy-Gene Durkin, Partner, Sterne, Kessler, Goldstein & Fox, PLLC John White, Partner, Berenato & White, LLC While patent protection for many forms of software have become more difficult to obtain,

	<p>particularly for financially related software and payment gateways in the United States, protection remains possible for GUIs through the use of design patents, which can protect the look-and-feel and provide protection against imitation.</p> <p><i>Moderated by Gene Quinn</i></p>
3:15pm to 3:30pm	BREAK
<p>Session #9 3:30pm to 4:45pm</p>	<p><b>Patent Reform: Legislatively Fixing § 101.</b></p> <p><i>Phil Johnson, Senior VP of IP, Johnson &amp; Johnson (ret.)</i></p> <p><i>Chris Israel, Partner, ACG</i></p> <p><i>Dana Colarulli, Senior Government Affairs Professional</i></p> <p>This session will explore the activities of the Senate IP Subcommittee, the House IP Subcommittee, and current legislative efforts to solve the patent eligibility crisis facing software, medical diagnostics and life sciences technologies.</p> <p><i>Moderated by Gene Quinn</i></p>

#### Faculty (in alphabetical order)

**Meredith “Mimi” Addy** is an intellectual property litigator with over 25 years of litigation experience. She has handled more than 30 cases before trial courts and argued more than 40 appeals to the Federal Circuit. She has held leadership positions at several AmLaw 100 firms and is a recipient of many awards and honors. Addy is currently a partner at AddyHart, P.C. Addy has testified before Congress to address issues relating to the Federal Circuit and the state of patent law. She has been a member of the Federal Circuit’s Advisory Council and a member of the board of directors of the Federal Circuit Bar Association. Addy is also a founder of the Richard Linn American Inn of Court, which is directed to intellectual property, and served as its first president. Addy has also been recognized as one of the most influential women in IP law by Law360.

**James Carmichael** is a former Administrative Patent Judge on the Board of Patent Appeals and Interferences (now the Patent Trial and Appeal Board). Jim currently represents inventors and patent challengers before the PTO in patent prosecution and *inter partes* review proceedings. Jim also regularly serves as an expert witness on PTO prosecution and post-grant procedures. Before becoming a Judge, Jim served for five years as an Associate Solicitor of the PTO. In that capacity, he represented the agency in federal court litigation and argued more than thirty cases at the U.S. Court of Appeals for the Federal Circuit. The cases Jim handled included patentability and reexamination. He was also Coordinator of attorney discipline proceedings while in the Solicitors Office at the PTO.

**Dana Robert Colarulli** is a senior government affairs professional with more than two decades of experience working on legal-related technology policy and intellectual property issues in and with the private sector, the Executive Branch and the U.S. Congress. He most recently served as the Director of the Office of Governmental Affairs and served on the Executive Management team at the U.S. Patent and Trademark Office (USPTO). As the top legislative liaison at the Department of Commerce on Intellectual Property issues, Mr. Colarulli facilitated substantive patent, copyright and trademark and related policy discussions and advocated for USPTO operational priorities through two Administrations and nearly 10 years. Mr. Colarulli coordinated USPTO personnel to facilitate enactment of various legislative reforms including the 2011 American Invents Act (AIA), the Defend Trade Secrets act, and implementation bills for various trademark, patent and

copyright treaties. Prior to this role, Mr. Colarulli served as Director of Government Relations for the Intellectual Property Owners Association (IPO). He has worked in the U.S. Senate, in a DC-based Law Firm and at the U.S. Small Business Administration.

**Kate Gaudry, Ph.D.**, is a partner with Kilpatrick Townsend. Kate focuses her practice on data-driven and strategic patent prosecution, and has developed a reputation for being one of the premiere data driven prosecution experts in the country. Specifically, she routinely performs empirical analyses of general, portfolio-level or application-level prosecution techniques to inform her clients' selection amongst various prosecution strategies. Through this research, she identifies probabilities and predictive factors of success for various approaches. She has authored over fifty publications. Dr. Gaudry also frequently consults with legal-services companies to help avail big-data, statistical and artificial-intelligence tools to prosecution professionals. Most of her clients are in the software, computers, and quantitative-biology technical areas. She holds a J.D. from Harvard Law, a Ph.D. in Computational Neurobiology from UCSD, and a B.S. in Physics from Fort Hays State University.

**Tracy-Gene Durkin** is a partner with Sterne, Kessler, Goldstein & Fox, PLLC. Simply stated, she is widely regarded as the preeminent authority on design patents in the United States. She is the head of the firm's Mechanical and Design Patent Group and has been the attorney representing some of the world's most iconic brands. With nearly thirty years of experience obtaining and enforcing intellectual property rights, Durkin is sought out by leading consumer product companies around the world for her deep understanding of utility and design patents, trademarks, and copyrights.

**Phil Hartstein** is president and CEO of Finjan Holdings, Inc. He oversees the direction and management of current assets and future investments and works with the company's executive management team to execute the shareholders' vision of a public technology company. Mr. Hartstein has worked in a number of technology and IP-related roles for over a decade. He started with a boutique IP law firm, before working in an in-house IP function for a venture capital-funded start-up and spending time in IP consulting and IP brokerage firms. Before joining Finjan, he spent four years with two groups focused on introducing both private and public market capital, expertise and credibility into licensing and enforcing patent rights on behalf of owners.

**Chris Israel** is a partner at American Continental Group, one of Washington's top government affairs and strategic consulting firms. Chris is an accomplished public and private sector executive with senior-level appointments by the President of the United States, service on Capitol Hill and a senior-level experience within a Fortune 50 company. A frequent speaker on IP and innovation issues, Chris was named one of the 50 most influential people in IP by *Managing IP Magazine* in 2006. He was also the first U.S. Coordinator for International Intellectual Property Enforcement, appointed to the position in July 2005 by President Bush.

**Phil Johnson** is formerly senior vice president and chief IP counsel at Johnson & Johnson. Prior to joining Johnson & Johnson as Chief Patent Counsel, he was a well-respected patent litigator for nearly three decades. Johnson played a key role in both the drafting and passage of the America Invents Act and was subsequently appointed a member of a six-person committee formed by the director of the USPTO to make recommendations on regulations to implement the *inter partes* review and post grant review proceedings. Johnson has served numerous industry organizations during his career, including as president of the Intellectual Property Owners Association, and as a member of the Board of Directors of the AIPLA. He was inducted into the *IP Hall of Fame* in 2017.

**Efrat Kasznik** is President of Foresight Valuation Group and a Lecturer at the Stanford Graduate School of Business. Efrat is a Silicon-Valley based valuation and intellectual property expert with two decades of consulting experience, focusing on assisting IP holders across industries with the creation, commercialization and monetization of their intangible assets. She helps clients, ranging in size from Fortune 100 companies to start-ups, with IP and business valuations in support of

licensing deals, IP and technology acquisitions, M&A transactions, financial reporting, strategic planning and fundraising. She frequently serves as a testifying expert in disputes involving IP and startup valuations and damages. Efrat currently serves as Chair of the High-Tech Sector – LES USA-Canada and has been recognized as one of the top IP strategists in the world by IAM every year since 2013.

**Sherry Knowles** is Managing Partner with Knowles IP Strategy. From 2006-2010, Ms. Knowles was the Senior Vice President and Chief Patent Counsel at GlaxoSmithKline, where she served as the worldwide head of patents for all litigation and transactional matters and managed a global department of over 200 people in 12 offices. At GSK, Ms. Knowles was a member of the Scientific Advisory Board, the Technology Investment Board, the Product Management Board, the Legal Management Team and she led the Global Patents Executive Team. In 2008, *Managing IP Magazine* named Ms. Knowles one of the top 10 most influential people in Intellectual Property. In November 2011, *Intellectual Asset Management Magazine* listed her among the top fifty key individuals, companies and institutions that have shaped the IP marketplace in the last eight years. She has also been recognized by *IAM Magazine* as one of the top IP strategists in the world numerous times.

**Jack Jianqing Lu**, PhD, CFA, is a Partner and Chief Economist of Intellectual Property Market Advisory Partners (IPMAP) in Austin, Texas. An economist & financial analyst with an engineering background and research credentials, Jack specializes in economic study, financial analysis, assets valuation and strategic advisory for IP transactions and litigation, and for IP-intensive corporate transactions and disputes in financing (VC & PE), M&A, equity investment, and distressed assets investment. He currently serves as the Senior Vice-President for Economic Analysis & Survey, Licensing Executives Society (LES USA Canada).

The **Honorable Paul Redmond Michel** was appointed to the U.S. Court of Appeals for the Federal Circuit in March of 1988 by President Ronald Reagan. On May 31, 2010, Chief Judge Michel stepped down from the bench after serving more than 22 years on the court. In his years on the bench, Judge Michel judged thousands of appeals and wrote over 800 opinions, approximately one-third of which were in patent cases. Judge Michel continues to be a forceful advocate for a strong patent system and testifies regularly on Capitol Hill.

**Grant Philpott** is Principal Director and Chief Operating Officer Information & Communications Technology at the European Patent Office. Philpott has responsibility for approximately 2,000 highly qualified patent examiners, managers and administrative staff, and finds himself at the epicenter of what we in the United States would generically refer to as software patents. During his 30 years at the EPO Philpott has worked across a range of technical fields encompassing ICT, mechanics and industrial chemistry, as a member of the committee responsible for organizing the European qualifying examination for patent attorneys, in the EPO's Controlling Office and also on several automation projects. He is now based in the EPO's office in The Hague, back where he started his EPO career, but he has also spent over 20 years working at the EPO's Munich headquarters site. Previous managerial positions include Principal Director of the Computers and Telecoms operational areas and Director of the EPO's semiconductor patenting directorate in Munich. Prior to joining the EPO Grant spent 3 years as director of the Brazilian subsidiary of a German SME and 9 years as an engineering officer in the British Army. He holds a master's degree from Cambridge University.

**Kirupa Pushparaj** is the director of intellectual property at Square, Inc, where he leads a team that is responsible for all aspects of Square's intellectual property globally. He protects Square's innovation and rights by managing its patent, copyright, and trademark portfolios and is responsible for all of Square's IP litigation, covering patents, domains, trademarks, copyrights, and trade secrets. Additionally, Kirupa leads Square's legal operations team that is responsible for championing innovation, efficiency, and adoption of emerging technologies across the legal team. Before Square, Kirupa was IP counsel for Lab126 – the digital technology arm of Amazon.com –

and was at Perkins Coie LLP before that, where he practiced patent prosecution and IP litigation. Prior to practicing law, Kirupa was a practicing engineer, first as a software engineer at Siemens Telecommunications Limited, and then as a hardware design engineer at Intel Corp., where he worked on semiconductor circuit design and process technology. Kirupa is also an adjunct professor for over eight years at various California universities, including Stanford University, the University of the Pacific, and the University of California, Davis. He has been recognized as a Northern California Rising Star in 2011 and 2012 by *Super Lawyers*, as Corporate IP Counsel of the Year by the *San Francisco Business Times*, as Corporate IP Star by *Managing IP*, as Best Under 40 Lawyers by the *National Asian Pacific American Bar Association*, and has been included in the IAM 300 list of World's Leading IP Strategists. He has also received multiple Wiley W Manuel awards for his continued *pro bono* services. He serves on the boards of the Silicon Valley IP Law Association and the Asian Pacific American Bar Association (Silicon Valley) and is an advisory board member for two tech startups in the Silicon Valley.

**Gene Quinn** is a patent attorney and a leading commentator on patent law and innovation policy. He is the Founder and Publisher of IPWatchdog.com, and serves as the President & CEO of IPWatchdog, Inc. Gene currently maintains a small private practice with Berenato & White, LLC, where he advises inventors, entrepreneurs and start-up businesses throughout the U.S. and around the world. IPWatchdog.com has been recognized multiple times by the American Bar Association as a top 100 legal blog, multiple times as the top IP blog, and in 2014 was inducted into the *ABA Blawg Hall of Fame*. Gene has been recognized by *IAM Magazine* as one of the top IP strategists in the world every year since 2017. He has also been recognized by *Managing Intellectual Property* as one of the 50 Most Influential People in IP (2014). Regarded as an expert on software patentability and U.S. patent procedure, Gene's particular specialty is in the area of strategic patent consultancy, portfolio building, and patent prosecution strategies.

**Bob Stoll** is co-chair of Drinker Biddle's Intellectual Property Practice Group. Bob retired from the USPTO as Commissioner for Patents at the end of 2011 after a distinguished 34-year government career. Bob was instrumental in the passage of landmark patent legislation, the America Invents Act, and lauded for his efforts to reduce patent pendency and improve patent quality. Having risen from the rank of examiner to lead the 8,000-employee organization, Bob has spent his career working to improve the intellectual property system. Today Bob advises clients on post-grant procedures before the USPTO and engages in policy work on patent issues. Bob regularly testifies as an expert on patent practice matters and represents other attorneys and firms before the Office of Enrollment and Discipline at the USPTO.

**John White** is a patent attorney and lecturer. He is an Adjunct Law Professor at the University of Virginia School of Law and is the principal lecturer in the PLI Patent Bar Review Course. John also teaches a patent practice course for new practitioners. Since John began teaching in 1995, he has personally taught at least 50% of all practicing patent attorneys and patent agents. John has also taught numerous U.S. Patent Examiners at the USPTO in the "Law and Evidence Course" necessary for them to advance to Partial Negotiation authority as Examiners. John serves as an expert witness in patent litigations and is regarded as a leading authority on patent practice and procedure in the United States. He maintains a selective patent practice with Berenato & White, LLC, largely aimed at assisting start-up technology companies increase and monetize their patent portfolios.

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