



**NAPP's 18th Annual Meeting and Conference**  
July 20-22 Hilton Old Town Alexandria, VA

**Session Description Details by Day**  
(revised May 26, 2014)

**AT-A-GLANCE**

**Sunday July 20: "Nuts & Bolts"**

- Do-It-Yourself Patent Searching, *Stan Lewis*
- Patent Application Preparation Parts 1 & 2, *David Grossman*
- Responding to an Office Action, *Michael Feigin*
- Client Counseling: Setting Realistic Expectations\*, *Greg Kavounas*
- Roadmap for Drafting a Design Application (It's Different!), *Anton Skaugset*

**Monday July 21: Practice Update Part 1, "USPTO Day"**

[Note: There may be substitutions of named USPTO presenters]

- USPTO Developments, Andrew Faile, *Deputy Commissioner for Patent Operations*
- Patent Application Initiative PAI AFCP 2.0, QPIDS, *Director*
- The Examination Process From Filing to Disposition, *Patent Specialty Directors*
- Examiner Interview Tactics: Pre-First-Action Interviews; After-Final Interviews; Pre-Appeal Conferences; WebEx, *Patent Specialty Directors*
- Ombudsman and Petition Process, *Joseph Thomas et al*
- PTAB Appeals, *3-4 PTAB Judges*
- Professional Responsibility Before the Office of Enrollment and Discipline: Cases and Considerations, *William Covey, Deputy General Counsel, Director OED*

**Tuesday July 22: Practice Update Part 2**

- Our Changing Practice: Decisions from the Federal Court, *Priya Cloutier, Chair (sponsored by NAPP's Government Affairs Committee)*
- Best Practices: Minimizing the Risk of Malpractice, *Andrew Jones and Larry Hilton, with Diane Gardner, Chair (sponsored by NAPP's Membership Committee)*
- On Your Radar: Docketing Systems Reviewed, *Bruce Young and David Stein*
- Covering All Bases: PCT Considerations, *Mavis Gallenson*
- Interactive Client Counseling: Licensing, Monetizing and Alternatives to Patents (final topics TBD) *Michael Shimokaji, Louis Hoffman, Lisa Adelson*

# SUNDAY NUTS & BOLTS

## **Do-It-Yourself Patent Searching, *Stan Lewis***

Generally directed to practitioners who want to do their own patent research. Discussion of types of patent research typically encountered. Some (but not all due to time limitations) of the tools (patent search engines) available for patent research with pros, cons, cost and comparisons (i.e., EAST, Lexis, Patbase, Derwent, etc.). Questions can be answered about the tools not specifically discussed. A discussion of Boolean operations and implementation in different patent search engines and the differences in capability. Databases covered by specific search tools and the extent of English translations for each database discussed. Classification searching and differences in IPC, CPC and US patent classification. A brief introduction to Chemical and Electrical searching. How to review a patent search upon completion or when the search is done by another source, i.e., things to look for to ensure quality. A resource page is for participants which provides additional search tools and information not specifically discussed.

## **Patent Application Preparation, *David Grossman***

Patent Application Preparation can be a daunting task for new practitioners. This presentation will go over the nuts and bolts of the process of drafting a commercially valuable patent application.

## **Responding to an Office Action, *Michael Feigin***

After applying for a patent on behalf of your client, the Patent Office typically issues Office Actions rejecting the application. Patent attorney Michael Feigin, Esq. provides a comprehensive step-by-step analysis of how to respond to such an Office Action. Mr. Feigin begins with a brief introduction to the Office Action and how to draft a patent with the office action in mind. Furthermore, he also gives examples of rejections and how to avoid them and uses examples of patent applications that he has submitted and were approved by the patent office. Mr. Feigin then continues to describe the examiner interview and how to successfully pass it and complete the required written response. Finally, this course provides helpful examples of past Office Actions and how attorneys represented their clients in these situations. This course is extremely useful for all patent practitioners who will need to handle these inquiries from the Patent Office on behalf on their clients' applications.

## **Client Counseling: Setting Realistic Expectations\*, *Greg Kavounas***

Clients hire patent practitioners for outcomes that they hope for. Helping clients understand which outcomes are pragmatic before the hiring can prevent disappointment and some negative consequences. A suggested procedure will be presented that uses a custom intake & estimate form. As the practitioner talks during the initial consultation, he can fill in blanks of the form, which further documents serious cautions that the inventor should heed. The speaker's newly released book will be introduced as a client retention & education tool for unsophisticated clients (and headache saving for practitioners!)

## **Roadmap for Drafting a Design Application (It's Different!), *Anton Skaugset***

Many practitioners do not file design patent applications, or do so only rarely, and therefore do not have the opportunity to become familiar with some fundamental aspects of design practice. In this talk we will be discussing the basics of design application drafting, with particular emphasis on the quality of the design drawings. The drawings of a design application ARE the patent claim, and we will discuss how to prepare illustrations that define the desired design with the appropriate scope, that establish the desired filing date for the claimed subject matter, and that avoid delays in prosecution due to formalities rejections.

# **MONDAY PRACTICE UPDATE PART I**

[Details Coming Soon]

**USPTO Developments**, *Andrew Faile, Deputy Commissioner for Patent Operations*

**Patent Application Initiative PAI AFCP 2.0, QPIDS**, *Director*

**The Examination Process From Filing to Disposition**, *Patent Specialty Examiners and Directors*

**Examiner Interview Tactics: Pre-First-Action Interviews; After-Final Interviews; Pre-Appeal Conferences; WebEx**, *Patent Specialty Examiners and Directors*

**Ombudsman and Petition Process**, *Joseph Thomas et al*

**PTAB Appeals**, *3 PTAB Judges*

**Professional Responsibility Before the Office of Enrollment and Discipline: Cases and Considerations**, *William Covey, Deputy General Counsel, Director OED*

An overview of professional responsibility matters at the USPTO's Office of Enrollment and Discipline, including illustrative cases and discussion of thought-provoking scenarios.

## **TUESDAY PRACTICE UPDATE PART II**

### **Our Changing Practice: Decisions from the Federal Court**, *Priya Cloutier, Chair, Government Affairs Committee*

The role of a patent prosecutor involves more than just helping clients obtain patents -- patent prosecutors must help clients obtain patents that are enforceable. The concepts of patentability and enforceability change every year depending on the whims of the courts. This presentation will provide patent prosecutors with an insight of how courts have changed the rules of patent prosecution this year, and how to respond to those changes in their day-to-day practice.

### **Annual Meeting: Interactive Engagement Moving NAPP Forward**, NAPP Board of Directors

### **Best Practices: Minimizing the Risk of Malpractice**, *Andrew Jones and Larry Hilton, with Diane Gardner, Chair, Membership Committee*

Practical tips to help you avoid malpractice claims; an understanding of the key errors and omissions; insurance terms you must know; and steps to ensure you are protected if a claim is made against you. Session includes sample protective letters and risk management checklist handouts. The three primary areas of discussion are I. Avoiding Disputes: Smart Matter Intake/Management; II. Best Practices: Risk management/best practice guidelines and checklists. III. The How, What & When Insurance Coverage. Also includes discussion of what qualifies as "continuing education" under the new BPRR program.

### **On Your Radar: Docketing Systems Reviewed**, *Bruce Young, David Stein*

Several different docketing systems will be described and compared. A standard set of questions will be answered for each system, including costs, and then special features will be highlighted for the various systems. The primary focus will be on patent practice, but some trademark practice features will be mentioned. An initial list of systems compared includes AppColl, CTS/Flextrac, DocketTrak, PATTSY, RevaTrademark, and Fileye (subject to change). Time will be left at the end for attendees to share their own experiences with docketing systems.

### **Covering All Bases: PCT Considerations**, *Mavis Gallenson*

This lecture discusses the nuances of PCT filing and the importance of preparing an application that will be successful in countries other than the US. US practice, like all national practices, does not present the rules of what are necessary to consider when filing abroad. Practitioners must be alert to other country practices when filing their PCT applications or risk failures of those applications abroad. Further, PCT practice is its own specialty and as a US practitioner, to do the best job for your client, you need to be aware of the benefits and pitfalls of this international forum from which decisions cannot be appealed.

### **Client Counseling: Licensing, Monetizing and Alternatives to Patents**, *Michael Shimokaji, Louis Hoffman, Lisa Adelson*

In this interactive final session, a series of inventions will be presented with multiple strategies and approaches to protect and capitalize on the intellectual property.