



**PROGRAM AGENDA  
LIBERTY HOTEL  
BOSTON, MASSACHUSETTS  
OCTOBER 18-20, 2010**

**MONDAY, OCTOBER 18, 2010**

***Registration***

***11:00 am – 4:00 pm***

***Liberty Hotel – Esplanade Room, 5<sup>th</sup> Floor  
215 Charles Street  
Boston, MA 02114***

*Please come to pick up your conference badge and materials. If you are unable to pick up your materials during this time, registration will reopen on Tuesday, October 19<sup>th</sup> at 7:15 am in the Liberty Ballroom Foyer on the main floor of the Liberty Hotel.*

***IP Counsels Committee Retreat &  
Working Luncheon***

***12:00 pm – 4:30 pm***

***Liberty Hotel – Esplanade Room, 5<sup>th</sup> Floor  
215 Charles Street  
Boston, MA 02114***

*\*Open to IP Counsels Committee company members and their representatives only.  
Chair: Thomas Kelley, Patent Counsel, Monsanto Company  
Copies of the Agenda for all Committee meetings will be provided onsite.*

***Welcome Reception***

***5:30 pm – 7:30 pm***

***The Liberty Hotel – 1<sup>st</sup> Floor  
Alibi Bar and Lounge  
215 Charles Street  
Boston, MA 02114***

*\*Prior RSVP is required.*

*Reception Sponsored by:*

**FINNEGAN**

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**TUESDAY, OCTOBER 19, 2010**

***Chairman's Welcome & Breakfast Buffet***

**7:00 am – 8:00 am**

***Liberty Hotel – Rotunda, 5<sup>th</sup> Floor***

***Sponsored by: Woodcock Washburn LLP***

***Session 1:***

**8:00 am – 9:45 am**

***It's Novel and Inventive, But Is It Patentable?***

***Liberty Ballroom – 2<sup>nd</sup> Floor***

***Sponsored by: Woodcock Washburn LLP***

***Moderator: S. Maurice Valla, Partner, Woodcock Washburn LLP***

***Panelists:***

*Jason Ferrone, Vice President, Patents & Senior Patent Counsel, Isis Pharmaceuticals, Inc.*

*Huw Hallybone, Partner, Carpmaels & Ransford*

*Christopher Sappenfield, Senior Counsel, Ibis Biosciences, Inc.*

*Sandra Wells, Vice President and Chief Intellectual Property Counsel, Affymetrix, Inc.*

The panel will explore the evolving law in the US regarding patentable subject matter as it relates to patenting of genes, biomarkers, diagnostic methods and cell-based therapies, with particular regard paid to the effect of cases such as *In re Bilski*, *Prometheus*, *Classen Therapeutics* and *Assoc. for Molec Path v. Myriad*.

***Session 2:***

**10:00 am – 11:45 am**

***Valuing IP in the Current High Risk Environment***

***Liberty Ballroom***

***Sponsored by: Woodcock Washburn LLP***

***Moderator: Gary Levin, Partner, Woodcock Washburn LLP***

***Panelists:***

*Dr. Richard Gering, Partner, ParenteBeard*

*Dr. Robert Hrubiec, Vice President, Intellectual Property, Cephalon, Inc.*

*Dr. Robert Schenkel, Director, Life Sciences Licensing, Center for Technology Transfer,  
University of Pennsylvania*

This panel will discuss the factors that must be evaluated when selling, licensing, or acquiring IP rights, including valuing the IP rights and licensing considerations (whether and how to) with a focus on issues that result from current uncertainties in the law and third-party encroachment into the market.

***Networking Luncheon***

***12:00 pm – 12:45 pm***

***Liberty Hotel – Rotunda, 5<sup>th</sup> Floor***

***Sponsored by: Finnegan, Henderson, Farabow, Garrett & Dunner, LLP***

***Session 3:***

***1:00 pm – 2:15 pm***

***Practice Before the PTO: What is Changing? What Still Needs to Change?***

***Liberty Ballroom***

***Sponsored by: Finnegan, Henderson, Farabow, Garrett & Dunner, LLP***

***Moderator: Dr. David Frazier, Partner, Finnegan, Henderson, Farabow, Garrett & Dunner, LLP***

***Panelists:***

***Robert L. Stoll, Commissioner for Patents, US Patent & Trademark Office***

***Charlie Van Horn, Partner, Finnegan, Henderson, Farabow, Garrett & Dunner, LLP***

***Donna Meuth, Associated Senior Patent Counsel, Eisai***

From a new examiner count system to a proposed three-track system for examination to the “bump and dump,” it is clear that Director Kappos is changing the way things work at the USPTO. Mr. Stoll will discuss the various initiatives that have been proposed or implemented during the first year of Kappos’ administration and comment on how those initiatives are altering the face of patent prosecution in the United States. Mr. Van Horn and Ms. Meuth, with the help of the audience, will identify other areas of PTO practice that could benefit from PTO review and/or reform.

***Session 4:***

***2:15 pm – 2:45 pm***

***How to Defend Your Patent in an Inter Partes Reexam***

***Liberty Ballroom***

***Sponsored by: Finnegan, Henderson, Farabow, Garrett & Dunner, LLP***

***Leslie McDonell, Partner, Finnegan, Henderson, Farabow, Garrett & Dunner, LLP***

Leslie McDonell of Finnegan, will discuss the burden faced by patent holders in the inter partes reexam process and the best ways to even the odds in this remarkably fast-paced, pro-requestor proceeding, including how to avoid common pitfalls.

***Session 5:***

***3:00 pm – 4:15 pm***

***Inequitable Conduct: Is Reform Finally In Sight?***

***Liberty Ballroom***

***Sponsored by: Finnegan, Henderson, Farabow, Garrett & Dunner, LLP***

***Moderator: Mark Sweet, Partner, Finnegan, Henderson, Farabow, Garrett & Dunner, LLP***

***Panelists:***

***Steve Caltrider, Vice President, Deputy General Patent Counsel, Eli Lilly and Company***

***Bernie Knight, General Counsel, US Patent & Trademark Office***

The panel will review the highs and lows of inequitable conduct law to date and the Federal Circuit's upcoming en banc review of this law in *Therasense Inc. v. Becton Dickinson & Co.*

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***Dinner Reception***  
***New England Aquarium***  
***1 Central Wharf***  
***Boston, MA 02110-3309***

*\*Open to registered attendees only.*  
*\*Prior RSVP is required.*

**5:30 pm – 9:30 pm**



Please meet at 5:30 pm in the Liberty Hotel lobby for transportation to the dinner reception. Shuttles will provide transportation back to the hotel upon conclusion of the event.

***Dinner Reception Sponsored by:***

**McCARTER  
& ENGLISH**  
ATTORNEYS AT LAW

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**WEDNESDAY, OCTOBER 20, 2010**

***Breakfast Keynote***  
***Liberty Hotel – Liberty Ballroom***  
***Sponsored by: Choate Hall & Stewart, LLP***

**7:30 am – 8:45 am**

The Honorable Judge William G. Young  
United States District Judge for the District of Massachusetts

***Session 6:***  
***What's Left of Biotech Method Patents***  
***Liberty Ballroom***  
***Sponsored by: Choate Hall & Stewart, LLP***

**9:00 am – 10:30 am**

***Moderator: Eric J. Marandett, Practice Group Leader, Choate Hall & Stewart, LLP***

***Panelists:***  
***Gavin T. Bogle, General Counsel, Iovate***  
***Janice Klunder, Associate General Counsel, Millennium Pharmaceuticals, Inc.***

A series of recent decisions, from *DSU Medical* in 2006, to *Myriad Genetics* and the Supreme Court's *Bilski* decision in 2010, have potentially sweeping implications on the value of important method patents in the biotech space. Once a key part of the patent portfolios of biotech and pharmaceutical companies, the practical value of claims to, for example, methods of treatment, diagnostic methods, mechanisms of action and personalized medicine protocols, are very much up in the air following these decisions. This panel will examine the ongoing viability of these types of method claims under the evolving case law.

**Session 7:**

**10:45 am – 12:15 pm**

***Tales from the Edge: Reports on Investment in Emerging Markets***

***Liberty Ballroom***

***Sponsored by: Choate Hall & Stewart, LLP***

***Moderator: Dr. Brenda Jarrell, Practice Group Leader, Choate Hall & Stewart, LLP***

***Panelists:***

*Jennifer Groves, Partner, Hughes Hubbard & Reed LLP*

*Otto Banho Licks, Associated Partner, Momsen, Leonardos & Cia*

*Sandra Pohlman, Partner, df-mp*

*Yoon-Suk Shin, Member, Lee International, IP & Law Group*

The panel will discuss recent experiences in funding and/or partnering with companies in emerging markets (e.g., China, India), with a focus on Intellectual Property issues that have arisen.

**Session 8: *IPCC Business Meeting & Wrap Up***

**12:30 pm – 2:00 pm**

***Working Luncheon***

***Esplanade Room, 5<sup>th</sup> Floor***

***\*Open to IP Counsels Committee company members and their representatives only.***

***Chair: Thomas Kelley, Patent Counsel, Monsanto Company***

***Copies of the Agenda for all Committee meetings will be provided onsite.***