

Agenda

Researching Inventions and Existing Patents

L. Murray

Collecting information about inventions
Patentability searches
Clearance searches

Managing and Preserving U.S. Patent Rights

M. Haggerson

Maintaining the patent
Licensing patent rights
Assigning patent rights
Handling patent issues in corporate transactions
Handling patent infringement issues

Preparing and Prosecuting US Patent Applications

R. Sovesky

Preparing US patent applications
• Identifying the invention and the inventors
• Drafting the patent application
• Reviewing sample applications
Prosecuting patent applications

Preventing Patent Disputes and Litigation

S. Altman, L. Tanglen

Create procedures to properly secure IP rights from the start
(Employee contracts, joint development agreements, cross-license)
Alternative arrangements to court (Licensing, joint ventures,
mediation, arbitration, settlement)
Mitigating losses (Insurance, attorney opinions)
Know your business and competitors (Freedom to operate searches,
literature review, etc.)

Current Issues in Patent Law

R. Sovesky, R. Capriotti

35 U.S.C. 101: Moving forward
Venue: The impact of TC heartland
Foreign lost profits

Patent Law for Non-Patent Professionals
Coraopolis, PA - Tuesday, February 26, 2019

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Learning Objectives

You'll be able to:

- Collect** information about inventions using various searches.
- Explore** patent rights licensing and learn how to handle patent infringement issues.
- Review** sample patent applications and discuss how patent applications are prosecuted.
- Create** procedures to secure intellectual property rights using employee contracts and joint development agreements.
- Discuss** current issues, including developments at the Patent Trial and Appeal Board.



Patent Law for Non-Patent Professionals

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- Learn** about researching inventions and existing patents
- Understand** how to prevent patent disputes and litigation
- Understand** how to manage and preserve U.S. patent rights
- Explore** current issues in patent law, including what inventions are patentable
- Discuss** the preparation of U.S. patent applications

Continuing Education Credits

- Professional Engineers**
6.5 PDHs
- Attorneys**
6.5S Pennsylvania CLE Hours
6.5 Ohio CLE Hours
7.5 New York CLE Hours
7.5 New Jersey CLE Hours



Faculty

Laurén Shuttleworth Murray *K&L Gates LLP, Pittsburgh*
Ms. Murray has extensive experience in patent preparation and prosecution before the U.S. Patent and Trademark Office for both utility and design applications. She participates in all aspects of the patent procurement process including obtaining and reviewing invention disclosures, performing patentability searches, drafting applications, preparing filings including responses to office actions, and interviewing examiners. Ms. Murray's practice also involves patent invalidity, clearance, and freedom-to-operate analyses; due diligence studies; and drafting substantive filings for post-grant procedures such as petitions for inter partes review. In addition, Ms. Murray works on trademark portfolio development and maintenance. She has extensive experience preparing and prosecuting trademark applications.

Michael Haggerson *K&L Gates LLP, Pittsburgh*
Mr. Haggerson's patent procurement practice includes preparing and prosecuting patent applications for a range of technologies including surgical cutters/staplers, ultrasonic surgical instruments, electrosurgical instruments, digital medicine, ingestible sensors, software and computer systems, artificial intelligence, and autonomous vehicles. Mr. Haggerson also has experience in post-grant proceedings before the Patent Trial and Appeal Board, including preparing inter partes review petitions targeting patents in various technical fields, including autonomous vehicles and software. Mr. Haggerson also has experience counseling clients on freedom to operate and patent invalidity issues involved in surgical techniques and other technological fields. He has a background in biomedical engineering and focuses his practice on patent procurement and portfolio management.

Robert J. Sovesky *K&L Gates LLP, Pittsburgh*
Mr. Sovesky's practice includes all aspects of intellectual property law relating to procurement, licensing, clearance, enforcement, management, and counseling. Mr. Sovesky is experienced with representation of companies of varying sizes, including fortune 100 companies and fledgling startups. Examples of Mr. Sovesky's experience include procurement and management of patent portfolios, technology roadmap counseling, white space guidance, innovation evaluation, and freedom-to-operate analyses. Mr. Sovesky's technical concentration is in the chemical, biotech, materials science, and mechanical areas. Examples of his technical concentration include 3D printing, metallurgy, polymers, polymerization coatings, enzymology, hydrocarbon processing, catalysis, and photovoltaic cells.

Seminar Information

Pittsburgh Airport Marriott
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HalfMoon Education Inc. is a New Jersey CLE Service Provider (No. 164), and this course offers 8.0 CLE hours to New Jersey attorneys.

Attendance will be monitored, and attendance certificates will be available after the seminar for most individuals who complete the entire event. Attendance certificates not available at the seminar will be mailed to participants within fifteen business days.

Roberto Capriotti *K&L Gates LLP, Pittsburgh*
Mr. Capriotti focuses his practice on intellectual property law, primarily in the preparation, prosecution, and litigation of high technology patents, trademarks, and copyrights. He also counsels clients on intellectual property strategy, portfolio development, and transactional matters. Prior to joining the firm, Mr. Capriotti held various positions as a patent agent and as an electronics design engineer where he designed microprocessor embedded systems including telecommunication devices, sensors, and instruments for various industries including energy measurement and distribution systems.

Susan Altman *K&L Gates LLP, Pittsburgh*
Ms. Altman helps clients properly structure contracts in ways that foster long-term, positive commercial relationships, whether through subscription agreements, licensing, strategic alliances, or outsourcing transactions. In addition to assisting clients with IT and business process outsourcing activities, Ms. Altman has negotiated commercial contracts across the breadth of global supply chain networks, from manufacturing to distribution and retail, and has supported the commercial launch of numerous cloud-based services. She has also negotiated licenses of intellectual property rights in the software, IoT, FinTech, data analytics, artificial intelligence, medical device, and biotechnology industries. She addresses privacy and data protection in commercial contracts, including many transactions in the financial services and healthcare industries. Ms. Altman is a frequent lecturer on commercial and technology issues affecting companies on the edge of tomorrow.

Lucas J. Tanglen *K&L Gates LLP, Pittsburgh*
Mr. Tanglen practices commercial litigation, with an emphasis on complex insurance coverage matters. His experience representing insurance policyholders includes mass tort product liability matters, intellectual property claims, and directors and officers (D&O) coverage, among many other types of insurance-related representations. His litigation experience includes taking the depositions of insurers' corporate designees and drafting numerous critical court filings, including motions for summary judgment, appellate briefs, motions to compel discovery, and declaratory judgment complaints.

Additional Learning

Webinar Series

Off-Grid Master Class

- **Off-Grid Master Class, Part I**
Wed., Feb. 6, 2019, 11:00 AM -2:15 PM CST
- **Off-Grid Master Class, Part II**
Thurs., Feb. 7, 2019, 11:00 AM -2:15 PM CST

Complying with ADA Standards for Accessible Design

- **Complying with Federal and State Accessibility Requirements**
Thurs., Feb. 7, 2019, 11:00 AM -1:30 PM CST
- **Meeting Requirements in IBC and ADA Standards**
Fri., Feb. 8, 2019, 11:00 AM -1:30 PM CST

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