

New Jersey Intellectual Property Law Association

Electronics, Telecom and Software Patent Practice Update

Wednesday, November 9, 2011 Hyatt Regency New Brunswick

NJIPLA
ELECTRONICS, TELECOM AND SOFTWARE PATENT PRACTICE UPDATE
November 9, 2011

12:00-12:45 p.m. **Lunch**

12:45-12:50 p.m. **Opening Remarks**

Andrea Kamage, NJIPLA President, Johnson & Johnson, New Brunswick, NJ

12:50-2:00 p.m. **The Prosecution of Patent Applications in the Electrical Arts**

12:50-1:20 p.m. **Examination of Applications on Electrical and Software Inventions**

James Dwyer, Assistant Deputy Commissioner, Computer Architecture, Software, Networking and Multiplex Communications Arts, USPTO, Washington, DC

1:20-1:40 p.m. **Impact of the New Legislation on Prosecution of Patent Applications in the Electrical Arts**

Robert E. Rudnick, Gibbons, Newark, NJ

1:40-1:55 p.m. **Argument of an Appeal before the BPAI**

Joel Miller, West Orange, NJ

1:55-2:00 **Q and A**

2:00-2:10 p.m. **Break**

2:10-3:50 p.m. **Electrical, Telecom and Software Patent Law Update**

2:10-2:25 p.m. **Patent Eligible Subject Matter in Software Inventions Post-Bilski**

Gregory Murgia, Alcatel-Lucent, Murray Hill, NJ

2:25-2:40 p.m. **Claim Construction and the DOE in the Electrical Arts**

Michele Conover, Siemens Corporation, Princeton, NJ

2:40-2:55 p.m. **Obviousness of Software and Electrical Inventions Post-KSR**

Jon A. Chiodo, Hoffmann & Baron, Parsippany, NJ

2:55-3:10 p.m. **Joint Infringement of Claims Drawn to Method and System Inventions**

Davy E. Zonerach, Lerner, David, Littenberg, Krumholtz & Mentlik, Westfield, NJ

3:10-3:25 p.m. **Apportionment of Patent Infringement Damages on Electrical Inventions**

Anthony S. Volpe, Volpe and Koenig, Philadelphia, PA

3:25-3:40 p.m. **Technical Standards and Patents - Conceptions and Myth Conceptions**

Marc Sandy Block, IBM Corporation, Armonk, NY

3:40-3:50 p.m. **Q and A**

3:50-4:00 p.m. **Break**

4:00-5:10 p.m. **Litigation of Electrical, Telecom and Software Patents Before the USITC**

4:00-4:30 p.m. **A View from the Bench**

Honorable Robert K Rogers, Jr., Administrative Law Judge, USITC, Washington, DC

4:30-4:45 p.m. **Practical Realities of Litigating Patents on Electrical Inventions in the ITC**

Mark J. Abate, Goodwin Procter, New York, NY

4:45-5:00 p.m. **Proving a "Violation" in the ITC**

Tony V. Pezzano, Cadwalader, Wickersham & Taft, New York, NY

5:00-5:10 p.m. **Q and A**

5:10-5:15 p.m. **Closing Remarks**

Robert E. Rudnick, Gibbons, Newark, NJ

Mark J. Abate

Mark Abate is a partner in the law firm of Goodwin Procter in New York and is a member of its Patent Litigation Practice. Mr. Abate is the Treasurer of the New Jersey Intellectual Property Law Association and recently served President of the New York Intellectual Property Law Association. He has been continually recognized by Chambers USA, *Who's Who in American Law* and *The Best Lawyers in America* as one of the nation's foremost patent lawyers. The *Chambers USA; America's Leading Lawyers for Business* provides Mr. Abate is "a true gentleman and a fantastic trial lawyer" and "is sought after for his lengthy experience before the ITC." He concentrates his practice on trials and appeals of patent infringement cases, and has particular expertise in electronics, electrical devices, computers, computer software, financial systems and medical devices. Mr. Abate has tried cases to their successful conclusions in U.S. district courts and the U.S. International Trade Commission and has argued appeals before the U.S. Court of Appeals for the Federal Circuit. He began his career as a law clerk for Chief Judge Howard T. Markey of the U.S. Court of Appeals for the Federal Circuit and also worked as a patent examiner at the U.S. Patent and Trademark Office.

Marc Sandy Block

Marc Sandy Block is a counsel at IBM Corporation's Intellectual Property Law headquarters, working in the areas of patent and technology licensing, standards and patent pool activities, administrative and legislative policy, and IP-related bankruptcy issues. He was a major contributor to the ABA Standards Development Patent Policy Manual and has authored numerous articles. He has spoken at AIPLA and other organizations on various topics. He was recently a panelist on the FTC Workshop on Patent Holdup. He was a Board member and past President of the International Intellectual Property Society in New York City (iipsny.org), is a member of the American National Standards Institute (ANSI) IPR Committee and AIPLA and IPO Standards Committees, is a Certified Licensing Professional, and is a lecturer on IP licensing and standards at the Cardozo Law School. He is a graduate of Lehigh University (BSEE) and George Washington University Law School (JD), and is a member of the Virginia, Maryland, and New York bars and is admitted to practice before the USPTO.

Jon A. Chiodo

Jon Chiodo is an associate at the firm of Hoffmann & Baron. A lecturer and author, his work has appeared in the New York Intellectual Property Law Association Bulletin, Joint Patent Practice seminar, and Metropolitan Corporate Counsel. Mr. Chiodo has extensive experience in litigation as well as prosecution of patent and trademark matters. Fields of technology include the chemical and pharmaceutical arts and medical devices.

Michele Conover

Michele Conover is Senior Counsel with Siemens Corporation and has represented the U.S. Research and Technology group based in Princeton, N.J. for the past eight years. Ms. Conover is responsible for developing worldwide patent strategies, drafting and negotiating research and development agreements with universities and other third parties, reviewing and administering government research contracts and other intellectual property based transactions. Ms. Conover has worked in a variety of technologies including medical imaging, industrial controls, and computer software. In addition, for the past three years, Ms. Conover has acted as Corporate Counsel for the Research and Technology Group. Her responsibilities include managing all legal matters including tax, employment, export and global transactional issues in addition to her IP responsibilities.

Prior to joining Siemens, Ms. Conover spent 10 years as in-house counsel at AT&T. At AT&T, Ms. Conover concentrated on the preparation and prosecution of telecommunications and software patent applications, patent infringement and validity studies as well as litigation support and management. Ms. Conover began her career as a patent examiner at the US Patent and Trademark Office.

Ms. Conover is a member of the New Jersey Bar and admitted to practice before the U.S. Patent and Trademark Office. Ms. Conover received a B.S. in Electrical Engineering and a J.D. from Rutgers University.

James Dwyer

Jim Dwyer has been with the U.S. Patent and Trademark Office for over 33 years. He has served as a Patent Examiner, Supervisory Patent Examiner, Quality Assurance Specialist and Group Director in a variety of electrical technologies. His current position is the Assistant Deputy Commissioner for Patent Operations overseeing the operations of Technology Center 2600 (Telecomm) and Technology Center 2800 (Circuits, Semiconductors and Physics). For many years, Jim has been instrumental in the USPTO's Patent Examiner recruitment and training programs; and is currently managing the Office's Patent Process Reengineering initiative. He has a BSEE from the University of Maryland.

Joel Miller

Joel Miller has been engaged in the practice of law for over thirty years, specializing in patent, trademark, copyright, unfair competition, and antitrust law, and established his solo practice in 1991. He served as a patent examiner in the U.S. Patent and Trademark Office, and as patent counsel for an aerospace division of the former Singer Company, and was associated with the law firm of Weil, Gotshal & Manges.

Mr. Miller has litigated intellectual property, antitrust, and commercial matters and has served as an arbitrator in a patent licensing dispute. In addition, he has secured patents, trademarks, and copyrights, and has negotiated intellectual property licenses and related agreements. He has worked in a variety of technologies including telecommunications, semiconductors, avionics, medical electronics, and computer hardware and software.

Mr. Miller is chair of the Inter Partes Review Subcommittee of the Post Grant and Inter Partes Patent Office Practice Committee of the ABA Section of Intellectual Property Law, and co-chair of the Patents and Legislative Affairs Subcommittee of the AIPLA Electronic and Computer Law Committee. Previously, he held leadership positions in ABA and AIPLA subcommittees focusing upon patentable subject matter, and was a member of the Task Force Subcommittee on Business Method Patents of the ABA Section of Intellectual Property Law.

Mr. Miller is a member of the District of Columbia, New Jersey, and New York Bars, admitted to practice before the U.S. Patent and Trademark Office, and a Fellow of the American Bar Foundation. Mr. Miller received a B.S. in Electrical Engineering from Lafayette College in 1975 and a J.D. from the University of Miami in 1978.

Gregory Murgia

Gregg Murgia is Senior Corporate Counsel & Director of Patent Creation for the Americas Region of Alcatel-Lucent. He has been in this position since the merger of Alcatel and Lucent Technologies (Bell Laboratories) in 2006. In this role, he is responsible for overseeing all patent creation and prosecution activities associated with building a global patent portfolio spanning the various technology areas of Alcatel-Lucent's business divisions and Bell Laboratories research activities. Mr. Murgia joined Lucent Technologies (Bell Laboratories) in 1997 and held various positions. As Corporate Counsel, he provided legal counsel and patent creation support for the Optical Networking Business Unit and Bell Labs Photonics Research group, which included the preparation and prosecution of patent applications, providing assertion support and counsel on various licensing activities. He was also a Director of Business Development in the Intellectual Property business for 3 years and managed a team of technical and business professionals responsible for identifying and developing patent licensing opportunities.

Before joining Lucent Technologies, Mr. Murgia was an Associate in the Intellectual Property Department of Crummy, Del Deo, Dolan, Griffinger & Vecchione. Prior to practicing law, Mr. Murgia was an officer in the U.S. Army Signal Corps serving in various capacities with assignments in the U.S, Germany and Saudi Arabia. He also worked for the U.S. Government as an engineer in the software engineering department at Fort Monmouth, New Jersey, working primarily on software development and testing for military telecommunication systems. Mr. Murgia received his law degree from the Seton Hall Law School and his undergraduate degree (B.S. Electrical Engineering) from the University of Notre Dame. He is admitted to practice in New Jersey, New York and before the U.S. Patent & Trademark Office.

Tony V. Pezzano

Tony Pezzano is a partner in the Intellectual Property Practice Group of the law firm Cadwalader, Wickersham & Taft LLP. Tony has more than 20 years of experience litigating many successful large scale patent cases in the Federal District Courts, in both jury and bench trials, the United States International Trade Commission (“ITC”) and the Court of Appeals for the Federal Circuit. He has represented major clients, including Hoffmann-La Roche, Merck, IBM, Ericsson, Sony Ericsson, Heidelberger, Cannon Avent, Bombardier, Procter & Gamble, ARCO, Chevron, ExxonMobil, Shell Oil and Texaco, in a wide range of technology areas, including pharmaceutical products, chemical and petroleum products and processes, wireless telecommunication equipment, computer systems, printing engines and systems, consumer products and recreational products. Tony is a frequent lecturer, having spoken throughout the United States, as well as in China and Europe, and author on patent litigation. He has been consistently selected as a New York Super Lawyer, which names the top 5 percent of attorneys in New York City chosen by their peers and through the independent research of Law & Politics. Tony was also recently selected for the Montclair Who’s Who directory of industry leaders from around the world and by 2011 US Legal 500 and 2011 IAM Magazine as a top tier patent litigator and ITC practitioner. Tony is the past President 2009 of the ITC Trial Lawyers Association and is also a member of the American Intellectual Property Law Association and New York Intellectual Property Law Association.

Judge Robert K. Rogers, Jr.

Judge Rogers was appointed as an Administrative Law Judge at the US International Trade Commission on July 6, 2008. Before his appointment at USITC, Judge Rogers served as an Administrative Law Judge with the Office of Medicare Hearings and Appeals (2007-2008), the Federal Energy Regulatory Commission (2005-2007) and the Office of Hearings and Appeals, Social Security Administration (1994-2005).

Rogers was the City Attorney of the City of South San Francisco, California from 1980 to 1986, where he participated in the negotiation and drafting of the habitat conservation plan that was used as the prototype for federal environmental regulations currently in effect to protect endangered species. Rogers subsequently practiced as a solo attorney, emphasizing litigation in land use, real property, redevelopment and environmental law, practicing in state and federal trial and appellate courts. Immediately prior to entering service as an Administrative Law Judge, he was Assistant City Attorney for the City of Thousand Oaks, California, where he was the chief litigator for that City.

Rogers retired in 1995 as a Captain in the U.S. Naval Reserve, Judge Advocate General's Corps. From 1977 to 1980 he served on active duty as the Staff Judge Advocate for Naval Air Station, Key West, Florida. He served as a medic in the U.S. Army from 1962-1968, including service in the Republic of West Germany, the Republic of Korea and the Republic of Vietnam. From 1968-1974, Judge Rogers was a Police Officer with the City of San Diego Police Department.

Judge Rogers earned a Juris Doctor degree in December 1976 at Brigham Young University's, J. Reuben Clark School of Law. He holds a Bachelor of Arts Degree in Public Administration from San Diego State University. Rogers is an active member of the State Bar of California, a member of its Intellectual Property Section, and a member of the Giles S. Rich American Inn of Court. Judge Rogers is admitted to practice in the U.S. District Courts for the Northern and Eastern Districts of California and the U.S. Court of Appeals for the Ninth Circuit. He was trained at the National Judicial College as a mediator.

Robert E. Rudnick

Robert Rudnick counsels clients in a wide variety of intellectual property matters including patent procurement and portfolio development strategies, generating value from patent portfolios, patent and technology licensing, patent clearance studies, patent non-infringement/invalidity evaluations and opinions, corporate mergers and acquisitions and patent prosecution, especially in the medical device and telecommunication technologies. In addition, Mr. Rudnick has significant business and legal experience in negotiating and providing counsel with intellectual property-based transactions. He has also counseled and defended clients from other aggressive patent licensing entities such as non-practicing entities (a/k/a Patent Trolls). He spent time in various in-house roles at AT&T and subsequent spin-off companies Lucent Technologies and Avaya Inc. before joining Gibbons.

At Avaya, Mr. Rudnick handled intellectual property issues important to Avaya's domestic and multi-national technology businesses, both in the manufacturing or services business sectors. His practice directly affected governance and operation of Avaya's business and included developing intellectual property policies concerning software, patent and trademark filing, mergers and acquisitions, divestitures, investor relations, and employee hiring, resignations and dismissals. Mr. Rudnick guided the establishment of Avaya's positions governing the activities of its representatives before standards bodies, negotiated intellectual property aspects arising in domestic and international sales and services agreements, including intellectual property defense and indemnification provisions, intellectual property ownership and Open Source software. Mr. Rudnick also provided advice and counsel regarding patent and trademark procurement strategies to leverage and protect the corporation's intellectual property assets as well as defending Avaya from allegations of patent infringement.

Before joining Avaya, Mr. Rudnick was a member of Lucent Technologies' Patent Assertion Team which received favorable notoriety in the article: "Soldiers of Fortune," COM-American Lawyer's Corporate Counsel Magazine, pp. 10-18 (June 1998) for the revenues it generated based on Lucent's patent portfolio. In that role, he utilized experience in patent portfolio management, negotiation skills and knowledge of patent prosecution and domestic and foreign infringement laws to provide patent assertion and licensing support in negotiating domestic and international patent license agreements.

Mr. Rudnick is the Vice President of the New Jersey Intellectual Property Law Association. He received his law degree from Rutgers University School of Law and undergraduate degree from Rutgers College of Engineering.

Anthony S. Volpe

Tony is a founding shareholder in Volpe and Koenig, P.C. He has corporate and private practice experience in all aspects of intellectual property rights. His current practice focuses on client counseling and the development of an IP strategy that yields the best value from the client's IP and, to the extent possible avoids the IP rights of third parties. When needed, Tony negotiates inter parte matters, and provides seasoned representation in state and federal litigation and before administrative agencies including the International Trade Commission, Office of Unfair Competition and the United States Patent and Trademark Office. Tony is also experienced in foreign intellectual property matters, including litigations, administrative proceedings, and licensing of territorial and global rights. He routinely conducts intellectual property due diligence reviews for domestic and foreign transactions.

Tony is admitted before the Supreme Court of Pennsylvania, the United States Supreme Court, the U.S. Courts of Appeals for the Federal, Third and Fourth Circuits, the U.S. District Court for the Eastern District of Pennsylvania and the U.S. District Court for the Eastern District of Michigan. Tony is a registered patent attorney admitted to practice before both the United States Patent and Trademark Office and the Canadian Patent Office.

Tony is a frequent presenter at intellectual property seminars and was a Scholar-in-Residence for Legal Studies at Temple University's Fox School of Business. Tony is often recognized for his intellectual property law practice. He has been recognized by *Super Lawyers* (2005-2011), *Best Lawyers* (2007-2012) and named a "Leader in the Field" by *Chambers USA* (2009 - 2011). Tony celebrates 10 years of being rated AV Preeminent by Martindale-Hubbel.

Davy E. Zoneraich

Davy E. Zoneraich, of counsel, Lerner, David, Littenberg, Krumholz & Mentlik, LLP, advises clients on all aspects of intellectual property law. He concentrates in the preparation and prosecution of patent and trademark applications, patent infringement and validity studies, and counseling on domestic and international transactions including licensing arrangements, joint ventures, acquisitions and divestitures, due diligence and non-disclosure agreements.

Mr. Zoneraich has extensive experience in the prosecution of patents involving medical devices, optical fiber and electric power components and systems, e-commerce and Internet business methods, data signal transmission over electrical and optical signal networks, data servers, video and digital signal processing, and electromechanical devices. Additionally, he counsels clients on enforcement of patent rights, and has been involved in patent infringement actions involving biomedical instrumentation and consumer electronics. Prior to becoming an attorney, Mr. Zoneraich worked for two years in the defense electronics industry.

Mr. Zoneraich is a Past President of the New Jersey Intellectual Property Law Association. He received his law degree from Rutgers University School of Law and undergraduate degree (B.S. Electrical Engineering) from Cornell University. He is admitted to practice in New Jersey, New York and before the U.S. Patent & Trademark Office.