

Division of Chemistry & The Law  
2006 San Francisco Programming

CHAL

*J.J. Hasford, Program Chair*  
*Carl Lippenberger, Chair*

Moscone Center	Sun.	Mon.	Tues.	Wed.	Thurs.
The Many Faces of CHAL: Where Chemistry Meets The Law	A				D
Protection of Chemical and Pharmaceutical Intellectual Property: Patents and Trade Secrets	P				
Patent Issues in Academe and the Petroleum Research Fund (PRF) Grants **		A			
Disasters and Recovery		P			
The Lawyer is In: CHAL's Legal Assistance Network**		P			
Sci-Mix		E			
Alternative Dispute Resolution (ADR) for the Chemist			D		
Regulating Nanotechnology: Developing Stakeholder Consensus for Future Rulemaking by EPA, FDA, and OSHA			D		
Recent US Supreme Court Cases in Patent Law				A	
Best Practices in Identifying, Protecting, and Managing Your Intellectual Property Portfolio				P	
Protecting Chemical Intellectual Property from Bench to Bench				P	

\*\* Primary Organizer of Co-Sponsored Symposium

A (AM)    D (AM/PM)    P (PM)    E (Evening)

### From the Program Chair:

The Division of Chemistry and the Law is currently accepting papers and symposia for the 233<sup>rd</sup> National Meeting of the American Chemical Society, to be held March 25-29, 2007, in Chicago, IL. CHAL welcomes submissions on all legal topics impacting the chemical sciences, including, but not limited to, intellectual property, patents, copyrights, trademarks, trade secrets, contract law, employment agreements, professional ethics and liability, product liability, tort law, expert witnesses, chemical consulting, chemical health and safety, chemical information, forensic chemistry, food and drug law, regulatory law, administrative law and rule making, biotechnology, pharmaceuticals, licensing and technology transfers, environmental safety, and litigation. Beginning August 28, 2006, please submit abstracts for individual presentations or Sci-Mix posters on the ACS Online Abstract Submittal System at <http://oasys.acs.org/oasys.htm> under the session entitled "The Many Faces of CHAL: Where Chemistry Meets the Law." For submission of half-day or full-day symposia with multiple speakers, please contact Program Chair Justin Hasford at [Justin.Hasford@finnegan.com](mailto:Justin.Hasford@finnegan.com).

*In addition, if you are willing to assist the CHAL Executive Committee in planning and coordinating upcoming programming at the Chicago Meeting or the 234<sup>th</sup> National Meeting, to be held August 19-23, 2007, in Boston, MA, please contact Justin Hasford at the above address.*

## Abstracts & Speaker Information—Sunday, September 10, 2006

### The Many Faces of CHAL: Where Chemistry Meets the Law

**Law Enforcement and Society can Benefit from Greater Transparency in Controlled Drug Analyses.** *Vedoster Ingram, Forensic Controlled Drug Group, Vingram Enterprises Ltd, PO Box 11047 Washington, DC 20008-0247, Fax: 202-667-3134.*

*vingram@vingramenterprisesltd.com, Phone: 202-257-3558*

Concerns are presented from the perspective of a former Drug Enforcement Administration chemist and a practicing forensic chemist consultant about the shortcomings that law enforcement and society face with both the lack of transparency and credibility in the government analyses of controlled drugs. Balanced advocacy of confiscated drug cases in the courts appears greatly affected by successful challenges to government alleged controlled drug cases. In efforts of providing security and safety to the public from confiscated contraband, law enforcement and government laboratories have developed credibility issues.

**Opinions of Counsel and Their Use in Business Strategy.** *Jitendra Malik, Alston & Bird LLP, Bank of America Plaza, 100 South Tryon Street, Suite 4000, Charlotte, NC 28280, Fax: 704-444-1111, jmalik@alston.com, Phone: 704-444-1115*

A business entity that fails to take action when notified that a product it plans to market or produce potentially infringes a U.S. patent misses an opportunity to save considerable expense and legal troubles. Prudent action may result in avoiding wasted research and development costs, marketing expenses, litigation expenses, and up to three times actual damages if infringement is found. This presentation discusses when and why to seek Opinions of Counsel, the requirements for a successful opinion, and an opinion's use in business strategy.

### Defensive Publications: Building a Wall Around Your IP

*Sandra Thompson, Buchalter Nemer, 18400 Von Karman Ave, Suite 800, Irvine, CA 92612. sthompson@Buchalter.com, Phone: 949-224-6282*

Defensive publications complete a total coverage strategy for intellectual property. We will discuss the various types of defensive publications, how to create complete and meaningful defensive publications and what they can do to help build a wall around your patent portfolio.

### Prosecuting Claims to Protein Crystals

*Richard G. A. Bone, Fish and Richardson, PC, 500 Arguello Street, Suite 500, Redwood City, CA 94063. richardbone@fr.com, Phone: 650-839-5070*

Although advances in protein crystallography mean that thousands of crystal structures are determined each year, we have not yet seen a deluge of patents that claim crystalline forms of proteins. I will review the applicable criteria for patentability, and the various pitfalls that can arise during prosecution of patent applications in this area.

### Maximizing Patent Protection in a Chemical Patent Application

*Sandra Thompson, Buchalter Nemer, 18400 Von Karman Ave, Suite 800, Irvine, CA 92612. sthompson@Buchalter.com, Phone: 949-224-6282*

Chemical patent applications and patents span the spectrum of being too specific to being unenforceable because of overbroadening. It is important to find a middle ground in drafting the patent application, while working to get the most patent coverage possible. We will discuss strategies for maximizing patent protection for chemical patent application. In addition, the USPTO proposed rules will be discussed, especially with respect to how they may apply to chemical patent applications.

### Protection of Chemical and Pharmaceutical Intellectual Property: Patents & Trade Secrets

#### Introductory Remarks

*Justin J. Hasford, Finnegan, Henderson, Farabow, Garrett and Dunner LLP, 901 New York Avenue, NW, Washington, DC 20001, Fax: 202.408.4400, Justin.Hasford@finnegan.com, Phone: 202.408.4000*

This symposium will explore patent and trade secret protection of chemical and pharmaceutical intellectual property in the United States. Trends in patent litigation and prosecution will be explored, and patent protection will be compared with trade secret protection. Trade secret litigation also will be discussed. The symposium will conclude with a panel discussion and Q&A session.

#### Introduction to Patent Litigation in the United States

*Justin J. Hasford, Finnegan, Henderson, Farabow, Garrett and Dunner LLP, 901 New York Avenue, NW, Washington, DC 20001, Fax: 202.408.4400, Justin.Hasford@finnegan.com, Phone: 202.408.4000*

Whoever without authority makes, uses, offers to sell, sells, or imports into the United States any patented invention infringes the corresponding patent. In an infringement suit, the trial court construes the scope of the patent claims, and then the fact finder applies that claim construction to the accused product or process. An infringement analysis includes both literal infringement and infringement under the doctrine of equivalents, as limited by prosecution history estoppel. Typical defenses advanced by the alleged infringer in a patent litigation include noninfringement of the patent in suit, patent invalidity, and unenforceability for inequitable conduct. Both damages and injunctive relief are available as remedies to a successful patent owner. This presentation discusses these major issues surrounding the substance and procedure of a patent infringement lawsuit.

#### Trends in Patenting: Recent developments at the U.S. Patent and Trademark Office.

*Charles E. Van Horn, Finnegan Henderson Farabow Garrett & Dunner, LLP, 901 New York Avenue, NW, Washington, DC 20001-4413, charles.vanhorn@finnegan.com, Phone: 202.408.4000*

This presentation will examine recent developments in United States Patent Office practice and procedure particularly of interest to those involved in the chemical and pharmaceutical arts.

#### Trade Secret vs. Patent Protection: Which is better for you?

*Griffith B. Price Jr., Finnegan Henderson Farabow Garrett & Dunner, LLP, 901 New York Avenue, NW, Washington, DC 20001-4413, griff.price@finnegan.com, Phone: 202.408.4000*

This presentation will compare two important forms of intellectual property protection, namely patents and trade secrets. Areas of consideration will include source of law, subject matter, prerequisites for protection, geographic scope, requirement for disclosure, scope of protectable rights, duration, cost, potential loss of rights, litigation considerations, and remedies.

#### Trade Secret Litigation: Actions for Misappropriation of Proprietary Information.

*Erik R. Puknys, Finnegan, Henderson, Farabow, Garrett & Dunner LLP, 3300 Hillview Avenue, Palo Alto, CA 94304, erik.puknys@finnegan.com, Phone: 650.849.6600*

This presentation will explore trade secret litigation in the United States. Substantive and procedural aspects will be discussed, and remedies for misappropriation of proprietary information will be considered.

## Abstracts & Speaker Information—Monday, September 11, 2006

### Patent Issues in Academe and the Petroleum Research Fund (PRF) Grants

**Intellectual Property and the ACS Petroleum Research Fund**  
**W. Christopher Hollinsed**, Office of Research Grants, American Chemical Society, 1155 16th Street, NW, Washington, DC, DC 20036, Fax: 202-872-6319, Phone: 202-872-6207

The Petroleum Research Fund was created in 1944 by seven major oil companies who wanted to avoid a potential anti-trust action by the federal government. The income from the Fund was designated to be used "...exclusively for advanced scientific education and fundamental research in the petroleum field...". The Fund which is now part of the American Chemical Society has written into the transfer agreement which legally governs the fund, an intellectual property clause which requires the "any patent taken out...shall be immediately dedicated to the public, royalty free." This talk will map out the difficulties and benefits of living with such trust language and highlight areas where change may be needed.

**The Bayh-Dole Act at 25 Years.** **Alan Ehrlich**, Weiss & Moy, PC and Rabin & Berdo, PC, 1101 14th Street, NW, Washington, DC 20005, Fax: 301-365-0246, ehrlichpolin@comcast.net, Phone: 301-365-0246

Prior to 1980, the Federal government rarely commercialized inventions made with government funding. In many agencies, the government retained ownership but in most cases did not obtain patents or move the inventions into the marketplace. The Bayh-Dole Act of 1980, as well as its expansions, Executive Order 12591 and the Federal Technology Transfer Act, changed the Federal government's approach. Now, grantees, contractors, and Federal laboratories could own their inventions and benefit from the royalties obtained. Since then, grantees, contractors, and Federal laboratories have been very successful in commercializing their technologies. Lessons learned from these successes will be discussed.

**Ninety-four Years of Funding Research.** **James M Gentile**, Research Corporation, 4703 East Camp Lowell, Suite 201, Tucson, AZ 85712, gentile@hope.edu, Phone: 520-571-1111

Research Corporation, established in 1912, is the second oldest foundation in the U.S. and the oldest foundation focused on funding scientific research and education. With an endowment of approximately \$150 million, Research Corporation disseminates about \$6 million annually to college and university researchers and educators through its grant programs. One of the original core missions of Research Corporation was to assist and enhance technology transfer at colleges and universities. This activity was divided in 1987 through the creation and spin-off of Research Corporation Technologies. This symposium talk will explore the implications of Research Corporation as an active foundation with limited resources and a large vision.

**75+ years of Success at WARF.** **Carl E. Gulbrandsen**, Wisconsin Alumni Research Foundation, 614 Walnut Street, Madison, WI 53726, carl@warf.org, Phone: 608-263-9395.

The Wisconsin Alumni Research Foundation (WARF) is the patent management organization for the University of Wisconsin-Madison. It is the recipient of the 2003 National Medal of Technology. WARF was nominated by ACS for that recognition. WARF is a non-profit, supporting organization of UW-Madison. Its mission since its founding in 1925 has been to support research at UW-Madison. Over its 75+ years of existence WARF has built an investment portfolio having market value in excess of \$1.5 billion. It also has an effective program for licensing technology arising from research at the UW-Madison. It uses earnings from the investment portfolio and its technology licensing to provide an annual gift to the UW-Madison which today exceeds \$50 million annually. The gift is intended to support further research at UW-Madison.

**Our Stanford Experience in Licensing Technology.** **Katherine Ku**, Technology Licensing, Stanford University, 1705 El Camino Real, Palo Alto, CA 94305, kku@stanford.edu, Phone: 650-723-0651

The Office of Technology Licensing is 35 years old - more than anything, we have learned that technology transfer is rarely easy. It remains a challenge to evaluate promising technologies, market them to appropriate potential licensees with the hope of finding a committed licensee, license them and then manage the long term, often unpredictable relationships between Stanford and industry. Our office mantra - "doing what's best for the technology" - guides every step we take.

**Where Do We Go From Here?** **David T. Smorodin**, American Chemical Society, 1155 Sixteenth Street, NW, Washington, DC 20036, d\_smorodin@acs.org, Phone: 202-872-4600

This portion of the Program will examine all facets of the history of the PRF as well as the legal challenges and opportunities of the future. Any discussion of the PRF should consider its history and the terms of its establishment. The PRF was established on October 26, 1944, when six oil companies executed a charitable trust agreement. By Agreement dated October 25, 2000, the assets of the PRF were transferred to the American Chemical Society, a congressionally chartered not-for-profit organization headquartered in the District of Columbia. The stated intent of the 2000 Agreement is "to create a fund to advance the public welfare in accordance with the laws of the District of Columbia...." The 2000 Agreement contains several terms that are of particular importance to this discussion. First, the American Chemical Society is required annually to fund one or more recipients, each of whom must be organized and operated exclusively for "charitable, scientific, or educational purposes...." No part of the net earnings of any recipient "may inure to the benefit of any private shareholder or individual...." Second, recipients of PRF funds must use all such funds "exclusively for advanced scientific education and fundamental research in the 'petroleum field,' which may include any field of pure science which in the judgment of the [ACS] ... may afford a basis for subsequent research directly connected with the petroleum field." Third, "[e]very patent ... that shall be taken out by or on behalf of any [recipient of PRF funds] ... shall be immediately dedicated to the public royalty free. Finally, any revisions to the 2000 Agreement must be reviewed by the United States Department of Justice and/or the Attorney General of the District of Columbia and, thereafter, approved by the Superior Court of the District of Columbia.

### Disasters & Recovery

**After the Storm.** **Garrett Brisbee**, Palo Alto Research Center, 3333 Coyote Hill Road, Palo Alto, CA 94306, info@parc.com, Phone: 650-812-4000

Hurricanes Katrina and Rita wreaked havoc on the Gulf Coast states in August-September 2005. Mr. Garrett Brisbee is with the Palo Alto Research Center (formerly XEROX PARC). He volunteers with a variety of non-profit organizations. Garrett has been involved with the Red Cross for many years. After seeing the devastation left by Hurricane Katrina, Garrett volunteered to go to Louisiana to help. He arrived a few days after Hurricane Rita hit. With all the publicity of the government response, see a first-hand account of what Garrett did in Louisiana and see his photos with the incredible stories behind them. Hear what the hurricane victims had to say how the responders responded to the changing scenarios of the continuing crisis and what lessons may be learned. This presentation is also found on the Internet at [http://www.parc.xerox.com/cms/get\\_article.php?id=518](http://www.parc.xerox.com/cms/get_article.php?id=518).

## Monday, September 11 (cont'd)-Tuesday, September 12, 2006

### The Lawyer is In: CHAL's Legal Assistance Network

**CHAL's Legal Assistance Network.** *Carl Lippenberger*, Lippenberger, Thompson, Welch, Soroko & Gilbert LLP, 201 Tamal Vista Boulevard, Corte Madera, CA 94925, [clippenberger@ltws.com](mailto:clippenberger@ltws.com), Phone: (415) 927-5200, Alan Ehrlich, Weiss & Moy, PC and Rabin & Berdo, PC, James C. Carver, Taylor, Porter, Brooks & Phillips, and Brian C. Meadows, Needle & Rosenberg, PC

As part of CHAL's new Legal Assistance Network for ACS members, this will be an informal drop-in session where questions can be asked of a panel of lawyers including, but not limited to, those listed above. These lawyers will be members of CHAL, available here without fee. Questions may be about any topic you desire: such as legal career options and about the law itself, including such areas as intellectual property, occupational health and safety, regulatory compliance, forensic science, product liability, toxic tort and environmental law. Questions may be of practical or theoretical interest. The discussions should be interesting, notwithstanding that correct answers are not guaranteed. This session will be of an informational and educational nature only. The considerations of questions asked cannot and will not be given in the context of any attorney-client relationship. Answers (if known) will not be given as legal advice.

### Sci-Mix

**Chocolate: Food of the Gods.** *Howard M. Peters*, Peters, Verny, Jones & Schmitt, LLP, 425 Sherman Avenue, Suite 230, Palo Alto, CA 94306, Fax: 650-324-1678, [peters4pa@sbcglobal.net](mailto:peters4pa@sbcglobal.net), Phone: 650-324-1677 X-103, and Sally Peters, Xerox-Parc

Chocolate (theobroma cocoa) as a processed food has been consumed for centuries. This poster will explore a brief history, processing, food values, structures of components, and some surprising facts (trivia) about chocolate - the food of the gods. See [www.howardpeters.net](http://www.howardpeters.net) under the Presentations link.

**National Inventors Hall of Fame Inductees 2006.** *Howard M. Peters*, Peters, Verny, Jones & Schmitt, LLP, 425 Sherman Avenue, Suite 230, Palo Alto, CA 94306, Fax: 650-324-1678, [peters4pa@sbcglobal.net](mailto:peters4pa@sbcglobal.net), Phone: 650-324-1677 X-103, and Sally Peters, Xerox-Parc

The National Inventors Hall of Fame in Akron Ohio ([www.invent.org](http://www.invent.org)) selects about 10 new inventors each year for induction into the Hall. This poster will provide a photograph, biography and some patent information for each 2006 inductee. The Induction ceremony occurred in mid-May 2006 in Akron.

### Alternative Dispute Resolution (ADR) For The Chemist Note: Held in 208/210 Moscone Conv. Center

**IP meets ADR at the AAA/ICDR.** *Dwight James*, American Arbitration Association, One Sansome Street, Suite 1600, San Francisco, CA 94104, [JamesD@adr.org](mailto:JamesD@adr.org), Phone: 415-981-3901

- AAA's domestic commercial arbitration rules
- AAA's Supplementary Rules for the Resolution of Patent Disputes
- ICDR's specialized international arbitration rules
- Customizing the ADR process to meet the needs of the IP client
- Administered versus Non-Administered
- Scope of the arbitration clause
- Subject matter expertise of the neutral
- Interim Emergency Relief
- Discovery
- Protective Orders
- Markman hearings.

**Domestic Arbitration.** *M. Scott Donahey*, Suite 171, 3790 El Camino Real, Palo Alto, CA 94022, [adr@scottdonahey.com](mailto:adr@scottdonahey.com), Phone: 650-823-0338

The United States has a strong tradition, case law, and statutory scheme that supports arbitration, including IP arbitration. Arbitration lends itself well to the pharma and biotech areas.

**International Arbitration.** *M. Scott Donahey*, Suite 171, 3790 El Camino Real, Palo Alto, CA 94022, [adr@scottdonahey.com](mailto:adr@scottdonahey.com), Phone: 650-823-0338

An international arbitration treaty ratified by all major trading companies of the world makes arbitration awards more readily enforceable than court judgments. Specialized arbitration rules protect confidentiality and provide for procedures tailored to the resolution of intellectual property disputes.

**Mediating the IP dispute.** *John A. Flaherty*, JAMS, 160 West Santa Clara Street, Suite 1600, San Jose, CA 95113, [jflaherty@jamsadr.com](mailto:jflaherty@jamsadr.com), Phone: 408-288-2240

Mediation is the most effective and efficient dispute resolution process available, particularly in IP matters; whether for preserving the ongoing business relationship of the parties, protecting their confidentiality, or providing for non-financial settlement terms. This session will explore and focus on the appropriate use of and timing for mediation, criterion for selecting the mediator, and preparing for the mediation.

**Effective Use of Discovery Referees.** *John A. Flaherty*, JAMS, 160 West Santa Clara Street, Suite 1600, San Jose, CA 95113, [jflaherty@jamsadr.com](mailto:jflaherty@jamsadr.com), Phone: 408-288-2240

Protracted litigation, voluminous and complex discovery disputes, and vying for dates on a judge's docket to hear and resolve the dispute. These are many of the issues litigators face within IP matters. This session will discuss the uses and benefits of Section 638 (Voluntary References), Section 639 (Involuntary References) and Fed. Rule. 53 (Special Masters) for general or limited discovery matters as well as for complete case resolution.

**The ICC International Court of Arbitration: Recent trends and developments.** *Nancy M. Thevenin*, ICC International Court of Arbitration, 1212 Avenue of the Americas, New York, NY 10036, [nthevenin@uscib.org](mailto:nthevenin@uscib.org), Phone: 212-703-5060

Since its creation in 1923, the ICC International Court of Arbitration has handled over 14,000 international cases. Over the years, ICC has developed a range of other dispute resolution rules, in addition to arbitration, and now offers a comprehensive package of dispute resolution services to meet the needs and challenges of international commerce today. During this session, participants will gain a greater understanding of the workings of the ICC Court and learn about current trends in the field of international dispute resolution.

**Discovery in Domestic and International Arbitration.** *Donald G. Lewis*, Chemical Patent Counsel, The Scripps Research Institute, 10550 North Torrey Pines Road, Mail Drop: TPC-8, LaJolla, CA 92037, Fax: 858-784-9399, [dlewis@scripps.edu](mailto:dlewis@scripps.edu), Phone: 858-784-2937

Discovery rules for domestic and international arbitration of IP disputes differ markedly. These differences can be outcome determinative. Recent developments regarding US and international arbitration discovery rules will be discussed.

## Tuesday, September 12—Wednesday, September 13, 2006

### Regulating Nanotechnology: Developing Stakeholder Consensus for Future Rulemaking by EPA, FDA and OSHA

**Monitoring Exposure to Airborne Engineered Nanomaterials: Requirements and Challenges.** *Andrew D. Maynard*, Woodrow Wilson International Center for Scholars, One Woodrow Wilson Plaza, 1300 Pennsylvania Avenue, NW, Washington, DC 20004, Fax: 202-691-4001, andrew.maynard@wilsoncenter.org, Phone: 202-691-4000

Engineered nanomaterials differ from many conventional materials in that their behavior is influenced by physical and chemical structure at the nanoscale. It follows that the health impact of some airborne nanomaterials may be influenced less by mass concentration, and more by characteristics such as particle size, shape, and surface properties. However, the challenges facing the development of exposure monitoring methods sensitive to these attributes are significant: Not only should alternative methods be cheap, robust and easy to apply; they will also need to be responsive to biologically significant particle characteristics throughout the respiratory system. Further research and development is needed if nano-specific exposure standards are to be developed and implemented.

**FDA Regulatory Considerations for Nanotechnology Products.** *Nakissa Sadrieh*, United States Food and Drug Administration, Building 21, Room 3524, 10903 New Hampshire Avenue, Silver Spring, MD 20993, Fax: 301-796-9734, sadriehn@cder.fda.gov, Phone: 301-796-1598

**The Effect of Nanotechnology on Manufacturing and the End Products: Who benefits?** *Peggy A. Brady*, Exponent, 39100 Country Club Drive, Farmington Hills, MI 48331, Fax: 248-324-9199, pbrady@exponent.com, Phone: 248-324-9102

There are endless opportunities to incorporate nanotechnology into manufacturing, but why the hesitation? If we prolong the life of an article several fold, have we just driven ourselves out of the business of making more? If we can increase the life of the production materials, will that effect the end product? And, in the course of making these changes, who is monitoring the quality and maintaining the quality control?

**Legal and Regulatory Implications of Emerging Nanotechnologies under TSCA and FIFRA: EPA's Two Product Approval Laws.** *Lynn L. Bergeson*, Bergeson & Campbell, P.C, 1203 Nineteenth Street, NW, Suite 300, Washington, DC 20036, Fax: 202-557-3736, lbergeson@lawbc.com, Phone: 202-557-3801

Chemical product approval laws bear a heavy burden as a result of emerging nanotechnologies. Federal agencies are scrambling to come up to speed in developing tools and methodologies to review and be positioned to approve, or credibly disapprove, new products based on nanotechnologies. This talk will provide an up-to-the-minute overview of program plans and offer a substantive summary of all you need to know to stay on top of this fast changing area.

**Assessment of Products Containing Nanomaterials.** *Joyce Tsujii* and Fiona Mowat, Exponent, 15375 SE 30th Place, Suite 250, Bellevue, WA 98007, Fax: 425-643-9827, tsujij@exponent.com, Phone: 425-519-8768

Risk assessment of nanomaterials in consumer products is an emerging challenge. In this presentation, we will discuss exposure, toxicity, and risk characterization.

**Safe nanotechnology: Implications and applications in the environment.** *Vicki L Colvin*, Department of Chemistry, Rice University, 6100 Main Street, MS-60, Houston, TX 77005, Fax: 713-348-2578, Phone: 713-348-5741.

Traditionally, nanotechnology has been motivated by the growing importance of very small ( $d < 50$  nm) computational and optical elements in diverse technologies. However, this length scale is also an important and powerful one for living systems. At Rice, we believe that the interface between the "dry" side of inorganic nanostructures and the "wet" side of biology offers enormous opportunities for medicine, environmental technologies, as well as entirely new types of nanomaterials. As part of our work on the potential biological applications, we also consider the unintended environmental implications of water soluble nanomaterials. Given the breadth of nanomaterial systems, we use a carefully selected group of model nanoparticles in our studies and focus on natural processes that occur in aqueous systems. We characterize the size and surface-dependent transport, fate and facilitated contaminant transport of these engineered nanomaterials. Models from larger colloidal particles can be extended into the nanometer size regime in some cases, while in others entirely new phenomena present themselves. We also consider biological interactions of nanoparticles and specifically address the interactions of a classic nanomaterial,  $C_{60}$ , with cellular systems. While the water-suspendable nano- $C_{60}$  nanocrystal is apparently cytotoxic to various cell lines, the closely related fully hydroxylated,  $C_{60}(OH)_{24}$ , is non-toxic, thus producing no cellular response. Similarly, we have also found that functionalized single-walled carbon nanotubes are non-toxic to cells in culture. More specifically, as the functionalization density of the SWNT increases, the nanotube becomes more inert to cultures.

**Regulating nanotechnology in the environment from a lawyer's perspective.** *Warren U. Lehrenbaum*, Pillsbury Winthrop Shaw Pittman, LLP, 2300 N Street, NW, Washington, DC 20037, Fax: 202-663-8007, warren.lehrenbaum@pillsburylaw.com, Phone: 202-663-8754

**Nanotechnology and the Toxic Substances Control Act.** *James Alwood*, United States Environmental Protection Agency, 1200 Pennsylvania Avenue, NW, Room 4351B, Mail Code 7405M, Washington, DC 20460, Fax: 202-564-9490, alwood.jim@epa.gov, Phone: 202-564-8974

### Recent US Supreme Court Cases in Patent Law

**How has the Supreme Court's 2002 decision in *Festo* affected prosecution?** *Richard G. A. Bone*, Fish and Richardson, PC, 500 Arguello Street, Suite 500, Redwood City, CA 94063, richardbone@fr.com, Phone: 650-839-5070

It's more than 4 years since the Supreme Court re-visited prosecution history estoppel, in *Festo*. Since then, numerous decisions in the Federal Circuit and lower courts have interpreted the Supreme Court's test in a variety of circumstances. I will review the most significant of these decisions and discuss their impact on claim drafting and prosecution strategy.

**Merck v. Integra.** *Karen I Boyd*, Fish and Richardson, PC, 500 Arguello Street, Suite 500, Redwood City, CA 94063, boyd@fr.com, Phone: 650-839-5070

Last year's decision in *Merck v. Integra* affirmed a broad exemption from patent infringement for research activities related to seeking regulatory approval. I will discuss the Supreme Court's decision and its impact on both patentees and those engaging in development of pre-clinical candidates.

## Abstracts & Speaker Information—Wednesday, September 13, 2006

**Labcorp v. Metabolite.** *Mary Ann Dillahunty*, Fish and Richardson, PC, 500 Arguello Street, Suite 500, Redwood City, CA 94063, dillahunty@fr.com, Phone: 650-839-5070

In Labcorp, the claims at issue cover a method of correlating a measured amino acid level in a subject with a vitamin B deficiency. The issue considered by the U.S. Supreme Court invokes far-ranging considerations of patentable subject matter. I will review the Court's decision and its likely impact on claim drafting for methods of medical diagnosis.

**eBay v. MercExchange: To enjoin or not to enjoin?** *Ping F. Hwung*, Fish and Richardson, PC, 500 Arguello Street, Suite 500, Redwood City, CA 94063, hwung@fr.com, Phone: 650-839-5070

The eBay case addresses the question of whether a patentee must be practicing the claimed invention in order to obtain an injunction against an accused infringer. I will review the Supreme Court's Opinion and discuss its ramifications for patentees in the chemical arts and life sciences.

**KSR v. Teleflex: How obvious is obvious?** *Richard G. A. Bone*, Fish and Richardson, PC, 500 Arguello Street, Suite 500, Redwood City, CA 94063, richardbone@fr.com, Phone: 650-839-5070

Although a new Supreme Court decision in the area of obviousness is still eagerly awaited, the KSR case highlights where the likely battleground will be. I will discuss the background to KSR and assess how a change in the obviousness standard might impact patenting in the chemical arts.

### Best Practices in Identifying, Protecting and Managing Your Intellectual Property Portfolio

**Options for Protecting Your Intellectual Property.** *Michael R. Albrecht*, Finnegan Henderson Farabow Garrett & Dunner, LLP, 3300 Hillview Avenue, Palo Alto, CA 94304, Fax: 650-849-6666, michael.albrecht@finnegan.com, Phone: 650-849-6600

This session will explore various options for protecting your intellectual property such as patents, trademarks, copyrights, and trade secrets. We will discuss how those distinct, but complementary, options can best be integrated to effectively protect your intellectual property.

**Identifying Inventions: Your Own and Those of Others.** *Gary J. Edwards*, Finnegan Henderson Farabow Garrett & Dunner, LLP, 3300 Hillview Avenue, Palo Alto, CA 94304, Fax: 650-849-6666, gary.edwards@finnegan.com, Phone: 650-849-6600

In this session, we will address the issue of identifying inventions from two perspectives. First, we will discuss capturing your own inventions. Then we will turn the tables and analyze how best to identify the inventions of your competitors, e.g., by examining third party rights and performing competitive intelligence.

**Protecting your intellectual property against third party infringers and third party patents.** *Robert F. McCauley III*, Finnegan Henderson Farabow Garrett & Dunner, LLP, 3300 Hillview Avenue, Palo Alto, CA 94304, Fax: 650-849-6666, robert.mccauley@finnegan.com, Phone: 650-849-6600

How best can you keep others from using your patented invention? Similarly, what can you do if others threaten to sue you for patent infringement? In this session, we will attempt to answer those questions and will discuss patent infringement, opinions of counsel, and declaratory judgment actions.

**Managing your intellectual property.** *Jean B. Fordis*, Finnegan Henderson Farabow Garrett & Dunner, LLP, 3300 Hillview Avenue, Palo Alto, CA 94304, Fax: 650-849-6666, Phone: 650-849-6600

You know that your intellectual property is a valuable asset. This session will focus on how best to manage your intellectual property to extract that value. Various licensing scenarios and considerations will be presented.

**Maximizing the Value of Your Intellectual Property.** *Lauren L. Stevens*, Finnegan Henderson Farabow Garrett & Dunner, LLP, 3300 Hillview Avenue, Palo Alto, CA 94304, Fax: 650-849-6666, lauren.stevens@finnegan.com, Phone: 650-849-6600

We will discuss how best to maximize the value of your intellectual property portfolio. Topics in this session will include organizing your portfolio and aligning it with your business as well as assessing IP value and risks.

### Protecting Chemical IP from Bench to Bench

**Reactions to the Dramatic New Patent Office Rules.** *Michael Hostetler<sup>1</sup>*, *Sandra Wells<sup>2</sup>*, and *Esther Kepplinger<sup>1</sup>*. (1) Wilson Sonsini Goodrich & Rosati PC, 12235 El Camino Real, Suite 200, San Diego, CA 92130, mhostetler@wsgr.com, Phone: 858-350-2306, (2) Affymetrix, Inc

Soon, the Patent Office will adopt sweeping new rules governing how it prosecutes and issues patents. The panel of industry insiders will assess how these changes could affect a company's patent portfolio for years to come and how companies can best brace for the expected impact.

**How to Catalyze Company Formation, Funding, and Acquisition.** *Vern Norviel*, Wilson Sonsini Goodrich & Rosati PC, 650 Page Mill Road, Palo Alto, CA 94304, vnorviel@wsgr.com, Phone: 650-320-4704, *Peppi Prasit*, Amira Pharmaceuticals, *John Brenner*, Cornell University Technology Transfer Office, and *Marcus F. Boehm*, Department of Medicinal Chemistry, Conforma Therapeutics Corp.

A panel of experts in commercializing chemical technology will address how a start-up company secures technology rights and grows by seeking early-stage investments or through partnering. The discussion will consider the best strategies in approaching and negotiating with universities, technology investors, and large company partners.

**Changing the Patent Legislation Base: How new reforms could affect your business.** *Jose C. Villarreal*, Wilson Sonsini Goodrich & Rosati PC, 8911 Capital of Texas Highway North, Westech 360, Suite 3210, Austin, TX 78759, jvillarreal@wsgr.com, Phone: 512-338-5424.

This presentation will assess how changes to the patent laws proposed by members of Congress may profoundly change the scope of patent rights and how patent rights can be enforced through litigation.

**A Formula for Success in Patent Litigation.** *Vicki G. Norton* and *Nicole W. Stafford*, Wilson Sonsini Goodrich & Rosati PC, 12235 El Camino Real, Suite 200, San Diego, CA 92130, Phone: 858-350-2305

The past year has seen a great deal of development in case law that affects the chemical industry. In light of these new rulings, this panel of chemical patent experts will address how chemical companies can best position their patents for court room success.

## Abstracts & Speaker Information—Thursday, September 14, 2006

### The Many Faces of CHAL: Where Chemistry Meets the Law

**Workplace Mobility: What Every Employer and Employee Should Know About Trade Secrets.** *Brian Range*, Wilson, Sonsini, Goodrich & Rosati PC, 8911 Capital of Texas Highway North, Westech 360, Suite 3350, Austin, TX 78759, brange@wsgr.com, Phone: 512-338-5400.

Unfortunately, it is quite common for former employees to improperly use their employer's valuable trade secret intellectual property, and it is also common for employers to incorrectly accuse former employees of stealing trade secrets. This presentation will provide legal background and advice for employers seeking to better protect their trade secrets and for employees hoping to smoothly transition to a new company without facing trade secret theft allegations.

**You really want to work with lawyers? What every scientist interested in becoming a litigation consultant or expert needs to know.** *Nicole W. Stafford*, Wilson Sonsini Goodrich & Rosati PC, 8911 Capital of Texas Highway North, Westech 360, Suite 3210, Austin, TX 78759-8497, Fax: 512-338-5499, nstafford@wsgr.com, Phone: 512-338-5400.

In today's world of highly technical litigation, particularly litigation involving patents, lawyers are often seeking out scientists to serve as technical experts and consult on technical issues. This presentation will provide an overview of the roles that scientists are often asked to play as consultants or testifying experts and will go through some of the applicable legal principles. This presentation will also provide tips for would be consultants/experts on the logistics of getting retained and some do's and don't's to keep in mind after being retained from a patent litigator's perspective.

**Meaningful Invention Disclosures and Using Them to Protect IP Assets.** *Sandra Thompson*, Buchalter Nemer, 18400 Von Karman Ave, Suite 800, Irvine, CA 92612, sthompson@Buchalter.com, Phone: 949-224-6282.

Whether your company is small or large, invention disclosures are an important tool for protecting IP assets. Invention disclosures come in many forms and can be used for documentation other than patent applications. We will discuss how to create meaningful invention disclosures - from the listing of the technology group to the problem to be solved.

**The continuing saga of *Madey v. Duke University*: Holding universities liable for patent infringement.** *Justin J. Hasford*, Finnegan, Henderson, Farabow, Garrett and Dunner LLP, 901 New York Avenue, NW, Washington, DC 20001, Fax: 202.408.4400, Justin.Hasford@finnegan.com, Phone: 202.408.4000.

In *Madey v. Duke University*, the U.S. Court of Appeals for the Federal Circuit reversed the trial court and held that Duke could not circumvent liability for patent infringement by invoking the common-law "experimental use" defense. On remand to the U.S. District Court for the Middle District of North Carolina, the trial court rejected Duke's motion for summary judgment on its defenses related to "governmental immunity" and set the case for trial. This presentation will examine the litigation between Dr. Madey and Duke and explore the circumstances under which universities may be held liable for patent infringement.

**How not to place your patent at risk: Recent developments in inequitable conduct law, and the duty of disclosure for inventors and patent practitioners.** *Peter Munson*, Wilson, Sonsini, Goodrich & Rosati PC, 12235 El Camino Real, Suite 200, San Diego, CA 92130, pmunson@wsgr.com, Phone: 858-350-2300.

In virtually every patent infringement lawsuit, the accused infringer argues the patent is unenforceable because it was obtained unfairly, or through inequitable conduct. This presentation will explain what actions taken (or not taken) by inventors and practitioners may ultimately cause a patent to be unenforceable, with a focus on inventors' and practitioners' duty to disclose certain information to the Patent and Trademark Office during the patent application process. The standards used to determine whether inequitable conduct has been committed - intent of the inventor or practitioner and materiality of the reference - will be reviewed and recent case law on inequitable conduct highlighted.

**Section 102 support services in Japan.** *Alan Engel*, Paterra, Inc, 526 N Spring Mill Road, Villanova, PA 19085-1928, Fax: 610-527-2041, aengel@paterra.com, Phone: 610-527-4500.

When faced with a patent infringement lawsuit, the first recourse of the accused party is usually to find what is called 102(a) or 102(b) prior art. This is invalidating prior art that has appeared in a printed publication in this or a foreign country either before the date of invention or more than one year before the date of application, respectively. Japan has a rich and expanding body of technology, yet it is often overlooked or downplayed in prior art searches by inventors and examiners. Searching the Japanese art is then a must for anyone needing 102(a) or 102(b) prior art. Paterra's newly opening office in Japan's Tsukuba Science City will be perfectly located for those searches that can best be done - or can only be done - in-country. This talk will describe the 102 support services and resources that Paterra will offer to the patent law community.

**What You Need to Know About Foreign Patent Prosecution.** *Sandra Thompson*, Buchalter Nemer, 18400 Von Karman Ave, Suite 800, Irvine, CA 92612, sthompson@Buchalter.com, Phone: 949-224-6282.

So you have a patent application in the United States or in the PCT process and you want to file it in foreign countries. Do you have a strategic and cost-effective foreign filing plan? Do you know how to maximize your patent budget in foreign countries? We will discuss these issues and others to help you and/or your company file patent applications globally. Europe, China, Japan, Korea, Taiwan, Singapore, Malaysia, Eastern Europe and Canada will be discussed in detail. In addition, handouts and summaries will be provided for these countries, along with others key filing areas, including Africa, South America and Australia.

**Worldwide Inventorship Issues.** *Sandra Thompson*, Buchalter Nemer, 18400 Von Karman Ave, Suite 800, Irvine, CA 92612, sthompson@Buchalter.com, Phone: 949-224-6282.

Inventorship issues dominate the landscape in patent prosecution and litigation, especially world-wide. We will discuss documentation of inventorship for the US and foreign countries, potholes that you may encounter when taking your application foreign, and current case law on inventorship issues.