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5 August 2010

ASPA – AIPLA SEMINAR

Working in conjunction with the American Intellectual Property Law Association and particularly the International Education Committee of AIPLA, we have organized an interactive, on-line seminar to be held at the offices of Ella Cheong Spruson & Ferguson (Singapore) Pte Ltd at 152 Beach Road #37-05/6 Gateway East Singapore 189721 on Wednesday 25 August 2010 commencing at 9.00 a.m. SHARP and will last for approximately 90 minutes.

Due to the costs involved there will be a small charge of S\$35 for each ASPA member who registers; and S\$85 for non-members. Non-members may wish to become members as it is S\$50 for associate membership. If the attached membership application form is sent with the registration form below the members' rate will apply for this and all ongoing ASPA seminars. The payment may be made before the seminar or at the seminar. Registrations should be sent to me by email (kcallinan@marks-clerk.com.sg) or by fax (62273898) and should be received by the close of business on Thursday 19 August 2010.

Please do not hesitate to send this to any person you believe may be interested in the seminar, even if they are not ASPA members.

This seminar will address two important topics that often raise issues for foreign associates who are faced with instructing their US counterparts during US prosecution.

First, the speakers will discuss determination of inventorship. In most cases, foreign associates are told by the client who the inventors are. However, whether the client's determination is accurate will depend on the degree of the competency of the people making the determination within the client. This is particularly relevant when dealing with research institutes and university-based inventions, for example, where there is a tendency to include a professor as a lead inventor because the professor is leading the research team. However, has the professor actually contributed to the invention? The speakers will address how to make a determination of inventorship under U.S. law, and the obligations on all foreign associates to do so, along with the consequences of getting the determination wrong. The determination of inventorship under US law is about ownership and the right to apply for a

patent. Get it wrong and the right to apply is not properly exercised. This may lead to invalidation, and punitive damages. If the fault lies with the Singapore patent agent, they could be facing a negligence claim. What happens if we accept the client's statements about the inventors without question? What is our responsibility and liability under US law?

Second, the speakers will discuss the current state of patentable subject matter in the U.S. On June 28, 2010, the U.S. Supreme Court decided *Bilski v. Kappos*, the long awaited patentable subject matter case. The speakers will discuss how the *Bilski* decision has changed (or not) the legal landscape for business methods, software, telecommunications, biotechnology, methods of treatment, and other patentable subject matter in the U.S., and present some practical suggestions for how to draft claims to reduce the likelihood of receiving a § 101 rejection during U.S. prosecution.

SPEAKERS:

Gary J. Speier is a registered patent attorney and shareholder with Schwegman, Lundberg & Woessner. His practice includes many facets of patent law, including patent preparation, prosecution, due diligence, opinion drafting, client counseling, clearance reviews and technology licensing and transfer agreements. Gary also counsels clients on legal issues relating to chemical and pharmaceutical patents, including patent enforcement, validity and infringement, licensing, collaborations, due diligence and business development. His experience in transactional matters for chemical and pharmaceutical clients includes IP due diligence. Gary has represented universities, non-profit research institutions, sole inventors, branded pharmaceutical companies as well as generic pharmaceutical companies. He has lectured on various topics including pharmaceutical patent life cycle management (LCM), IP licensing issues, Green technologies, as well as legal opinions to support Paragraph IV certifications for Abbreviated New Drug Applications (ANDA) under the Hatch-Waxman Act. Gary practices in the firm's home office in Minneapolis, Minnesota.

James D. Hallenbeck is a patent attorney also at Schwegman, Lundberg & Woessner and focuses on patent prosecution in various technology areas including complex computer software systems. Jim received a B.S. in Computer Information Systems from Chapman University in Orange, California (B.S., cum laude, 1998) and a Juris Doctorate from William Mitchell College of Law (J.D., 2004). Prior to joining the firm, Jim worked as a software engineer and analyst, designing and developing global software systems supporting a wide range of industries including financial services, automotive, and insurance.



Keith Callinan
President

**ASPA – AIPLA SEMINAR
REGISTRATION FORM**

Name:

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Payment of S\$ is attached/will be made at the seminar.