

American Conference Institute's 2nd National Forum on

# BUSINESS METHOD PATENTS

Protecting and Capitalizing on Innovations in the  
Financial Services, Software, and Insurance Industries

November 19-20, 2008 • The Helmsley Park Lane Hotel • New York City

## Network with industry leaders from:

- Accenture
- Cantor Fitzgerald
- Citigroup
- Hartford Financial Services
- IBM
- JPMorgan Chase
- Lehman Brothers
- Microsoft
- Morgan Stanley
- Oracle
- SAP
- Travelers
- UBS
- Visa

## MEDIA PARTNERS



## Obtain proven strategies and expert advice for:

- Employing new defenses against patent trolls in the wake of *Bilski*, *Comiskey*, and other recent cases
- Identifying patentable processes in your organization to maximize licensing opportunities
- Assessing the validity of your BMPs based on emerging court decisions and PTO regulations
- Putting a plan in place to protect your proprietary information in the absence of patentability
- Speeding up the prosecution process: tips for creating a PTO-friendly application
- Prior art searches: where to look when mining key resources—and when to stop

## DON'T MISS THE INTERACTIVE WORKSHOP

NOVEMBER 20, 2008

Drafting Techniques for Business Method Patent  
Applications: Strategies for Receiving a Patent  
Issuance Quickly and Efficiently



Register Now • 888-224-2480 • [AmericanConference.com/BMP](http://AmericanConference.com/BMP)

# BUSINESS METHOD PATENTS

Ten years after the landmark *State Street* decision, the Court of Appeals for the Federal Circuit is reconsidering just what is patentable subject matter and what is not. The Court's decision in *In re Bilski* will likely have a very significant impact on the financial services, software, and insurance industries due to the prevalence of business method patents in those industries. It is critical that corporate and outside counsel that handle patents for companies in these industries be prepared for the changes that *In re Bilski* and other recent decisions are bringing to all aspects of business method patents, from prosecution to litigation to licensing. Add to this the difficulties of prior art searches involving business method patents and looming Congressional patent reform legislation and it is clear that the challenges and opportunities in the area of business method patents have never been greater.

American Conference Institute's 2nd National Forum on Business Method Patents will bring together leading corporate IP and patent counsel from the financial services, software, and insurance industries as well as expert outside counsel to provide you with the knowledge, strategies, and insights that you need to:

- Successfully bring and defend against business method patent infringement claims
- Win the battle over the determination of damages
- Structure effective licensing agreements post-*Quanta*
- Establish and maintain ownership of intellectual property through alternatives to business method patents
- Use *inter partes* reexamination as an effective defensive tool
- Conduct accurate valuations of business method patents

Secure your place now for this must-attend event. You may register by calling 1-888-224-2480, by faxing your registration form to 1-877-927-1563, or by visiting us online at [www.AmericanConference.com/BMP](http://www.AmericanConference.com/BMP).

## DISTINGUISHED FACULTY

### CO-CHAIRS

**Moshe Malina**

Associate General Counsel & Chief Patent Counsel  
Citigroup

**Barry J. Schindler**

Co-Chair, Patent Prosecution Group, Greenberg Traurig, LLP

### SPEAKERS

**Nicholas Baggaley**

Senior Corporate Counsel, Oracle U.S.A., Inc.

**Steven M. Bauer**

Partner  
Proskauer Rose LLP

**Jeffrey A. Berkowitz**

Partner  
Finnegan, Henderson, Farabow, Garrett & Dunner, LLP

**Shailendra Bhumralkar**

Director, IP Portfolio Development, SAP

**Thomas S. Biemer**

Member, Dilworth Paxson LLP

**James M. Bollinger**

Partner  
Morgan, Lewis & Bockius LLP

**David E. Boundy**

Vice President, Assistant General Counsel  
Intellectual Property  
Cantor Fitzgerald L.P.

**Laurence Bromberg**

Executive Director and Patent Counsel  
Morgan Stanley

**Richard Brown**

IP Counsel, SAP

**Kathlyn Card Beckles**

Vice President & Assistant General Counsel  
Technology, Sourcing & Intellectual Property  
JPMorgan Chase Bank

**John Cronin**

Managing Director and Chairman, ipCapital Group

**Victoria A. Cundiff**

Partner, Paul, Hastings, Janofsky & Walker LLP

**David Cunningham**

Vice President, Assistant General Counsel  
& Director of Patent Law  
The Hartford Financial Services Group, Inc.

**Jubin Dana**

Global Head of Patent Management, Visa

**Gerald L. DePardo**

Intellectual Property Counsel, The Travelers Companies, Inc.

**William T. Ellis**

Partner, Foley & Lardner LLP

**Bill Harmon**

Associate General Counsel, Microsoft Corporation

**Mark P. Kesslen**

Member, Chair of the IP Group, Lowenstein Sandler PC

**Kerry L. Konrad**

Partner, Simpson Thacher & Bartlett LLP

**Charles Kwalwasser**

Vice President and Counsel, Intellectual Property  
Lehman Brothers

**Wayne P. Sobon**

Associate General Counsel, Director of Intellectual Property  
Accenture

**Steven J. Soucar**

Senior Counsel, Intellectual Property Law, IBM

**Robert A. Stewart**

Director and Chief Patent Counsel of Americas, UBS AG

**Jeffrey D. Sullivan**

Partner, Baker Botts L.L.P.

**Dirk D. Thomas**

Partner, Co-Chair IP Litigation Group  
and Life Sciences Practice, Dewey & LeBoeuf LLP



## ALUMNI

### Expand Your Network

The complimentary ACI Alumni Program is designed to provide returning delegates with unique networking and learning opportunities beyond the scope of their conference experience.

#### Highlights include:

- Search for and contact fellow Alumni
- Post a question or look for answers in our Industry Forums
- Join a live Industry Chat in progress
- Build your own community
- Earn Forum points towards free conferences & workshops

Expand your Network at [www.my-aci.com](http://www.my-aci.com)



DAY ONE:  
**WEDNESDAY, NOVEMBER 19, 2008**

8:30 Registration Opens and Continental Breakfast 

9:00 **Opening Remarks from Conference Co-Chairs**

**Moshe Malina**

Associate General Counsel & Chief Patent Counsel  
Citigroup

**Barry J. Schindler**

Co-Chair, Patent Prosecution Group  
Greenberg Traurig, LLP

9:15 **What is Patentable Now: The Current State of Patentable Subject Matter and the Viability of Business Method Patents**

**Laurence Bromberg**

Executive Director and Patent Counsel  
Morgan Stanley

**Robert A. Stewart**

Director and Chief Patent Counsel of Americas  
UBS AG

**Wayne P. Sobon**

Associate General Counsel, Director of Intellectual Property  
Accenture

**James M. Bollinger**

Partner  
Morgan, Lewis & Bockius LLP

**Thomas S. Biemer**

Member  
Dilworth Paxson LLP

- Impact of *Comiskey*, *Nuijten*, and *Bilski* on the future of BMPs
- What is patentable going forward and how are existing patents affected?
- The impact of *KSR*, *MedImmune*, *eBay*, and *Seagate* on business method patents
- Working with the USPTO in light of the evolving case law
- Congressional reforms under consideration and the likely effects that they will have on BMPs

10:45 Networking Coffee Break 

11:00 **Capitalizing on the Heightened Standards of Patentability and Recent Procedural Developments When Defending Against Business Method Patent Infringement Claims**

**Kathlyn Card Beckles**

Vice President & Assistant General Counsel  
Technology, Sourcing & Intellectual Property  
JPMorgan Chase Bank

**Charles Kwalwasser**

Vice President and Counsel, Intellectual Property  
Lehman Brothers

**Jeffrey A. Berkowitz**

Partner  
Finnegan, Henderson, Farabow, Garrett & Dunner, LLP

Moderator:

**Mark P. Kesslen**

Member, Chair of the IP Group  
Lowenstein Sandler PC

- Successfully arguing that a claimant's method or process is not patentable subject matter under the evolving caselaw
  - When claimant's subject matter consists only of mental processes
  - When claimant's subject matter has both mental and physical elements
- Using "obviousness" after *Comiskey* and *KSR* to defeat a BMP infringement claim
- Defending against willful infringement claims post-*Seagate*
- Implementing an aggressive and strategic plan for confronting BMP trolls
- Coordinating your defense with other troll targets
- Winning the battle over the determination of damages
- Impact of recent shifts in venue preferences

12:30 Networking Luncheon 

1:45 **Ensuring and Using Accurate Valuations of Business Method Patents**

**Jubin Dana**

Global Head of Patent Management, Visa

- Methodologies for accurately assessing the value of a potential BMP
- Incorporating the increased uncertainty of receiving an issuance into your cost/benefit analysis when making the decision to pursue a BMP
- Assessing the value of a pre-existing BMP
- Determining appropriate licensing fees to pay or require to be paid

2:30 **Obtaining and Negotiating Business Method Patent Licensing Agreements: Considerations for Licensors and Licensees**

**John Cronin**

Managing Director and Chairman  
ipCapital Group

**Kerry L. Konrad**

Partner  
Simpson Thacher & Bartlett LLP

- Licensor/licensee perspectives on where BMPs fit in licensing strategies
- Impact of *Bilski* on pre-existing licensing agreements
- Maximizing the utility of cross-licensing agreements
- Applying lessons learned from the tech licensing world to the financial services and insurance industries
- How BMP "risk factors" are different from most other patents in licensing
- Strategies for ensuring that a license stays in force
- Declaratory judgment – a new world
  - How to license in the wake of the new DJ Supreme Court rulings
- Factors to consider when determining whether to renegotiate a BMP licensing agreement
- Impact of *Quanta* on BMP licensing agreements
- Finding and exploiting new licensing opportunities

3:30 Afternoon Refreshment Break

**3:45**     **Protecting Your Portfolio: Identifying and Curbing Infringements of Your Business Method Patents**

---

**Moshe Malina**

Associate General Counsel & Chief Patent Counsel  
Citigroup

**Jeffrey D. Sullivan**

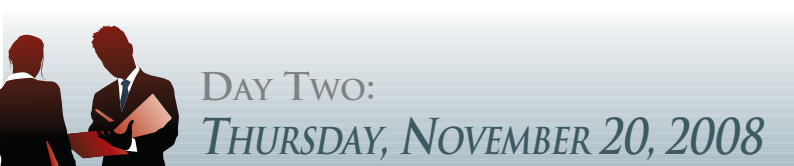
Partner, Baker Botts L.L.P.

**Dirk D. Thomas**

Partner, Co-Chair IP Litigation Group and Life Sciences Practice  
Dewey & LeBoeuf LLP

- Identifying potential infringements of your BMPs
- Deciding what action to take against a potential infringer:
  - Identity of the potential infringer
  - The cost-benefit calculus of pursuing potential infringers
  - Anticipated outcome of each course of action
- Ensuring that your BMPs withstand an “obviousness” defense after *Comiskey* and *KSR*
- Overcoming a non-patentable subject matter defense – what you must prove and how you prove it
- Making a successful claim of willful infringement in the wake of *Seagate*
  - Proving “objective recklessness” on the part of the defendant

**5:00**     Conference Adjourns for the Day



**8:30**     Registration Opens and Continental Breakfast 

**9:00**     **Recap and Remarks from Conference Co-Chairs**

---

**Moshe Malina**

Associate General Counsel & Chief Patent Counsel  
Citigroup

**Barry J. Schindler**

Co-Chair, Patent Prosecution Group  
Greenberg Traurig, LLP

**9:15**     **Streamlining the Business Method Patent Prosecution Process in the Wake of *Bilski*, *Comiskey*, and Other Recent Cases**

---

**David Cunningham**

Vice President, Assistant General Counsel & Director of Patent Law  
The Hartford Financial Services Group, Inc.

**Moshe Malina**

Associate General Counsel & Chief Patent Counsel  
Citigroup

**Steven J. Soucar**

Senior Counsel, Intellectual Property Law  
IBM

**William T. Ellis**

Partner  
Foley & Lardner LLP

**Barry J. Schindler**

Co-Chair, Patent Prosecution Group  
Greenberg Traurig, LLP

- Obtaining the information necessary to effectively prosecute a patent in light of the evolving scope of BMPs
- Drafting claims to include a “non-routine” technical component
- Using clear and explicit language that the patent examiner will understand
- Determining which documents should be submitted to the USPTO and which should not
- Responding to an Office action that finds that subject matter is not patent-eligible
- The recent expansion of the USPTO’s Peer Review Pilot to include business method patents
- Knowing where to look when conducting prior art searches – moving beyond the USPTO into professional journals, textbooks, articles, and other published materials
- Considerations when a prior art search reveals a potentially relevant pre-existing patent
  - Writing your claims around the claim boundaries of a pre-existing patent
  - Conducting a cost/benefit analysis of challenging the validity of an existing BMP
  - Using *inter partes* reexaminations as a defensive tool

**10:45**     Networking Coffee Break 

**11:00**     **Managing Business Method Patent Portfolios: Strategies for Identifying and Protecting Innovation**

---

**Shailendra Bhumralkar**

Director, IP Portfolio Development  
SAP

**Richard Brown**

IP Counsel  
SAP

**Gerald L. DePardo**

Intellectual Property Counsel  
The Travelers Companies, Inc.

**Steven M. Bauer**

Partner  
Proskauer Rose LLP

- Implementing a system for identification of patentable business methods
- Integrating BMPs into your patent portfolio
- Monitoring the industry:
  - Ensuring that you are aware of your competitors’ patents and how they impact you
  - Knowing which BMPs are being asserted against your competitors and using this information to your advantage

**12:00**     **Alternatives to Business Method Patents: Exploiting and Protecting Intellectual Property Without Obtaining a Patent**

---

**Nicholas Baggaley**

Senior Corporate Counsel  
Oracle U.S.A., Inc.

**Bill Harmon**

Associate General Counsel  
Microsoft Corporation



## Victoria A. Cundiff

Partner

Paul, Hastings, Janofsky & Walker LLP

- When obtaining patent protection may actually limit the value of your IP
- Enhancing the value of your IP through trade secret
- Ensuring that you own your proprietary trading strategies and other business methods
- Detecting and preventing trade secret misappropriation
- Strategies for avoiding the acquisition of trade secrets from competitors
- Benefits and limitations of non-disclosure agreements and non-compete clauses as a means of protecting business methods and processes
- When is disclosure of trade secrets “threatened” or “inevitable” and what can be done to reduce the risk of disclosure?
- Protecting trade secrets through “black box” monitoring and other creative remedies

1:00

Conference Concludes



## POST-CONFERENCE WORKSHOP THURSDAY, NOVEMBER 20, 2008

2:00 p.m. – 5:00 p.m. (Registration begins at 1:30 p.m.)

### Drafting Techniques for Business Method Patent Applications: Strategies for Receiving a Patent Issuance Quickly and Efficiently

#### David E. Boundy

Vice President, Assistant General Counsel

Intellectual Property

Cantor Fitzgerald L.P.

*Over the past few years, the number of business method patent applications filed each year has steadily increased. At the same time, the examination process in the Patent Office's business methods art units has become far less predictable. The broad view that originally prevailed after State Street may have been scaled back - or may simply be in an ongoing process of refinement. The pitfalls that destroy value for patents in all technologies have become more dangerous. Thus, it is more important now than ever before to be fully aware of the technological and legal issues in a business method patent; failure to do so will result in costly delays, loss of rights, or a worthless patent. In this interactive workshop, participants will learn the drafting strategies and techniques that will enable them to draft a business method patent application that will minimize delays, have a higher likelihood of approval, and command more value in the market. Participants will leave the workshop with the knowledge and insights needed to:*

- Accurately and effectively describe the business method or process
- Ensure that claims are directed to patent-eligible subject matter
- Avoid new obviousness challenges under KSR and *Comiskey*
- Draft applications to ease examination by the PTO
- Draft applications to maximize value and to overcome PTO reluctance to examine high-value applications

## WHO YOU WILL MEET

### Corporate Counsel and Executives including:

- IP Counsel
- Patent Counsel
- Chief Technology Officers
- Chief Information Officers
- General Counsel
- Patent Portfolio Managers

### Attorneys specializing in:

- Patents
- Intellectual Property

### IP Consultants

### Patent Agents

## CONTINUING LEGAL EDUCATION CREDITS



Accreditation will be sought in those jurisdictions requested by the registrants which have continuing education requirements. This *transitional* course is appropriate for both experienced and newly admitted attorneys.

ACI certifies that the activity has been approved for CLE credit by the New York State Continuing Legal Education Board in the amount of 11.0 hours. An additional 3.0 credit hours will apply to workshop participation.

ACI certifies that this activity has been approved for CLE credit by the State Bar of California in the amount of 9.5 hours. An additional 3.0 credit hours will apply to workshop participation.

ACI has a dedicated team who process requests for state approval. Please note that event accreditation varies by state and ACI will make every effort to process your request.

## GLOBAL SPONSORSHIP OPPORTUNITIES

ACI, along with our sister organization based in London, C5 Conferences, works closely with sponsors in order to create the perfect business development solution catered exclusively to the needs of any practice group, business line or corporation. With over 350 conferences in the United States, Europe, the Commonwealth of Independent States (CIS) and China, ACI/C5 Conferences provides a diverse portfolio of first-class events tailored to the senior level executive spanning multiple industries and geographies.

For more information about this program or our global portfolio of events, please contact:

#### Wendy Tyler

Group Leader & Business Development Executive

American Conference Institute

Tel: 212-352-3220 x 242

Fax: 212-220-4281

[w.tyler@AmericanConference.com](mailto:w.tyler@AmericanConference.com)

© American Conference Institute, 2008

Register now: 888-224-2480 • Fax: 877-927-1563 • [AmericanConference.com/BMP](http://AmericanConference.com/BMP)

American Conference Institute's 2nd National Forum on

# BUSINESS METHOD PATENTS

Protecting and Capitalizing on Innovations in the  
Financial Services, Software, and Insurance Industries

November 19-20, 2008 • The Helmsley Park Lane Hotel • New York City

## REGISTRATION FORM

### PRIORITY SERVICE CODE:

S

ATTENTION MAILROOM: If undeliverable to addressee, please forward to:  
Patent Counsel, Intellectual Property Counsel, General Counsel

CONFERENCE CODE: 693L09-NYC

☐ YES! Please register the following delegate for

**BUSINESS METHOD PATENTS**

NAME \_\_\_\_\_ POSITION \_\_\_\_\_

APPROVING MANAGER \_\_\_\_\_ POSITION \_\_\_\_\_

ORGANIZATION \_\_\_\_\_

ADDRESS \_\_\_\_\_

CITY \_\_\_\_\_ STATE \_\_\_\_\_ ZIP CODE \_\_\_\_\_

TELEPHONE \_\_\_\_\_ FAX \_\_\_\_\_

EMAIL \_\_\_\_\_ TYPE OF BUSINESS \_\_\_\_\_

FEE PER DELEGATE	Register & Pay by Sep 17 2008	Register & Pay by Oct 22, 2008	Register after Oct 22 2008
<input type="checkbox"/> Conference Only	\$1895	\$1995	\$2195
<input type="checkbox"/> Conference & Interactive Workshop	\$2495	\$2595	\$2795
<input type="checkbox"/> I would like to add ___ copies of the conference materials on CD-ROM to my order – \$299 each			
<input type="checkbox"/> I cannot attend but would like information regarding conference publications			
<input type="checkbox"/> Please send me information about related conferences			

### PAYMENT

Please charge my ☐ VISA ☐ MasterCard ☐ AMEX ☐ Please invoice me

Number \_\_\_\_\_ Exp. Date \_\_\_\_\_

Signature \_\_\_\_\_

(for credit card authorization and opt-in marketing)

☐ I have enclosed my check for \$ \_\_\_\_\_ made payable to  
**American Conference Institute (T.I.N.—98-0116207)**



Can be recycled

## DON'T MISS THE INTERACTIVE WORKSHOP

NOVEMBER 20, 2008

**Drafting Techniques for Business  
Method Patent Applications:  
Strategies for Receiving  
a Patent Issuance Quickly  
and Efficiently**

### 5 Easy Ways to Register



**MAIL** American  
Conference Institute  
41 West 25th Street  
New York, NY 10010



**PHONE** 888-224-2480



**FAX** 877-927-1563



**ONLINE** AmericanConference.com/BMP



**EMAIL**  
CustomerService  
@AmericanConference.com

### Hotel Information

American Conference Institute is pleased to offer our delegates a limited number of hotel rooms at a preferential rate. Please contact the hotel directly and mention ACI to receive this rate.

VENUE: The Helmsley Park Lane Hotel  
ADDRESS: 36 Central Park South, New York, NY 10019  
RESERVATIONS: 800-221-4982 or 212-371-4000

### Registration Fee

The fee includes the conference, all program materials, continental breakfasts, lunches, refreshments and complimentary membership of the ACI Alumni program

### Payment Policy

Payment must be received in full by the conference date. All discounts will be applied to the Conference Only fee (excluding add-ons), cannot be combined with any other offer, and must be paid in full at time of order. Group discounts available to individuals employed by the same organization.

### Cancellation and Refund Policy

You must notify us by email at least 48 hrs in advance if you wish to send a substitute participant. Delegates may not "share" a pass between multiple attendees without prior authorization. If you are unable to find a substitute, please notify American Conference Institute (ACI) in writing up to 10 days prior to the conference date and a credit voucher valid for 1 year will be issued to you for the full amount paid, redeemable against any other ACI conference. If you prefer, you may request a refund of fees paid less a 25% service charge. No credits or refunds will be given for cancellations received after 10 days prior to the conference date. **ACI reserves the right to cancel any conference it deems necessary or remove/restrict access to the ACI Alumni program and will not be responsible for airfare, hotel or other costs incurred by registrants. No liability is assumed by ACI for changes in program date, content, speakers, venue or arising from the use or unavailability of the ACI Alumni program**

### Incorrect Mailing Information

If you would like us to change any of your details please fax the label on this brochure to our Database Administrator at 1-877-927-1563, or email data@AmericanConference.com.

### CONFERENCE PUBLICATIONS

To reserve your copy or to receive a catalog  
of ACI titles go to [www.aciresources.com](http://www.aciresources.com)  
or call 1-888-224-2480.

### SPECIAL DISCOUNT

We offer special pricing for groups and government employees.  
Please email or call for details.  
Promotional Discounts May Not Be Combined. ACI offers financial  
scholarships for government employees, judges, law students,  
non-profit entities and others. For more information,  
please email or call customer care.