

U.S.-Canadian Patent Law Symposium

Sponsored By
American Bar Association Section of Intellectual Property Law
and
The Giles S. Rich American Inn of Court
and
National Intellectual Property Section, Canadian Bar Association

To Be Held At
United States Court of Appeals for the Federal Circuit
Ceremonial Courtroom 201
717 Madison Place, N.W.
Washington, D.C.

Friday, May 20, 2011

- I. WELCOME, 1:00p.m.-1:15p.m.**
Marylee Jenkins, Chair, Intellectual Property Law Section, American Bar Association
Andrew Bernstein, Vice Chair of National Intellectual Property Section, Canadian Bar Association

- II. TRIAL COURT PANEL, 1:15p.m.-2:15p.m.**
Justice Roger T. Hughes, Federal Court of Canada
Chief Judge Royce C. Lamberth, United States District Court, Washington, D.C.
Judge Susan Braden, United States Court of Federal Claims
Bruce Stratton, Dimock Stratton, Toronto

This panel will highlight the significant differences between the U.S. and Canadian trial practice regarding the use of expert witnesses, in light of August 4, 2010 amendments to Section 52 of the Canadian Federal Court Rules that allow a pre-trial expert conference, the designation of a single joint expert, and “hot-tubbing,” *i.e.*, allowing experts to testify on a panel and challenge each others’ testimony, *sua sponte* or at the direction of the judge. The panel will also discuss the fact that Canadian jurists are not required to conduct separate *Markman* proceedings nor conduct patent infringement proceedings before a jury. The panel will conclude with a discussion of remedies and whether the adaptation of Canadian procedural approaches to experts and *Markman* would lead to more expedited, less expensive, and more uniform decisions in the United States.

BREAK - 2:15p.m.-2:30p.m.

III. APPELLATE COURT PANEL, 2:30p.m.-3:30p.m.

Justice Carolyn Layden-Stevenson, Federal Court of Appeals of Canada
Judge Richard Linn, United States Court of Appeals for the Federal Circuit
Don Dunner, Finnegan Henderson
Susan Beaubien, Moffat & Co.

This panel will begin with contrasting the specialized nature of the United States Court of Appeals for the Federal Circuit with the generalized appeals considered by the Federal Court of Canada. A discussion of the applicable standards of review in both appellate courts will be followed by a substantive comparison of the inequitable conduct doctrine discussed in *Therasense Inc. v. Becton, Dickinson & Co.*, 593 F.3d 1289 (2010), *rehearing en banc granted, opinion vacated* 374 Fed. Appx. 35 (Fed. Cir. 2010), No. 2008-1511 (*en banc*) (Fed. Cir., hearing Nov. 9, 2010) with *Lundbeck Canada, Inc. v. Ratiopharm, Inc.*, 2009 FC 1102 and the written description requirement/validity discussed in *Ariad Pharmaceuticals Inc. v. Eli Lilly*, 598 F.3d 1336 (Fed. Cir 2010) (*en banc*) and *Apotex, Inc. v. Wellcome Foundation Ltd.*, 2002 4 S.C.R. 153.

BREAK - 3:30p.m.-3:45p.m.

IV. SUPREME COURT PANEL, 3:45p.m.-4:45p.m.

Justice Marshall Rothstein, Supreme Court of Canada
Judge Timothy Dyk, United States Court of Appeals for the Federal Circuit
Paul Clement, King & Spalding (former Solicitor of the United States)
Donald H. Macodrum, McMillan LLP

This panel first will focus on how the discretionary review is exercised by the Supreme Court of both countries. The substance will focus on the impact of *Catnic Components v. Hill & Smith*, 1981 F.S.R. 60 (H.L.), collapsing literal infringement and doctrine of equivalents, *i.e.*, “substantive infringement” inquiry into one “purposive construction.” This analysis was subsequently adopted in *Free World Trust v. Electo Santé* 2000 SCC 66 and *Whirlpool Camco* 2000 SCC 67, that extended “purposive construction” to the validity and infringement inquiry. The panel will then contrast: the “obviousness” analysis of *KSR Int’l Co. v. Teleflex, Inc.*, 550 U.S. 398, 419 (2007) with *Apotex, Inc. v. Sanofi-Synthelabo Canada, Inc.*, 2008 SCC 61; and the treatment of patentable subject matter in *Bilski v. Kappos*, 130 S. Ct. 3218 (2010) with *Monsanto Canada Inc. v. Schmeiser*, 2004 SCC 34 (patentability of genetically modified genes in plants) and *Harvard College v. Canada*, 2002 SCC 76 (patentability of life forms); *see also In Re Amazon.com, Inc.* 2010 FC 1011 (business method).

COCKTAIL RECEPTION AT DOLLEY MADISON HOUSE - 5:00 p.m.