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**Tuesday, September 24, 2024****7:30 – 8:30am Breakfast & Sign-In****8:30 – 8:45am Welcome & Announcements**  
(Ferguson, Withers)**8:45 – 10:15am [Session 01] Patent Developments Around the World – Last 12 Months**  
(Cooper, Lieck, Métier, Selwyn\*, Trenton )

Over the past year, there have been significant patent trends and developments which our panel will explore. Among those include: new decisions and rulings in the Unified Patent Court after 16 months in operation, the current status of and third party comments on the European Commission's proposal to regulate Standard Essential Patents, developments in the Chinese patent system, adoption of a new obviousness test for design patents, the patentability of inventions, obviousness after Amgen and the PTO's examiner statement on Wands, the PTAB's finding that real party in interest status is impacted by an indemnity agreement, the pending PREVAIL Act, and a \$525M patent verdict against Amazon, setting the bar high for 2024.

*Please fill out a brief online [evaluation](#) of this session.*

**Materials**

- 1.1 UPC Case Load 2023-24
- 1.2 Sedona, UPC Framework
- 1.3 LKQ Corp v GM Global
- 1.4 Cross-Border Discovery (Stage 3)

**10:15 – 10:30am Morning Break****10:30 – 11:30am [Session 02] Brainstorming Session - Injunctive Relief Across Jurisdictions**  
(Abdullah, Lieck, Trenton, Widera )

This brainstorming group will make a recommendation about whether WG9/10 should prepare a commentary on best practices relating to bases and rationales in connection with injunctive relief. A potential commentary might consider current practices across jurisdictions, including the United States, the United Kingdom, Germany, the UPC, and China. It might analyze factors currently considered in each jurisdiction and evaluate the extent to which current practice overlaps and differs. The commentary could present a recommendation as to what considerations, if any, there should be in connection with injunctive relief. If so, it could advance recommendations for harmonization across jurisdictions. It might further consider whether different considerations should apply in different jurisdictions. Members of the brainstorming group will solicit member feedback and input on this topic.

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**Materials**

- 2.1 Sedona Injunctive Relief Outline
- 2.2 RESTORE Act Text

**11:30 – 12:30pm [Session 03] Global FRAND Commentary**

(Delgado, Geiszler, Powers\*, Trenton )

The assertion and valuation of standard-essential patents, and the determination of a fair, reasonable, and non-discriminatory (FRAND) royalty rate, continues to be hot topic worldwide. Whether it's the European Commission's proposed "framework" for SEPs, the continued rise of SEP patent pools, or the question of who determines a global FRAND rate, our panel will address these topics and provide insight from industry insiders. The panel will also solicit input and guidance from the membership about the proper scope for a commentary on the Global FRAND topic.

*Please fill out a brief online [evaluation](#) of this session.*

**Materials**

- 3.1 Ericsson v Lava Final Judgment
- 3.2 Interdigital v Lenovo Approved Judgment

**12:30 – 1:30pm Lunch****1:30 – 2:30pm [Session 04] Case Management of Patent Damages and Remedies Issues**

(Cohen, Deneault, Hadzimehmedovic\*, Sum)

This panel will provide an update on its work on this topic and seek input from membership. The current Commentary presents principles and best practices for addressing and managing patent damages and remedies issues as they arise in various stages of litigation, including:

- Pre-trial management of patent damages and remedies issues: fact discovery, expert discovery, and damages hearings
- Trial management of patent damages and remedies issues: trial time allocation, bifurcation of liability and damages for discovery or trial, and jury instructions and jury verdict forms; and
- Post-trial management of patent damages and remedies issues: injunctions, ongoing royalties, and attorney fees

*Please fill out a brief online [evaluation](#) of this session.*

**Materials**

- 4.1 Sedona, Best Practices - Use of Experts
- 4.2 Sedona, Best Practices - Case Management
- 4.3 Sedona, Pleading Standards Under Iqbal-Twombly

## 4.4 Sedona, Damages &amp; Remedies

**2:30 – 2:45pm Afternoon Break****2:45 – 4:00pm [Session 05] Brainstorming Session - AI and Patent Law**  
(Ferguson, Ko, Kenton, Powers\* )

The widespread adoption of generative artificial intelligence by the business world will have far-reaching implications in the patent litigation space. A critical component of every patent case concerns the definition of the hypothetical person of ordinary skill in the art (“POSITA”). This definition has implications for claim construction and infringement purposes, and invalidity analyses under 35 U.S.C. §§ 102, 103, and 112. There is an open question whether the POSITA definition should assume access to generative AI platforms. Would such access greatly expand the POSITA’s knowledge? And if access to generative AI platforms is assumed, what are the contours of those platform(s)? If a POSITA is assumed to have access to AI, what are the implications for the motivation to combine analysis and analogous art issues under § 103? What are the implications for considering whether a patent contains an enabling disclosure under § 112? Additionally, generative AI can now be used to propose numerous solutions to stated problems. Those solutions can be posted to a website or other database. Should these AI-generated disclosures qualify as “prior art” within the meaning of 35 USC § 102? Do they meet the statutory definition and court-developed applications of that definition? If, as many courts have determined, only a person can qualify as an inventor for purposes of obtaining a patent, then should a disclosure qualify as “prior art” only if it was created by a person? The purpose of this brainstorming group is to propose an outline based on dialogue and consensus that may be used to draft a Commentary addressing these important issues. The panel will elicit input from members on these issues at this meeting with the goal of helping frame the resulting project charter.

*Please fill out a brief online [evaluation](#) of this session.*

**Materials**

- 5.1 Ko and Michel, Testing the Limits
- 5.2 PTO Request for Comments re AI

**4:00 – 4:15pm Afternoon Break****4:15 – 5:30pm [Session 06] Patent Litigation and Law - Judicial and In-House Perspectives**  
(Delgado, Ferguson\*, Geiszler, Hon. Johnson Hines)

Two spheres of the legal world – the judiciary and in-house counsel – are often foreign to the experiences of outside counsel and sometimes to each other. Outside attorneys usually provide counsel to attorneys employed by corporations and may not have an in-depth understanding of how complex the corporate decision-making structure, and various motivations, might be. Similarly, disputes between competitors may trigger powerful client reactions that exceed the practical merits of the conflict and jeopardize any settlement prospects. On the judicial side, resources are limited,

and patent disputes may be infrequent. What should litigators understand about effective advocacy, especially over complicated patent infringement claims? And what do in-house counsel want our courts to understand when they are litigating significant patent disputes with consequential implications for ongoing operations? Our panel comprised of seasoned in-house counsel and experienced judges will consider these and other issues impacting their positions and will provide valuable thoughts and insights enhancing our understanding.

*Please fill out a brief online [evaluation](#) of this session.*

**5:30 – 7:30pm Reception (guests invited)**

### Wednesday, September 25, 2024

**7:30 – 8:45am Breakfast Buffet & Sign-In**

**8:45 – 10:00am [Session 07] Brainstorming Session - The Proper Role of the Prosecution History in Patent Litigation**  
(Métier, Widera, Wu)

A patent's prosecution history reflects the record of proceedings between the applicant and the Patent Office and as such is considered intrinsic evidence for claim construction purposes. Many courts, however, are reluctant to rely on the prosecution history during claim construction unless it reflects a "clear and unmistakable" disclaimer of subject matter. This improperly diminishes the prosecution history's role in claim construction. Apart from claim construction, the prosecution history may also play an important role in the infringement analysis, including consideration of infringement under the doctrine of equivalents. The proposed Commentary will explore how the prosecution history may assist in both the claim construction process and in determining infringement, in the U.S. courts, the Unified Patent Court, and other fora throughout the world. Members of this brainstorming group will solicit the input and guidance of the membership at this meeting in framing the issues to be considered as part of the brainstorming group's project charter.

*Please fill out a brief online [evaluation](#) of this session.*

#### Materials

- 7.1 In re Pemetrexed – Judgment
- 7.2 Ortovox v Mammut
- 7.3 DexCom v Abbott
- 7.4 Vusion v Hanshow Trial Judgment
- 7.5 Vusion v Hanshow Appeal

**10:00 – 10:30am Morning Break**

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**10:30 – 11:45am [Session 08] The Evolving Relationship Between Federal Courts and Administrative Agencies**

(Groombridge, Hon. Johnson Hines, Nathan\*, Hon. Tuite)

The focus of this session is to seek dialogue on the current version of the WG10 Commentary on The Evolving Relationship Between Federal Courts and Administrative Agencies. This Commentary seeks to explore various issues that arise from related proceedings in Federal District and Appellate Courts, before the U.S. Patent and Trademark Office's Patent Trial and Appeal Board (PTAB), and Section 337 investigations at the International Trade Commission (ITC). Issues explored in this Commentary include stays of litigation, accelerated and conflicting trial scheduling, estoppel, ANDA provisions, standing, and availability of judicial review.

*Please fill out a brief online [evaluation](#) of this session.*

**Materials**

- 8.1 Sedona, Parallel USPTO Proceedings, Stage 1
- 8.2 Sedona, Parallel USPTO Proceedings, Stage 2
- 8.3 Sedona, Patent Reasonable Royalty Determinations
- 8.4 Sedona, Commentary on Courts & Agencies

**11:45 – 1:00pm [Session 09] Topics for our Global IP Program in The Hague, The Netherlands, March 24-25, 2025**

(Ferguson, Powers, Withers)

The 2023 and 2024 Sedona Global IP Litigation Conferences were great successes, cementing our relationship with the judges on the new Unified Patent Court (UPC). The 2025 conference will build on this and expand the scope beyond just patent law and beyond the US-EU bilateral relationship. Anticipation is already in the air and Sedona staff have already solicited interest from German, French, Italian, English, Brazilian and Israeli IP practitioners and regulators. Potential topics for discussion have included:

- Venue selection and territorial reach issues in IP litigation
- Managing parallel IP proceedings in multiple jurisdictions
- Use of 28 U.S.C. § 1782 for discovery in support of non-U.S. IP litigation
- Comparison of post-grant administrative invalidity proceedings in multiple jurisdictions
- Cross-border issues in Standard-Essential Patent (SEP) and Fair, Reasonable, and Non-Discriminatory (FRAND) determinations
- UPC case law update and comparison with recent case law from other jurisdictions, including ITC
- IP remedies and settlements in tension with various competition and consumer protection laws
- Potentially conflicting treatment of AI-assisted inventorship or creatorship in national IP laws

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**AGENDA**

The Sedona Conference is in the early stages of planning this marquee event. Working Group 9 and 10 input is sought to help narrow, expand, and prioritize the topics, and to get ideas for dialogue leaders and ancillary activities.

*Please fill out a brief online [evaluation](#) of this session.*

**Required Materials**

- 9.1 Sedona, UPC Framework
- 9.2 USPTO Inventorship Guidance Feb 2024
- 9.3 Inventorship of AI Generated Invention

**1:00 – 1:15pm** **Closing Remarks**  
(Withers)

**1:15pm** **Adjournment & Grab & Go Lunch (provided)**

*Please complete the brief online [evaluation](#) of the entire conference.*

