

**LISA A. DOLAK**  
*ladolak@syr.edu*

## **EXPERIENCE**

**PROFESSOR OF LAW** August 2005-Present  
**ANGELA S. COONEY PROFESSOR OF LAW** July 2009-August 2022  
**BOARD OF ADVISORS PROFESSOR OF LAW** August 2007-June 2009  
**SENIOR ASSOCIATE DEAN FOR ACADEMIC AFFAIRS** April 2005-June 2008  
**ASSOCIATE PROFESSOR OF LAW** August 1999-August 2005  
**ASSISTANT PROFESSOR OF LAW** August 1995-August 1999  
**Syracuse University College of Law, Syracuse, New York**  
Teach courses on patent law and policy, federal civil procedure, federal courts, and law, politics and the media.

**SR. VICE PRESIDENT AND UNIVERSITY SECRETARY** March 2015-December 2021  
**INTERIM SECRETARY** January 2015-March 2015  
**Syracuse University, Syracuse, New York**  
Coordinate and facilitate the activities of the Board of Trustees, and its committees, to ensure the effective and efficient operation of the University's system of governance.

**LAW CLERK** August 2003-July 2004  
**United States Court of Appeals for the Federal Circuit, Washington, D.C.**  
On sabbatical leave from the Syracuse University College of Law, served as law clerk to the Hon. Paul R. Michel, Circuit Judge.

**PROFESSIONAL CONSULTING** August 1995-Present  
Serve as expert in patent litigation, malpractice, and discipline matters. Consult and advise regarding federal and state court litigation matters and post-grant proceedings in the United States Patent and Trademark Office.

**ASSOCIATE** September 1988-July 1995  
**Technology and Intellectual Property Practice Group**  
**Nixon, Hargrave, Devans & Doyle, Rochester, New York**  
Prepared and prosecuted patent applications and trademark registration applications; prosecuted and defended patent, trademark, trade dress, and copyright infringement actions, trademark oppositions and concurrent use proceedings, patent interferences, and appeals; negotiated and drafted license agreements; prepared opinions (patentability, validity, infringement, and patent and trademark clearance).

**RESEARCH ASSISTANT** October 1984-July 1986  
**Ayerst Laboratories Research, Inc., Princeton, New Jersey**  
Designed and conducted radiolabelled syntheses of drug candidates and putative metabolites.

**RESEARCH ASSISTANT**

**September 1983-September 1984**

**Bristol-Myers Company, Evansville, Indiana**

Synthesized new drug candidates and putative metabolites. Purified and characterized synthetic products. Designed and presented proposed synthetic routes.

**EDUCATION**

**Syracuse University College of Law, Syracuse, New York**

Juris Doctor, May 1988, *summa cum laude* (Class Rank: 1/240)

**Duquesne University, Pittsburgh, Pennsylvania**

Bachelor of Science, Chemistry, May 1983

**PUBLICATIONS**

*The Ethics of Patent Assertion: Does “Purpose” Matter?*, in IP MONETIZATION AND INVESTMENT 2017: MAXIMIZE YOUR FINANCIAL AND STRATEGIC OPTIONS (2017)

*Negotiation Ethics: Guidance for the Intellectual Property Practitioner*, in IP MONETIZATION AND INVESTMENT 2017: MAXIMIZE YOUR FINANCIAL AND STRATEGIC OPTIONS (2017)

*Don't Check Your Ethics at the Door: The Ethical Implications of Legal Service Outsourcing*, (with Tyler Maulsby & Michael E. McCabe), in PATENT LAW INSTITUTE 2016 (10TH ANNUAL) (PLI Intellectual Property Course Handbook Series No. G-1268, 2016) and PATENT LAW INSTITUTE 2018: CRITICAL ISSUES & BEST PRACTICES (PLI Intellectual Property Course Handbook Series No. G-1362, 2018)

*Patent Office Contested Proceedings and the Duty of Candor*, 22 J. INTELL. PROP. L. 1 (Fall 2014)

*Trial Lawyers in Trouble: Litigation Misconduct and Its Ethics Fallout*, 52 U. LOUISVILLE L. REV. 225 (2014)

*Litigating Inequitable Conduct after Therasense, Exergen, and the AIA: Lessons for Litigants, Options for Owners*, 13 CHI.-KENT J. INTELL. PROP. 51 (Fall 2013)

*USPTO Post-Grant Proceedings and the Duty of Candor*, KOR. BAR ASS'N NEWS (December 2013), available at <http://news.koreanbar.or.kr/news/articleView.html?idxno=10152>

*USPTO Contested Proceedings: New Challenges, New Opportunities*, KOR. BAR ASS'N NEWS (September 2013) available at: <http://news.koreanbar.or.kr/news/articleView.html?idxno=9543>

*Ideology in the Supreme Court*, THE WCNY MAGAZINE, at 8 (September/October 2013)

*New USPTO Professional Conduct Rules Will Take Effect on May 3*, Guest Post, Patently-O (April 3, 2013). Available at <http://www.patentlyo.com/patent/2013/04/guest-post-new-uspto-professional-conduct-rules-will-take-effect-on-may-3.html>

*Major Shift for U.S. Patent System*, THE KOREAN BAR ASSOCIATION NEWS (March 2013)

*Patent Office Post-Grant Trials and the Duty of Candor*, in USPTO POST-GRANT PATENT TRIALS 2013, at 465 (PLI USPTO Post-Grant Patent Trials Course Handbook Series No. G-1130, 2013)

*New USPTO Proposed Ethics Rules*, Guest Post, Patently-O (Oct. 18, 2012). Available at <http://www.patentlyo.com/patent/2012/10/guest-post-new-uspto-proposed-ethics-rules-part-i.html>

*America Invents the Supplemental Examination But Retains the Duty of Candor: Questions and Implications*, 6 AKRON I.P. J. 147 (2012)

*Ethics in Intellectual Property Negotiations: Issues and Illustrations*, 40 AIPLA Q.J. 197 (2012)

*The America Invents Act: Target, the Eastern District of Texas [Panel]*, 15 SMU SCI. & TECH. L. REV. 471 (2012)

*Supplemental Examination in Context: Risks, Alternatives and Opportunities* (June 27, 2012), available at SSRN: <http://ssrn.com/abstract=2094497>

*Supplemental Examinations and the Client-Practitioner Relationship*, Guest Post, Patently-O (December 30, 2011). Available at <http://www.patentlyo.com/patent/2011/12/guest-post-supplemental-examinations-and-the-client-practitioner-relationship-.html>

*One Patent, Two Paths: Federal Circuit Review of Divergent USPTO and District Court Decisions*, 4 No. 2 LANDSLIDE 22 (2011)

*Misrepresenting the Client's "Bottom Line": Permitted Puffery? Or Prohibited Deceit?* PLI Patent Law Practice Center (October 17, 2011). Available at <http://patentlawcenter.pli.edu/2011/10/17/misrepresenting-the-clients-bottom-line-permitted-puffery-or-prohibited-deceit/>

*Resolving Differences: How the Federal Circuit Treats Divergent USPTO and District Court Rulings*, PLI Patent Law Practice Center (July 19, 2011). Available at <http://patentlawcenter.pli.edu/2011/07/19/resolving-differences-how-the-federal-circuit-treats-divergent-uspto-and-district-court-rulings/>

*Supplemental Examinations to Consider, Reconsider, or Correct Patent-Related Information*, PLI Patent Law Practice Center (January 3, 2011). Available at <http://patentlawcenter.pli.edu/2011/01/03/supplemental-examinations-to-consider-reconsider-or-correct-patent-related-information/>

*Inequitable Conduct: A Flawed Doctrine Worth Saving*, 11 WAKE FOREST J. BUS. & INTELL. PROP. 1 (Fall 2010)

*In the Wake of MedImmune: What We Have Learned*, PLI Patent Law Practice Center (September 14, 2010). Available at <http://patentlawcenter.pli.edu/2010/09/14/in-the-wake-of-medimmune-what-we-have-learned/>

*Lawyers Acting Badly, or Not? Misconduct in IP Litigation: Recent Examples and the Questions They Raise*, PLI Patent Law Practice Center (July 14, 2010). Available at <http://patentlawcenter.pli.edu/2010/07/14/lawyers-acting-badly-or-not-misconduct-in-ip-litigation-recent-examples-and-the-questions-they-raise/>

*Innovation & Intellectual Property Rights in China and India: Prospects and Strategies* (with Bernard Arogyaswamy), in *INTELLECTUAL PROPERTY, INNOVATION AND MANAGEMENT IN EMERGING ECONOMIES* (Ruth Taplin & Alojzy Z. Nowak eds. 2010)

*Supplemental Examinations to Consider, Reconsider, or Correct Patent-Related Information: A Tangled Web Indeed* (July 29, 2010). Available at SSRN: <http://ssrn.com/abstract=1650648>

*Lawyers Acting Badly, or Not? Misconduct in IP Litigation: Recent Examples and the Issues They Raise* (June 29, 2010). Available at SSRN: <http://ssrn.com/abstract=1632502>

*The Inequitable Conduct Gyre Widens*, 50 *IDEA: J.L. & TECH.* 215 (2010)

*Beware the Inequitable Conduct Charge! (Why Practitioners Submit What They Submit)*, 91 *J. PAT. & TM. OFF. SOC.* 558 (Oct./Nov./Dec. 2009)

*Recent and Proposed Patent System Reforms: Implications for Technology Commercialization* (March, 19 2009). Available at SSRN: <http://ssrn.com/abstract=1365439>

*Inequitable Conduct: A Flawed Doctrine Worth Saving (October 1, 2008)*. Available at SSRN: <http://ssrn.com/abstract=1276414>

*The United States Patent System in the Media Mirror* (with Blaine T. Bettinger), 58 *SYRACUSE L. REV.* 459 (2008)

*EBay and the BlackBerry®: A Media Coverage Case Study* (with Blaine T. Bettinger), 2 *AKRON INTELL. PROP. J.* 1 (2008)

*Patent Reform: A Necessary Evil?*, *INNOVATION: AMERICA'S JOURNAL OF TECHNOLOGY COMMERCIALIZATION*, February-March 2008, at 9

*Power or Prudence: Toward a Better Standard for Evaluating Patent Litigants' Access to the Declaratory Judgment Remedy*, 41 *U.S.F. L. REV.* 407 (2007)

*The Ethics of Delaying Prosecution*, 53 *AM. U. L. REV.* 739 (2004)

*Ethical Intellectual Property Opinions (and it's all legal!)*, in *PREPARING PATENT LEGAL OPINIONS 2004*, at 519 (PLI Pat. Copyrights, Trademarks & Literary Prop., Course Handbook Series No. 802, 2004) *reprinted in* *PREPARING PATENT LEGAL OPINIONS 2005*, at 217 (PLI Pat. Copyrights, Trademarks & Literary Prop., Course Handbook Series No. 843, 2005)

*Negotiation Ethics: Not an Oxymoron*, IPL NEWSL. (A.B.A. Sec. Intell. Prop. L.), Fall 2003, at 16

*Professionalism: What's In It For In-House Counsel?*, INSIDE, Vol. 21, No. 1 (Summer 2003)

*Risky Business: The Perils of Representing Competitors*, 30 A.I.P.L.A. Q.J. 413 (2002)

*Judges Increasingly Criticize Patent Counsel*, PAT. STRAT. & MGMT., Dec. 2002, at 5

*The Inequitable Conduct Doctrine: Lessons from Recent Cases*, 84 J. PAT. & TM. OFF. SOC. 719 (2002)

*Recognizing and Resolving Conflicts of Interest in Intellectual Property Matters*, 42 IDEA: J.L. & TECH. 453 (2002)

*Pre-File Investigations: Look Before You Leap*, PAT. STRAT. & MGMT., March 2002, at 1

*E-Evidence: Proving Invention Dates with Electronic Records*, PAT. STRAT. & MGMT., August 2001, at 1

*Clients, Their Confidences, and Internet Communications*, 36 ABA TORT & INS. L.J. 829 (Spring 2001)

*Responding to Prior Art Rejections—An Analytical Framework (with Michael L. Goldman)*, 83 J. PAT. & TRADEMARK OFF. SOC'Y 5 (2001)

*How to Educate Inventors About Inequitable Conduct*, INT. PROP. STRAT., August 2000, at 1

*As If You Didn't Have Enough to Worry About: Current Ethics Issues for Intellectual Property Practitioners*, 82 J. PAT. & TM. OFF. SOC. 235 (April 2000)

*Evaluating Conflicts of Interest: Are You Cavalier, Confident, Cautious or Clueless? (A Quiz for the Intellectual Property Law Specialist)*, IPL NEWSL. (A.B.A. Sec. Intell. Prop. L.), Fall 1999, at 16

*Patents Without Paper: Proving a Date of Invention with Electronic Evidence*, 36 HOUS. L. REV. 472 (1999)\*\*

*Conflicts of Interest: Guidance for the Intellectual Property Practitioner*, 39 IDEA: J.L. & TECH. 267 (1999)

*Declaratory Judgment Jurisdiction in Patent Cases: Restoring the Balance Between the Patentee and the Accused Infringer*, 38 B.C.L. REV. 903 (1997)

---

\*\* Designated by the Intellectual Property Law Review as “[among] the best intellectual property law review articles recently published.”

*The Inequitable Conduct Defense: Down, But Not Out* (with Steven C. Becker), IPL NEWSL. (A.B.A. Sec. Intell. Prop. L.), Summer 1997, at 1

*Federal Circuit Treatment of the Inequitable Conduct Defense* (with Steven C. Becker), in 16 SELECTED LEGAL PAPERS: A COLLECTION OF PAPERS BASED ON PRESENTATIONS AT AIPLA FUNCTIONS 175 (Thomas E. Smith ed., 1997)

*Inequitable Conduct in the Presentation of Affidavits to the U.S. Patent and Trademark Office* (with Michael L. Goldman), in AM. INT. PROP. L. ASS'N BASIC CHEMICAL AND BIOTECHNOLOGY PATENT PRACTICE SEMINAR COURSE BOOK (1996)

*Prosecuting Patent Applications in the Face of Prior Art Rejections* (with Michael L. Goldman), in AM. INT. PROP. L. ASS'N BASIC CHEMICAL AND BIOTECHNOLOGY PATENT PRACTICE SEMINAR COURSE BOOK (1994)

*Riding the Rapids: Financing the Leveraged Transaction Without Getting Wet* (with Christian C. Day & Michael P. Walls), 41 SYRACUSE L. REV. 661 (1990)

### **SELECTED PRESENTATIONS, PANELS, AND WORKSHOPS**

“The Ethics of Outsourcing Legal Services and Functions: What Patent Prosecutors and Litigators Need to Know to Survive” Practising Law Institute, Patent Law Institute 2018: Critical Issues & Best Practices, New York NY, April 5, 2018

“Patent Law Update – 2017 in Review” 35<sup>th</sup> Annual National CLE – Intellectual Property, Vail CO, January 6, 2018

“Policing Conflicts: In-House Counsel’s Critical Role as Guardian of the Organization’s Interests” IP Law & Management Institute, Austin TX, November 7, 2017

Panelist, “Ethical Issues Arising in IP Monetization” Practising Law Institute, IP Monetization and Investment 2017: Maximize Your Financial and Strategic Gain, New York NY, April 19, 2017

Panelist, “Don’t Check Your Ethics at the Door: The Ethical Implications of Legal Service Outsourcing” Practising Law Institute, 10<sup>th</sup> Annual Patent Law Institute, San Francisco CA, May 5, 2015

Panelist, “Conflict Waivers: How to Avoid Unpleasant Surprises” IPO IP Chat Channel Webinar, September 22, 2015

“Patent Subject Matter Conflicts: Risks, Issues, and Challenges for Prosecutors and Litigators” 2015 Midwest IP Institute, Minneapolis MN, September 18, 2015

Panelist, “Breaking Good -- Essentials for the Ethical IP Attorney” ABA Section of Intellectual Property Law, 2015 ABA Annual Meeting, Chicago IL, July 31, 2015

“The Duty of Candor in USPTO Contested Proceedings” 10<sup>th</sup> Annual Advanced Patent Law Institute, Alexandria VA, March 13, 2015

“The Ethics of Trolling: Does Litigation Purpose Matter?” AIPLA 2015 Mid-Winter Institute, Orlando FL, January 31, 2015

“The Duty of Candor in Post-Issuance Proceedings” 30<sup>th</sup> Annual Institute on Intellectual Property Law, Galveston TX, October 11, 2014

“PTAB Contested Proceedings: Tips and Traps for the Patent Owner and Petitioner” 2014 Salishan Patent Law Conference, Oregon Patent Law Association, Gleneden Beach OR, September 27, 2014

“On Trial and In Trouble - Litigation Misconduct and Its Ethics Fallout” 10<sup>th</sup> Annual Advanced Patent Litigation Course (Texas Bar CLE), San Antonio TX, July 17, 2014

“The New USPTO Contested Proceedings and the Duty of Candor” AIPLA Spring Meeting, Philadelphia PA, May 15, 2014

“The Duty of Candor in USPTO Post-Grant Proceedings” Intellectual Property Workshop: Challenging Patents – PTO Proceedings or the Courts (Texas Bar CLE), Dallas TX, March 19, 2014

“Post-Grant Contested Proceedings and the Duty of Candor” Utah State Bar IP Summit, Salt Lake City UT, February 28, 2014

“Subject Matter Conflicts: Risks, Issues, and Challenges” New York State Bar Association Intellectual Property Law Section Annual Meeting, New York NY, January 28, 2014

“Ethics Put to the Test: Specialized Issues for IP Counsel” University of New Hampshire School of Law, Concord NH, November 12, 2013

“The *Therasense* Standards in Action: What Have We Learned” 2013 IPO Annual Meeting, Boston MA, September 17, 2013

Panelist, “Avoiding Ethics and Malpractice Risks in the New Post-Grant Proceedings” West Legal Edcenter® Webinar, June 28, 2013

“Litigating Inequitable Conduct after *Therasense* and the AIA” AIPLA 2013 Chemical Patent Practice Road Show, Wilmington DE, June 20, 2013

Panelist, “Fraud on the US Patent and Trademark Office: Has the Plague of Inequitable Conduct Been Eradicated?” ABA 28<sup>th</sup> Annual Intellectual Property Law Conference, Arlington VA, April 5, 2013

Panelist, “Ethical Issues in Patent and Trademark Practice: A Practitioner’s Guide to the USPTO’s Proposed New Ethics Rules and Responding to OED Disciplinary Investigations” Virginia CLE, Charlottesville VA, April 4, 2013

Panelist, “Practice Before the PTAB Roundtable” and “Appeals to the Court of Appeals for the Federal Circuit” PLI USPTO Post-Grant Patent Trials 2013, San Francisco CA, April 15, 2013, New York NY, March 27, 2013

“Ethics-Related Implications of the America Invents Act” IPO PTO Day, Washington DC, December 10, 2012

Panelist, “Ethics-Related Implications of the AIA” IPO IP Chat Channel Webinar, October 23, 2012

“On Trial and In Trouble: Litigation Misconduct and Its Ethics Fallout” 22nd All Ohio Annual Institute On Intellectual Property (AOAIOIP), Cleveland OH, September 20, 2012; Cincinnati OH, September 21, 2012

“On Trial and In Trouble: Litigation Misconduct and Its Ethics Fallout” New York State Bar Association Intellectual Property Law Section Fall Meeting, New York NY, September 14, 2012

“Ethics: Conflicts and Litigation Misconduct in Intellectual Property Representations” 2012 IPO Annual Meeting, San Antonio TX, September 11, 2012

“Why Do We Bother? The Villified, But Tenacious, Doctrine of Inequitable Conduct” 12<sup>th</sup> Annual Intellectual Property Scholars Conference, Palo Alto CA, August 10, 2012

Panelist, “Discussion Group: Pedagogical Choices and Challenges in Civil Procedure” Southeastern Association of Law Schools 2012 Annual Conference, Amelia Island FL, August 1, 2012

Panelist, “Ethics Issues in IP” McDermott Will & Emery 2012 Intellectual Property Symposium, Chicago IL, June 14, 2012

Panelist, “Target, The Eastern District of Texas” Symposium on Emerging Intellectual Property Issues, The America Invents Act: A Revolution in Patent Law and Procedure, SMU Dedman School of Law, Dallas TX, April 20, 2012

Panelist, “New Supplemental Examination: USPTO Outlines New Rules. Navigating the New Mechanism to Cure Inequitable Conduct” Strafford Webinar, February 14, 2012

Panelist, “The Conflict of Interest Conundrum and Ethical Considerations” AIPLA Mid-Winter Meeting, Las Vegas NV, January 25, 2012

“Negotiation Ethics: Guidance for the Intellectual Property Practitioner” AIPLA Live Online Seminar, December 7, 2011

Panelist, “Subject-Matter Conflicts in Patent Prosecution, Opinion Work, Licensing and Litigation” IPO IP Chat Channel Webinar, November 30, 2011

The Reexamination Center Executive Interview: Professor Lisa Dolak, Sterne Kessler Goldstein Fox Reexamination Center Executive Interview Series, November 23, 2011



“Inequitable Conduct after *Therasense* and the America Invents Act” Rochester Intellectual Property Law Association Annual Fall Seminar, Rochester NY, November 9, 2011

Fifth Annual IP Forum: *Patent Law Reform*, University of Akron School of Law, Akron OH, October 28, 2011

Panelist, “*Therasense* – Does It Make Sense? Is the Patent Law Doctrine of Inequitable Conduct Now Fixed?” Tenth Annual “Hot Topics in Patent Law” Symposium, George Mason University School of Law, Arlington VA, July 19, 2011

Panelist, “*Therasense* – Does It Make Sense? Is the Patent Law Doctrine of Inequitable Conduct Now Fixed?” BNA/Banner Webinar, June 22, 2011

“The Rules of Engagement: Avoiding, Recognizing and Resolving Ethical Conflicts of Interest in Intellectual Property Representations” Kansas Bar Association 2011 Intellectual Property Law CLE, Overland Park KS, May 6, 2011

“Whose Rules Rule? Federal Circuit Review of Divergent USPTO and District Court Decisions” Panel on Contrasting USPTO and Judiciary Treatment of Patent Issues: How the Differing Standards Impact Your Practice, ABA 26<sup>th</sup> Annual Intellectual Property Law Conference, Arlington VA, April 7, 2011

Panelist, “Structure and Jurisprudential Approach of the Court of Appeals for the Federal Circuit” Evolving the Court of Appeals for the Federal Circuit and its Patent Law Jurisprudence, Missouri Law Review Symposium 2011, Columbia MO, February 25, 2011

Panelist, “Avoiding Conflicts of Interest in Patent Prosecution and Litigation: A Guide for Law Firms and Clients” IPO IP Chat Channel Webinar, February 17, 2011

“Supplemental Examinations to Consider, Reconsider, or Correct Information: A Tangled Web, Indeed” Sixth Annual Advanced Patent Law Institute, Alexandria VA, January 20, 2011

“Ethics: Supplemental Examinations to Consider, Reconsider, or Correct Information (A Tangled Web Indeed)” AIPLA Live Online Seminar, December 1, 2010

Panelist, “The Ethical Ramifications of *Therasense*” sponsored by The Catholic University of America, Columbus School of Law, Washington DC, September 27, 2010

“Supplemental Examinations to Consider, Reconsider, or Correct Patent-Related Information: A Tangled Web Indeed” 10<sup>th</sup> Annual Intellectual Property Scholars Conference, Berkeley CA, August 12, 2010

“Supplemental Examinations to Consider, Reconsider, or Correct Information: Ethics and Disciplinary Implications” Ninth Annual “Hot Topics in Patent Law” Symposium, George Mason University School of Law, Arlington VA, July 20, 2010

“Trial Lawyers in Trouble (But It’s Really Tough Being a Trial Judge!)” 36<sup>th</sup> ABA National Conference on Professional Responsibility, Seattle WA, June 3, 2010

Panelist, “Review of Crucial Recent Supreme Court and Federal Circuit Decisions Impacting Patent and Trademark Law” Federal Circuit Judicial Conference, Washington DC, May 20, 2010

“Inequitable Conduct: What’s New and What’s Next?” Philadelphia Intellectual Property Law Association, Philadelphia PA, March 18, 2010

“Inequitable Conduct: Can (Should) this Doctrine Be Saved?” Twelfth Annual Richard C. Sughrue Symposium on Intellectual Property Law and Policy, University of Akron School of Law, Akron OH, March 8, 2010

“Inequitable Conduct: A Doctrine in Flux” Practising Law Institute, 4<sup>th</sup> Annual Patent Law Institute, New York NY, March 2, 2010

“What Not to Do: How IP Practitioners Get Themselves in Trouble” Rochester Intellectual Property Law Association Annual Fall Seminar, Rochester NY, November 20, 2009

“What Not to Do: How IP Practitioners Get Themselves in Trouble” LAW! LIVE in DC Speaker Series, Washington DC, November 5, 2009

“Beware the Inequitable Conduct Charge: Why Practitioners Submit What They Submit” AIPLA-USPTO Partnering in Patents XVI, Alexandria VA, October 14, 2009

“The Patent System in the Media Mirror” Federal Judicial Center Conference on Law and Media, Syracuse NY, September 24, 2009

“Media Portrayals of the United States Patent System” AIPLA Webinar: Career Practice and Management Series, July 22, 2009

“Inequitable Conduct: A Flawed Doctrine Worth Saving” Washington State Patent Law Association, Seattle WA, May 20, 2009

“Establishing First to Invent & Electronic Lab Notebooks” New York State Science & Technology Law Center webcast, May 12, 2009 (available at [http://nysstlc.syr.edu/video/ensemble.html?videoID=rLZwkz\\_CL0ep08pxLXb1PA](http://nysstlc.syr.edu/video/ensemble.html?videoID=rLZwkz_CL0ep08pxLXb1PA))

“What’s REALLY Wrong with Inequitable Conduct . . . and How to Fix It” The John Marshall Law School *Ethics in the Practice of Intellectual Property Law* IP Ethics CLE Program, Chicago IL, May 1, 2009

“Inequitable Conduct: A Flawed Doctrine Worth Saving” Panel on *The Ethics of Patent Prosecution*, ABA 24<sup>th</sup> Annual Intellectual Property Law Conference, Arlington VA, April 3, 2009

“Inequitable Conduct: A Flawed Doctrine Worth Saving” Panel on *Inequitable Conduct: What Standard? What Evidence?*, 2008 IPO Annual Meeting, San Diego CA, September 23, 2008

“The Patent System in the Media Mirror” Panel on *Interdisciplinary Perspectives on Patent Lawyers and the Patent System*, 2008 Law and Society Association Annual Meeting, Montreal, Canada, May 29, 2008

Moderator, "Patent Issues Ripe for Judicial Clarification" Federal Circuit Judicial Conference, Washington DC, May 15, 2008

"The Inequitable Conduct Gyre Widens" Patent Law Association/Washington State Patent Law Association Joint Conference, Gleneden Beach OR, April 11, 2008

First Annual IP Forum: *The Changing Landscape of IP Remedies after eBay*, University of Akron School of Law, Akron OH, November 8-9, 2007

"The United States Patent System in the Media Mirror" IJPM/SU Law Review Symposium: *Creators vs. Consumers: The Rhetoric, Reality and Reformation of Intellectual Property Law and Policy*, Syracuse University, Syracuse NY, October 26, 2007

"The Inequitable Conduct Gyre Widens" Virginia State Bar (Intellectual Property Section) 19th Annual IP Fall CLE Weekend Seminar, Williamsburg VA, September 29, 2007

"Media Portrayals of the United States Patent System" 7<sup>th</sup> Annual Intellectual Property Scholars Conference, Chicago IL, August 10, 2007

"Media Portrayals of the United States Patent System" Panel on Property, Citizenship, and Social Entrepreneurism, 2007 Law and Society Association Annual Meeting, Humboldt University, Berlin, Germany, July 27, 2007

"Media Portrayals of the United States Patent System" Workshop on Comparative, Transnational & Emerging Issues in Property Law, Durham University, Durham, England, July 18, 2007

"Federal Circuit Review" State Bar of California (Intellectual Property Law Section) Conference: *The Federal Circuit Judges Come to California*, Marina del Ray CA, February 20, 2007

"The Duty of Candor: Its Source, Scope, and Significance" IPO Patent and Trademark Office Day, Washington DC, December 4, 2006

Panelist, "The Supreme Court Year in Preview" Conference on *Patent Policy in the Supreme Court and Congress*, Santa Clara CA, October 27, 2006

"Seeking Declaratory Relief: How Scared Is Scared Enough?" 16<sup>th</sup> All Ohio Annual Institute On Intellectual Property (AOAIOIP), Cleveland OH, September 14, 2006; Cincinnati OH, September 15, 2006

"Prudence vs. Power: It Does Matter in Patent Cases" 6<sup>th</sup> Annual Intellectual Property Scholars Conference, Berkeley CA, August 10, 2006

Panelist, "Panel of patent experts ponders Supreme Court's increased interest in IP law" Intellectual Property LAWCAST®, Vol. XII, No.13, August 7, 2006

"Intellectual Property Law Reform: Real Progress or Rearranging Deck Chairs?" LAW! LIVE @ Lubin Speaker Series, New York NY, May 24, 2006

Panelist, "Patent law experts ponder the BlackBerry settlement and its impact on the practice" Intellectual Property LAWCAST®, Vol. XII, No. 7, May 8, 2006

"Current Issues in Inequitable Conduct and Representation Conflicts" Patent Resources Group, Inc., Washington DC, Bonita Springs FL, April 9, 2006; Indian Wells CA, October 26, 2005; Bonita Springs FL, April 20, 2005; Washington DC, August 4, 2004

"Inequitable Conduct: A Few Things Worth Knowing" Utah IP Summit, Salt Lake City UT, February 24, 2006

"Ethical Intellectual Property Opinions (And It's All Legal!)" Practising Law Institute "Preparing Patent Legal Opinions" Course, New York NY, September 28, 2005

"Triggering 'Due Care' and Damages: Requiring More Detailed Notice of Infringement" IPO Conference on *Patent 'Trolls' and Patent Property Rights*, Washington DC, March 14, 2005

"Ethical Intellectual Property Opinions (And It's All Legal!)" Seventh Annual Richard C. Sughrue Symposium on Intellectual Property Law and Policy, University of Akron School of Law, Akron OH, March 7, 2005

"Negotiation Ethics: Not an Oxymoron" AIPLA Annual Meeting, Washington DC, October 16, 2004

"Ethical Intellectual Property Opinions (And It's All Legal!)" Practising Law Institute "Preparing Patent Legal Opinions" Course, New York NY, September 29, 2004

"Ethics Issues for I.P. Opinion Counsel" The 14<sup>th</sup> All Ohio Annual Institute On Intellectual Property (AOAIOIP), Cincinnati OH, September 10, 2004; Cleveland OH, September 9, 2004

"Conflicts of Interest in IP Practice" IPO Patent and Trademark Office Day, Washington DC, December 8, 2003

Panelist, "*Dastar*: Narrowing Opinion, Broad Implications" Intellectual Property LAWCAST®, Vol. IX, No. 7, June 9, 2003

"Hatch-Waxman Law and Policy" Conference on Patent Policy in the Pharmaceutical Industry, Syracuse University College of Law, Syracuse NY, April 9, 2003

"Ethics Implications of Prosecution Laches" New York State Bar Association 126<sup>th</sup> Annual Meeting (Intellectual Property Law Section), New York NY, January 21, 2003

"Ethics Implications of Prosecution Laches" Rochester Intellectual Property Law Association Annual IP Law Seminar, Rochester NY, November 22, 2002

"Patents and Ownership of Data" SUNY Health Science Center, Syracuse NY, November 13, 2002; November 14, 2001; October 3, 2000; October, 1999; September 22, 1998; September 23, 1997; November 6, 1996; January 31, 1996

“Patent Law Update” 18<sup>th</sup> Annual Institute on Intellectual Property Law, Galveston TX, September 27, 2002

“Ethics Implications of Prosecution Laches” George Mason University School of Law Symposium on “Hot Topics in Patent Law,” Arlington VA, July 16, 2002

“Inequitable Conduct: Lessons from Recent Cases” American Intellectual Property Law Association (“AIPLA”) Advanced Patent Practice Seminar, Boston MA, June 7, 2002; Chicago IL, May 17, 2002; Newport Beach CA, May 3, 2002

“Ethical Issues in Licensing and License Negotiations” American Law Institute-American Bar Association (“ALI-ABA”) Course of Study on Intellectual Property Licensing in Today’s “E-conomy,” Boston MA, May 30, 2002

“Risky Business – the Perils of Representing Competitors” The 17<sup>th</sup> Annual Intellectual Property Law Conference (ABA-IPL), Washington DC, April 12, 2002

“Risky Business – the Perils of Representing Competitors” Washington State Patent Law Association, Seattle WA, March 22, 2002

“Ethics: Risky Business – the Perils of Representing Competitors” New York State Bar Association 125<sup>th</sup> Annual Meeting (Intellectual Property Law Section), New York NY, January 22, 2002

“Patent Law Update” 17<sup>th</sup> Annual Institute on Intellectual Property Law, Galveston TX, November 9, 2001

“Professionalism and the In-House IP Counsel” IPO Annual Meeting, New York NY, November 6, 2001

“Ensuring Your Outside Patent Counsel Does Not Have a Conflict of Interest” American Conference Institute 3rd National Legal and Regulatory Forum for Patenting: *Genomics, Proteomics, and Complex Biotech*, New York NY, November 5, 2001

“Risky Business: The Ethics and Perils of Representing Competitors” AIPLA Annual Meeting, Washington DC, October 20, 2001

“Cavalier, Confident, Cautious, or Clueless?: Test Your Conflicts IQ” New York State Bar Association “Bridge the Gap” Program on Intellectual Property and the Internet, Rochester NY, September 20, 2001

“Patents Without Paper” (Mock Trial, Proving Invention Dates with Electronic Evidence), The Collaborative Electronic Notebook Systems Association Legal & Regulatory Symposium, Summit NJ, May 1, 2001

“As if You Don’t Have Enough to Worry About: Current Ethics Issues for Intellectual Property Practitioners” Patent, Trademark, and Copyright Section, Colorado Bar Association, Denver CO, March 14, 2001

“State of the Professional Rules: Conflicts in IP Representation” New York State Bar Association 124<sup>th</sup> Annual Meeting (Intellectual Property Law Section), New York NY, January 23, 2001

Panelist, “Three New Rulings on Inequitable Conduct Serve as Prosecution Practice Pointers” Intellectual Property LAWCAST®, Vol. VI, No. 23, December 11, 2000

“Cavalier, Confident, Cautious, or Clueless?: Test Your Conflicts IQ” New York Intellectual Property Law Association Fall 2000 CLE Weekend, Tarrytown NY, October 15, 2000

“Cavalier, Confident, Cautious, or Clueless?: Test Your Conflicts IQ” Iowa Intellectual Property Law Association Continuing Legal Education Seminar, Des Moines IA, October 13, 2000

“Understanding and Responding to PTO Office Actions: Prior Art Rejections” American Intellectual Property Law Association (“AIPLA”) Patent Prosecution Basic Training Program, Arlington VA, September 23, 2000

“Clients, Their Confidences, and the Internet” Law Seminars International “E-Commerce in the Heart of Techtopia” Conference, Tyson's Corner VA, September 22, 2000

“As if You Didn’t Have Enough to Worry About: Current Ethics Issues for Intellectual Property Practitioners” State Bar of Wisconsin Annual Convention, Madison WI, June 30, 2000

“Current Ethics Issues for the Patent Practitioner” AIPLA Advanced Patent Practice Seminar, San Francisco CA, June 9, 2000; New Orleans LA, May 26, 2000; Washington DC, April 8, 2000

“Conflicts of Interest for the Intellectual Property Practitioner” Spring Ethics CLE Course, Patent, Trademark & Copyright Section of the Bar Association of the District of Columbia and Virginia Bar Association Intellectual Property Law Section, Washington DC, April 6, 2000

“Conflicts of Interest in IP Practice” IPO Patent and Trademark Office Day, Washington DC, December 6, 1999

Intellectual Property Seminar, Central New York Advanced Course in Engineering, Syracuse University CASE Center, Syracuse NY, September 13, 1999; September 14, 1998

“Rules of Engagement: Conflicts and Other Client Issues” American Intellectual Property Law Association (“AIPLA”) Advanced Patent Practice Seminar, San Diego CA, June 12, 1998; New York NY, May 22, 1998; Houston TX, May 8, 1998

“Cavalier, Confident, Cautious, or Clueless?: Test Your Conflicts IQ” AIPLA Spring Meeting, Minneapolis MN, April 24, 1998

“The Legal Aspects of Electronic Recordkeeping Systems” The Collaborative Electronic Notebook Systems Consortium, San Diego CA, January 15, 1998

Panelist, Expert Focus Group, Electronic Filing of Patent Applications, United States Patent and Trademark Office, Washington DC, September 19, 1997

“How to Protect Your Flank: Minimizing the Risk of an Inequitable Conduct Charge” AIPLA Spring Meeting, San Antonio TX, April 30, 1997

“Discovery in Civil Litigation” 1996 Cohasset Associates, Inc. Conference on Managing Electronic Records, November 4, 1996

“Ethical Considerations: Proper Use of Data and Affidavits” AIPLA 1996 Basic Chemical and Biotechnology Patent Practice Seminar, San Francisco CA, June 14, 1996; Chicago IL, June 7, 1996

“Drafting and Prosecuting the Application to Meet §102/103 Novelty/Obviousness Requirement” AIPLA 1994 Basic Chemical and Biotechnology Patent Practice Seminar, Cambridge MA, September 23, 1994

### **COURSES**

Patent Resources Group Biotechnology Patent Practice Workshop, Steamboat Springs CO, March, 1995

Patent Resources Group New U.S. Patent Term Extension & Diminution Practice, Bethesda MD, February, 1995

Patent Resources Group Chemical Patent Practice Course, Hilton Head SC, April 1991

### **BAR ADMISSIONS**

State of New York

United States District Courts: Western, Eastern, Northern and Southern Districts of New York

United States Court of Appeals for the Federal Circuit

United States Patent and Trademark Office

### **PROFESSIONAL ACTIVITIES**

Advisory Council, United States Court of Appeals for the Federal Circuit (appointed) (January 2005-September 2013)

AIPLA Professionalism and Ethics Committee (appointed) (2014)

AIPLA Special Committee to Study the National Research Council’s Report on Reaping the Benefits of Genomic and Proteomic Research (appointed) (2006)

AIPLA Education Committee Chair (appointed) (Fall 1999-Fall 2001)

Member, Ad Hoc Patent Rules Committee, Northern District of New York (appointed) (April 2010-December 2011)

American Bar Association Presidential Task Force on the Patent and Trademark Office (appointed) (2007)

Chair, Syracuse University College of Law Reading Group, Sonia M. Sotomayor Nomination  
(convened at the request of the American Bar Association Standing Committee on the  
Federal Judiciary)

Chair, Syracuse University College of Law Reading Group, Samuel A. Alito Nomination  
(convened at the request of the American Bar Association Standing Committee on the  
Federal Judiciary)

Contributor, PLI's Patent Law Practice Center (June 2010-Present)

Occasional commentator, IP Law360 (May 2008-Present)

Panelist, "The Ivory Tower Half Hour" (public affairs discussion program airing weekly on  
WCNY-TV) (June 2006-October 2020; June 2024-Present)

Board of Editors, *Patent Strategy & Management*, American Lawyer Media (2000-2003)

American Bar Association, Section of Intellectual Property Law

New York State Bar Association, Intellectual Property Section