



THE STANFORD PROGRAM IN LAW, SCIENCE & TECHNOLOGY  
BERKELEY CENTER FOR LAW & TECHNOLOGY AT BOALT HALL  
THE UNIVERSITY OF TEXAS SCHOOL OF LAW



5th Annual

# ADVANCED PATENT LAW INSTITUTE

Earn up to 12.75 Hours of Credit Including 1.5 Hours of Ethics Credit



December 2-3, 2004  
THE FAIRMONT SAN JOSE  
San Jose, California

## ADVANCED PATENT LAW INSTITUTE

December 2–3, 2004 • The Fairmont San Jose • San Jose, CA

Earn up to 12.75 Hours of Credit Including 1.5 Hours of Ethics Credit

## THURSDAY MORNING, DECEMBER 2, 2004

## Presiding Officer:

Jean Burke Fordis, Palo Alto

## 8:00 a.m. Registration Opens

Includes continental breakfast.

## 8:30 a.m. Welcoming Remarks

## 9:00 a.m. .50 hr.

## Beyond SCO: Emerging Open Source Issues

The convergence of software patents and open source licensing has generated new challenges for identifying and addressing patent infringement in electronic products (and not just software). An assessment of these emerging patent litigation issues with an emphasis on avoiding inadvertent patent infringement and enforcing patent rights against distributors and users of open source products.

James W. Morando, San Francisco  
Christian H. Nadan, Santa Clara

## 9:30 a.m. .50 hr.

## Inequitable Conduct

The Federal Circuit's inequitable conduct jurisprudence continues to evolve. Recent decisions, including *Knorr-Bremse*, are changing the way that inequitable conduct claims are prosecuted and defended. Mr. Bobrow will discuss these developments and their impact on patent litigation strategy.

Jared Bobrow, Redwood Shores

## 10:00 a.m. .50 hr.

## Written Description Issues

There is an apparent disagreement at the Federal Circuit as to how the written description requirement should be applied—which view will prevail, and how will it affect prosecution and litigation strategies.

Kate H. Murashige, San Diego

## 10:30 a.m. Break

## 10:45 a.m. 1.00 hr.

## Prefiling Considerations

The evolving requirements for a satisfactory prefiling investigation, the pros and cons of current patent litigation hot spots, strategies for responding to patent infringement assertions that may be meritorious or frivolous, and practical problems for patent owners and alleged infringers.

Morgan Chu, Los Angeles  
Daralyn J. Durie, San Francisco

## 11:45 a.m.

## Networking Lunch for Speakers &amp; Registrants

Please select on registration form.

## THURSDAY AFTERNOON

## Presiding Officer: Richard J. Lutton, Cupertino

## 1:00 p.m. 1.00 hr.

## Strategic Prosecution

Ever wonder what happens to your patents after they issue? This presentation will address some of the reasons patents reviewed in pre-litigation investigations are not selected for litigation and will address some of the related issues faced during prosecution. The presentation will also focus on prosecution case law development and will touch on hot topics in biotech prosecution.

Mary Ann Dillahunty, Redwood City  
Katherine Kelly Lutton, Redwood City

## 2:00 p.m. 1.00 hr. ethics

## Privilege Waivers and Opinion Drafting

Opinion practice after *Knorr-Bremse*: the end of the adverse inference; the continuing duty of care; and the remaining problem of the scope of the privilege waiver when an opinion is asserted.

L.J. Chris Martiniak, San Francisco  
Lee Van Pelt, Cupertino

## 3:00 p.m. Break

## 3:15 p.m. .75 hr.

## Claims Construction

A review of the continuing Federal Circuit trek through intrinsic, extrinsic, and other evidence, dictionaries and "plain meaning," and the methodology of claims construction overhung by the impending *Phillips en banc* basic review.

Kenneth R. Adamo, Dallas, TX

## 4:00 p.m. .50 hr.

## The Outsourcing of Patent Prosecution

Some companies have begun to move portions of their patent prosecution work overseas. Can it be done? Are there actual savings and benefits? What are the pitfalls and opportunities for companies looking to outsource prosecution work and patent prosecution firms? Find out!

Robert Barr, San Jose  
Sandeep Jaggi, Milpitas

## 4:30 p.m. 1.00 hr

## Judges Panel

A panel of distinguished and experienced federal judges will discuss what they dislike about patent cases and what you can do to help.

Matthew D. Powers, Redwood Shores, Moderator  
Hon. Susan Y. Illston, San Francisco  
Hon. Kent A. Jordan, Wilmington, DE  
Hon. Ronald M. Whyte, San Jose

## 5:30 p.m. Adjourn

## FRIDAY MORNING, DECEMBER 3, 2004

## Presiding Officer:

Thomas J. Friel, Jr., San Francisco

## 8:00 a.m. Conference Room Opens

Continental breakfast provided.

## 8:30 a.m. .50 hr.

## PTO Rule Changes: Key Developments that Affect Your Practice

A discussion of key rule changes at the PTO, of interest to every patent practitioner.

Stephen G. Kunin, Washington, D.C.

## 9:00 a.m. .50 hr. ethics

## Eligibility to Practice Before the PT

An overview and discussion of PTO's practice rules.

Stephen G. Kunin, Washington, D.C.

## 9:30 a.m. .50 hr.

## Inherency

Understanding the doctrine of inherency in light of fundamental recent changes in the law.

Mark A. Lemley, Stanford

## 10:00 a.m. Break

## 10:15 a.m. .50 hr.

## Monetizing &amp; Securitizing IP

Beyond adversarial licensing; IP monetization strategies for the new era.

John A. Amster, San Francisco  
Ron Epstein, San Mateo  
Ron Laurie, Palo Alto

10:45 a.m. .75 hr.

#### IP Holding Companies: How, Why and Why Not

The strategic, business and tax advantages / disadvantages of IP holding companies; their effect on commercialization, jurisdiction, standing and damages in litigation.

Joseph Ferraro, Santa Clara  
Christopher A. Martinez, Austin, TX

11:30 a.m. .75 hr.

#### Packaging and Optimizing Mediation

Most cases settle, but some settle much better than others. Leading mediators discuss how counsel can help achieve the best outcome.

Antonio Piazza, San Francisco  
James Pooley, Palo Alto  
Randall Wulff, Oakland (invited)

12:15 p.m. Lunch On Your Own

### FRIDAY AFTERNOON

#### Presiding Officer:

Christopher J. Byrne, Santa Clara

1:15 p.m. .50 hr.

#### 102(f) Inventorship

A discussion of the detailed requirements of, and effective strategy in response to, the recent amendment to section 103 of the Patent Act eliminating from the prior art certain joint work stemming from contract R&D alliances.

Robert P. Merges, Berkeley

1:45 p.m. .50 hr.

#### Distributed Patent Infringement

Strategies for prosecuting and litigating divided claims, those with more than one infringer, or in more than one country.

Mark A. Lemley, Stanford

2:15 p.m. .50 hr.

#### Inducement—Level of Intent

What does it take to induce infringement of a patent?

Michael A. Jacobs, San Francisco

2:45 p.m. Break

3:00 p.m. .50 hr.

#### Antitrust Issues

This session will review recent developments in the application of antitrust law to patent-holders and licensees in light of new legislation, administrative decisions and foreign developments.

Daniel M. Wall, San Francisco

3:30 p.m. .50 hr.

#### Electronic Discovery

Electronic and international discovery: a practical guide for handling (and not mishandling) electronic data (including e-mails and backup files) and for pursuing and obtaining discovery from foreign parties in domestic patent litigation.

Michael S. Kwun, Mountain View

4:00 p.m. Adjourn

## Conference Publications and Media

### Course Binder

Conference registration includes a course binder of articles, sample forms and planning strategies—a resource guide you'll refer to all year.

### eBinder on CD

Get the entire conference binder on CD, in electronic PDF format. Only \$50 if added to a registration or purchase of Course Binder or Audio CD Set. \$200 purchased alone.

### Audio CD Set

Conference presentations are available on CD. Listen to the entire conference or individual sessions at your convenience.

### Group CLE

Would your firm like to run an in-house version of this conference, with full participatory MCLE credit? Order Group CLE and we'll accredit the course for you; we'll also provide an Audio CD Set for the group and a Course Binder for each participant.

Mail this registration form or fax a copy to: (512) 475-6876

### REGISTRATION FOR PJ04

The University of Texas School of Law • Office of Continuing Legal Education

Attn: PJ04 • Post Office Box 7759 • Austin TX 78713-7759

#### PLEASE PRINT CLEARLY

Bar Card# \_\_\_\_\_ ☐ TX ☐ Other State: \_\_\_\_\_ ☐ N/A

Name [ Mr. / Ms. ] \_\_\_\_\_

Firm \_\_\_\_\_

Address \_\_\_\_\_

City \_\_\_\_\_ State \_\_\_\_\_ Zip \_\_\_\_\_

Telephone \_\_\_\_\_ Fax \_\_\_\_\_

E-mail Address \_\_\_\_\_

#### REGISTRATION

##### Includes Course Binder

☐ Early Registration Fee due by Wed., November 24, 2004 ..... \$695.00

☐ Registration Fee after Wed., November 24, 2004 ..... \$745.00

☐ Thursday Networking Luncheon ..... \$25.00

#### CONFERENCE PUBLICATIONS AND MEDIA

##### Allow 2-3 weeks from conference date for delivery.

☐ Course Binder ..... \$225.00

Note: Conference registration includes Course Binder.

☐ Audio CD Set ..... \$200.00

☐ eBinder on CD (PDF format) ..... \$200.00/\$50.00  
(\$200 purchased alone, \$50 with registration or purchase of Course Binder or Audio CD Set)

#### GROUP CLE: Bring the conference in-house and learn at your convenience.

##### Allow 2-3 weeks from conference date for delivery.

☐ Group CLE for 2 - Includes Audio CD Set and 2 Course Binders ..... \$750.00

\_\_\_\_\_ Add participants (includes Course Binder) for \$200 each ..... \$ \_\_\_\_\_

TOTAL ENCLOSED ..... \$ \_\_\_\_\_

#### METHOD OF PAYMENT

☐ Check (make checks payable to: The University of Texas at Austin)

☐ VISA or ☐ Mastercard (sorry, no AMEX or Discover)

Card #     -     -     -

X

Authorized Signature

/

Exp. Date (mm/yy)



## SAN JOSE

Dec. 2-3, 2004

### CONFERENCE LOCATION



**The Fairmont San Jose**  
170 South Market Street  
San Jose, CA 95113  
(800) 346-5550

\$145 single or double special  
group rate (subject to availability)  
good through **Nov. 10, 2004**

### KEY DATES

#### Registration and Cancellation

**November 24, 2004, 5 p.m.**  
•last day for early registration  
add \$50 for registrations  
received after this time

**November 29, 2004, 5 p.m.**  
(Monday before conference)  
•last day for refunds  
\$50 processing fee applied

**December 2, 2004, 9:00 a.m.**  
•conference begins

## CONFERENCE FACULTY

KENNETH R. ADAMO  
Jones Day  
Dallas, TX

JOHN A. AMSTER  
ICMB Ocean Tomo  
San Francisco

ROBERT BARR  
Cisco Systems, Inc.  
San Jose

JARED BOBROW  
Weil, Gotshal & Manges LLP  
Redwood Shores

MORGAN CHU  
Irell & Manella LLP  
Los Angeles

MARY ANN DILLAHUNTY  
Fish & Richardson P.C.  
Redwood City

DARALYN J. DURIE  
Keker & Van Nest, LLP  
San Francisco

RON EPSTEIN  
IPotential, LLC  
San Mateo

JOSEPH FERRARO  
Ferraro Mediation Group  
Santa Clara

HON. SUSAN Y. ILLSTON  
United States District Court  
Northern District of California  
San Francisco

MICHAEL A. JACOBS  
Morrison & Foerster LLP  
San Francisco

SANDEEP JAGGI  
LSI Logic Corporation  
Milpitas

HON. KENT A. JORDAN  
United States District Court  
District of Delaware  
Wilmington, DE

STEPHEN G. KUNIN  
U.S. Patents and Trademark Office  
Washington, D.C.

MICHAEL S. KWUN  
Google, Inc.  
Mountain View

RON LAURIE  
Inflection Point Strategy, LLC  
Palo Alto

MARK A. LEMLEY  
Stanford Law School  
Of Counsel, Keker & Van Nest LLP  
Stanford

KATHERINE KELLY LUTTON  
Fish & Richardson, P.C.  
Redwood City

CHRISTOPHER A. MARTINEZ  
StoneTurn Group  
Austin, TX

L.J. CHRIS MARTINIAK  
Heller Ehrman White &  
McAuliffe LLP  
San Francisco

ROBERT P. MERGES  
Boalt Hall School of Law  
University of California at Berkeley  
Berkeley

JAMES W. MORANDO  
Farella Braun + Martel LLP  
San Francisco

KATE H. MURASHIGE  
Morrison & Foerster LLP  
San Diego

CHRISTIAN H. NADAN  
Sun Microsystems, Inc.  
Santa Clara

ANTONIO PIAZZA  
Gregorio, Haldeman, Piazza,  
Rotman & Matityahu  
San Francisco

JAMES POOLEY  
Milbank, Tweed, Hadley &  
McCloy LLP  
Palo Alto

MATTHEW D. POWERS  
Weil, Gotshal & Manges LLP  
Redwood Shores

LEE VAN PELT  
Van Pelt & Yi  
Cupertino

DANIEL M. WALL  
Latham & Watkins  
San Francisco

HON. RONALD M. WHYTE  
United States District Court  
Northern District of California  
San Jose

RANDALL WULFF  
(invited)  
Wulff Quinby Sochynsky  
Oakland

## PLANNING COMMITTEE

ROBERT BARR  
Cisco Systems, Inc.  
San Jose

KAREN BOYD  
Fish & Richardson P.C.  
Redwood City

CHRISTOPHER J. BYRNE  
National Semiconductor  
Santa Clara

CHARLES S. CROMPTON  
Latham & Watkins  
Menlo Park

DARALYN J. DURIE  
Keker & Van Nest, LLP  
San Francisco

JOSEPH FERRARO  
Ferraro Mediation Group  
Santa Clara

BENJAMIN W. HATTENBACH  
Irell & Manella LLP  
Los Angeles

SANDEEP JAGGI  
LSI Logic Corporation  
Milpitas

RONALD S. LAURIE  
Inflection Point Strategy, LLC  
Palo Alto

MICHELLE LEE  
Google Inc.  
Mountain View

MARK A. LEMLEY  
Stanford Law School  
Of Counsel, Keker & Van Nest LLP  
Stanford

KATHERINE KELLY LUTTON  
Fish & Richardson P.C.  
Redwood City

ALAN H. MACPHERSON  
MacPherson Kwok Chen &  
Held LLP  
San Jose

L.J. CHRIS MARTINIAK  
Heller Ehrman White &  
McAuliffe LLP  
San Francisco

ROBERT P. MERGES  
Boalt Hall School of Law  
University of California at Berkeley  
Berkeley

JAMES POOLEY  
Milbank, Tweed, Hadley &  
McCloy LLP  
Palo Alto

GERALD T. SEKIMURA  
Gray Cary Ware & Freidenrich, LLP  
San Francisco

STEPHANIE SKAFF  
Farella Braun + Martel LLP  
San Francisco

SHIRLEY WEBSTER  
InteCap, Inc.  
a subsidiary of Charles River  
Associates Incorporated  
Houston, TX

MATTHEW F. WEIL  
McDermott, Will & Emery  
Irvine

MICHAEL ESPOSITO  
The University of Texas  
School of Law  
Austin, TX

Stanford Law School and The Boalt Hall School of Law are accredited providers of MCLE by the State of California. The University of Texas School of Law is an accredited sponsor of The State Bar of Texas. The program contains 12.75 MCLE hours, including 1.5 hours of ethics credit.



THE UNIVERSITY OF TEXAS AT AUSTIN  
THE UNIVERSITY OF TEXAS SCHOOL OF LAW  
P.O. Box 7759 • Austin, TX 78713-7759

*This program is not printed or mailed at state expense.*

5th Annual

## ADVANCED PATENT LAW INSTITUTE

December 2-3, 2004 • The Fairmont San Jose • San Jose, CA

**NON-PROFIT-ORG**

U.S. Postage Paid  
The University of  
Texas  
School of Law

E-mail us at

[utcle@mail.law.utexas.edu](mailto:utcle@mail.law.utexas.edu)

or call us at

512-475-6700

for more information