

**2005 Advanced Patent Law Institute**  
**December 1-2, 2005 • Fairmont Hotel, San Jose, CA • San Jose, CA, CA**

**Thursday Morning, Dec. 1, 2005**

**Presiding Officer:**

**Robert Barr**, Berkeley Center for Law and Technology - Berkeley, CA

9:00 am 0.50 hr	<p><b>Limits on Changing Claims During Prosecution</b></p> <p>A discussion of the limitations on adding, changing, and amending claims during prosecution posed by the written description, enablement, and best mode requirements, as well as by the doctrine of prosecution laches.</p> <p>Deanna L. Kwong, Covington &amp; Burling - San Francisco, CA</p>
9:30 am 0.50 hr	<p><b>Pre-filing Investigations, Including Prosecution Perspectives</b></p> <p>This session covers professional obligations in standards of inquiry before filing a declaratory judgment claiming invalidity or unenforceability.</p> <p>Charles S. Crompton, Latham &amp; Watkins LLP - San Francisco, CA</p>
10:00 am 0.75 hr	<p><b>Claim Construction in Light of Phillips</b></p> <p>A discussion and review of the continued Federal Circuit explorations of claims construction—"plain meaning," dictionaries, intrinsic, extrinsic, and other evidence—in light of Phillips.</p> <p>Vernon M. Winters, Weil, Gotshal &amp; Manges LLP - San Jose, CA</p>
11:05 am 0.75 hr	<p><b>Best Practices for Avoiding Claims for Willful Infringement: Options, Opinions and Privilege</b></p> <p>In-house counsel, opinion counsel, and litigation counsel discuss best practices to avoid claims for willful infringement, including practical and ethical issues involving exculpatory patent opinions and special problems involving waiver of privilege, including implications of Knorr-Bremse.</p> <p>Michelle Lee, Google, Inc. - Mountain View, CA Barton E. Showalter, Baker &amp; Botts L.L.P. - Dallas, TX Ragesh Tangri, Kecker &amp; Van Nest LLP - San Francisco, CA</p>
11:50 am 0.50 hr	<p><b>Inequitable Conduct</b></p> <p>A detailed discussion of the inequitable conduct issues faced by IP asset managers and their patent counsel in managing a patent portfolio, prosecuting patent applications, and enforcing U.S. patents.</p> <p>Matthew F. Weil, McDermott, Will &amp; Emery - Irvine, CA</p>

**Thursday Afternoon, Dec. 1, 2005**

**Presiding Officer:**

**Edward C. Kwok**, MacPherson Kwok Chen & Heid LLP - San Jose, CA

1:30 pm 0.50 hr	<p><b>Written Description and Section 112: Impact on Biotech Patenting</b></p> <p>Recent Federal Circuit cases discussing written description suggest that the Court's stance on this doctrine may be shifting. Is biotech finally getting a break in <i>Capon v. Dudas</i>? Is it really all about new matter as suggested in <i>Pandrol v. Airboss</i>? And what might we expect next?</p> <p>Karen Boyd, Patent Mediation and Consulting - Palo Alto, CA</p>
2:00 pm 0.50 hr	<p><b>Doctrine of Equivalents</b></p> <p>How viable is the doctrine of equivalents as an infringement theory post-Festo, and how is it proven at trial?</p> <p>Paul Grewal, Day Casebeer Madrid &amp; Batchelder LLP - Cupertino, CA</p>
2:30 pm 0.50 hr	<p><b>Remedies in Component and Downstream Cases, Including ITC Options</b></p> <p>Discussion of the problems and solutions for the patent owner when an infringing part is used in building a larger system. Includes discussion of avenues for pursuing (1) foreign infringers and assemblers, (2) importers, and (3) domestic sellers, in both district court and the ITC. Will also cover the limits on injunctive relief and customs seizure when the value of the larger system far exceeds the value of the infringing component, and recovering damages for loss of market share and lost profits from foreign infringers.</p> <p>L. Scott Oliver, Milbank, Tweed, Hadley &amp; McCloy - Palo Alto, CA</p>
3:20 pm 0.50 hr	<p><b>Joint Defenses and Joint Defense Privilege</b></p> <p>A discussion of key issues and pitfalls arising in joint defenses, including the latest case law on waiver of privilege.</p> <p>Daralyn Durie, Kecker &amp; Van Nest LLP - San Francisco, CA</p>
3:50 pm 0.50 hr	<p><b>Developing and Protecting IP in China Including Patent Prosecutions</b></p> <p>Key issues and pitfalls in prosecuting and enforcing patents in China, including lessons learned and practical tips on how to win patent infringement suits there.</p> <p>Catherine Sun, Weil, Gotshal &amp; Manges LLP - Shanghai, China</p>
4:20 pm 1.00 hr	<p><b>Judicial Panel</b></p> <p>A panel of distinguished and experienced federal judges will discuss, from a judicial perspective, some of the complexities of patent litigation and how you can help address them.</p> <p>Hon. Jeremy D. Fogel, United States District Court, Northern D - San Jose, CA  Hon. Susan Y. Illston, U.S. District Court For The Northern Dis - San Francisco, CA  Hon. Elizabeth D. Laporte, U.S. District Court For The Northern Dis - San Francisco, CA  Vernon M. Winters, Weil, Gotshal &amp; Manges LLP - San Jose, CA</p>

## Friday Morning, Dec. 2, 2005

### Presiding Officer:

**Jean Burke Fordis**, Finnegan, Henderson & Farabow, et al. - Palo Alto, CA

8:30 am 0.50 hr	<p><b>102 (b)</b></p> <p>What conduct triggers the on sale of public use bars of Section 102(b)? What conduct constitutes experimental use? This discussion will review recent Federal Circuit cases applying Section 102(b) and address the current state of the law.</p> <p>Soyeon Pak Laub, McDermott Will &amp; Emery - Irvine, CA</p>
9:00 am 0.50 hr	<p><b>Inducement and Indirect Infringement</b></p> <p>In its recent Grokster decision, the Supreme Court purported to apply the patent law doctrine of inducement of infringement to claims of copyright infringement. We will explore the extent to which the doctrine as articulated in Grokster in fact goes further than existing patent law, and consider the question of how patent law inducement doctrine might evolve in light of Grokster.</p> <p>Gary N. Frischling, Irell &amp; Manella LLP - Los Angeles, CA</p>
9:30 am 0.75 hr	<p><b>Extraterritoriality</b></p> <p>Federal Circuit cases have extended both prior art and infringement beyond U.S. borders. The Federal Circuit is considering whether to allow U.S. courts to hear foreign patent cases. We will discuss the limits and changes to the territoriality principle.</p> <p>Mark A. Lemley, Stanford Law School - Stanford, CA</p>
10:35 am 0.50 hr	<p><b>The Statutory Research Infringement Exemption: How Far Back Is “Reasonably Related”?</b></p> <p>The U.S. Supreme Court’s decision in Merck KGaA v. Integra Lifesciences I, Ltd., 125 S. Ct. 2372 (2005), enlarging the statutory research exemption to patent infringement of 35 U.S.C. § 271(e)(1), left several questions unanswered. For example: how far back the statutory exemption should apply, and what is the status of the common law experimental use defense to patent infringement. The Court left this specific guidance to the percolation of case law through the district courts and the Federal Circuit.</p> <p>Meredith M. Addy, Brinks Hofer Gilson &amp; Lione - Chicago, IL</p>
11:05 am 0.50 hr	<p><b>Antitrust, Patents, and Standard-Setting</b></p> <p>Recent cases and investigations brought by the Federal Trade Commission and other enforcement agencies have highlighted the risks associated with enforcing patents covering products developed through industry standard-setting efforts. Standard-setting organizations are exploring changing the rules covering the disclosure of patents during the standards process. This session will cover the implications both of increased antitrust enforcement in this area and the standards community’s response, both of which lie at the crossroads of patent and antitrust law.</p> <p>Gil Ohana, Cisco Systems - San Jose, CA</p>
11:35 am 0.75 hr	<p><b>Open Source: Giving Away Patents and Managing Open Source Assets</b></p> <p>This session opens by examining the generous grant of patent right under open source licenses, and the affect such grants have on industry standards. Other types of “give aways” via standards will also be discussed. The session closes with a discussion of practical strategies and policies to manage the use and acquisition of open source assets.</p> <p>Karen F. Copenhaver, Black Duck Software, Inc - Waltham, MA Lawrence Rosen, Rosenlaw &amp; Einschlag Technology Law Offi - Ukiah, CA</p>

## Friday Afternoon, Dec. 2, 2005

### Presiding Officer:

**Christopher J. Byrne**, National Semiconductor - Santa Clara, CA

12:20 pm 0.50 hr	<b>Lunch Presentation: Patent Reform: Winners, Losers and Prospects</b>  Peter N. Detkin, Intellectual Ventures - Los Altos, CA Richard J. Lutton Jr., Apple Computer Inc - Cupertino, CA James Pooley, Morrison & Foerster, LLP - Palo Alto, CA
1:50 pm 0.75 hr	<b>Patent Law and Policy for Public/Private Collaborations</b>  Open collaborations and communication among researchers is probably the best way to promote technological innovation. How will Prop 71 and the CREATE Act fare in fostering a collaborative environment? What lessons can be learned from BayhDole in shaping future laws and policies?  Elizabeth A. Howard, Orrick, Herrington & Sutcliffe LLP - Menlo Park, CA Katherine Ku, Stanford University - Palo Alto, CA Gary H. Loeb, Genentech, Inc. - San Francisco, CA
2:35 pm 0.75 hr	<b>The Market for Buying and Selling IP</b>  A discussion of what's happening, what are options for corporate buyers and sellers, what valuation models are being used, and more.  Ron Laurie, Skadden, Arps, Slate, Meagher & Flom LLP - Palo Alto, CA David L. McCombs, Haynes & Boone, LLP - Dallas, TX Mallun Yen, Cisco Systems, Inc. - San Jose, CA
3:20 pm 0.50 hr	<b>Outlicensing Strategies</b>  A discussion of the factors that a large patent holder considers in establishing a licensing program and evaluating outbound license grants.  John F. Schiffhauer, Intel Corporation - Santa Clara, CA