



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



7<sup>TH</sup> ANNUAL

# ADVANCED PATENT LAW INSTITUTE

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November 29\*, 30-December 1, 2006  
The Fairmont San Jose  
San Jose, California

\*Evening Session on Effective Advocacy Techniques—Included in Registration Fee

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ADVANCED PATENT LAW INSTITUTE

November 29\*, 30-December 1, 2006 • The Fairmont San Jose • San Jose, CA

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WEDNESDAY EVENING—NOV. 29, 2006\*

6:00 p.m. Registration Opens

6:30 p.m. 2.00 hrs

**Effective Advocacy Techniques: Mock Trials, Witness Preparation, and Preparation of Experts**

Beyond meritorious facts, winning patent litigation requires presenting complex technology and confusing patent law concepts to juries in compelling and comprehensible advocacy. This discussion will explore how to test themes, witnesses and experts in mock trials, and how to apply the results in preparing witnesses and experts to credibly deliver the themes, facts and opinions.

Moderator: Lynn H. Pasahow, Mountain View, CA  
William L. Anthony, Jr., Menlo Park, CA  
Juanita R. Brooks, San Diego, CA  
Daralyn J. Durie, San Francisco, CA  
David H. Weinberg, Greenbrae, CA

8:30 p.m. Adjourn

THURSDAY MORNING—NOV. 30, 2006

Presiding Officer: Robert Barr, Berkeley, CA

8:00 a.m. Registration Opens

Includes continental breakfast.

8:50 a.m. Welcoming Remarks

9:00 a.m. .50 hr

**Current Developments in Claim Construction**

The Federal Circuit is one year post-*Phillips v. AWH*. Where does the court appear to be on claim construction and what effect has it had?

Matthew D. Powers, Redwood Shores, CA

9:30 a.m. .50 hr

**Obviousness**

A discussion of the current state of obviousness law, including the pending *KSR Int'l Co. v. Teleflex, Inc.* case before the Supreme Court.

Christopher A. Cotropia, Richmond, VA

10:00 a.m. .75 hr

**Reexaminations During the Course of Litigation: What Should You Do?**

Parties, and in particular defendants, in patent cases are increasingly requesting reexaminations of patents during the course of litigation. This session considers empirical data and discusses factors to consider in seeking reexamination during litigation, including the impact and timing of reexamination.

Katherine Kelly Lutton, Redwood City, CA  
David L. McCombs, Dallas, TX

10:45 a.m. Break

11:00 a.m. 1.00 hr

**Strategic Patent Prosecution**

This session will discuss filing and prosecution strategy from the perspective of the in-house counsel, including issues of prioritization, budgeting and outreach; prosecution strategy in re-examination proceedings, accelerated examination, and how to conduct effective personal interviews with patent examiners. Other topics include dealing with many-fold restriction issues and getting ready for the potential implications of the proposed PTO rule changes; and addressing obviousness and lack of utility rejections.

Ginger R. Dreger, Menlo Park, CA  
Michelle Lee, Mountain View, CA  
Lee Van Pelt, Cupertino, CA

12:00 p.m. Lunch on Your Own

THURSDAY AFTERNOON

Presiding Officer: Alan H. MacPherson, San Jose, CA

1:00 p.m. .75 hr including .25 hr ethics

**Pre-Filing Considerations and Strategies in Patent Cases**

Strategic and financial considerations about where to file a patent case. The discussion will include an analysis of how "conventional wisdom" about forum selection compares with actual data about the most popular fora. This session will also cover professional obligations lawyers must satisfy when filing patent suits.

Charles S. Crompton, San Francisco, CA  
Jonathan S. Kagan, Los Angeles, CA

1:45 p.m. .50 hr ethics

**Echoes from *EchoStar*: Waiver Issues in the Election to Rely on an Opinion of Counsel**

Vernon M. Winters, Redwood Shores, CA

2:15 p.m. .50 hr ethics

**Inequitable Conduct: Modern Trends**

A review of recent cases from the Federal Circuit addressing issues such as the materiality standard for inequitable conduct, the duty of disclosure, and what rises to the level of intent. The program will also focus on proposed patent reform legislation and how it may alter the law regarding inequitable conduct.

Matthias A. Kamber, San Francisco, CA

2:45 p.m. .50 hr

**The Doctrine of Equivalents, Reverse Doctrine of Equivalents: Mythical Doctrines of Patent Law?**

Much ink has been spilled in briefing, case law, and law review articles on the Doctrine of Equivalents (and related prosecution history estoppel), and Reverse Doctrine of Equivalents. But, as a practical matter, do these doctrines really exist? How often do they win the day? More importantly, when and how do they win the day? This talk will explore the historical and current importance of these doctrines, and may also highlight a few other mythical creatures of patent law.

Karen Boyd, Redwood City, CA

3:15 p.m. Break

3:30 p.m. .50 hr

**Divided and Indirect Infringement**

Distributed technologies, such as client server systems or other network-related technologies, increasingly entail the interactive functioning of more than one party. Such technologies are generating cases that are pressing the limits of the traditional patent law system which presumed a single actor practicing an invention that existed in a single place. This session will review the state of the law and consider where it might be going.

Robert D. Fram, San Francisco, CA

4:00 p.m.

.50 hr

**Extraterritoriality**

The Federal Circuit has recently expanded the ability of U.S. patent holders to redress infringement that occurs in whole or in part beyond U.S. borders, in some cases imposing liability for foreign companies, and in other cases dramatically increasing the damages exposure of domestic manufacturers. This session discusses the recent developments in this increasingly important topic and provides suggestions both for expanding the reach of your patent portfolio to cover competitors' activities, and for limiting your potential exposure.

Erik R. Puknys, Palo Alto, CA

4:30 p.m.

.50 hr

**Inherency**

A discussion and review of recent Federal Circuit decisions regarding the inherency doctrine.

Craig R. Kaufman, Menlo Park, CA

5:00 p.m.

.75 hr including .25 hr ethics

**Judicial Panel**

Leading district court judges discuss effective litigation procedures and practices, and peeves (pet or otherwise) with IP cases and trial lawyers.

Moderator: Kenneth R. Adamo, Dallas, TX  
Hon. Patti B. Saris, Boston, MA  
Hon. Ronald M. Whyte, San Jose CA

5:45 p.m.

Adjourn

**FRIDAY MORNING—DEC. 1, 2006**

**Presiding Officer: Christopher J. Byrne,  
Santa Clara, CA**

7:30 a.m.

1.25 hrs

**Breakfast Discussion:****International Patent Prosecution Issues, Strategies and Tactics**

In an increasingly global economy, the issues, strategies and tactics for successful international patent prosecution are paramount. This is particularly true for ascendant economies and countries in the Asia/Pacific region, but continually important for Europe as well. This panel of seasoned patent professionals will discuss their approaches and experiences in an engaging and informative interactive format.

Moderator: Richard "Chip" J. Lutton, Jr.,  
Cupertino, CA  
Philip McGarrigle, Santa Clara, CA  
Speaker TBD  
Speaker TBD

8:45 a.m.

Break

8:55 a.m.

.75 hr

**Written Description May Have Some Bite**

Decisions at the Federal Circuit signal an increasing willingness to apply the written description requirement, even in the predictable arts. This talk will review recent court decisions, offer some predictions for the future, and suggest both litigation and prosecution strategies in view of this developing defense.

Gary H. Loeb, San Francisco, CA  
Barton "Bart" E. Showalter, Dallas, TX

9:40 a.m.

.75 hr

**Patent Prosecution Procedure: New Rules, Continuations, and Regulations**

As the USPTO moves forward with publishing the final rules on Continuing Prosecution, Claim Designation, and perhaps Information Disclosure Statements, practitioners are preparing for the implementation of the rules. This talk provides a brief summary of the rules but focuses on implementation strategy.

Jean Burke Fordis, Palo Alto, CA  
William Leschensky, Palo Alto, CA

10:25 a.m.

.50 hr

**Declaratory Judgment Jurisdiction After *MedImmune***

The Supreme Court granted certiorari in *MedImmune v. Genentech* to address when a patent licensee in good standing can challenge the validity of a patent. This session reviews declaratory judgment jurisdiction in light of that case including the "actual controversy" requirement of the Declaratory Judgment Act, and the public policy regarding patent validity challenges as applied in the Supreme Court's 1969 decision in *Lear v. Adkins*.

Daniel M. Wall, San Francisco, CA

10:55 a.m.

Break

11:05 a.m.

.50 hr

**Exhaustion and Implied License**

A discussion of (i) how the doctrine of patent exhaustion and implied license affect vendors and customers, (ii) what parties to patent license agreements may do—or may not do—to limit those effects, and (iii) how courts have blurred the distinction between the two doctrines.

Rufus Pichler, San Francisco, CA  
William I. Schwartz, San Francisco, CA

11:35 a.m.

.75 hr

**Injunctions and Damages After *e-Bay***

A discussion of the Supreme Court's *e-Bay* decision and its impact on patent litigation, as well as the problem of royalty stacking in damages cases.

Mark A. Lemley, Stanford, CA

**FRIDAY AFTERNOON**

**Presiding Officer: Jean Burke Fordis,  
Palo Alto, CA**

**LUNCHEON PRESENTATION**

12:20 p.m.

Pick Up Box Lunch

Included in conference registration fee.

12:35 p.m.

.75 hr

**David Nelson Memorial Keynote Address**

sponsored by Morrison & Foerster LLP

**The USPTO Strategic Plan**

The USPTO is in the process of developing its strategic plan for the next five years. This session will discuss what the Office is anticipating in terms of possible changes in the agency and patent law into the next decade.

James A. Toupin, United States Patent and  
Trademark Office, Alexandria, VA

1:30 p.m.

.50 hr

**Create Act and Joint Ownership**

Sec. 103(c) of the patent statute provides that the work of joint development partners may not be cited as prior art against patent applications arising from the joint development. This session will review the history of that legislation and the requirements under PTO practice for taking advantage of its protection.

Robert J. Goldman, Palo Alto, CA

2:00 p.m.

.75 hr

**Antitrust, Patents, and Standard-Setting**

Recent cases brought by the Federal Trade Commission and other enforcement agencies have highlighted the risks associated with enforcing patents covered products developed through industry standard-setting efforts. The recent *In re Rambus* decision is reviving interest in antitrust remedies in patent cases. Increased attention in the European Union to standards issues also has raised the international implications of standard-setting. This session covers the implications of increased antitrust enforcement and litigation in this area, which lies at the crossroads of patent and antitrust law.

M. Sean Royall, Dallas, TX and Washington, DC

**Online Courses**  
**from UT Law**  
**www.utcle.org**

2:45 p.m. .50 hr

### Investing in IP

The speakers will discuss two models for investment in IP. The first uses a valuation model that is based upon the utility of the IP, based upon the potential to receive royalties from assertion or from the value to a buyer seeking improved freedom of action. The second views IP as the core element of a more broadly defined "Technology Asset," where value is derived from the demand-market value of products, or product improvements that are enabled by the asset. Mr. Kramer will present a brief history of IP investing, why Altitude Capital Partners is drawn to IP as an asset class, what it invests in, and why. Mr. Pellegrini will discuss the factors that determine the "transaction readiness" and valuation of the more broadly defined Technology Asset and how investment and sponsorship can improve those factors.

Robert Kramer, New York, NY  
Joseph C. Pellegrini, Boston, MA

3:15 p.m. .50 hr including .25 hr ethics

### Electronic Discovery Landmines to Avoid

The new electronic discovery rules take effect December 1, 2006: this session covers key issues under the new rules and key case law developments of interest to patent practitioners.

Michelle Greer Galloway, Palo Alto, CA

3:45 p.m. Adjourn

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☐ Early Registration Fee due by Wednesday, Nov. 22, 2006 ..... \$745.00

☐ Registration Fee after Wednesday, Nov. 22, 2006 ..... \$795.00

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## SAN JOSE

Nov. 29\*, 30-Dec. 1, 2006

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### KEY DATES

#### Registration & Cancellation

November 22, 2006—5 p.m.  
*last day for early registration*  
add \$50 for registrations  
received after this time

November 27, 2006—5 p.m.  
*last day for full refund*

November 28, 2006—5 p.m.  
*last day for partial refunds*  
\$50 processing fee applied

November 29, 2006—6:30 p.m.  
*Wednesday evening session begins*

November 30, 2006—9 a.m.  
*conference begins*

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### PATENT LAW IN AUSTIN, TX

**Oct. 25, 26-27, 2006 • Four Seasons Hotel**

Join leading practitioners, academics and in-house counsel from the Southwest and Silicon Valley in Austin, Texas for two days of presentations on a rich array of prosecution and litigation topics. Cool weather, great city, music and food—at the Four Seasons Austin.



### PATENT LAW IN ALEXANDRIA, VA

**Nov. 16-17, 2006 • USPTO—Main Auditorium**

This conference—offered at the USPTO—provides unique insights into claim construction; standard-setting and pooling; avoiding patent infringement; remedies and injunctions; the search process; patent reform and USPTO patent quality initiatives. Join USPTO senior staff, leading practitioners, academics and members of the federal judiciary from a variety of courts and forums in the Washington DC area, for two days at the USPTO. The conference is jointly sponsored with the George Mason University School of Law.



### PATENT LAW IN SAN JOSE, CA

**Nov. 29, Nov. 30-Dec.1, 2006 • The Fairmont San Jose**

Come to the heart of Silicon Valley, and join leading judges, practitioners and in-house counsel from Apple, Google, and National Semiconductor at the Fairmont San Jose. This conference is jointly sponsored by the Berkeley Center for Law and Technology at Boalt Hall School of Law and Stanford Law School.

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