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November 28*, 29-30, 2007
The Fairmont San Jose
San Jose, California

* Evening Sessions on Fees and Licensing—Included in Registration

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November 28*, 29-30, 2007 • The Fairmont San Jose • San Jose, CA

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WEDNESDAY EVENING – NOV. 28, 2007

5:30 p.m. Registration Opens

Light buffet provided.

6:00 p.m. 1.00 hr

Controlling Fees: Creative Billing Structures, ADR, and the Management of IP Legal Fees

A panel of outside counsel discusses approaches to managing legal expenses, including using in-house counsel for work historically done by outside counsel, using mediation throughout a dispute, non-billable-hour-based fee structures in major litigations, and controlling costs in portfolio management by increasing communication and accountability. The panel will address the nuts-and-bolts of their approaches, where they've worked, and where they haven't.

Moderator: Karen Boyd, Patent Mediation and Consulting, Palo Alto, CA

Barbara A. Caulfield, Affymetrix, Inc., Santa Clara, CA

Rick Frenkel, Cisco Systems, Inc., San Jose, CA

Meg Snowden, Impax Laboratories, Inc., Hayward, CA

Wayne P. Sobon, Accenture, San Jose, CA

7:00 p.m. Break

7:15 p.m. 1.00 hr

Licensing, Portfolio Monetization and the Future of Contingency Fee Patent Litigation

A discussion of the business of acquiring, valuing, licensing, and asserting patents, covering current trends impacting the business, from the point of view of those who view their patent portfolio as a necessary defensive evil, those who see it as a valuable profit center, and those for whom asserting patents is a business model unto itself.

Moderator: Matthew F. Weil, McDermott, Will & Emery, Irvine, CA

Ron Epstein, IPotential, LLC, San Mateo, CA
Vincent Pluvinage, Intellectual Ventures, Bellevue, WA

Ronald J. Schutz, Robins, Kaplan, Miller & Ciresi L.L.P., Minneapolis, MN

8:15 p.m. Adjourn

THURSDAY MORNING – NOV. 29, 2007

Presiding Officer:

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

8:00 a.m. Registration Opens

Includes continental breakfast.

8:50 a.m. Welcoming Remarks

9:00 a.m. .50 hr

Indirect and Divided Infringement

This session will address indirect infringement in a Post-DSU World as well as the emerging questions concerning divided infringement.

Mark A. Lemley, Stanford Law School, Of Counsel, Kecker & Van Nest, LLP, Stanford, CA

9:30 a.m. 1.00 hr

Strategic Patent Prosecution

2007 has seen the most significant changes to patent law since 1952. The panel will discuss how prosecution strategy must change in the new environment. Highlighted topics will include the new continuation rules, claim limits, examination support documents and divisionals, obviousness after *KSR*, the scope of enablement requirements and prosecution disclaimer.

Jean Burke Fordis, Finnegan, Henderson, Farabow, Garrett & Dunner, LLP, Palo Alto, CA

Alan H. MacPherson, MacPherson Kwok Chen & Heid LLP, San Jose, CA

Lee Van Pelt, Van Pelt, Yi and James, Cupertino, CA

10:30 a.m. Break

10:45 a.m. .75 hr

USPTO Rule Changes and Initiatives

Continuation rule changes and their strategic implications will be discussed. PTO initiatives, including accelerated examination, pre-appeal briefs, peer to patent pilot program, and the highway pilot program with the JPO will also be addressed.

William S. Galliani, Cooley Godward LLP, Palo Alto, CA

11:30 a.m. .75 hr

Reexaminations After *KSR*

KSR International v. Teleflex, Inc. has been called "the most important patent case of the last 20 years." It is widely thought that *KSR* made it much easier to invalidate patents for obviousness and, in particular, increased the attractiveness of reexamination proceedings to patent defendants. This session will discuss potential reexamination strategies and recent empirical data from the perspective of the PTO, patent owners, and litigants.

Marc David Peters, Morrison & Foerster LLP, Palo Alto, CA

USPTO Representative - TBA

LUNCHEON PRESENTATION

12:15 p.m. Pick Up Box Lunch

Included in conference registration fee.

12:30 p.m. .75 hr

Forum Selection

Venue is a crucial consideration for patent litigators and their clients. The benches, jury pools, local rules, and outcomes differ greatly among the jurisdictions handling a significant number of patent cases. This panel discussion will provide data and anecdotes to help evaluate and compare these jurisdictions.

Moderator: Charles S. Crompton, Latham & Watkins LLP, San Francisco, CA

Ruffin B. Cordell, Fish & Richardson P.C., Washington, DC

David H. Weinberg, JuryScope, Inc., Greenbrae, CA

THURSDAY AFTERNOON

Presiding Officer:

Alan H. MacPherson, MacPherson Kwok Chen & Heid LLP, San Jose, CA

1:30 p.m. .75 hr

Developments in Claims Construction

Overshadowed by the U.S. Supreme Court/ Federal Circuit colloquy, this core issue has percolated along quietly. This year's pitfalls and construction trends of the moment will be explored, with an eye toward a more tactical approach to *Markman* mechanisms responsive to those trends. The Federal Circuit still controls the keys to the kingdom, but are the locks secure?

Kenneth R. Adamo, Jones Day, Dallas, TX

2:15 p.m. 1.00 hr ethics

Privilege Waiver, Work Product Immunity, and the Trial Counsel Exemption: The New Rules for Everyone

The Federal Circuit's decision in *In re Seagate* re-wrote the rules on willful infringement and the advice-of-counsel defense. The changes will impact everyone—in-house and outside counsel, trial and opinion counsel. Panel members will summarize the critical changes from *In re Seagate* and other recent cases, then consider their impact on each stage of a typical patent litigation matter. The discussion will include the new "objective recklessness" standard for willfulness, the new scope of privilege waivers, and the new questions left unanswered by the Federal Circuit.

Moderator: Mallun Yen, Cisco Systems, Inc., San Jose, CA

Robert D. Fram, Heller Ehrman LLP, San Francisco, CA

David L. McCombs, Haynes and Boone, LLP, Dallas, TX

Erik R. Puknys, Finnegan, Henderson, Farabow, Garrett & Dunner, LLP, Palo Alto, CA

3:15 p.m. Break

3:30 p.m. .50 hr ethics

Inequitable Conduct

A review of current issues relating to the inequitable conduct defense, including the most recent Federal Circuit case law on materiality, intent and the balancing test to assess enforceability of a patent in suit.

Robert J. Goldman, Ropes & Gray, LLP, Palo Alto, CA

4:00 p.m. .50 hr

Extraterritoriality of U.S. Patent Law after *Microsoft v. AT&T*

The Supreme Court's decision in *Microsoft v. AT&T* certainly narrowed the applicability of U.S. Patent Law to foreign activities. This discussion will focus on whether arguments still remain for liability under U.S. Patent Law for non-U.S. activities and how the courts likely are to respond to those arguments.

Christopher W. Kennerly, Baker Botts L.L.P., Dallas, TX

4:30 p.m. 1.00 hr including .25 hr ethics

Judicial Panel

In a time of evolving patent landscape and increased activity in the Supreme Court, legislature and Patent and Trademark Office, a panel of distinguished District Court Judges discuss their experiences with, and thoughts on, managing, hearing and trying patent cases.

Moderator: Katherine Kelly Lutton, Fish & Richardson P.C., Redwood City, CA

Hon. David J. Folsom, United States District Court, Eastern District of Texas, Texarkana, TX

Hon. Ronald M. Whyte, United States District Court, Northern District of California, San Jose, CA

Hon. Lee Yeakel, United States District Court, Western District of Texas, Austin, TX

5:30 p.m. Adjourn

FRIDAY MORNING – NOV. 30, 2007

Presiding Officer:

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

7:30 a.m. Conference Room Opens

Includes continental breakfast.

8:00 a.m. .75 hr ethics

E-Discovery Update: Rules, Case Law and Obligations

The new e-discovery rules were implemented a year ago and this session will provide practitioners with valuable insight on their impact to patent litigation. Our panel of outside and in-house counsel will share their unique perspectives on the pitfalls and opportunities presented by electronic discovery, and they will identify real world best practices for dealing with complex technological and strategic challenges. The panel will also discuss emerging trends and key learnings from the case law so that you will be prepared to provide expert guidance to your clients regarding e-discovery.

Allon Stabinsky, Intel Corporation, Santa Clara, CA

Glenn E. Westreich, Nixon Peabody LLP, San Francisco, CA

8:45 a.m. .50 hr ethics

Subject Matter Conflicts

A discussion of ethics and risk management issues arising in intellectual property practice, including technical subject matter conflicts, client identity issues, and recent developments.

John Steele, Fish & Richardson, P.C., Redwood City, CA

9:15 a.m. 1.00 hr

MedImmune and Licensing

This session explores the state of Article III jurisdictional requirements for patent validity challenges by patent licensees after the Supreme Court's rejection of the "reasonable apprehension of suit" test in *MedImmune v. Genentech*. It also examines the viability of a merits-based defense to such a challenge based on licensee estoppel. Finally, the panel will present and discuss the potential enforceability of various licensing provisions, such as "no challenge" clauses and "termination for challenge" clauses, intended to restore some balance to patent licensing relationships in the wake of the *MedImmune* decision.

Tim Crean, SAP AG, Palo Alto, CA

Alfred C. Server, M.D., Ph.D., Wilmer Cutler Pickering Hale and Dorr LLP, Boston, MA

Hannah Shen-Mei Williams, Genentech, Inc., San Francisco, CA

10:15 a.m. Break

10:30 a.m. .50 hr

Saying Too Much or Not Enough: The Uncomfortable Tension of Claim Breadth, Enablement, and Written Description

This presentation will center on the recent developments in the case law related to enablement and written description, including pitfalls of claim drafting and litigation strategies for validity challenges.

I. Neel Chatterjee, Orrick, Herrington & Sutcliffe LLP, Menlo Park, CA

11:00 a.m. .50 hr

Obviousness after *KSR*

In *KSR*, the Supreme Court changed the standard for obviousness. We now know what the correct test is not, but the Supreme Court did not clearly articulate what it is. This session will discuss obviousness cases post-*KSR*, the current relevance of secondary indicia of non-obviousness, and the likely impact of *KSR* going forward.

Daralyn J. Durie, Keker & Van Nest, San Francisco, CA

11:30 a.m. .50 hr

The Merged Implied License and Exhaustion Doctrines—Is there a Divorce in the Future?

Federal Circuit authority renders the implied license doctrine and the exhaustion doctrine nearly indistinguishable. Yet, the underpinnings of each are entirely different, the former in contract law and the latter in constitutional law. Recognizing that difference, should the exhaustion doctrine be given an identity of its own with clearly unique attributes and characteristics?

William L. Anthony, Jr., Orrick, Herrington & Sutcliffe LLP, Menlo Park, CA

12:00 p.m. Lunch on Your Own

FRIDAY AFTERNOON

Presiding Officer:

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

1:15 p.m. .50 hr

Patent Prosecution Study

A major new study of patent prosecution reveals the hidden truth about the PTO's actual grant rates, the use of continuations, and the shocking facts about which industries face the toughest prosecutions.

Mark A. Lemley, Stanford Law School, Of Counsel, Keker & Van Nest, LLP, Stanford, CA

1:45 p.m. .50 hr

The Dark Forest of § 101 Subject Matter: Software, Business Methods & Tax Schemes, Oh My!

As technology and human knowledge advance, attempts to patent those advances can challenge prevailing law, policy and wisdom. This session will examine current “taxing” subject matter areas, including business methods, tax schemes, check processing, and other areas of innovation under attack for patentability. We will briefly overview both U.S. and other responses to these challenges, and note the state of any legislative or judicial actions.

Wayne P. Sobon, Accenture, San Jose, CA

2:15 p.m. .75 hr

Remedies: Damages, Injunctions, and the Pendulum Swing

In the last year there has been a movement in both the courts and Congress to rein in what many claim is a legal framework too favorable to patent owners. Are damages and injunction doctrines broken and in need of fixing? What should a reasonable royalty be when a patent covers only a small improvement to a complex product or system? When should non-competitors such as individual inventors and research institutions be entitled to injunctions? With the pendulum swinging, what is the reasonable balance that should be struck, and will we go too far in restricting patent remedies? This session will cover key recent developments and their implications for the future of patent remedies.

Gary H. Ritchey, Ph.D., Townsend and Townsend and Crew LLP, Palo Alto, CA

Julie S. Turner, The Turner Law Firm, Palo Alto, CA

3:00 p.m. .75 hr

Antitrust and SSO Developments

Litigation at the intersection of standards development, antitrust, and patent law has been increasing. This session will cover the assertion of antitrust, unfair competition, and related defenses to the assertion of patents that are alleged to be essential to implement standards. It will also address responses by the standards development community and government antitrust enforcers to the increased prominence of patent-related issues in standards development.

John (Jay) A. Jurata, Heller Ehrman LLP, Washington, DC

Gil Ohana, Wilmer Cutler Pickering Hale and Dorr LLP, Palo Alto, CA

3:45 p.m. Adjourn

3:45 p.m.

Possible Patent Reform “Add-On” Session

See www.utcle.org for program updates.

Patent Reform .75 hr

This session will take place *IF* patent reform legislation is passed by both the House and the Senate, and will address key provisions and implications. If legislation is not passed by both houses, this session will not be offered.

Speakers TBA

4:30 p.m. Adjourn

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visit www.fisterrastudio.com

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P.O. Box 7759, Austin, TX 78713-7759 or fax a copy to: (512) 475-6876

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☐ Early Registration Fee due by Wednesday, Nov. 21, 2007 \$775.00

☐ Registration Fee after Wednesday, Nov. 21, 2007 \$825.00

CONFERENCE PUBLICATIONS AND MEDIA

Allow 2-4 weeks from the conference date for delivery.

☐ Course Binder *Without* Conference Registration \$200.00

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SAN JOSE

November 28*, 29-30, 2007

CONFERENCE LOCATION



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170 South Market Street
San Jose, CA 95113
866-540-4494
408-998-1900

SPECIAL ROOM RATE \$169

good through October 29, 2007
(subject to availability)

Parking: Valet Only: \$26;
self parking lots nearby
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KEY DATES

Registration & Cancellation

November 21, 2007—5 p.m.

last day for early registration
add \$50 for registrations
received after this time

November 23, 2007—5 p.m.

last day for full refund

November 26, 2007—5 p.m.

last day for partial refunds
\$50 processing fee applied

November 28, 2007—6 p.m.

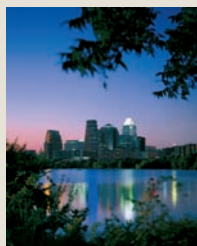
Wednesday evening session begins

November 29, 2007—9 a.m.

institute begins

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PATENT LAW IN SAN JOSE, CA

Nov. 28, Nov. 29-Dec.1, 2007

The Fairmont San Jose

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