UT LAW CLE Continuing Legal Education

11th Annual Advanced Patent Law Institute - Silicon Valley
December 9-10, 2010 • Four Seasons Hotel • Palo Alto, CA, CA

Thursday Morning, Dec. 9, 2010

Presiding Officer:
Robert Barr, Berkeley Center for Law & Technology - Berkeley, CA

7:45 am	**Registration Opens** Includes continental breakfast.
8:30 am	**Welcoming Remarks**
8:40 am 0.33 hr	**Patent Prosecution: The PTO's Use of Prior Art Submissions** A short look at some recent empirical results on what examiners do (and don't) pay attention to. Mark A. Lemley, Stanford Law School - Stanford, CA
9:00 am 0.75 hr	**Claim Drafting Strategies: Prosecutor and Litigator Perspectives on Drafting and Prosecuting Claims** The prosecutor has thousands of dollars to draft and negotiate issued claims. The litigator has millions of dollars to argue over what they mean. Given the backdrop of the current patent law, this panel considers what claims drafting techniques can be taken to strengthen your patents for litigation, without exceeding your prosecution budget. Moderator: Michael J. Schallop, Van Pelt, Yi & James LLP - Cupertino, CA Panelists: Michael W. Farn, Fenwick & West LLP - Mountain View, CA Panelists: Erik R. Puknys, Finnegan, Henderson, Farabow, Garrett & Dunner, LLP - Palo Alto, CA
9:45 am 0.50 hr	**Managing Patent Prosecution and Portfolios: Effective Use of New USPTO Options and Initiatives** An evaluation of rule and policy changes at the USPTO under David Kappos, including recommendations and cautions for managing corporate portfolios. Duane R. Valz, Chadbourne & Parke LLP - Los Angeles, CA
10:15 am	**Break**
10:30 am 0.75 hr	**Reexamination and Concurrent Patent Litigation** A tour of the parallel universe of patent reexamination and concurrent patent litigation in the district courts and the USITC. Hot button topics to be addressed include PTO stats and timelines, the SNQ requirement, request requirements, ex parte interviews, responses to Office Actions and the use of declaration evidence, *KSR* issues, petition practice, protective orders and the duty of disclosure, stays, use of reexam developments in trial, difference standards between reexams and the courts, and concurrency issues between tribunals.

	Moderator: Robert Greene Sterne, Sterne, Kessler, Goldstein & Fox, P.L.L.C. - Washington, DC Panelist: Barton 'Bart' E. Showalter, Baker Botts L.L.P. - Dallas, TX
11:15 am 0.50 hr	**Examiner Interviews: Why, When and How** Interviews with examiners can advance common understanding of an invention, resolve conflicts in interpreting claims and prior art, and efficiently move cases toward allowance, but few practitioners receive training or think strategically about effective interview structure and presentation. In this session, a litigator and a prosecutor address key considerations and skills in the art of planning and holding the interview, with mock dialogue to illustrate particular techniques and a discussion of visual presentation tools. Karl J. Kramer, Morrison & Foerster LLP - Palo Alto, CA Christopher J. Palermo, Hickman Palermo Truong & Becker LLP - San Jose, CA
11:45 am 0.83 hr	**Successful Multilateral International Patent Prosecution** Successfully building a valuable international patent portfolio is a tremendous challenge in light of differences in local laws and patent practices. Panelists from Australia and the United Kingdom provide perspectives across a range of industries. Moderator: Edward Van Gieson, Beyer Law Group LLP - Cupertino, CA Panelists: Richard Howson, Kilburn & Strode LLP - London, United Kingdom Panelists: Anthony Lee, Madderns Patent & Trade Mark Attorneys - Adelaide, Australia

Thursday Afternoon, Dec. 9, 2010

Presiding Officer:
James Pampinella, Navigant Consulting, Inc. - San Francisco, CA

	LUNCHEON PRESENTATION Sponsored by Covington & Burling LLP
12:35 pm	**Pick up Lunch** Included in conference registration fee.
12:50 pm 0.75 hr	**Patentable Subject Matter: Back in the Federal Circuit's Court** In *Bilski*, the Supreme Court reaffirmed the bar against patenting "abstract ideas" while rejecting the exclusivity of a machine-or-transformation test for process patentability. Where might the law go from here, and how might private parties react? Mark A. Lemley, Stanford Law School - Stanford, CA Robert R. Sachs, Fenwick & West LLP - San Francisco, CA
1:35 pm	**Break**
1:50 pm 0.75 hr	**Antitrust Issues: Patent Pooling, Aggregators, Misuse, SSOs, etc.** Deception in the standard-setting context has been a major issue for regulators and private litigants on

	both sides of the Atlantic. This session looks at the most recent developments and what they mean for licensees, licensors and SSO administrators. In addition, the Federal Circuit's August 2010 decision in *Princo Corp.* has brought the misuse doctrine back into the spotlight. This presentation also discusses the impact of *Princo* and likely future developments. Hanno F. Kaiser, Latham & Watkins LLP - San Francisco, CA
2:35 pm 0.50 hr	**Anticipating the Worst: Anti-Injunction Strategies, Design Arounds and Avoiding Contempt Proceedings** This session addresses the impact of recent decisions concerning injunctions, design arounds and contempt proceedings, including *i4i v. Microsoft* and *TiVo v. Echostar*, especially from the defense perspective. The need for early planning is explored, as well as strategies for injecting design arounds into the underlying action to avoid injunctions and contempt proceedings. Michael A. Ladra, Wilson, Sonsini, Goodrich & Rosati - Palo Alto, CA Michael J. Malecek, Kaye Scholer LLP - Menlo Park, CA
3:05 pm 0.50 hr ethics	**Spoliation and Its Impact on Patent Litigation and Document Hold Practices** Spoliation can have a substantial impact on patentees seeking to enforce their patents as well as defendants. This session covers some interesting current legal issues in the context of patent infringement suits and spoliation, including a discussion of a number of different matters where spoliation may have impacted the outcome and the different ways courts have addressed spoliation issues. Eric R. Lamison, Kirkland & Ellis LLP - San Francisco, CA
3:35 pm	**Break**
3:50 pm 0.75 hr	**Patent Defense 2.0: New Models in Patent Disputes** Patent litigation is expensive, risky and time consuming. This panel considers emerging alternative and counter strategies including reexamination, collective buying, crowd sourcing, use of aggregators and other innovative approaches. Moderator: Glenn E. Westreich, Haynes and Boone, LLP - San Jose, CA Panelists: Chip Lutton, Apple Inc. - Cupertino, CA Panelists: Joseph Siino, Ovidian Group, LLC - Berkeley, CA Panelists: Mallun Yen, RPX Corporation - San Francisco, CA
4:35 pm 0.92 hr 0.50 hr ethics	**Judicial Panel** Leading District Court judges discuss cutting-edge and patent litigation issues. Moderator: Vernon M. Winters, Greenberg Traurig LLP - San Francisco, CA Panelists: Hon. Andrew J. Guilford, U.S. District Court, Central District of California - Santa Ana, CA Panelists: Hon. Lucy H. Koh, U.S. District Court, Northern District of California - San Jose, CA
5:30 pm	**Adjourn**

Friday Morning, Dec. 10, 2010

Presiding Officer:
Christopher J. Byrne, Tessera, Inc. - San Jose, CA

8:00 am	**Conference Room Opens** Includes continental breakfast.
8:30 am 0.50 hr ethics	**Inequitable Conduct** The Federal Circuit's decision to revisit the inequitable conduct doctrine in *Therasense* has brought this area of the law to a crossroads. The presentation looks at the en banc briefing and argument that is scheduled to take place in November 2010, and considers whether the law is likely to change and, if so, how. In addition, the speaker discusses best practices under the current law to avoid charges of patent unenforceability and to defeat such charges at trial if necessary. Robert J. Goldman, Ropes & Gray, LLP - East Palo Alto, CA
9:00 am 0.50 hr	**Design Patents and Utility Patents: Where the Twain Meet and Even Overlap** Statutory subject matter for design patents must be “ornamental,” while that for utility patents must be “useful.” For design patents, the ornamental boundary is defined by the doctrine of functionality, while for utility patents, usefulness is couched in terms of providing some identifiable benefit. This presentation analyzes those boundaries, and shows how they can actually overlap, i.e., how design patents can be used to protect functional features of products, and how utility patents can be used to protect ornamental features. Perry Saidman, Saidman DesignLaw Group, LLC - Silver Spring, MD
9:30 am 0.75 hr	**Licensing Update** A look at recent developments and trends related to patent licensing (in the areas of patent misuse, licenses vs. covenants not to sue, and exhaustion), as well as an examination of the issues and trends regarding patents and standards, and the intersection of patents and open source licenses and projects. Karen N. Ballack, Weil, Gotshal & Manges LLP - Redwood City, CA Gary Ross, NetApp, Inc. - Sunnyvale, CA
10:15 am	**Break**
10:30 am 0.50 hr	**Patent Marking: True AND False** Proper patent marking can vastly increase your ability to recover damages, but overdoing it can lead to scary liability for false marking. This session covers the basics of proper marking, as well as the nuances of the quickly evolving false marking case law. Karen Boyd, Turner Boyd LLP - Mountain View, CA
11:00 am 0.75 hr	**ITC Section 337 Patent Enforcement Update** This session examines the emergence of the ITC as a patent enforcement forum, developments in ITC case management, the role of non-practicing entities at the ITC, and the interaction between ITC and district court patent cases. Moderator: Peter S. Menell, University of California at Berkeley School of Law and Berkeley Center for Law & Technology - Berkeley, CA Panelists: Yar R. Chaikovsky, McDermott Will & Emery - Menlo Park, CA Panelists:

	Robert D. Fram, Covington & Burling LLP - San Francisco, CA
11:45 am 0.75 hr	**Preserving Issues for Appeal** The presentation identifies issues of particular importance in appeals involving patent cases. It describes the various methods of preserving those issues for appeal and identifies some of the risks of not being careful about preserving errors by the district courts. Daralyn J. Durie, Durie Tangri LLP - San Francisco, CA Carter G. Phillips, Sidley Austin LLP - Washington, DC

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	LUNCHEON PRESENTATION Sponsored by Chadbourne & Parke LLP
12:30 pm	**Pick up Lunch** Included in conference registration fee.
12:45 pm 0.75 hr	**Administrative Innovation at the PTO** Although patent reform is often envisioned in legislative terms, the PTO enjoys some ability to promote administrative reform that may reduce backlog and improve patent quality. This presentation evaluates enacted and proposed reforms in light of available empirical data. Arti K. Rai, Duke University School of Law - Durham, NC
1:30 pm	**Break**
1:45 pm 0.75 hr	**Alternative Fee Arrangements and Cost Control: Bidding for Cases** The advent of the patent troll, changes in patent law and an increasingly competitive marketplace have collectively impacted, and in many ways fundamentally changed, the business of how patent cases are budgeted and handled. The panel explores alternative fee arrangements, case budgets and other cost control measures both from an in-house and outside counsel perspective. The panel also looks at how tighter corporate budgets are impacting the bidding and selection process for litigation counsel. Moderator: Theodore T. "Ted" Herhold, Townsend and Townsend and Crew LLP - Palo Alto, CA Panelists: Wab Kadaba, Kilpatrick Stockton LLP - Atlanta, GA Panelists: Emily Ward, eBay, Inc. - San Jose, CA Panelists: Karen K. Williams, Sybase, Inc. - Dublin, CA
2:30 pm 0.50 hr	**Protective Orders in Patent Cases: Who Can Keep a Secret?** Strategies for keeping confidential information from adversaries, including patent prosecution bars after *In re Deutsche Bank* (2010), cases interpreting FRE 502 and clawback agreements, and a review of local rules and model protective orders from several district courts. Michelle Greer Galloway, Cooley LLP - Palo Alto, CA

	Mark E. Michels, Cisco Systems, Inc. - San Jose, CA
3:00 pm 0.75 hr	**Damages** The role of the entire market value rule in the calculation of patent damages has been the subject of much discussion in the context of both litigated cases and patent law reform efforts. Parties often disagree about how much of the value of an accused product should be subject to a damages calculation, where the invention of the patent at issue arguably does not implicate, or create the demand for, the entire product. This panel explores the current state of the law under the *Lucent* and *Cornell* decisions and offers practical insights on how best to present and defend against damages claims in light of the applicable law. Moderator: Stanley Young, Covington & Burling LLP - Redwood City, CA Panelists: Colleen Chien, Santa Clara University - Santa Clara, CA Panelists: Jeffrey Dubin, Anderson School of Management, UCLA - Los Angeles, CA Panelists: Howard G. Pollack, Fish & Richardson P.C. - Redwood City, CA
3:45 pm	**Adjourn**