

12TH ANNUAL SILICON VALLEY
ADVANCED PATENT LAW



December 8–9, 2011

Four Seasons Hotel Silicon Valley ▪ Palo Alto, California

MAJOR SPONSOR

NAVIGANT

Earn up to 13.25 Hours of Credit including 2.50 Hours of Ethics Credit

12TH ANNUAL SILICON VALLEY ADVANCED PATENT LAW

December 8–9, 2011 ■ Four Seasons Hotel Silicon Valley ■ Palo Alto, California

Earn up to 13.25 Hours of Credit including 2.50 Hours of Ethics Credit

THURSDAY MORNING, DEC. 8, 2011

Presiding Officer:

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

8:00 a.m. Registration Opens

Includes continental breakfast.

8:50 a.m. Welcoming Remarks

9:00 a.m. .75 hr

Patentable Subject Matter: The Ongoing Saga of Section 101

A discussion of recent developments in Section 101, including the *Myriad*, *Classen*, and *CyberSource* cases and their impact on patent development, patent prosecution, and litigation strategies.

Gary H. Loeb, Amyris, Inc., Emeryville, CA
Robert R. Sachs, Fenwick & West LLP,
San Francisco, CA

9:45 a.m. 1.00 hr

Reexamining Reexamination: Past, Present, and Future

Now that we have more than a decade of *inter partes* reexamination under our belts, this panel looks back at ten years of statistics on how reexamination is actually working, and discusses current uses of reexamination in conjunction with litigation and on its own. It also explores the future of reexamination, including post-grant review and the new reexamination guidelines.

Moderator:

Karen Boyd, Turner Boyd LLP, Mountain View, CA

Panelists:

Scott J. Coonan, Juniper Networks, Inc., Sunnyvale, CA
Rajiv P. Patel, Fenwick & West LLP, Mountain View, CA
Bijal V. Vakil, White & Case LLP, Palo Alto, CA
Lee Van Pelt, Van Pelt, Yi & James LLP, Cupertino, CA

10:45 a.m. Break

11:00 a.m. .50 hr

Developments in Claims Construction

A look at findings from a new comprehensive database of Federal Circuit claims construction decisions from 2000-2010.

Peter S. Menell, University of California at Berkeley School of Law and Berkeley Center for Law & Technology, Berkeley, CA
Samuel F. Ernst, Covington & Burling LLP,
San Francisco, CA

11:30 a.m. .50 hr

Capability Claiming

Patent claims to functional constructs (including software) are increasingly written to require not actual steps or operational features but that a system or device be capable of performing those steps or providing those features. Are capability claims valid? What do they cover? Are they a good idea?

William S. Galliani, Cooley LLP, Palo Alto, CA
Mark A. Lemley, Stanford Law School and
Durie Tangri LLP, Stanford and San Francisco, CA

12:00 p.m. .75 hr

The Novelty Wears Off: Patent Litigation at the Supreme Court

Focusing on the most recent decisions and certiorari grants, this presentation discusses the Supreme Court's increased willingness to take on patent-related cases and what seems to interest the Court—and thus offers some insight on taking a case from the Federal Circuit to the Supreme Court and what happens once there.

David S. Bloch, Winston & Strawn LLP, San Francisco, CA
Deanne E. Maynard, Morrison & Foerster LLP,
Washington, DC

12:45 p.m. Pick Up Box Lunch

THURSDAY AFTERNOON

Presiding Officer:

Matthew H. Poppe, Orrick, Herrington & Sutcliffe LLP, Menlo Park, CA

THANK YOU TO OUR
LUNCHEON SPONSOR



LUNCHEON PRESENTATION

1:00 p.m. .75 hr

Patent Reform: Planning for Changes to Come

Patent reform has finally passed. Now that it has arrived, what do you need to do?

Dan H. Lang, Cisco Systems, Inc., San Jose, CA

1:45 p.m. Break

2:00 p.m. .50 hr

A New World for Indirect Infringement? The Supreme Court's View of Indirect Patent Infringement Standards

In *Global-Tech Appliances, Inc. v. SEB S.A.*, the Court recently altered the knowledge requirement for inducing patent infringement. The Court's holding will have an impact on any form of indirect patent infringement and may impact other areas of patent law. This presentation focuses on how in-house and outside counsel can better protect their clients' businesses from successful allegations of indirect infringement.

Yar R. Chaikovsky, McDermott Will & Emery LLP,
Menlo Park, CA

2:30 p.m. .50 hr

Joint Infringement

Focus on the entities that perform steps of a method claim has transformed patent litigation in the computer and networking fields. Two en banc Federal Circuit cases seek to reconsider scope and limitations of certain joint/divided infringement doctrines. What are best practices in prosecution and litigation during this period of uncertainty?

Mark A. Lemley, Stanford Law School and Durie Tangri LLP, Stanford and San Francisco, CA
David W. O'Brien, Zagorin O'Brien Graham LLP,
Austin, TX

3:00 p.m. .75 hr ethics

Inequitable Conduct

This presentation looks at the Federal Circuit's 2011 en banc ruling in *Therasense*. The Federal Circuit clearly believed that it was changing the law to reduce charges of inequitable conduct; the PTO has announced that it will conform its materiality standard to what the Federal Circuit has done. Will *Therasense* end the "plague"? What can patent prosecutors do to stay on the right side of the duty of candor, both day-to-day and, if necessary with the help of litigators, at trial?

Bradley Baugh, North Weber & Baugh LLP, Palo Alto, CA
Robert J. Goldman, Ropes & Gray, LLP,
East Palo Alto, CA

3:45 p.m. Break

4:00 p.m. .50 hr

Venue Transfers

A review of the latest developments in 1404(a) case law and resulting strategy considerations.

Clement S. Roberts, Durie Tangri LLP,
San Francisco, CA

4:30 p.m. 1.00 hr including .50 hr ethics

Judicial Panel

Leading District Court judges discuss cutting-edge and patent litigation issues.

Moderator:

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

Panelists:

Hon. Edward J. Davila, U.S. District Court, Northern District of California, San Jose, CA
Hon. Paul Singh Grewal, U.S. District Court, Northern District of California, San Jose, CA
Hon. Lucy H. Koh, U.S. District Court, Northern District of California, San Jose, CA

5:30 p.m. Adjourn

FRIDAY MORNING, DEC. 9, 2011

Presiding Officer:

Colleen Chien, Santa Clara University, Santa Clara, CA

8:30 a.m. Conference Room Opens

Includes continental breakfast.

9:00 a.m. .75 hr

Rule, Policy, and Process Changes at the USPTO

In the past year, the USPTO has proposed or adopted rules, non-rule policies, and other changes affecting information disclosure, appeal, reexamination, and other important practice areas. This session reviews and comments on the substance and impact of these changes on domestic and international prosecution.

M. Paul Barker, Finnegan, Henderson, Farabow, Garrett & Dunner, LLP, Palo Alto, CA
Christopher J. Palermo, Hickman Palermo Truong & Becker LLP, San Jose, CA

9:45 a.m. .50 hr

Domestic Disturbances: The Latest from the ITC on Establishing a Domestic Industry

The advent of NPE complainants and the increased reliance on licensing as a domestic industry in Section 337 investigations have produced recent decisions from the Commission exploring and refining the requirements for establishing this jurisdictional necessity. This session reviews the recent developments and discusses its implications for both complainants and respondents.

Noreen Krall, Apple, Inc., Cupertino, CA
Michael A. Ladra, Latham & Watkins LLP, Menlo Park, CA

10:15 a.m. Break

10:30 a.m. .50 hr ethics

Litigation Holds and Spoliation Issues in Patent Litigation

This presentation provides an overview of current law in this area including a discussion of the Federal Circuit's opinions in *Rambus*. This presentation also addresses ways to avoid spoliation and ways to establish spoliation as a defense.

Eric R. Lamison, Kirkland & Ellis LLP, San Francisco, CA

11:00 a.m. 1.00 hr

China's Increasing Influence in IP: Key Patent Development and Enforcement Trends

China's third patent law amendment, powerful trends in patent filings in China, Chinese patent activity in foreign countries, China's "indigenous innovation" policies, and new trends in IP litigation in China are significantly impacting foreign companies doing business in China and competing with Chinese companies elsewhere. The panel discusses these trends and best practices for addressing them.

Moderator:

Christopher J. Byrne, Tessera Technologies, San Jose, CA

Panelists:

Mei Gechlik, Stanford Law School, Stanford, CA
Jeanine Hayes, Nike, Inc., San Francisco, CA
Julie Stephenson, Synopsys, Inc., Mountain View, CA
Alex Zhang, King & Wood, Palo Alto, CA

12:00 p.m. Break for Buffet Lunch

FRIDAY AFTERNOON

Presiding Officer:

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

THANK YOU TO OUR LUNCHEON SPONSOR



Hickman Palermo Truong & Becker LLP
INTELLECTUAL PROPERTY LAW

LUNCHEON PRESENTATION

12:20 p.m. .67 hr ethics

Ethics in Patent Practice: 2011 Review

A review of this year's cases, news articles, and committee opinions that apply legal ethics to patent practice—both in patent litigation and prosecution.

John Steele, Attorney at Law, Palo Alto, CA

1:00 p.m. Break

1:15 p.m. 1.00 hr

Patent Aggregators and the IP Marketplace

The exponential rise of non-practicing entity litigation and the strategic use of patents as competitive weapons have spawned new business models for IP ownership and licensing. This panel explores the role of patent aggregators in this changing IP marketplace, including institutional vs. ad-hoc aggregation, IP valuation, licensing strategies, and risk management.

Moderator:

Anne M. Cappella, Weil, Gotshal & Manges LLP, Redwood Shores, CA

Panelists:

Suzanne Michel, Google, Inc., Washington, DC
Renee DuBord Brown, Tessera Technologies, San Jose, CA
Ron Laurie, Inflexion Point Strategy, LLC, Palo Alto, CA
Mallun Yen, RPX Corporation, San Francisco, CA

2:15 p.m. 1.25 hr

Damages

In recent years, there have been substantial developments concerning the law of damages for patent infringement. The Federal Circuit has issued several decisions intended to clarify the law including *Lucent*, *ResQNet*, and *Uniloc*; the FTC has issued a major report; and trial courts have required a more rigorous level of proof. This panel explores the current state of the law and offers practical insights on how best to present and defend against damages claims.

Moderator:

Glenn E. Westreich, Haynes and Boone, LLP, San Jose, CA

Panelists:

James Pampinella, Navigant Consulting, Inc., San Francisco, CA
Matthew D. Powers, Tensegrity Law Group LLP, Redwood City, CA
John A. Squires, Chadbourne & Parke LLP, New York, NY

3:30 p.m. Adjourn

ABOUT THE COVER



Span 3, 24" x 20", mixed media collage of reclaimed rusty metal, nails, acrylic and ink on board, is by Leah Dunaway. For more information on this piece, visit www.leahdunaway.com. Image acquisition by Sandra Gregor, art consultant, 512-477-2827.

CONFERENCE FACULTY AND PLANNING COMMITTEE

ROBERT BARR—CO-CHAIR*
Berkeley Center for Law & Technology
Berkeley, CA

MARK A. LEMLEY—CO-CHAIR*
Stanford Law School and Durie Tangri LLP
Stanford and San Francisco, CA

M. PAUL BARKER
Finnegan, Henderson, Farabow, Garrett & Dunner, LLP
Palo Alto, CA

BRADLEY BAUGH*
North Weber & Baugh LLP
Palo Alto, CA

DAVID S. BLOCH*
Winston & Strawn LLP
San Francisco, CA

KAREN BOYD*
Turner Boyd LLP
Mountain View, CA

RENEE DUBORD BROWN
Tessera Technologies
San Jose, CA

CHRISTOPHER J. BYRNE*
Tessera Technologies
San Jose, CA

ANNE M. CAPPELLA
Weil, Gotshal & Manges LLP
Redwood Shores, CA

YAR R. CHAIKOVSKY*
McDermott Will & Emery LLP
Menlo Park, CA

PETER CHEN*
Latham & Watkins LLP
Menlo Park, CA

SCOTT J. COONAN
Juniper Networks, Inc.
Sunnyvale, CA

HON. EDWARD J. DAVILA
U.S. District Court
Northern District of California
San Jose, CA

SAMUEL F. ERNST
Covington & Burling LLP
San Francisco, CA

MICHAEL W. FARN*
Fenwick & West LLP
Mountain View, CA

WILLIAM S. GALLIANI
Cooley LLP
Palo Alto, CA

MEI GECHLIK
Stanford Law School
Stanford, CA

ROBERT J. GOLDMAN*
Ropes & Gray, LLP
East Palo Alto, CA

HON. PAUL SINGH GREWAL
U.S. District Court
Northern District of California
San Jose, CA

JEANINE HAYES*
Nike, Inc.
San Francisco, CA

HON. LUCY H. KOH
U.S. District Court
Northern District of California
San Jose, CA

NOREEN KRALL
Apple, Inc.
Cupertino, CA

MICHAEL A. LADRA
Latham & Watkins LLP
Menlo Park, CA

ERIC R. LAMISON
Kirkland & Ellis LLP
San Francisco, CA

DAN H. LANG*
Cisco Systems, Inc.
San Jose, CA

RON LAURIE*
Inflexion Point Strategy, LLC
Palo Alto, CA

GARY H. LOEB*
Amyris, Inc.
Emeryville, CA

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

DEANNE E. MAYNARD
Morrison & Foerster LLP
Washington, DC

LISA MCFALL*
Ovidian Group, LLC
Berkeley, CA

PETER S. MENELL
University of California at Berkeley School of Law
and Berkeley Center for Law & Technology
Berkeley, CA

SUZANNE MICHEL
Google, Inc.
Washington, DC

DAVID W. O'BRIEN
Zagorin O'Brien Graham LLP
Austin, TX

CHRISTOPHER J. PALERMO*
Hickman Palermo Truong & Becker LLP
San Jose, CA

JAMES PAMPINELLA*
Navigant Consulting, Inc.
San Francisco, CA

RAJIV P. PATEL*
Fenwick & West LLP
Mountain View, CA

MATTHEW H. POPPE*
Orrick, Herrington & Sutcliffe LLP
Menlo Park, CA

MATTHEW D. POWERS*
Tensegrity Law Group LLP
Redwood City, CA

CLEMENT S. ROBERTS*
Durie Tangri LLP
San Francisco, CA

ROBERT R. SACHS
Fenwick & West LLP
San Francisco, CA

JOHN A. SQUIRES*
Chadbourne & Parke LLP
New York, NY

JOHN F. STARK*
Navigant Consulting, Inc.
San Francisco, CA

JOHN STEELE
Attorney at Law
Palo Alto, CA

JULIE STEPHENSON
Synopsis, Inc.
Mountain View, CA

JENNIFER S. SWAN*
Finnegan, Henderson, Farabow, Garrett & Dunner, LLP
Palo Alto, CA

ALISON M. TUCHER*
Morrison & Foerster LLP
San Francisco, CA

BIJAL V. VAKIL*
White & Case LLP
Palo Alto, CA

LEE VAN PELT*
Van Pelt, Yi & James LLP
Cupertino, CA

GLENN E. WESTREICH*
Haynes and Boone, LLP
San Jose, CA

MICHELLE YANG*
Samsung Information Systems America
San Jose, CA

MALLUN YEN*
RPX Corporation
San Francisco, CA

ALEX ZHANG
King & Wood
Palo Alto, CA

*planning committee member

HOW TO REGISTER

Mail your registration to:

The University of Texas
School of Law
Attn. CLE—PJ11
P.O. Box 7759
Austin, TX 78713-7759

Or fax to:
512-475-6876

Or register online:
www.utcle.org

Questions? Call us at 512-475-6700

MATERIALS, AUDIO AND IN-HOUSE CLE

Printed Materials in Course Binder

Leading practitioners and members of the judiciary, regulatory and academic communities provide the definitive set of materials.

eBinder on CD

Add the electronic version of conference materials to your course registration or purchase of the Course Binder or Audio MP3 Speeches on CD or Audio CD Set for only \$50. eBinders are distributed 3–5 weeks after the conference and include searchable PDF versions of printed materials.

Audio MP3 Speeches on CD or Audio CD Set

Listen to Advanced Patent Law on the go. Informative, topical and entertaining presentations recorded from UT Law's other live CLE programs are also available.

In-House CLE

CLE for two or more participants—as many as you want. Receive full MCLE credit. We'll accredit the course for you* and provide one Audio CD Set plus a Course Binder for each participant.

*Texas MCLE credit only.

REGISTRATION FOR PJ11

Mail this registration form to:

The University of Texas School of Law, Attn. CLE—PJ11
P.O. Box 7759, Austin, TX 78713-7759 or fax a copy to: 512-475-6876

PLEASE PRINT CLEARLY

Bar Card# _____ TX Other State: _____ N/A

Name [Mr. / Ms.] _____

Firm _____

Address _____

City _____ State _____ Zip _____

Telephone _____ Fax _____

Registrant's Email (required) _____

Assistant's Email (optional) _____

Invoices, confirmations and receipts are emailed to these addresses.

STANDARD REGISTRATION—Includes Printed Course Binder (only) and Thursday and Friday Luncheon Presentations

- Early Registration Fee due by Wednesday, November 30, 2011\$775
 Registration Fee after Wednesday, November 30, 2011\$825

GREEN REGISTRATION—Includes Electronic Materials on USB Key (only) and Thursday and Friday Luncheon Presentations

- Early Registration Fee due by Wednesday, November 30, 2011\$770
 Registration Fee after Wednesday, November 30, 2011\$820

CONFERENCE PUBLICATIONS AND MEDIA

Allow 3–5 weeks from the conference date for delivery.

- Course Binder WITHOUT Conference Registration\$275
Note: Conference Registration includes Course Binder.
- Audio MP3 Speeches on CD\$175
- Audio CD Set\$230
- eBinder on CD (PDF format)\$275/\$50
(\$275 purchased alone, \$50 with Registration or purchase of Course Binder or Audio MP3 Speeches on CD or Audio CD Set)

IN-HOUSE CLE: Bring the conference in-house and learn at your convenience.

Allow 3–5 weeks from the conference date for delivery. Approved for Texas MCLE credit.

- In-House CLE for 2—Includes Audio CD Set and Course Binders\$995
- _____ Add participants (includes Course Binder) for \$275 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 number - - -

X _____
Authorized Signature

/
Exp. Date (mm/yy)



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.

12TH ANNUAL SILICON VALLEY
ADVANCED PATENT LAW

December 8–9, 2011 ■ Four Seasons Hotel ■ Palo Alto, California

NON-PROFIT-ORG
U.S. Postage
PAID
U T School of Law

E-mail us at
utcle@law.utexas.edu
or call us at
512-475-6700
for more information

PALO ALTO

December 8–9, 2011

CONFERENCE LOCATION



Four Seasons Hotel Silicon Valley
2050 University Avenue
East Palo Alto, CA 94303
650-566-1200

Special Room Rate: \$255
good through November 7, 2011
(subject to availability)

Parking:
Complimentary self-parking;
valet parking \$22 per day

KEY DATES

November 30, 2011, 5 p.m.
last day for early registration
add \$50 for registrations
received after this time

December 2, 2011, 5 p.m.
last day for full refund

December 5, 2011, 5 p.m.
last day for partial refund
\$50 processing fee applied

December 8, 2011, 2011, 9 a.m.
Institute begins

ADVANCED PATENT LAW INSTITUTES

Each program uniquely tailored to its locale

PATENT LAW IN AUSTIN, TX

October 27–28, 2011, Four Seasons Hotel

Join leading practitioners, academics and in-house counsel from the Southwest and Silicon Valley in Austin for two days of presentations on a rich array of prosecution and litigation topics. The Four Seasons Hotel is on the shores of Lady Bird Lake just steps away from the Hike and Bike Trail, downtown’s restaurant and entertainment district, and the vibrant SoCo area.



PATENT LAW IN SILICON VALLEY

December 8–9, 2011,

Four Seasons Hotel Silicon Valley

Come to Palo Alto in the heart of Silicon Valley and join leading judges and practitioners from major corporations such as Apple, Google, and Cisco. The Institute is jointly presented with the Berkeley Center for Law and Technology at UC Berkeley and the Stanford Program in Law, Science and Technology.



PATENT LAW AT THE USPTO

January 19–20, 2012, USPTO — Main Auditorium

The insider’s perspective on USPTO initiatives, practice rules, developments and much more. Join USPTO 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 Institute is jointly presented with the U.S. Patent and Trademark Office and George Mason University School of Law.



**M
C
L
E**

This course has been approved for Minimum Continuing Legal Education credit by the State Bar of Texas Committee on MCLE in the amount of 13.25 hours, of which 2.50 credit hours will apply to legal ethics/professional responsibility credit. The University of Texas School of Law is a State Bar of California approved MCLE provider (#1944), and an Oklahoma Bar Association MCLE presumptively-approved provider (#169).