

13th Annual Advanced Patent Law Institute
December 6-7, 2012 • Four Seasons Hotel • Palo Alto, CA, CA

Thursday Morning, Dec. 6, 2012

Presiding Officer:

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

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| 7:30 am | Registration Opens Includes continental breakfast. |
| 8:20 am | Welcoming Remarks |
| 8:30 am 0.50 hr | Claims Drafting Strategies Too often, applicants prosecute patent applications without adequately considering how the claims will be asserted in litigation. A consideration of the latest case law concerning claim format—whether the patentee can proceed on a theory of direct, induced, or contributory infringement, or whether a patentee must proceed on a theory of divided infringement. This session demonstrates ways these theories are litigated, how they affect discovery and litigation cost, and how they can even mean the difference between victory and failure. More importantly, strategies to avoid the typical claim-format pitfalls are discussed. Erik R. Puknys, Finnegan, Henderson, Farabow, Garrett & Dunner, LLP - Palo Alto, CA |
| 9:00 am 0.50 hr | Claim Construction: Methodologies of Construction A discussion of the growing divide between two basic modes of claim construction emerging from Federal Circuit case law, the current trends in the methodological divide, how the judges split on claim construction and how to think about this. R. Polk Wagner, University of Pennsylvania School of Law - Philadelphia, PA |
| 9:30 am 0.50 hr | After the Ides of March—Prosecution Strategies Surrounding the March 16 First-to-File Transition To file or not to file, that is the question. Beginning with a quick review of the differences between the pre- and post-March 16 prior art rules, this discussion focuses on the decision of whether to accelerate filings to take advantage of the pre-March 16 rules and also addresses how prosecution practice may, or may not, change post-March 16. Michael W. Farn, Fenwick & West LLP - Mountain View, CA |
| 10:00 am | Break |

10:15 am
0.50 hr ethics

Malpractice Risks of the First-to-File System and the America Invents Act

The transition from "first-to-invent" to "first-to-file" and other changes under the APA present multiple ethics issues for practitioners, including identifying the more favorable regime as the March 2013 change-over approaches, balancing the "need for speed" with proper drafting practices under the new regime, and reconciling duties to the PTO with client desires now that best mode is no longer a litigation defense.

Ragesh K. Tangri, Durie Tangri LLP - San Francisco, CA

10:45 am
1.00 hr

Post-Grant Practice and Inter Partes Reviews under the America Invents Act

With the new rules on post-grant proceedings now in place, the impact and practice considerations of these new rules from the Office, district court and USITC perspectives are reviewed. A look at strategies and tactics for choice of a validity challenge in the Office, the district court or USITC, and the possible scenarios involving parallel validity proceedings. Timelines, representative costs and chances of success are discussed under the new proceedings, along with the views from the Board now that the new proceedings have become operational.

Moderator:

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

Panelists:

Rajiv P. Patel, Fenwick & West LLP - Mountain View, CA

Panelists:

Hon. James Smith, U.S. Patent and Trademark Office - Alexandria, VA

Panelists:

Robert Greene Sterne, Sterne, Kessler, Goldstein & Fox - Washington, DC

11:45 am
0.75 hr

Patentable Subject Matter

An analysis of how *Prometheus* will affect personalized medicine and the *Myriad* case, the implications of *Prometheus* for software patents, and where Section 101 considerations fit in the prosecution and litigation process.

Moderator:

Edward R. Reines, Weil, Gotshal & Manges LLP - Redwood City, CA

Panelists:

Daralyn J. Durie, Durie Tangri LLP - San Francisco, CA

Panelists:

Lee Van Pelt, Van Pelt, Yi & James LLP - Cupertino, CA

12:30 pm

Break to Pick Up Lunch

Included in conference registration fee.

Thursday Afternoon, Dec. 6, 2012

Presiding Officer:

James Pampinella, Navigant Consulting, Inc. - San Francisco, CA

LUNCHEON PRESENTATION

Sponsored by Hickman Palermo Truong Becker Bingham Wong LLP

12:45 pm
1.00 hr

Essential Questions About Standard-Essential Patents

Patents that are considered essential to industry standards raise special concerns. A look at several issues that have been the subject of recent debate in legislative and administrative bodies and litigation in the courts such as proving—and defending against—claims of infringement, the duty of disclosure to standards bodies and when the duty arises, the duty to license on reasonable and non-discriminatory terms and related disagreements about the availability of injunctive relief, and transfers of standard-essential patents which can involve questions of both contract and competition law.

Moderator:

Stanley Young, Covington & Burling LLP - Redwood City, CA

Panelists:

Matthew Bye, Google Inc. - Mountain View, CA

Panelists:

Mark D. Flanagan, Wilmer Cutler Pickering Hale and Dorr LLP - Palo Alto, CA

Panelists:

Andrew N. Thomases, Skadden, Arps, Slate, Meagher & Flom LLP - Palo Alto, CA

1:45 pm

Break

2:00 pm
0.50 hr ethics

Privilege: Don't Believe Everything You Think

Recent decisions on various types of privilege have surprised many practitioners. An analysis of several fluid areas of privilege law, such as whether mediation or settlement privilege exist, how (not) to establish a relationship with a third party that supports the attorney-client privilege, and privilege surprises when you leave the cozy confines of the United States.

Karen Boyd, Turner Boyd LLP - Mountain View, CA

2:30 pm
1.00 hr

What is That Patent Really Worth? Courts Take a Hard Look at the "Reasonable Royalty" Calculation

The Federal Circuit and district courts have recently begun requiring experts to link reasonable royalty calculations to real-world facts related to the specific invention—e.g. *Apple v. Motorola*. Courts are also taking a close look at what facts are admitted into evidence, excluding sales data (*Uniloc*) and license data (*ResQnet*) that were employed erroneously to "drive up" the royalty rate. These cases do not always make clear whether it is the expert's method or data that should be excluded. The need for better methods and better data is especially strong in the case of complex products, which may embody hundreds of patents. This panel examines recent cases and discusses new economic methods that hold promise for satisfying the new standards that have emerged in them.

Moderator:

Julie M. Holloway, Latham & Watkins LLP - San Francisco, CA

Panelists:

Eugene M. Paige, Kecker & Van Nest LLP - San Francisco, CA

Panelists:

Jonathan D. Putnam, Competition Dynamics - Salem, MA

3:30 pm

Break

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| <p>3:45 pm 0.75 hr</p> | <p>Managing Patent Cases in the Era of Misjoinder, Multidistrict Litigation, and Multinational Litigation</p> <p>A discussion of the latest developments in management of multiple lawsuits involving the same patent or set of patents, the growth of multidistrict litigation as an option in multi-defendant cases, the influence of AIA as well as <i>In re EMC</i> on such cases, the developments of Rule 42 consolidation after misjoinder under Rule 20 is found and the challenges of coordinating domestic and international litigation.</p> <p>David S. Bloch, Winston & Strawn LLP - San Francisco, CA Michael F. Heafey, Orrick, Herrington & Sutcliffe LLP - Menlo Park, CA</p> |
| <p>4:30 pm 1.00 hr 0.50 hr ethics</p> | <p>Judicial Panel</p> <p>Leading District Court judges discuss cutting-edge patent litigation issues.</p> <p>Moderator: Thomas M. Melsheimer, Fish & Richardson P.C. - Dallas, TX Panelists: Hon. J. Rodney Gilstrap, U.S. District Court, Eastern District of Texas - Marshall, TX Panelists: Hon. Roy Payne, U.S. District Court, Eastern District of Texas - Marshall, TX Panelists: Hon. Ronald M. Whyte, U.S. District Court, Northern District of California - San Jose, CA</p> |
| <p>5:30 pm</p> | <p>Adjourn</p> |

Friday Morning, Dec. 7, 2012

Presiding Officer:
Ron Laurie, Palo Alto, CA

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| <p>8:00 am</p> | <p>Conference Room Opens</p> <p>Includes continental breakfast.</p> |
| <p>8:30 am 0.50 hr</p> | <p>Functional Claiming</p> <p>Software patents are often claimed in functional terms, even if they don't use means-plus-function language. An in-depth look at the perils—and promise—of functional claiming in software.</p> <p>Mark A. Lemley, Stanford Law School - Stanford, CA</p> |

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| <p>9:00 am 1.00 hr</p> | <p>Coordinating International Litigation: Focus on German Patent Enforcement</p> <p>An overview of international patent litigation that focuses on German patent litigation and the Pan-European perspective such as the smartphone wars and what drives litigations in certain forums and countries. Learn strategies for handling substantive legal differences and comparing limits on discovery, duration of trials, bifurcation of issues, arbitration and mediation and remedies.</p> <p>Moderator: Yar R. Chaikovsky, McDermott Will & Emery - Menlo Park, CA</p> <p>Panelists: David L. Cohen, Vringo Inc. - New York, NY</p> <p>Panelists: Alexander Harguth, McDermott Will & Emery - München , Germany</p> <p>Panelists: Ari Laakkonen, Powell Gilbert LLP - London, United Kingdom</p> |
| <p>10:00 am</p> | <p>Break</p> |
| <p>10:15 am 1.00 hr</p> | <p>Strategic Portfolio Management</p> <p>Experts in strategic portfolio management discuss key issues and insightful thinking processes involved in adapting to sweeping AIA changes and critical case law, the increasing internationalization of patent activity and the increasing "make-versus-buy" trade-offs of the patent marketplace. Learn how to keep up with accelerating technological change and the pace of R&D, and how to address constant management and budget challenges.</p> <p>Moderator: Christopher J. Byrne, San Jose, CA</p> <p>Panelists: T.J. Angioletti, Netflix, Inc. - Los Gatos, CA</p> <p>Panelists: Sandeep Jaggi, Intermolecular, Inc. - San Jose, CA</p> <p>Panelists: Philip L. McGarrigle, Jazz Pharmaceuticals - Palo Alto, CA</p> |
| <p>11:15 am 0.75 hr</p> | <p>Emerging Developments at the ITC: Domestic Industry and Remedies</p> <p>The International Trade Commission's surge in popularity continues to make it a favored forum for bringing patent disputes. Over the past year, Congress and the Commission have closely considered who should be allowed to bring a patent case and what remedies the ITC should award. Evolving domestic industry requirements for obtaining relief in ITC cases along with emerging ITC remedies issues are reviewed from a policy and legal standpoint. Hear a Q&A discussion of the substantive law, developments in the ITC's Rules and Procedures and the politics of the ITC.</p> <p>Colleen Chien, Santa Clara University - Santa Clara, CA Eric R. Lamison, Kirkland & Ellis LLP - San Francisco, CA</p> |
| <p>12:00 pm</p> | <p>Break to Pick Up Lunch</p> <p>Included in conference registration fee.</p> |

Friday Afternoon, Dec. 7, 2012

Presiding Officer:

Vernon M. Winters, San Francisco, CA

LUNCHEON PRESENTATION

Sponsored by Inflexion Point Strategy, LLC

12:20 pm
0.75 hr

New Approaches to Patent Strategy and to Dealing with Inventors

A look at new ways of dealing with innovators and innovation, including strategies that may foster invention disclosures and curb offensive patent litigation. The panel discusses the merits of Twitter's proposed patent assignment—the Innovator's Patent Agreement (IPA)—that allows inventors to limit the offensive use of their patents, and the Defensive Patent License (DPL) that protects innovators by networking patents into mutually beneficial legal shields. The interplay of these strategies with recent USPTO rule changes to implement the Inventor's Oath or Declaration provisions of the America Invents Act is addressed.

Moderator:

Bradley Baugh, North Weber & Baugh LLP - Palo Alto, CA

Panelists:

Benjamin Lee, Twitter, Inc. - San Francisco, CA

Panelists:

Jennifer M. Urban, UC Berkeley School of Law - Berkeley, CA

1:05 pm

Break

1:15 pm
0.50 hr

Joint/Divided Infringement

After en banc rehearing by a divided court, the Federal Circuit, in *Akamai* and *McKesson*, serves up new indirect infringement doctrines that obviate requirements for predicate direct infringement liability in 271(b) inducement cases. How will the new doctrines affect claiming strategies and infringement litigation? Will the doctrines survive scrutiny of the Supreme Court?

David W. O'Brien, Zagorin O'Brien Graham LLP - Austin, TX

1:45 pm
0.50 hr ethics

Inequitable Conduct after *Therasense*: All Clear?

A look at how the law of inequitable conduct has been reconfigured by the Federal Circuit's 2011 decision in *Therasense* and how courts analyze the requirement of "but-for" materiality. What does it mean to have acted with "intent to deceive" in a hypothetical, but-for world? The interplay between the new law of inequitable conduct and related doctrines, such as *Walker Process* antitrust claims, is discussed along with the PTO response to *Therasense*, including the revisions to PTO Rule 56(a).

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

2:15 pm
0.50 hr

Inducement

Hot topics in inducement law, including divided infringement scenarios after *Akamai*, the interplay between inducement's intent requirement and willfulness, and the risks and rewards of opinion letters in combating inducement allegations.

Jeffrey G. Homrig, Kasowitz, Benson, Torres & Friedman LLP - Redwood City, CA

2:45 pm
0.50 hr

To Plead or Not to Plead

A look at the murky landscape of pleading standards for infringement and invalidity between *Twombly/Iqbal*, Form 18 and all of the varying court opinions in between.

Jeannine Yoo Sano, White & Case LLP - Palo Alto, CA

Bijal V. Vakil, White & Case LLP - Palo Alto, CA

