

9th Annual

ADVANCED PATENT LAW INSTITUTE

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October 27*, 28-29, 2004

* Optional Wednesday Evening Session

In-House Counsel's Perspective on Patent Prosecution

Four Seasons Hotel

Austin, Texas

9th Annual ADVANCED PATENT LAW INSTITUTE

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WEDNESDAY EVENING, OCTOBER 27

***Optional Session (no additional fee)**
Please select on registration form.

6:30 p.m. (1.50 hours)

Patent Prosecution Strategies and Best Practices from an In-House Counsel Perspective

A panel of in-house IP counsel will address patent procurement strategies from conception to enforcement of rights and the management of a cost effective patent portfolio. Patent drafting tips for a multi-jurisdictional filing, prosecution strategies for the U.S. Patent Office and strategic aspects of opposition practice will be discussed.

Robert L. King, Austin
David L. Parker, Austin
Keith E. Witek, Austin

8:00 p.m. Adjourn

THURSDAY MORNING, OCTOBER 28

Presiding Officer: Andrew J. Dillon, Austin

8:00 a.m. Registration Opens

Includes continental breakfast.

8:50 a.m. Welcoming Remarks

9:00 a.m. (0.50 hour)

Moving Patent Prosecution Overseas: The Good, the Bad, the Ugly

Some companies have begun to move portions of their patent prosecution work overseas. Can it be done? Are there actual savings or benefits? What are the pitfalls and opportunities for companies looking to outsource prosecution work and patent prosecution firms? Find out.

Charles Kulas, Palo Alto, CA

9:30 a.m. (0.50 hour)

A Circuit Split Within the Federal Circuit

This presentation will address the current debate within the Federal Circuit over whether a separate written description requirement exists in 35 U.S.C. §112, and address the recent cases concerning the written description issue.

John R. Keville, Houston

10:00 a.m. (0.50 hour ethics/PR credit)

Avoiding the Rule 11 Train Wreck

How to conduct adequate prefiling investigations before filing a suit involving patent claims.

Jeffrey D. Mills, Austin

10:30 a.m. Break

10:45 a.m. (0.75 hour)

Strategic Preparation and Prosecution Tactics

Preparation and prosecution tactics that are designed to control claim construction and avoid prosecution history estoppel.

James E. Beyer, Dayton, OH

11:30 a.m. (0.50 hour ethics/PR credit)

The United States Patent and Trademark Office's Proposed Rules for Attorneys

An overview of the proposed new eligibility rules to practice before the PTO, as well as the new disciplinary rules, patterned after the ABA model rules.

Carol M. Langford, San Francisco, CA

12:00 p.m. Optional Networking Luncheon \$25.00 - Please select on registration form.

Joint networking luncheon for speakers and registrants of the Advanced Patent Law Institute and the Page Keeton Civil Litigation Conference.

THURSDAY AFTERNOON

Presiding Officer: Robert W. Turner, Dallas

1:15 p.m. (0.75 hour)

Claims Construction

A review of the continuing Federal Circuit trek through intrinsic, extrinsic, and other evidence, dictionaries and "plain meaning," and the methodology of claims construction overhung by the impending *Phillips en banc* basic review.

Kenneth R. Adamo, Dallas

2:00 p.m. (1.0 hour ethics/PR credit)

Privilege Waivers

A discussion of exculpatory patent opinions and special problems regarding waiver of privilege; discussion of other privilege waiver issues and *Knorr Bremse* (if decided).

Robert M. Chiaviello, Jr., Dallas
William L. LaFuze, Houston

3:00 p.m. Break

3:15 p.m. (0.50 hour)

PTO Rule Changes You Must Know About

A discussion of key rule changes at the PTO, of interest to every patent practitioner.

Stephen G. Kunin, Washington, DC

3:45 p.m. (0.50 hour ethics/PR credit)

Inequitable Conduct

An analysis of recent cases raising significant inequitable conduct issues, including those holding that attorneys have a duty of inquiry and that clients are imputed with knowledge of patent law.

David C. Hricik, Macon, GA

4:15 p.m. (1.25 hour)

Judges Panel

A distinguished panel of judges and practitioners will discuss their experiences and give their views on such matters as *Markham* hearings, the use of special masters of technical advisors, the use of special rules for patent cases, issues regarding the use of experts and *Daubert* challenges, the use of juries in patent cases, the good and bad traits of patent trial lawyers, and other matters of interest to the patent bar.

Robert W. Turner, Dallas, Moderator
Hon. T. John Ward, Marshall
Hon. Lee Yeakel, Austin
Hon. Frances H. Stacy, Houston
Hon. Ed Kinkeade, Dallas

5:30 p.m. Adjourn

FRIDAY MORNING, OCTOBER 29

Presiding Officer: Keith E. Witek, Austin

8:30 a.m. (0.50 hour)

Monetizing IP

Beyond adversarial licensing: IP monetization strategies for the new era.

Joseph K. Siino, Palo Alto, CA

9:00 a.m. (0.50 hour)

We Won!...Now What? A Patentee's Guide to Post-Verdict Remedies

The verdict is in — and the jury has found your client's patent to be valid and infringed, and has awarded substantial damages. After the celebration, reality sets in, and you ask yourself: "What do we do now to ensure that the client benefits from all available remedies?" Issues to be considered at this point include: supplemental damages for continued infringement between issuance of the verdict and entry of final judgment, award of interest and costs, and entry of a permanent injunction.

Amber Hatfield Rovner, Austin

9:30 a.m. (0.50 hour)

Distributed Patent Infringement

Strategies for prosecuting and litigating divided claims, those with more than one infringer, or in more than one country.

Mark A. Lemley, Stanford, CA
David W. O'Brien, Austin

10:00 a.m. Break

10:15 a.m. (0.50 hour)

Licensing Do's and Don'ts

Selected topics to be addressed in licensing agreements, including most favored nation status and secrecy provisions

Chaz De La Garza, Austin

10:45 a.m. (0.50 hour)

Current Antitrust Issues in Patent Law

This session will review recent developments in the application of antitrust law to patent-holders and licensees in light of new legislation, administrative decisions and European Commission Rules.

David J. Healey, Houston

11:15 a.m. (0.50 hour)

Licensee Estoppel

A discussion of the changing landscape of licensee estoppel and its implications for licensing strategies and litigation.

Daralyn J. Durie, San Francisco, CA

11:45 a.m. Lunch on your own

FRIDAY AFTERNOON

Presiding Officer: Robert L. King, Austin

1:00 p.m. (0.50 hour)

Don't Amend...Don't Amend...Appeal...the Festo Two Step

This session will discuss the strategic importance of practice before the Board of Patent Appeals for minimizing prosecution history estoppel following *Festo*; tips, tricks and the new rules.

Andrew J. Dillon, Austin

1:30 p.m. (0.50 hour)

Prosecution Disclaimers

When do prosecution statements trump the ordinary meaning of claim terms? This session will explore the doctrine of "prosecution disclaimer," including the important balance between the public notice function and the right of patentees to seek broad patent coverage.

George W. Jordan, III, Atlanta, GA

2:00 p.m. Break

2:15 p.m. (0.75 hour)

Electronic Discovery in Patent Cases

Electronic and international discovery: a practical guide for handling (and not mishandling) electronic data (including emails and backup files) and for pursuing and obtaining discovery from foreign parties in domestic patent litigation.

Kevin Kudlac, Austin

3:00 p.m. (0.50 hour)

Inherency

Understanding the doctrine of inherency in light of fundamental recent changes in the law.

Mark A. Lemley, Stanford, CA

3:30 p.m. (0.50 hour)

Inventorship and Prior Art

The fallout from the *Oddzon* holding by the Federal Circuit has had Congress trying to determine the reach of Section 102(f) as prior art and put new emphasis on determining the correct inventorship.

James B. Gambrell, Hunt

4:00 p.m. Adjourn

eBinder on CD

Get the entire conference binder on CD, in electronic PDF format. See registration form below.

Mail this registration form or fax a copy to: (512) 475-6876

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Includes Course Binder

☐ Early Registration Fee due by Wed., October 20, 2004 \$595.00

☐ Registration Fee after Wed., October 20, 2004 \$645.00

☐ Optional Wednesday Evening Session FREE

☐ Optional Networking Luncheon \$25.00

CONFERENCE PUBLICATIONS AND MEDIA

Available by November 15, 2004.

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Oct. 27*, 28-29, 2004

CONFERENCE LOCATION



Four Seasons Hotel

98 San Jacinto
Austin, TX 78701
(512) 685-8100

\$195 single or double special
group rate good through
October 1, 2004

Parking: \$5 self-parking; daily
Valet: \$9 valet; daily

KEY DATES:

Cancellations & last-minute registrations

October 20, 2004, 5 p.m.

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

October 22, 2004, 5 p.m.

• **last day for full refund**

October 25, 2004, 5 p.m.

(Monday before conference)
• **last day for partial refunds**
(\$50 processing fee applied)

October 27, 2004, 6:30 p.m.

• **optional session begins**

October 28, 2004, 9 a.m.

• **conference begins**

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Dallas

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School of Law
San Francisco, CA

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Austin

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www.utcle.org
Online Courses

Advanced Patent Law in San Jose

Stanford Law School, Berkeley Center for Law & Technology, and The University of Texas School of Law will co-sponsor this year's **Advanced Patent Law Institute in San Jose, CA** to be held **December 2-3, 2005** at the Fairmont Hotel. For more information, visit www.utcle.org.



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