

**2004 Advanced Patent Law Institute**  
**October 27-29, 2004 • Four Seasons Hotel • Austin, TX**

**Wednesday Evening, Oct. 27, 2004**

6:30 pm  
1.50 hrs

**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.

Rob King, Freescale Semiconductor - Austin, TX  
David L. Parker, Fulbright & Jaworski LLP - Austin, TX  
Keith Edward Witek, Advanced Micro Devices - Austin, TX

**Thursday Morning, Oct. 28, 2004**

9:00 am  
0.50 hr

**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, Townsend And Townsend And Crew - San Francisco, CA

9:30 am  
0.50 hr

**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, Howrey LLP - Houston, TX

10:00 am  
0.50 hr

**Avoiding the Rule 11 Train Wreck**

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

Jeffrey David Mills, Fulbright & Jaworski LLP - Austin, TX

10:45 am  
0.75 hr

**Strategic Preparation and Prosecution Tactics**

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

James E. Beyer, Dinsmore & Shohl, LLP - Dayton, OH

11:30 am 0.00 hr 0.50 hr ethics	<b>The United States Patent and Trademark Office's Proposed Rules for Attorneys</b>  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, University of San Francisco School of Law - San Francisco, CA
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## Thursday Afternoon, Oct. 28, 2004

1:15 pm 0.75 hr	<b>Claims Construction</b>  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, Jones Day - Dallas, TX
2:00 pm 0.00 hr 1.00 hr ethics	<b>Privilege Waivers</b>  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., Fulbright & Jaworski - Dallas, TX William L. LaFuze, Houston, TX
3:15 pm 0.50 hr	<b>PTO Rule Changes You Must Know About</b>  A discussion of key rule changes at the PTO, of interest to every patent practitioner.  Robert W. Bahr, U.S. Patents and Trademark Office - Washington, DC
3:45 pm 0.00 hr 0.50 hr ethics	<b>Inequitable Conduct</b>  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, Walter F. George School of Law - Macon, GA
4:15 pm 1.25 hrs	<b>Judges Panel</b>  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.  Ed Kinkeade, US District Court - Dallas, TX Frances H. Stacy, United States Courthouse - Houston, TX Thomas J. Ward, US Dist Courthouse - Marshall, TX Earl Leroy Yeakel III, United States District Court, W.D. Texas - Austin, TX

## Friday Morning, Oct. 29, 2004

8:30 am 0.50 hr	<b>Monetizing IP</b>  Beyond adversarial licensing; IP monetization strategies for the new era.  Joseph K. Siino, Inflexion Point Strategy, LLC - Palo Alto, CA
9:00 am 0.50 hr	<b>We Won!! Now What? A Patentee's Guide to Post-Verdict Remedies</b>  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, McKool Smith, P.C. - Austin, TX
9:30 am 0.50 hr	<b>Distributed Patent Infringement</b>  Strategies for prosecuting and litigating divided claims, those with more than one infringer, or in more than one country.  Mark A. Lemley, Stanford Law School - Stanford, CA David W. O'Brien, Zagorin O'Brien & Graham - Austin, TX
10:15 am 0.50 hr	<b>Licensing Do's and Don'ts</b>  Selected topics to be addressed in licensing agreements, including most favored nation status and secrecy provisions.  Charles H. De La Garza, Chaz De La Garza & Associates, LLC - Austin, TX
10:45 am 0.50 hr	<b>Current Antitrust Issues in Patent Law</b>  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, Weil, Gotshal & Manges LLP - Houston, TX
11:15 am 0.50 hr	<b>Licensee Estoppel</b>  A discussion of the changing landscape of licensee estoppel and its implications for licensing strategies and litigation.  Daralyn Durie, Kekker & Van Nest LLP - San Francisco, CA

## Friday Afternoon, Oct. 29, 2004

1:00 pm 0.50 hr	<p><b>Don't Amend...Don't Amend...Appeal...the Festo Two Step</b></p> <p>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.</p> <p>Andrew J. Dillon, Dillon &amp; Yudell LLP - Austin, TX</p>
1:30 pm 0.50 hr	<p><b>Prosecution Disclaimers</b></p> <p>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.</p> <p>George Washington Jordan III, Merchant &amp; Gould, L.Lc - Atlanta, GA</p>
2:15 pm 0.75 hr	<p><b>Electronic Discovery in Patent Cases</b></p> <p>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.</p> <p>Kevin Sean Kudlac, Weil Gotshal &amp; Manges - Austin, TX</p>
3:00 pm 0.50 hr	<p><b>Inherency</b></p> <p>Understanding the doctrine of inherency in light of fundamental recent changes in the law.</p> <p>Mark A. Lemley, Stanford Law School - Stanford, CA</p>
3:30 pm 0.50 hr	<p><b>Inventorship and Prior Art</b></p> <p>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.</p> <p>James B. Gambrell, C/O Roddy Tree Ranch - Hunt, TX</p>