

10th Annual

ADVANCED PATENT LAW INSTITUTE

Earn up to 15.25 Hours of MCLE Credit Including 2.50 Hours of Ethics Credit



October 26*, 27-28, 2005
The Four Seasons Hotel
Austin, Texas

*Special Wednesday Evening Session on Prosecution Strategies—Included in Registration

10TH ANNUAL ADVANCED PATENT LAW INSTITUTE

October 26*, 27-28, 2005 • The Four Seasons Hotel, Austin, Texas

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* WEDNESDAY EVENING, OCT. 26, 2005

* Optional Session Included in Registration
(No Additional Fee)

6:00 p.m. 2.50 hr | .50 hr ethics

Prosecution Strategies: Looking Ahead to Prevent Challenges, Invalidations and Design-Arounds

A comprehensive presentation and discussion of patent preparation and prosecution tactics designed to maximize the scope of protection and avoid invalidity issues when drafting and prosecuting patent applications. Best practices for minimizing inequitable conduct issues and anticipating patent reform legislation will be covered.

Robert L. King, Austin
Dale S. Lazar, Reston, VA
Keith E. Witek, Austin

8:30 p.m. Adjourn

THURSDAY MORNING, OCT. 27, 2005

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. .50 hr

Augmenting Claims, Reconstructing Amendments and Infectious Estoppel: Performing Surgical Claim Amendments During Patent Prosecution

Prosecution history estoppel can arise from amendments to the claims, arguments made during prosecution, the prosecution history of the parent application, and even activities other than amendments or arguments. This presentation will examine the current case law and tips for avoiding narrowing claim amendments during prosecution.

William D. Wiese, Austin

9:30 a.m. .50 hr ethics

Pre-filing Considerations in Patent Cases

An exploration of pre-filing issues in patent infringement cases, including what is required under Rule 11.

Daniel Chapman, San Antonio
Richard R. Ruble, Houston

10:00 a.m. .75 hr

Current Developments in Claims Construction

A discussion and review of the continued Federal Circuit explorations of claims construction—"plain meaning," dictionaries, intrinsic, extrinsic, and other evidence—in light of *Phillips*.

Kenneth R. Adamo, Dallas

10:45 a.m. Break

11:00 a.m. .50 hr ethics

Willfulness, Scope of Privilege, Waiver

A discussion of key practical and ethical issues arising from drafting exculpatory patent opinions and special problems involving waiver of privilege, including implications of *Knorr Bremse*.

Ragesh Tangri, San Francisco, CA

11:30 a.m. .50 hr ethics

Inequitable Conduct Issues in Patent Prosecution, Litigation, and IP Asset Management

A detailed discussion of the inequitable conduct issues faced by IP asset managers and their patent counsel in managing a patent portfolio, prosecuting patent applications, and enforcing U.S. patents.

James E. Beyer, Cincinnati, OH

12:00 p.m. Box Lunch Presentation

Additional fee; please select on registration form.

Patent Reform: Winners, Losers and Prospects

 .50 hr

Robert A. Armitage, Eli Lilly, Indianapolis, IN
Robert Barr, Berkeley Center for Law and Technology, Berkeley, CA
Peter N. Detkin, Intellectual Ventures, Los Altos, CA

THURSDAY AFTERNOON

Presiding Officer: David L. McCombs, Dallas

1:30 p.m. .50 hr

Obviousness

Examining the law of obviousness in light of recent case law and legislative developments.

Christopher A. Cotropia, New Orleans, LA

2:00 p.m. .50 hr

Doctrine of Equivalents

How viable is the doctrine of equivalents as an infringement theory post-*Festo*, and how is it proven at trial?

Steven J. Pollinger, Austin

2:30 p.m. .75 hr

A Dialogue on Remedies and Damages

Law, tactics, and examples of damages and remedies in patent infringement cases from the view of plaintiff, defendant and for in-house counsel evaluation. ITC options and entire market value rule will also be discussed.

David J. Healey, Houston
Brett C. Govett, Dallas

3:15 p.m. Break

3:30 p.m. .50 hr

Sun Tzu—On the Art of Patent Prosecution

Sun Tzu said: "If you know the enemy and know yourself, you need not fear the result of a hundred battles. If you know yourself but not the enemy, for every victory gained you will also suffer a defeat. If you know neither the enemy nor yourself, you will succumb in every battle."

Patent Prosecution is not war, but sometimes it certainly feels like it. Patent practitioners are all generally confident in their own abilities and highly knowledgeable about their client's inventions, but what do they know about the Examiner Corps? What level is your Examiner, and how much authority does that Examiner have? Why is the Examiner more receptive to negotiation some days than others? What counts as a "disposal," what is a "bi-week," and why is it important? Understanding the world your Examiner lives in can make prosecution less war-like and more efficient.

Andrew J. Dillon, Austin

4:00 p.m. .50 hr ethics

Joint Defenses and Joint Defense Privilege Waivers

A discussion of key issues and pitfalls arising in joint defenses, including the latest case law on waiver of privilege.

Daralyn J. Durie, San Francisco, CA

4:30 p.m. 1.00 hr

Judicial Panel

A distinguished panel of judges will discuss their procedures for managing patent cases in their courts, including potential use of special masters or advisors, the use of special rules for patent cases, availability of remedies, conducting *Markman* hearings, time allocation and scheduling orders, the use of juries, and views on effective trial advocacy.

Moderator: David L. McCombs, Dallas
Hon. Andrew W. Austin, Austin
Hon. Paul J. Luckern, Washington, D.C.
Hon. Sam Sparks, Austin

5:30 p.m. Adjourn

FRIDAY MORNING, OCT. 28, 2005

Presiding Officer: Robert L. King, Austin

8:30 a.m. .50 hr

Reexaminations During the Course of Litigation: What Should You Do?

Defendants in patent cases are increasingly requesting reexaminations of patents in the course of litigation. This session discusses factors to consider, including timing, in seeking reexamination during litigation. Recent cases involving inconsistent results of reexaminations and district court rulings will also be discussed.

James B. Gambrell, Hunt

9:00 a.m. .50 hr

Indirect Infringement

A discussion of indirect infringement and its effect on participants of today's business climate. This session will explore indemnification and other licensing provisions as means of risk-shifting.

Miriam Quinn, Dallas

9:30 a.m. .75 hr

Extraterritoriality

Federal Circuit cases have extended both prior art and infringement beyond U.S. borders. The federal circuit is considering whether to allow U.S. courts to hear foreign patent cases. The session closes with a discussion of the limits and changes to the territoriality principle.

Mark A. Lemley, Stanford, CA

10:15 a.m. Break

10:30 p.m. .50 hr

An Update on Section 102(b): On Sale, Public Use, Experimentation, and All That

What conduct triggers the on sale of public use bars of Section 102(b)? What conduct constitutes experimental use? This discussion will review recent Federal Circuit cases applying Section 102(b) and address the current state of the law.

Steven R. Borgman, Houston

11:00 a.m. .50 hr

Patents in China: Key Prosecution and Enforcement Issues for Western Practitioners

Key issues and pitfalls in prosecuting and enforcing patents in China, including lessons learned and practical tips on how to win patent infringement suits there.

J. Benjamin Bai, Houston

11:30 a.m. .50 hr

Antitrust, Patents and Standard Setting

Recent cases brought by the Federal Trade Commission and other antitrust enforcement agencies have highlighted the risks associated with enforcing patents covering products developed through industry standard-setting efforts.

This session covers the implications of increased antitrust enforcement in this area, which lies at the crossroads of patent and antitrust law.

M. Sean Royall, Dallas

12:00 p.m. Lunch On Your Own

FRIDAY AFTERNOON

Presiding Officer: Keith E. Witek, Austin

1:15 p.m. .75 hr

Managing Inventors In-House

This session will include a discussion of the OddzOn Products decision, 35 U. S. C. § 102(F) and the CREATE Act of 2004, how to manage inventors in-house in order to maximize patentable subject matter and minimize inventorship nightmares.

Randall C. Brown, Dallas
Anthony E. Peterman, Austin
Additional Speaker TBA

2:00 p.m. .75 hr

Giving Away Patents: Open Source, Contributions, and Standards

Open source licenses generously grant patent rights. This affects patent policies for industry standards as well. Relationships between open source and software patents are explored. The session will also discuss impact of other types of "give aways" such as contributions and participation in standards organizations.

Lawrence Rosen, Ukiah, CA
H. Shannon Tyson, Jr., Irvine, CA

2:45 p.m. Break

3:00 p.m. .50 hr

Trends in Monetizing IP

There has been increased interest in converting intellectual property rights directly into cash. We will examine several of those transactions and their implications for IP practitioners.

James D. Woods, Houston

3:30 p.m. .50 hr

Electronic Discovery Landmines to Avoid

Discussion of several cases involving electronic discovery disasters and sanctions.

Alan D. Albright, Austin

4:00 p.m. Adjourn

REGISTRATION FOR PT05

Mail this registration form to:

The University of Texas School of Law, Attn. PT05
P.O. Box 7759, Austin, TX 78713-7759 **or fax a copy to: (512) 475-6876**

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REGISTRATION

Includes Course Binder and Special Wednesday Evening Session

Early Registration Fee due by Wed. Oct. 19, 2005 \$595.00

Registration Fee after Wed. Oct. 19, 2005 \$645.00

ADD LUNCH: THURSDAY, OCT 27, 2005

Thursday Lunch Presentation on Patent Reform \$10.00

CONFERENCE PUBLICATIONS AND MEDIA

Allow 2-4 weeks from conference date for delivery.

Course Binder WITHOUT Conference Registration \$200.00

Audio CD Set \$175.00

eBinder on CD (PDF format) \$200.00/\$50.00

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October 26*, 27-28, 2005

CONFERENCE LOCATION



Four Seasons Hotel

98 San Jacinto Blvd.
Austin, TX 78701
512-685-8100

\$199 special group rate
(subject to availability)
good through October 3, 2005.

Parking: \$6.00 self-parking
\$10.00 valet (subject to change)

KEY DATES

Registration & Cancellation

October 19, 2005, 5 p.m.

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

October 21, 2005, 5 p.m.

- last day for full refund

October 24, 2005, 5 p.m.

- last day for partial refunds \$50 processing fee applied

October 26, 2005

- special Wed. evening session begins at 6:00 p.m.

October 27, 2005

- conference begins at 9:00 a.m.

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