

2005 Advanced Patent Law Institute
October 26-28, 2005 • Four Seasons Hotel • Austin, TX

Wednesday Evening, Oct. 26, 2005

6:00 pm
2.50 hrs

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, Freescale Semiconductor, Inc. - Austin, TX
Dale S. Lazar, DLA Piper Rudnick Gray Cary US - Reston, VA
Keith E. Witek, Advanced Micro Devices - Austin, TX

Thursday Morning, Oct. 27, 2005

Presiding Officer:

Andrew J. Dillon, Dillon & Yudell, LLP - Austin, TX

9:00 am
0.50 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, Dubois Bryant Campbell & Schwartz LLP - Austin, TX

9:30 am
0.50 hr

Pre-filing Considerations in Patent Cases

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

Daniel D. Chapman, Jackson Walker - San Antonio, TX
Richard R. Ruble, Vinson & Elkins, LLP - Houston, TX

10:00 am
0.75 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, Jones Day - Dallas, TX

11:00 am 0.50 hr	<p>Willfulness, Scope of Privilege, Waiver</p> <p>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.</p> <p>Brian L. Ferrall, Kecker & Van Nest LLP - San Francisco, CA</p>
11:30 am 0.50 hr	<p>Inequitable Conduct Issues in Patent Prosecution, Litigation, and IP Asset Management</p> <p>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.</p> <p>James E. Beyer, Dinsmore & Shohl, LLP - Dayton, OH</p>

Thursday Afternoon, Oct. 27, 2005

Presiding Officer:

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

12:00 pm 0.50 hr	<p>Box Lunch Presentation: Patent Reform: Winners, Losers and Prospects</p> <p>Robert A. Armitage, Eli Lilly and Company - Indianapolis, IN Robert A. Barr, Cisco Systems, Inc. - San Jose, CA Peter N. Detkin, Intellectual Ventures - Los Altos, CA</p>
1:30 pm 0.50 hr	<p>Obviousness</p> <p>Examining the law of obviousness in light of recent case law and legislative developments.</p> <p>Christopher A. Cotropia, Intellectual Property Institute - Richmond, VA</p>
2:00 pm 0.50 hr	<p>Doctrine of Equivalents</p> <p>How viable is the doctrine of equivalents as an infringement theory post-Festo, and how is it proven at trial?</p> <p>Steven J. Pollinger, McKool Smith PC - Austin, TX</p>
2:30 pm 0.75 hr	<p>A Dialogue on Remedies and Damages</p> <p>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.</p> <p>Brett C. Govett, Fulbright & Jaworski, L.L.P. - Dallas, TX David J. Healey, Weil, Gotshal & Manges, LLP - Houston, TX</p>

3:30 pm 0.50 hr	<p>Sun Tzu—On the Art of Patent Prosecution</p> <p>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.</p> <p>Andrew J. Dillon, Dillon & Yudell, LLP - Austin, TX</p>
4:00 pm 0.50 hr	<p>Joint Defenses and Joint Defense Privilege Waivers</p> <p>A discussion of key issues and pitfalls arising in joint defenses, including the latest case law on waiver of privilege.</p> <p>Matthias Kamber, Keker & Van Nest, LLP - San Francisco, CA</p>
4:30 pm 1.00 hr	<p>Judicial Panel</p> <p>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.</p> <p>Andrew W. Austin, United States Magistrate Judge - Austin, TX Paul J. Luckern, U.S. International Trade Comm., Off. Of - Washington, DC David L. McCombs, Haynes & Boone, LLP - Dallas, TX Sam Sparks, United States District Judge - Austin, TX</p>

Friday Morning, Oct. 28, 2005

Presiding Officer:

Robert L. King, Freescale Semiconductor, Inc. - Austin, TX

8:30 am 0.50 hr	<p>Reexaminations during the Course of Litigation: What Should You Do?</p> <p>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.</p> <p>James B. Gambrell, C/O Roddy Tree Ranch - Hunt, TX</p>
9:00 am 0.50 hr	<p>Indirect Infringement</p> <p>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.</p> <p>Miriam L. Quinn, Fulbright & Jaworski, LLP - Dallas, TX</p>

9:30 am 0.75 hr	<p>Extraterritoriality</p> <p>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.</p> <p>Mark A. Lemley, Stanford Law School - Stanford, CA</p>
10:30 am 0.50 hr	<p>An Update on Section 102(b): On Sale, Public Use, Experimentation, and All That</p> <p>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.</p> <p>Steven R. Borgman, Vinson & Elkins, L.L.P. - Houston, TX</p>
11:00 am 0.50 hr	<p>Patents in China: Key Prosecution and Enforcement Issues for Western Practitioners</p> <p>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.</p> <p>J. Benjamin Bai, Jones Day - Houston, TX</p>
11:30 am 0.50 hr	<p>Antitrust, Patents and Standard Setting</p> <p>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.</p> <p>M. Sean Royall, Dallas, TX</p>

Friday Afternoon, Oct. 28, 2005

Presiding Officer:

Keith E. Witek, Advanced Micro Devices - Austin, TX

1:15 pm 0.75 hr	<p>Managing Inventors In-House</p> <p>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.</p> <p>Randall C. Brown, Haynes and Boone, LLP - Dallas, TX Anthony E. Peterman, Dell Inc. Legal Department - Round Rock, TX</p>
2:00 pm 0.75 hr	<p>Giving Away Patents: Open Source, Contributions, and Standards</p> <p>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.</p> <p>Lawrence Rosen, Rosenlaw & Einschlag Technology Law Offi - Ukiah, CA H. Shannon Tyson Jr., Broadcom Corporation - Austin, TX</p>

3:00 pm
0.50 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, Grant Thornton - Houston, TX

3:30 pm
0.50 hr

Electronic Discovery Landmines to Avoid

Discussion of several cases involving electronic discovery disasters and sanctions.

Alan D. Albright, Fish & Richardson P.C. - Austin, TX