

11TH ANNUAL

ADVANCED PATENT LAW INSTITUTE

Earn up to 15.75 Hours of Credit Including 2.25 Hours of Ethics Credit



October 25*, 26-27, 2006
Four Seasons Hotel
Austin, Texas

*Evening Session on International Prosecution and Enforcement

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ADVANCED PATENT LAW INSTITUTE

October 25*, 26-27, 2006 • Four Seasons Hotel • Austin, Texas

*Evening Session on International Prosecution and Enforcement

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WEDNESDAY EVENING—OCT. 25, 2006

*Optional session included in conference registration.

6:00 p.m. 2.00 hrs

Effective Strategies for Creating, Prosecuting and Enforcing Patent Portfolios in International Markets

In today's global economy, most companies receive significant revenue from overseas business activity. Furthermore, a significant portion of a company's strategic IP is now being created and infringed outside the United States. A robust global patent protection and enforcement strategy is key to continued business success. A panel of three patent experts will address prosecution, financial, political, and business issues that attorneys and companies will face when creating and operating multi-national patent programs. Special focus will be given to markets in and around India, China, and the EU.

Moderator: Keith E. Witek, Austin, TX
CHINA: J. Benjamin Bai, Houston, TX
INDIA: Chid S. Iyer, Washington, D.C.
EUROPE: Bruno Weihs, Paris, France

8:00 p.m. Adjourn

THURSDAY MORNING—OCT. 26, 2006

Presiding Officer: Robert L. King, Austin, TX

8:00 a.m. Registration Opens

Includes continental breakfast.

8:50 a.m. Welcoming Remarks

9:00 a.m. .50 hr

Obviousness/Non-Obviousness of the Novel Invention 35 U.S.C. 103

Examining the law of obviousness in light of recent developments including *KSR v. Teleflex*.

Gale R. (Pete) Peterson, San Antonio, TX

9:30 a.m. .75 hr

Effective Patent Prosecution: Critical Choices, Drafting Techniques, and Strategies

Patent law has changed drastically over the past ten years. Has your style of application drafting and prosecution? Learn how to optimize protection for your client in today's legal environment.

Timothy W. Lohse, East Palo Alto, CA

10:15 a.m. Break

10:30 a.m. .50 hr ethics

Pre-Filing Considerations in Patent Cases

A discussion of a patent-infringement plaintiff's obligation to perform an adequate pre-filing investigation.

J. Russell Emerson, Dallas, TX

11:00 a.m. .75 hr

Current Developments in Claim Construction

The Federal Circuit is one year post *Phillips v AWH*. Where does the court appear to be on claim construction (including single embodiment, power of the specification, and FH effects), and what the trial courts are doing at the "first instance"/real world level will be the focus of this session.

Kenneth R. Adamo, Dallas, TX

11:45 a.m. .50 hr ethics

Privilege and the Scope of Waiver

A discussion of the practical and ethical issues involving privileged opinions of counsel and the scope of waiver from reliance on an opinion, including an analysis of *Echostar* and its implications.

Steven R. Borgman, Houston, TX

THURSDAY AFTERNOON

Presiding Officer: James D. Woods, Ph.D., Houston, TX

LUNCHEON PRESENTATION

12:15 p.m. Pick Up Box Lunch

Included in conference registration.

12:30 p.m. 1.00 hr

Judicial Panel Discussion on Patent Litigation

A distinguished panel of judges from the Eastern and Western districts of Texas 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: William L. LaFuze, Houston, TX
Hon. Ron Clark, Beaumont, TX
Hon. David J. Folsom, Texarkana, TX
Hon. T. John Ward, Marshall, TX
Hon. Lee Yeakel, Austin, TX
Hon. John Love, Tyler, TX

1:45 p.m. .50 hr ethics

Inequitable Conduct Issues Update:

A Kaleidoscope of Tests

A detailed analysis of the inequitable conduct issues recently reviewed by the Federal Circuit and a discussion of how those holdings affect prosecution of patent applications and enforcement of U.S. Patents.

Miriam L. Quinn, Dallas, TX

2:15 p.m. .50 hr

The Doctrine of Equivalents—Has It Taken on a Life of Its Own?

Since *Markman*, infringement allegations under the doctrine of equivalents have soared. *Warner-Jenkinson* reaffirmed the existence of the doctrine of equivalents, but did so with "concern . . . that the doctrine of equivalents . . . has taken on a life of its own, unbounded by the patent claims." Overzealous assertion of equivalency can lead to anomalous results, often creating tension with other long recognized tenets of patent law. An analysis of these issues and policy considerations is provided.

John F. Luman III, Houston, TX
Co-author: Albert B. Kimball, Jr., Houston, TX

2:45 p.m. 1.00 hr

Patent Prosecution Procedure: Continuing Applications, Information Disclosure and Other New Rules

New rules already promulgated, or proposed for near-term adoption, promise to significantly change certain aspects of practice before the USPTO and the prosecution strategies available to patent applicants. New pitfalls will be created and new avenues for challenging validity or enforceability of patents in litigation are likely.

Andrew J. Dillon, Austin, TX
David W. O'Brien, Austin, TX
Jay P. Lucas, Alexandria, VA (invited)

3:45 p.m. Break

4:00 p.m. .50 hr

New Developments Regarding the Written Description Requirement

A discussion and review of recent Federal Circuit decisions regarding the written description requirement of 35 U.S.C. 112, first paragraph.

Randall C. Brown, Dallas, TX

4:30 p.m. 1.00 hr

Injunctions and Damages after *e-Bay*

A discussion of the Supreme Court's *e-Bay* decision, as well as the lower court decisions which have applied it and its impact on patent litigation. Other noteworthy decisions on damages and remedies will also be discussed.

Brett C. Govett, Dallas, TX
Mark A. Lemley, Stanford, CA

5:30 p.m. Adjourn

FRIDAY MORNING—OCTOBER 27, 2006

Presiding Officer: Miriam L. Quinn,
Dallas, TX

9:00 a.m. .75 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 in seeking reexamination during litigation, including the impact of reexamination initiative in the USPTO and the timing of reexaminations in the context of litigation.

Hilda C. Galvan, Dallas, TX
David M. O'Dell, Richardson, TX

9:45 a.m. .50 hr

Indirect Infringement

This presentation will address joint infringement of method and apparatus claims and the latest developments in the intent requirement for inducement of infringement.

David G. Wille, Dallas, TX

10:15 a.m. Break

10:30 a.m. .50 hr

Extraterritoriality

The Federal Circuit has recently expanded the ability of U.S. patent holders to redress infringement that occurs in whole or in part beyond U.S. borders, in some cases imposing liability for foreign companies and in other cases dramatically increasing the damages exposure of domestic manufacturers. This session discusses the recent developments in this increasingly important topic and provides suggestions both for expanding the reach of your patent portfolio to cover competitors' activities and for limiting your potential exposure.

Erik R. Puknys, Palo Alto, CA

11:00 a.m. .75 hr

Declaratory Judgment Jurisdiction

The Supreme Court granted certiorari in *MedImmune v. Genentech* to address when a patent licensee in good standing can challenge the validity of a patent. This session reviews declaratory judgment jurisdiction in light of that case including the "actual controversy" requirement of the Declaratory Judgment Act, and the public policy regarding patent validity challenges as applied in the Supreme Court's 1969 decision in *Lear v. Adkins*.

Darryl J. Adams, Austin, TX
Daralyn J. Durie, San Francisco, CA

11:45 a.m. .50 hr ethics

Ethics in Negotiations

A discussion of several real-world fact situations that commonly arise in negotiations, the ethical issues posed by each, and the resolution or occasional lack of resolution of the ethical issue.

Tom Adolph, Houston, TX

FRIDAY AFTERNOON

Presiding Officer: Andrew J. Dillon, Austin, TX

LUNCHEON PRESENTATION

12:15 p.m. Pick Up Box Lunch
Included in conference registration fee.

12:30 p.m. 1.00 hr

Patent Reform: Winners, Losers, and Prospects

The panel will provide an update and discussion on the ongoing patent reform initiatives. In addition to summarizing the latest legislative and regulatory proposals, the panel will provide commentary on the alignment of interest groups and the prospect for movement during the coming year.

Michael K. Kirk, Arlington, VA
Richard "Chip" J. Lutton, Jr., Cupertino, CA
James Pooley, Palo Alto, CA

1:45 p.m. .50 hr

Recent Developments in Patentable Subject Matter

Recent litigation, such as *Lab. Corp. of Am. Holdings v. Metabolite Labs. Inc.* at the U.S. Supreme Court, highlighted the presence of ongoing issues in establishing clear boundaries for patentable subject matter under 35 U.S.C. § 101. Implications from the Supreme Court's dismissal of the writ of certiorari in the *Metabolite Labs. Inc.* case will be discussed in addition to revised guidelines that the USPTO is presently using.

John M. Golden, Austin, TX

2:15 p.m. .50 hr including .25 hr ethics

Electronic Discovery Landmines to Avoid

The new electronic discovery rules take effect December 1, 2006: this session covers key issues under the new rules and key case law developments of interest to all practitioners.

Alan D. Albright, Austin, TX

2:45 p.m. .75 hr

Antitrust, Patents, and Standard-Setting

Recent cases brought by the Federal Trade Commission and other enforcement agencies have highlighted the risks associated with enforcing patents covered products developed through industry standard-setting efforts. The recent *In re Rambus* decision is reviving interest in antitrust remedies in patent cases. Increased attention in the European Union to standards issues also has raised the international implications of standard-setting. This session covers the implications of increased antitrust enforcement and litigation in this area, which lies at the crossroads of patent and antitrust law.

David J. Healey, Houston, TX

3:30 p.m. .50 hr

Portfolio Selections and Valuations in Cross-Licensing Negotiations and Auctions

This session will cover strategies for selecting licensing "proud lists" and selecting potential licensees and accused products. Approaches to determining relative portfolio values in cross-license negotiations will also be examined.

John C. Lindgren, Dallas, TX
James Pampinella, San Francisco, CA

4:00 p.m. Adjourn

ABOUT THE CONFERENCE

A stellar faculty from bench, bar, industry, and academia will address complex and cutting-edge issues at this year's Advanced Patent Law Institute in Austin, one of the leading IP conferences in the country. On Wednesday evening, a panel will discuss patent portfolios in international markets—focusing on markets in and around China, India, and the EU. Other highlights include special lunch presentations: a judicial panel on patent litigation and an update on the ongoing patent reform initiatives.

COMMENTS FROM LAST YEAR'S INSTITUTE

***Appreciate the
seasoned and
experienced speakers.***

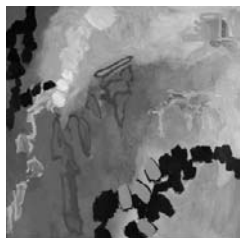
Outstanding program!

***Thank you for providing
both substantive papers
and PowerPoint
printouts.***

***Insightful, intellectual,
and experienced speakers
throughout.***

***Effective program with a
good mix of topics.***

***The Four Seasons Hotel
continues to be an
excellent choice
of venue.***



ABOUT THE COVER

*"Sinner," oil on wood, is by
Jennifer Chenoweth. For
more information, visit
www.fisterrastudio.com*

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Houston, TX

MARK A. LEMLEY
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Keker & Van Nest, LLP
Stanford, CA

JOHN C. LINDGREN
Texas Instruments Incorporated
Dallas, TX

TIMOTHY W. LOHSE
DLA Piper Rudnick Gray Cary US LLP
East Palo Alto, CA

HON. JOHN LOVE
United States District Court
Eastern District of Texas
Tyler, TX

JAY P. LUCAS (Invited)
United States Patent and
Trademark Office
Alexandria, VA

JOHN F. LUMAN III
Bracewell & Giuliani LLP
Houston, TX

RICHARD "CHIP" J. LUTTON, JR.
Apple Computer, Inc.
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Austin, TX

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San Francisco, CA

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Dallas, TX

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Eastern District of Texas
Marshall, TX

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Paris, France

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Baker Botts L.L.P.
Dallas, TX

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Advanced Micro Devices, Inc.
Austin, TX

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United States District Court
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Course Binders

The Advanced Patent Law Institute generates a definitive IP resource guide. Don't miss updated case law, current developments, articles and planning strategies—over 500 pages of practical materials.

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P.O. Box 7759, Austin, TX 78713-7759 **or fax a copy to: (512) 475-6876**

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Assistant's Email (optional) _____

Invoices, confirmations and receipts are emailed to these addresses.

REGISTRATION:

Includes Course Binder, Wednesday Evening Session, Thursday and Friday Box Lunch Presentations

- ☐ Early Registration Fee due by Wednesday, Oct. 18, 2006 \$645.00
☐ Registration Fee after Wednesday, Oct. 18, 2006 \$695.00

CONFERENCE PUBLICATIONS AND MEDIA

Allow 2-4 weeks from the conference date for delivery.

- ☐ Course Binder Without Conference Registration \$200.00
Note: Conference registration includes Course Binder.
☐ Audio CD Set \$175.00
☐ eBinder on CD (PDF format) \$200.00/\$50.00
(\$200 purchased alone, \$50 with registration or purchase of Course Binder or Audio CD Set)

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Allow 2-4 weeks from the conference date for delivery.

- ☐ In-House CLE for 2—Includes Audio CD Set and Course Binder \$750.00
_____ Add participants (includes Course Binder) for \$200 each \$ _____

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AUSTIN

October 25*, 26-27, 2006

CONFERENCE LOCATION



Four Seasons Hotel

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

SPECIAL RATE \$199

(subject to availability)
good through October 5, 2006

Parking: \$6 self-parking; \$10 valet
(subject to availability)

KEY DATES

Registration & Cancellation

October 18, 2006—5 p.m.

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

October 20, 2006—5 p.m.

last day for full refund

October 23, 2006—5 p.m.

last day for partial refunds
\$50 processing fee applied

October 25, 2006—6 p.m.

Wednesday evening session begins

October 26, 2006—9 a.m.

conference begins

MCLE

This course has been approved for Minimum Continuing Legal Education credit by the State Bar of Texas Committee on MCLE in the amount of 15.75 hours, of which 2.25 credit hour will apply to legal ethics/professional responsibility credit.

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Each program uniquely tailored to its locale



PATENT LAW IN AUSTIN, TX

Oct. 25, 26-27, 2006 • Four Seasons Hotel

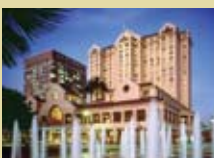
Join leading practitioners, academics and in-house counsel from the Southwest and Silicon Valley in Austin, Texas for two days of presentations on a rich array of prosecution and litigation topics. Cool weather, great city, music and food—at the Four Seasons Austin.



PATENT LAW IN ALEXANDRIA, VA

Nov. 16-17, 2006 • USPTO—Main Auditorium

This conference—offered at the USPTO—provides unique insights into claim construction; standard-setting and pooling; avoiding patent infringement; remedies and injunctions; the search process; patent reform and USPTO patent quality initiatives. Join USPTO senior staff, leading practitioners, academics and members of the federal judiciary from a variety of courts and forums in the Washington DC area, for two days at the USPTO. The conference is jointly sponsored with the George Mason University School of Law.



PATENT LAW IN SAN JOSE, CA

Nov. 29, Nov. 30-Dec.1, 2006 • The Fairmont San Jose

Come to the heart of Silicon Valley, and join leading judges, practitioners and in-house counsel from Apple, Google, National Semiconductor, and Hewlett-Packard at the Fairmont San Jose. This conference is jointly sponsored by the Berkeley Center for Law and Technology at Boalt Hall School of Law and Stanford Law School.

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