

**2006 Advanced Patent Law Institute**  
**October 25-27, 2006 • Four Seasons Hotel • Austin, TX**

**Wednesday Evening, Oct. 25, 2006**

6:00 pm  
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.

J. Benjamin Bai, Jones Day - Houston, TX  
Chid S. Iyer, Sughrue Mion, PLLC - Washington, DC  
Bruno K. Weihs, Osha Liang - Paris, France  
Keith E. Witek, Advanced Micro Devices, Inc. - Austin, TX

**Thursday Morning, Oct. 26, 2006**

**Presiding Officer:**

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

9:00 am  
0.50 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 Roy Peterson, Cox Smith Matthews Inc - San Antonio, TX

9:30 am  
0.75 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, Gray Cary Ware & Freidenrich - Palo Alto, CA

10:30 am  
0.00 hr  
0.50 hr ethics

**Pre-Filing Considerations in Patent Cases**

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

John Russell Emerson, Haynes And Boone, LLP - Dallas, TX

11:00 am 0.75 hr	<p><b>Current Developments in Claim Construction</b></p> <p>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.</p> <p>Kenneth R. Adamo, Jones Day - Dallas, TX</p>
11:45 am 0.00 hr 0.50 hr ethics	<p><b>Privilege and the Scope of Waiver</b></p> <p>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.</p> <p>Peter E. Mims, Vinson &amp; Elkins - Houston, TX</p>

## Thursday Afternoon, Oct. 26, 2006

### Presiding Officer:

**James D. Woods Ph.D.**, Grant Thornton LLP - Houston, TX

12:30 pm 1.00 hr	<p><b>Luncheon Presentation: Judicial Panel Discussion on Patent Litigation</b></p> <p>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.</p> <p>Ron Clark, United States District Court - Beaumont, TX  David J. Folsom, United States District Court - Texarkana, TX  William L. LaFuze, Vinson &amp; Elkins LLP - Houston, TX  John D. Love, United States District Court - Tyler, TX  Thomas J. Ward, US Dist Courthouse - Marshall, TX  Earl Leroy Yeakel III, United States District Court, W.D. Texas - Austin, TX</p>
1:45 pm 0.00 hr 0.50 hr ethics	<p><b>Inequitable Conduct Issues Update: A Kaleidoscope of Tests</b></p> <p>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.</p> <p>Miriam L. Quinn, Fulbright &amp; Jaworski, LLP - Dallas, TX</p>
2:15 pm 0.50 hr	<p><b>The Doctrine of Equivalents—Has It Taken on a Life of Its Own?</b></p> <p>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.</p> <p>John Francis Luman III, Bracewell &amp; Giuliani, LLP - Houston, TX</p>

2:45 pm 1.00 hr	<p><b>Patent Prosecution Procedure: Continuing Applications, Information Disclosure and Other New Rules</b></p> <p>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.</p> <p>Andrew J. Dillon, Dillon &amp; Yudell LLP - Austin, TX David W. O'Brien, Zagorin O'Brien &amp; Graham - Austin, TX</p>
4:00 pm 0.50 hr	<p><b>New Developments Regarding the Written Description Requirement</b></p> <p>A discussion and review of recent Federal Circuit decisions regarding the written description requirement of 35 U.S.C. 112, first paragraph.</p> <p>Randall C. Brown, Haynes And Boone - Dallas, TX</p>
4:30 pm 1.00 hr	<p><b>Injunctions and Damages after e-Bay</b></p> <p>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.</p> <p>Brett C. Govett, Fulbright &amp; Jaworski, L.L.P. - Dallas, TX Mark A. Lemley, Stanford Law School - Stanford, CA</p>

## Friday Morning, Oct. 27, 2006

### Presiding Officer:

**Miriam L. Quinn**, Fulbright & Jaworski, LLP - Dallas, TX

9:00 am 0.75 hr	<p><b>Reexaminations during the Course of Litigation: What Should You Do?</b></p> <p>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.</p> <p>Hilda C. Galvan, Jones Day - Dallas, TX David M. O'Dell, Haynes And Boone, LLP - Richardson, TX</p>
9:45 am 0.50 hr	<p><b>Indirect Infringement</b></p> <p>This presentation will address joint infringement of method and apparatus claims and the latest developments in the intent requirement for inducement of infringement.</p> <p>Samir A. Bhavsar, Baker Botts LLP - Dallas, TX</p>

10:30 am 0.50 hr	<p><b>Extraterritoriality</b></p> <p>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.</p> <p>Erik R. Puknys, Finnegan, Henderson, Farabow, Garrett &amp; - Palo Alto, CA</p>
11:00 am 0.75 hr	<p><b>Declaratory Judgment Jurisdiction</b></p> <p>The Supreme Court granted certiorari in <i>MedImmune v. Genentech</i> 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 <i>Lear v. Adkins</i>.</p> <p>Darryl J. Adams, Dewey Ballantine LLP - Austin, TX Daralyn Durie, Kecker &amp; Van Nest LLP - San Francisco, CA</p>
11:45 am 0.50 hr	<p><b>Ethics in Negotiations</b></p> <p>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.</p> <p>Tom Adolph, Jackson Walker LLP - Houston, TX</p>

## Friday Afternoon, Oct. 27, 2006

### Presiding Officer:

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

12:30 pm 1.00 hr	<p><b>Luncheon Presentation: Patent Reform: Winners, Losers, and Prospects</b></p> <p>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.</p> <p>Vincent E. Garlock, Aipla - Arlington, VA Richard Joseph Lutton Jr., Apple Computer Inc - Cupertino, CA James Pooley, Pooley &amp; Oliver, LLP - Palo Alto, CA</p>
1:45 pm 0.50 hr	<p><b>Recent Developments in Patentable Subject Matter</b></p> <p>Recent litigation, such as <i>Lab. Corp. of Am. Holdings v. Metabolite Labs. Inc.</i> 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 <i>Metabolite Labs. Inc.</i> case will be discussed in addition to revised guidelines that the USPTO is presently using.</p> <p>John M. Golden, University of Texas School of Law - Austin, TX</p>

2:15 pm 0.00 hr 0.25 hr ethics	<b>Electronic Discovery Landmines to Avoid</b>  <p>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.</p> <p>Alan D. Albright, Fish &amp; Richardson - Austin, TX</p>
2:45 pm 0.75 hr	<b>Antitrust, Patents, and Standard-Setting</b>  <p>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.</p> <p>David J. Healey, Weil, Gotshal &amp; Manges, LLP - Houston, TX</p>
3:30 pm 0.50 hr	<b>Portfolio Selections and Valuations in Cross-Licensing Negotiations and Auctions</b>  <p>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.</p> <p>John C. Lindgren, Texas Instruments Incorporated - Dallas, TX James Pampinella, Navigant Consulting, Inc. - San Francisco, CA</p>