

12th Annual Advanced Patent Law Institute
October 24*, 25-26, 2007 • Four Seasons Hotel • Austin, TX

Wednesday Afternoon, Oct. 24, 2007

4:00 pm
2.00 hrs

International Patent Prosecution Issues

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.

Georg A. Jahn, Noerr Stiefenhofer Lutz - Munich, Germany
Bijesh Thakker, Thakker & Thakker Solicitors & Advocates - Mumbai, India
Johnson D. L. Wang, Boss & Young, Attorneys at Law - Beijing, China
Moderator:
Keith E. Witek, Advanced Micro Devices, Inc. - Austin, TX

Wednesday Evening, Oct. 24, 2007

6:00 pm | **Adjourn**

Thursday Morning, Oct. 25, 2007

Presiding Officer:

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

8:00 am

Registration Opens

Includes continental breakfast, fruit, and breakfast tacos.

8:50 am

Welcoming Remarks

9:00 am
0.75 hr

Strategic Patent Prosecution

Successfully prosecuting a patent application without creating *Festo* estoppels, while maximizing claim scope and avoiding the embarrassing amendments and remarks is even more difficult today in view of the *KSR* decision. This presentation explains how to do so.

Richard A. Killworth, Dinsmore & Shohl, LLP - Dayton, OH

9:45 am 0.75 hr	<p>Patent Prosecution Procedure: Welcome to the Brave New World</p> <p>The United States Patent Office has published new rules which limit the number of claims in an application that will be initially examined, and which limit the number of continuation applications that can be filed. What types of claims should you select for examination under this rule and what impact should the limit on continuation applications have on your prosecution strategy? Additionally, revised rules for submission of Information Disclosure Statements are imminent and new rule packages have been proposed which will limit the use of Markush claims and which revise the format and procedure for appeals to the Board of Patent Appeals. Tactics and strategies for the changing prosecution landscape will be discussed.</p> <p>Andrew J. Dillon, Dillon & Yudell LLP - Austin, TX</p>
10:30 am 0.50 hr	<p>USPTO Initiatives</p> <p>A discussion of current USPTO Initiatives, including expedited patent prosecution, pre-appeal process and the patent highway pilot program.</p> <p>Daniel Drew Chapman, Jackson Walker, LLP - San Antonio, TX Ashley L. Kirk, Jackson Walker L.L.P. - San Antonio, TX</p>
11:00 am	Break
11:15 am 0.75 hr	<p>Developments in Claims Construction</p> <p>Overshadowed by the US Supreme Court/ Federal Circuit colloquy, this core issue has percolated along quietly. This year's pitfalls and construction trends of the moment will be explored, with an eye towards a more tactical approach to <i>Markman</i> mechanisms responsive to those trends. The Federal Circuit still controls the keys to the kingdom, but are the locks secure?</p> <p>Kenneth R. Adamo, Jones Day - Dallas, TX</p>

Thursday Afternoon, Oct. 25, 2007

Presiding Officer:

Amber Hatfield Rovner, Weil, Gotshal & Manges LLP - Austin, TX

12:00 pm 0.50 hr	<p>Patent Reform</p> <p>Congress continues to wrestle with conflicting industry viewpoints over patent reform. This session will report on the politics and prospects of the moment.</p> <p>James Pooley, Morrison & Foerster, LLP - Palo Alto, CA</p>
12:30 pm	Lunch on your Own

1:45 pm 0.50 hr	<p>Extraterritoriality After <i>AT&T v. Microsoft</i></p> <p>At this very program one year ago, the Federal Circuit's decision in <i>AT&T v. Microsoft</i> was analyzed and criticized at length. Just minutes after the presentation ended, the Supreme Court announced that it would review the Federal Circuit's decision. Late this spring, the Supreme Court reversed the judgment in <i>AT&T v. Microsoft</i>, reducing the damages award by hundreds of millions of dollars. This year, the impact of the Supreme Court's decision will be discussed, both in the context of lower court decisions and in the context of legislative proposals, many of which had previously suggested a complete repeal of section 271(f).</p> <p>Erik R. Puknys, Finnegan, Henderson, Farabow, Garrett & Dunner, LLP - Palo Alto, CA</p>
2:15 pm 0.50 hr ethics	<p>Attorney Opinions as a Defense to Willful Infringement and Special Problems of Waiver</p> <p>This topic will cover attorney opinions in connection with defense against a charge of willful infringement. It will address special problems of waiver of privilege in light of recent case law, including <i>In re Seagate</i>, <i>In re Echostar</i>, and <i>Knorr-Bremese</i>.</p> <p>Michael Anthony Valek, Vinson & Elkins LLP - Austin, TX</p>
2:45 pm 0.50 hr	<p>Update on Patent Damages: Considerations in Determining Royalty-Based Compensation</p> <p>Several recent Federal Circuit and Supreme Court decisions have directly affected patent prosecution, liability decisions and patent licensing activities. These decisions have received much attention in legal circles and even in the popular business media. Recent decisions related to damages have not been highlighted to the same extent. This session presents a brief panel discussion to re-cap the most important new developments in the area of patent damages. Topics will include compulsory licensing (<i>eBay v. MercExchange</i> and <i>Finisar v. DirecTV</i>) as well as apportionment, entire market value and royalty stacking (<i>Microsoft v. AT&T</i> and others).</p> <p>Barry L. Bell, Navigant Consulting, Inc. - Chicago, IL James D. Woods, Grant Thornton LLP - Houston, TX</p>
3:15 pm	<p>Break</p>
3:30 pm 0.50 hr	<p>Licensing After <i>Medimmune</i></p> <p>This session will discuss the Supreme Court's decision in <i>Medimmune</i> and its implications for both licensees and licensors, including strategies for structuring licensing programs and negotiating and drafting agreements.</p> <p>Mark Patrick, Texas Instruments - Dallas, TX</p>
4:00 pm 0.50 hr	<p>Obviousness</p> <p>There has been widespread discussion and comment since the recent Supreme Court decision in <i>KSR v. Teleflex</i> about whether that case represents a sea change, a profound transformation in patent jurisprudence, and in particular 35 USC § 103. A study of the precedents involved will analyze whether or not this may be so.</p> <p>Albert B. Kimball Jr., Bracewell & Giuliani LLP - Houston, TX</p>

4:30 pm 1.00 hr 0.25 hr ethics	Judicial Panel A distinguished panel of judges will discuss their procedures for managing patent cases in their courts, including ADR mechanisms, the use of special rules for patent cases, availability of remedies, electronic discovery, managing discovery disputes, time allocation and scheduling orders, the use of juries, and views on trial advocacy. Moderator: David L. McCombs, Haynes & Boone, LLP - Dallas, TX Hon. Keith P. Ellison, United States District Court, Southern District of Texas - Houston, TX Hon. Joseph J. Farnan Jr., United States District Court, District of Delaware - Wilmington, DE Hon. Jeff Kaplan, United States District Court, Northern District of Texas - Dallas, TX
5:30 pm	Adjourn

Friday Morning, Oct. 26, 2007

Presiding Officer:

Hilda C. Galvan, Jones Day - Dallas, TX

8:00 am	Conference Opens Included continental breakfast, fruit, and breakfast tacos.
8:30 am 0.50 hr	Patent Remedies A discussion of patent remedies and recent activity in the area. Brett C. Govett, Fulbright & Jaworski L.L.P. - Dallas, TX
9:00 am 0.50 hr	E-Discovery: Avoiding Landmines Key issues under the new rules and key case law developments of interest to all practitioners. John Scott Denko, Fish & Richardson - Austin, TX
9:30 am 1.00 hr	Indirect Infringement/Exhaustion and Implied License/Divided Infringement This panel will address a constellation of issues that arise when defendants sell only part of an infringing product, or sell goods that work in concert with the patentee's products. Moderator: Mark A. Lemley, Stanford Law School - Stanford, CA Steven R. Borgman, Vinson & Elkins LLP - Houston, TX William D. Wiese, Dubois, Bryant & Campbell, LLP - Austin, TX
10:30 am	Break

10:45 am 0.50 hr ethics	<p>The Fall-Out from <i>Medimmune</i>: Impact on Prefiling Considerations</p> <p>The Supreme Court in <i>Medimmune</i> and the Federal Circuit in <i>SanDisk</i> have changed the standard for filing declaratory judgment actions in patent cases. Does this new standard impact prefiling considerations for the declaratory judgment plaintiff? Does it impact prefiling considerations for the patentee?</p> <p>Hilda C. Galvan, Jones Day - Dallas, TX</p>
11:15 am 0.50 hr ethics	<p>Inequitable Conduct</p> <p>A review of recent developments in inequitable conduct law including the clarification of the standard of materiality, a possible shift in the scope of intent, and proposed legislative changes.</p> <p>Darryl J. Adams, Baker Botts L.L.P. - Austin, TX</p>
11:45 am 0.50 hr ethics	<p>Subject Matter Conflicts</p> <p>A discussion of practical and ethical issues as well as techniques for minimizing subject matter conflicts during the course of patent prosecution.</p> <p>Wei Wei Jeang, Haynes and Boone, LLP - Richardson, TX</p>

Friday Afternoon, Oct. 26, 2007

Presiding Officer:

Barton 'Bart' E. Showalter, Baker Botts L.L.P. - Dallas, TX

12:15 pm	<p>Luncheon Presentation</p> <p>Pick Up Box Lunch Included in conference registration fee.</p>
12:30 pm 0.75 hr	<p>Jury Consultants in IP Cases: Case Presentation and Venue Selection</p> <p>A panel of jury consultants will discuss trial presentation of IP cases in Texas, compare juror profiles and community attitudes among federal districts in Texas, and reveal common juror predispositions relevant to IP cases.</p> <p>Moderator: Craig W. Weinlein, Carrington, Coleman, Sloman & Blumenthal, L.L.P. - Dallas, TX Rob Conklin, Starr Litigation Services, Inc. - West Des Moines, IA George Speckart, Courtroom Sciences, Inc. - Irving, TX Theresa Zagnoli, Zagnoli, McEvoy & Foley, LLC - Chicago, IL</p>
1:30 pm 0.50 hr	<p>The Scope of Means Plus Function Elements in Computer Software Patents</p> <p>This presentation will address the current view of the scope of means plus function clauses in patents involving computer software. The scope of such clauses has been contested in numerous cases in the past several years and courts have adopted varying approaches to identifying corresponding structure.</p> <p>David G. Wille, Baker Botts L.L.P. - Dallas, TX</p>

2:00 pm 0.50 hr	<p>Strategic Use of Reexamination In (and to Avoid) Litigation</p> <p>Reexamination, both ex parte and inter partes, presents an interesting decision for potential targets of patent licensing and enforcement campaigns. This talk will discuss the strategic use of reexamination, including considerations to stay district court action, the effect of <i>KSR v Teleflex</i> on reexamination filings, and recent statistics.</p> <p>Barton 'Bart' E. Showalter, Baker Botts L.L.P. - Dallas, TX</p>
2:30 pm 0.50 hr	<p>Patent Prosecution Study</p> <p>A major new study of patent prosecution reveals the hidden truth about the PTO's actual grant rates, the use of continuations, and the shocking facts about which industries face the toughest prosecutions.</p> <p>Mark A. Lemley, Stanford Law School - Stanford, CA</p>
3:00 pm 0.50 hr	<p>Antitrust Update Including Supreme Court and FTC Developments</p> <p>A brief update on key antitrust developments including Supreme Court cases and FTC developments in light of <i>Rambus</i>.</p> <p>Adam C. Hemlock, Weil, Gotshal & Manges LLP - New York, NY</p>
3:30 pm 0.50 hr	<p>ITC Update</p> <p>Investigations by the International Trade Commission are more important than ever. This presentation will cover some of the hot issues currently before the ITC, as well as pointers for representing clients before the Commission.</p> <p>Douglas A. Cawley, McKool Smith PC - Dallas, TX</p>
4:00 pm	<p>Adjourn</p>