

13TH ANNUAL**ADVANCED PATENT LAW INSTITUTE**

Earn up to 14.25 Hours of Credit Including 2.75 Hours of Ethics Credit



October 30-31, 2008

Four Seasons Hotel

Austin, Texas

Major Sponsorship Provided by

NAVIGANT
CONSULTING

13TH ANNUAL
ADVANCED PATENT LAW INSTITUTE

October 30-31, 2008 • Four Seasons Hotel • Austin, Texas

Earn up to 14.25 Hours of Credit Including 2.75 Hours of Ethics Credit

THURSDAY MORNING, OCT. 30, 2008

**Presiding Officer: Robert L. King,
Freescale Semiconductor, Inc., Austin, TX**

8:00 a.m. Registration Opens

Includes continental breakfast.

8:45 a.m. Welcoming Remarks

8:50 a.m. 1.00 hr

Disasters in Litigation: What Patent Prosecutors Could Have Done to Prevent the Carnage

Ten case histories, with disastrous results for the patentee, will be discussed. In each instance there will be suggestions as to what the patent prosecutor could have done to avoid the bad result.

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

Dale S. Lazar, DLA Piper, Reston, VA

9:50 a.m. .67 hr

Developments in Claims Construction

With apparent claim construction peace declared between the Federal Circuit and the Supreme Court, the Federal Circuit has dug in and potentially opened a new front in its *O2* decision. Other old-favorite construction rules and trends have gone off on new loops and tangents as well. These new fronts and trends will be discussed, how to handle them in *Markman* constructions will be explored, and the new pitfalls and "gotchas" will be flagged.

Kenneth R. Adamo, Jones Day, Dallas, TX

10:30 a.m. Break

10:45 a.m. .50 hr

Patent Exhaustion After *Quanta*: Impact on Litigation and Licensing

The Supreme Court's recent decision in *Quanta* redefines an area of patent law that had been subject to considerable confusion for many years. The Court confirmed that so-called "combination" or "system" claims can be exhausted by the sale of a component "substantially embodying" the patented invention. The Court also reversed decades-old Federal Circuit precedent in holding that method claims are subject to the same exhaustion rules as apparatus claims. At the same time, the Court left open the ex-

tent to which application of the exhaustion doctrine may be contractually limited. This session explores the impact of *Quanta* on patent litigation and licensing, including an analysis of the Court's test for exhaustion and the possible extension of *Quanta* to attempted contractual restrictions.

Garland T. Stephens, Weil, Gotshal & Manges LLP, Houston, TX

11:15 a.m. .75 hr

Obviousness After KSR: Litigation and Prosecution

A discussion about how *KSR* has changed patent infringement litigation and patent prosecution, including a review of cases citing *KSR*, jury charges on obviousness post-*KSR*, trial strategies, examiner arguments and rejections, and prosecution strategies.

Tom Adolph, Jackson Walker LLP, Houston, TX

Stephen P. Koch, ExxonMobil Upstream Research Company, Houston, TX

THURSDAY AFTERNOON

**Presiding Officer: Amber Hatfield Rovner,
Weil, Gotshal & Manges LLP, Austin, TX**

LUNCHEON PRESENTATION

Sponsored by
**Fulbright & Jaworski L.L.P.
Weil, Gotshal & Manges LLP**

12:00 p.m. Pick up Lunch
Included in conference registration.

12:15 p.m. .75 hr

Jury-Oriented Patent Prosecution and Presentation

Ideas, strategies and tips for the patent prosecutor and litigator, with the end goal being an understandable patent and/or jury presentation.

Moderator: Brett C. Govett, Fulbright & Jaworski L.L.P., Dallas, TX

George Speckart, Ph.D., Courtroom Sciences, Inc., Irving, TX

Andrew M. Spingler, The Focal Point, Santa Fe, NM

James B. Stiff, Ph.D., Trial Analysts, Inc., College Station, TX

1:00 p.m. Break

1:15 p.m. .50 hr

Patent Quality Checklist: In-House Counsel's Perspective for Ensuring Successful Licensing

A patent is crafted years before it is asserted. The decision whether, when, how, and where to license a patent depends on any number of business and legal considerations, but it almost always begins with the patent itself. Is your patent ready to take to market? We will discuss what to do before filing and during prosecution to ensure that the finished product—the issued patent or family of patents—is indeed ready. We will also consider how to evaluate issued patents to determine their suitability for licensing.

Alexander E. Silverman, AT&T Mobility, Redmond, WA

1:45 p.m. .50 hr

Forum Selection and Local Rules

A survey of popular districts for patent litigation, comparing local patent rules, time to trial and other factors relevant to forum selection.

Craig W. Weinlein, Carrington, Coleman, Sloman & Blumenthal, L.L.P., Dallas, TX

2:15 p.m. .75 hr including .25 hr ethics

Top 10 Do's and Don'ts for Patent Trial Practice

The ever increasing complexities of patent litigation come to a head at trial, where the case must be boiled down to sell it to a lay jury. This session will explore what to do, and what not to do, to successfully try a patent case to a jury and for appeal, and to properly work up the case in discovery and pretrial. Plaintiff's and defendant's perspectives, as well as ethical issues, will be considered.

Michael D. Pegues, Bracewell & Giuliani LLP, Dallas, TX

Steven J. Pollinger, McKool Smith, P.C., Austin, TX

3:00 p.m. Break

3:15 p.m. .50 hr

Indirect and Divided Infringement

Few recent cases addressing the law of infringement have been as significant as the Federal Circuit's decisions in *DSU Medical Corp. v. JMS Co., Ltd.*, 471 F.3d 1293 (Fed. Cir. 2006)(en banc) (concerning induced infringement) and *BMC Resources, Inc. v. Paymentech, L.P.*, 498 F.3d 1373 (Fed. Cir. 2007) (concerning divided

infringement). This presentation analyzes how the lower courts have responded to those decisions and provides practical advice on how to avoid the pitfalls of those cases for practitioners drafting and prosecuting patent applications.

Erik R. Puknys, Finnegan, Henderson, Farabow, Garrett & Dunner, LLP, Palo Alto, CA

3:45 p.m. .75 hr

When to Hold, When to Fold: Litigation Judgment and Settlement Strategies in Patent Cases

Deciding when and how to settle patent cases, and which cases to take to trial, is a critical business decision that requires not only an assessment of the risks and benefits in a specific case but also a strategic sense of the long-term interests of the company. This panel of in-house counsel will discuss their experiences and their lessons learned about what works and what doesn't work in making these decisions.

Moderator: Robert Barr, Berkeley Center for Law and Technology, Berkeley, CA

Richard 'Chip' J. Lutton Jr., Apple Computer, Inc., Cupertino, CA

Mark Patrick, Texas Instruments, Dallas, TX

Jennifer B. Wuamett, Freescale Semiconductor, Inc., Austin, TX

4:30 p.m. 1.00 hr including .25 hr ethics

Judicial Panel

In a time of an evolving patent landscape and increased activity in the Supreme Court, legislature and Patent and Trademark Office, a panel of distinguished District Court Judges discuss their experiences with, and thoughts on, managing, hearing and trying patent cases.

Moderator: Katherine Kelly Lutton, Fish & Richardson P.C., Redwood City, CA

Hon. David J. Folsom, U.S. District Court, Eastern District of Texas, Texarkana, TX

Hon. T. John Ward, U.S. District Court, Eastern District of Texas, Marshall, TX

Hon. Lee Yeakel, U.S. District Court, Western District of Texas, Austin, TX

5:30 p.m. Adjourn

FRIDAY MORNING, OCT. 31, 2008

Presiding Officer: Darryl J. Adams, Dewey & LeBoeuf LLP, Austin, TX

8:30 a.m. .50 hr

Patent Reexamination Nuts and Bolts

Patent reexaminations, especially inter partes reexaminations, have increasingly become arrows in the quivers of a patent litigator's arsenal that are used to defend allegations of infringement. This presentation will discuss reexamination strategies as well as the nuts and bolts of a successful reexamination request.

A check list of must's and should's will be provided.

Wei Wei Jeang, Haynes and Boone, LLP, Richardson, TX

9:00 a.m. .50 hr

New USPTO Appeal Rules

Effective December 8, 2008, the Board of Appeals and Interferences will be operating under a new rule package which is intended to streamline the process and address the increasing backlog of appeals. This presentation will address which rules have changed, what are the best strategies for dealing with the new rule package, and whether the new rules represent progress or merely movement.

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

9:30 a.m. .75 hr

Industry Standards Impact on How Companies Do Business: SDO's, Essential Patents, Antitrust and Contractual Challenges in Technology Markets

Companies designing, developing, selling and/or purchasing products for markets that require compliance with industry standards, face uniquely challenging IP and business issues due to the convergence of patent, antitrust, and contractual laws and obligations that are complex and often conflict with business goals. Recent decisions such as the *Rambus* Federal Circuit decision and the Third Circuit's *Broadcomm v Qualcomm* decision, as well as ongoing EU investigations of *Qualcomm* and *Rambus* highlight how vastly differing interpretations of these laws can have profound business and market implications. This panel of outside counsel and in-house counsel will discuss how companies can better understand and reconcile these laws and obligations in a way that balances the risks and rewards of competing and participating in these industry compliant markets.

Tim Carlson, Texas Instruments, Germantown, MD

David J. Healey, Weil, Gotshal & Manges, LLP, Houston, TX

10:15 a.m. Break

10:30 a.m. .50 hr

After eBay: Post-verdict Remedies and ITC Orders

The Supreme Court's *eBay v. MercExchange* decision changed the rules for injunctive relief and will likely have a substantial influence on the remedies available to patent owners. What happens when there's a finding of infringement but a denial of an injunction? What post-verdict remedies remain available and when do they apply? The session will focus on alternative remedies, such as post-verdict royalties and ITC orders and their potential application.

Brent K. Bersin, Navigant Consulting, Inc., Houston, TX

Steven R. Borgman, Vinson & Elkins, L.L.P., Houston, TX

11:00 a.m. .50 hr

The Proper Scope of the Experimental Use Doctrine In View of Pfaff

After the Supreme Court's decision in *Pfaff v. Wells Electronics* redefined the scope of the on-sale bar, the Federal Circuit has struggled to find the proper scope of the experimental use negation of the on-sale bar. The Federal Circuit has recognized that its caselaw is confusing in this area and has explicitly questioned whether its precedent is consistent with *Pfaff*. This presentation will examine the current scope of the experimental use doctrine and the proper scope of the doctrine in view of *Pfaff*.

Darryl J. Adams, Dewey & LeBoeuf LLP, Austin, TX

11:30 a.m. .50 hr

The Shocking Truth About Patent Litigation: Data From the IP Litigation Clearinghouse

Professor Lemley will present preliminary findings from the most comprehensive collection of patent litigation data in the country, including the real truth about how many patent trolls are out there, whether defendants copy inventions, and the best district to get your patent case to trial (hint: it's NOT the Eastern District of Texas).

Mark A. Lemley, Stanford Law School, Stanford, CA

FRIDAY AFTERNOON

Presiding Officer: David W. O'Brien, Zagorin O'Brien & Graham LLP, Austin, TX

LUNCHEON PRESENTATION

Sponsored by
Jones Day

12:00 p.m. Pick up Lunch
Included in conference registration.

12:15 p.m. .75 hr ethics

Top 10 Prosecution Ethics Issues

Malpractice and conflict of interest claims based upon patent prosecution are growing in number and severity of settlement. This session will address ten issues that should be of concern to patent practitioners.

David Hrick, Mercer University School of Law, Macon, GA

1:00 p.m. Break

1:15 p.m. .50 hr

Strategic Patent Monetization: Brokers and Auctions

Historically, the intellectual property market

CONFERENCE FACULTY AND PLANNING COMMITTEE

has been insulated as transactions were largely conducted in private and, thus, transaction prices and other details were not disclosed. The emergence of live auctions have changed this as sellers and buyers now have access to an increasing amount of comparable data as well as expanded knowledge of available assets. However, depending upon specific seller requirements, a private auction or sale may be the better option. During this session, the speaker will discuss current trends, pros and cons of various transaction platforms and common challenges associated with each type.

Michael James Lasinski, Ocean Tomo,
Chicago, IL

1:45 p.m. **.50 hr**

Section 101

The presentation discusses recent changes and updates by the U.S. Supreme Court, the Federal Circuit, District Courts and the USPTO to the understanding of statutory subject matter. It further examines what changes might be expected over the coming year.

Michael G. Locklar, Jackson Walker L.L.P.,
Houston, TX

2:15 p.m. **.50 hr ethics**

Joint Defense Strategies and Agreements

The number of patent cases being filed against groups of unrelated defendants is on the rise. As a result, the number of joint defense groups being formed is also on the rise and issues surrounding joint defense groups are many. This presentation will include a discussion of waiver, conflicts and strategic considerations involving management of the case and the group.

Hilda C. Galvan, Jones Day, Dallas, TX

2:45 p.m. **.50 hr ethics**

Patent Malpractice Claims

A discussion of the increasing number of malpractice actions brought against individual practitioners and firms for mistakes in prosecuting applications and dealing with other patent related issues.

James B. Gambrell, Hunt, TX

3:15 p.m. **.50 hr ethics**

E-Discovery and Spoliation

Key issues and case law updates of interest to all practitioners will be discussed.

Barry K. Shelton, Fish & Richardson P.C.,
Austin, TX

3:45 p.m. **Adjourn**

*planning committee members

KENNETH R. ADAMO

Jones Day
Dallas, TX

DARRYL J. ADAMS*

Dewey & LeBoeuf LLP
Austin, TX

TOM ADOLPH*

Jackson Walker LLP
Houston, TX

ROBERT BARR

Berkeley Center for Law and Technology
Berkeley, CA

BRENT K. BERSIN*

Navigant Consulting, Inc.
Houston, TX

STEVEN R. BORGMAN*

Vinson & Elkins, L.L.P.
Houston, TX

TIM CARLSON

Texas Instruments
Germantown, MD

ANDREW J. DILLON*

Dillon & Yudell LLP
Austin, TX

KIRBY B. DRAKE*

Fulbright & Jaworski L.L.P.
Dallas, TX

MICHAEL J. ESPOSITO*

The University of Texas School of Law
Austin, TX

JOHN D. FLYNN*

IBM Corporation
Austin, TX

HON. DAVID J. FOLSOM

U.S. District Court, Eastern District of Texas
Texarkana, TX

HILDA C. GALVAN

Jones Day
Dallas, TX

JAMES B. GAMBRELL*

Hunt, TX

JOHN M. GOLDEN*

The University of Texas School of Law
Austin, TX

BRETT C. GOVETT*

Fulbright & Jaworski L.L.P.
Dallas, TX

GARY W. HAMILTON*

Hamilton & Terrill, LLP
Austin, TX

DAVID J. HEALEY*

Weil, Gotshal & Manges, LLP
Houston, TX

DAVID HRICIK

Mercer University School of Law
Macon, GA

WEI WEI JEANG*

Haynes and Boone, LLP
Richardson, TX

RICHARD A. KILLWORTH

Dinsmore & Shohl, LLP
Dayton, OH

ALBERT B. KIMBALL JR.*

Bracewell & Giuliani, LLP
Houston, TX

ROBERT L. KING—CO-CHAIR*

Freescale Semiconductor, Inc.
Austin, TX

STEPHEN P. KOCH

ExxonMobil Upstream Research Company
Houston, TX

WILLIAM L. LAFUZE*

Vinson & Elkins LLP
Houston, TX

MICHAEL JAMES LASINSKI

Ocean Tomo
Chicago, IL

DALE S. LAZAR

DLA Piper
Reston, VA

MARK A. LEMLEY*

Stanford Law School
Stanford, CA

MICHAEL G. LOCKLAR

Jackson Walker L.L.P.
Houston, TX

KATHERINE KELLY LUTTON

Fish & Richardson P.C.
Redwood City, CA

RICHARD 'CHIP' J. LUTTON JR.

Apple Computer, Inc.
Cupertino, CA

ERIC L. NATINSKY*

Wilson Sonsini Goodrich & Rosati
Austin, TX

DAVID W. O'BRIEN*

Zagorin O'Brien & Graham LLP
Austin, TX

MARK PATRICK*

Texas Instruments
Dallas, TX

MICHAEL D. PEGUES

Bracewell & Giuliani LLP
Dallas, TX

STEVEN J. POLLINGER

McKool Smith, P.C.
Austin, TX

REGISTRATION FOR PT08

ERIK R. PUKNYS
Finnegan, Henderson, Farabow, Garrett & Dunner, LLP
Palo Alto, CA

LOUIS A. RILEY*
Austin, TX

AMBER HATFIELD ROVNER—CO-CHAIR*
Weil, Gotshal & Manges LLP
Austin, TX

BARRY K. SHELTON
Fish & Richardson P.C.
Austin, TX

ALEXANDER E. SILVERMAN
AT&T Mobility
Redmond, WA

GEORGE SPECKART, PH.D.
Courtroom Sciences, Inc.
Irving, TX

ANDREW M. SPINGLER
The Focal Point
Santa Fe, NM

GARLAND T. STEPHENS
Weil, Gotshal & Manges LLP
Houston, TX

JAMES B. STIFF, PH.D.
Trial Analysts, Inc.
College Station, TX

ROBERT W. TURNER*
Jones Day
Dallas, TX

HON. T. JOHN WARD
U.S. District Court, Eastern District of Texas
Marshall, TX

SHIRLEY WEBSTER*
CRA International
Houston, TX

CRAIG W. WEINLEIN*
Carrington, Coleman, Soman & Blumenthal, L.L.P.
Dallas, TX

WILLIAM D. WIESE*
Dubois, Bryant & Campbell, LLP
Austin, TX

JAMES D. WOODS*
Grant Thornton LLP
Houston, TX

JENNIFER B. WUAMETT
Freescale Semiconductor, Inc.
Austin, TX

HON. LEE YEAKEL
U.S. District Court, Western District of Texas
Austin, TX

Mail this registration form to:
The University of Texas School of Law, attn. PT08
P.O. Box 7759, Austin, TX 78713-7759 **or fax a copy to: (512) 475-6876**
Online registration available at www.utcle.org

PLEASE PRINT CLEARLY

Bar Card# _____ TX Other State: _____ N/A

Name [Mr. / Ms.] _____

Firm _____

Address _____

City _____ State _____ Zip _____

Telephone _____ Fax _____

Registrant's Email (required) _____

Assistant's Email (optional) _____

Invoices, confirmations, and receipts are emailed to these addresses.

REGISTRATION

Includes Course Binder and Box Lunch Presentations

- Early Registration Fee due by Wed., Oct. 22, 2008 \$660.00
- Registration Fee after Wed., Oct. 22, 2008 \$710.00

CONFERENCE PUBLICATIONS AND MEDIA

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

- Course Binder WITHOUT Conference Registration \$225.00
- Audio CD Set \$175.00
- eBinder on CD (PDF format) \$225.00/\$50.00
(\$225 purchased alone, \$50 with registration or purchase of Course Binder or Audio CD Set)

IN-HOUSE CLE: Bring the conference in-house and learn at your convenience.

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 \$225 each \$ _____

UTCLE eLibrary: Papers, PPTs, and Podcasts in 40 practice areas

- One-year subscription for UTCLE eLibrary \$295.00
- Discounts available for multiple subscriptions; call 512-475-6700 for more information.

TOTAL ENCLOSED \$ _____

METHOD OF PAYMENT

- Check (make checks payable to: **The University of Texas at Austin**)
- VISA or Mastercard (sorry, no AMEX or Discover)

Card # - - -

X _____
Authorized Signature

/
Exp. Date (mm/yy)

THANK YOU TO OUR LUNCHEON SPONSORS

Fulbright & Jaworski L.L.P.
Jones Day
Weil, Gotshal & Manges LLP

AUSTIN

October 30-31, 2008
CONFERENCE LOCATION

Four Seasons Hotel

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

SPECIAL ROOM RATE: \$225
good through October 3, 2008
(subject to availability)

Parking: Valet: Day \$10, Overnight \$25
\$7 Self-Parking available in
parking garage across from hotel
(subject to change)

KEY DATES

Registration and Cancellation

October 22, 2008, 5 p.m.

last day for early registration

add \$50 for registrations received after this time

October 24, 2008, 5 p.m.

last day for full refund

October 27, 2008, 5 p.m.

last day for partial refunds

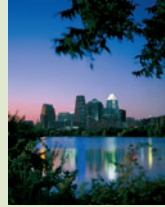
\$50 processing fee applied

October 30, 2008, 8:50 a.m.

conference begins

ADVANCED PATENT LAW INSTITUTES

Each program uniquely tailored to its locale



PATENT LAW IN AUSTIN, TX

Oct. 30-31, 2008 • 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. 13-14, 2008 • USPTO—Main Auditorium

This conference provides the insider's perspective on USPTO initiatives, practice rules, developments, and much more. 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 SANTA CLARA, CA

Dec. 11-12, 2008

Hyatt Regency Santa Clara

Come to the heart of Silicon Valley, and join leading judges and practitioners from major corporations such as Google, Yahoo!, and Genentech. This conference is jointly sponsored by the Berkeley Center for Law and Technology at Boalt Hall and the Stanford Program in Law, Science and Technology.



ABOUT THE COVER

"Small Stripe," paint and ash on artboard, 10" x 8", framed, is by Jennifer Chenoweth and Todd Campbell. For more information, visit www.fisterrastudio.com

UTCLE

THE UNIVERSITY OF TEXAS AT AUSTIN
THE UNIVERSITY OF TEXAS SCHOOL OF LAW
P.O. Box 7759 • Austin, TX 78713-7759

This program is not printed or mailed at state expense.

M
C
L
E

The Advanced Patent Law Institute course has been approved for MCLE credit by the State Bar of Texas Committee on MCLE in the amount of 14.25 hours, of which 2.75 hours will apply to legal ethics/professional responsibility. The UT School of Law is a State Bar of CA approved MCLE provider (#1944).

Email us at
utcle@law.utexas.edu
or call us at
512-475-6700
for more information

13TH ANNUAL ADVANCED PATENT LAW INSTITUTE

October 30-31, 2008 • Four Seasons Hotel • Austin, Texas

NON-PROFIT-ORG
U.S. Postage Paid
The University of
Texas
School of Law