

13th Annual Advanced Patent Law Institute - Austin
October 29*, 30-31, 2008 • Four Seasons Hotel • Austin, TX

Thursday Morning, Oct. 30, 2008

Presiding Officer:

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

8:00 am	Registration Opens Includes continental breakfast.
8:45 am	Welcoming Remarks
8:50 am 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 am 0.67 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 <i>O2</i> 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 <i>Markman</i> constructions will be explored, and the new pitfalls and "gotchas" will be flagged. Kenneth R. Adamo, Jones Day - Dallas, TX
10:30 am	Break
10:45 am 0.50 hr	Patent Exhaustion After <i>Quanta</i>: Impact on Litigation and Licensing The Supreme Court's recent decision in <i>Quanta</i> 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 extent to which application of the exhaustion doctrine may be contractually limited. This session explores the impact of <i>Quanta</i> on patent litigation and licensing, including an analysis of the Court's test for exhaustion and the possible extension of <i>Quanta</i> to attempted contractual restrictions. Garland T. Stephens, Fish & Richardson P.C. - Houston, TX

11:15 am 0.75 hr	<p>Obviousness After KSR: Litigation and Prosecution</p> <p>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.</p> <p>Tom Adolph, Jackson Walker LLP - Houston, TX Stephen P. Koch, ExxonMobil Upstream Research Company - Houston, TX</p>
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Thursday Afternoon, Oct. 30, 2008

Presiding Officer:

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

	<p>LUNCHEON PRESENTATION</p> <p>Sponsored by Fulbright & Jaworski L.L.P. Weil, Gotshal & Manges LLP</p>
12:00 pm	<p>Pick up Lunch</p> <p>Included in conference registration.</p>
12:15 pm 0.75 hr	<p>Jury-Oriented Patent Prosecution and Presentation</p> <p>Ideas, strategies and tips for the patent prosecutor and litigator, with the end goal being an understandable patent and/or jury presentation.</p> <p>Moderator: Brett C. Govett, Fulbright & Jaworski L.L.P. - Dallas, TX George Speckart, Courtroom Sciences, Inc. - Irving, TX Andrew M. Spingler, The Focal Point - Santa Fe, NM James B. Stiff, Trial Analysts, Inc. - College Station, TX</p>
1:00 pm	<p>Break</p>
1:15 pm 0.50 hr	<p>Patent Quality Checklist: In-House Counsel's Perspective for Ensuring Successful Licensing</p> <p>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.</p> <p>Umesh M. Desai, AT&T Laboratories, Inc. - Austin, TX</p>
1:45 pm 0.50 hr	<p>Forum Selection and Local Rules</p> <p>A survey of popular districts for patent litigation, comparing local patent rules, time to trial and other factors relevant to forum selection.</p> <p>John Steven Torkelson, Carrington, Coleman, Sloman & Blumenthal L.L.P. - Dallas, TX</p>

2:15 pm 0.75 hr 0.25 hr ethics	<p>Top 10 Do's and Don'ts for Patent Trial Practice</p> <p>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.</p> <p>Michael D. Pegues, Bracewell & Giuliani LLP - Dallas, TX Steven J. Pollinger, McKool Smith, P.C. - Austin, TX</p>
3:00 pm	Break
3:15 pm 0.50 hr	<p>Indirect and Divided Infringement</p> <p>Few recent cases addressing the law of infringement have been as significant as the Federal Circuit's decisions in <i>DSU Medical Corp. v. JMS Co., Ltd.</i>, 471 F.3d 1293 (Fed. Cir. 2006)(en banc) (concerning induced infringement) and <i>BMC Resources, Inc. v. Paymentech, L.P.</i>, 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.</p> <p>Erik R. Puknys, Finnegan, Henderson, Farabow, Garrett & Dunner, LLP - Palo Alto, CA</p>
3:45 pm 0.75 hr	<p>When to Hold, When to Fold: Litigation Judgment and Settlement Strategies in Patent Cases</p> <p>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.</p> <p>Moderator: Robert Barr, Berkeley Center for Law and Technology - Berkeley, CA Richard 'Chip' J. Lutton Jr., Apple, Inc. - Cupertino, CA Mark Patrick, Texas Instruments - Dallas, TX Jennifer B. Wuamett, Freescale Semiconductor, Inc. - Austin, TX</p>
4:30 pm 1.00 hr 0.25 hr ethics	<p>Judicial Panel</p> <p>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.</p> <p>Hon. David J. Folsom, U.S. District Court, Eastern District of Texas - Texarkana, TX Moderator: Katherine Kelly Lutton, Fish & Richardson P.C. - Redwood City, CA 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</p>
5:30 pm	Adjourn

Friday Morning, Oct. 31, 2008

Presiding Officer:

Darryl J. Adams, Baker Botts L.L.P. - Austin, TX

8:30 am 0.50 hr	<p>Patent Reexamination Nuts and Bolts</p> <p>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.</p> <p>Wei Wei Jeang, Haynes & Boone, LLP - Richardson, TX</p>
9:00 am 0.50 hr	<p>New USPTO Appeal Rules</p> <p>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.</p> <p>Andrew J. Dillon, Dillon & Yudell LLP - Austin, TX</p>
9:30 am 0.75 hr	<p>Industry Standards Impact on How Companies Do Business: SDO's, Essential Patents, Antitrust and Contractual Challenges in Technology Markets</p> <p>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 <i>Rambus</i> Federal Circuit decision and the Third Circuit's <i>Broadcomm v Qualcomm</i> decision, as well as ongoing EU investigations of <i>Qualcomm</i> and <i>Rambus</i> 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.</p> <p>Tim Carlson, Texas Instruments - Germantown, MD David J. Healey, Fish & Richardson P.C - Houston, TX</p>
10:15 am	<p>Break</p>
10:30 am 0.50 hr	<p>After eBay: Post-verdict Remedies and ITC Orders</p> <p>The Supreme Court's <i>eBay v. MercExchange</i> 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.</p> <p>Brent K. Bersin, Navigant Consulting, Inc. - Houston, TX Steven R. Borgman, Vinson & Elkins, L.L.P. - Houston, TX</p>
11:00 am 0.50 hr	<p>The Proper Scope of the Experimental Use Doctrine in View of Pfaff</p> <p>After the Supreme Court's decision in <i>Pfaff v. Wells Electronics</i> 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 <i>Pfaff</i>. This presentation will examine the current scope of the experimental use doctrine and the proper scope of the doctrine in view of <i>Pfaff</i>.</p> <p>Darryl J. Adams, Baker Botts L.L.P. - Austin, TX</p>

11:30 am 0.50 hr	<p>The Shocking Truth about Patent Litigation: Data from the IP Litigation Clearinghouse</p> <p>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).</p> <p>Mark A. Lemley, Stanford Law School - Stanford, CA</p>
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Friday Afternoon, Oct. 31, 2008

Presiding Officer:

David W. O'Brien, Zagorin O'Brien & Graham LLP - Austin, TX

	<p>LUNCHEON PRESENTATION</p> <p>Sponsored by Jones Day</p>
12:00 pm	<p>Pick up Lunch</p> <p>Included in conference registration.</p>
12:15 pm 0.75 hr ethics	<p>Top 10 Prosecution Ethics Issues</p> <p>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.</p> <p>David Hricik, Mercer University School of Law - Macon, GA</p>
1:00 pm	<p>Break</p>
1:15 pm 0.50 hr	<p>Strategic Patent Monetization: Brokers and Auctions</p> <p>Historically, the intellectual property market 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.</p> <p>Nicole D'Hondt, Ocean Tomo - Chicago, IL</p>
1:45 pm 0.50 hr	<p>Section 101</p> <p>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.</p> <p>Michael G. Locklar, Jackson Walker L.L.P. - Houston, TX</p>

2:15 pm 0.50 hr ethics	Joint Defense Strategies and Agreements <p>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.</p> <p>Hilda C. Galvan, Jones Day - Dallas, TX</p>
2:45 pm 0.50 hr ethics	Patent Malpractice Claims <p>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.</p> <p>James B. Gambrell, Hunt, TX</p>
3:15 pm 0.50 hr ethics	E-Discovery and Spoliation <p>Key issues and case law updates of interest to all practitioners will be discussed.</p> <p>Barry K. Shelton, Fish & Richardson P.C. - Austin, TX</p>
3:45 pm	Adjourn