

16<sup>TH</sup> ANNUAL  
**ADVANCED PATENT LAW**



October 27–28, 2011  
Four Seasons Hotel ▪ Austin, Texas

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16<sup>TH</sup> ANNUAL  
**ADVANCED PATENT LAW**

October 27–28, 2011 ■ Four Seasons Hotel ■ Austin, Texas

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**THURSDAY MORNING, OCT. 27, 2011**

**Presiding Officer:**

**William L. LaFuze, Vinson & Elkins LLP,  
Houston, TX**

**8:00 a.m. Registration Opens**

Includes continental breakfast.

**8:50 a.m. Welcoming Remarks**

**9:00 a.m. .67 hr**

**Developments in Claim Construction**

Despite marked changes in other areas of IP law driven by the Federal Circuit and the Court, and the onset of the leadership and personnel shift on the Federal Circuit bench, the Copernican centrality of claim construction to preparation, prosecution and litigation remains seemingly unchallengeable. The state of play, whether attempts have been made to move off *Phillips* or simply to focus and refine, are addressed, discussed and queried.

Kenneth R. Adamo, Kirkland & Ellis LLP, Chicago, IL

**9:40 a.m. .83 hr**

**Claims Drafting Strategies and Prosecution Issues: How to Avoid the Unintended Consequences**

Patent prosecution is a practice fraught with pitfalls for the unwary. This session first looks at some examples from a prosecutor's perspective of how examiners purporting to apply the "broadest reasonable interpretation" of the claims sometimes interpret the claims in ways the drafter never intended. Then, from the perspective of a litigator specializing in appeals before the Federal Circuit, the presentation shows how courts may misinterpret an applicant's statements made to the PTO in ways that the applicant surely did not envision.

Erik R. Puknys, Finnegan, Henderson, Farabow,  
Garrett & Dunner, LLP, Palo Alto, CA  
Mark E. Scott, Conley Rose PC, Austin, TX

**10:30 a.m. Break**

**10:45 a.m. .50 hr**

**Cost Savings in Litigation:  
Separating Fact from Fiction**

Bringing e-discovery in-house, outsourcing document review, flat fees and project-based fees are only some of the methods used to try to control escalating litigation budgets. Are the savings promised actually realized at the end of the suit?

Louis A. Riley, McAfee, Inc., Plano, TX

**11:15 a.m. .50 hr**

**Indirect Infringement after *Global-Tech v. SEB***

In *Global-Tech Appliances v. SEB*, the Supreme Court clarified the mental state requirement for inducing patent infringement under 35 U.S.C. § 271(b), holding that "willful blindness" by a defendant is sufficient to show the requisite "knowledge" that the induced acts constitute patent infringement. This presentation examines the "willful blindness" standard announced by the Supreme Court and its implications for patent prosecution and patent litigation.

Douglas W. McClellan, Weil, Gotshal & Manges LLP,  
Houston, TX

**11:45 a.m. .50 hr ethics**

**Litigation Holds and Spoliation in  
Light of *Rambus***

This presentation explores the boundaries of the duty to preserve evidence in anticipation of litigation and discusses the Federal Circuit's guidance concerning when litigation becomes reasonably foreseeable in the *Rambus* opinions.

Carmen E. Bremer, Weil, Gotshal & Manges LLP,  
Dallas, TX

**12:15 pm .50 hr ethics**

**The New Rules for Inequitable Conduct**

The Federal Circuit's *en banc* decision in *Therasense v. Becton Dickinson* changed the rules, but did it change the game? This presentation reviews the *Therasense* decision and its impact on litigation and prosecution.

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

**12:45 p.m. Lunch on Your Own**

**THURSDAY AFTERNOON**

**Presiding Officer:**

**Amber H. Rovner, Weil, Gotshal &  
Manges LLP, Austin, TX**

**2:00 p.m. .50 hr**

**Recent Damages Cases:  
Proofs and Procedural Issues**

A critical look at a number of current topics in remedies law for patent cases.

Kevin James Meek, Baker Botts L.L.P., Austin, TX

**2:30 p.m. .75 hr**

**Damages Strategies**

The panel discusses both the theoretical framework and the practical considerations litigators and experts must consider in the preparation of expert reports and the presentation of testimony in deposition and trial.

**Moderator:**

Kevin James Meek, Baker Botts L.L.P., Austin, TX

**Panelists:**

David J. Healey, Fish & Richardson P.C., Houston, TX  
James J. Nawrocki, IPFC Corp., Houston, TX  
Steven J. Pollinger, McKool Smith, P.C., Austin, TX  
Keith R. Ugone, Analysis Group, Dallas, TX

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

**Ethical and Practical Considerations in  
Multi-Defendant Cases**

A discussion of problems, conflicts and concerns that commonly arise in multi-defendant litigation and approaches to tackling these issues that will protect your client's interests.

Keith B. Davis, Jones Day, Dallas, TX

**3:45 p.m. Break**

**4:00 p.m. .50 hr**

**Contempt Proceedings in Light of *TiVo v. EchoStar*: Where Are We Now?**

In *TiVo*, the Federal Circuit created new guidelines for structuring a contempt proceeding when the adjudged infringer introduces a "new" product. This presentation examines those guidelines, their subsequent application, and the possible impact on your client's future decisions.

Floyd R. Nation, Winston & Strawn LLP, Houston, TX

“ Always a great conference with timely topics and good speakers.  
I always learn something new, even after 15 years.

Great job! Crisp, concise presentations.

The topics and speakers were very strong. This program's strength  
is the high caliber of speakers. ”

**4:30 p.m. 1.00 hr including .50 hr ethics**

### Judicial Panel

Distinguished judges discuss their experiences with and thoughts on managing, hearing and trying patent cases.

**Moderator:**

William L. LaFuze, Vinson & Elkins LLP, Houston, TX

**Panelists:**

Hon. Leonard Davis, U.S. District Court,  
Eastern District of Texas, Tyler, TX  
Hon. Arthur J. Boylan, U.S. District Court,  
District of Minnesota, Minneapolis, MN  
Hon. Jeff Kaplan, U.S. District Court,  
Northern District of Texas, Dallas, TX

**5:30 p.m. Adjourn**

## FRIDAY MORNING, OCT. 28, 2011

**Presiding Officer:**

David L. McCombs, Haynes and Boone, LLP,  
Dallas, TX

**8:00 a.m. Conference Opens**

Includes continental breakfast.

**8:30 a.m. .75 hr**

### Patent Quality and Pendency Initiatives at the USPTO

James Dwyer, U.S. Patent and Trademark Office,  
Alexandria, VA

**9:15 a.m. .75 hr**

### Patentable Subject Matter: Prosecution Strategies against the Backdrop of U.S. Supreme Court, Federal Circuit and BPAI Decisions

An analysis of the most recent Section 101 decisions, highlighting where the courts and Board are currently drawing the line of patent-eligible subject matter.

Mark Thomas Garrett, Fulbright & Jaworski L.L.P.,  
Austin, TX

J. Michael Jakes, Finnegan, Henderson, Farabow,  
Garrett & Dunner, LLP, Washington, DC

**10:00 a.m. Break**

**10:15 a.m. .75 hr**

### Strategic Use of Design Patents

This presentation covers three distinct, but related, topics in design patent law: (1) the overlap between design patents and utility patents, i.e., how design patents can be used to protect functional features of products and how utility patents can be used to protect ornamental features; (2) an update on the aftermath of the Federal Circuit's landmark *Egyptian Goddess* design patent infringement decision; and (3) tips on how to use design patents effectively in a modern design enforcement program.

Perry Saidman, Saidman DesignLaw Group, LLC,  
Silver Spring, MD

**11:00 a.m. .75 hr**

### The Role of Patent Aggregators in the IP Marketplace

Although many views exist on the proper use of patents, the emergence of patent aggregators can no longer be ignored. As the market for patents continues to evolve, so does the role of patent aggregation companies. This session includes a discussion of what role such companies are likely to play in the future patent world, possible effects on innovation, and how operating businesses can protect themselves.

**Moderator:**

Erick Robinson, Red Hat, Inc., Raleigh, NC

**Panelists:**

Matthew D. Powers, Tensegrity Law Group LLP,  
Redwood Shores, CA  
Paul M. Saraceni, RPX Corporation, San Francisco, CA  
Erich Spangenberg, IP Navigation Group, LLC,  
Dallas, TX

**11:45 a.m. .50 hr**

### Capability Claiming

Patent claims to functional constructs, including software are increasingly written to require not actual steps or operational features, but that a system or device be capable of performing those steps or providing those features. Are capability claims valid? What do they cover? Are they a good idea?

Mark A. Lemley, Stanford Law School and  
Durie Tangri LLP, Stanford and San Francisco, CA  
David W. O'Brien, Zagorin O'Brien Graham LLP,  
Austin, TX

**12:15 p.m. Pick Up Box Lunch**

Included in conference registration fee.

## FRIDAY AFTERNOON

**Presiding Officer:**

Robert L. King, Silicon Laboratories,  
Austin, TX

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### LUNCHEON PRESENTATION

**12:30 p.m. .75 hr ethics**

### Prosecution Ethics: Some Growing Concerns

This session examines problems that practitioners have faced in recent reported and filed cases, and examines means by which to reduce exposure and protect the client, the lawyer and the PTO.

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

**1:15 p.m. Break**

**1:30 p.m. .75 hr**

### Joint Infringement

Focus on the entities that perform the steps of a method claim has transformed patent litigation in the computer and networking fields. Two *en banc* Federal Circuit cases seek to reconsider scope and limitations of certain joint/divided infringement doctrines. What are best practices in prosecution and litigation during this period of uncertainty?

Mark A. Lemley, Stanford Law School and  
Durie Tangri LLP, Stanford and San Francisco, CA  
David W. O'Brien, Zagorin O'Brien Graham LLP,  
Austin, TX

**2:15 p.m. .75 hr**

### The Use of Inter Partes Reexamination: Substantive and Procedural Considerations, Comments and Issues

When your client files or receives an inter partes reexamination request, what do you need to know to effectively prosecute the reexamination? This presentation begins with an overview of inter partes reexamination fundamentals including statistics, choosing between an ex parte and inter partes reexamination, and other strategic issues. It then explores more advanced topics including petition practice and appeals to the Board of Patent Appeals and Interferences.

David M. O'Dell, Haynes and Boone, LLP,  
Richardson, TX  
Jason W. Whitney, Jackson Walker L.L.P.,  
San Antonio, TX

**3:00 p.m. Adjourn**

## ABOUT THE COVER



Span 1, 30" x 20", mixed media collage of reclaimed rusty metal, nails, acrylic and ink on board, is by Leah Dunaway. For more information on this piece, visit [www.leahdunway.com](http://www.leahdunway.com). Image acquisition by Sandra Gregor, art consultant, 512-477-2827.

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P.O. Box 7759  
Austin, TX 78713-7759

### Or fax to:

512-475-6876

### Or register online:

www.utcle.org

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### STANDARD REGISTRATION—Includes Printed Course Binder (only) and Friday Luncheon Presentation

☐ Early Registration Fee due by Wednesday, October 19, 2011 .....\$645

☐ Registration Fee after Wednesday, October 19, 2011 .....\$695

### GREEN REGISTRATION—Includes Electronic Materials on USB Key (only) and Friday Luncheon Presentation

☐ Early Registration Fee due by Wednesday, October 19, 2011 .....\$640

☐ Registration Fee after Wednesday, October 19, 2011 .....\$690

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*Allow 3–5 weeks from the conference date for delivery.*

☐ Course Binder WITHOUT Conference Registration .....\$250  
Note: Conference Registration includes Course Binder.

☐ Audio MP3 Speeches on CD .....\$130

☐ Audio CD Set .....\$210

☐ eBinder on CD (PDF format) .....\$250/\$50  
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October 27–28, 2011 ■ Four Seasons Hotel ■ Austin, Texas

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### AUSTIN

October 27–28, 2011

#### CONFERENCE LOCATION



**Four Seasons Hotel**  
98 San Jacinto Blvd.  
Austin, TX 78701  
512-685-8100

**Special Room Rate: \$240**  
good through October 3, 2011  
(subject to availability)

**Parking:**  
Valet parking \$12 per day, \$31.40 overnight;  
Self-parking \$10 per day

#### KEY DATES

**October 19, 2011, 5 p.m.**  
*last day for early registration*  
add \$50 for registrations  
received after this time

**October 21, 2011, 5 p.m.**  
*last day for full refund*

**October 24, 2011, 5 p.m.**  
*last day for partial refund*  
\$50 processing fee applied

**October 27, 2011, 2011, 9 a.m.**  
*Institute begins*

## ADVANCED PATENT LAW INSTITUTES

*Each program uniquely tailored to its locale*

### PATENT LAW IN AUSTIN, TX

October 27–28, 2011, Four Seasons Hotel

Join leading practitioners, academics and in-house counsel from the Southwest and Silicon Valley in Austin for two days of presentations on a rich array of prosecution and litigation topics. The Four Seasons Hotel is on the shores of Lady Bird Lake just steps away from the Hike and Bike Trail, downtown's restaurant and entertainment district, and the vibrant SoCo area.



### PATENT LAW IN SILICON VALLEY

December 8–9, 2011

Four Seasons Hotel Silicon Valley

Come to Palo Alto in the heart of Silicon Valley and join leading judges and practitioners from major corporations such as Google, Yahoo! and Tessera. The Institute is jointly presented with the Berkeley Center for Law and Technology at UC Berkeley and the Stanford Program in Law, Science and Technology.



### PATENT LAW AT THE USPTO

January 19–20, 2012, USPTO — Main Auditorium

The insider's perspective on USPTO initiatives, practice rules, developments and much more. Join USPTO 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 Institute is jointly presented with the U.S. Patent and Trademark Office and George Mason University School of Law.



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 12.50 hours, of which 2.75 credit hours will apply to legal ethics/professional responsibility credit. The University of Texas School of Law is a State Bar of California approved MCLE provider (#1944), and an Oklahoma Bar Association MCLE presumptively-approved provider (#169).