

16th Annual Advanced Patent Law Institute
October 27-28, 2011 • Four Seasons Hotel • Austin, TX

Thursday Morning, Oct. 27, 2011

Presiding Officer:

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

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| 8:00 am | Registration Opens Includes continental breakfast. |
| 8:50 am | Welcoming Remarks |
| 9:00 am 0.67 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 <i>Phillips</i> or simply to focus and refine, are addressed, discussed and queried. Kenneth R. Adamo, Kirkland & Ellis LLP - Chicago, IL |
| 9:40 am 0.83 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 am | Break |
| 10:45 am 0.50 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 |

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| 11:15 am 0.50 hr | <p>Indirect Infringement after <i>Global-Tech v. SEB</i></p> <p>In <i>Global-Tech Appliances v. SEB</i>, the Supreme Court clarified the mental state requirement for inducing patent infringement under 35 U.S.C. Section 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.</p> <p>Douglas W. McClellan, Weil, Gotshal & Manges LLP - Houston, TX</p> |
| 11:45 am 0.50 hr ethics | <p>Litigation Holds and Spoliation in Light of <i>Rambus</i></p> <p>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 <i>Rambus</i> opinions.</p> <p>David M. Hoffman, Fish & Richardson P.C. - Austin, TX</p> |
| 12:15 pm 0.50 hr ethics | <p>The New Rules for Inequitable Conduct</p> <p>The Federal Circuit's <i>en banc</i> decision in <i>Therasense v. Becton Dickinson</i> changed the rules, but did it change the game? This presentation reviews the <i>Therasense</i> decision and its impact on litigation and prosecution.</p> <p>Darryl J. Adams, Baker Botts L.L.P. - Austin, TX</p> |
| 12:45 pm | <p>Lunch on Your Own</p> |

Thursday Afternoon, Oct. 27, 2011

Presiding Officer:

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

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| 2:00 pm 0.50 hr | <p>Recent Damages Cases: Proofs and Procedural Issues</p> <p>A critical look at a number of current topics in remedies law for patent cases.</p> <p>Kevin James Meek, Baker Botts L.L.P. - Austin, TX</p> |
| 2:30 pm 0.75 hr | <p>Damages Strategies</p> <p>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.</p> <p>Moderator: Kevin James Meek, Baker Botts L.L.P. - Austin, TX</p> <p>Panelists: David J. Healey, Fish & Richardson P.C. - Houston, TX</p> <p>Panelists: James J. Nawrocki, IPFC Corp. - Houston, TX</p> <p>Panelists: Steven J. Pollinger, McKool Smith, P.C. - Austin, TX</p> <p>Panelists: Keith R. Ugone, Analysis Group - Dallas, TX</p> |

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| 3:15 pm 0.50 hr ethics | <p>Ethical and Practical Considerations in Multi-Defendant Cases</p> <p>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.</p> <p>Keith B. Davis, Jones Day - Dallas, TX</p> |
| 3:45 pm | Break |
| 4:00 pm 0.50 hr | <p>Contempt Proceedings in Light of <i>TiVo v. EchoStar</i>: Where Are We Now?</p> <p>In <i>TiVo</i>, 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.</p> <p>Floyd R. Nation, Winston & Strawn LLP - Houston, TX</p> |
| 4:30 pm 1.00 hr 0.50 hr ethics | <p>Judicial Panel</p> <p>Distinguished judges discuss their experiences with and thoughts on managing, hearing and trying patent cases.</p> <p>Moderator: William L. LaFuze, Vinson & Elkins LLP - Houston, TX</p> <p>Panelists: Hon. Arthur J. Boylan, U.S. District Court, District of Minnesota - Minneapolis, MN</p> <p>Panelists: Hon. Leonard Davis, U.S. District Court, Eastern District of Texas - Tyler, TX</p> <p>Panelists: Hon. Jeff Kaplan, U.S. District Court, Northern District of Texas - Dallas, TX</p> |
| 5:30 pm | Adjourn |

Friday Morning, Oct. 28, 2011

Presiding Officer:

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

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| 8:00 am | <p>Conference Opens</p> <p>Includes continental breakfast.</p> |
| 8:30 am 0.75 hr | <p>Patent Quality and Pendency Initiatives at the USPTO</p> <p>James Dwyer, U.S. Patent and Trademark Office - Alexandria, VA</p> |
| 9:15 am 0.75 hr | <p>Patentable Subject Matter: Prosecution Strategies against the Backdrop of U.S. Supreme Court, Federal Circuit and BPAI Decisions</p> <p>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.</p> <p>Mark Thomas Garrett, Fulbright & Jaworski L.L.P. - Austin, TX</p> <p>J. Michael Jakes, Finnegan, Henderson, Farabow, Garrett & Dunner, LLP - Washington, DC</p> |

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| 10:00 am | Break |
| 10:15 am 0.75 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 <i>Egyptian Goddess</i> 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 am 0.75 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: Kevin Fiur, Innovestion - Austin, TX Panelists: Matthew D. Powers, Tensegrity Law Group LLP - Redwood City, CA Panelists: Paul M. Saraceni, RPX Corporation - San Francisco, CA Panelists: Erich Spangenberg, IP Navigation Group, LLC - Dallas, TX |
| 11:45 am 0.50 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 - New York, NY David W. O'Brien, Zagorin O'Brien Graham LLP - Austin, TX |
| 12:15 pm | Pick up Box Lunch Included in conference registration fee. |

Friday Afternoon, Oct. 28, 2011

Presiding Officer:

Robert L. King, Silicon Laboratories - Austin, TX

LUNCHEON PRESENTATION

Sponsored by Vinson & Elkins LLP

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| 12:30 pm 0.75 hr ethics | <p>Prosecution Ethics: Some Growing Concerns</p> <p>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.</p> <p>David Hricik, Mercer University School of Law - Macon, GA</p> |
| 1:15 pm | <p>Break</p> |
| 1:30 pm 0.75 hr | <p>Joint Infringement</p> <p>Focus on the entities that perform the steps of a method claim has transformed patent litigation in the computer and networking fields. Two <i>en banc</i> 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?</p> <p>Mark A. Lemley, Stanford Law School - New York, NY David W. O'Brien, Zagorin O'Brien Graham LLP - Austin, TX</p> |
| 2:15 pm 0.75 hr | <p>The Use of Inter Partes Reexamination: Substantive and Procedural Considerations, Comments and Issues</p> <p>When your client files or receives an <i>inter partes</i> reexamination request, what do you need to know to effectively prosecute the reexamination? This presentation begins with an overview of <i>inter partes</i> reexamination fundamentals including statistics, choosing between an <i>ex parte</i> and <i>inter partes</i> reexamination, and other strategic issues. It then explores more advanced topics including petition practice and appeals to the Board of Patent Appeals and Interferences.</p> <p>David M. O'Dell, Haynes and Boone, LLP - Richardson, TX Jason W. Whitney, Jackson Walker L.L.P. - San Antonio, TX</p> |
| 3:00 pm | <p>Adjourn</p> |