

**17<sup>th</sup> Annual Advanced Patent Law Institute**  
**November 1-2, 2012 • Four Seasons Hotel • Austin, TX**

**Thursday Morning, Nov. 1, 2012**

**Presiding Officer:**

**Alan D Albright**, Bracewell & Giuliani LLP - Austin, TX

8:00 am	<b>Registration Opens</b>  Includes continental breakfast.
8:50 am	<b>Welcoming Remarks</b>
9:00 am 0.75 hr	<b>Claims Drafting Strategies</b>  Recommended techniques for drafting claims that satisfy 35 U.S.C. Section 112 disclosure requirements and also make it difficult for others to design around.  Richard A. Killworth, Dinsmore & Shohl, LLP - Dayton, OH
9:45 am 0.75 hr	<b>Developments in Claim Construction</b>  No major movement or re-invention regarding claim construction is apparently in the offing, but Markman and its progeny, claim construction proceedings and appellate review are creating many exceptions, refinements and fine-tunes that increase exposure to error, sanctions and problems in general. This discussion tracks these trends, exposes tricks and traps, and with luck, blazes the trails that lead to good results.  Kenneth R. Adamo, Kirkland & Ellis LLP - Chicago, IL
10:30 am	<b>Break</b>
10:45 am 0.75 hr	<b>The Ides of March: Prosecution Strategies After the First-to-File Transition</b>  The America Invents Act established a "first inventor to file" system in the United States that will be implemented on March 16, 2013. Learn strategies and considerations for patent application filings in this new regime.  Brian W. Oaks, Baker Botts L.L.P. - Austin, TX
11:30 am 0.75 hr	<b>The America Invents Act and Post-Grant Strategies: Tactics 101</b>  Discussion of the new AIA contested proceedings, rules of practice and procedure, concurrent litigation in the district courts and the U.S. International Trade Commission, appeals to the Federal Circuit, and representative timelines, schedules, and budgets.  Robert Greene Sterne, Sterne, Kessler, Goldstein & Fox - Washington, DC
12:15 pm	<b>Lunch on your Own</b>

## Thursday Afternoon, Nov. 1, 2012

### Presiding Officer:

**James J. Nawrocki**, IPFC Corp. - Houston, TX

1:30 pm 0.50 hr ethics	<p><b>From <i>ResQNet.com</i> to <i>MSTG</i> and Beyond: A Look at Limitations on Privilege in Recent Cases</b></p> <p>A look at how recent cases have limited certain privileges and their effect on discovery and settlement of your next case.</p> <p>Floyd R. Nation, Winston &amp; Strawn LLP - Houston, TX</p>
2:00 pm 1.00 hr	<p><b>Patent Remedies Strategies</b></p> <p>The theoretical framework and the practical considerations litigators and experts must consider in the presentation of testimony in deposition and trial and in the preparation of expert reports from the perspective of both the plaintiff and defendant.</p> <p>Moderator: Kevin James Meek, Baker Botts L.L.P. - Austin, TX</p> <p>Panelists: Jane Politz Brandt, Thompson &amp; Knight LLP - Dallas, TX</p> <p>Panelists: Willem G. Schuurman, Vinson &amp; Elkins LLP - Austin, TX</p>
3:00 pm	<p><b>Break</b></p>
3:15 pm 0.75 hr 0.25 hr ethics	<p><b>Multi-District Litigation: Strategic and Tactical Questions</b></p> <p>Prohibition against joinder in the AIA and tough venue opinions from the Federal Circuit mean separate patent suits are filed, often in different jurisdictions. This has resulted in an increase in requests for pretrial consolidation to multi-district litigation (MDL) panels. When, how, why or why not seek MDL treatment?</p> <p>Moderator: David J. Healey, Fish &amp; Richardson P.C. - Houston, TX</p> <p>Panelists: Jeffrey A. Andrews, Sutton McAugahan Deaver PLLC - Houston, TX</p> <p>Panelists: Bryan Farney, Farney Daniels LLP - Georgetown, TX</p>
4:00 pm 0.50 hr	<p><b>Venue Transfer and Severance: The Last Hurrah?</b></p> <p>Has the Federal Circuit put an end to plaintiffs' enforcement strategies, or will plaintiffs merely find other ways to enforce their patents while keeping litigation costs down?</p> <p>Hilda C. Galvan, Jones Day - Dallas, TX</p>

4:30 pm 1.00 hr 0.50 hr ethics	<b>Judicial Panel</b>  Distinguished judges discuss their thoughts and experiences about managing, hearing and trying patent cases.  Moderator: Alan D Albright, Bracewell & Giuliani LLP - Austin, TX Panelists: Hon. Cathy Ann Bencivengo, U.S. District Court, Southern District of California - San Diego, CA Panelists: Hon. J. Rodney Gilstrap, U.S. District Court, Eastern District of Texas - Marshall, TX Panelists: Hon. Sam Sparks, U.S. District Court, Western District of Texas - Austin, TX
5:30 pm	<b>Adjourn</b>

## Friday Morning, Nov. 2, 2012

### Presiding Officer:

**Michael P. Adams**, Winstead PC - Austin, TX

8:00 am	<b>Conference Room Opens</b>  Includes continental breakfast.
8:30 am 0.75 hr	<b>Section 101: Where Things Stand and Tips For Patent Drafters and Litigators About How to Cope</b>  Nothing is hotter or more fluid now than patentable subject matter under Section 101. A review of the year's important cases, both in biopharma and computer software, including <i>Mayo v. Prometheus</i> from Mayo's counsel of 7 years, and a comparison of what the Supreme Court and the Federal Circuit are trying to do. Efforts that patent drafters, litigation plaintiffs and litigation defendants should be taking to deal with this fast-changing area of the law are described.  John A. Dragseth, Fish & Richardson P.C. - Minneapolis, MN Mark Thomas Garrett, Fulbright & Jaworski L.L.P. - Austin, TX
9:15 am 0.75 hr	<b>Top Mistakes to Avoid at Trial and on Appeal to Maximize Success</b>  Litigation and appeals experts expose the major errors and traps that lose cases at trial and on appeal, and how to avoid them.  Donald R. Dunner, Finnegan, Henderson, Farabow, Garrett & Dunner, LLP - Washington, DC Kevin Kudlac, Weil, Gotshal & Manges LLP - Houston, TX
10:00 am	<b>Break</b>
10:15 am 0.50 hr	<b>Functional Claiming</b>  Software patents are often claimed in functional terms, even if they don't use means-plus-function language. This analysis focuses on the perils—and promise—of functional claiming in software.  Mark A. Lemley, Stanford Law School - Stanford, CA

10:45 am 1.00 hr	<p><b>In-House Perspectives on Changes Mandated by the America Invents Act</b></p> <p>The AIA has modified in-house strategies regarding the procurement, licensing and litigating of patents. Experienced in-house counsel share how the changes brought by the AIA are changing the provision of IP services.</p> <p>Moderator: Robert L. King, Silicon Laboratories - Austin, TX</p> <p>Panelists: Mark J. Griffin, Overstock.com, Inc. - Salt Lake City, UT</p> <p>Panelists: John F. Horvath, Google Inc. - Austin, TX</p> <p>Panelists: Jennifer B. Wuamett, Freescale Semiconductor, Inc. - Austin, TX</p>
11:45 pm	<b>Pick up Box Lunch</b>

## Friday Afternoon, Nov. 2, 2012

### Presiding Officer:

**John M. Golden**, The University of Texas School of Law - Austin, TX

	<p><b>LUNCHEON PRESENTATION</b></p> <p>Sponsored by Bracewell &amp; Giuliani LLP</p>
12:00 pm 1.00 hr ethics	<p><b>Adversity in Patent Litigation, Opinions and Prosecution</b></p> <p>It is unethical for a firm to be adverse to a current client of the firm. An examination of what "adversity" means in patent practice, from the easy case of suing a current client to the thorny issues in litigation, opinion work and patent prosecution.</p> <p>David Hricik, Mercer University School of Law - Macon, GA</p>
1:00 pm	<b>Break</b>
1:15 pm 0.50 hr	<p><b>Joint/Divided Infringement: Past, Present and Future</b></p> <p>A look at the evolution of joint (or divided) infringement from <i>BMC Software</i> to <i>Akamai/McKesson</i>.</p> <p>John Russell Emerson, Haynes and Boone, LLP - Dallas, TX</p>
1:45 pm 0.50 hr	<p><b>Licensing-Based Domestic Industry Requirements at the ITC</b></p> <p>How to navigate the legal requirements for proving a license-based domestic industry, with specific examples and pitfalls from the case law, including recent guidance from the Commission in <i>Certain Navigation Devices</i>. The effect these requirements have on choosing the ITC as a forum is addressed.</p> <p>Michael Chibib, Bracewell &amp; Giuliani LLP - Austin, TX</p>

2:15 pm  
0.50 hr

### **Expediting Prosecution via the Patent Prosecution Highway**

An in-depth focus on the Patent Prosecution Highway (PPH) including identifying cases eligible for expedited prosecution under the PPH, the actual impact on prosecution, and advantages and strategic uses of the PPH.

J. Robert Brown Jr., Conley Rose, PC - Plano, TX

2:45 pm

**Adjourn**