18th Annual Advanced Patent Law Institute
October 31 - November 1, 2013 • Four Seasons Hotel • Austin, TX

Thursday Morning, Oct. 31, 2013

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

7:30 am	**Registration Opens** Includes continental breakfast.
8:20 am	**Welcoming Remarks**
8:30 am 0.50 hr	**Patentable Subject Matter: Software and Business Methods** A discussion of the patent-eligibility of software and business methods and a review of *CLS Bank v. Alice* and other recent decisions. Sanders N. Hillis, Brinks Hofer Gilson & Lione - Indianapolis, IN
9:00 am 0.50 hr	**Antitrust and FRAND Patents: Current Issues and Red Flags** Antitrust issues have taken on increasing profile and importance in the last year—the Supreme Court in *FTC v. Actavis* re-calibrated the scope of antitrust immunity for a patent owner while clarifying the standard against which conduct outside of that immunity is evaluated for liability; the Justice Department has prosecuted a high-profile case based in large part on "most favored nations" provisions (a common feature in licenses); antitrust enforcers are investigating the actions of patent assertion entities and patent pools; FRAND has made headlines with a Presidential veto of an ITC exclusion order and with continuing lawsuits between major telecom companies over how to define and apply FRAND obligations; and the EU has also been active in dealing with FRAND commitments, highlighting the globalization of antitrust enforcement. David M. Hoffman, Fish & Richardson P.C. - Austin, TX
9:30 am 0.75 hr	**Valuation of FRAND Patents** Technology firms often agree to license their standard essential patents on fair and reasonable terms. There has been much discussion and disagreement about what fair and reasonable means when licensing standards essential patents. Recent District Court decisions have indicated that interpreting fair and reasonable requires an analysis focused on the value of the standard and the relative value of the patents being licensed to the other patents in the standard. This interpretation may have significant implications for the value of standard essential patents. Moderator: James D. Woods, UHY Advisors, Inc. - Houston, TX Panelists: Douglas A. Cawley, McKool Smith PC - Dallas, TX Christopher V. Ryan, Vinson & Elkins LLP - Austin, TX Jennifer B. Wuamett, Freescale Semiconductor, Inc. - Austin, TX
10:15 am	**Break**

10:30 am 0.50 hr	**Revisiting Remedies at the ITC** From The White House, to Congress, to the Judiciary, and to the ITC itself, recent use of patent enforcement at the ITC has drawn the attention—and reaction—of all branches of government. Those reactions, their motivations, and their potential effects on patent enforcement and remedies at the ITC are surveyed. Alan D. Albright, Sutherland Asbill & Brennan LLP - Austin, TX
11:00 am 0.75 hr 0.25 hr ethics	**How to Maximize Success Before the Federal Circuit** A discussion of critical pre-appeal efforts necessary to preserve issues for appeal and how to craft a winning brief and oral argument accompanied by anecdotes from the presenter from over 160 cases he has argued. Donald R. Dunner, Finnegan, Henderson, Farabow, Garrett & Dunner, LLP - Washington, DC
11:45 am 0.50 hr	**Best Practices in Design Patent Prosecution in View of *In re Owens*, and What Lies Ahead** The landscape for preparing and prosecuting design patent applications has been radically altered by the recent Federal Circuit decision *In re Owens*. Strategies and best practices are discussed along with a look toward the future including implementation of the international design filing system under the Hague Agreement. Perry Saidman, Saidman DesignLaw Group, LLC - Silver Spring, MD
12:15 pm	**Pick Up Lunch** Included in registration.

Thursday Afternoon, Oct. 31, 2013

Presiding Officer:
Shirley Webster, Ocean Tomo, LLC - Houston, TX

	LUNCHEON PRESENTATION Sponsored by Baker Botts
12:35 pm 1.00 hr 0.50 hr ethics	**Judicial Panel** Distinguished judges from the District Court discuss their experiences hearing and trying patent cases, and examine the status and results of the Pilot Program. Moderator: Scott F. Partridge, Baker Botts - Houston, TX Panelists: Hon. Nancy F. Atlas, U.S. District Court, Southern District of Texas - Houston, TX Hon. Barbara M. G. Lynn, U.S. District Court, Northern District of Texas - Dallas, TX Hon. Lee Yeakel, U.S. District Court, Western District of Texas - Austin, TX
1:35 pm	**Break**

1:45 pm 0.50 hr	**Damages and Remedies: Overview of Current Cases and Methodologies** A look at important damages and remedy issues, including the market value rule and its application, damages and remedy issues when standard essential patents are at issue, and recent injunction case law. Michael J. Newton, Alston & Bird LLP - Dallas, TX
2:15 pm 0.75 hr	**Damages and Remedies: Panel Discussion** Moderator: Michael J. Newton, Alston & Bird LLP - Dallas, TX Panelists: Brett C. Govett, Norton Rose Fulbright - Dallas, TX James J. Nawrocki, IPFC Corp. - Houston, TX
3:00 pm 1.00 hr	**Concurrent Litigation Strategies After AIA** Review of the impact of the AIA on patent litigation and the new opportunities and challenges emerging for both plaintiffs and defendants—how the case law is developing in the wake of recent legislative changes and the practical ways in which courts are addressing those changes; the latest tactical developments in venue selection and multi-defendant litigation; changes in the requirements for inducement; the use of parallel PTAB proceedings to contest validity; the interplay between proceedings in the courts and PTAB; and overall case management considerations. Hear perspectives on what the future holds (as best anyone can tell), including whether new defenses or new legislation will further alter the patent litigation landscape. Moderator: Mark E. Patrick, Texas Instruments Incorporated - Dallas, TX Panelists: Bryan Farney, Farney Daniels PC - Georgetown, TX Hilda C. Galvan, Jones Day - Dallas, TX David L. McCombs, Haynes and Boone, LLP - Dallas, TX Donald R. McKenna, Taiwan Semiconductor Manufacturing Company - Hsinchu, Taiwan
4:00 pm	**Break**
4:15 pm 0.50 hr	**Post-Grant Proceedings, Strategies, and Practice: One Year After AIA** The new inter partes review (IPR) and covered business method (CBM) post-grant proceedings became operational on September 16, 2012, and the new post-grant review (PGR) became operational on March 16, 2013. More than one post-grant proceeding has been filed every calendar day since IPR and CBM became available and the rate of filings continues to rise. Many proceedings are progressing through trial at the new Patent Trial & Appeal Board as they move towards final written decision. Major decisions, developments and trends have occurred in these proceedings that provide a road map of how this new patent world is taking shape. Robert Greene Sterne, Sterne Kessler Goldstein & Fox, PLLC - Washington, DC

4:45 pm 0.75 hr	**Filing Strategies for In-House Counsel** In-house counsel discuss application filing strategies, including what, when and where to file. Learn how factors such as budget, subject matter, potential encumbrances, ease of prosecution, and strength of patent offices and legal systems inform and influence both domestic and foreign filing decisions. Moderator: John F. Horvath, Austin, TX Panelists: Michael C. Barrett, Cirrus Logic - Austin, TX Robert L. King, Silicon Laboratories - Austin, TX Travis M. Wohlers, Luminex Corporation - Austin, TX
5:30 pm	**Adjourn**

Friday Morning, Nov. 1, 2013

Presiding Officer:
Michael P. Adams, Jackson Walker L.L.P. - Austin, TX

8:00 am	**Conference Room Opens** Includes Continental Breakfast
8:30 am 0.50 hr ethics	**USPTO Ethic Rules vs. Texas Rules of Conduct** Effective May 2, 2013, the USPTO adopted new professional conduct rules. Compare and contrast the new USPTO rules with the Texas Disciplinary Rules of Professional Conduct. Jane Politz Brandt, Thompson & Knight LLP - Dallas, TX
9:00 am 0.75 hr	**Developments in Claim Construction** Claim construction maintains its Copernican centrality to patent prosecution and litigation, displaying all the usual conundrums, inconsistencies and (seemingly) intractable contradictions which are its historic hallmarks. Added to this are two new factors—the presence of the PTAB and its claim construction practices (displayed principally through inter partes reviews), and the Federal Circuit's long-expected attempt to "rethink" deference in light of *Markman*, as announced by *Lighting Ballast*, when claim constructions are reviewed on appeal. These events are reviewed and puzzled over, through attention to new/old/uncertain precedent and procedures for claim construction. Kenneth R. Adamo, Kirkland & Ellis LLP - Chicago, IL
9:45 am 0.50 hr	**Claim Construction after *Lighting Ballast*** *Lighting Ballast* has been taken up *en banc* by the Federal Circuit to address the Court's power to review patent claim construction appeals on a *de novo* basis. This presentation examines the highlights of the briefing and oral arguments and the potential impact of the decision. Jennifer Claire Kuhn, Law Office of Jennifer Kuhn - Austin, TX
10:15 am	**Break**

10:30 am 0.50 hr	**Synchronizing Specification and Claims for Strong (Valid) Patents** The inventor creates the invention. Who creates the claims? The inventor? The patent practitioner? Implicit in Federal Circuit decisions is that the Court is more confident that the inventor created the described embodiments/examples than the claims. If the claims reach too far beyond the disclosed embodiments/examples, the claims are often construed more narrowly than the ordinary meaning of the claims would suggest, or the claims are held invalid for lack of written description support. This presentation provides an in-depth look at what needs to be done with patent specifications so that broad claims are interpreted broadly and found to be valid. Dale S. Lazar, DLA Piper - Reston, VA
11:00 am 0.75 hr	**Patentable Subject Matter: Life Sciences** Review and analysis of recent cases regarding patentable subject matter under 35 U.S.C. 101 such as *Prometheus v. Mayo* and *The Association for Molecular Pathology v. Myriad Genetics*, and their impact on USPTO practice and the biotechnology industry including the realm of personalized medicine. Moderator: Ana Christina Ward, Asuragen, Inc. - Austin, TX Panelists: Mary K. Ferguson, Finnegan, Henderson, Farabow, Garrett & Dunner, LLP - Boston, MA Gina N. Shishima, Norton Rose Fulbright - Austin, TX
11:45 am	**Pick Up Lunch** Included in registration.

Friday Afternoon, Nov. 1, 2013

Presiding Officer:
John M. Golden, The University of Texas School of Law - Austin, TX

	LUNCHEON PRESENTATION Sponsored by Kenyon & Kenyon LLP
12:05 pm 1.00 hr ethics	**Ethics in Doing Deals and Settling IP Suits** Using video cartoons to examine ethical issues in negotiation, this presentation addresses issues of client identity, the line between "puffing" and "material misrepresentations," the duty of disclosure and interaction between the rule against ex parte contacts, the client's right to talk directly to the other side, and the lawyer's obligation not to induce the client to engage in acts the lawyer is barred from doing. David Hricik, Mercer University School of Law - Macon, GA
1:05 pm	**Break**

1:15 pm 1.00 hr	**Economics of NPEs** Non-Practicing Entities (NPEs) and their supporters believe that NPEs provide a valued market to move, enable and monetize otherwise stagnant patent assets for the benefit of patent assignees. Many corporations believe that NPEs needlessly tax the resources and cash flows of corporate America for little or no gain, whereby NPEs should not be allowed to engage in their business model. This panel explores and debates the differing views and economic effects of the NPE business from all perspectives. Moderator: Keith E. Witek, Advanced Micro Devices, Inc. - Austin, TX Panelists: Paul Reidy, RPX Corporation - San Francisco, CA Neal A. Rubin, Cisco Systems, Inc. - San Jose, CA Ranjeev Singh, Intellectual Ventures - Austin, TX
2:15 pm 0.50 hr	**Update on Patent Exhaustion** A discussion of the Supreme Court's decisions in *Bowman v. Monsanto* and *Kirtsaeng v. John Wiley & Sons* regarding patent exhaustion and the first-sale doctrine. Amber L. Hagy, Weil, Gotshal & Manges LLP - Austin, TX
2:45 pm 0.50 hr	**The Mental Gymnastics of Divided Infringement after *Akamai* and *McKesson*** Divided infringement is now quite different than direct infringement. Learn about the new law and how it has been applied. Phillip B. Philbin, Haynes and Boone, LLP - Dallas, TX
3:15 pm 0.50 hr ethics	**Inequitable Conduct After *Therasense*** A survey of how the courts have applied the new inequitable conduct standards of *Therasense* (including *1st Media*), and whether the new standards have impacted the number of inequitable conduct allegations and the disclosure of references to the Patent Office. Darryl J. Adams, Baker Botts - Austin, TX
3:45 pm	**Adjourn**