

2003 Advanced Patent Law Institute
October 29*, 30-31, 2003 • Four Seasons Hotel • Austin, TX

Wednesday Morning, Oct. 29, 2003

9:00 am 1.00 hr	Optional Wednesday Evening Session, October 29
9:00 am 1.00 hr	Optional Thursday Luncheon with Robert Barr

Wednesday Evening, Oct. 29, 2003

6:00 pm 2.25 hrs	<p>From Beijing to Bangalore: Design, Production, Co-Production and Enforcement Issues</p> <p>This two hour special session will address the issues and pitfalls faced in moving design and production of IP to China and India including: optimal corporate structures for foreign entities that create and own intellectual property; employment and operational issues in host companies; where and how to economically obtain appropriate international protection for the IP; and, when the time comes, how to enforce it.</p> <p>Kevin Sean Kudlac, Weil Gotshal & Manges - Austin, TX Matthew H. Laight, Bird & Bird - Hong Kong, China Louis A. Riley, Legerity - Austin, TX</p>
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Thursday Morning, Oct. 30, 2003

9:00 am 0.50 hr	<p>Continuing Evolution of the Doctrines of Patent Exhaustion and Implied License</p> <p>A discussion of the current state of the law on patent exhaustion and implied license, with a look at how we got here and predictions of where we'll go from here.</p> <p>Amber Hatfield Rovner, McKool Smith, P.C. - Austin, TX</p>
9:30 am 0.75 hr	<p>Bioengineered Evolution of Written Description</p> <p>The presentation will address the recent evolution of the written description requirement in the courts and under the PTO guidelines. Recent relevant cases addressing the issue will also be discussed.</p> <p>Tracey B. Davies, The Terrace 7 - Austin, TX Lekha Gopalakrishnan, Morgan, Lewis & Bockius LLP - Dallas, TX</p>

10:30 am 0.50 hr	<p>Prefiling Considerations in Patent Infringement Litigation, Including Ethical Issues</p> <p>Issues that should be considered prior to and in connection with the filing of a patent infringement suit, including litigation objectives, financial considerations, ethical considerations, consideration of risks, prefiling investigations, gathering evidence, opinions of counsel, and preparation and filing of the complaint.</p> <p>William L. LaFuze, Houston, TX</p>
11:00 am 0.75 hr	<p>Strategic Prosecution Tactics</p> <p>Prosecution tactics that are designed to control claim construction and avoid prosecution history estoppel.</p> <p>Richard A. Killworth, Killworth Gottman Hagan & Schaeff LLP - Dayton, OH</p>
11:45 am 0.50 hr	<p>Continuing Application Strategy</p> <p>Use of continuing and/or reissue applications to transform an otherwise hit-or-miss portfolio into an asset with strategic coverage. Discussion identifies opportunities and pitfalls. Re-examination, too.</p> <p>David W. O'Brien, Zagorin O'Brien & Graham - Austin, TX</p>

Thursday Afternoon, Oct. 30, 2003

12:15 pm 0.50 hr	<p>Luncheon Presentation</p> <p>Is the Current Patent System Good or Bad for Technology Companies?</p> <p>Robert A. Barr, Cisco Systems, Inc. - San Jose, CA</p>
1:30 pm 0.50 hr	<p>The Doctrine of Equivalents in the Aftermath of FESTO: The Rise of the All Elements Rule</p> <p>A review of the impact of the Supreme Court's reversal of the Federal Circuit's Festo decision and discussion of how the Federal Circuit nevertheless continues to rein in and restrict the doctrine of equivalents through application of the all elements rule.</p> <p>John R. Keville, Howrey LLP - Houston, TX</p>
2:00 pm 0.50 hr	<p>Claims Construction</p> <p>A review of the continuing Federal Circuit odyssey through the seas of intrinsic, extrinsic, and other evidence, the dominance of dictionaries and "plain meaning," and the methodology of claims construction.</p> <p>Kenneth R. Adamo, Jones Day - Dallas, TX</p>
2:30 pm 0.50 hr	<p>Scope of Privilege Waivers</p> <p>Obtaining an opinion of counsel on validity and infringement is a Catch-22. What exactly must you do, when must you do it, and what do you give up when you get such a letter. The answers may surprise you.</p> <p>Mark A. Lemley, Stanford Law School - Stanford, CA</p>

3:00 pm 0.50 hr	<p>Strategies and Issues Concerning Pre-Litigation Patentee/Infringer Communications — Demand Letters, Responses, and Opinion Letters</p> <p>Issues affecting and strategies for drafting pre-litigation communications. Addresses business purposes, admissions against interest, willful infringement, §287, declaratory judgment, laches, estoppel, patent misuse, and defamation.</p> <p>Thomas Harold Adolph, Jackson Walker L.L.P. - Houston, TX</p>
3:45 pm 0.75 hr	<p>Discovery Issues in Patent Cases</p> <p>Patent litigation presents unique and challenging discovery issues. Infringement, validity, unenforceability and damages are all impacted by the conduct of discovery, and the choice of venue may have a dramatic influence on the discovery available.</p> <p>Douglas A. Cawley, McKool Smith PC - Dallas, TX Kimberly A. Moore, George Mason University - Arlington, VA</p>
4:30 pm 1.00 hr	<p>Judges Panel</p> <p>A distinguished panel of federal judges will discuss their experiences and give their views on such matters as <i>Markman</i> hearings, the use of special masters of technical advisors, the use of special rules for patent cases, issues regarding the use of experts and <i>Daubert</i> challenges, the use of juries in patent cases, the good and bad traits of patent trial lawyers, and other matters of interest to the patent bar.</p> <p>Andrew W. Austin, United States Magistrate Judge - Austin, TX Hon. Jeff Kaplan, US Magistrate Judge-N Dist - Dallas, TX Gale Roy Peterson, Cox Smith Matthews Inc - San Antonio, TX Robert Wayne Turner, Jones Day - Dallas, TX Hon. John Shepard Wiley Jr., Superior Court of California, County of - Los Angeles, CA</p>

Friday Morning, Oct. 31, 2003

8:00 am 0.50 hr	<p>Inventorship and Prior Art</p> <p>The fallout from the Oddzon holding by the Federal Circuit has Congress trying to determine the reach of Section 102(f) prior art and put new emphasis on determining the correct inventorship.</p> <p>James B. Gambrell, C/O Roddy Tree Ranch - Hunt, TX</p>
8:30 am 0.50 hr	<p>Inequitable Conduct</p> <p>An analysis of recent Federal Circuit cases about activities asserted to be inequitable conduct, and whether the rate of success in using the defense is changing.</p> <p>Albert B. Kimball Jr., Bracewell & Giuliani, - Houston, TX</p>
9:00 am 0.50 hr	<p>Issues to Consider When Writing Settlements of Patent Cases</p> <p>A discussion of antitrust and res judicata considerations in the settlement of patent litigation.</p> <p>Hilda Contreras Galvan, Jones Day - Dallas, TX</p>

9:30 am 0.50 hr	<p>Managing Outside Counsel, Including Fee Arrangements</p> <p>How one hi-tech company has established guidelines for working with outside counsel covering staffing, communications, budgeting and billing...what works and what doesn't work.</p> <p>Robert A. Barr, Cisco Systems, Inc. - San Jose, CA</p>
10:30 am 0.50 hr	<p>Malpractice Checklist</p> <p>Means to reduce malpractice exposure and ethical disputes from the start to the finish of the attorney-client relationship, including the need for attorneys to assign any rights they have to their clients, the need for clarification of client identity in prosecution, and other issues.</p> <p>David C. Hricik, Walter F. George School Of Law - Macon, GA</p>
10:45 am 0.75 hr	<p>Evolving Techniques in IP Portfolio Strategies: What Works?</p> <p>The panel will explore long term strategic approaches to defensive and offensive IP management with emphasis on what strategies work in light of a constantly changing IP landscape.</p> <p>Walter Bratic, InteCap, Inc. - Houston, TX David L. McCombs, Haynes & Boone - Dallas, TX Nainesh Shah, Stmicroelectronics - Carrollton, TX Keith Edward Witek, Advanced Micro Devices - Austin, TX</p>
11:30 am 0.50 hr	<p>Patent Damages</p> <p>An overview of patent damages and recent cases.</p> <p>Robert M. Chiaviello Jr., Fulbright & Jaworski - Dallas, TX</p>

Friday Afternoon, Oct. 31, 2003

1:15 pm 0.50 hr	<p>Indirect Infringement</p> <p>A discussion of contributory infringement, inducement and liability for the importation of foreign goods made by a process patented in the U.S.</p> <p>Wes Musselman, Fish & Richardson P.C. - Dallas, TX</p>
1:45 pm 0.50 hr	<p>Licensing Do's and Don'ts</p> <p>Selected topics to address in license agreements including most favored nations and secrecy provisions.</p>
2:15 pm 0.75 hr	<p>Current Antitrust Issues In Patent Enforcement</p> <p>Update on antitrust issues in patent enforcement in private litigation and government investigations and actions.</p> <p>David J. Healey, Weil, Gotshal & Manges LLP - Houston, TX Shirley Webster, InteCap - Houston, TX</p>