

27th Annual Advanced Patent Law Institute
October 20-21, 2022 • Sheraton Austin Hotel at the Capitol • Austin, TX
October 20-21, 2022 • Live Webcast

Thursday Morning, Oct. 20, 2022

Presiding Officer:

Bert A. Greene, Duane Morris LLP - Austin, TX

8:00 am In Austin Only	<p>Registration Opens</p> <p>Includes continental breakfast.</p>
8:45 am	<p>Welcoming Remarks</p>
8:55 am 0.75 hr	<p>Recent Developments in Claim Construction</p> <p>The baseline of patent application preparation/prosecution, district court trials, Federal Circuit appeals, and AIA post-grant review proceedings, is claim construction. Review the important 2021-2022 claim construction cases and issues at the Federal Circuit and trial court levels, as well as at the PTAB. Examine the PTAB's procedural and substantive claim construction "rules, practices, and etc." And discuss adherence to the APA by the PTAB under various circumstances, plus discussion of discretionary PTAB IPR institution and interface with claim construction in parallel district court proceedings.</p> <p>Kenneth R. Adamo, Law Office of KRAdamo - Chicago, IL</p>
9:45 am 1.00 hr	<p>Section 101 Update</p> <p><i>Alice</i> is growing up. Examine recent patent subject matter developments, including recent cases of interest. The panel also dives into the data and considers what trends may be discerned and what tips and tricks might be useful for patent prosecutors and litigators.</p> <p>Steve Borgman, Kilpatrick Townsend & Stockton LLP - Houston, TX Michael W. Piper, Conley Rose, PC - Plano, TX Gina N. Shishima, Norton Rose Fulbright - Austin, TX Janice Le Ta, Perkins Coie LLP - Austin, TX</p>
10:45 am	<p>15-Minute Break</p>
11:00 am 1.00 hr	<p>Year in Review</p> <p>A whirlwind tour of the year in patent law at the Federal Circuit.</p> <p>Mark A. Lemley, Stanford Law School - Stanford, CA</p>
12:00 pm 0.50 hr	<p>Current Issues Around FRAND and SEPs</p> <p>Four years ago, the DOJ announced the "New Madison" approach to intellectual property and antitrust disputes, arguing that SEPs holders should be entitled to injunctive relief like any other patent holder. Since then, some of those policies have been rolled back, but has the "New Madison" approach marched on, and what difference has it made, especially in Texas courts?</p> <p>Brian Pandya, Duane Morris LLP - Washington, DC</p>

12:30 pm
In Austin Only

Pick Up Lunch (in Austin)

Included in registration.

Thursday Afternoon, Oct. 20, 2022

Presiding Officer:

Kat Li, Kirkland & Ellis LLP - Austin, TX

LUNCHEON PRESENTATION

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HAYNES BOONE

12:50 pm
0.50 hr

View from the USPTO

Hear about the current priorities, programs, and initiatives underway at the Office.

Mysa W. Lubke, VMware - Austin, TX
Hope C. Shimabuku, Regional Director, U.S. Patent and Trademark Office, Texas Regional Office - Dallas, TX

1:20 pm

10-Minute Break

1:30 pm
1.00 hr

Advanced Patent Drafting: Strategies and Tactics

Software patent eligibility continues to be uncertain, and USPTO data highlights the importance of preparing software patent applications for the 101 gauntlet during prosecution. In this session, learn about general drafting guidelines and preferences that may help further the likelihood of an application crossing the 101 finish line, and various procedural strategies to assist clients with efficient and cost-effective prosecution.


Jonathan Harder, Dickinson Wright - Austin, TX
Matthew G. Osterhaus, Fletcher Yoder, P.C. - Houston, TX
Erick S. Robinson, Spencer Fane LLP - Houston, TX

2:30 pm
0.50 hr

To Opt-Out or Not to Opt-Out of the UPC in Europe?

The new European Unified Patent Court is going to start in early 2023. It is high time for patentees to decide which patents to opt-out. The speakers discuss the pros and cons of the UPC and other considerations to take into account for the decision.

Jonathan Ball, Norton Rose Fulbright LLP - London, United Kingdom
Clemens Rübél, Norton Rose Fulbright - Munich, Germany

<p>3:00 pm 0.50 hr</p>	<p>Foreign Service and Foreign Discovery</p> <p>Examine the laws and rules that govern the processes of obtaining foreign service and foreign discovery for intellectual property litigation. Through this exploration of foreign service and foreign discovery in areas such as China, Japan, Taiwan, and Korea, the speakers illustrate practical considerations for those involved in intellectual property litigation involving foreign parties.</p> <p>Jordan Garsson, Dickinson Wright PLLC - Austin, TX Kevin Kudlac, Radulescu LLP - Austin, TX</p>
<p>3:30 pm</p>	<p>15-Minute Break</p>
<p>3:45 pm 0.75 hr</p>	<p>The Ins and Outs of Patent Damages</p> <p>An update on patent damages, including current hot-button issues that may (or may not) trigger limitations to damages testimony.</p> <p>Moderator: Jeanne M. Heffernan, Kirkland & Ellis LLP - Austin, TX</p> <p>Panelists: Leah Bhimani Buratti, Wittliff Cutter - Austin, TX Aaron Gabriel Fountain, Morrison & Foerster LLP - Austin, TX Shirley Webster, Ocean Tomo, LLC - Houston, TX</p>
<p>4:30 pm 1.00 hr 0.50 hr ethics</p>	<p>Judicial Panel</p> <p>Hear distinguished judges from the District Courts discuss their experiences hearing and trying patent cases.</p> <p>Moderator: Sheila Kadura, The University of Texas System - Austin, TX</p> <p>Panelists: Hon. Colm F. Connolly, U.S. District Court, District of Delaware - Wilmington, DE Hon. Derek T. Gilliland, U.S. District Court, Western District of Texas - Waco, TX Hon. Dustin M. Howell, U.S. District Court, Western District of Texas - Austin, TX</p>
<p>5:30 pm</p>	<p>Adjourn</p>
<p>In Austin Only</p>	<p>Networking Reception (in Austin from 5:30 p.m. - 6:30 p.m.)</p> <p>Join us for drinks and hors d'oeuvres with program faculty and attendees.</p> <p>Thank You to Our Sponsor</p> 

Friday Morning, Oct. 21, 2022

Presiding Officer:

David W. O'Brien, Haynes Boone, LLP - Austin, TX

7:00 am In Austin Only	<p>Conference Room Opens</p> <p>Includes continental breakfast.</p>
BREAKFAST PRESENTATION	
<p>Thank You to Our Sponsor</p> <p>KIRKLAND & ELLIS</p>	
8:00 am 1.00 hr 0.50 hr ethics	<p>Breakfast Panel Hosted by Women in IP - Addressing Diversity in IP: Impacts on Attorney Retention, Inventorship, and More</p> <p>This session spotlights in-house counsel discussing actions their companies have taken to increase the diversity of innovators and promote inclusivity in technology law.</p> <p>Moderator: Michele Connors, Cirrus Logic, Inc. - Austin, TX</p> <p>Panelists: Danielle Coleman, VMware - Palo Alto, CA Sharmini Green, Intel Corporation - Austin, TX Lauren B. Hoffer, Dell Technologies - Round Rock, TX Christine Abuel Pompa, YETI - Austin, TX</p>
9:00 am	15-Minute Break
9:15 am 1.00 hr	<p>Practice and Issues before the PTAB</p> <p>This panel explores the evolution of PTAB practice over the past decade from APJ and practitioner viewpoints, focusing on discretionary practices, recent and expected policy changes, and the potential impact of the new administration. Additionally, it discusses best practices, common pitfalls, and recent trends.</p> <p>Moderator: Teresa Stanek Rea, Crowell & Moring, LLP - Washington, DC</p> <p>Panelists: W. Todd Baker, Kirkland & Ellis LLP - Washington, DC Hon. Amber L. Hagy, U.S. Patent and Trademark Office, Patent Trial and Appeal Board - Austin, TX Hon. Miriam L. Quinn, U.S. Patent and Trademark Office, Patent Trial and Appeal Board - Dallas, TX</p>
10:15 am 0.75 hr	<p>From PTAB to the Federal Circuit</p> <p>Strategies in the PTAB to best position your case for success on appeal.</p> <p>Debbie McComas, Haynes Boone, LLP - Dallas, TX Angela M. Oliver, Haynes Boone, LLP - Washington, DC</p>
11:00 am	15-Minute Break

<p>11:15 am 0.50 hr</p>	<p>Navigating IPR Estoppel at Trial</p> <p>In <i>California Institute of Technology v. Broadcom</i>, the Federal Circuit held that estoppel under 35 U.S.C. § 315(e)(2) applies to any ground that was brought or could have been brought in an IPR. But the law is still unclear on whether estoppel applies to product prior art under 35 USC § 102(a) or 102(b) that is described by one or more patents and printed publications. This presentation explores the current state of the law and provides tips for navigating estoppel with respect to product prior art during litigation.</p> <p>Paula Diane Heyman, McDermott Will & Emery - Austin, TX</p>
<p>11:45 am 0.50 hr ethics</p>	<p>Update on Privilege and Work Product Law in Patent Cases</p> <p>This presentation analyzes the application of attorney-client privilege and attorney work product in patent cases, further exploring the intersection between business advice and legal advice.</p> <p>David Tobin, Baker Botts - Dallas, TX</p>
<p>12:15 pm In Austin Only</p>	<p>Pick Up Lunch (in Austin)</p> <p>Included in registration.</p>

Friday Afternoon, Oct. 21, 2022

Presiding Officer:

Michael C. Barrett, Cirrus Logic, Inc. - Austin, TX

LUNCHEON PRESENTATION

	<p>Thank You to Our Sponsor</p> <p>MORRISON FOERSTER</p>
<p>12:35 pm 0.75 hr ethics</p>	<p>USPTO Disciplinary Decisions: Do this, Don't do that!</p> <p>A discussion of recent disciplinary decisions from the Office of Enrollment and Discipline at the USPTO, followed by observations designed to help practitioners avoid client grievances.</p> <p>Jennifer Librach Nall, DLA Piper LLP - Austin, TX Emily Pyclik, Baker Botts LLP - Austin, TX</p>
<p>1:20 pm</p>	<p>10-Minute Break</p>
<p>1:30 pm 0.75 hr</p>	<p>Patent License Issues from the In-House Perspective</p> <p>Key considerations in several common patent transaction models. The RPX patent aggregation and licensing model. Patent issues in IP agreements include indemnity clauses, limits of liability, IP ownership issues, and forum selection clauses.</p> <p>Umesh M. Desai, AT&T Labs - Austin, TX John D. Flynn, IBM Corporation - Austin, TX Paul Reidy, RPX Corporation - Austin, TX</p>

2:15 pm
0.75 hr
0.25 hr ethics

Litigation Funding for Patent Cases

Litigation funding has become common in commercial litigation throughout the U.S. and in Texas, including in patent cases. These speakers discuss how funding helps businesses and clients manage risk while bringing meritorious claims to trial, as well as trends, discovery issues, and ethical issues relating to funding.

Michelle Eber, Validity Finance - Houston, TX
Natalie Alfaro Gonzales, Baker Botts - Houston, TX

3:00 pm
0.75 hr ethics

Ethics in IP Practice

This session describes recent cases involving conflicts of interest in IP practice, how to comply with Rule 11 without violating the prohibition against ex parte contacts with represented persons, and using engagement letters to reduce risk and uncertainty over several issues.

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

3:45 pm

Adjourn