

28th Annual Advanced Patent Law Institute
November 2-3, 2023 • AT&T Conference Center • Austin, TX
November 2-3, 2023 • Live Webcast

Thursday Morning, Nov. 2, 2023

Presiding Officer:

John D. Flynn, IBM Corporation - Austin, TX

7:30 am In Austin Only	Registration Opens Includes continental breakfast.
8:15 am	Welcoming Remarks
8:25 am 0.75 hr	Recent Developments in Claim Construction 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 2022-2023 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." Discuss adherence to the APA by the PTAB under various circumstances. And, discuss the claim construction interface between an IPR and a parallel district court proceeding. Kenneth R. Adamo, Law Office of KRadamo - Chicago, IL
9:15 am 0.50 hr	SEP Licensing and Litigation Update Erick S. Robinson, Spencer Fane LLP - Houston, TX
9:45 am	15-Minute Break
10:00 am 0.50 hr	Patent Reexamination Ex parte reexamination filings sharply declined with the advent of the AIA, but in recent years have begun to rise again as reexamination has emerged as an important component of patent litigation and PTAB proceedings. This presentation discusses the role of and the strategic considerations surrounding ex parte reexaminations in the current landscape of patent litigation and PTAB proceedings. Michael Pohl, Norton Rose Fulbright - Austin, TX
10:30 am 0.50 hr ethics	Does Intelligence Equal Competence? Navigating Artificial Intelligence in the Practice of Law Artificial Intelligence may be embedded in tools, or may even be a tool itself, that helps lawyers better meet client needs. But, it is no different than other conventional tools and technologies used by lawyers—they must be used in conjunction with a lawyer's duty to provide competent representation. Daniel H. Shulman, Vedder Price P.C. - Chicago, IL


11:00 am 0.50 hr 0.25 hr ethics	IP Considerations for Generative AI My company is at the edge of technology: we use generative AI for software development to invent a new product. Should and can we file a patent application naming the generative AI as an inventor, and what patenting strategy should we adopt? What are the IP implications of using open source software (OSS) to train the generative AI or if the generative AI itself is an OSS model? Patrick Njeim, Kilpatrick Townsend & Stockton - Seattle, WA
11:30 am In Austin Only	Pick Up Lunch (in Austin)

Thursday Afternoon, Nov. 2, 2023

Presiding Officer:

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

LUNCHEON PRESENTATION

	Thank You to Our Luncheon Sponsor 
11:50 am 0.75 hr	Functional Claiming Functional claiming is the focus of the Supreme Court's recent <i>Amgen</i> decision, but it is also central to many disputes in the software industry. When are functional claims allowed, and when should you use them? Mark A. Lemley, Stanford Law School - Stanford, CA
12:35 pm	15-Minute Break
12:50 pm 0.75 hr	Hot Topics in Appeals The panel explores the hot issues most likely to draw the attention of the Federal Circuit and how best to position your case either to seize on the opportunity to make new law or avoid being the key case cited for a new principle for the next few years. Moderator: Debbie McComas, Haynes Boone, LLP - Dallas, TX Panelists: Peter J. Ayers, U.S. Patent and Trademark Office - Austin, TX Jessica Hannah, DLA Piper - San Francisco, CA

1:35 pm 0.50 hr	<p>License on Transfer: Lessons Learned from The Founder and Implications for AI</p> <p>The license on transfer network (lotnet.com) reduces the patent assertion entity problem for 3,200 plus member companies covering approximately four million patent assets by leveraging a royalty-free networked patent license. The founder of the lot network shares lessons learned over the past decade, implications for the future, and opportunities for similar collaborative efforts in AI.</p> <p>Eric Schulman, Fish & Richardson P.C. - Redwood City, CA</p>
2:05 pm	15-Minute Break
2:20 pm 0.75 hr	<p>Challenges Presented by Litigation Funding</p> <p>District courts and parties continue to grapple with issues relating to litigation funding and the funders themselves. This panel discusses some of the more prominent challenges including disclosure requirements (e.g., Delaware), how to get a funded litigant to settle, and patent aggregation by funded entities.</p> <p>Moderator: Kevin Kudlac, Radulescu LLP - Austin, TX</p> <p>Panelist: Michelle Eber, West U Capital - Houston, TX</p>
3:05 pm 1.00 hr 0.50 hr ethics	<p>Judicial Panel</p> <p>Hear distinguished Western District of Texas judges discuss their experiences hearing and trying patent cases.</p> <p>Moderator: Kat Li, Kirkland & Ellis LLP - Austin, TX</p> <p>Panelists: Hon. Alan D Albright, U.S. District Court, Western District of Texas - Waco, TX Hon. Alia Moses, U.S. District Court, Western District of Texas - Del Rio, TX Hon. Robert Pitman, U.S. District Court, Western District of Texas - Austin, TX</p>
4:05 pm	Adjourn
In Austin Only	<p>Thank You to Our Networking Reception Sponsor</p> <p>HAYNES BOONE</p>
In Austin Only	<p>Networking Reception (in Austin from 4:05 p.m. to 5:05 p.m.)</p> <p>Join us for drinks and hors d'oeuvres with program faculty and attendees.</p>

Friday Morning, Nov. 3, 2023

Presiding Officer:

José C. Villarreal, Baker Botts - Austin, TX

7:30 am In Austin Only	Conference Room Opens Includes continental breakfast.
8:30 am 0.75 hr	Judge's View of Patent Litigation An exclusive fireside chat with Judge Yeakel, expertly guided by 30-year patent trial veteran Michael Pegues. Gain rare insights into the world of patent litigation. Michael D. Pegues, Polsinelli PC - Dallas, TX Hon. Lee Yeakel, King & Spalding - Austin, TX
9:15 am 1.00 hr	Implications of the EU Unified Patents and the EU Unified Patent Court The EPO Unitary Patents and the EU Unified Patent Court went live on June 1, 2023, and have caused fundamental changes in strategy and tactics regarding utility patent protection, enforcement, and freedom to operate in continental Europe. This panel of leading experts discuss the implications in a robust, hands-on, immediately useful round table discussion. Moderator: Robert Greene Sterne, Sterne, Kessler, Goldstein & Fox P.L.L.C. - Washington, DC Panelists: Florian Meyer, Meissner Bolte mbB - Munich, Germany Philipp Rastemborski, Eisenführ Speiser - Munich, Germany Caren Yusem Sterne, AddyHart P.C. - Chicago, IL Dr. James Zhu, JunHe LLP - Shanghai, China
10:15 am	15-Minute Break
10:30 am 0.50 hr	Venue Transfer and Mandamus at the Federal Circuit This presentation takes a look at recent issues in venue transfer through the lens of mandamus practice at the Federal Circuit. Seth W. Lloyd, Morrison Foerster - Washington, DC
11:00 am 0.50 hr	Recent Developments and Trends in 101 <i>Alice</i> turns 10 next year. This presentation takes a look at recent cases and trends involving Section 101 and its application in the courts and at the U.S. Patent and Trademark Office. Tips and lessons learned will be covered. Andrew Saul, Kilpatrick Townsend & Stockton LLP - Atlanta, GA
11:30 am In Austin Only	Pick Up Lunch (in Austin) Included in registration.

Friday Afternoon, Nov. 3, 2023

Presiding Officer:

Michael P. Adams, Dykema - Austin, TX

LUNCHEON PRESENTATION

11:50 am 0.75 hr	<p>Inventing Tomorrow: A Guide to Claiming and Patenting AI Creations</p> <p>This presentation covers various topics on patents in AI including: why we should pursue patents in AI (open source vs. IP rights), how we can claim an AI invention (target, detectability, eligibility), and additional thoughts on the future landscape of AI patents.</p> <p>Charlene Liu, Haynes Boone, LLP - San Francisco, CA Hong Shi, Haynes Boone, LLP - Austin, TX</p>
12:35 pm	<p>15-Minute Break</p>
12:50 pm 0.75 hr	<p>Uncertain Times: When Does IPR Estoppel Apply?</p> <p>While the Supreme Court passed on an opportunity to define the scope of IPR estoppel, the Federal Circuit clarified the burden of proof for establishing estoppel and adopted the “skilled searcher” standard in <i>Ironburg v. Valve</i>. Districts courts, however, remain split on whether IPR estoppel applies to product prior art under 35 USC §§ 102(a) or 102(b) that is described by patents and/or printed publications. This presentation explores how district courts are applying the “skilled searcher” standard, and the continued split in district courts as to whether product prior art falls within the scope of IPR estoppel.</p> <p>Paula Diane Heyman, McDermott Will & Emery - Austin, TX</p>
1:35 pm 0.50 hr	<p>Strategic Advantages and Disadvantages of Post Grant Review</p> <p>In the first 9 months after a patent issues, an inter partes review is not available but a post grant review is available and can be raised on any issue, not just 102-103 on prior printed publications and this presents unique opportunities and problems. It permits 101 grounds, and also 112 grounds, as well as prior art that are not printed publications. The estoppel provision for PGR matches its breadth, which means that if you file a PGR you lose any defenses not raised in the PTAB, and could be forced to trial only on infringement and if available, inequitable conduct and other equitable defenses.</p> <p>Danielle Joy Healey, Spencer Fane - Houston, TX</p>
2:05 pm	<p>15-Minute Break</p>
2:20 pm 1.00 hr ethics	<p>Recurring Ethical Issues in Patent Practice</p> <p>This session addresses recent cases involving improper contacts with represented persons, conflicts of interest, and ethical issues in patent prosecution.</p> <p>David Hricik, Mercer Law School - Macon, GA</p>
3:20 pm	<p>Adjourn</p>