

10TH ANNUAL
ADVANCED PATENT LAW
INSTITUTE



December 10–11, 2009
Four Seasons Hotel Silicon Valley ▪ East Palo Alto, California

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10TH ANNUAL
ADVANCED PATENT LAW INSTITUTE

December 10–11, 2009 ▪ Four Seasons Hotel Silicon Valley ▪ East Palo Alto, California

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THURSDAY MORNING, DEC. 10, 2009

Presiding Officer:

Robert Barr, Berkeley Center for Law & Technology, Berkeley, CA

8:00 a.m. Registration Opens

Includes continental breakfast.

8:35 a.m. Welcoming Remarks

8:45 a.m. 1.00 hr

Patentable Subject Matter and Practice Strategies in the Shadow of *Bilski*

In re Bilski, now on appeal to the Supreme Court, has already sent shock waves throughout the patent community and may change our fundamental notions of patentable subject matter. The panelists discuss the immediate impact of the Federal Circuit decision on litigation, the PTO response to the decision in its post-decision practice and draft guidelines, post-*Bilski* appeal board decisions, and offer both prosecution and litigation strategies in view of this important case.

Moderator:

Robert D. Fram, Covington & Burling LLP, San Francisco, CA

Panelists:

Henry N. Garrana, Haynes and Boone, LLP, Austin, TX

Jonathan E. Singer, Fish & Richardson P.C., Minneapolis, MN

Lee Van Pelt, Van Pelt, Yi & James LLP, Cupertino, CA

9:45 a.m. .75 hr

Strategic Patent Prosecution

Building a patent portfolio that meets the needs of any business requires focused consideration of the underlying R&D, product markets, eco-systems, and geography. It also requires intimate knowledge of local laws and costs. Two experienced practitioners provide both in-house and outside counsel perspectives across a broad range of industries.

Jean Burke Fordis, Finnegan, Henderson, Farabow, Garrett & Dunner, LLP, Palo Alto, CA

David M. Simon, Intel Corporation, Santa Clara, CA

10:30 a.m. Break

10:45 a.m. .50 hr

What is Obvious in the post-KSR World?

The KSR decision may have posed some difficult questions. When does the previously disfavored "obvious to try" standard come into play? How can you establish that a result is not predictable? What was wrong with the comfortable, but rigid, teaching-suggestion-motivation test? By considering approaches revealed in decisions in the wake of KSR, this discussion provides strategies for navigating through an obviousness analysis.

M. Paul Barker, Finnegan, Henderson, Farabow, Garrett & Dunner, LLP, Palo Alto, CA

11:15 a.m. .75 hr

TransCore, LP v. Electronic Transaction Consultants Corp.

Implications for patent exhaustion, implied license and related strategy for patent transactions.

Dana W. Hayter, Intel Corporation, Santa Clara, CA

William I. Schwartz, Morrison & Foerster LLP, San Francisco, CA

THURSDAY AFTERNOON

Presiding Officer:

Christopher J. Byrne, Tessera, Inc., San Jose, CA

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Dewey & LeBoeuf LLP

12:00 p.m. Pick up Lunch

Included in conference registration.

LUNCHEON PRESENTATION

12:15 p.m. .75 hr

Update from the USPTO

The new Director of the U.S. Patent and Trademark Office discusses the state of the USPTO and his goals for the agency.

David Kappos, Director, U.S. Patent and Trademark Office, Alexandria, VA (Invited)

1:00 p.m. Break

1:15 p.m. .75 hr

Venue Transfers and Strategic Forum Selection

Forum selection and venue transfer continue to be key aspects of patent litigation strategy. This panel provides an overview of the law applicable to transfer motions and discusses trends of district courts deciding transfer motions in popular venues. Moving beyond these core issues, the panel discusses additional forum selection and venue considerations, including how district courts in various venues are resolving motions to dismiss in light of *Ashcroft v. Iqbal* and similar case law, motions to sever defendants in multi-party patent litigation, and motions to stay or adjust case schedules in light of reexamination requests to the USPTO or requests to the Judicial Panel on Multidistrict Litigation.

Yar R. Chaikovsky, Sonnenschein Nath & Rosenthal LLP, Palo Alto, CA

Eric R. Lamison, Kirkland & Ellis LLP, San Francisco, CA

2:00 p.m. .75 hr

Managing Cost and Strategies in Multi-Party Cases: Pretrial and During Trial

Patent cases involving numerous defendants are increasingly filed. In many cases, the alleged infringement of each defendant is substantially different. In others, both manufacturers and their customers are named. In yet a third category, several cases are filed with overlapping patents and issues. Each one of these cases can become more expensive due to the need to coordinate between parties. This presentation discusses strategies to reduce cost and ensure that cases with multiple parties stay on track and that the parties are prepared for trial.

Daralyn J. Durie, Durie Tangri Page Lemley Roberts & Kent LLP, San Francisco, CA

Fabio Marino, Orrick, Herrington & Sutcliffe LLP, Menlo Park, CA

"Excellent breadth and depth of subject matter covered."

"The topics were pertinent to the times and of great interest to IP practitioners."

"The conference was excellent"

2:45 p.m. .50 hr

Foreign Complainants, NPEs, FRAND and the ITC: What Are the Limits on the ITC's Jurisdiction?

The U.S. International Trade Commission is empowered to investigate patent infringement claims in order to protect "domestic industries" from unfair competition from imported goods. Its sole available remedies are injunctive exclusion and cease and desist orders. Yet the ITC has long accepted cases filed by foreign patent holders with minimal domestic operations. Recently, a growing number of non-practicing entities (NPEs) are filing in the ITC—relying on their licensing and litigation efforts, as are holders of patents subject to an obligation to license under Fair, Reasonable and Non-Discriminatory (FRAND) terms. This session discusses the "domestic industry" requirement and whether it imposes real limitations on the ITC's jurisdiction.

Sean P. DeBruine, Alston + Bird LLP, Palo Alto, CA

3:15 p.m. Break

3:30 p.m. .50 hr

SSO Developments

Recent decisions in *FTC v. Rambus*, *FTC v. N-Data*, and *Broadcom v. Qualcomm*, as well as policy statements by antitrust enforcers, have brought SSOs back into the antitrust spotlight. This presentation analyzes the impact of those developments on licensors (e.g., how to ensure that your patents do not become inadvertently encumbered through participation in an SSO) and licensees (e.g., how to protect yourself against a patent ambush or a refusal by a licensor to honor RAND commitments).

Hanno F. Kaiser, Latham & Watkins LLP, San Francisco, CA

4:00 p.m. .75 hr

Injunction, Post-Judgment Royalties and Apportionment

When can a patentee get an injunction? What do they get if they don't get an injunction? And how should damages be calculated in multi-component industries? These issues and others are discussed.

Mark A. Lemley, Stanford Law School and Durie Tangri Page Lemley Roberts & Kent LLP, Stanford, CA

Taraneh Maghame, Tessera, Inc., San Jose, CA

4:45 p.m. .75 hr including .25 hr ethics

Judicial Panel

Leading district court judges discuss effective litigation procedures and practices.

Moderator:
Vernon M. Winters, Weil, Gotshal & Manges LLP, Redwood Shores, CA

Panelists:
Hon. Andrew J. Guilford, U.S. District Court, Central District of California, Santa Ana, CA

Hon. Marilyn Hall Patel, U.S. District Court, Northern District of California, San Francisco, CA

5:30 p.m. Adjourn

FRIDAY MORNING, DEC. 11, 2009

Presiding Officer:
Colleen Chien, Santa Clara University, Santa Clara, CA

8:00 a.m. Conference Room Opens

Includes continental breakfast.

8:30 a.m. .50 hr

Joint Infringement and Section 271(f)

A method claim is directly infringed if each step of the claimed method is performed by an alleged infringer. But what if different steps of the method are performed by different parties? This session examines joint infringement and its implications for both transactional attorneys and litigators. How to structure agreements, describe relationships, or apportion or outsource the provision of services may all have an impact on potential joint infringement liability. Likewise, determination of who does what and why may drive the outcome of litigation, and present strategic challenges and opportunities for the Plaintiff and the Defense.

Glenn E. Westreich, Winston & Strawn LLP, San Francisco, CA

9:00 a.m. .50 hr

Enablement, Written Description, and Indefiniteness—Oh, My!

Over the last several years, Section 112 issues—previously relegated to biotech and chemical practices—have firmly ensconced themselves across the breadth of technologies in patent law. This session provides an update on recent case law, and attempts to answer the eternal Section 112 question: what is the difference between written description and enablement?

Karen Boyd, Turner Boyd LLP, Palo Alto, CA

9:30 a.m. .50 hr ethics

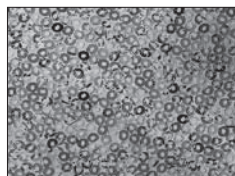
Inequitable Conduct

A review of current issues relating to the inequitable conduct defense, as framed by recent Federal Circuit decisions, and a discussion of best practices to avoid charges of patent unenforceability.

Robert J. Goldman, Ropes & Gray, LLP, Palo Alto, CA

10:00 a.m. Break

ABOUT THE COVER



Extremity of Personal Absence III, 23" x 28", mixed media collage of law books and product packaging is by Philip Durst. For more information visit www.philipdurst.com or call 512-474-6200.

10:15 a.m. 1.00 hr

Knowing When to Hold and When to Fold: Choosing and Settling Your Disputes Wisely

Best practices and pointers in choosing whether and how to raise patent disputes, how to evaluate your case, and when and how to settle. This session balances perspectives of in-house counsel, law firms, and the court.

Moderator:
Gary H. Loeb, Genentech, Inc., San Francisco, CA

Panelists:
Barbara A. Caulfield, Dewey & LeBoeuf LLP, East Palo Alto, CA
Douglas A. Cawley, McKool Smith PC, Dallas, TX
Andy Culbert, Microsoft, Redmond, WA

11:15 a.m. .75 hr including .50 hr ethics

Strategic Use of Opinions of Counsel for Defending against Willful Infringement and Indirect Infringement

A discussion of the value of opinions of counsel, particularly in response to charges of willful infringement and inducing infringement, and a case law update including the aftermath of *In re Seagate* and *Broadcom v. Qualcomm*. Effect of not producing an opinion and scope of waiver for use of opinions used for defense against willfulness and indirect infringement is also examined.

Moderator:
Tim Crean, SAP AG, Palo Alto, CA

Panelists:
Heidi Keefe, Cooley Godward Kronish LLP, Palo Alto, CA
Michael Schallop, Van Pelt, Yi & James LLP, Cupertino, CA

FRIDAY AFTERNOON

Presiding Officer:
Elizabeth Dean, Navigant Consulting, Inc., San Francisco, CA

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Inflexion Point Strategy, LLC

12:00 p.m. Pick Up Lunch
Included in conference registration.

LUNCHEON PRESENTATION

12:15 p.m. .50 hr

The Importance of Amicus Briefs to Successful Appellate Advocacy

Amicus briefs are a vital tool in the workshop of the appellate advocate. Learn more about how they can be used effectively to shape the law generally and win your appeal specifically.

Edward R. Reines, Weil, Gotshal & Manges LLP, Redwood Shores, CA

12:45 p.m. Break

1:00 p.m. .67 hr

Cost Management for IP Litigation: Strategies for Dealing with "Frivolous" Law Suits

With rising litigation costs, tightening budgets and upward trends in IP litigation, companies and their legal departments are under increasing pressure to find creative ways to achieve good results in complex IP litigation at a reasonable cost. The challenges are even greater with lower risk litigation where costs can still be high and harder to justify. Counsel with both in-house and outside experience discuss creative solutions including leveraging internal litigation attorneys and paralegals, as well as strategies for partnering with outside counsel, managing budgets and case schedules, containing discovery, capturing efficiencies across cases, addressing lack of merit early and often, choosing mediators and mediating, and a variety of other issues.

- Catherine Lacavera, Google, Inc., Mountain View, CA
- Michael J. Malecek, Dewey & LeBoeuf LLP, East Palo Alto, CA

1:40 p.m. .67 hr

Patent Markets and IP Valuations: Where Are We Now and What's Ahead?

An overview of the current patent monetization market and predictions for the future; a discussion of how the patent valuation challenge, and particularly the difficulties in pricing IP risk, affect deal completion and market stability; and a look at some innovative models for using patents to finance corporate M&A and R&D.

- Ronald S. Laurie, Inflexion Point Strategy, LLC, Palo Alto, CA
- Vincent Pluvinage, Intellectual Ventures, Palo Alto, CA
- Joseph K. Siino, Ovidian Group, LLP, Berkeley, CA

2:20 p.m. .67 hr

IP Diligence during Patent Acquisitions and Corporate Mergers and Acquisitions

A practical look at portfolio assessment, pre-existing licenses, freedom to operate, litigation risk, the treatment of opinion letters and preserving common interest privilege.

- William S. Galliani, Cooley Godward Kronish LLP, Palo Alto, CA
- Mallun Yen, Cisco Systems, Inc., San Jose, CA

3:00 p.m. .75 hr ethics

Managing Patent E-Discovery Risks, Costs, and Burdens: An In-House Perspective

An examination of strategies and techniques to efficiently address the growing costs and risks associated with patent litigation discovery with a particular emphasis on Federal Rules of Civil Procedure objective of a "just, speedy and inexpensive determination of every action."

- Stephanie Mendelsohn, Genentech, Inc., San Francisco, CA
- Mark E. Michels, Cisco Systems, Inc., San Jose, CA

3:45 p.m. Adjourn

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(\$250 purchased alone, \$50 with registration or purchase of Course Binder or Audio CD Set)

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EAST PALO ALTO

December 10–11, 2009

CONFERENCE LOCATION



Four Seasons Hotel Silicon Valley
2050 University Avenue
East Palo Alto, CA 94303
(650) 566-1200

Special Room Rate: \$255
good through November 9, 2009
(subject to availability)

Parking: Self-parking \$12/day
Valet \$22/day
(subject to change)

KEY DATES

December 2, 2009, 5 p.m.
last day for early registration
add \$50 for registrations
received after this time

December 4, 2009, 5 p.m.
last day for full refund

December 7, 2009, 5 p.m.
last day for partial refund
\$50 processing fee applied

December 10, 2009, 8:45 a.m.
Institute begins

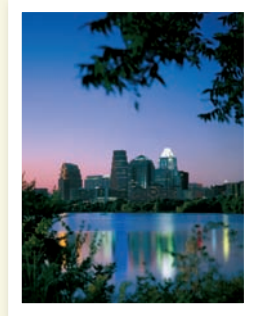
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October 29–30, 2009, Four Seasons Hotel

Join leading practitioners, academics and in-house counsel from the Southwest and Silicon Valley in Austin, TX for two days of presentations on a rich array of prosecution and litigation topics. Cool weather, great city, music and food—at the Four Seasons Hotel.

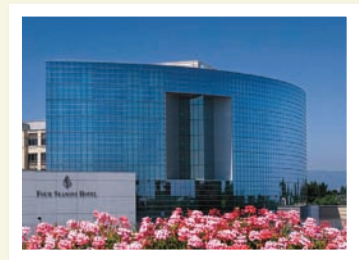


PATENT LAW IN PALO ALTO, CA

December 10–11, 2009

Four Seasons Hotel Silicon Valley

Come to the heart of Silicon Valley, and join leading judges and practitioners from major corporations such as Google, Microsoft, Intel and Genentech. This conference is jointly sponsored with the Berkeley Center for Law and Technology at UC Berkeley and the Stanford Program in Law, Science and Technology.



PATENT LAW IN ALEXANDRIA, VA

January 21–22, 2010, USPTO — Main Auditorium

This conference provides the insider's perspective on USPTO initiatives, practice rules, developments, and much more. Join USPTO staff, leading practitioners, academics and members of the federal judiciary from a variety of courts and forums in the Washington, DC area, for two days at the USPTO. The conference is jointly sponsored with the George Mason University School of Law.

