



Institute for
**LAW AND
TECHNOLOGY**

53rd Annual Conference on Intellectual Property Law



53rd Annual Conference on Intellectual Property Law

November 16 - 17, 2015

The Center for American
and International Law
Plano, Texas

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AND INTERNATIONAL LAW**

Highlights

- Annual patent, trademark and copyright law updates
- Deep dive track on hot issues in patent litigation
- Overcoming challenges in drafting and prosecuting patent applications on software inventions
- A half day on conducting PTAB trials
- Alice and the patent eligibility morass
- Recent developments in patent portfolio licensing models
- The new Texas Uniform Trade Secrets Act
- Introduction to the Texas Regional PTO Office
- And more!

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53rd Annual Conference on Intellectual Property Law

PROGRAM AT A GLANCE

November 16-17

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GROUP**

Monday, November 16

7:15 NETWORKING BREAKFAST PRESENTED BY THE WOMEN IN IP TASK FORCE - STATE BAR OF TEXAS

8:45 WELCOME

THE IP YEAR IN REVIEW AND PATENT LAW RETROSPECTIVE

9:00 PATENT YEAR IN REVIEW

9:45 COPYRIGHT YEAR IN REVIEW

10:15 TRADEMARK YEAR IN REVIEW

10:45 BREAK

11:00 PATENT LAW RETROSPECTIVE

12:15 PICK UP BOXED LUNCH

12:30 ETHICS AT THE USPTO

1:30 BREAK

PTAB PROCEEDINGS

1:45 STATE OF THE BOARD

2:15 PATENT OWNER SURVIVAL IN THE WAKE OF THE PTAB: HOW TO AVOID THE DARWIN AWARDS

3:00 BREAK

3:15 HOT ISSUES IN PTAB TRIALS SESSION 1: PTAB PROCEDURAL DEVELOPMENTS AND IMPACT OF ONGOING REFORM

4:00 HOT ISSUES IN PTAB TRIALS SESSION 2: COORDINATION WITH DISTRICT COURT LITIGATION

5:00 ADJOURN

5:15 RECEPTION

Tuesday, November 17

7:45 BREAKFAST ROUNDTABLES: PET PEEVES THAT LITIGATORS HAVE WITH PROSECUTORS AND VICE VERSA

PATENT PROSECUTION AND PATENT LITIGATION

PATENT PROSECUTION		PATENT LITIGATION	
9:00	PANEL ON SOFTWARE PROSECUTION ISSUES	9:00	RAND, FRAND, SEP, SSO, IEEE, - MAKING SENSE OUT OF ALPHABET SOUP
10:30	BREAK	9:45	RECENT ETHICS/MALPRACTICE DEVELOPMENTS FOR ATTORNEYS HANDLING PATENT LITIGATION
10:45	PANEL ON INDEFINITENESS	10:15	BREAK
11:45	TAKING ADVANTAGE OF OUR LOCAL BRANCH OF THE PTO	10:30	THE FEDERAL CIRCUIT AND THE ITC - WHO'S CALLING THE SHOTS?
		11:00	FLYING HIGH OR CRASH AND BURN? GETTING PATENT DAMAGES RIGHT

12:00 LUNCH

12:30 ETHICS ROUNDTABLE

1:30 BREAK

TECH TRANSFER & MISCELLANEOUS

1:45 PATENT PORTFOLIO LICENSING MODELS

2:15 THE NEW TEXAS UNIFORM TRADE SECRETS ACT

2:45 BOILERPLATE BLUNDERS

3:15 BREAK

3:30 THE PATENT ELIGIBILITY MORASS: HOW DID WE GET HERE, HOW BAD IS IT, AND CAN WE FIX IT?

5:00 ADJOURN

7:15 NETWORKING BREAKFAST PRESENTED BY THE WOMEN IN IP TASK FORCE – STATE BAR OF TEXAS INCLUDING PRESENTATION (7:45 – 8:45 AM)

MODERATOR:

– **Cathryn Berryman**, Winstead PC, Dallas, Texas

PANELISTS:

– **The Hon. Stacey G. White**, USPTO, Dallas, Texas

– **The Hon. Miriam L. Quinn**, USPTO, Dallas, Texas

8:45 WELCOME

THE IP YEAR IN REVIEW AND PATENT LAW RETROSPECTIVE

9:00 PATENT YEAR IN REVIEW

– **Gale R. (“Pete”) Peterson**, Law Offices of Gale R. Peterson, San Antonio, Texas

9:45 COPYRIGHT YEAR IN REVIEW

– **Kevin Tottis**, TottisLaw, Chicago, Illinois

10:15 TRADEMARK YEAR IN REVIEW

– **Dyan House**, Carter Scholer Arnett Hamada & Mockler, Dallas, Texas

10:45 BREAK

11:00 PATENT LAW RETROSPECTIVE

The pace of change in patent law has been dizzying over the last decade. An experienced panel of practitioners and judges will address the changes and how the patent litigation landscape has changed.

MODERATOR:

– **Theodore Stevenson, III**, McKool Smith, Dallas, Texas

12:15 PICK UP BOXED LUNCH

12:30 ETHICS AT THE USPTO

– **Professor David Hricik**, Mercer University School of Law, Macon, Georgia

1:30 BREAK

PTAB PROCEEDINGS

Module Chair: **J. Andrew Lowes**, Haynes and Boone LLP

1:45 STATE OF THE BOARD

– **The Hon. Michael P. Tierney**, U.S. Patent and Trademark Office, Alexandria, Virginia

2:15 PATENT OWNER SURVIVAL IN THE WAKE OF THE PTAB: HOW TO AVOID THE DARWIN AWARDS

The Darwin Awards commemorate those who improve our gene pool by removing themselves from it. Patent owners are facing similar self-selection challenges in crafting their patents to avoid extinction under PTAB scrutiny. How should you prepare and prosecute patents to withstand critical review by the Patent Trial and Appeal Board (PTAB)?

– **Tom L. Irving**, Finnegan, Henderson, Farabow, Garrett & Dunner, LLP, Washington, D.C.

PTAB PROCEEDINGS, CONT.

3:00 BREAK

3:15 HOT ISSUES IN PTAB TRIALS

SESSION 1: PTAB PROCEDURAL DEVELOPMENTS AND IMPACT OF ONGOING REFORM

Presenters will provide a run down on procedural aspects of PTAB practice, directed to recent developments and their influence on overall case strategy.

Topics include:

- Drop in Institution Rate – Market Factors and Board Approach to Petition Defects
- Serial Petitions and the Application of Section 325 discretion/estoppel
- New rules and proposed reform legislation

MODERATOR:

— **J. Andrew Lowes**, Haynes and Boone LLP, Richardson, Texas

PANELISTS:

— **Douglas A. Robinson**, Harness, Dickey & Pierce, PLC, Saint Louis, Missouri

— **Dan Smith**, Fish & Richardson LLP, Dallas, Texas

— **Gita Srivastava**, Norton Rose Fulbright LLP, Dallas, Texas

4:00 HOT ISSUES IN PTAB TRIALS

SESSION 2: COORDINATION WITH DISTRICT COURT LITIGATION

The panel will discuss PTAB trials and their experiences from real cases on what works most effectively, mistakes to avoid, and the interplay with district court litigation.

Topics include:

- IPR Timing with Litigation
- Use of Institution Decision at the District Court
- Claim Construction Considerations
- Federal Circuit Appeal – Scope; Likelihood; Then What?

MODERATOR:

— **J. Andrew Lowes**, Haynes and Boone LLP, Richardson, Texas

PANELISTS:

— **Chris Dunstan**, Ericsson Inc., Plano, Texas

— **Sharon Israel**, Mayer Brown LLP, Houston, Texas

— **Donald Puckett**, Skiermont Puckett LLP, Dallas, Texas

— **The Hon. Michael P. Tierney**, U.S. Patent and Trademark Office, Alexandria, Virginia

5:00 ADJOURN

5:15 RECEPTION

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7:45 BREAKFAST ROUNDTABLES: HELP ME HELP YOU

Join your peers in moderated discussions between patent prosecutors and litigators as they exchange their pet peeves about the other and explore ways for improving licensing and enforcement of patents during the entire life cycle of a patent.

MODERATOR:

— **Adam C. Davenport**, Dallas, Texas

PANELISTS:

— **Matthew C. Acosta**, Harness, Jackson Walker L.L.P., Dallas, Texas

— **Austin Champion**, Griffith Bates Champion & Harper LLP, Dallas, Texas

— **Tara Clothier**, Essilor of America, Inc., Dallas, Texas

— **Juanita Deloach, Ph.D.**, Dentons US LLP, Dallas, Texas

— **Michael Henry, Ph.D.**, Henry Patent Law Firm PLLC, Dallas, Texas

— **Kandace D. Walter**, Wilson Legal Group, PC, Dallas, Texas

— **Andrew J. Wright**, Bruster PLLC, Southlake, Texas

— **Mimi Yu**, Jones Day, Dallas, Texas

CONCURRENT SESSIONS

PATENT PROSECUTION Module Chair: Michael W. Piper

9:00 SOFTWARE PROSECUTION: DEALING WITH THE HARD REALITIES OF A SOFTWARE PRACTICE

Developing disclosures and draft software cases to be prepared for the future, managing patent office prosecution for software cases already filed, and answering the challenges of functional claiming.

— **Christa Brown-Sanford**, Baker Botts L.L.P., Dallas, Texas

— **David Carstens**, Carstens & Cahoon, Dallas, Texas

— **Sarah Knight**, Talem IP Law, Gainesville, Florida

— **Jay Lytle**, Sughrue Mion PLLC, Washington, D.C.

10:30 BREAK

10:45 INDEFINITENESS IN PATENT CLAIMS – DEFINITELY AN ISSUE

In view of the Supreme Court’s decision in *Nautilus* and the USPTO’s increasing scrutiny, patent attorneys need to focus on drafting specifications and claims to withstand the future challenges.

— **Ira Matsil**, Slater & Matsil, Dallas, Texas

— **Brian McCormack**, Baker & McKenzie, Dallas, Texas

PATENT LITIGATION Module Chair: Bruce Sostek

9:00 RAND, FRAND, SEP, SSO, IEEE, - MAKING SENSE OUT OF ALPHABET SOUP

A Panel Discussion on the importance of FRAND/RAND Commitments and their significance for patent litigation

— **Allen S. Lineberry**, Siemens PLM Software, Plano, Texas

— **John P. Veschi**, CEO, Marquis Technologies, Plano, Texas

9:45 RECENT ETHICS/MALPRACTICE DEVELOPMENTS FOR ATTORNEYS HANDLING PATENT LITIGATION (ETHICS 9:45 - 10:00)

— **Susan Fortney**, Texas A&M University School of Law, Fort Worth, Texas

— **Saurabh Vishnubhakat**, Texas A&M University School of Law, Fort Worth, Texas

10:15 BREAK

10:30 THE FEDERAL CIRCUIT AND THE ITC – WHO’S CALLING THE SHOTS?

Suprema, Align Technologies, Lelo, and Other Recent Developments.

— **James L. Quarles, III**, WilmerHale, Washington, D.C.

PATENT PROSECUTION, CONT.

11:45 HOW DO I TAKE ADVANTAGE OF HAVING THE PTO IN MY OWN BACKYARD FOR THE BENEFIT OF MY COMMUNITY, MY CLIENTS, AND MY PRACTICE?

- What opportunities will it create?
- Searching with PTO Tools
- Interviewing for Efficiency
- Oral Argument for Appeal

PATENT LITIGATION, CONT.

11:00 FLYING HIGH OR CRASH AND BURN?— GETTING PATENT DAMAGES RIGHT

Panel Discussion on Recovering Patent Damages in the current environment.

- **Christopher C. Barry, CPA/MBA, CFF**, Partner, PricewaterhouseCoopers LLP, Boston, Massachusetts
- **Andrew W. Carter**, Founding Partner, Managing Director and Chief Operating Officer, Ocean Tomo, Chicago, Illinois
- **Roy Weinstein**, Managing Director, Micronomics Los Angeles, California

12:00 LUNCH

12:30 ETHICS ROUNDTABLES - A NUTS AND BOLTS DISCUSSION ON COMMON ETHICAL PROBLEMS ENCOUNTERED BY IP LAWYERS

Roundtable discussions organized by **Colin Cahoon**, Carstens & Cahoon, Dallas, Texas and **Paul Storm**, Gardere Wynne Sewell LLP, Dallas, Texas

1:30 BREAK

TECH TRANSFER & MISCELLANEOUS Module Chair: Mike Pegues, Polsinelli PC, Dallas, Texas

1:45 PATENT PORTFOLIO LICENSING MODELS — CIRCLING THE WAGONS WHILE INTERNALLY RUNNING A LICENSING PROGRAM

Circling the wagons while internally running a Licensing Program (Discussion of LOT, RPX, et al. and traditional licensing.)

- **Alfi Guindi**, IPValue, Santa Clara, California
- **Nainesh Shah**, STMicroelectronics, Coppel, Texas

2:15 THE NEW TEXAS UNIFORM TRADE SECRETS ACT

Texas adopted its version of the UTSA in 2012. Learn what the Act has changed the way businesses litigate trade secret theft claims. Learn too about how business are using the Act to control the hiring of technology employees (i.e., Is the inevitable disclosure doctrine alive and kickin' in Texas?) Finally, investigate whether the Act makes it easier/harder to obtain TROs (and the ethics challenges that arise in the TRO context).

- **Stephen Fox**, Polsinelli PC, Dallas, Texas

2:45 BOILERPLATE BLUNDERS

Boilerplate provisions are often cut and pasted from one license agreement to another with little thought about the impact of their use. This talk will assist counsel in identifying and avoiding the pitfalls of using boilerplate provisions and provide practical guidance for adapting provisions to meet the needs of each transaction.

- **Robert H. Johnston**, Johnston Law, Dallas, Texas

3:15 BREAK

3:30 THE PATENT ELIGIBILITY MORASS: HOW DID WE GET HERE, HOW BAD IS IT, AND CAN WE FIX IT?

In these presentations we will assess the current patent eligibility landscape based on statistical analyses of court decisions and USPTO office actions since Alice was decided in June 2014. The panel will then review the larger historical developments in eligibility theory to show how the courts have improperly incorporated concepts of inventiveness into eligibility, concepts which Congress expressly attempted to eliminate in the 1952 Act. Finally, the panel will discuss potential legislative changes to the patent statute.

- Russ Emerson, Haynes and Boone LLP, Dallas, Texas
- Robert R. Sachs, Fenwick & West LLP, San Francisco, California
- Prof. David O. Taylor, SMU Dedman School of Law, Dallas, Texas

5:00 ADJOURN

ABOUT THE INSTITUTE FOR LAW AND TECHNOLOGY (ILT)



Institute for
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Established in 2003 as part of The Center for American and International Law (CAIL), the Institute for Law and Technology (ILT), sponsors educational programs for lawyers and other professionals with a principal focus on intellectual law and practice.

ILT is a membership organization and counts leading intellectual property practitioners, both in-house and in private practice, among its members. For more information, visit cailaw.org/ilt

ABOUT THE CENTER FOR AMERICAN AND INTERNATIONAL LAW (CAIL)



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CAIL is a nonprofit educational institution dedicated to improving the quality of justice through continuing education to lawyers and law enforcement officials in the U.S. and throughout the world. Founded in 1947 by Robert Storey, Dean of the Southern Methodist University School of Law, CAIL was a pioneer back in a time when the notion of continuing formal education beyond law school was a relatively new idea. Today, tens of thousands of lawyers and law enforcement officers from all 50 states and 130 countries have participated in CAIL's high quality, cutting-edge programs. Learn more at cailaw.org



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53rd Annual Conference on Intellectual Property Law

November 16-17, 2015

The Center for American and International Law
Plano, Texas

Registration includes the Conference, course materials, continental breakfasts, boxed luncheons on Monday and Tuesday and networking reception on Monday for conference registrants and faculty.

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HOUSING: The cost of housing is not included in tuition. However, rooms (in limited number) have been reserved at Dallas/Plano Marriott at Legacy Town Center, 7121 Bishop Road, Plano, Texas 75024. Registrants should advise them they will be attending the IP Law Program to receive the reduced room rate of \$174 + tax. The last day to obtain this special rate is October 26, 2015.

NONDISCRIMINATION POLICY: The Center for American and International Law does not discriminate on the basis of race, color, sex, religion, national origin, age, disability, veteran status or any other protected status in educational activities, scholarship programs or admissions.

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For this conference, ILT will directly apply (if requested) for course accreditation in the following states: California, Minnesota, New Mexico, Ohio, Oklahoma, Pennsylvania, Texas and Virginia. Some of these states may not approve a program for credit hours before the program occurs. Attorneys may be eligible to receive CLE credit through reciprocity or attorney self-submission in other states. ILT conferences are typically accredited by all mandatory CLE states.



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