



Institute for
**LAW AND
TECHNOLOGY**

52nd Annual Conference on Intellectual Property Law



52nd Annual Conference on Intellectual Property Law

November 10-11, 2014
The Center for American
and International Law
Plano, Texas

After Dinner Conversation

Between
The Hon. Randall R. Rader
and
Dean John M. Whealan

Highlights

- Annual Review of Patent, Trademark, Copyright and Trade Secret Law
- Deep-Dive, Concurrent Tracks on Patent Prosecution and Litigation
- Lunch Remarks from USPTO Chief of Staff, **Andrew C. Byrnes**
- PTAB Best Practices
- District Court Best Practices

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AIPLA

52nd Annual Conference on Intellectual Property Law

PROGRAM AT A GLANCE

November 10-11

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Dallas, Texas

David O. Taylor
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SMU Dedman School of Law
Dallas, Texas

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Monday, November 10

7:15 NETWORKING BREAKFAST PRESENTED BY THE WOMEN IN IP TASK FORCE - STATE BAR OF TEXAS: *ETHICS PRESENTATION: "NEGOTIATING ETHICS"*

8:45 WELCOME

THE IP YEAR IN REVIEW

9:00 COPYRIGHT YEAR IN REVIEW

9:45 TRADEMARK YEAR IN REVIEW

10:30 BREAK

10:45 PATENT YEAR IN REVIEW

11:30 TRADE SECRET YEAR IN REVIEW

12:00 PICK UP BOXED LUNCH

12:15 ETHICS PRESENTATION: PROSECUTION BARS

1:15 BREAK

TECHNOLOGY, LICENSING AND IP RIGHTS

1:30 THE FUTURE OF TRADE SECRET LAW

2:00 DEMAND LETTERS: WHAT IS APPROPRIATE ANYMORE?

2:30 EXPLORING COMPETING INTERESTS OF FRAND LICENSING COMMITMENTS

3:15 BREAK

3:30 THE NAME OF THE GAME IS THE (INSURANCE) CLAIM - INDEMNIFICATION IN PATENT LITIGATION

4:00 ETHICS PRESENTATION: SUBJECT MATTER CONFLICTS - THE NEXT WAVE IN IP MALPRACTICE CLAIMS?

5:00 RECEPTION

6:00 CONFERENCE DINNER

Tuesday, November 11

7:15 NETWORKING BREAKFAST PRESENTED BY DBA IP SECTION NEW LAWYERS COMMITTEE

7:45 BREAKFAST ROUNDTABLE: PATENT PROSECUTION BEST PRACTICES	BREAKFAST ROUNDTABLE: PATENT LITIGATION BEST PRACTICES
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PATENT PROSECUTION AND PATENT LITIGATION

9:00 WHAT DO I DO NOW?	CURRENT ISSUES AT THE ITC
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10:00	DISCOVERY IN PATENT LITIGATION: LOCAL PATENT RULES AND POTENTIAL CHANGES TO THE FEDERAL RULES OF CIVIL PROCEDURE
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10:30 BREAK

10:45 LIVING WITH THE NEW § 102: HOW WILL IT CHANGE YOUR PRACTICE?	FOCUS GROUPS AND MOCK TRIALS: BEST PRACTICES IN PATENT LITIGATION
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11:30 STRATEGIC USES OF NEW USPTO INITIATIVES AND PROCEDURES: HOW TO IMPROVE PROSECUTION EXPEDIENCY	HIRING AND MANAGING LITIGATION COUNSEL
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12:15 PICK UP BOXED LUNCH

12:30 LUNCH KEYNOTE - FROM SILICON VALLEY TO WASHINGTON, D.C.: INSIGHTS FROM THE INTERSECTION OF TECHNOLOGY, LAW AND POLITICS

1:30 BREAK

PATENT DISPUTES

1:45 EFFECTIVE ADVOCACY IN PATENT LITIGATION

2:30 BREAK

2:45 PATENT OWNERS, DON'T GET CAUGHT IN THE TSUNAMI: AIA POST-GRANT PROCEEDINGS

3:45 TRIAL PROCEEDINGS BEFORE THE PTAB: BEST PRACTICES AND LESSONS LEARNED

5:00 ADJOURN

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

When it comes to ethics in negotiations, it’s anything but anything goes. Could a tiny white lie here and a teeny puffing there mean the difference between getting the deal done and getting disbarred? We will address these questions and more in a novel way as our speakers challenge you: “Are you smarter than a first-year lawyer?”

PANELISTS:

- **Wilson Chu**, K&L Gates LLP, Dallas, Texas
- **Barrett R. Howell**, K&L Gates LLP, Dallas, Texas
- **Hope Shimabuku**, Xerox Business Services, LLC, Dallas, Texas

8:45 WELCOME

THE IP YEAR IN REVIEW
Module Chair: Michael D. Pegues

9:00 COPYRIGHT YEAR IN REVIEW

A review of 2013-14 cases and controversies involving copyright law issues.

- **Kevin J. Meek**, Baker Botts, L.L.P., Austin, Texas

9:45 TRADEMARK YEAR IN REVIEW

An overview of 2013-14 cases from the TTAB and important civil cases involving trademarks.

- **Megan Dredla Hoyt**, Thompson & Knight LLP, Dallas, Texas

10:30 BREAK

10:45 PATENT YEAR IN REVIEW

Pete Peterson will present his annual review of patent law decisions by the U.S. Supreme Court and the Federal Circuit.

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

11:30 TRADE SECRET YEAR IN REVIEW

An overview of the year’s developments in trade secret law.

- **Joseph F. Cleveland, Jr.**, Brackett & Ellis, P.C., Fort Worth, Texas

12:00 PICK UP BOXED LUNCH

12:15 ETHICS PRESENTATION: PROSECUTION BARS

Developed to protect against misuse of confidential information by competitive decision-makers, prosecution bars can sometimes be used in effect as motions to disqualify. At the same time, agreeing to abide by a bar creates its own management issues. This session will address the many ethical issues created by prosecution bars, including their scope and application in *inter partes* review, reissue, and other contexts.

- **David Hricik**, Professor of Law, Mercer University, Macon, Georgia

1:15 BREAK

TECHNOLOGY, LICENSING, & IP RIGHTS
Module Chair: Jeffrey R. Bragalone

1:30 THE FUTURE OF TRADE SECRET LAW

Congress has recently considered legislation that would, among other things, create a federal cause of action for trade secret misappropriation. What are the prospects for enactment of this or similar legislation? What would this legislation mean for state causes of action? In short, what is the future of trade secret law?

- **Thaddeus Burns**, Senior Counsel, Intellectual Property & Trade, General Electric, Washington, D.C.

TECHNOLOGY, LICENSING, & IP RIGHTS, CONT.

2:00 DEMAND LETTERS: WHAT IS APPROPRIATE ANYMORE?

Various states have begun to crack down on what critics deride as “bad-faith demand letters” that seek to obtain payments for licenses to patents. Some states have sought to enforce their existing, generally-applicable laws, while others have enacted laws specifically designed to address this perceived problem. As a result, we now have a patchwork quilt of state laws governing demand letters. What do these laws allow? What do they require? What might be on the horizon in more states (including Texas) and at the federal government? And are these state laws preempted by federal law, or will they be?

— **Dennis Skarvan**, Deputy General Counsel, Caterpillar, Inc., Peoria, Illinois

2:30 EXPLORING COMPETING INTERESTS OF FRAND LICENSING COMMITMENTS

Many standard setting organizations (SSOs) require fair, reasonable, and non-discriminatory (FRAND) licensing commitments from patent owners before patented technology may be incorporated into standards. Patent owners want a return on their development costs, while implementers want low-cost access to patent licenses to maintain their own margins. How do SSOs and courts balance these competing interests, for example, with respect to patent disclosure requirements and injunctions? How should they?

PANEL MODERATOR

— **Lawrence (Larry) J. Bassuk**, Deputy General Patent Counsel, Texas Instruments Inc., Dallas, Texas

PANELISTS

— **David Killough**, Assistant General Counsel, Microsoft Corporation, Seattle, Washington

— **Luke McLeroy**, Licensing Counsel, Ericsson, Inc., Dallas, Texas

3:15 BREAK

3:30 THE NAME OF THE GAME IS THE (INSURANCE) CLAIM – INDEMNIFICATION IN PATENT LITIGATION

No exceptional case? No problem. Dust off your vendor agreements and learn how to recover attorneys’ fees, settlement amounts, and damages arising out of patent litigation.

— **Austin Champion**, Klemchuk Kubasta LLP, Dallas, Texas

4:00 ETHICS PRESENTATION: SUBJECT MATTER CONFLICTS – THE NEXT WAVE IN IP MALPRACTICE CLAIMS?

Representing different, non-adverse clients in similar technical fields has always been a potential business conflict for IP firms, but a recent Texas court case shows that the malpractice risks in this situation are no longer theoretical. This presentation explores a number of proactive steps that IP firms can take to reduce risks from the frequently-encountered issue of potential subject matter conflicts.

— **Colin Cahoon**, Carstens & Cahoon, LLP, Dallas, Texas

5:00 RECEPTION

6:00 CONFERENCE DINNER

A Conversation with The Hon. Randall R. Rader

Former Chief Judge, U.S. Court of Appeals for the Federal Circuit, Washington, DC

Featuring **The Hon. Randall R. Rader** in conversation with **Dean John M. Whealan**

Dean for Intellectual Property Law Studies, George Washington University Law School, Washington, DC



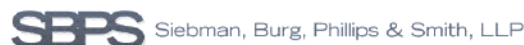
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7:45 **BREAKFAST ROUNDTABLES PRESENTED BY DALLAS BAR ASSOCIATION IP SECTION NEW LAWYERS COMMITTEE. TO ALLOW TIME FOR NETWORKING, BREAKFAST WILL BE SERVED FROM 7:15 A.M.**

Breakfast Roundtable: Patent Prosecution Best Practices

Patent Prosecutorial Judgment: Enhance your judgment of real world issues facing patent prosecutors by taking part in discussions with the best teachers—your peers! Join discussions with experienced patent prosecution professionals on topics that range from the best use of foreign application prosecution to those new, pesky 101 rejections. Voice your experiences while learning from the best.

PANEL MODERATOR

— **Adam C. Davenport**, Slater & Matsil, L.L.P., Dallas, Texas

PANELISTS

- **Bobby Braxton**, Braxton, Hilton, & Perrone, Dallas, Texas
- **Michael Kevin Henry Ph.D.**, Fish & Richardson, Dallas, Texas
- **John J. (Jake) May**, Gardere Wynne Sewell LLP, Dallas, Texas
- **Michael G. Rodriguez**, Munck, Wilson, Mandala, LLP, Dallas, Texas

Breakfast Roundtable: Patent Litigation Best Practices

Grab some coffee and join the discussion! Share your knowledge of patent litigation practice with others at a focused discussion covering timely patent litigation issues including the impact of PTAB proceedings—namely *Inter Partes* Review and Covered Business Method review—on patent litigation, limitations on discovery, and the Federal Circuit and Supreme Court’s latest pronouncements on substantive patent law issues. Come join in the conversation.

PANEL MODERATOR

— **Dwayne C. Norton**, Alston & Bird, Dallas, Texas

PANELISTS

- **Juanita Deloach**, Dentons US LLP, Dallas, Texas
- **Scott Hejny**, McKool Smith, Dallas, Texas
- **Amy E. LaValle**, Conley Rose, P.C., Plano, Texas
- **Paul Lein**, Locke Lord LLP, Dallas, Texas

CONCURRENT SESSIONS

PATENT PROSECUTION Module Chair: Michael W. Piper

9:00 WHAT DO I DO NOW?

Writing specifications and claims in light of recent cases on subject matter eligibility, written description, indefiniteness, and divided infringement.

PANEL MODERATOR

— **Michael W. Piper**, Conley Rose, P.C., Plano, Texas

PANELISTS

- **Courtenay C. Brinckerhoff**, Foley & Lardner LLP, Washington, D.C.
- **Micky Minhas**, Associate General Counsel, Patent Strategy, Microsoft Corporation, Redmont, Washington
- **Robert L. Stoll**, Drinker Biddle & Reath LLP, Washington, D.C.

PATENT LITIGATION Module Chair: Bruce Sostek

9:00 CURRENT ISSUES AT THE ITC

The International Trade Commission (ITC) has become an increasingly important weapon in the patent owners’ arsenal. This session considers several issues confronting complainants and respondents at the ITC, including (a) how complainants might avoid being gored by the economic prong of the domestic injury requirement when relying upon domestic research and development and licensing; (b) how respondents might cut costs and obtain early dispositions; and (c) whether electronic transmissions of digital data qualify as “articles” imported into the United States.

- **Robert K. Rogers, Jr.**, Steptoe & Johnson, LLP, Los Angeles, California
- **Michael E. Schonberg**, Thompson & Knight LLP, Dallas, Texas

Faculty Dinner Sponsor

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51st Annual Conference on Intellectual Property Law

PATENT PROSECUTION, CONT.

10:30 BREAK

10:45 **LIVING WITH THE NEW § 102: HOW WILL IT CHANGE YOUR PROSECUTION PRACTICE?**

This presentation will describe the new § 102 in three simple concepts and describe ways in which prior art under AIA has been both expanded and contracted. It will cover when and how to file declarations under 37 C.F.R. § 1.130. The presentation will also describe pitfalls to avoid when filing new applications, including the “malpractice box” on the AIA Application Data Sheet and address whether you should search an application before filing and what references you should be searching for.

— **Kenneth N. Nigon**, RatnerPrestia, Valley Forge, Pennsylvania

11:30 **STRATEGIC USES OF NEW USPTO INITIATIVES AND PROCEDURES: HOW TO IMPROVE PROSECUTION EXPEDIENCY**

At the end of the USPTO’s most recent fiscal year, the USPTO documented 78,272 pending requests for continued examination (RCEs). Tackling this backlog of RCEs, of course, will divert the USPTO’s resources away from the examination of new applications. The USPTO therefore recently introduced several initiatives to address the issue of prosecution expediency. The USPTO has made these initiatives available for consideration and use at each stage of prosecution prior to the filing of an RCE (i.e., before and during filing of an application, before a first office action on the merits, after a final rejection, before an appeal, during and after

PATENT LITIGATION, CONT.

10:00 **DISCOVERY IN PATENT LITIGATION: LOCAL PATENT RULES AND POTENTIAL CHANGES TO THE FEDERAL RULES OF CIVIL PROCEDURE**

Discovery in patent litigation is often protracted and expensive, which can lead to unwarranted or premature settlements. Recognizing this problem, many federal courts have implemented local rules to streamline discovery and reduce costs for patent litigants. Additionally, the Advisory Committee on Civil Rules has recently proposed various amendments to the Federal Rules of Civil Procedure, including provisions regarding proportionality and cost-shifting, that could have important implications for discovery in patent litigation.

— **Megan M. La Belle**, Associate Professor of Law, The Catholic University of America Columbus School of Law, Washington, D.C.

10:30 BREAK

10:45 **FOCUS GROUPS AND MOCK TRIALS: BEST PRACTICES IN PATENT LITIGATION**

A panel of experienced trial practitioners talk about what works - and what doesn’t - when using focus groups and mock trials in patent litigation. Learn what to use focus groups for, and when mock trials can help crystallize the theories that will win at trial.

PANEL MODERATOR

— **Michael C. Smith**, Siebman, Burg, Phillips & Smith, LLP, Marshall, Texas

PANELISTS

— **Jennifer Haltom Doan**, Haltom & Doan, Texarkana, Texas

— **Wesley Hill**, Ward & Smith Law Firm, Longview, Texas

11:30 **HIRING AND MANAGING LITIGATION COUNSEL**

How do in-house counsel decide which law firm to hire as litigation counsel for patent infringement cases? And, after hiring litigation counsel, how can in-house counsel constrain expense and risk through effective use of litigation counsel?

PANEL MODERATOR

— **Bart E. Showalter**, Baker Botts L.L.P., Dallas, Texas

PANELISTS

— **Brian Gaffney**, General Attorney - IP Litigation, AT&T, Dallas, Texas

PATENT PROSECUTION, CONT.

allowance, and after issuance). This presentation will focus on strategic use of each of these initiatives.

— **Carey C. Jordan**, McDermott Will & Emery LLP, Houston, Texas

PATENT LITIGATION, CONT.

— **Mark Patrick**, Assistant General Counsel, Texas Instruments Inc., Dallas, Texas

— **Betty Ungerman**, Vice President, Deputy General Counsel, Lennox International, Richardson, Texas

12:15 PICK UP BOXED LUNCH

12:30 LUNCHEON KEYNOTE ADDRESS

From Silicon Valley to Washington, D.C.: Insights from the Intersection of Technology, Law and Politics

Andrew Byrnes, Chief of Staff, U.S. Patent and Trademark Office, Alexandria, Virginia

1:30 BREAK

PATENT DISPUTES Module Chair: Theodore Stevenson III

1:45 EFFECTIVE ADVOCACY IN PATENT LITIGATION

A panel of federal judges will discuss the dos and don'ts of pretrial procedure and trial, identifying what makes for effective advocacy.

PANEL MODERATOR

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

PANELISTS

— **The Hon. Barbara M.G. Lynn**, United States District Court for the Northern District of Texas, Dallas, Texas

— **The Hon. Roy Payne**, United States District Court for the Eastern District of Texas, Marshall, Texas

2:30 BREAK

2:45 PATENT OWNERS, DON'T GET CAUGHT IN THE TSUNAMI: AIA POST-GRANT PROCEEDINGS

Tom Irving will discuss preparing and prosecuting U.S. patent applications to withstand scrutiny by the Patent Trial and Appeal Board (PTAB) during AIA reviews, and to make reviews more difficult to institute at the Board. Strategies include building into the patent application and prosecution a broadest reasonable claim construction that will avoid unpatentability whether in view of prior art, nonenablement, or lack of written description, and more liberal use of declarations relating to nonobviousness and §112 issues.

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

3:45 TRIAL PROCEEDINGS BEFORE THE PTAB: BEST PRACTICES AND LESSONS LEARNED

Trial proceedings before the Patent Trial and Appeal Board (PTAB) are becoming the norm in patent litigation. This interactive panel will provide perspectives from practitioners, patent challengers, and the bench on best practices and lessons learned in handling *inter partes*, covered business method, and post grant review proceedings before the PTAB.

PANEL MODERATOR

— **Sharon A. Israel**, Mayer Brown, Houston, Texas

PANELISTS

— **Chris Dunstan**, Senior Legal Counsel - Litigation, Ericsson Inc., Plano, Texas

— **David L. McCombs**, Haynes and Boone, LLP, Dallas, Texas

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

5:00 ADJOURN

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REGISTRATION

52nd Annual Conference on Intellectual Property Law

November 10-11, 2014

The Center for American and International Law
Plano, Texas

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

Check applicable box:	Received by 10/24/14	Received after 10/24/14
Regular registration fee	<input type="checkbox"/> \$595	<input type="checkbox"/> \$645
ILT Advisory Board Member	<input type="checkbox"/> \$0	<input type="checkbox"/> \$0
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Law Student <i>(includes lunches and materials, but excludes Monday dinner)</i>	<input type="checkbox"/> \$50	<input type="checkbox"/> \$50
Law Student <i>(includes lunches, materials and the Monday dinner)</i>	<input type="checkbox"/> \$100	<input type="checkbox"/> \$100
Materials Only	<input type="checkbox"/> \$150	<input type="checkbox"/> \$150

I plan to attend the Conference Dinner on Monday, November 10.
(There is no charge for the dinner, but we would like to know how many to expect.)

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PAYMENT MUST ACCOMPANY REGISTRATION

GENERAL INFORMATION

CANCELLATION POLICY: Tuition, less a \$50 cancellation fee will be refunded upon receipt of written cancellation received by October 24, 2014. E-mail cancellation notice to lgaspar@cailaw.org. After this date, no refunds, but substitution of attendees for this program will be permitted. Registrants not entitled to a refund will receive the course materials.

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 \$139 + tax. The last day to obtain this special rate is October 21, 2014.

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