15th Annual Silicon Valley
Advanced Patent Law Institute

December 11 & 12, 2014
Four Seasons Hotel
East Palo Alto, CA

Navigant

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UC Berkeley School of Law certifies that this activity has been approved for 14.5 hours CLE credit, including 1.25 hours in Legal Ethics, by the State Bar of California.

Presentations and additional materials available online at www.APLISV.org

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Welcome

The Berkeley Center for Law & Technology and the Stanford Program in Law, Science and Technology welcome you to the 15th Annual Advanced Patent Law Institute: Silicon Valley (APLiSV).

The program draws on the many strengths of the UC Berkeley School of Law and the Stanford Law School in patent and IP law, and their strong interest in fostering interactions between litigators, patent prosecutors, corporate IP counsel, academics, USPTO officials, IP strategists, and judges.

We are delighted that you have chosen to attend APLiSV and we hope that you enjoy the program, the venue, and the opportunity to listen to and meet with a nationally recognized conference faculty and fellow attendees.

The goal of the conference is to cover key developments in patent law at an advanced level, with a blend of topics and speakers that provides corporate IP counsel, patent prosecutors, and litigators with highly relevant information, insights and practical guidance, as well as opportunities for networking and informal exchanges of information.

The conference would not be possible without the active participation of the conference planning committee, speakers, moderators, and presiding officers; as well as the support of our sponsors. We are most appreciative of the many efforts on behalf of this program.

Robert Barr
Berkeley Center for Law & Technology

Mark Lemley
Stanford Law School; Durie Tangri LLP

Michael Esposito
Blue Moon Software, Inc.
The mission of the Berkeley Center for Law & Technology (BCLT) is to foster the beneficial and ethical advancement of technology by guiding the development of intellectual property law, information privacy law, and related areas of law and public policy as they interact with business, science and technical innovation.

Established in 1995 with a focus on intellectual property, BCLT has developed the leading program in law and technology. BCLT has expanded over the years to encompass privacy law, cyberlaw, electronic commerce, digital entertainment law, cleantech, biotech, telecommunications regulation and many other areas of constitutional, regulatory and business law that are affected by new technologies.

Led by an internationally esteemed faculty, BCLT frames and advances the law and technology discussion. Equally noteworthy is BCLT’s global community of students, alumni, practicing attorneys, policymakers, and scholars in all sectors of law and technology, who participate with BCLT in a variety of academic, practical, and law reform activities.

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Stanford Law School's Program in Law, Science and Technology (LST) explores one of the most highly charged fields of study in law today. People working on this continuously evolving frontier face complex issues including patent reform, copyright and privacy issues arising on the Internet, legal and ethical issues surrounding new discoveries in the biosciences, and issues surrounding technologies that promise to make the legal system more efficient. Through interdisciplinary research and teaching, the Program produces cutting-edge scholarship and trains the next generation of leaders in the field.

Much of Stanford’s work in law, science, and technology takes place through the LST Program’s six constituent centers that provide a neutral forum for interdisciplinary investigation that shapes real-world law and through the Juelsgaard IP and Innovation Clinic.

The Centers are:
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Center for Law and the Biosciences
Codex - Stanford Center for Legal Informatics
The Stanford Program in Neuroscience and Society
Center for E-Commerce
Transatlantic Technology Law Forum

Web: lst.stanford.edu
Phone: 650.723.5905
Email: tech@law.stanford.edu
Thursday Morning, December 11, 2014

Presiding Officer: Robert Barr, Berkeley Center for Law & Technology

7:30 a.m. Registration Opens + Continental Breakfast

Breakfast Sponsored By:

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8:20 a.m. Welcoming Remarks

8:30 a.m. 0.75 hr

Patentable Subject Matter: From Software to Genes

Over the last few years, the Supreme Court and the U.S. Court of Appeals for the Federal Circuit have rendered several opinions regarding the most basic of patent questions: “What kinds of things are patentable?” The cases have ranged from software cases, to business methods, to genes, to molecular diagnostic methods. We will explore the manner in which the courts approach this issue in general, as well as some of the particular problems and opportunities that are created.

Moderator:
Vern Norviel, Wilson Sonsini Goodrich & Rosati

Panelists:
David Jones, Microsoft Corporation
David Simon, Salesforce.com, Inc.

9:15 a.m. 0.50 hr

Joint / Divided Infringement

Limelight Networks, Inc. v. Akamai Technologies, Inc. has revived the divided infringement defense for induced infringement, and brought the issue of direct infringement into the spotlight. This presentation will evaluate the history of divided infringement at the Federal Circuit, the Supreme Court’s Akamai decision, and more recent developments.

Matthias Kamber, Keker & Van Nest LLP

9:45 a.m. 0.50 hr

Indirect Infringement: It’s a State of Mind

Recent case law has strengthened the intent requirements for proving indirect infringement. In this session, we will discuss that case law as well as litigation and reexamination strategies opened up by those developments.

Clement S. Roberts, Durie Tangri LLP

10:15 a.m. 15 minute break

10:30 a.m. 1.50 hr including 0.25 ethics

Is District Court Litigation Essentially Over? Everyone is at the PTAB

This panel will explore the impact of the Inter Partes Review and covered business methods at the Patent Trial and Appeal Board. Why is it the venue of choice these days? What are the advantages/disadvantages? What trends are emerging?

Moderator:
Bijal V. Vakil, White & Case LLP

Panelists:
Hon. Peter Chen, Patent Trial and Appeal Board, USPTO
Matthew Kreeger, Morrison & Foerster LLP
Renée Lawson, Zynga Inc.
Hon. Teresa Stanek Rea, Former Acting Director of USPTO, now at Crowell & Moring

12:00 p.m. Break to Pick Up Lunch

Lunch Sponsored By:

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12:15 p.m. 0.75 hr

Lunch Keynote:
A Conversation with Chief Judge Prost: Her Experiences on the Court and Where She Thinks the Court is Going

Matthias Kamber, Keker & Van Nest LLP
Chief Judge Sharon Prost, US Court of Appeals for the Federal Circuit

1:00 p.m. 1.50 hr

Prosecution Update

The panel will discuss how new case law and developments at the PTO are affecting patent strategy and patent practice. A roundtable discussion will address provocative and challenging questions arising from recent administrative actions and proceedings in addition to Supreme Court and Federal Circuit case law affecting areas such as written description and sufficiency, patent eligible subject matter, obviousness and case acceleration and pendency.

Moderator:
Lee Van Pelt, Van Pelt, Yi & James LLP

Panelists:
Nena Bains, Kilpatrick Townsend & Stockton LLP
Emily Haliday, Weaver Austin Villeneuve & Sampson LLP
Christopher J. Palermo, Hickman Palermo Becker Bingham LLP
Rajiv Patel, Fenwick & West LLP

2:30 p.m. 15 minute break
EFFECTIVE STRATEGIES AND TREND-SPOTTING IN PATENT DAMAGES

A no-holds barred discussion on how to successfully shape and manage damages in patent litigation, including damages fact development, when and how best to use expert depositions, and options for challenging experts.

Karen Boyd, Turner Boyd LLP
James Pampinella, Navigant Consulting, Inc.
Isaac Peterson, Netflix, Inc.

FAIR, REASONABLE, AND NON-DISCRIMINATORY TERMS (FRAND) AND STANDARD ESSENTIAL PATENTS (SEP): EMERGING ISSUES AFTER MICROSOFT, INNOVATION AND APPLE

This panel will focus on the availability of injunctions for SEPs, the determination of whether a patent is in fact “essential,” whether a patent can be rendered unenforceable due to the breach of a FRAND commitment.

Moderator:
Robert D. Fram, Covington & Burling LLP

Panelists:
Scott Gilfillan, Intel Corporation
Matthew Lynde, Cornerstone Research

DEFINITENESS AND FUNCTIONAL CLAIMING

Claim definiteness has become a focus of policy discussions – are imprecisely drafted claims leading to unwarranted patent litigation? – as well as substantial litigation to better define the statutory mandate of claims “particularly pointing out and distinctly claiming” what has been invented. The panel will approach the issue in view of the Supreme Court’s new standard for definiteness in its 2014 decision in Nautilus v. Biosig Instruments, and will also focus on issues relating to “functional claiming,” both in the Courts and in the US Patent and Trademark Office (US PTO).

Moderator:
Robert J. Goldman, Ropes & Gray LLP

Panelists:
William S. Galliani, Cooley LLP
Sonal N. Mehta, Weil, Gotshal & Manges LLP
John D. Vandenberg, Klarquist Sparkman, LLP

JUDGES PANEL

Leading District Court judges discuss cutting-edge patent litigation issues including creative ways they are managing patent cases in an evolving patent landscape.

Moderator:
Hon. Paul Singh Grewal, US District Court, Northern District of California

Panelists:
Hon. Roy Payne, US District Court, Eastern District of Texas
Hon. Ronald M. Whyte, US District Court, Northern District of California

OUR DIVIDED PATENT SYSTEM

Professor Lemley will report the results of the first comprehensive study of patent litigation outcomes in nearly twenty years. It includes some surprising findings on who wins – and who loses – patent lawsuits.

Mark Lemley, Stanford Law School; Durie Tangri LLP

ETHICS ISSUES RAISED BY CLIENT AND THIRD PARTY CLAIMS AGAINST IP LAWYERS

Using a review of client and third party claims against IP lawyers in the past twelve months, this presentation will identify recurring ethics issues and offer suggestions on how to handle them correctly.

John Steele, John Steele Law

ASSIGNOR ESTOPPEL: AN ANCIENT SQUARE PEG IN A MODERN ROUND HOLE?

The doctrine of assignor estoppel was developed within a historical, and now quite dated, economic and commercial context. The modern contexts in which it has been applied are very different. Does the doctrine still make sense in the modern economy? This talk will explore that question.

Vernon M. Winters, Sidley Austin LLP

MULTIDISTRICT LITIGATION, FORUM SELECTION, AND TRANSFER: TIPS AND TRENDS

Where a patent case is filed – and where it ends up – has a substantial impact on the likely outcome and the odds of settlement. This session looks at patentees’ favorite forums, recent developments in the law governing transfer, and trends in the utilization of Multidistrict Litigation (MDL) by patentees and defendants.

Julie M. Holloway, Latham & Watkins LLP

THE ETHICAL IMPLICATIONS OF DISCOVERY AND PLEADING REFORM EFFORTS

Chris and Doug will address recent cases and reform efforts currently underway aimed at streamlining patent litigation by heightening pleading requirements, adopting a more focused approach to discovery, and staging discovery. Progress on these fronts may ease the ethical concerns that plague counsel regarding preservation, collection and production of electronically stored information.

Christian E. Mammen, Hogan Lovells LLP
Douglas Nemec, Skadden, Arps, Slate, Meagher & Flom LLP & Affiliates
1:45 P.M. 0.75 HR

DÉJÀ VU ALL OVER AGAIN (OR NOT): PATENT REFORM 2014

Proposals to reform the patent system in America are becoming a nearly permanent feature of the landscape. Are this year’s proposals more of the same or is it different this time? This panel will talk about the stalled bills in Congress, agency reforms, and other ongoing efforts to “fix” a patent system nearly everyone thinks is broken, including how judicial decisions and market-based solutions have affected the landscape and whether the courts can effectively step in when Congress fails to act.

Moderator:
David Enzminger, Winston & Strawn LLP

Panelists:
Marta Beckwith, Aruba Networks, Inc.
Eric R. Lamison, Cisco Systems, Inc.
Mallun Yen, RPX Corporation

2:30 P.M. 15 MINUTE BREAK

2:45 P.M. 0.50 HR

OBVIOUSNESS: WHAT’S NEW AND NONOBVIOUS?

This session will review recent updates in the law of obviousness, both in the US Patent and Trademark Office and in litigation.

Steven C. Carlson, Kasowitz, Benson, Torres & Friedman LLP

3:15 P.M. 0.50 HR

INTERNATIONAL TRADE COMMISSION 2014: A YEAR IN FLUX (LEARNING FROM RECENT DEVELOPMENTS)

This session will delve into the recent hot button issues and challenges in the world of ITC litigation, including (among others) whether the ITC is still a viable forum for patent litigation, the current state of the domestic industry requirement, indirect infringement at the ITC and the requirement for infringement at importation, the effect of the public interest on exclusion orders, and whether the ITC has jurisdiction over the electronic transmission of goods.

Yar R. Chaikovsky, McDermott Will & Emery

3:45 P.M. CLOSING REMARKS
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Our firm has expertise in the following areas:

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- Semiconductor and computer architecture
- Object-oriented programming and development environments
- Video image processing
- Complex analytics and statistical analysis methods
- Payment systems

“[Hickman Palermo] are among the brightest minds in the patent prosecution area today”

What Can An Intellectual Property Investment Bank Do For You?

Bring the true value of your IP to the bottom line...

Inflexion Point represents technology companies and institutional investors in buying, selling, and investing in intellectual property assets—including patent portfolios, related know-how & exclusive field-of-use rights—and operating businesses for which IP is critically important. We monetize the unrealized value in these IP assets by generating additional licensing revenue, building a defensive shield against litigious competitors, and increasing corporate valuation in M&A transactions.

Intellectual Property Investment Banking: Our business model is based on the premise that IP is no longer viewed merely as a bundle of legal rights to be enforced or licensed. IP has now become a commercial asset class like real property or corporate securities. This transition has opened up a range of value enhancement opportunities based on adaptation of the models that have been used with more traditional asset classes.

Value Proposition: It’s widely recognized that 80% or more of the market value of technology companies consists of intangible assets. This “intellectual capital” includes both intellectual property rights—patents, trademarks, copyrights, and trade secrets—and less defined assets such as customer loyalty, inter-company relationships, company know-how and undocumented inventions in employee minds.

Our experience is that many companies pay far too little attention to the IP-related components of corporate value because IP is viewed as too abstract, complex, and/or unquantifiable to be included in the value calculus of business transactions.

We disagree. In a knowledge-based economy, innovative technology creates competitive advantage in the form of lead time or first mover advantage; but a strong IP position creates sustainable competitive advantage. However, because the traditional accounting-based value metrics such as EBITDA, free cash flow and various other multiples and ratios based on historical data simply don’t apply to IP, a substantial value component is often left on the table in corporate transactions.

Structured For Results: Inflexion Point provides a full range of intellectual property investment banking services. As part of our patent brokerage and IP-driven M&A advisory services, we provide deal support by assembling and managing teams of technical experts, market analysts, and patent research specialists to meet the special project needs of our client engagements.

Distinctive Competence: Our team members all have had hands-on experience in commercializing technology and monetizing the value of the associated IP.

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- We’re connected. We have an extensive network of high-level contacts in the largest technology companies in Silicon Valley, across the US, and around the world.
- We’re focused. We quickly assemble a highly customized deal team with the right technical background, industry experience, and market knowledge.
- We’re flexible. We are an outside resource that can bring experience, creativity, analysis, and visualization tools to any IP project based on the breadth and scope of the assignment.

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When cases matter most, the world’s leading innovators and product developers call on us to protect their technology and intellectual property. In the past year alone, Keker & Van Nest has won groundbreaking, bet-the-company cases for leading companies within the semiconductor, Internet, smartphone, telecommunications, and biotech industries.

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At Kilpatrick Townsend, we believe that ingenious businesses will succeed, and that complex business issues demand creative solutions. We believe in working together, and in bringing the right mix of diverse thought and skill to every engagement. We believe in hard work, and we engage in the tireless pursuit of business-building goals on our clients’ behalf.
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Will Acworth, Senior Vice President, FIA
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~ As of December 3, 2014 ~

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