



BERKELEY CENTER FOR  
**LAW & TECHNOLOGY**

**Stanford** Law School

Stanford Program in  
Law, Science & Technology

15TH ANNUAL SILICON VALLEY

# ADVANCED PATENT LAW INSTITUTE

DECEMBER 11 & 12, 2014

FOUR SEASONS HOTEL

EAST PALO ALTO, CA

FIG. 1

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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.

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# 15TH ANNUAL SILICON VALLEY ADVANCED PATENT LAW INSTITUTE

DECEMBER 11-12, 2014 • FOUR SEASONS HOTEL • EAST PALO ALTO, CA

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## 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 :



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 to 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 InterPartes 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 Vakil, *White & Case LLP*

#### Panelists:

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

## THURSDAY AFTERNOON, DECEMBER 11, 2014

### PRESIDING OFFICER:

RONALD S. LAURIE, *INFLEXION POINT*

12:00 P.M. BREAK TO PICK UP LUNCH

### LUNCH SPONSORED BY:



HICKMAN PALERMO  
TRUONG BECKER  
BINGHAM WONG LLP

INTELLECTUAL PROPERTY LAW

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

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 Truong Becker Bingham Wong LLP*  
Rajiv Patel, *Fenwick & West LLP*

2:30 P.M.

15 MINUTE BREAK

2:45 P.M.

0.75 HR

**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.*  
Hilary Ware, *Netflix, Inc.*

3:30 P.M.

0.75 HR

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

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

**Moderator:**

Robert D. Fram, *Covington & Burling LLP*

**Panelists:**

Ann Armstrong, *Intel Corporation*  
Matt Lynde, *Cornerstone Research*  
Luke McLeroy, *Ericsson*

4:15 P.M.

1.00 HR

**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:**

Katherine Lutton, *Fish & Richardson P.C.*

**Panelists:**

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

5:15 P.M.

CLOSING REMARKS

**PRESIDING OFFICER:**

SEAN DEBRUINE,  
KILPATRICK TOWNSEND &  
STOCKTON LLP

8:00 A.M. CONFERENCE ROOM OPENS  
+ CONTINENTAL BREAKFAST

BREAKFAST SPONSORED BY :



8:30 A.M.

1.00 HR

**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 Mehta, *Weil, Gotshal & Manges LLP*  
John Vandenberg, *Klarquist Sparkman, LLP*

9:30 A.M.

0.50 HR

**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

10:00 A.M.

15 MINUTE BREAK

10:15 A.M.

0.25 HR

**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*

10:30 A.M.

0.50 HR

**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*

11:00 A.M.

0.75 HR

INCLUDING 0.50 ETHICS

**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 US LLP*  
Douglas Nemec, *Skadden, Arps, Slate, Meagher & Flom LLP & Affiliates*

11:45 A.M.

0.50 ETHICS

**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*

**PRESIDING OFFICER:**

ROBERT BARR,  
BERKELEY CENTER FOR LAW &  
TECHNOLOGY

12:15 P.M. BREAK TO PICK UP LUNCH

**LUNCH SPONSORED BY:**

12:30 P.M.

0.75 HR

**LUNCH KEYNOTE:**

**EUROPEAN PATENT LAW:  
COMMENTARY ON CURRENT  
TRENDS; STRATEGIES FOR A  
UNIFIED FUTURE**

With the Unitary Patent system coming ever closer, yet no date or fees known, European patent specialists Gwilym Roberts (prosecution) and Daniel Brook (litigation) speculate and strategize on best steps now and in the short to medium term. Factoring in recent changes across a geographically, legally and culturally diverse region, they present an overview of best practices in Europe for building, bolstering and enforcing your patent portfolio.

Daniel Brook, *Hogan Lovells US LLP*  
Gwilym Roberts, *Kilburn & Strode LLP*

1:15 P.M.

0.50 HR

**FEE SHIFTING AFTER OCTANE  
FITNESS**

After the Supreme Court weighed in on the “exceptional case” standard under Section 285, requests to shift fees at the district court level have exploded. This new landscape, and the emerging trends, will be addressed.

Jared Bobrow, *Weil, Gotshal & Manges LLP*

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 S. Bloch, *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

## Planning Committee

Robert Barr, *CO-CHAIR; Berkeley Center for Law & Technology*

Mark Lemley, *CO-CHAIR; Stanford Law School; Durie Tangri LLP*

Michael Esposito, *CO-CHAIR; Blue Moon Software, Inc.*  
\* \* \*

Steven Baik, *Reed Smith LLP*

Nena Bains, *Kilpatrick Townsend & Stockton LLP*

Bradley D. Baugh, *North Weber & Baugh LLP*

Marta Beckwith, *Aruba Networks, Inc.*

David S. Bloch, *Winston & Strawn LLP*

Jared Bobrow, *Weil, Gotshal & Manges LLP*

Karen Boyd, *Turner Boyd LLP*

Christopher Byrne, *Samsung Electronics Co., Ltd.*

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

Douglas Carsten, *Wilson Sonsini Goodrich & Rosati*

Yar R. Chaikovsky, *McDermott Will & Emery LLP*

Andrew Culbert, *Microsoft Corporation*

James Elacqua, *Skadden, Arps, Slate, Meagher & Flom LLP & Affiliates*

Robert D. Fram, *Covington & Burling LLP*

William S. Galliani, *Cooley LLP*

Robert J. Goldman, *Ropes & Gray LLP*

Julie M. Holloway, *Latham & Watkins LLP*

Richard Hung, *Morrison & Foerster LLP*

Matthias Kamber, *Keker & Van Nest LLP*

Noreen Krall, *Apple Inc.*

Eric R. Lamison, *Cisco Systems, Inc.*

Eric Lancaster, *White & Case LLP*

Dan Lang, *Cisco Systems, Inc.*

Ronald S. Laurie, *Inflexion Point Strategy, LLC*

Louise Lee, *Berkeley Center for Law & Technology*  
Allen Lo, *Google, Inc.*

Katherine Lutton, *Fish & Richardson P.C.*

Christian E. Mammen, *Hogan Lovells US LLP*

David L. McCombs, *Haynes and Boone LLP*

Sonal Mehta, *Weil, Gotshal & Manges LLP*

Christopher J. Palermo, *Hickman Palermo Truong Becker Bingham Wong LLP*

James Pampinella, *Navigant Consulting, Inc.*

Rajiv Patel, *Fenwick & West LLP*

Tim Porter, *Google, Inc.*

Kirupa Pushparaj, *Square, Inc.*

Joshua Raskin, *Greenberg Traurig LLP*

Clement S. Roberts, *Durie Tangri LLP*

David Simon, *Salesforce.com, Inc.*

Lee Van Pelt, *Van Pelt, Yi & James LLP*

Vernon M. Winters, *Sidley Austin LLP*

Mallun Yen, *RPX Corporation*

## LOGISTICS

### CONFERENCE LOCATION:

#### FOUR SEASONS HOTEL SILICON VALLEY

2050 University Avenue  
East Palo Alto, CA 94303

Please call the hotel directly at  
(650) 470-3847 for room reservations  
**by November 10.** Request **APLI SV 2014** when  
making reservations to receive the special room  
rate of **\$289/night.**

#### Parking:

Daily self-parking: complimentary  
Overnight self-parking: \$12  
Valet parking: \$22

### KEY DATES:

#### NOVEMBER 7

Last day for early registration

#### DECEMBER 1

Last day for partial refund

#### DECEMBER 5

Last day to substitute names of attendees

#### DECEMBER 7

Last day for regular registration

#### AFTER DECEMBER 7

Registrations will be accepted at a higher rate  
on a space available basis. Walk-up registrations  
may not be available.

#### DECEMBER 11

Institute begins

### QUESTIONS:

Email: [aplisv@law.berkeley.edu](mailto:aplisv@law.berkeley.edu)  
Phone: **510.642.4712**

# REGISTRATION

### REGISTER ONLINE

Whether you are paying by credit card or check, you must register online. Speakers and Moderators are also required to register online to answer key questions and initial the "authorization to publish."

[www.aplisv.org](http://www.aplisv.org)

### REGISTRATION RATES

Earlybird Registration (by November 7) .....	<b>\$890</b>
Regular Registration (by December 7) .....	<b>\$990</b>
Late Registration (after December 7 on a space available basis).....	<b>\$1200</b>

### GROUP REGISTRATION - DISCOUNTS (REGISTER ONLINE)

- 10% - 5 or more people from the same organization
- 20% - 10 or more people from the same organization

### CANCELLATION POLICY

Full refunds (less \$100 cancellation fee) available for paid registrations cancelled in writing to [aplisv@law.berkeley.edu](mailto:aplisv@law.berkeley.edu) **by December 1.**

No refunds are available after December 1; however, you may substitute a different person by writing to [aplisv@law.berkeley.edu](mailto:aplisv@law.berkeley.edu) **by December 5.**



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