



BERKELEY CENTER FOR
LAW & TECHNOLOGY

Stanford Law School

Stanford Program in
Law, Science & Technology

14TH ANNUAL SILICON VALLEY

ADVANCED PATENT LAW INSTITUTE

DECEMBER 12 & 13, 2013
FOUR SEASONS HOTEL
EAST PALO ALTO, CA

Wi-Fi PIN: APLI



Conference materials will be
made available at aplisv.org

TWEET WITH YOUR FELLOW ATTENDEES USING #APLISV

MAIN SPONSOR

NAVIGANT
CONSULTING

www.navigant.com



INTELLECTUAL PROPERTY LAW
www.hickmanpalermo.com



www.ip-strategy.com



ATTORNEYS AT LAW
www.kilpatricktownsend.com



From Concept to Courtroom®
www.gorlm.com

Earn up to 14.0 Hours of CLE Credit Including 1.75 Hours in Legal Ethics

14TH ANNUAL SILICON VALLEY ADVANCED PATENT LAW INSTITUTE

DECEMBER 12-13, 2013 • FOUR SEASONS HOTEL • EAST PALO ALTO, CA

Earn up to 14.0 Hours of CLE Credit Including 1.75 Hours in Legal Ethics

THURSDAY MORNING, DECEMBER 12, 2013

PRESIDING OFFICER:

ROBERT BARR, BERKELEY CENTER FOR LAW & TECHNOLOGY—BERKELEY, CA

7:30 A.M. REGISTRATION OPENS +

BREAKFAST SPONSORED BY:



From Concept to Courtroom®

8:15 A.M. WELCOMING REMARKS 0.25 HR

8:30 A.M. 0.75 HR

CLAIM CONSTRUCTION AND DE NOVO REVIEW

This session will discuss the pending Federal Circuit *en banc* review in *Lighting Ballast Control v. Philips Electronics*, empirical research on appellate review of claim construction decisions, and ramifications for patent case management.

Julie M. Holloway, Latham & Watkins LLP—
San Francisco, CA

Christian E. Mammen, Hogan Lovells US LLP—
San Francisco, CA

9:15 A.M. 0.75 HR INCLUDING 0.25 ETHICS

POST-GRANT PROCEEDINGS IN THE USPTO: DEVELOPMENTS, ISSUES AND STRATEGIES

Much can be learned from the first year of patent challenge proceedings before the Patent Trial and Appeal Board under the America Invents Act ("AIA"). This panel will discuss successful and not-so-successful examples of strategies used by patent owners and challengers, the challenges of coordinating strategy between PTAB proceedings and co-pending litigation, and up-to-date PTAB statistics. They will also address ethical issues raised by the real party in interest disclosure requirements for inter partes and post grant reviews.

Erika Harmon Arner, Finnegan, Henderson, Farabow, Garrett & Dunner LLP—Reston, VA

Matthew I. Kreeger, Morrison & Foerster LLP—
San Francisco, CA

10:00 A.M. 15 MINUTE BREAK

10:15 A.M. 1.00 HR

PATENTABLE SUBJECT MATTER

Myriad, CLS Bank, Ultramercial, Guidewire: the 101 cases keep coming, but is the law any more clear as a consequence? Where are we headed? Are we developing an industry-specific 101 standard? What is the relationship between 101 and 103? And can thoughtful prosecution strategies avoid the 101 question altogether? This panel will tackle these questions and more.

Moderator:

Daralyn J. Durie, Durie Tangri LLP—San Francisco, CA

Panelists:

Gary Loeb, Counsyl—South San Francisco, CA

Tim Porter, Google, Inc.—Mountain View, CA

11:15 A.M. 1.00 HR

REMEDIES: DEVELOPMENTS IN DAMAGES AND INJUNCTIVE RELIEF

Is injunctive relief appropriate in your case? Lost profits damages? A reasonable royalty? And to what extent do the parties' relationships with third parties bear on the inquiry? The panelists will address cutting edge developments and the most recent decisions in the evolving legal landscape governing damages and injunctions.

Moderator:

Tamara Fraizer, Fish & Richardson P.C.—Redwood City, CA

Panelists:

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

James Pampinella, Navigant Consulting, Inc.—
San Francisco, CA

Bijal Vakil, White & Case LLP—Palo Alto, CA

Siddhartha Venkatesan, Orrick, Herrington & Sutcliffe LLP—
Menlo Park, CA

THURSDAY AFTERNOON, DECEMBER 12, 2013

PRESIDING OFFICER:

NENA BAINS, KILPATRICK TOWNSEND & STOCKTON LLP—MENLO PARK, CA

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

LUNCH SPONSORED BY:



12:30 P.M. 0.75 HR

LUNCHEON PRESENTATION:

UPDATES FROM THE UNITED STATES PATENT & TRADEMARK OFFICE

Michelle Lee, Silicon Valley Director of the United States Patent & Trademark Office (USPTO), will discuss the USPTO's efforts on the White House's initiatives to reduce abusive patent litigation as well as the goals, vision and latest developments on the Silicon Valley USPTO.

Michelle Lee, Director, Silicon Valley U.S. Patent and Trademark Office—Menlo Park, CA

1:15 P.M. 15 MINUTE BREAK

1:30 P.M. 0.75 HR

STANDARD ESSENTIAL PATENTS: RECENT DEVELOPMENTS AND KEY ISSUES

The past year has seen several developments regarding the enforcement of patents that have been declared to be essential to a standard and subject to a commitment to license on fair, reasonable and nondiscriminatory (FRAND) terms. This panel will discuss the first case *Microsoft v. Motorola* that actually determined a FRAND royalty rate, the limited availability of injunctive relief and ITC exclusion orders, and efforts by government regulators to interpret and enforce FRAND commitments.

Renee DuBord Brown, Motorola Mobility LLC—
Sunnyvale, CA

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

2:15 P.M. 0.50 HR

RECENT DECISIONS IN PATENT EXHAUSTION:

BOWMAN, KIRTSAENG AND OTHER DEVELOPMENTS IMPACTING THE EXHAUSTION DOCTRINE

In *Bowman v. Monsanto*, the Supreme Court ruled that "[p]atent exhaustion does not permit a farmer to reproduce patented seeds through planting and harvesting without the patent holder's permission." The impact of the Court's ruling on other cases of patent exhaustion remains to be seen. In *Kirtsaeng v. John Wiley & Sons*, the Supreme Court held that an authorized sale of a copy, occurring anywhere in the world, exhausted the copyright owner's rights in that copy of the work. The Court denied *certiorari* in another case which put the question of international patent exhaustion squarely

before the Court: Whether the initial authorized sale outside the United States of a patented item terminates all patent rights to that item. This panel will consider evolving patent exhaustion arguments following *Bowman, Kirtsaeng* and other developments in the field of patent exhaustion.

Yar R. Chaikovsky, *McDermott Will & Emery—Menlo Park, CA*

Keith L. Slenkovich, *Wilmer Cutler Pickering Hale and Dorr LLP—Palo Alto, CA*

2:45 P.M.

0.75 HR

COORDINATING LITIGATION

The panel will review the impact of the America Invents Act on patent litigation and the new opportunities emerging for both patent owners and challengers. Topics will include overall case management considerations including the economics of case funding; joint defense groups; estoppel, prosecution bar, and related considerations; the latest tactical developments in venue selection and transfer practice; the evolution of Federal Circuit case law favoring defendants; and the interplay between proceedings in the courts and PTAB.

Moderator:

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

Panelists:

Jared Bobrow, *Weil, Gotshal & Manges LLP—Redwood Shores, CA*

Isaac Peterson, *Netflix, Inc.—San Francisco, CA*

3:30 P.M.

15 MINUTE BREAK

3:45 P.M.

0.50 HR

THE RIGHT TO A JURY TRIAL ON VALIDITY

Is there a Seventh Amendment right to have juries decide if patents are valid? We assume the answer is yes, but the support for such a claim is surprisingly weak. What would change if juries didn't decide validity?

Mark Lemley, *Stanford Law School; Durie Tangri LLP—Stanford, CA*

4:15 P.M.

1.00 HR INCLUDING 0.50 ETHICS

JUDGES PANEL: EFFICIENTLY MANAGING PATENT LITIGATION IN A TIME OF FLUX

Patent law is in a state of flux on fundamental issues ranging from the parameters of patentable subject matter to appellate review of bifurcated trials and sanctions for litigation misconduct. This panel of highly-regarded jurists from leading patent jurisdictions will discuss ways to manage patent litigation effectively and efficiently in the face of that flux.

Moderator:

Vernon M. Winters, *Sidley Austin LLP—San Francisco, CA*

Panelists:

The Honorable Yvonne Gonzalez Rogers, *US District Court for the Northern District of CA*

The Honorable Marilyn L. Huff, *US District Court for the Southern District of CA*

The Honorable Jon S. Tigar, *US District Court for the Northern District of CA*

5:15 P.M.

CLOSING REMARKS

FRIDAY MORNING, DECEMBER 13, 2013

PRESIDING OFFICER:

THOMAS J. FRIEL JR., *COOLEY LLP—SAN FRANCISCO, CA*

8:00 A.M.

CONTINENTAL BREAKFAST

8:30 A.M.

0.75 HR

INDIRECT AND DIVIDED INFRINGEMENT

An indirect infringer must know of, or be willfully blind to, its own infringement. How does this standard, articulated by the Supreme Court in 2011, play out in practice? When does evidence of a patent's invalidity defeat indirect infringement? And for those patent claims where more than one actor is necessary to perform all the patented steps, what evidence of intent is required? This panel will discuss the Federal Circuit's decision in *Akamai Techs. v. Limelight Networks* and other recent cases on indirect and divided infringement.

Steven C. Carlson, *Kasowitz, Benson, Torres & Friedman LLP—Redwood Shores, CA*

Alison M. Tucher, *Morrison & Foerster LLP—San Francisco, CA*

9:15 A.M.

15 MINUTE BREAK

9:30 A.M.

0.50 HR

BEST PATENT PROSECUTION PRACTICES FOR DAMAGES AND LICENSING PURPOSES

When evaluating an invitation to license a patent or a patent assertion opportunity, there are salient patent prosecution issues to scrutinize. Patent enforcement perspectives are used to inform a practical discussion of best patent prosecution practices.

William S. Galliani, *Cooley LLP—Palo Alto, CA*

10:00 A.M.

0.50 HR

FUNCTIONAL CLAIMING

This session will discuss strategies for drafting broad claims and how to deal with the issue of functional claiming.

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

10:30 A.M.

0.50 HR ETHICS

SAFEGUARDING CONFIDENTIAL AND PRIVILEGED INFORMATION IN COMPLEX LITIGATION

The ability to store and rapidly transmit vast quantities of information has dramatically altered the landscape of discovery in civil litigation. As a result, the risk that sensitive information will be mishandled in the course of litigation is very real, and the consequences of such mishandling can be grave. This session will survey best practices for protecting confidential and privileged information in discovery, and handling situations in which sensitive information is improperly disclosed.

Douglas R. Nemecek, *Skadden, Arps, Slate, Meagher & Flom LLP—New York, NY*

11:00 A.M.

15 MINUTE BREAK

11:15 A.M.

0.50 HR

PHARMACEUTICAL "REVERSE PAYMENT" PATENT SETTLEMENTS

After fifteen years of government and private litigation regarding "reverse payment" settlements, the Supreme Court weighed in this year in *FTC v. Actavis*. This panel will discuss what it means, not just for pharmaceutical companies, but for all IP owners.

Mark Lemley, *Stanford Law School; Durie Tangri LLP—Stanford, CA*

Seth C. Silber, *Wilson Sonsini Goodrich & Rosati—Washington, DC*

11:45 A.M.

0.50 HR

OBVIOUSNESS: THE RISE, FALL AND RETURN OF OBJECTIVE EVIDENCE

Recent Federal Circuit decisions have indicated a renewed insistence that Courts fairly weigh factors such as commercial success, the failure of others, and other "objective evidence" of non-obviousness or obviousness. This panel will examine the recent case law, and discuss how it affects both the litigation and prosecution environments. We will also consider how the obviousness defense may factor into the new PTO procedures under the AIA.

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

Christopher J. Palermo, *Hickman Palermo Truong Becker Bingham Wong LLP—San Jose, CA*

PRESIDING OFFICER:

DAVID SIMON, SALESFORCE.COM—
SAN FRANCISCO, CA

12:15 P.M.

BREAK TO PICK UP LUNCH

LUNCH SPONSORED BY:

12:30 P.M.

1.00 HR

**LUNCH PRESENTATION:
PATENT REFORM UPDATE**

Despite the recent passage of the America Invents Act after years of debate, both Congress and the White House are again considering patent reform proposals, and several state attorneys general have become active on the patent front. What proposals are gaining traction? A panel of experts will explore legislative proposals, state-level efforts, Presidential and FTC efforts, e-discovery reform, fee shifting and sanctions.

Moderator:

Katherine Kelly Lutton, *Fish & Richardson P.C.*—
Redwood City, CA

Panelists:

David S. Bloch, *Winston & Strawn LLP*—San Francisco, CA
David Jones, *Microsoft Corp.*—Redmond, WA
Brian Love, *Santa Clara University*—Santa Clara, CA
Suzanne Michel, *Google, Inc.*—Mountain View, CA
Matthew D. Powers, *Tensegrity Law Group LLP*—Redwood Shores, CA

1:30 P.M.

15 MINUTE BREAK

1:45 P.M.

0.50 HR ETHICS

NEW PTO CONDUCT RULES

Changes were made in the new PTO ethics rules, effective May 2013. What do patent lawyers need to know about these changes?

John Steele, *Steele Law Firm*—Palo Alto, CA

2:15 P.M.

0.50 HR

**LIFE UNDER THE NEW NOVELTY REGIME:
INTERPRETING SECTION 102—PRIOR ART,
EXCEPTIONS, AND MORE**

The transition this year to "First Inventor to File" represents a fundamental shift in US patent practice. Section 102 of the AIA altered how novelty, the relevant prior art, and the grace period are determined. While the scope of the changes to Section 102 may take years and several cases to help define,

this panel will discuss Section 102, some potential issues, and strategies for helping clients function in this new regime.

Bradley D. Baugh, *North Weber & Baugh LLP*—Palo Alto, CA

Michael W. Farn, *Fenwick & West LLP*—Mountain View, CA

2:45 P.M.

0.75 HR

**THE PATENT MARKETPLACE: TRENDS AND
PERSPECTIVES – AN INTERACTIVE DISCUSSION
AMONG SEASONED DOMAIN EXPERTS**

This panel will discuss the state of the patent marketplace, the data, the players, the business models and the likely near, mid and longer term changes in the ecosystems.

Moderator:

Christopher Byrne, *Samsung Electronics Co., Ltd.*—
San Jose, CA

Panelists:

Dan Lang, *Cisco Systems*—San Jose, CA
Ronald S. Laurie, *Inflexion Point Strategy, LLC*—Palo Alto, CA
Mallun Yen, *RPX Corp.*—San Francisco, CA

3:30 P.M.

CLOSING REMARKS

ABOUT THE COVER:

The drawing featured on the cover of this program is from US Patent Publication No. 20080023917 for the "Hydril Annular Blowout Preventer," a specialized valve used to seal oil and gas wells and control the pressure therein.

Conference Faculty & 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.*

Erika Harmon Arner, *Finnegan Henderson Farabow Garrett & Dunner LLP*

Nena Bains, *Kilpatrick Townsend & Stockton LLP*

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

David S. Bloch*, *Winston & Strawn LLP*

Jared Bobrow*, *Weil, Gotshal & Manges LLP*

Karen Boyd*, *Turner Boyd LLP*

Renee DuBord Brown, *Motorola Mobility LLC*

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

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

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

Daralyn J. Durie*, *Durie Tangri LLP*

Michael W. Farn*, *Fenwick & West LLP*

Tamara Fraizer, *Fish & Richardson P.C.*

Robert D. Fram*, *Covington & Burling LLP*

Thomas J. Friel Jr.*, *Cooley LLP*

William S. Galliani, *Cooley LLP*

Robert J. Goldman*, *Ropes & Gray LLP*

Hon. Yvonne Gonzalez Rogers, *USDC, Northern District of California*

Julie M. Holloway*, *Latham & Watkins LLP*

Hon. Marilyn L. Huff, *USDC, Southern District of California*

Kelly Hunsaker*, *Fish & Richardson P.C.*

David Jones, *Microsoft Corp.*

Matthias Kamber*, *Keker & Van Nest LLP*

Matthew I. Kreeger, *Morrison & Foerster LLP*

Eric R. Lamison*, *Kirkland & Ellis LLP*

Dan Lang, *Cisco Systems*

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

Mike Lee*, *Cisco Systems, Inc.*

Michelle Lee*, *US Patent & Trademark Office*

Gary Loeb, *Counsel*

Brian Love*, *Santa Clara University*

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

Christian E. Mammen*, *Hogan Lovells US LLP*

David L. McCombs*, *Haynes and Boone LLP*

Suzanne Michel, *Google, Inc.*

Nader Mousavi*, *Sullivan & Cromwell LLP*

Douglas R. Nemeck, *Skadden, Arps, Slate, Meagher & Flom LLP*

Vern Norviel*, *Wilson, Sonsini, Goodrich & Rosati*

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

James Pampinella, *Navigant Consulting, Inc.*

Rajiv Patel*, *Fenwick & West LLP*

Isaac Peterson, *Netflix, Inc.*

Tim Pham*, *Google, Inc.*

Tim Porter, *Google, Inc.*

Matthew D. Powers, *Tensegrity Law Group LLP*

Seth C. Silber, *Wilson Sonsini Goodrich & Rosati*

David Simon*, *Salesforce.com, Inc.*

Keith L. Slenkovich*, *Wilmer Cutler Pickering Hale and Dorr LLP*

John Steele, *Steele Law Firm*

Andrew N. Thomases*, *Ropes & Gray LLP*

Hon. Jon S. Tigar, *USDC, Northern District of California*

Alison M. Tucher*, *Morrison & Foerster LLP*

Bijal Vakil*, *White & Case LLP*

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

Siddhartha Venkatesan*, *Orrick, Herrington & Sutcliffe LLP*

Glenn Westreich*, *Haynes and Boone LLP*

Vernon M. Winters*, *Sidley Austin LLP*

Michelle Yang*, *Samsung Electronics Co., Ltd.*

Mallun Yen*, *RPX Corp.*

* Planning Committee