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UC Berkeley School of Law certifies that this activity has been approved for 13.75 hours Continuing Legal Education credit, including 1.0 hour in Legal Ethics and 1.0 hour in Elimination of Bias, by the State Bar of California.

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16TH ANNUAL SILICON VALLEY ADVANCED PATENT LAW INSTITUTE

DECEMBER 10-11, 2015 • FOUR SEASONS HOTEL • EAST PALO ALTO, CA

UC Berkeley School of Law certifies that this activity has been approved for 13.75 hours Continuing Legal Education credit, including 1.0 hour in Legal Ethics and 1.0 hour in Elimination of Bias, by the State Bar of California.

THURSDAY MORNING, DECEMBER 10, 2015

PRESIDING OFFICER:

ROBERT J. GOLDMAN, ROPES & GRAY LLP

7:30 A.M. REGISTRATION OPENS +
CONTINENTAL BREAKFAST

BREAKFAST SPONSORED BY:



8:20 A.M. WELCOMING REMARKS

8:30 A.M. 0.50 HR

PATENT REFORM

Over the last few years, state and federal lawmakers have been engaged in discussing, investigating, drafting, advancing, and, at the state level, enacting reforms aimed at curbing patent litigation abuses. This opening panel will discuss where reform has advanced and stalled, and what to expect in the coming year.

Colleen Chien, Santa Clara Law School

9:00 A.M. 1.50 HR

NAVIGATING, LITIGATING AND EVEN AVOIDING ELIGIBLE SUBJECT MATTER QUESTIONS

Eighteen months after *Alice* and *Mayo*, both their progeny and USPTO policy have changed the landscape of patent-eligible subject matter. What trends and tensions exist in the current Federal Circuit law? How are litigators managing eligibility disputes at the district court level, particularly in light of different rules and outcomes in different venues? How are prosecutors responding to the changes? This panel will explore these issues, over the lifecycle of a patent.

Moderator:

Vernon M. Winters, Sidley Austin LLP

Panelists:

John Dragseth, Fish & Richardson

Heidi Keefe, Cooley LLP

Peter Menell, UC Berkeley School of Law, BCLT

Christopher J. Palermo, Hickman Palermo

Becker Bingham LLP

10:30 A.M. 15 MINUTE BREAK

10:45 A.M. 0.75 HR

DRAFTING AND ATTACKING PLEADINGS UNDER THE NEW STANDARDS

Leading patent litigators will debate such questions as:

- How will the new pleading standards impact pre-filing investigations and initial preparation for all cases?
- With Form 18 (nearly) gone, what must be included in a patent infringement complaint?
- Do *Alice* and its progeny impact how you should draft a complaint?
- What are the pleading standards for affirmative defenses?
- What is the procedure to attack a claim or defense as insufficiently pled?
- Will the amendments to the Federal Rules limit discovery into possible or proposed claims or defenses?
- Will forum selection be more important than ever?

Yar R. Chaikovsky, Paul Hastings LLP

Richard S. J. Hung, Morrison & Foerster LLP

Christian E. Mammen, Hogan Lovells LLP

11:30 A.M. 0.50 HR

ASSET PROTECTION IN A CHANGING ENVIRONMENT

Given recent developments, what are the pros and cons of patent vs. copyright vs. trade secrets in the protection of an IP portfolio? Does the answer differ depending on whether you are protecting innovations in software, the life sciences, or other fields? What can you do in the creation of your assets to ensure that they survive the test of time and changing law?

David Simon, Salesforce

THURSDAY AFTERNOON, DECEMBER 10, 2015

PRESIDING OFFICER:

GWILYM ROBERTS,
KILBURN & STRODE LLP

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

LUNCH SPONSORED BY:



**HICKMAN PALERMO
BECKER BINGHAM** LLP

INTELLECTUAL PROPERTY LAW

12:30 P.M. 0.50 HR

LUNCH KEYNOTE:

THE RT. HON. PROFESSOR SIR
ROBIN JACOB:

THE FUTURE OF IP LITIGATION
IN EUROPE WITH THE (LIKELY)
COMING OF THE UNIFIED PATENT
COURT

Sir Robin, a retired Lord Justice of the Court of Appeal and Professor of IP law at University College London, is widely regarded as one of the UK's, and Europe's, leading intellectual property judges of recent times. He will discuss the creation of the court, its procedures, judge selection, forum shopping, speed, cost, and why he thinks it might work.

1:00 P.M. 15 MINUTE BREAK

1:15 P.M. 0.50 HR

COMPARATIVE PATENT LITIGATION: GERMANY VERSUS THE UNITED STATES

Germany has become a popular choice for patentees seeking a venue for patent litigation outside the United States. This panel will explore some of the major differences between United States and German patent litigation, with an emphasis on what attorneys and clients from each jurisdiction often find surprising about the other.

Lisa Buccino, SAP

Eugene M. Paige, Kecker & Van Nest LLP

Brad Waugh, Intel

1:45 P.M.

0.50 HR

JOINT, DIVIDED, AND INDIRECT INFRINGEMENT

When there's no direct infringer, what remedies remain? Steve Carlson will discuss the Supreme Court's *Commil* ruling, governing mental state for inducement, and the Federal Circuit's *en banc* ruling in *Suprema*, governing ITC enforcement of indirect infringement claims, among the other recent twists in this important topic.

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

2:15 P.M. 1.00 HR BIAS ELIMINATION

ETHICS: BLOCKING BIAS

Shelley Correll will describe her groundbreaking research into redesigning workplace structures and practices to be simultaneously more inclusive and more innovative and will then discuss, with a panel of tech industry insiders, individual strategies and organizational solutions for minimizing gender bias.

Shelley J. Correll, *The Clayman Institute for Gender Research at Stanford University*

Panelists:

Mitchell Gaynor, *Juniper Networks*
Deanna Kwong, *Hewlett-Packard*
Karen Robinson, *Adobe Systems*

3:15 P.M.

15 MINUTE BREAK

3:30 P.M.

0.50 HR

CLAIM CONSTRUCTION POST-TEVA

This session will examine the impact of the Supreme Court's *Teva* decision on claim construction and will address what attorneys can do to exploit *Teva*. It will also examine whether district court judges have changed their approach to claim construction as a result of *Teva*. It will consider the significance of the PTO's continued application of the broadest reasonable interpretation (BRI) standard in PTAB proceedings.

Edward R. Reines, *Weil, Gotshal & Manges LLP*

4:00 P.M.

1.00 HR

JUDGES PANEL

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

Moderator:

Karen I. Boyd, *Turner Boyd LLP*

Panelists:

Hon. Richard G. Andrews, *US District Court, District of Delaware*
Hon. James Donato, *US District Court, Northern District of California*
Hon. Rebecca R. Pallmeyer, *US District Court, Northern District of Illinois*
Hon. Robert W. Schroeder III, *US District Court, Eastern District of Texas [tentative]*

5:00 P.M.

CLOSING REMARKS

FRIDAY MORNING, DECEMBER 11, 2015

PRESIDING OFFICER:

DAVID S. BLOCH,
WINSTON & STRAWN LLP

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

BREAKFAST SPONSORED BY :



8:30 A.M.

1.50 HR

THE RISE OF PTAB: HOT TOPICS AND STRATEGIES

The current status and hot issues affecting proceedings before the PTAB will be discussed from a variety of viewpoints. Topics to be addressed include trends in PTAB proceedings, recent Federal Circuit decisions and the proposed new rules, with a discussion of how these developments are affecting AIA trials and patent litigation strategy.

Moderator:

Sean DeBruine, *Kilpatrick Townsend & Stockton LLP*

Panelists:

Eric Lamison, *Cisco Systems, Inc.*
David O'Brien, *Haynes and Boone, LLP*
Terry Rea, *Crowell & Moring LLP*

10:00 A.M.

0.50 HR

NEW PTO PILOT PROGRAMS

This session will review the status of pilot programs launched by the Patent and Trademark Office to improve procedures – and patent quality – including the first action interview program, the glossary initiative, and the expedited patent appeal pilot (enabling an appellant to secure expedited review of one pending *ex parte* appeal in exchange for another pending *ex parte* appeal).

US PTO Representative TBA

10:30 A.M.

15 MINUTE BREAK

10:45 A.M.

0.75 HR

PROSECUTION: FUNCTIONAL CLAIMING

What is the problem with functional claims? What is a functional claim? Do I want to write one? Have I written one whether I want to or not? And if I have, what happens?

Mark Lemley, *Stanford Law School*; *Durie Tangri LLP*
Lee Van Pelt, *Van Pelt, Yi & James LLP*

11:30 A.M.

0.50 HR

112 IMPLICATIONS FOR GENUS CLAIMS

This session will consider, from a litigator's perspective, challenges to meeting the written description and enablement requirements of Section 112, in the life sciences and beyond.

Bhanu Sadasivan, *McDermott Will & Emery*

12:00 P.M.

0.50 ETHICS

ETHICS: INFORMATION FLOW IN PATENT LITIGATION — ETHICAL CONSIDERATIONS, PROSECUTION BARS, ACQUISITION BARS AND PROTECTIVE ORDERS

This session takes a pragmatic look at how to balance ethical considerations regarding information flows in patent litigation. How do parties reasonably share confidential information with adversaries? What limitations are placed on litigation and prosecution counsel? How can litigation counsel share with competitor's counsel in the context of joint defense? The answers lie in carefully crafted patent prosecution bars, patent acquisition bars and protective orders, and careful party-by-party management of disclosures.

Gabriel M. Ramsey, *Orrick, Herrington & Sutcliffe LLP*

PRESIDING OFFICER:
RONALD S. LAURIE,
INFLEXION POINT STRATEGY, LLC

12:30 P.M. NETWORKING LUNCH

NETWORKING LUNCH SPONSORED BY:



1:15 P.M. 0.50 HR ETHICS

ETHICS: FEE SHIFTING

A look at the implications of post-*Octane* fee shifting on the attorney-client relationship.

Clement S. Roberts, *Durie Tangri LLP*

1:45 P.M. 0.75 HR

ANTITRUST AND LICENSING ISSUES

This session will examine issues at the intersection of patent and antitrust law. It will examine the challenges of FRAND licensing for standards essential patents, the impact of the IEEE's revised patent policy, and the implications of the Supreme Court's decision earlier this year in *Kimble v. Marvel*. Finally, it will consider the emergence of China as an important arena for FRAND-related antitrust enforcement and litigation.

Robert D. Fram, *Covington & Burling LLP*
David Killough, *Microsoft Corp.*
Scott Sher, *Wilson Sonsini Goodrich & Rosati*

2:30 P.M. 15 MINUTE BREAK

2:45 P.M. 0.50 HR

PATENT PORTFOLIO MANAGEMENT: CLAIM DRAFTING AND PROSECUTION STRATEGIES IN UNCERTAIN TIMES

This session will explore strategies for claim drafting, prosecution and overall patent portfolio management in view of uncertainties introduced by the Supreme Court *Alice* decision, decisions from the Federal Circuit and Patent Trial and Appeal Board, and new guidelines from the U.S. Patent and Trademark Office.

Douglas Luftman, *NetApp*
Rajiv Patel, *Fenwick & West LLP*

3:15 P.M. 0.50 HR

CURRENT TRENDS IN PATENT DAMAGES

This session will examine the up-to-the-minute state of patent damages including the impact of the Federal Circuit's recent decision in *Ericsson v. D-Link* and whether it has broader implications for use of the *Georgia-Pacific* factors. Consideration will also be given to the *Lifetech* case, which held that it is possible to "induce yourself" to infringe under Section 271, and the latest on extra-territoriality and damages. The group will also explore trends in joining other claims such as infringement of design patents, trade secret claims and business torts in order to increase current limits on damages.

G. Hopkins Guy, III, *Baker Botts LLP*
Keith Slenkovich, *WilmerHale*

3:45 P.M. 0.50 HR

TRANSBORDER ISSUES AND EXHAUSTION

This session will examine infringement of articles made and sold outside the United States in the wake of *Carnegie Mellon v. Marvel*. It will describe how to develop manufacturing and distribution strategy to minimize patent exposure.

Sasha Rao, *Maynard Cooper & Gale*

4:15 P.M. CLOSING REMARKS

Planning Committee

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

James Dempsey, *CO-CHAIR; Berkeley Center for Law & Technology*

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

Robert Barr, *Berkeley Center for Law & Technology (retired)*

David S. Bloch, *Winston & Strawn LLP*

Mehrnaz Boroumand Smith, *Kilpatrick Townsend & Stockton LLP*

Karen I. Boyd, *Turner Boyd LLP*

Christopher Byrne, *Samsung*

Yar R. Chaikovsky, *Paul Hastings LLP*

Colleen Chien, *Santa Clara Law School*

Sean DeBruine, *Kilpatrick Townsend & Stockton LLP*

John M. Farrell, *Fish & Richardson*

Robert D. Fram, *Covington & Burling LLP*

Robert J. Goldman, *Ropes & Gray LLP*

Sarah Guichard, *RPX Corp.*

G. Hopkins Guy, III, *Baker Botts LLP*

Elaine Heal, *North Weber & Baugh LLP*

Richard S. J. Hung, *Morrison & Foerster LLP*

Heidi Keefe, *Cooley LLP*

David Killough, *Microsoft Corp.*

Deanna Kwong, *Hewlett-Packard*

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

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

Louise Lee, *Berkeley Center for Law & Technology*

Gary Loeb, *Counsyl*

Christian E. Mammen, *Hogan Lovells LLP*

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

Peter Menell, *UC Berkeley School of Law, BCLT*

Suzanne Michel, *Google Inc.*

Veronica Nauts, *Kasowitz Benson Torres & Friedman LLP*

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

Rajiv Patel, *Fenwick & West LLP*

Greg Pinsonneault, *LitiNomics, Inc.*

Ashok Ramani, *Keker & Van Nest LLP*

Gabriel M. Ramsey, *Orrick, Herrington & Sutcliffe LLP*

Sasha Rao, *Maynard Cooper & Gale*

Terry Rea, *Crowell & Moring LLP*

Edward R. Reines, *Weil, Gotshal & Manges LLP*

Clement S. Roberts, *Durie Tangri LLP*

Gwilym Roberts, *Kilburn & Strode LLP*

Bhanu Sadasivan, *McDermott Will & Emery*

Jeannine Yoo Sano, *White & Case LLP*

David Simon, *Salesforce*

Maya Skubatch, *Wilson Sonsini Goodrich & Rosati*

Keith Slenkovich, *WilmerHale*

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

Vernon M. Winters, *Sidley Austin LLP*

LOGISTICS

CONFERENCE LOCATION:

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(650) 470-3847 for room reservations
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Parking:

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

KEY DATES:

NOVEMBER 6

Last day for early registration

DECEMBER 1

Last day for partial refund

DECEMBER 4

Last day to substitute names of attendees

DECEMBER 6

Last day for regular registration

AFTER DECEMBER 6

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

DECEMBER 10

Institute begins

QUESTIONS:

Email: 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 scheduling questions and initial the "authorization to publish" your slides and the audio recordings of the event.

www.aplisv.org

REGISTRATION RATES

Earlybird Registration (by November 6)	\$890
Regular Registration (by December 6)	\$990
Late Registration (after December 6 on a space available basis).....	\$1200

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 **by December 1.**

No refunds are available after December 1; however, you may substitute a different person by writing to aplisv@law.berkeley.edu **by December 4.**



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