

Patent Strategies

Hot Issues in Intellectual Property Law 2006

March 28-30, 2006 • Digital Sandbox Network Event Center • New York, NY

Judicial Perspectives From:



Honorable
Garrett E. Brown Jr.
CHIEF JUDGE (NJ)



Honorable
**Kathleen
McDonald O'Malley**
U.S. DISTRICT JUDGE (N.D. OH)

Honorable
Liam O'Grady
U.S. MAGISTRATE
JUDGE (VA)



Honorable
T. John Ward
U.S. DISTRICT COURT
MARSHALL DIVISION (TX)

Government and Regulatory Perspective From:



Lynn Levine
Director, Office of Unfair
Import Investigations
**U.S. INTERNATIONAL TRADE
COMMISSION**



Lore Unt
Council for Intellectual
Property
FEDERAL TRADE COMMISSION



Stephen Kunin
Former Deputy Commissioner
**U.S. PATENT AND TRADEMARK
OFFICE**

Topics include:

- Judges' Panels: Opinions of counsel after Knorr Bremse v. Dana, Perspective from the Court, Claims Construction after Philips
- Business method patents
- Implications of new patent decisions and patent cases
- Maximizing your success with the examiner
- Patent Troll versus Infringer debate
- Creative I.P. pre-litigation strategies
- Getting buy in from business people and management
- Hot topics in the patent-antitrust interface
- Patent outsourcing and offshoring
- Controlling costs in patent management and litigation
- Generating licensing revenue
- Section 337 Investigations

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Dear Executive:

Patents are a critical corporate asset and integral to long term corporate success. IQPC is pleased to announce Patent Strategies: Hot Issues in Intellectual Property Law, which covers exactly what you need to know, when you need to know it. We will look at real world solutions and practical intellectual property strategies in a changing and challenging environment.

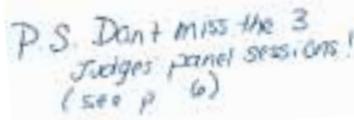
IQPC has assembled some of the very best people in the country - all under one roof, all at the same time. Judges, Government & Regulatory Experts, 15 in-house corporate speakers, and preeminent legal experts will provide lessons learned and strategies for success in 2006 and beyond.

I look forward to seeing you in New York.

Sincerely,



Lisa Schulman, Team Leader
LegalIQ, a division of the IQPC



ABOUT THE ORGANIZER

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a division of IQPC

IQPC
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Legal IQ, a division of **IQPC**, is dedicated to providing practical, detailed information through educational conferences held at the national level. International Quality & Productivity Center (www.iqpc.com) provides millions of business executives with tailored practical conferences, keeping them up-to-date with industry trends, technological developments and the regulatory landscape. Last year alone, IQPC produced more than 1,200 events. And, we continue to grow. Founded in 1973, IQPC now has offices across five continents around the world.

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Legal IQ is looking to expand its course offerings. Do YOU have an interesting "story to tell" or a "hot" conference topic idea? If so, please send a short e-mail to Lisa.Schulman@iqpc.com.

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INTERACTIVE PRE-CONFERENCE WORKSHOPS • TUESDAY, MARCH 28, 2006

A 8:15am - 12:00pm (8:00am Continental Breakfast and Registration)

Document Management & E Discovery Issues For Patent Portfolio Management

More than 99% of information is now being created and stored electronically. The millions of e-mail messages and other electronic communications that flow through your company could be ticking time bombs. As judges are becoming more familiar with technology and dealing with the unique issues involved in conducting discovery matters electronically, courts are becoming less tolerant of law firms and corporations who are unprepared. The risks of devastating sanctions and adverse inference

instructions increase substantially if counsel and clients are not aware of their obligations in the electronic world in which we live. Companies must take proactive approaches now to minimize the risks of E Discovery later. This interactive workshop will provide strategic and cost-effective document production strategies and document retention best practices specific to your Intellectual Property practice.

Key topics for discussion will include:

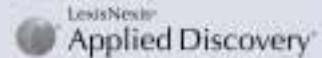
Preservation duties, spoliation sanctions, risk

management, litigation hold, technology challenges, implications of recent case law, international issues, e discovery ethical issues, impact of Federal Rules, and quality standards and metrics.

Find out how to proactively manage documents and minimize risks!

Please visit our website www.iqpc.com for more information about the workshop content and leaders.

Presented by LexisNexis® Applied Discovery® (www.lexisnexis.com/applieddiscovery)



B 1:00pm-4:30 pm (12:45pm Workshop Registration)

The Implications Of New Patent Decisions And Pending Cases

This workshop will provide an intensive review of new patent decisions and pending cases, including: Philips, Lundgren, RIM, Metabolite and EBay. We will examine the developments in the law, as well as policy changes, which affect the day-to-day practice of IP lawyers and the

expectations of their clients. We will also consider the practical affect of those cases in a variety of contexts, such as drafting patents, building patent portfolios, deciding whether to sue, developing settlement strategies, and assessing the likelihood of appellate success.

We will analyze:

- The new rules for patentable subject matter
- The evolving standards of claim construction, including the uses of specifications, file histories and dictionaries
- The current state of injunction cases
- Key appellate issues

WORKSHOP LEADERS

Andrew Cadel
Managing Director
JPMORGAN CHASE & CO.

Charles M. Fish, Esq.
Vice President & Chief
Patent Counsel
TIMEWARNER



Paul R. Gupta
Partner
MAYER, BROWN
ROWE & MAW LLP



Erik Oliver, Esq.
Chief IP Litigation Counsel
SYNOPSIS, INC

7:30 Breakfast and Registration

8:00 Chairperson's Opening Remarks

8:10 Business Method Patents

A business method patent as the name implies is a patent related in some way to a method of doing business. As the Internet and other advanced technologies evolved in the 1990's, new business models and methods of doing business became very important in the competitive marketplace. To protect such important assets, businesses began to look to patents for protection. In 1998, the U.S. Court of Appeals for the Federal Circuit opened up the gates to business method patents in *State Street Bank & Trust Co. v. Signal Financial Group, Inc.*, a case involving a method of calculating the net asset of mutual funds. Since then, businesses in every industry have become aggressive in protecting their new business methods. In the payments industry, for example, patents have been filed and granted involving new methods of making payments involving electronic commerce, mobile commerce, and smart card commerce (using both contact and contactless smart cards). Areas for discussion include:

- What constitutes a business method patent
- The challenges of finding prior art
- Legal requirements for getting a business method patent
- Current Patent and Trademark Office handling of business method patents
- Strategies for prosecuting business method patents

Leonardo Renna

Vice President and Senior Counsel

MASTERCARD INTERNATIONAL

9:00 Patents And Prior Art As High Velocity: New Tools To Solve Old Problems

- New repositories of information
- New tools and resources for organizing and accessing references and other prior art
- New means for collaborating to combat invalid patents

Catherine Lacavera

Patent Counsel

GOOGLE

9:45 Mid-Morning Refreshments

10:10 What You Need To Know About New Patent Decisions And Pending Cases

This session will look at new patent decisions and pending cases, including: Philips, Lundgren, RIM, Metabolite and eBay.

- Patentable subject matter
- Claim construction
- Injunctions
- Appellate issues

Andrew Cadel, Managing Director

JPMORGAN CHASE & CO.

Charles M. Fish, Esq.

Vice President & Chief Patent Counsel

TIMEWARNER

Paul R. Gupta, Partner

MAYER, BROWN, ROWE & MAW LLP

Erik Oliver, Esq., Chief IP Litigation Counsel

SYNOPSIS, INC

11:05 Patent Troll Versus An Infringer - Where Is The Happy Medium

What is a Patent Troll or is it just a way to bash intellectual property owners that stand up for their rights [don't have the recourses to enforce their own patents?]

- Does the Constitution or the law limit patent enforcement to only those that make products?
- Is the real problem bad enforcers, or bad patents – Could the patent system be improved if Congress didn't divert hundreds of millions of dollars in Patent Office fees?
- What can corporations do about patent speculators?
- Is it fair for big companies to collect millions in IP royalties and deny the small inventor the same rights?
- Where does the balance lie – the right to enforce versus the right to be free from the expense of frivolous claims?
- Where is the individual inventor or small company left given the enormous expense of patent enforcement.
- Is the Supreme Court's review of eBay's case going to be another Festo or another Fiasco?
- Is pending Patent Reform Act of 2005 going save us? What changes in the law can be made to make the system more fair for everyone?

PANEL MODERATOR AND PANELIST:

Raymond P. Niro, Senior Partner

NIRO, SCAVONE, HALLER & NIRO

PANELISTS:

Robert A. Berman

Chief Operating Officer and General Counsel

ACACIA TECHNOLOGIES GROUP

Robert A. Cote

Partner

ORRICK

Dr. Alexander Poltorak

Chairman & CEO

GENERAL PATENT CORPORATION

12:05 Luncheon for Delegates and Speakers

Special Luncheon Address: Maximizing Your Success With The Examiner – Achieving Both Your Client's And Examiner's Objectives

This insightful session will provide practical tips on how to maximize your success with the examiner through the preparation of a high quality patent application. It will cover how to satisfy the client's interests while helping the USPTO achieve its mission of promptly issuing valid patents.



Stephen G. Kunin, Senior Counsel

OBLON SPIVAK MCCLELLAND MAIER & NEUSTADT P.C.

Former Deputy Commissioner for Patent Examination Policy

U.S. PATENT & TRADEMARK OFFICE

1:05 Patent Reform on the Horizon

The year 2005 witnessed the emergence of a consensus for serious patent reform among divergent stakeholders in the U.S. patent community. Congress responded with a draft bill that presages the

most far-reaching changes in patent law since the Patent Act of 1952. That bill has since seen markups by Congress and several divergent interest groups. Congress appears poised to enact sweeping reforms that will affect a broad swath of patent practice. The question is which reforms will make it into the final bill and which interest groups will prevail in the debate. The panel will discuss the current version of the amendments and the competing interests seeking to influence the direction of reform. Included in the discussion will be:

- Movement toward harmonization, including first-to-file, continuation practice, best mode, and redefinition of prior art
- Improvements to patent quality, including post-grant opposition and third party participation in prosecution
- Direction of litigation reform, including changes to standards governing willfulness, inequitable conduct, damage calculations, and venue
- Proposed and extremely controversial changes to the injunction standard and the Supreme Court's appropriation of the issue in *eBay v. Mercexchange*, cert granted, (Nov. 28, 2005)
- Obviousness reform – ignored by Congress despite recommendation in FTC report to tighten standard – will the Supreme Court accept certiorari in *KSR International v. Teleflex*, currently awaiting Solicitor General's views and if it does, what are the Court's options.

Wayne P. Sobon

**Associate General Counsel, Director of Intellectual Property
ACCENTURE**

Board Member

AMERICAN INTELLECTUAL PROPERTY ASSOCIATION (AIPLA)

Daniel Ravicher, Executive Director

PUBLIC PATENT FOUNDATION

Alan J. Ross, Partner

BRICKER & ECKLER LLP

Brian Way, Senior Patent Counsel

APPLE COMPUTER

2:05 Creative I.P. Litigation Strategies – Winning Before The Race Begins

Smart companies can implement creative intellectual property strategies that will assist them in winning litigation before it has begun. Pre-litigation strategies beginning with effectively filing applications for intellectual property, recording intellectual property with Customs, analyzing competitive litigation and patents, and obtaining proper opinions of counsel can place a corporation in a strong position regarding future litigation. In addition, techniques such as requesting reexamination, filing a protest or opposition, or submitting prior art can alter the landscape of prospective or pending litigation in favor of the proactive party. During litigation, requesting removal of products, limiting initial discovery to Markman issues, and using current litigation to create future design-arounds are techniques that can turn the tables on a competitor. Each of these creative litigation strategies and more will be detailed during this discussion.

- Pre-litigation resolution approach
- Ethics, issues and pre-litigation efforts needed to undertake to

- make sure your case is strong both offensively and defensively
- What you would do during litigation

Joseph J. Berghammer, Partner

BANNER & WITCOFF, LTD.

Adjunct Professor in IP Litigation

NORTHWESTERN UNIVERSITY SCHOOL OF LAW

Buckmaster De Wolf

Senior Counsel Litigation & Legal Policy

GENERAL ELECTRIC COMPANY

Steven Steger, Chief Intellectual Property Counsel

BRUNSWICK CORPORATION

3:05 Mid-Afternoon Refreshments

3:30 How To Set Up A Patent Review Board

It is not always easy to get business people interested and involved in determining the value of particular invention disclosures and patents within a patent portfolio. However, it is essential to the success of a patent program to have business people involved in making such determinations in order to direct your patent dollars and other resources effectively and efficiently. Gathering a group of diverse interests that represent different aspects of the organization to review which invention should be protected by patents can make the difference between a good portfolio and a great one. This insightful presentation will address how to set up a patent review committee.

- Benefits of an internal patent review board
- Who the players should be
- How often should you meet?
- Grouping disclosures by a particular technology and scoring each of the disclosures
- Criteria to use to score disclosures and how to determine when to file a patent
- When to file a patent in a foreign country
- How to select in which foreign countries to file
- When to use trade secret protection rather than patent protection
- Assorted other useful tips on how to mine and make decisions regarding protection

Find out how the patent review boards assist with determining which inventions to patent, setting strategies for licensing products to competitors and infringers, while taking the guess work out of patenting and licensing.

Bruce Greenhaus, Vice President, Patent Counsel

QUALCOMM INCORPORATED

Adjunct Professor with THOMAS JEFFERSON SCHOOL OF LAW

4:20 Emerging Issues And Hot Topics In The Patent-Antitrust Interface

Overview of common and emerging antitrust claims and counterclaims related to patent litigation

- Walker Process claims
- Successfully distinguishing between inequitable conduct and Walker Process claims
- Defining and proving market power
- Bad faith litigation
- Standards for Handguards-type claims
- Standard-setting cases

- Rambus, Unocal: what standards govern misrepresentations or omissions to a standard-setting body concerning patent rights?
- Pharmaceutical patent litigation settlement cases
- What is the current status of the cases in this fast-developing area?
- Recent developments in antitrust and misuse law relating to patent licensing and tying
- Independent Ink and Philips

Lore Unt

Counsel for Intellectual Property

Office of Policy and Coordination

FEDERAL TRADE COMMISSION

5:10 Case Study: From Garage To Successful Company - Lessons And Insights From Development And Enforcement Of A Patent Portfolio

Starting in 1992 with two inventors working out of a garage, TARGUS Information Corp. (TARGUSinfo) has grown into a successful real-time data services company that adds intelligence

to over one billion telephone call transactions annually. The technology developed by TARGUSinfo has resulted in over fifteen issued U.S. patents, with more in the queue. Many of these patents have been extensively licensed and litigated through Murex Licensing Corporation (MLC), an affiliate of TARGUSinfo. Mike Barry, formerly patent counsel for Samsung Electronics, is TARGUSinfo's General Counsel and MLC's Patent Counsel, and he will share some lessons and insights from this case study in the acquisition and enforcement of a patent portfolio.

- How to identify features of valuable patents
- Key issues in setting up a licensing program
- Viewing portfolio management as a long-term investment
- Licensing and litigation – the interface of business and law

Michael M. Barry

General Counsel, TARGUSinfo

and Chief Patent Counsel, MUREX LICENSING

5:50 Day One Concludes

MAIN CONFERENCE • DAY 2 • THURSDAY, MARCH 30, 2006

7:45 Breakfast

8:00 Chairperson's Opening Remarks

8:10 Patent Outsourcing and Offshoring: A Summary of the Issues

Outsourcing of patent work can cut the costs of patent preparation and prosecution, by as much as 80%. This discussion describes the issues raised by offshoring, both pros and cons, including costs, patent quality, export control issues, valuation issues and legal ethics related to offshore-drafted Patent applications. The legal ethics that arise when sending technology and patent work offshore, including privilege and duty of disclosure, are also discussed.

Scott C. Harris

Principal

FISH & RICHARDSON P.C

8:55 Controlling Costs In Patent Management

- Managing costs and patent procurement
- Development of patent strategies to optimize cost of protection for the dollars spent
- Making sure investment is aligned with dollars spent

Steven P. Caltrider

Senior Assistant General Patent Counsel

ELI LILLY AND COMPANY

9:40 Mid-Morning Refreshments

10:05 Selling Patents Into Corporate Culture & Generating Licensing Income

In 2000, Mr. Thomas was hired as American Express' first IP lawyer. His former career as a sports agent provided him with the skill set for selling the idea of patenting IP to his skeptical

business-side colleagues. AMEX's defensive patent filings paid off as the company has successfully fended off lawsuits brought by patent holding companies. To get the business side truly interested in patents, Thomas realized he had to do more than file defensive applications. Find out how Thomas developed a program that would generate licensing income over the long term, which is radical for the financial services industry. By 2003, AMEX produced "tens of millions" of dollars in annual licensing revenue

- Getting buy-in from the business side
- Protecting key or "core" IP
- Taking creative, innovative strategies

Find out how Mr. Thomas, a former Sports Agent, has developed one of the leading patent programs in the financial services industry when it comes to capturing and licensing patented innovations.

Tracey Thomas

Chief IP Counsel

AMERICAN EXPRESS

10:50 Section 337 Investigations: A Mechanism for Redressing Patent Infringement by Imports

The International Trade Commission conducts investigations under 19 U.S.C. § 1337 regarding unfair competition in the import trade. Most of these investigations involve claims of patent infringement where the primary remedy for violations is an exclusion order barring the entry of infringing goods into the U.S. Topics to be discussed will include:

- Elements of a §337 claim
- Complaint requirements and procedures
- The adjudicatory process before the ALJs and the Commission
- §337 remedies

Lynn I. Levine

Director, Office of Unfair Import Investigations

U.S. INTERNATIONAL TRADE COMMISSION

11:40 Opinions Of Counsel After Knorr Bremse V. Dana

A finding of willful patent infringement may lead to award of treble damages. One defense to an allegation of willfulness has been the infringer's reliance on an opinion of counsel. Has the law changed since the Federal Circuit's en banc decision in Knorr-Bremse v.

Dana? This will be an opportunity to listen to the views of judges, an inside corporate attorney and outside counsel. Some topics for discussion include:

- When to consider obtaining an opinion?
- What should in-house counsel consider in retaining opinion counsel?
- What makes for a competent opinion?
- Has Knorr-Bremse changed the way counsel opinions are drafted?
- How should the opinion be handled after it is received?
- Has Knorr-Bremse changed the frequency with which counsel opinions are used in litigation?
- Making the decision to rely on an opinion in litigation.
- How broad is the scope of the waiver of privilege when an opinion is produced?
- Knorr-Bremse, is an opinion necessary?
- In litigation, when should an opinion be produced, phasing of trial to address waiver of privilege and what can be said about unproduced opinions.
- What factors are considered in deciding to award increased damages?

PANEL MODERATOR:

Leif R. Sigmond, Jr.

MCDONNELL BOEHNEN HULBERT & BERGHOFF LLP

PANELISTS

The Honorable Liam O'Grady
MAGISTRATE JUDGE, U.S.

The Honorable Kathleen M. O'Malley
U.S. DISTRICT JUDGE (NORTHERN DISTRICT OHIO)

Mark Abate, Partner
MORGAN & FINNEGAN

Stuart Ford, VP and IP Counsel
W-H ENERGY SERVICES, INC.

12:35 Luncheon for Delegates and Speakers

1:35 Setting Up Formal IP Policies And Awarding Innovation

Along with implementing its aggressive E & P Strategy, Anadarko has changed its technology focus from viewing IP as an ancillary tool for finding oil and gas to recognizing IP as a valuable corporate asset. Find out how IP policies and procedures, as well as an innovator program, were set up at ground zero.

- Establishing policies and procedures to maximize value and minimize liability exposure
- Innovator Program –
- Recognizing engineers and technology staff for innovation and technologies developed
- Exploring whether the company has the right to use this technology
- Protecting valuable ideas

Rebecca McMichael, Senior Counsel
ANADARKO PETROLEUM CORPORATION

2:05 Mid-Afternoon Refreshments

2:25 Judge's Panel: Perspectives From The Court

We have assembled judges from across the country. Here's your chance to ask Judge's for answers to pressing issues in IP cases.

The following is a sample of issues to be addressed:

- Civility – does the conduct of lawyers drive up the cost?
- Local rules and the implications
- Markman hearings – when do you hold it to make it the most cost effective on the one hand and the most efficient for moving your case to deposition on the other
- Should there be a specialized district court for patents?
- Damages and remedies
- E Discovery related issues
- Mistakes not to make

PANEL MODERATOR:

Jonathan Kagan, Partner
IRELL & MANELLA LLP

The Honorable Garrett E. Brown Jr.
CHIEF JUDGE (NJ)

The Honorable Kathleen M. O'Malley
U.S. DISTRICT JUDGE, (NORTHERN DISTRICT OHIO)

The Honorable Liam O'Grady
U.S. MAGISTRATE JUDGE (VA)

The Honorable T. John Ward
U.S. DISTRICT COURT, MARSHALL DIVISION (TX)

3:20 Claim Construction After Philips: How Clear Are The Rules And How Have They Changed?

Did Philips make the rules clearer? Will it reduce the reversal rate of markman decisions in the Federal Circuit? How are district courts and the Federal Circuit deciding claim construction issues after Philips? Are claims getting narrower? These questions and more will be discussed in depth by district judges who wrestle with these difficult issues every day.

PANEL MODERATOR:

Matt Powers
Chair, Global Patent Litigation Group
WEIL GOTSHAL & MANGES

The Honorable Garrett E. Brown Jr.
CHIEF JUDGE (NJ)

The Honorable T. John Ward
U.S. DISTRICT COURT, MARSHALL DIVISION

4:15 Conference Concludes

WHO WILL ATTEND:

This event is designed to appeal to all service and manufacturing companies, as well as law firms and other legal specialists, and vendors/consultants. Specific job functions that should attend include:

- Patent Counsel
- Senior/Chief Patent Counsel
- General Counsel
- Senior Counsel
- IP Counsel
- IP Litigation Counsel
- Director of Intellectual Property
- Associate General Counsel
- Litigation and Legal Policy
- VPs Legal
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 5 min walk

New York Marriott Financial Center:
<http://marriott.com/property/propertypage/NYCWS>
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 7-10 min walk

Hilton Millennium:
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 10 min walk

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