



The Third Annual BNA/ABA Section  
of IP Patent Law Conference:

# Using **TODAY'S** **PATENT LAWS** to Protect **TOMORROW'S** **TECHNOLOGY:** New Litigation Strategies

**October 6, 2008**

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## Changes in patent law

generally occur more slowly than changes in technology. As lawyers, we must continually adapt today's laws to protect tomorrow's technology. However, several Supreme Court and Federal Circuit decisions over the last eighteen months have changed the rules for patent litigation. Successful litigators will need to rethink their strategies regarding:

- *KSR* – Revisited 18 Months Later
- *In re Seagate* – Is Willfulness Alive or Dead?
- Exhaustion of Patent Rights by Licensor in *Quanta v. LG Electronics*
- Use of Reexaminations in Litigation
- Declaratory Judgment Jurisdiction after *MedImmune* and *SanDisk*
- Litigating in Popular Jurisdictions
- Scope of Patent Protection under Section 101—*In re Bilski*

Now, BNA Legal & Business EDge and the American Bar Association's Section of Intellectual Property Law have convened a panel of distinguished experts to discuss litigation strategies in light of the last 18 months of Supreme Court and Federal Circuit decisions. The agenda is packed with ideas and tips to meet the strictures of the new court rulings and to take advantage of the latest approaches used by leading litigators to pursue their cases.

This conference presents an unparalleled opportunity to hear, on one platform, from the best names in patent litigation—including partners in major law firms, general counsel from leading corporations, and other key players.

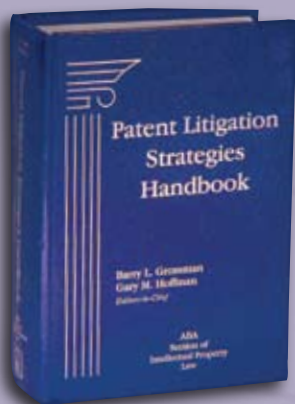
Join your colleagues and this panel of experts to discuss winning litigation strategies in light of the recent court decisions that will most affect you and your clients.

### ALSO OF INTEREST:

## Patent Litigation Strategies Handbook, Second Edition

Barry L. Grossman and Gary M. Hoffman, Editors-in-Chief

ABA Section of Intellectual Property Law



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# USING TODAY'S PATENT LAWS TO PROTECT TOMORROW'S TECHNOLOGY: NEW LITIGATION STRATEGIES

## PROGRAM HIGHLIGHTS

8:00 a.m. – 9:00 a.m.

### REGISTRATION AND CONTINENTAL BREAKFAST

9:00 a.m. – 9:10 a.m.

### INTRODUCTION BY PROGRAM CO-CHAIRS

Gary M. Hoffman, Dickstein Shapiro LLP

Barry L. Grossman, Foley & Lardner LLP

9:10 a.m. – 9:20 a.m.

### COMMENTS FROM THE ABA

9:20 a.m. – 10:10 a.m.

### QUANTA v. LG ELECTRONICS— SURVIVING THE PATENT EXHAUSTION TEST

- *Quanta* is one of the most important patent cases decided by the Supreme Court, yet patent practitioners differ sharply on its effects.
- In the various industries (e.g. electronics, software, chemical and biotech) will any restructuring of existing licenses be necessary as a result of the *Quanta* decision? If so, how do you assess the potential dimensions of that project?
- How will the *Quanta* decision affect the viability of current patent licensing strategies?
- What should a licensee do if a current license does not authorize downstream uses?
- What are the implications for licensing practices in the fields of biotechnology and patent-protected seeds?
- Are contract limitations and breach of contract damages still available even though the patent exhaustion doctrine operates to eliminate patent damages?

Gary M. Hoffman (amicus for IPO)  
Dickstein Shapiro LLP (DC)

Jeffrey I.D. Lewis (amicus for AIPLA)  
Patterson, Belknap, Webb & Tyler LLP

Marian Underweiser (amicus for IBM)  
IBM Corporation

10:10 a.m. – 11:00 a.m.

### USE OF REEXAMINATIONS IN LITIGATION

- The decision to use inter partes reexamination, ex parte reexamination, or no reexamination should be a critical part of your litigation strategy. What are the benefits and liabilities of each?
- What are the factors used by judges in deciding whether or not to grant a stay of litigation when a reexamination is pending? What is the likelihood of obtaining a stay?
- When should you file for reexamination?
- How long will the reexamination process take?
- Review the current results on reexaminations.

Gordon T. Arnold

Arnold & Knobloch, L.L.P.

2008-2009 Chair, ABA Section of Intellectual Property Law

Douglas C. Doskocil

Goodwin Procter LLP

Christopher J. Renk

Banner & Witcoff, Ltd.

11:00 a.m. – 11:15 a.m.

### BREAK

11:15 a.m. – 12:00 p.m.

### DECLARATORY JUDGMENT JURISDICTION AFTER MEDIMMUNE AND SANDISK

- Can you send any safe warning letters?
- Does *MedImmune* fundamentally alter the negotiating positions of licensors and licensees?
- Does a licensee now have an incentive to challenge patents?
- What are the most effective new strategies and clauses for preventing or discouraging a licensee from challenging a license agreement?
- How does *MedImmune* apply in trademark cases?

E. Anthony Figg

Rothwell, Figg, Ernst & Manbeck, P.C.

Teresa Stanek Rea

Crowell & Moring LLP

Jeffrey K. Sherwood

Dickstein Shapiro LLP

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**12:00 p.m. – 1:30 p.m.**

**LUNCHEON**

**KEYNOTE SPEAKER: MARC S. ADLER**

Mr. Adler served as Associate General Counsel & Assistant Secretary for Rohm and Haas, where he was responsible for all intellectual property matters for the worldwide specialty materials company that has had annual sales as high as \$8.2 billion and annual R&D budgets of \$300 million. Mr. Adler managed 25 attorneys in 6 locations in 4 countries, the US, UK, Japan, and Canada.

**1:30 p.m. – 2:45 p.m.**

**LITIGATING IN POPULAR JURISDICTIONS**

- Is Wisconsin the new Texas?
- Does forum-shopping create an unfair situation that needs to be fixed?
- Popular today; unpopular tomorrow—is transfer the solution?
- How pro plaintiff are these jurisdictions?
- What are the advantages/disadvantages of being in the eastern district of Texas?

**Kenneth R. Adamo**, Jones Day

**Eric M. Albritton**, Albritton Law Firm

**Cynthia E. Kernick**, Reed Smith LLP

**Charles F. Schill**, Steptoe & Johnson LLP

**William R. Zimmerman**, Knobbe Martens Olson & Bear LLP

**2:45 p.m. – 3:30 p.m.**

**SCOPE OF PATENT PROTECTION UNDER SECTION 101—  
IN RE BILSKI**

- Should “mental methods” be patentable under Section 101?
- Should there be any limits to patentable subject matter other than abstract ideas, physical phenomena, or principles of nature? What is an “abstract idea”?
- Must software be tied to a computer and cause some physical transformation in order to be patentable?
- How do we determine the kind of “discoveries” that the statute was enacted to protect?
- Will the Federal Circuit be able to resolve the issue or will the Supreme Court be next?

**Daniel A. Boehnen**

McDonnell Boehnen Hulbert & Berghoff, LLP

**Kenneth R. Corsello**, IBM Corporation

**Professor John Fitzgerald Duffy**

George Washington University Law School

**Professor Kali N. Murray**, Marquette University Law School

**3:30 p.m. – 3:45 p.m.**

**BREAK**

**3:45 p.m. – 4:30 p.m.**

**KSR – REVISITED 18 MONTHS LATER**

- What have the courts done in implementing *KSR*?
- Is there a difference between technologies?
- Are simple mechanical inventions patentable under *KSR*?
- Under *KSR*, what are the most effective ways to establish that an invention is not obvious (or is obvious)?

**William P. Atkins**, Pillsbury Winthrop Shaw Pittman LLP

**Jeanne M. Gills**, Foley & Lardner LLP

**Barry L. Grossman**, Foley & Lardner LLP

**4:30 p.m. – 5:30 p.m.**

**IN RE SEAGATE—IS WILLFULNESS ALIVE OR DEAD?**

- What is “objective recklessness”?
- How obvious does a risk have to be to be “so obvious that it should be known”?
- Should you get an opinion of counsel even though there is no affirmative obligation to obtain one?
- Should the patent owner always move for a preliminary injunction to help prove reckless behavior by the alleged infringer?
- Need the patent owner always move for a preliminary injunction to help prove reckless behavior by the alleged infringer?
- Is it willful infringement if the defendant continues to infringe after entry of a judgment?
- Did *Seagate* alter the requirement that the totality of the circumstances must be taken into account when determining whether infringement was willful?

**J. Michael Jakes**, Finnegan, Henderson, Farabow, Garrett & Dunner, LLP

**William J. McCabe**, Ropes & Gray LLP

**James H. Wallace, Jr.**, Wiley Rein LLP

**Mark L. Whitaker**, Howrey LLP

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New Litigation Strategies

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