



BNA'S PATENT LITIGATION STRATEGIES UPDATE

Co-sponsored by the American Bar Association Section of Intellectual Property Law

- How Important New June '06 Supreme Court Actions Impact Strategies and Tactics
- Hear from Federal Judges and Leading Practitioners

September 28, 2006 – Sofitel Hotel, Redwood City, (San Francisco), CA November 16, 2006 – Westin Embassy Row Hotel, Washington, DC

> FREE bonus to registrants: A half-day pre-conference workshop E-Discovery in Patent Litigation: New Rules, New Tools September 27, 2006 – Sofitel Hotel, Redwood City, CA November 15, 2006 – Westin Embassy Row Hotel, Washington, DC

For more than 75 years, BNA has been the recognized leader in providing the most essential and reliable legal and regulatory information and analysis from Washington, D.C. Now, in conjunction with Sandpiper Partners/Stephen and Lynn Glasser, BNA is proud to present authoritative conferences that capitalize on BNA's expertise to give you the EDge you need.





BNA'S PATENT LITIGATION STRATEGIES UPDATE

SHAPING YOUR CASE IN A RAPIDLY CHANGING ENVIRONMENT

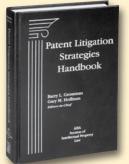
Patent litigation is exploding!

Awards are up, new complexities abound, "best practices" are being reexamined, and counsel is on the spot to devise a winning strategy. The Supreme Court's actions in KSR v. Teleflex and the EBay decision will lead to a sea change in litigation strategies and techniques as practitioners develop practical tactics to deal with the Court's findings. Now is the time to hone your patent trial skills.

The ABA Section of Intellectual Property Law and BNA have teamed up to bring you a timely, comprehensive briefing on all you need to know now to be more successful in resolving these disputes. 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 advocates to pursue their cases. From the changing role of experts to more effective and cost-sensitive pretrial discovery, we'll take you through every stage of the process.

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 for leading corporations, distinguished judges, and a prominent official from the U.S. Patent & Trademark Office. These participants' combined years of experience and success in the field translate into uniquely helpful insights for today's practitioner.

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

The premier source for insights into winning strategies for every stage of the patent litigation process.

This unique legal reference gives you both the "how-to" and the "why-to" of patent litigation, with specific, proven tactics for protecting your clients' interests. Expert litigators give you practical, winning answers to questions like "Why sue in the first place?" "Should you consider ADR instead?" "What are your burdens of proof?" "What types of damages should you seek?" and more. And — most important — this book focuses on resolving legal disputes efficiently, effectively, and professionally. 2005/1,508 pp. Hardcover/Order #1502/\$325.00

Order your copy today.

Call BNA Books at 1-800-960-1220 or go to www.bnabooks.com for more information. ABA IP Section members get a 25% discount.

FREE TO ALL PARTICIPANTS

TIMELY HALF-DAY PRE-CONFERENCE WORKSHOP

E-Discovery in Patent Litigation: New Rules, New Tools

September 27, 2006, Redwood City, CA, 2pm-5pm November 15, 2006, Washington, DC, 2pm-5pm

The new Federal Rules of Civil Procedure covering retention and discovery of electronic evidence, are expected to go into effect on December 1, 2006. Don't miss this opportunity to prepare for these significant changes. Our experts will examine the revisions in the context of patent litigation matters.

Lab notebooks are now often stored on computers, invention disclosures are transmitted by e-mails, engineers working together share their thoughts through e-mails, manufacturing records and reports are computerized, etc. How do you obtain access to this vast array of information and do so in a cost effective manner? What can you seek and how do you do it?

Among the issues to be discussed are:

- How to develop and implement a discovery and response plan under the new rules
- Preparing disclosures under Rules 26(a)(1), 30(b)(6) computer records depositions, 26(f) and 16(b) conferences
- Discovery of extensive e-mails between Research
 & Development and Manufacturing Groups
- Discovery requests and responses that maximize the new rules, from the sides of both patent owner and accused infringer
- Protocols for the production and retention of electronic information
- How and why one conducts on-site inspections of computer systems
- Privilege and confidentiality issue
- Rule 37 sanctions and cost shifting
- Spoliation prevention

Key questions answered include:

- When a suit is filed or served, do you know the three e-mails that in-house counsel should now send to their company's key players?
- After December 1, do you know what to anticipate in discovery requests and responses?

With over 90 billion e-mails sent daily and 90% of all information being kept electronically, this is a workshop you must attend.

Workshop Faculty

Moderator: William P. Atkins – Partner, Pillsbury Winthrop Shaw Pittman LLP, Washington, DC (CA, DC)

Hon. Christopher J. Renk – Partner, Banner & Witcoff, Ltd., Chicago, IL (DC)

Hon. Liam O'Grady – U.S. Magistrate, Eastern District of Virginia, Alexandria, VA (DC)

Sharon D. Nelson – President, Sensei Enterprises, Inc., Fairfax, VA (DC)

Mark D. Samuels – Partner, O'Melveny & Meyers LLP, Los Angeles, CA (CA)

Craig R. Kaufman – Partner, Orrick, Herrington & Sutcliffe LLP, Menlo Park, CA (CA)

Helen Bergman Moure – Partner, Preston Gates Ellis LLP, Seattle, WA (CA)

Hon. Bernard Zimmerman – U.S. Magistrate Judge, Northern District of California, San Francisco, CA (CA)

BNA'S PATENT

Schedule: 8:45am – 5:15pm — Including Breaks and Lunch

8:00am-8:45am

Registration & Continental Breakfast

8:45am-9:00am

Opening Remarks & Introductions

9:00am-10:00am

Adopting a Theme for Your Case

A patent lawsuit presents complex, specialized, and technical problems, but your goal is clear: you want to win. How do you construct a compelling case?

- Creating a theme that is short and simple
- When should the theme be created
- How to utilize the theme throughout
- How to convey your message in your opening statement and presentation through trial

Joseph M. Lipner – Irell & Manella LLP (CA) Ronald J. Schutz – Robins, Kaplan, Miller & Ciresi LLP (CA)

James H. Wallace, Jr. – Wiley Rein & Fielding LLP (DC) Raphael V. Lupo – McDermott Will & Emery LLP (DC)

10:00am-11:00am

Cost-Effective Pretrial Proceedings in an Electronic World: Discovery, Depositions, Requests to Admit, Motions, Pitfalls & Risks

Being inherently scientific and technical in nature, inventions, their exploitation, and the related prior art have a proclivity for recordation of information in documents directed to their development, particulars of construction, modification, and application. An everincreasing reliance on e-mail and use of the Internet has heightened the challenges of obtaining documents in electronic form.

- Developing a discovery plan of action
- Targeting what is important
- Seeking electronic discovery (documents and e-mails)
- Creating databases to simplify the process: are they cost-effective?

Jerry A. Riedinger – Perkins Coie LLP (CA)

Philip G. Hampton II – Dickstein Shapiro LLP
(CA, DC)

Joseph M. Potonza – Ranner & Witcoff Ltd (DC)

Joseph M. Potenza – Banner & Witcoff, Ltd. (DC) Hon. Liam O'Grady – U.S. Magistrate Judge (DC)

11:15am-Noon

Supreme Court & Federal Circuit Court Cases & Trends

The Supreme Court is taking on more IP cases. In KSR v. Teleflex the court will determine what will happen to the standard of "obviousness". The EBay case suggests that litigation strategies and tactics will change since a stay is no longer automatic. How will District Courts apply the "four factor" test in the future?

- Does *EBay* create the possibility of a compulsory licensing system?
- How will the granting of injunctions change as courts apply standard factors of equity?

The Federal Circuit continues to issue controversial decisions; in *Zoltex Corp. v. U.S.*, a three-judge panel issued four opinions in its decision. Leading litigators and advocates critique and analyze recent landmark cases and give insight into future court trends.

- Cases currently before the Supreme Court
- How to improve your odds in having the Supreme Court grant your petition
- The importance of amicus briefs
- How Supreme Court practice works
- Is the Federal Circuit providing certainty and predictability as promised?

Seth P. Waxman – WilmerHale (DC)
Carter Phillips – Sidley Austin LLP (DC)
Mark A. Lemley – Keker & Van Nest LLP,
Stanford Law School (CA)

LITIGATION STRATEGIES UPD

12:00pm-12:30pm

Questions & Answers on Morning Sessions

12:30pm-2:00pm

Luncheon

The Rule of Law and the Role of IP Rights in Economic Development

William H. Neukom – Preston Gates & Ellis LLP, ABA President-Elect, former General Counsel, Microsoft Corp., (CA)

Patent Litigation from the PTO's Perspective

John M. Whealan – Deputy General Counsel for IP and Solicitor, U.S. Patent & Trademark Office (DC)

2:00pm-2:50pm

Perspectives of Judges of the CAFC & Federal District Courts

Noted District Court and Federal Circuit judges who have handed down some of the most noteworthy patent decisions in recent years provide insight and commentary on patent litigation.

- How they control the pace of the litigation and move the cases
- How to insure civility among lawyers
- Controlling the costs of litigation
- Effective advocacy
- What bothers judges most about the lawyers appearing before them?

Hon. Leonie M. Brinkema – Eastern District of Virginia (DC)

Hon. Richard Linn – U.S. Court of Appeals for the Federal Circuit (DC)

Moderator: Pamela Banner Krupka, Krupka Law Group, P.C. (CA)

2:50pm-3:40pm

Choosing & Using Experts to Win Your Case

Experts are critical to support your offensive or defensive strategies. Knowing what experts are needed and in what areas, and when to get them involved, is essential.

- Choosing an expert: what should you be looking for?
- Technical experts: academia vs. industry
- Damages: have they actually negotiated licenses or does it matter?
- Working with your expert to create an effective presentation
- Will courts restrict legal experts today?

Sharon R. Barner – Foley & Lardner LLP (CA)
Thomas F. Smegal, Jr. – Knobbe, Martens, Olson & Bear, LLP (CA)

Jeanne M. Gills – Foley & Lardner LLP (DC) Robert J. Yerman – LECG (DC)

3:55pm-5:15pm

Willful Infringement/Waiver of Privilege; Markman; Appellate Practice

Willful Infringement/Waiver of Privilege

How do you identify behavior that proves willfulness? By relying on the advice of counsel, does an alleged infringer waive attorney-client privilege regarding all otherwise privileged communications on the subject matter?

- What is the true impact of *Knorr-Bremse* and *Golden Blount*?
- Are opinions still important to have?
- If you rely on the opinion, what is the scope of the waiver?
- Does the waiver extend to opinions of trial counsel?

William L. LaFuze – Vinson & Elkins LLP (CA) Kenneth R. Adamo – Jones Day (DC)

ATE — PROGRAM

Markman: Practice, Procedures & Tactics

Markman broadly defined the role of the courts in claim construction, but left the operational details up to the lower courts. These "details" are still developing, providing both problems and opportunities for practitioners and courts. How do you cope in the meantime?

- Ten years later, has *Markman* simplified matters?
- Trends as to when the hearings should be held
- Should all courts adopt the procedures of the Northern District of California and the Eastern District of Texas?
- Pros and cons of the process

Claude Stern – Quinn Emanuel Urquhart Oliver & Hedges LLP (CA)

Richard L. DeLucia - Kenyon & Kenyon LLP (DC)

Appellate Practice

Lingering in the background of every patent dispute is the possibility of an appeal at some point in the process. The jurisprudence of the U.S. Court of Appeals for the Federal Circuit presents both obstacles and opportunities. Learn about both from a highly skilled appellate practice attorney.

Joseph R. Re – Knobbe Martens Olson & Bear LLP (CA) Donald R. Dunner – Finnegan, Henderson, Farabow, Garrett & Dunner, LLP (DC)

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Since 1894, the American Bar Association (ABA) Section of Intellectual Property Law has contributed significantly to the development of our system for the protection of intellectual property rights. It was the second Section created by the American Bar Association and the first Section organized to deal with a special branch of the law. With nearly 20,000 members, the Section is the largest intellectual property law organization in the world.

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REGISTRATION INFORMATION

FEES AND PAYMENT POLICY:

Conference & Workshop: \$995 (\$795 for BNA subscribers/ ABA IPL Section members) Workshop only: \$395

The registration fee of \$995 (special price of \$795 for BNA subscribers and Section members) includes the conference, continental breakfast, luncheon, and course materials. Make checks payable to BNA. All payments must be received prior to the start of the conference.

CANCELLATIONS AND CHANGES:

Cancellations for CA program received by 9:00a.m. ET, Sept. 21, 2006 will be accepted, and a full refund will be made - less a \$95 administrative processing fee. Cancellations for DC program received by 9:00a.m. ET, Nov. 9, 2006 will be accepted, and a full refund will be made - less a \$95 administrative processing fee. Attendee substitutions for this conference may be made at any time. These substitutions are not transferable to other conferences. Seminars are held subject to enrollment. Date, venue, and program details are based on information available upon publication of the brochure, and may be subject to change. In the event of a conference cancellation, BNA will make a full refund of any registration fees paid but assumes no liability for non-refundable transportation costs, hotel accommodations, or additional costs incurred by registrants.

COURSE MATERIALS:

A course book will be provided to each registrant.

CLE:

BNA will apply for continuing legal education credits in any state where available. Certificates of Attendance are available at conference registration. Contact Richard Cornfield at rcornfield@bna.com for more information concerning approval.

SCHOLARSHIP/FINANCIAL HARDSHIP POLICY:

Full and partial scholarships to attend BNA programs are available. For information, contact Richard Cornfield at rcornfield@bna.com.

HOTEL ACCOMODATIONS:

SAN FRANCISCO AREA, September 26-28, Sofitel Hotel, San Francisco Bay, 223 Twin Dolphin Drive, Redwood City, CA 94065. Phone: (650) 598-9000. Room rate (if booked prior to September 7, 2006, and requesting the BNA Conference rate): \$159 per night.

WASHINGTON, D.C., November 14-16, 2006, Westin Embassy Row, 2100 Massachusetts Avenue, NW, Washington, DC 20008. Phone: (202) 293-2100. Room rate (if booked prior to October 23, 2006, and requesting the BNA Conference rate): \$299 per night.

ABOUT THE DISTINGUISHED FACULTY

CO-CHAIRS

Barry L. Grossman - Partner, Foley & Lardner LLP, Milwaukee, WI

Gary M. Hoffman – Partner, Dickstein, Shapiro LLP, Washington, DC

Editors-in-Chief, *Patent Litigation Strategies Handbook*, *Second Edition*, BNA Books, Washington, DC

FROM THE JUDICIARY

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Hon. Leonie M. Brinkema – U.S. District Judge, Eastern District of Virginia, Alexandria, VA

Hon. Richard Linn – Circuit Judge, U.S. Court of Appeals for the Federal Circuit, Washington, DC

Hon. Liam O'Grady – U.S. Magistrate Judge, Eastern District of Virginia, Alexandria, VA

FROM THE GOVERNMENT

John M. Whealan – Deputy General Counsel for IP and Solicitor, U.S. Patent & Trademark Office

PRACTITIONERS

Kenneth R. Adamo – Partner, Jones Day, Cleveland, OH

Sharon R. Barner – Partner and Chair of IP Department, Foley & Lardner LLP, Chicago, IL

Richard L. DeLucia – Partner, Kenyon & Kenyon, LLP, New York, NY; (lead counsel for Boston Scientific in litigation against Johnson & Johnson)

Donald R. Dunner – Partner, Finnegan, Henderson, Farabow, Garrett & Dunner, LLP, Washington, DC; frequent advocate before Federal Circuit

Jeanne M. Gills – Partner and Vice-Chair of IP Litigation Practice Group, Foley & Lardner LLP, Chicago, IL

Nicholas Groombridge – Partner, Weil, Gotshal & Manges LLP, New York, NY

Philip G. Hampton II – Partner, Dickstein Shapiro LLP, Washington, DC; former Assistant Commissioner of Trademarks

Pamela Banner Krupka – Principal, Krupka Law Group, P.C., Los Angeles, CA

William L. LaFuze – Partner, Vinson & Elkins LLP, Houston, TX; former President, AIPLA

Mark A. Lemley – Of Counsel, Keker & Van Nest LLP, San Francisco, CA; William H. Neukom Professor of Law, Stanford Law School; Director, Stanford Program in Law, Science, and Technology

Joseph M. Lipner – Partner, Irell & Manella LLP, Los Angeles, CA

Raphael V. Lupo – Partner and Chair of IP Practice, McDermott Will & Emery LLP, Washington, DC; co-author, Patent Litigation Strategies Handbook, Second Edition, BNA Books, Washington, DC

PRACTITIONERS (continued)

William H. Neukom – Chair, Preston Gates & Ellis LLP, Seattle, WA; former Executive Vice President of Law and Corporate Affairs, Microsoft Corp.; President-Elect, ABA

Carter Phillips – Partner, Sidley Austin LLP, Washington, DC; former Assistant to the Solicitor General of the U.S.; frequent advocate before U.S. Supreme Court

Joseph M. Potenza – Partner, Banner & Witcoff, Ltd., Washington, DC; Adjunct Professor, Georgetown University Law Center

Jerry A. Riedinger – Partner, Perkins Coie LLP, Seattle, WA

Thomas F. Smegal, Jr. – Partner, Knobbe, Martens, Olson & Bear, LLP, San Francisco, CA; former President, ABA Intellectual Property Section; former President, AIPLA

Joseph R. Re – Partner, Knobbe Martens Olson & Bear LLP, Orange County, CA

Ronald J. Schutz – Partner, Robins, Kaplan, Miller & Ciresi LLP, Minneapolis, MN; counsel for patent owners in Fonar v. GE and Honeywell v. Minolta

Claude Stern – Partner and Co-Chair of IP Litigation Practice, Quinn Emanuel Urquhart Oliver & Hedges, LLP, Silicon Valley, CA

James H. Wallace, Jr. – Partner, Wiley Rein & Fielding LLP, Washington, DC; lead counsel for patent owner in NTP v. RIM

Seth P. Waxman – Partner, WilmerHale, Washington, DC; former Deputy Solicitor General of the U.S.; frequent advocate before U.S. Supreme Court

Robert N. Yerman – Senior Managing Director and National Director of IP Practice, LECG, Washington, DC

WORKSHOP FACULTY

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Hon. Liam O'Grady – U.S. Magistrate Judge, Eastern District of Virginia, Alexandria, VA

Sharon D. Nelson – President, Sensei Enterprises, Inc., Fairfax, VA

Mark D. Samuels – Partner, O'Melveny & Meyers LLP, Los Angeles, CA

Craig R. Kaufman – Partner, Orrick, Herrington & Sutcliffe LLP, Menlo Park, CA

Helen Bergman Moure – Partner, Preston Gates Ellis LLP, Seattle, WA

Hon. Bernard Zimmerman – U.S. Magistrate Judge, Northern District of California, San Francisco, CA

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THE ABA SECTION OF INCOPERTY Law





Workshop Only

STRATECIES UPDATE BNA'S PATENT LITICATION

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