

15th Annual Institute on Intellectual Property Law

New York City, October 1-2, 2009

San Francisco, October 29-30, 2009

Live Webcast, October 29-30, 2009

Day One - Program Schedule (9:00 a.m. – 5:00 p.m.)

Morning Session 9:00 a.m. – 12:30 p.m.

9:00 Program Overview

NYC: David Bender

SF & WEB: Robert P. Taylor

9:15

Protecting Content in New Technologies

- Internet and online content
- Mobile technology and content distribution
- Videogames / online gaming / computer entertainment / virtual worlds
- DVR recording and the ramifications of Cablevision
- Evolution of the first-sale doctrine: What is a distribution?

NYC: Raymond T. Nimmer

SF & WEB: Raymond T. Nimmer

10:15

Privacy, Information Security and Data Protection Developments

- The commercial benefits of privacy in challenging economic times
- Privacy issues in cloud computing
- Privacy and targeted advertising
- The “red flag” identity theft rules
- The need for a global cross-border data transfer paradigm
- The cost of a data security breach

NYC: David Bender

SF & WEB: David Bender

11:15 *Break*

11:30

Standard Setting Issues

- Where are we after the denial of certiorari in Rambus?
- The consent judgment in Negotiated Data Solutions
- The evolving solutions in Standard Setting Organizations
- Estoppel, waiver and the Federal Circuit decision in Qualcomm
- Managing the standard setting process for new technologies

NYC: Robert P. Taylor

SF & WEB: Robert P. Taylor

12:30 *Lunch*

Afternoon Session 1:45 p.m. – 5:00 p.m.

[Concurrent Breakout Sessions]

1:45

Breakout Session No. 1a – COPYRIGHT

Google Print Settlement/Book Rights Registry

- How the Google Print Settlement (GPS) came into existence: its history, and the platform that the class action presents
- Fair Use: the decision that was averted; impact of settlement on the Fair Use Doctrine
- Innovation: 'non-display uses' and data mining opportunities – who benefits?
- Are public domain materials impacted by the settlement?
- If Google becomes the default place to search, browse and buy books, will Google's ability to retain and collate this data with other data violate your privacy?
- A new "Book Rights Registry" will mediate relationships among authors, publishers, and copyright owners: What is the status of launching the BRR?

NYC: Katherine C. Spelman

SF & WEB: Katherine C. Spelman

Reverse Engineering

- Understanding reverse engineering
- Contract prohibitions against reverse engineering
- Effect on trade secrets
- Fair use, intermediate copying and other copyright issues
- DMCA anticircumvention exception
- Clean-room procedures

NYC: Jay T. Westermeier

SF & WEB: William Sloan Coats

Copyright Misuse

- History of the defense
- Ramifications of copyright misuse
- Recent developments
- Examples of copyright misuse

NYC: G. Gervaise Davis III

SF & WEB: G. Gervaise Davis III

1:45

Breakout Session No. 1b - PATENT

How *In re Bilski* is Changing the Patent Landscape for Business Method and Other Patents

- In re Bilski 101 - anatomy of the ruling
- Supreme Court review
- The potential impact of Bilski on other businesses (such as software and life sciences)
- The potential impact of Bilski on other types of patent claims (such as apparatus, system, and section 112(6) claims)
- How In re Bilski is being applied in the BPAI and the district courts
- The future of business method patents in the courts, the Patent Office, and the Federal Circuit

NYC: Jeffrey D. Neuburger
 SF & WEB: James R. Myers

Defending Charges of Culpable Infringement with Opinions of Counsel

- Review of post-Seagate and post-DSU Medical cases on willful infringement and inducement
- Role of legal opinions in defending against such claims
- Privilege and work product issues associated with the use of opinions
- Other practice tips regarding opinions of counsel

NYC: Theresa M. Gillis
 SF & WEB: Henry C. Su

The Evolution of Obviousness after KSR

- What has happened to the TSM test?
- What tests are being applied by courts after KSR?
- How has the role of secondary considerations evolved?
- How has the role of expert witnesses developed?
- What are emerging considerations for patentees?
- What are emerging considerations for challengers?

NYC: Jesse J. Jenner
 SF & WEB: Christopher A. Mathews

3:15 **Break**

3:30

Breakout Session No. 2a – LICENSING

Licensing in Asia

- Comparative review of selected IP laws of major countries in Asia and how differences affect specific license provisions
- Common "gotchas" in cross-border license agreements and how to avoid them
- Review of governing law, arbitration and other similar issues in the context of cross-border licensing arrangements
- Anticipating counterparty insolvency

NYC: Vivian L. Hanson
 SF & WEB: Laurie S. Hane

Licensing in the EU

- IP protection in the EU – state of play
- European Commission v. Microsoft: the continuing saga

- The European Commission's other IP priorities
- Recent case-law affecting IP licensing in Europe

NYC: George Metaxas
SF & WEB: George Metaxas

Licensing in the U.S. (Recent Cases)

- Arbitration clauses
- Incorporation by reference of terms posted on a website
- Enforcing open source licenses
- Traps for the unwary in licensing joint improvements
- Quanta – how are companies managing the implications?
- Licensing under Bilski

NYC: William A. Tanenbaum
SF & WEB: Denis T. Rice

3:30

Breakout session No. 2b – TRADEMARK

When, Where, How & Who: Anticounterfeiting Enforcement in the Wake of *Ebay* and the Struggling Economy

- Internet advertising and trademark issues - US/EU perspectives, including eBay infringement cases
- The Internet and counterfeits: ISP liability and the latest eBay cases
- PRO-IP Act: Are brands feeling the effects?
- Enforcement strategies in a struggling economy: Latest trends in online enforcement strategies

NYC: Brian W. Brokate
SF & WEB: Lisa Greenwald-Swire; Matthew L. Levine

Fair Use of Trademarks Online

- Can they do that? Is use of your mark in third party advertising a "fair use"?
- Using trademarks to make you smile - or think? Opportunism or fair use? Reconciling Dr. Seuss with Barbie—three 9th Circuit opinions
- Nominative fair use - when can you use a mark to describe your own goods and services?
- Giving users tools to create third party trademarks - is the HULK created by a fan a liability?

NYC: Peter Brown
SF & WEB: Anne Hiaring Hocking

Trademark Damages & Valuation

- Current damages landscape and calculations
- Statutory provisions
- Recent cases
- Role of intent-to-infringe and actual confusion

NYC: Frank L. Politano

SF & WEB: Richard L. Kirkpatrick

5:00 *Adjourn*

Day Two - Program Schedule (9:00 a.m. – 4:15 p.m.)

Morning Session 9:00 a.m. – 12:15 p.m.

9:00

IP in the New Administration

- What's happened so far?
- What's on the horizon and where are we headed?
- Patent reform legislation
- Green IP
- IP Czar
- PTO operations

NYC: James Pooley

SF & WEB: James Pooley

10:00

Trade Secrets in a Post-Bilski World

- What information should be protected as a trade secret?
- How can it be protected? The interplay between trade secrets, non-solicitation and (sometimes, some places) non-compete agreements
- A brave new world for trade secrets? Recent key decisions
- Litigation advantages and pitfalls
- Remedies--alternatives to simple "don't use or disclose" injunctions, and the rise of major damages awards

NYC: Victoria Cundiff

SF & WEB: Karineh Khachatourian

11:00 *Break*

11:15

Trademark Hot Topics: Progress in Bridging the Great Divides?

- "Use in Commerce" and likely confusion on the Internet: Is it still the Second Circuit vs. the rest of the country?
- Protecting famous marks that are not used in the U.S.: The Second Circuit vs. the Ninth Circuit
- Dilution: The First Amendment vs. the trademark owner
- Trade Dress: National brands vs. private labels - The Splenda saga
- What is the proper standard for fraud on the USPTO? The Trademark Trial and Appeal Board vs. trademark applicants
- Aftermath of the Supreme Court's Walmart decision: Product packaging vs. product design

NYC: Siegrun D. Kane

SF & WEB: Karen Frank

12:15 **Lunch**

Afternoon Session 1:30 p.m. – 4:15 p.m.

1:30

Corporate Counsel Panel: Managing IP in a Challenging Economic Environment

- Modifying your filing decisions (fewer countries? fewer inventions/trademarks?)
- Re-thinking the “whether-to-file-a provisional” determination
- Rebalancing the in-house/outside counsel load
- Reducing software costs – negotiating lower license fees and migrating to cloud computing
- Increasing the efficiency of the IP operation
- Seizing the initiative to generate additional revenues
- Monetizing IP to raise cash
- Rethinking opinions of counsel
- How in-house counsel can pay for themselves

NYC: Carolyn Blankenship; Ayala Deutsch; Roy F. Waldron; Joel Wolfson

SF & WEB: Brett Alten; Keith G. Askoff; Ron Laurie; Jean Liu; Seth J. Steinberg

3:00 **Break**

3:15

IP Lawyer Ethical Issues

- Trends in IP malpractice suits
- How to avoid malpractice claims
- Best practices
- Conflicts and confidentiality issues

NYC: Jerry A. Riedinger

SF & WEB: Jerry A. Riedinger

4:15 **Adjourn**

NEW YORK CITY

Co-Chairs:

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Dobbs Ferry, New York
Adjunct Professor
University of Houston Law Center
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Author, *Kane on Trademark Law: A Practitioner's Guide* (PLI)

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