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Intellectual Property Law Institute 2011

New York City, September 22-23, 2011

San Francisco, October 27-28, 2011

Live Webcast, October 27-28, 2011 — www.pli.edu

- Get Pointers on Conducting IP Due Diligence
- What the Trend Toward Patent Invalidity in the Federal Courts Means
- Effective Strategies for Global Brand Management
- Best Practices for Protecting Trade Secrets in a Digital Age

Special Features:

- Breakouts on Hot Topics in Copyright, Trademark, Licensing and Patent Law
- Corporate Counsel Perspectives on Licensing

Earn
One Full Hour
of Ethics
Credit

Do You Know There Are 5 Ways To Attend PLI's Programs? *See inside for details...*

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Intellectual Property Law Institute 2011

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Why You Should Attend

PLI's **Intellectual Property Law Institute** is a "must-attend" program for IP lawyers. This program provides a complete analysis of all areas of IP, as well as updates on cases and government agency developments that IP lawyers need to know. A highlight of the program will be a panel of in-house IP counsel from prominent companies discussing licensing, and suggesting some best practices and strategies. Some other plenary sessions will treat the importance of IP due diligence in mergers, acquisitions, and joint arrangements; content ownership in the Internet Age; the general trend toward patent invalidity in the Federal courts; and ethics for the IP lawyer.

This year's program will feature four breakout sessions, each with three current topics, that will focus respectively on copyrights, licensing, patents, and trademarks. Other plenary sessions will deal with strategic branding, developments in trade secret law, and developments in the doctrines of inequitable conduct. Among the breakout topics will be a discussion of post-*Bilski* abstract idea litigation; ramifications of the *Myriad Genetics* case; grey market exhaustion; keyword advertising; international trademark protection in an Internet world; and recent developments in U.S. licensing law.

What You Will Learn

- The latest updates in the law of patents, copyrights, trademarks, and trade secrets
- In-house perspectives on licensing best practices
- *Microsoft v. i4i* — How much of the "clear and convincing" standard will survive?
- Guidance on conducting IP due diligence
- IP online and in social media
- Strategic branding: effective strategies
- Inequitable conduct

Special Features

- Four separate breakouts
- Complete overview of IP law
- Earn ethics credit — 1 hour

Who Should Attend

General practitioners, intellectual property attorneys, in-house counsel and others who need a comprehensive update on the major areas of intellectual property law. Join **Institute** Co-Chairs David Bender and Robert P. Taylor, and a faculty of distinguished intellectual property practitioners from major corporations and law firms in the United States and Europe. Don't miss this once-a-year opportunity to learn from the best, and to network with in-house and outside intellectual property lawyers from around the world. In just two days, you will become up-to-date on many of the important intellectual property developments, learn best practices in a variety of practice settings, hear best practices to maximize the value of intellectual property assets, and earn ethics credit, too!

Here's what past attendees had to say:

"This was a terrific program.

Very informative." — Alvin Lin, Morrison Cohen LLP

"The speakers were well prepared and organized. One of the best PLI programs I have attended." — 2010 Attendee

"Great materials, topics, speakers. Well done!" — 2010 Attendee

"Fantastic panelists." — 2010 Attendee

"Keep up the good work! I always enjoy the PLI programs. High caliber materials, beautiful facility, great location. Thank you . . . can't wait to come back!" — 2010 Attendee

"Overall, the IP Law Institute FAR exceeded my expectations, especially as it was not designed solely for IP Law experts." — 2010 Attendee

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Thomas Vinje

Clifford Chance LLP
Brussels, Belgium

P R O G R A M

Day One: 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

IP Due Diligence

- Getting your arms around the project, and separating wheat from chaff
- Reviewing pertinent contracts
- Evaluating the integrity of important computer code, including open source software
- Assessing “right to use” patent studies for important products and processes
- Appraising right to use, and exclusivity of, important trademarks
- Weighing the appropriateness of secrecy protection for important trade secrets

NYC, SF & WEB: David Bender

10:15

Content Providers Versus Technology Developers in a Social Media World

- Do media operators have obligations to prevent infringement?
- Does Google have a right to copy your book or your art?
- Balance of interests in peer-to-peer environments
- Do technology controls protect content?
- What conduct amounts to inducing infringement?

NYC, SF & WEB: Raymond T. Nimmer

11:15 *Networking Break*

11:30

The Shifting Winds of Patent Invalidity

- Challenges to the “clear and convincing” evidentiary standard
- Obviousness and the continuing fallout from *KSR*
- Enablement and the “undue experimentation” test
- Increasing emphasis on the written description requirement
- Patentable subject matter as a validity issue

NYC, 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 — Licensing

Licensing in the EU

- Current developments in the European protection of IP
- A future for the EU patent?
- A new regime for collecting societies?
- Recent case law of the European Courts in IP matters
- Technology, standards, IPR and EU antitrust

NYC: George Metaxas

SF & WEB: Thomas Vinje

Licensing in Asia

- Comparative review of (and recent developments in) IP laws of selected countries in Asia and how differences affect specific license provisions
- Common “gotchas” in cross-border licensing arrangements
- Review of governing law, arbitration and other similar enforcement issues in the context of cross-border licensing arrangements

NYC: Vivian L. Hanson

SF & WEB: Laurie S. Hane

Licensing in the U.S.

- *Stanford v. Roche* and the latest on the Bayh-Dole Act and university licensing
- License conditions versus contractual commitments
- Rights of exclusive licensees
- Collaborative developments and joint IP ownership and licensing
- Licensing new technologies (e.g., “GreenTech”/“CleanTech”)

NYC: William A. Tanenbaum

SF & WEB: Amy L. Toro

1:45

Breakout Session No. 1b — Copyright

Copyright Hot Topics

- Google Books — Discussion of what the order means; the issues raised and what are the options going forward?
- First Use Doctrine — Is it alive? *AMG v. Augusto* and others
- Is the Sonny Bono Copyright Extension Act constitutional? *Golan v. Holder*
- Internet and copyright: is copyright expanding or contracting?
- Digital publishing and copyright — What does the new publishing contract include?

NYC, SF & WEB: Katherine C. Spelman

Grey Market and Exhaustion

- Resulting state of the law of copyright exhaustion/first sale following *Costco*
- Comparison to patent exhaustion
- Comparison to trademark exhaustion
- Impact of the decision on copyright owners/users

NYC: Jonathan E. Moskin

SF & WEB: William Sloan Coats

SCHEDULE

Limits of DMCA Section 512(c) Safe Harbor

- Understanding Section 512(c)
- Service provider requirements for Safe Harbor protection
- Identifying “red flags”
- Designated agent for DMCA notices
- Compliance with DMCA notice and take-down procedures
- Policies for terminating repeat infringers
- *Viacom International v. YouTube, UMG Recordings v. Veoh Networks, Io Group v. Veoh Networks* and other cases

NYC: J. (Jay) T. Westermeier

SF & WEB: G. Gervaise Davis III

3:15 Networking Break

3:30

Breakout Session No. 2a — Patent

Patent Hot Topics

- *Global Tech* and the standard for establishing induced infringement
- The changing landscape for patent damages after *Uniloc, Lucent, ResQNet, i4i* and *Cornell*
- Estoppel, waiver and laches in patent litigation
- Post-trial royalties in the absence of a permanent injunction
- Current status of reverse payments in patent settlements
- Patent “reform” legislation

NYC, SF & WEB: I. Neel Chatterjee

Bilski Update

- Did the Supreme Court’s decision change the focus from “machine or transformation” analysis to a question of whether a claim is abstract?
- Overview of how courts have analyzed claims as being “abstract” after *Bilski*
- Overview of how courts are continuing to apply “machine or transformation” after *Bilski*
- Has the Federal Circuit made the “machine or transformation” test meaningless through decisions such as *Prometheus*?
- How is the PTO handling patentability post-*Bilski*?
- How should practitioners draft claims in view of the post-*Bilski* court decisions?

NYC: Stuart P. Meyer

SF & WEB: Rajiv P. Patel

The Myriad Genetics Case and Its Ramifications

- Growing scope of public interest attack on patents
- How a small patent fight became a global war against biotechnology
- Is standing still a requirement for declaratory judgment actions?
- Can public relations trump the rule of law?
- Don’t even think about patent litigation unless you are prepared to put your business at risk

NYC, SF & WEB: Thomas E. Kelley

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- MP3/Audio CD/DVDs

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3:30

Breakout Session No. 2b — Trademark

Trademark Hot Topics

In 2011 Courts are:

- Deciding if Betty Boop has revived the defense of aesthetic functionality in the 9th Circuit
- “Showing plaintiffs the money” — With high damage awards against defaulting counterfeiters and willful trademark infringers
- Adopting new standards of proof for dilution and looking for survey evidence
- Adopting tougher standards for proving fraud on the PTO
- Reexamining standards for attorney fees awards in “exceptional cases”
- Assessing parody and first amendment defenses: Lamebook takes on Facebook

NYC: Siegrun D. Kane

SF & WEB: Karen Frank

International Protection in an Internet World

- What trademark owners need to know re: ICANN’s proposal for new gTLDs
- Has the Internet changed global filing strategies?
- Dos and don’ts for trademark-related take-down notices
- Handling trademark enforcement across borders

NYC, SF & WEB: Kathleen E. McCarthy

Keyword Advertising

- What is keyword advertising?
- Keyword advertising is global in scope, not merely national
- How the U.S. enforcement scheme works — Federal and state courts
- No exemptions from trademark infringement liability for trademark infringements
- Consensus views of the Circuits in the U.S. — Direct and vicarious or contributory infringement
- The Electronic Commerce Directive in the EU
- Exemptions for all forms of liability, including trademark infringement, if the infringer is a “host”
- ECJ Decisions-based use of Adwords: four rulings based on referrals from French, Austrian, Dutch and German courts
- Global consensus? The rules of the road today

NYC, SF & WEB: Anne Haring Hocking

5:00 Adjourn

PLI’s Nationally Acclaimed Course Handbooks

All program attendees will receive a copy of the Course Handbook *Intellectual Property Law Institute 2011*, either in one bound volume or on a flash drive. The Course Handbook is prepared specifically for this program and also stands alone as a permanent reference. PLI’s Course Handbooks represent the definitive thinking of the nation’s finest legal minds, and are considered the standard reference in the field. The Course Handbook will be available on the first day of the program. *Please note: Webcast attendees will have access to a downloadable version of the Handbook one business day prior to the program.*

Please plan to arrive with enough time to register before the conference begins.
A networking breakfast will be available upon your arrival.

Day Two: 9:00 a.m. – 4:15 p.m.

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

9:00

Strategic Branding

- Global brand management
- Digital branding and marketing
- How to keep a brand fresh
- IP legal issues in branding
- Synergies between Branding and Legal
- Handling brands in mergers and acquisitions

NYC: Sara Blotner, Susan Song

SF & WEB: Leslie C. McKnew, Meredith Pavia

10:00

Trade Secrets Update

- What are best practices for protecting trade secrets in a digital age?
- How can organizations roll out and ensure compliance with trade secrets protection programs?
- How can organizations protect their trade secrets when dealing with other businesses?
- When will irreparable harm be presumed in a trade secrets dispute, and when shouldn't it be?
- When is disclosure of trade secrets "inevitable" and what measures can reduce the risk?
- How can the parties help the court to craft the most equitable remedies for trade secrets disputes?
- How can damages be most "equitably" calculated in trade secrets cases?
- How can you use alternative dispute resolution techniques for resolving trade secrets disputes?
- What should your organization know about the Economic Espionage Act?

NYC, SF & WEB: Victoria Cundiff

11:00 *Networking Break*

11:15

Inequitable Conduct — The Momentous Requirement of Candor

- The *Kingsdown* pronouncements in theory and practice
- Proving actual intent to mislead the patent office
- Should courts infer intent from high levels of materiality?
- *Therasense* and the practicalities of prosecuting in multiple countries
- Legislation that did not make the cut

NYC, SF & WEB: Joseph A. Micallef

12:15 *Lunch*

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

1:30

Corporate Counsel Panel: Licensing Best Practices and Strategies

- Business considerations that drive whether and when to license
- Business considerations that drive pricing and limitations on the scope of what is licensed
- Negotiating and drafting limitation of liability and/or indemnity clauses
- Dealing with open source issues and the many iterations of open source licenses
- Balancing prosecution, enforcement, licensing objectives and business reality

NYC: Carolyn H. Blankenship, Donald A. Cohn, Andrea L. Colby, Joel Wolfson

SF & WEB: Dana W. Hayter, Michele Herman, Jean Liu, Douglas L. Reilly

3:00 *Networking Break*

3:15

IP Lawyer Ethical Issues

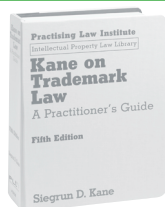
- Latest trends in IP malpractice suits
- Confidentiality issues
- Conflicts of interest
- Docketing/calendaring practices (use of technology)
- Effective practice group management

NYC: Katie M. Lachter

SF & WEB: Mark L. Tuft

4:15 *Adjourn*

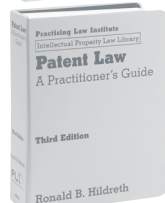
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Intellectual Property Law Institute 2011

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 13723 Kane on Trademark Law: A Practitioner's Guide,¹ 1 looseleaf volume with CD-ROM, \$325
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