

NPE LITIGATION

How to Successfully Defend Against Complex IP Infringement Claims & Litigation Involving "Patent Trolls"

June 12, 2012 – Millennium UN Plaza – New York, NY

Spotlight Address: Perspectives from an NPE on Permanent Injunctions, the New AIA Joinder Rules, eDiscovery and Patent Litigation "Rocket Dockets"

Melissa Finocchio
Chief Litigation Counsel
Intellectual Ventures

Hear from

Hewlett-Packard	Qualcomm
Conair	Sony
Nokia Siemens	Ciena*
Yahoo	

Judicial Perspectives:

Hon. Ronald M. Whyte
Senior District Judge
Northern District of California

*Hon. David Folsom**
District Judge
Eastern District of Texas

Hon. Jeremy Fogel
District Judge
Northern District of California

Hon. Charles Everingham, IV
Former Magistrate Judge
Eastern District of Texas

Hon. Carl C. Charneski
Former Administrative Law Judge
U.S. ITC

Senior in-house IP counsel and experienced patent litigation attorneys will provide proven strategies for successfully defending against *patent infringement claims* as well as *threat of the litigation* by NPEs as they share defensive and offensive litigation strategies for:

- Responding to an NPE "love letter"
- Weighing the pros and cons of various defensive and offensive litigation tactics – **divided or joint infringement, prior commercial use, laches and patent pools**
- Protecting your client's interest as a member of a **joint defense agreement** in a **multi-defendant NPE action**

Learn how your peers are strategically building a pre-trial arsenal to prevent NPE claims from going to trial, including proven strategies for:

- **Strategically utilizing reexam** as an alternative or defensive counter measure to litigation
- **Challenging the construction of key claims** at the Markman hearing
- **Effectively utilizing motion practice** to quash the claim—how to win a motion to dismiss or pursue summary or declaratory judgment

NPEs at the ITC – Gain firsthand insights from the *Hon. Theodore R. Essex, Administrative Law Judge, U.S. International Trade Commission* on how NPEs are meeting the "domestic industry requirement" in Section 337 investigations and changing the litigation landscape at the ITC

Advanced AIA Boot Camp for IP Litigators – June 11, 2012

What *Every IP Litigation Counsel* Needs to Know about Supplemental Proceedings, Post-Grant Review, Estoppel, Inter Partes Reexam and Inter Partes Review

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“Patent trolls cost inventors half a trillion dollars.”

CNNMoneyTech, September 2011

“Why the increase in lawsuits... One explanation may be troll litigation, which shows little signs of slowing.”

Corporate Counsel, December 2011

“Patent trolls and smartphone wars mean more litigation...”

WSJ Law Blog, December 2011

A multi-billion dollar industry has emerged based on litigating intellectual property rights for financial gain.

Known by many names within the industry - non-practicing entity (NPE), patent assertion entity (PAE) and most infamously as “patent trolls” – NPEs over the past few years have single-handedly spawned a sub-specialty of patent litigation that companies across industries have become all too familiar with. Often using the threat of litigation as a tool for engaging large corporate defendants into pricey license negotiations, it is estimated that the average patent suit involving NPEs results in **\$122 million in lost wealth** for the defendant, not to mention the millions of dollars often spent in litigation costs, lost work hours and time-consuming negotiations.

Offered as a one-day event to minimize time spent out of the office and in contrast to more general IP litigation events, **American Conference Institute’s NPE Litigation** conference provides an opportunity for attendees to network with colleagues while engaging in an open discussion with peers who are also being confronted with the same issues.

Ensure your client comes to the table armed with its best defensive and offensive litigation tools next time it receives an NPE “love letter.”

Take note as you are provided with practical strategies for:

- Approaching **settlement and license negotiations** with an NPE
 - What Recent Cases Reveal about Acceptable Royalty Bases in NPE Cases
 - How to Obtain Favorable Results from Your Settlement and License Negotiations
- Utilizing **reexam, motion practice, claim construction** and the **Markman hearing** to preemptively address weak IP
- Effectively asserting key defenses – **divided or joint infringement, prior commercial use laches and patent pools**
- Making the decision of whether or not participate in a **patent pool, defensive patent aggregation group or joint defense agreement**

Gain and discuss best practices for successfully defending against this new breed of patent infringement claim and walk away with practical tips and proven strategies for ensuring your client achieves success in its next action involving an NPE.

Seats at this event are expected to go quickly given the great interest in this topic. Reserve a space now for a member of your IP and litigation departments by calling 1-888-224-2480; faxing your registration to 1-877-927-1563 or registering online at www.AmericanConference.com/NPE.

Who You Will Meet

Corporate counsel and private practice attorneys specializing in IP and IP/Patent Litigation in the following industries:

- Computer, Software, Technology
- Semiconductor, Electronics
- Telecommunications
- Consumer Products
- Financial Services

Announcing ACI's NEW 1-Day Summit on **High Tech Patent Litigation**, June 13, 2012 in New York

Hear from **technology and telecom industry leaders** and **expert legal counsel** as they share their direct experiences on how to:

- Select the best forum for achieving optimal results – federal district court vs. the ITC vs. international courts
- Achieve success in court as a plaintiff or defendant
- Pursue early case termination and incorporate license negotiations into your overall litigation resolution strategy

Advanced ITC Boot Camp for Patent Litigators:

A Complete Guide to Navigating the Complex Investigatory Procedures and Fast-Paced Timeline of Section 337 Investigations

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What Every IP Litigation Counsel Needs to Know about Supplemental Proceedings, Post-Grant Review, Estoppel, Inter Partes Reexam and Inter Partes Review

Teresa Stanek Rea

Deputy Under Secretary of Commerce for Intellectual Property and Deputy Director
United States Patent and Trademark Office
(Alexandria, VA)

Philip Wadsworth

Vice President & Legal Counsel
Qualcomm Inc. (San Diego, CA)

Matthew A. Smith

Chair, Administrative Patent Disputes Group
Foley & Lardner LLP (Washington, DC)

By the date of this conference several of the new, revised and amended provisions provided for in the monumental America Invents Act (AIA) will be in effect or soon take effect. Yet, given the great complexities surrounding many of the newly implemented and updated procedures, counsel who are inexperienced in practice before the USPTO may find this new conundrum of legislation and procedures a maze to decipher and thus miss out on opportunities to avail oneself of the benefits these procedures could offer.

Specially designed to provide litigation counsel with a clear and comprehensive overview of the key new and amended procedures under the AIA that may prove especially useful during litigation, this interactive working group session will walk attendees through the key provisions of the AIA, with an eye towards explaining how they may be incorporated into an overall defensive IP litigation strategy. Points for discussion during this working group will include:

Supplemental Proceedings

- Exploring scenarios in which it makes sense for a patent holder to pursue supplemental reexamination vs. request ex-parte reexamination
- Defining a substantial new question of patentability (SNQP)
- Protocols and procedures for supplemental proceedings
- Exploring relationship between supplemental proceedings and inequitable conduct

Post-Grant Review and Estoppel

- Weighing considerations for when a challenge should be brought under post grant review (PGR)
- Analyzing the petitioner's burden of proof
 - proving that it is "more likely than not that one of the claims challenged in the petition is unpatentable"
 - raising a novel or unsettled question of legal importance to other patents
- Estoppel considerations
 - have all bases for invalidity been raised?
 - considering the impact of preclusion in subsequent district court litigation
 - distinguishing PTO estoppel v. district court estoppel

- understanding the various triggers for estoppel – when does estoppel attach?
- evaluating the effects of settlement on estoppel
- examining the possibility in concurrent proceedings for a stay on grounds of estoppel

Inter-Partes Reexam and Inter-Partes Review

- Comparing current inter partes reexamination protocols with new inter partes review protocols under AIA – timing, cost, speed of resolution
- Understanding revisions to patent challenger's burden of proof under both procedures – substantial new question of patentability vs. reasonable likelihood that the petitioner will prevail on claim
- Exploring the scope of review for each procedure under 102 and 103
- Timing of procedures – transition and phase out
- Transition in presiding forums – Central Reexam Unit (CRU) vs. Patent Trial and Appeal Board (PTAB) and appeal to CAFC

Main Conference – June 12, 2012

7:30 Registration Begins and Continental Breakfast

8:30 **Co-Chairs' Opening Remarks**

Vaishali Udupa

IP Litigation Counsel
Hewlett-Packard (Washington, DC)

Blair M. Jacobs

Partner
McDermott Will & Emery (Washington, DC)

8:45 **4 Steps to Take Immediately When Served with an NPE "Love Letter"**

Vaishali Udupa

IP Litigation Counsel
Hewlett-Packard (Washington, DC)

David Brightman

Head of IP Litigation & Conflict Management
Yahoo! Inc. (Sunnyvale, CA)

- How to request and obtain information from the NPE
- Investigating the NPE
- Assessing the strength of the claim raised and the underlying IP
- Evaluating the potential exposure created by the claim
- Sending a document retention notice and preparing for next steps
- Investigating potential indemnity

9:30 **Judicial Perspectives on NPE Litigation**

Hon. Ronald M. Whyte

Senior District Judge
U.S. District Court for the Northern District of California (San Jose, CA)

Hon. Jeremy Fogel
District Judge
U.S. District Court for the Northern District of California (San Jose, CA)

*Hon. David Folsom**
District Judge
U.S. District Court for the Eastern District of Texas (Texarcana, TX)

Hon. Carl C. Charneski
Counsel
Brinks Hofer Gilson & Liono LLP (Washington, DC)
Former Administrative Law Judge, U.S. ITC

Hon. Charles Everingham, IV – Panel Moderator
Partner
Akin Gump Strauss Hauer & Feld LLP (Longview, TX)
Former U.S. Magistrate Judge, E.D. Tex.

During this exclusive panel hear from current and former sitting Judges representing the top jurisdictions in which NPE cases have been brought in recent years as they share and discuss their thoughts on the impact NPEs are having on the IP litigation system. Take note as the Judges provide insight into:

- How they interpret and analyze the underlying IP, claims and issues presented by the parties on both sides
- What Judges prefer and dislike in terms of trial tactics utilized by counsel on both sides
- What you could be doing to more effectively try and resolve your case
- The Judges current thinking on settlement

Attendees will be provided with the opportunity to pose questions during a moderated Q&A segment at the conclusion of the panel.

10:45 Morning Coffee Break

11:00 **Weighing Defensive and Offensive Litigation Tactics: Divided or Joint Infringement, Prior Commercial Use, Laches, Patent Aggregation and Patent Pools**

Vanessa P. Bailey
Senior Legal IPR Counsel – Litigation
Nokia Siemens Networks LLC (Herndon, VA)

Nicholas M. Canella
Partner
Fitzpatrick, Cella, Harper & Scinto (New York, NY)

Divided or Joint Infringement

- Delineating how many parties participated in the alleged infringement – which party exercised “control and direction” over the claimed process
- Determining if an agency relationship exists between the parties who perform method steps
- Understanding how the nature of the relationship between the parties affects the question of infringement liability

Defensive Patent Aggregation and Patent Pools

- Knowing when the circumstances may be ripe for working collaboratively with an NPE to fend off NPE or competitor litigation
- Weighing the pros and cons of participating in a – patent pools

- defensive patent aggregators
- Discussing participation in a patent pool or defensive patent aggregation group – antitrust concerns

Laches vs. Prior Commercial Use

- Distinguishing a defense under laches vs. prior commercial use and when the circumstances may be ripe to allege each – was there knowledge of the infringement?
- Understanding the limits on prior commercial use as a defense and the burden of proof required to establish it

12:00 **Spotlight Address: Perspectives from an NPE on Permanent Injunctions, the New AIA Joinder Rules, eDiscovery and the Evolution of Patent Litigation "Rocket Dockets"**

Melissa Finocchio
Chief Litigation Counsel
Intellectual Ventures (Bellevue, WA)

During this session be engaged in a provocative, real-time discussion of current issues impacting on NPE litigation as Ms. Finocchio shares with you her thoughts on:

- The evolution of the application of the *eBay* test in the context of IP litigation involving NPEs and the new standard for demonstrating irreparable harm
- How new joinder provisions under the AIA will impact NPE litigation
- What happened to all of the rocket docket – perspectives on the shifting status of jurisdictions well known for handling IP litigation disputes
- eDiscovery in NPE litigation

12:30 Networking Luncheon for Speakers and Attendees

1:45 **Fine-Tuning Your Pre-Trial Arsenal: How to Cost-Effectively Build Your Case through Reexam, Motion Practice, Claim Construction and the Markman**

Lawrence Cruz
Chief Patent Counsel
Conair Corporation (Stamford, CT)

John A. Marlott
Partner
Jones Day (Chicago, IL)

- Examining key pre-litigation considerations
- Evaluating the use of reexam as an alternative or defensive counter-measure to litigation
 - weighing the challenges and benefits associated with improved patent quality afforded by reexamination
 - key new considerations under the AIA
- Motions – knowing how strong your evidence is and whether or not it will support the motion you want to make – (e.g., motions to dismiss, motions to sever/transfer/stay, summary judgments motions)
- Claim construction – how to approach the *Markman* in view of the uncertainty in Federal Circuit’s case law on claim construction (i.e. – more narrow reading of claims vs. broader reading)
- Other pre-trial strategies for narrowing issues

2:30 **NPEs at the ITC: How Section 337 Investigations are Changing the NPE Litigation Landscape**

Hon. Theodore R. Essex
Administrative Law Judge
U.S. International Trade Commission (Washington, DC)

Marcia Sundeen
Partner
Kenyon & Kenyon LLP (Washington, DC)

During this panel, be brought up to speed on the current status of caselaw outlining the sufficiency of licensing activity required to meet the domestic industry requirement at the ITC. Hear how NPEs have sought to establish a “nexus” between the asserted patent and the licensing activity in the context of recent Section 337 investigations.

- Addressing the sufficiency of licensing activity required to meet the domestic industry requirement under *Certain Multimedia Display and Navigation Devices and Systems* and its progeny
- Knowing what the ITC is looking for when evaluating the “nexus” of activity between the asserted patent and the licensing activity
 - is the asserted patent(s) part of portfolio licensing activity?
 - evidence of practicing the patent and infringement in the US
 - how financial investment in a patent portfolio will be weighed

3:15 Afternoon Refreshment Break

3:30 **Joint Defense Agreements: Balancing Costs and Benefits to Obtain the Results You Want in Multi-Defendant NPE Actions**

*Tyler Brown**
Chief IP Counsel
Ciena Corporation (Linthicum, MD)

Blair M. Jacobs
Partner
McDermott Will & Emery (Washington, DC)

- Strategies for keeping all defendants on the same page
- How to craft a joint defense agreement among multiple defendants while still keeping your client’s best interest at heart
- Identifying mechanisms for preserving various causes of action among multiple defendants at the outset and during the litigation
- Strategies for seeking indemnity from co-defendants
- Organizing and deferring disputes among initial defendants and prospective third party defendants to avoid cross claims
- Knowing when to separate from a multi-defendant action
- Preparing for the impact of the new joinder law (35 USC 299) on multi-defendant NPE actions

FOCUS ON SETTLEMENT

4:30 **Caselaw Update – Royalties and Damages: What Recent Cases Reveal about Acceptable Royalty Bases in NPE Cases**

Robert Maier
Partner
Baker Botts L.L.P. (New York, NY)

- Determining what an acceptable royalty base is based on evolving caselaw post-*Uniloc, i4i* and others
- Overview of reasonable royalty calculation methodologies – weighing the *Georgia-Pacific* factors
- How to ensure your experts and IP valuers are providing the best calculations
- Navigating the shift from the 25 percent rule to the entire market value rule when calculating the appropriate royalty rate

5:00 **Ensuring the Success of Your Settlement and Licensing Negotiations: Senior Litigator’s Strategies for Obtaining Favorable Results**

Vladimir Elgort
Senior Director, Intellectual Property Counsel
Sony Corporation of America (New York, NY)

Paul R. Gupta
Partner
Orrick, Herrington & Sutcliffe LLP (New York, NY)

- Understanding your client’s position and how far they are willing and not willing to go in defense of an NPE action
- Using the record to negotiate a license agreement that is most favorable to your client
- Ensuring a protective order is secured to shield other/future parties access to the financial details of the settlement
- Addressing licensing and royalty agreement terms

5:45 Conference Concludes



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