



Intellectual Property Law Section

State Bar of Texas

Special Issue - 2014 Advanced Intellectual Property Law Course

27th Advanced Intellectual Property Law Course

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The 27th Annual Advanced Intellectual Property Law Course was held March 19-21, 2014 in Dallas, Texas.

Wednesday

Overview of the New Post-Issuance Proceedings

Nathan Rees of Norton Rose Fulbright led off an afternoon discussion of new post-issuance proceedings with an overview of new procedures created by the 2011 America Invents Act ("AIA"). Mr. Rees first highlighted three lesser-known additions from the AIA: (1) prior art submission by third parties during prosecution; (2) supplemental examination, a central reexamination unit ("CRU") proceeding that may allow a patent owner to request reconsideration over art and potentially even cure inequitable conduct or Section 112 issues; and (3) derivation proceedings, a substitute for interferences in the new first-to-file system.

Mr. Rees then gave an overview of the new post-issuance proceedings: inter partes review ("IPR"), post-grant review ("PGR"), and covered business method ("CBM") review. He presented attendees with a detailed chart comparing the new IPR, PGR,



Nathan Rees

and CBM proceedings side-by-side and against ex parte reexamination, a remaining post-issuance option from pre-AIA law. The chart compared each proceeding based on when it can be initiated, who can initiate, the grounds for challenging the patent, the standards of review, estoppels that may apply, discovery allowed, and whether the proceeding could be ended by settlement.

Mr. Rees also presented the attendees with a series of statistics on the new post-issuance proceedings. For instance, attendees learned that IPRs have been instituted thus far on approximately 46% of the challenged grounds. Practitioners are advised to pick their best rejections because there are page limits and the board has demonstrated it will not accept every challenged ground. He also noted that, as of Dec. 2013, CBM review had a 100% kill rate (i.e., all claims amended or rejected). Mr. Rees also explained that approximately 60% of motions to stay litigation pending IPR, PGR, or CBM have been granted. With numbers like these, practitioners are well advised to become more familiar with these procedures and the strategic concerns addressed in more detail the rest of the afternoon.

Tips and Strategies on Whether to Use Post-Issuance Proceedings

Colin Cahoon, of Carstens & Cahoon, and Diane Lettelleir, of J.C. Penney, jointly provided an overview of tips and strategies for the new post-issuance proceedings. Mr. Cahoon led off the first half covering considerations



Colin Cahoon

related to the new proceedings right up until suit is filed. Mr. Cahoon highlighted points at which a company might monitor inventive activity (publication, issuance, when litigation is filed) and how a company might avail itself of the new procedures provided by the AIA. For example, Mr. Cahoon noted that the new prior art submission provisions allow submission of any prior art along with an explanation of that art during prosecution. This provides for, in essence, the same benefits as an *ex parte* reexamination except it is less expensive and is earlier in the process—i.e. before issuance.

Diane Lettelleir next offered her perspective after three years in-house at J.C. Penney, a frequent target of non-practicing entities, along with her prior 26 years of experience in private practice. Ms. Lettelleir highlighted the high-level considerations in seeking post-issuance review at the PTO, including: the timing compared with district court litigation (some district courts requiring invalidity contentions 75 days from answer), legal standard applied (i.e. district courts construing claims to preserve validity), the complexity of the validity argument (can it be effectively presented to a lay jury?), estoppel effects, and the risk of the opportunity to amend. Ms. Lettelleir also addressed cost concerns in pursuing a post-issuance proceeding. Waiting too long to file a post-issuance proceeding with the PTO may decrease one's chances of getting litigation stayed, particularly if depositions have begun, claim construction briefing has started, or especially if a claim construction order has issued. Post-issuance proceedings also shift a lot of costs forward, to earlier than they would otherwise be in litigation.



Diane Lettelleir

The new post-issuance proceedings and other provisions of the AIA give defendants (and potential defendants) a lot more options and points in time at which they can evaluate the inventive landscape and take action. Navigating these new options requires consideration of many factors related to an accused infringer's validity versus infringement position, timing, and cost concerns.

Lessons Learned from the Post-Issuance Trenches

Sharon A. Israel, of Mayer Brown, and David L. McCombs, of Haynes and Boone, jointly presented on lessons learned in their early experience with the new post-issuance proceedings. They first presented a slide taken from a PTAB administrative patent judge's ("APJ") presentation showing that the PTAB is now the third busiest forum for patent cases behind only the Eastern District of Texas (#2) and the District of Delaware (#1). The APJs are under great pressure given this workload and the statutory requirement to issue a final decision within a



David McCombs and Sharon Israel.

year of instituting a post-issuance proceeding. Though the statute allows up to an additional six months for good cause, the APJs are strictly adhering to the one-year deadline thus far. This pressure is reflected in the PTO's expectation to hire approximately 50 more APJs to add to the current complement of 70 APJs handling these proceedings, as well as decisions refusing to institute on redundant grounds and refusing to allow broader discovery.

Ms. Israel and Mr. McCombs walked attendees through a series of lessons from both the petitioner's and the patent owner's perspective. They advised petitioners not to treat a petition like invalidity contentions. The petition needs to be focused for what is essentially a paper trial that concludes with an appellate-like argument of likely no more than one hour per side. Evidence needs to be cited with particularity, and the PTAB has shown a preference for general English language usage dictionaries when evaluating claim constructions. The petitioner also needs to try to address any claim construction issues up front in the petition because it may be difficult to do later. For the patent owner's part, the ability to frame the argument after the petitioner has staked out claim construction issues can be an advantage. But, if the patent owner wants to amend claims, there is a high bar—essentially, the patent owner must show the new claim is patentable over the prior art. If a patentee really wants to amend, separate reissue and reexamination may provide a better opportunity. There is also limited opportunity to get discovery of the petitioner, particularly if seeking evidence of commercial success for secondary-considerations purposes.

Ms. Israel and Mr. McCombs presented attendees with valuable lessons practitioners need to consider, whether they are on the side of the petitioner or patent owner. Overall, they need to prepare to provide their best arguments and evidence up front—the petitioner in his initial petition and a patent owner needs to consider the issue even before filing suit.

Post-issuance proceedings are being filed frequently in light of the success rate to date. Many expect that the initial success may be the result of self-selection, i.e. stronger cases being brought initially, and outcomes may return to the mean as time

goes forward. The APJs do not want to be known as patent “death squads” as former Chief Judge Randall Rader recently characterized them. But these new proceedings seem likely to become an important part of the patent system going forward.

Litigation Stays or a Race to Decision Judgment

Joseph M. Beauchamp, of Jones Day, presented on litigation stays. He began with data supporting the conventional wisdom that patentees want to get to trial quickly and accused infringers do not. A study from Price Waterhouse &



Joseph
Beauchamp

Cooper found that patent owners have a 77% success rate in front of a jury once they get to trial. By comparison, 80% of the new post issuance proceedings have been instituted and of the 31 that have reached a final decision thus far, 29 have found the same claims invalid that the APJs thought might be invalid when they decided to institute. The timing difference for the new procedures before the PTAB is also stark—2.5 years median time to trial in district court compared with 18 months from petition to final written decision before the PTAB (decision to institute within six months of petition and written decision within one year of decision to institute by statute).

As a result of the timing differences between the PTAB and district court litigation, the familiar race to the Federal Circuit remains a part of the litigation landscape but with a different spin due to the speed of the new proceedings. Mr. Beauchamp walked through significant cases where the race to judgment by the Federal Circuit had been a close one, specifically *Translogic v. Hitachi* and more recently *Fresnius v. Baxter*. Prior

to the AIA though, district court judges had been relatively reluctant to stay litigation pending reexaminations mostly due to the long delay and potential prejudice to the patent holder. The new post-issuance proceedings have altered the landscape. Mr. Beauchamp walked through the three factors courts consider in deciding whether to stay litigation pending IPR and the additional fourth factor for CBMs. Based on these factors, Mr. Beauchamp reported that as of early March 2014, 139 stay motions had been filed and 73 percent of them were granted (i.e. 102 stays). Removing unopposed motions to stay, there were 101 contested motions to stay litigation with a stay being granted in 58 cases.

The presentation highlighted the overall trend in district courts granting stays in favor of the new post-issuance proceedings along with many specifics from recent cases around the country. Among them was the unsurprising decision not to grant a stay when the motion to stay was filed seven hours before jury selection. A more surprising result perhaps was a district court's decision to grant a stay relying at least in part on the fact that the companies were in the high-tech industry where employees change jobs frequently and a stay might potentially prejudice the patentee (as well as the accused infringer) as important fact witnesses moved on.

So You Have a Decision, Now What? Appeal Issues, Estoppel Considerations

Bart Showalter, chair of Baker Botts's IP department, took on the challenge of discussing estoppel considerations for new post-issuance proceedings, despite the lack of court cases that have reached the topic. Mr. Showalter focused on how and



Bart Showalter

when estoppels are triggered as well as the scope of those estoppels in terms of parties and the arguments they can and can't make in later proceedings.

Mr. Showalter identified that the estoppels vary among the three post-issuance proceedings: inter partes reviews (IPRs), post grant reviews (PGRs), and covered business method reviews (CBMs). He pointed out that there are also differences between the three new proceedings and inter partes reexaminations, especially when an estoppel attaches. The case law for reexamination estoppel had allowed all appeals to conclude, which can be a long process, before the estoppel attached. In contrast, all the new proceedings attach the estoppel upon a final written decision of the Board. Mr. Showalter also identified differences among the new proceedings with respect to the potential arguments covered and the parties other than the filer who might be subject to the estoppel.

Mr. Showalter emphasized that you should identify your chief concern with the estoppel. Whether you are more concerned about the parties that will be covered or the scope of arguments that will be precluded is an important factor. According to Mr. Showalter, CBMs have the most limited estoppel coverage with respect to subsequent district court and ITC cases and may be ideal if the patent you want to challenge has the right subject matter. He also emphasized that it may not be a good choice to refuse to take advantage of the new proceedings for fear of the estoppel, because you foreclose your legal rights in proceedings with big advantages for challengers: a lower preponderance of the evidence standard and broadest reasonable construction of the patent claims. Retaining your rights under less advantageous circumstances may not be worthwhile.

The Duty of Candor in USPTO Post-Grant Proceedings

Wednesday's presentations concluded with Syracuse University College of Law Professor Lisa Dolak presenting on the duties of candor and disclosure for parties to the new post-grant proceedings. The topic was



Lisa Dolak

primarily directed to the obligations set forth in new rules 37 CFR 42.11 "Duty of candor" and 42.51 "Discovery," with the key points being that (i) Rule 56 is inapplicable, (ii) the new rules impose a broader disclosure burden than Rule 56, and (iii) a candor violation by the patent owner in a post-grant proceeding *may* be the basis for asserting inequitable conduct in a later proceeding.

Regarding rule 42.11, the PTAB trial rules explain the duty of candor and good faith to the Office as "essential to the integrity of the proceeding," and describe the scope of this duty as comparable to the obligations toward the tribunal under Fed. R. Civ. P. 11. Rule 42.12 specifies sanctionable conduct and the sanctions which may be applied during or after the proceeding, with some as serious as dismissal of the petition and an award of compensatory expenses including attorney fees. For counsel, the consequences for violating the rules of candor potentially include OED Director-imposed sanctions pursuant to an OED investigation conducted at any time—including after a final written decision.

Rule 42.51, also enforced under the Rule 42.12 sanctions, specifies the other new candor-related obligation which applies to contested proceedings and specifically relates to Discovery. Under the new rules, a party must serve on the opposing party information that is inconsistent with a position advanced by the serving party. This Discovery requirement extends to others, such as inventors and corporate officers, as

well as counsel. Regarding the scope of the duty, Professor Dolak noted the PTAB's position that the duty is broader than that under Rule 56, but there is no obligation to explain relevance and traditional evidentiary privileges and discovery immunities are preserved. The new rules therefore appear to impose a broad disclosure obligation that falls more heavily on patent owners because petitioners need only serve relevant information that is inconsistent with an advanced position while patent owners presumably have the broader inequitable conduct duty to disclose known material information to the Office.

Thursday

Patent Law Update

Thursday morning started with a presentation by Derrick Pizarro, Shareholder, Cox, Smith & Matthews, San Antonio. He provided an overview of some of the latest patent cases from the Federal Circuit and the Supreme Court. Mr. Pizarro covered the following cases:



Derrick Pizarro

- *Minton v. Gunn*, 133 S. Ct. 1059 (2013): Patent malpractice claims should be brought in state court.
- *Medtronic v. Mirowski*, 134 S. Ct. 843 (2014): Licensor has burden of proof to show infringement in a DJ action for non-infringement brought by a licensee.
- *Bowman v. Monsanto*, 133 S. Ct. 1761 (2013): No patent exhaustion and infringement occurs by planting the self-replicating offspring of a patented plant without a license.
- *FTC v. Actavis*, 133 S. Ct. 2223 (2013): Licenses and payments between a name brand pharmaceutical company and a generic manufacturer preventing

the manufacturer from selling its generic drug are permissible under a rule of reason, case-by-case analysis under the antitrust laws.

- *Hamilton Beach v. Sunbeam*, 726 F.3d 1370 (Fed. Cir. 2013): There is no supplier exception to the on-sale bar: manufacturer's response to purchase order creates offer for sale.
- *Solvay v. Honeywell*, 742 F.3d 998 (Fed. Cir. 2014): Inurement exists if the inventor authorizes another to reduce his invention to practice; it does not require that the inventor expressly request or direct the non-inventor to perform reductive work.
- *Allergan v. Sandoz*, 726 F.3d 1286 (Fed. Cir. 2013): FDA approval may be relevant to the obviousness analysis, but there is no requirement that the person of ordinary skill be motivated to develop the claimed invention based on a rationale that forms the basis for FDA approval.
- *Plantronics v. Aliph*, 724 F.3d 1343 (Fed. Cir. 2013): All evidence pertaining to the objective indicia of nonobviousness must be considered before reaching an obviousness conclusion.
- *Cephalon v. Watson Pharma*, 707 F.3d 1330 (Fed. Cir. 2013): Extensive experimentation does not necessarily render the experiments unduly extensive where the experiments involve repetition of known or commonly used techniques.
- *Wyeth v. Abbott*, 720 F.3d 1380 (Fed. Cir. 2013): Having to synthesize and screen each of at least tens of thousands of candidate compounds constitutes undue experimentation.
- *Novozymes v. DuPont*, 723 F.3d 1336 (Fed. Cir. 2013): Taking the claims as a whole rather than as the sum of their

individual limitations, nothing in the application indicated possession of the claimed enzyme variant.

- *Synthes USA v. Spinal Kinetics*, 734 F.3d 1332 (Fed. Cir. 2013): Predictability is a factual issue judged on a case-by-case basis: disclosure of species in "mechanical" field did not support genus claiming.
- *Medtronic v. Edwards Life Sciences*, 741 F.3d 1359 (Fed. Cir. 2014): To obtain the benefit of a foreign priority date under § 120, a patent must cite to each intermediate application back to the priority application or lose the priority date.
- *Dawson v. Dawson*, 710 F.3d 1347 (Fed. Cir. 2013): UCSF did not own patent because inventor conceived of invention after inventor left the university.
- *Frolow v. Wilson Sporting Goods*, 710 F.3d 1303 (Fed. Cir. 2013): Federal Circuit declines to adopt "marking estoppel" doctrine; however, the practice of marking a product with a patent number is a form of extrajudicial admission that the product falls within the patent claims.
- *Aristocrat Technologies v. International Game Technology*, 709 F.3d 1348 (Fed. Cir. 2013): Actions that are "natural, ordinary, and reasonable consequences" of another's conduct do not establish direction or control sufficient for direct infringement.
- *Hall v. Bed, Bath and Beyond*, 705 F.3d 1357 (Fed. Cir. 2013): Claim construction is not an essential element of a patent infringement complaint for design patent infringement.
- *Network Signatures v. State Farm*, 731 F.3d 1239 (Fed. Cir. 2013): Compliance with the standard PTO procedure for delayed payment, using the PTO form

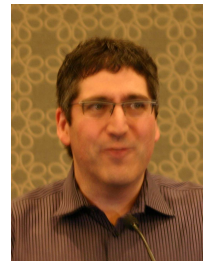
for delayed payment but without providing factual detail, did not provide clear and convincing evidence of withholding of material information with the intent to deceive the Director.

- *Ring & Pinion v. ARB*, 743 F.3d 831 (Fed. Cir. 2014): District court erred in failing to enforce parties' stipulation to equivalence and instead finding no infringement based on vitiation.
- *Lighting Ballast v. Phillips Electronics*, 744 F.3d 1272 (Fed. Cir. 2014) (en banc): 6-4, en banc Federal Circuit confirms the *Cybor* standard of de novo review.
- *3M v. Tredegar*, 725 F.3d 1315 (Fed. Cir. 2013): Three judges, three opinions—none could affirmatively agree on if the contract doctrine of *contra proferentem* should apply, *i.e.*, if the claim terms should be construed against the drafter.
- *elcommerce.com v. SAP*, 745 F.3d 490 (Fed. Cir. 2014): Expert testimony is not required in every situation, but there is no Federal Circuit or other prohibition on using such expertise.
- *High Point Design v. Buyers Direct*, 730 F.3d 1301 (Fed. Cir. 2013): District court erred by (1) applying the "ordinary observer" standard versus the "ordinary designer" standard; (2) not considering an expert's report; (3) failing to translate the claimed design into a sufficiently detailed verbal description to "evoke a visual image consonant with that design"; (4) failing to provide its reasoning; and (5) determining if the claimed design's "primary features" could perform functions versus determining if the claimed design was "primarily functional" or "primarily ornamental."

- *In re Owens*, 710 F.3d 1362 (Fed. Cir. 2013): A broken line added to a figure of a design patent continuation application was new matter; the continuation lost priority to the parent application.
- *Pacific Coast Marine v. Malibu Boats*, 739 F.3d 694 (Fed. Cir. 2014): Prosecution history estoppel applies to design patents.

Trademarks and Social Media

Ryan Garcia from Dell in Austin spoke about trademarks and social media. Mr. Garcia began his talk by noting that while the terms "social media" and "social networking" are often used interchangeably, the terms



Ryan Garcia are actually defined differently. Social media encompasses social networking because it is "any tool that uses the Internet to facilitate conversation."

Mr. Garcia shared five problematic situations that brand owners and attorneys often encounter when it comes to protecting their trademarks while trying to successfully build their brand on social media. He referred to the situations as: (1) "your brand is not alone;" (2) "the informal tone beast;" (3) "the blunting of our enforcement tools;" (4) "one person can reach millions;" and (5) "the dangers of social media contests."

In concluding his talk, Mr. Garcia suggested that brand owners and attorneys can anticipate and avoid causing social media crises by "social media governance." The four steps he listed under social media governance included: (1) "know why you are on social media;" (2) "create a policy for how you will act on social media;" (3) "create a training plan for those who will represent you on social media;" and (4) "monitor those who represent you social media."

Section 101 - Trends in Computer Software/Business Method Patent Eligibility

Leisa Peschel of Williams Morgan, P.C. (Houston) presented on patent-eligibility for computer software and business methods under 35 U.S.C. § 101. Dr. Peschel summarized the development



of the law of patent-eligibility through and including the Federal Circuit's *en banc* decision in *Alice Corp. v. CLS Bank* and subsequent decisions, as well as the status of *CLS Bank* briefing at the Supreme Court. Dr. Peschel summarized certain Supreme Court cases, including: *Gottschalk v. Benson*, 409 U.S. 63 (1972); *Parker v. Flook*, 437 U.S. 584 (1978); *Diamond v. Chakrabarty*, 447 U.S. 303 (1980); *Diamond v. Diehr*, 450 U.S. 175 (1981); *Bilski v. Kappos*, 561 U.S. 593 (2010); and *Mayo v. Prometheus*, 132 S. Ct. 1289 (2012).

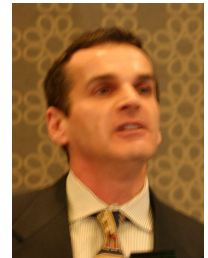
Dr. Peschel then discussed the procedural history and competing opinions in Federal Circuit's *en banc* decision in *CLS Bank v. Alice Corp.*, 717 F.3d 1269 (Fed. Cir. 2013). The Lourie opinion, joined by Judges Dyk, Prost, Reyna, and Wallach, provided an analytical framework in which a claim is first compared to the literal language of § 101 and, if within one of the categories, is then reviewed for applicability of the judicial exceptions for laws of nature, natural phenomena, and abstract ideas. The Rader opinion, joined by Judge Moore, and joined in-part by Judges Linn, and O'Malley, differed in that it would have held the system claims to be eligible as directed to a programmed and, thus, special-purpose computer. Judge Moore, and Judges Linn and O'Malley, also wrote separately to express additional concerns, and Judge Newman wrote a further opinion that was not joined by any other judge.

Dr. Peschel also summarized the Federal Circuit's subsequent decisions in *Ultramercial, Inc. v. Hulu LLC*, 722 F.3d 1335 (Fed. Cir. 2013) and *Accenture Global Servs. v. Guidewire Software*, 728 F.3d 1336 (Fed. Cir. 2013). In *Ultramercial*, Judge Rader wrote the majority opinion reversing a district court's grant of a motion to dismiss on § 101 grounds, possibly making it less likely that district courts will invalidate claims at the motion-to-dismiss stage. In *Accenture*, the Court affirmed the district court's grant of summary judgment that system claims were patent ineligible, despite Chief Judge Rader's dissent that cited *Ultramercial* extensively.

Dr. Peschel then summarized the issues pending before the Supreme Court in *Alice Corp. v. CLS Bank*, and predicted that it would be decided relatively narrowly on the facts of that case without necessarily providing broadly-applicable guidance.

Section 101 - Trends in Biotech Patentability

Nicolas G. Barzoukas of Baker Botts LLP (Houston) presented on patent-eligibility for biotech inventions under 35 U.S.C. § 101, including a summary of the development of the law of patent-eligibility through and including the Supreme Court's decisions in *Mayo v. Prometheus*, 132 S. Ct. 1289 (2012) and *Assoc. for Molecular Pathology v. Myriad Genetics, Inc.*, 133 S. Ct. 2107 (2013). Mr. Barzoukas noted that while his own presentation focused on biotech inventions, the case law overlaps and should be considered with case law related to computer-related inventions.



Nicholas
Barzoukas

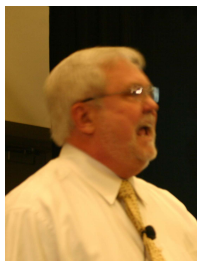
Mr. Barzoukas began by summarizing key historical Supreme Court cases. He then summarized the Supreme Court's recent *Prometheus* and *Myriad* decisions. In *Mayo*,

the claims were held to be ineligible because they did not require action on the abstract idea and could conceivably have been infringed even if no action was taken after recognizing the claimed correlation. In *Myriad*, the Supreme Court held that claims directed to isolated gDNA in the form in which it naturally occurs are not patent eligible, but claims to synthetically created cDNA are patent eligible. Mr. Barzoukas noted method claims addressed by the Federal Circuit but not by the Supreme Court, including (1) claims for analyzing that were not patent eligible because they only involved comparing genes; and (2) claims to a method of screening potential therapeutics that were patent eligible because they involved transforming a cell to a non-naturally-occurring state and applying a therapeutic to determine an effect on the cell.

Mr. Barzoukas offered several recommendations for drafting patent-eligible biotech claims, including: limiting claims to particular application(s) to illustrate why the scope of the claims does not preempt all uses of a natural law or abstract idea, including mechanization (e.g., equipment); including an application step such as a treatment; and describing in the specification a tangible transformation achieved by what is claimed. Patentees can also consider filing a reissue application to add dependent claims with particular applications and implementations.

Luncheon Presentation: Forward to the Past – Forgotten Lessons in IP Licensing

During lunch, Tom Pruitt delivered a colorful and interesting treatment of some philosophical tenets of IP licensing. He began by explaining that while *principles* of IP licensing have been well documented, and



Tom Pruitt

are therefore usefully accessible by practitioners, the *philosophy* behind those principles is more obscure but well worth considering in application. He summed up the tenets as four “curses”: presuming superior knowledge on the part of the client, failing to be adequately probative, failing to discern the truly key agreement provisions, and failing to address uncomfortable issues with the client. Mr. Pruitt then illustrated aspects of the underlying philosophy by delving into two civil war era patent-licensing cases, both involving patents on firearms and demonstrating how failure to apply the basic tenets was costly in terms of profit and arguably resulted in loss of life during the war.

Trade Regulation and International Technology Transfers

Jim Chester of Chester & Jeter LLP in Dallas discussed international technology transfers. The presentation identified the agencies responsible for enforcement of export regulations, the key questions to be asked when



exporting goods or information, and the steps to follow during the exporting process to ensure regulatory compliance. Mr. Chester also identified the potential penalties for failing to comply with U.S. export law, which include monetary penalties, imprisonment, restrictions on further exporting, and debarment from government contracts.

Mr. Chester focused on some common pitfalls for exporters, such as failing to understand that “export” means any good or *information* transferred outside the United States, including downloads and emails. Moreover, a transfer within the United States can be “deemed” an export if the transfer is to a foreign national who is not a permanent resident. Export records must be kept for at

least five years. From his experience, most violations occur by personnel outside of shipping and export departments, such as an engineer shipping samples to an international client or providing schematics through email.

Mr. Chester provided his keys to compliance. First, understand that export regulations and sanctions programs change frequently, so maintain an updated *written* compliance program. Implement “hands on” management of vendors, agents, brokers, and forwarders so that their violations don’t reflect on your client or employer. Finally, exporters should check their work with periodic compliance reviews and self-report any violations, as it’s better to be proactive about known violations rather than have the government show up on your doorstep unannounced.

Open Source Software Licenses

With over 20 years in IBM’s in-house IP law department, Mark Walker has dealt extensively with copyright and software-licensing matters, including those involving open-source code. In presenting on the topic of open-source software licenses, the depth and breadth of his expertise in these areas were evident as he succinctly explained a practical guide for enabling businesses to avail themselves of the many benefits of using open-source code without incurring undue legal risk. After explaining the nature of the licensing terms that define software as being open source, Mr. Walker noted how increasingly commonplace and essential open-source software has become to the IT world.

Use and distribution of open-source code by companies is rapidly becoming a critical competitive necessity but comes with risks



which Mr. Walker categorized into two groups. The first risk is uncertainty due to potentially-unclear pedigree of the code combined with a lack of any warranties of originality, non-infringement, etc. The second risk is compliance with terms of the license, because while all open-source licenses permit use, modification, and distribution of the source code, there are differing terms among the licenses governing the user’s return obligations.

The proposed solution, supported by Mr. Walker’s in-house experience over the years, was for companies to institute a formal, systematic open-source evaluation process. The system should be designed to evaluate both of the above-mentioned basic risk categories and therefore should include a code pedigree investigation (e.g., author’s background, open-source community history, etc.) as well as a careful assessment and recording of particular license terms that may place a company’s rights to its own code in jeopardy if combined and distributed with open-source code. He concluded with the following minimum features for such a system: control acquisition of open-source software, review all new or modified packages, establish open-source procedures to meet license terms, scan open-source and your own proprietary software, and audit compliance with open-source terms.

Perspectives on In-House IP Practice

Todd Bynum, Lead Counsel of Technology and IP Analytics for ConocoPhillips, Houston, Jaime A. Castano, Manager of IP Enforcement at Schlumberger, Houston and Brianna L. Hinojosa-Flores, Senior Patent Counsel for Blackberry in Irving provided their insights and perspectives on in-house IP practice. Indranil Chowdhury, Principal at Chowdhury & Georgakis, PC, Houston, moderated the panel. The panel answered questions on the three topics of in-house

lifestyle, best practices of in-house IP practice, and building and keeping a productive relationship with outside counsel.

Discussing in-house lifestyle, Mr. Bynum indicated that the goals and objectives motivating him as an in-house counsel include making sure that the company has a strong technology and IP portfolio, making sure the company complies with laws in



Todd Bynum, Brianna Hinojosa-Flores, Jaime Castano.

every jurisdiction, and respecting the valid intellectual property of others. Ms. Flores stated that her main goals and objectives as an in-house counsel for Blackberry are to protect her company's IP and to build a strong portfolio that can be used in litigation and/or licensing efforts. Mr. Castano, in his role as Manager for IP enforcement, indicated that his primary goals and objectives are ensuring that third parties do not infringe Schlumberger's IP and demystifying the dispute and litigation process for Schlumberger's business managers so that they can make educated decisions.

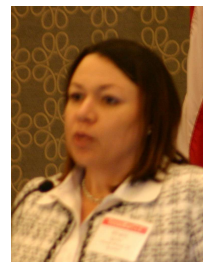
Next, Mr. Bynum explained his best in-house IP practices such as understanding the company's business thoroughly and setting and meeting expectations. Ms. Flores's best in-house practice tips included understanding the client (i.e. business units), understanding the purpose of the IP assets, familiarity with the company's products and competitors, for foreign prosecution understanding where to file and why based on technology, asking questions and keeping open communication with outside counsel and always looking for ways to be more efficient or to cut cost, whether asked

to or not. On the dispute side, Mr. Castano described some of his best in-house IP practices including making sure all stakeholders understand the reasons for taking certain actions, the assumptions built into the actions and recommendations, as well as the risks or consequences of the actions.

Finally, the panel discussed the topic of building and keeping a productive relationship with outside counsel. Mr. Bynum mentioned that he expects outside counsel to follow all guidelines he provides them, invest the time necessary for the matter, and keep him informed as to issues and budget problems. In response to the question of "What are some things outside counsel can do to strengthen their relationship with in-house counsel?" Ms. Flores said that she hires attorneys within a firm and expects that attorney to do the work. Ms. Flores indicated that she expects the outside counsel to invest the time in the work, manage their time and maintain a high quality work product, and meet all guidelines and deadlines. Mr. Castano stated that his expectations for outside counsel were no surprises, staying on budget, receptive to ideas and understanding that the in-house counsel are invested in the outcome and expect good results.

My First Year as a PTAB Judge

The Hon. Miriam Quinn, an Administrative Patent Judge ("APJ") in the PTO's new Dallas office, provided her observations on her first year as a judge, which coincided roughly with the first eighteen months of the new post-issuance proceedings. One thousand eighty-two petitions have been filed with the PTAB since these new post-issuance proceedings became available, most of these proceedings being inter partes



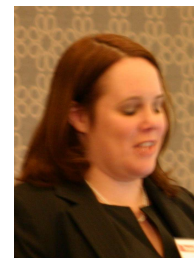
Hon. Miriam Quinn

reviews (“IPR”). There has been a steady increase in filings with the highest month to date in Dec. 2013 when 120 petitions were filed. On average for the last months, between roughly 60 and 80 petitions are filed each month. Of these, 70% are in the electrical/computer arts and 15% in the mechanical arts, with the balance split among the chemical, bio/pharma, design patent, and other areas. The PTAB currently has 181 APJs with 20% of those in satellite offices in Detroit, Denver, Dallas and Silicon Valley. Of the total 181 APJs, 40% are assigned to the trial docket handling these new post-issuance proceedings.

After an overview of new post-issuance proceedings and the workings of the PTAB, Judge Quinn outlined some of the lessons learned from the first 18 months of these proceedings. On motions to amend claims, Judge Quinn echoed comments from practitioners in earlier presentations—the PTAB is not granting many of these motions. Judge Quinn noted, however, that the ground rules for what should be in a motion to amend were set forth in the PTAB's decision in the *Idle Free* case. She also noted, as perhaps overlooked by some practitioners, that the APJs are not an examination corps. They do not search for prior art, but rather take the evidence presented and rule on it. Accordingly, the burden is on the patentee to show that an amended claim is patentable—not just over the art of record but over everything else that the patent owner is aware of. This is a high bar, but the PTAB continues to issue additional guidance in its written decisions such as the recent *Toyota Motors* case. On discovery and the content of petitions, Judge Quinn also noted key decisions, available on the PTAB's website in a section on representative AIA decisions, governing the standards for each and provided attendees with her view on some of these key issues in the new proceedings.

Inter Partes Review - Learning from the Denied Petitions

Kirby Drake, Partner, Klemchuk Kubasta, Dallas, provided an overview of and lessons learned from denied petitions for *inter partes* review (“IPR”). The lessons include: (1) failure to demonstrate that the petition meets the “reasonable likelihood of prevailing” standard for instituting IPR, (2) exceeding the one-year statutory bar for filing an IPR, (3) estoppel based on actions in other PTO or district court proceedings, (4) references that do not qualify as prior art, (5) prior art teaches away from the combination advocated by the petitioner, and (6) the claim interpretation advanced by petitioner is unreasonable. Understanding these lessons will benefit petitioners and respondents.



Kirby Drake

Inventor Issues Under the AIA

Iona Kaiser of McDermott Will & Emery in Houston discussed inventorship issues under the AIA. Topics included ensuring inventors understand the impact of the AIA's first-to-file provisions, ensuring proper assignment of patent ownership rights, and dealing with unavailable and uncooperative inventors.



Iona Kaiser

Ms. Kaiser also identified potential traps for practitioners. For one, if the employee-inventor is not your client, the employer should have the inventor execute any necessary documents to avoid potential conflict issues. Also, documents previously relevant to conception and diligent reduction to practice should still be kept, as they are now relevant to defending against claims of derivation.

Ms. Kaiser provided the audience with some

tips and best practices in dealing with application documents and processes. She suggested adding an assignment and declaration to any invention disclosure provided by an employee-inventor. Preferably, another, more formal assignment and declaration should also be obtained, but this may be helpful in a crunch. She also highlighted some ways the Patent Office has relaxed filing requirements, such as the lower burden in correcting inventorship and the ability to combine an assignment with a declaration.

The New PTO Ethics Rules

Greg Hasley of Hasley Scarano, L.L.P., presented on the new U.S. Patent & Trademark Office Rules of Professional Conduct and how the new rules affect Texas patent attorneys. The presentation began with an overview of the new Rules which apply to all attorneys or agents that appear before the USPTO. The new rules are based upon the ABA's Model Rules for Professional Conduct but Mr. Hasley warned that attorneys should be aware of the differences between the USPTO Rules, the Model Rules, and the Texas Disciplinary Rules for Professional Conduct.



Greg Hasley

Mr. Hasley then reviewed relevant case law showing that while in some situations the USPTO Rules may trump Texas Rules for Texas patent attorneys, the law does not provide a clear line of demarcation between whether Texas patent attorneys must follow the USPTO Rules versus the Texas Rules, and vice versa. He advised reviewing both sets of rules and proceeding with a course of conduct that would satisfy either rule if possible.

Finally, the presentation reviewed specific areas of difference between the new

USPTO Rules and the Texas Rules, including: (1) inclusion of patent agents in the USPTO Rules; (2) differences in confidentiality obligations; (3) differences in the transactions with clients; (4) the inclusion of a USPTO rule for dealing with prospective clients; and (5) significant differences in the advertising rules for lawyers.

Friday

Texas Uniform Trade Secrets Act

Friday morning started with Herbert Hammond, Partner, Thompson & Knight, Dallas, presenting an overview of the current Texas Uniform Trade Secrets Act ("TUTSA"). The overview included: (1) the definition of a trade secret; (2) the requirements of a trade secret under the TUTSA; (3) the subject matter of trade secrets, including compilations, negative know-how, and customer lists; (4) causes of action for misappropriation of trade secrets including the existence of a trade secret, improper acquisition, unauthorized disclosure and use, and discovery of a trade secret by improper means; (5) civil liability for trade secret misappropriation including the breach of a confidential or fiduciary relationship, the breach of an express contractual obligation, third party derivative liability, and the Texas theft liability act; (6) the effect of the TUTSA on criminal liability for trade secret misappropriation; (7) the remedies for statutory trade secret misappropriation including injunctive relief, the plaintiff's actual loss, unjust enrichment, reasonable royalty, exemplary damages, costs, and attorney fees; (8) defenses to statutory trade secret claims including a three-year statute of limitations, independent discovery and development by other means, unclean hands, and laches; and (9) protecting trade secrets during litigation



Herbert Hammond

including using protective orders and qualified privileges for protection of trade secrets from discovery.

USPTO AIA Pro Bono Assistance Program

Shekar Rao of the Center for Innovation (“CFI”) outlined the Patent Office’s Pro Bono Assistance Program under the AIA. The CFI is an Arlington, Texas based non-profit organization that has worked closely with the Patent Office to facilitate technology transfer between federal agencies and the private sector. The CFI also acts to place individual inventors with limited resources with patent and technology law firms willing to provide pro bono assistance.



Shekar Rao

Dr. Rao stressed that the center of gravity for innovation has moved from the United States to Asia. In 2012, for example, China became the world’s single largest patent filer, and Japan is close behind. The AIA is intended to reverse that move by supporting independent inventors, startups, and small business, which is where most innovation happens.

The Patent Office has taken a number of steps to achieve this objective. For one, the Office has established regional offices in Dallas/Fort Worth, Denver, San Jose, and Detroit to help foster American innovation, help inventors cut through red tape in the patent process, and create new opportunities in technology innovation. The Office has also established the pro bono assistance program in order to work with entities like the CFI. With these and other steps, the Office aims to reorient the global center of innovation back to the United States.

I’m So Confused - What Is Prior Art Now?

Marc Hubbard of Dallas discussed the AIA’s changes to what constitutes prior art under 35 USC § 102. He noted, however, the lack of case law addressing how to interpret the AIA’s changes. Mr. Hubbard recommended reviewing the Examination Guidelines for Implementing the First Inventor to File Provisions, which can be found at 78 Fed. Reg. 11059.

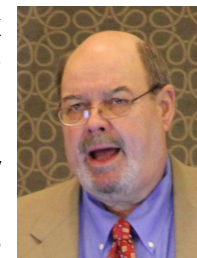
Mr. Hubbard noted that a number of issues remain unresolved. First, has the AIA eliminated secret commercial use and secret on-sale activities from prior art? And if so, what will be required to demonstrate public availability? Second, what proof is required to disqualify a disclosure by an inventor, or by someone who obtained the subject matter from an inventor? Third, how similar must a third-party disclosure be to an inventor disclosure to disqualify it? Mr. Hubbard expects to be dealing with these and other issues relating to the transition to the first-to-file system for many years.



Marc Hubbard

Unexpected Results - Primary or Secondary Considerations?

Pete Peterson with Cox Smith’s San Antonio office covered the historical and recent jurisprudence relating to so-called “secondary considerations” used in determining obviousness under 35 U.S.C. § 103. The palpable need for more predictability in obviousness judgments naturally calls for a renewed focus on objective criteria, which was the steady focus of the presentation.



Pete Peterson

Mr. Peterson began by briefly covering the history—including key holdings, reasoning, and administrative actions—reflecting the need for an obviousness standard and

sound application thereof. He noted, for example, the apparent practical application of an obviousness standard long before the existence of any formal rule equivalent to § 103: The very first US patent examiner, Thomas Jefferson, had only a 21% allowance rate, which is particularly surprising given the absence of any accumulated prior-art library. Lack of statutory guidance combined with limited early Patent Office resources set the stage for a period through the 1940s during which courts appeared inclined to invalidate any patent at issue.

The presentation then transitioned to the modern law of obviousness, but focused particularly on discretionary application of the fourth of the *Graham* factors, “secondary considerations.” The distinction of “secondary considerations” as “objective evidence of non-obviousness” combined with the readily-apparent need for objectivity for purposes of relative predictability renders the discretionary application questionable. Furthermore, as noted by Mr. Peterson, the “level of ordinary skill in the art” factor, which is a “primary” factor that must be considered, is arguably not adequately ascertainable without addressing at least the “unexpected results” and “long felt but unresolved need” considerations. Mr. Peterson therefore favors mandatory consideration of at least these factors as well.

Case Management Tips for In-House Counsel: Best Practices in Managing Litigation Dockets and Minimizing Cost

David Cho, Head Trademark and Copyright Counsel, AT&T, Dallas, and Brad Waugh, Senior Patent Litigation Counsel, Intel Corporation, Santa Clara, California, provided their best practices and tips for managing litigation dockets and minimizing litigation costs. Tom Tarnay, Partner, Sidley



& Austin, Dallas, moderated the panel.

Mr. Cho’s tips included: (1) moving quickly to resolve litigation issues and cases early to cut long-term litigation costs; (2) addressing challenges of staffing, trusting outside counsel, communication protocols and periodicity, and juggling multiple cases at once; (3) develop case strategies at the beginning of a case, obtain cost estimates as a benchmark to work against, provide general and specific outside-counsel guidelines and ensure outside counsel follows them, and constantly monitor costs and case management strategy; (4) outside counsel should understand their client’s business and how the litigation affects and fits into that business; (5) the lowest bid doesn’t always win—factors include quality, effectiveness, and reputation; (6) always have at least one person on outside counsel’s team that is responsible for communicating with the client; (7) cut costs by effectively managing discovery; (8) pay flat fees subject to monthly review; (9) monitor for outside counsel hours inflation by monitoring actual work done versus hours billed; (10) increase or decrease flat fees depending on successes of prior year; (11) to cut costs, don’t use U.S. counsel to help manage foreign counsel; and (12) before going in-house, learn how the legal department and company works to get things done.



Mr. Waugh’s tips included: (1) monitor outside counsel to ensure they are following the case management strategy; (2) maintain regular communications with outside counsel to address issues as they occur, e.g., via weekly team calls with attorneys and paralegals; (3) watch for lawyers that are good at selling their firm and services but don’t deliver; (4) use e-discovery model orders for reducing and managing e-

discovery costs, and limit the number of documents that are produced—only an extremely small percentage of documents are actually used; (5) use creative case management strategies such as limiting discovery until after claim construction; (6) avoid alternative fee arrangements because outside attorneys typically pay less attention to those cases—you get what you pay for; (7) use U.S. counsel to help manage foreign counsel when unfamiliar with a foreign country’s laws and procedures; (8) participate in joint defense groups to share costs when possible, e.g., prior art searches and experts; and (9) when going in-house, get up to speed as quickly as possible on your assigned cases.

Inside the Judge’s Chambers - A Conversation with Judge Kathleen O’Malley

During lunch, the Honorable Kathleen O’Malley, Circuit Judge, U.S. Court of Appeals for the Federal Circuit, was gracious to answer questions from Hope Shimabuku about key IP cases pending in the Federal Court system and her life and career. Ms. Shimabuku is in-house counsel at Xerox Business Services.



Hon. Kathleen O’Malley and Hope Shimabuku.

Judge O’Malley’s experience in private practice focused on complex corporate and intellectual property litigation, which prepared her well for presiding in over 100 patent and trademark cases. She regularly educates others and the judiciary on handling IP cases through her teaching on the faculty of the Berkeley Center for Law

and Technology and Case Western Reserve University School of Law.

Judge O’Malley shared intimate details about her clerkships and presidential appointment to the Federal Circuit in 2010 after 16 years of service on the district court bench. Ms. Shimabuku then delved into recent decisions made by the Federal Circuit, including *Akamai*, and O’Malley expounded on her positions (either for the majority or dissent) and her postulations as to how the Supreme Court might rule on these cases on appeal. The discussions concluded with a lively Q&A exchange between Judge O’Malley and the audience.

The Law of Inducement

Samuel E. Shehadeh of ExxonMobil provided an overview of current inducement standards with a focus on particular areas in which the law is evolving. Inducement liability seeks to prevent a defendant from avoiding liability by inducing



Samuel Shehadeh

another to infringe, and allows a patentee to pursue a single inducer where there are numerous direct infringers. Mr. Shehadeh reviewed the three elements required for inducement: (1) specific intent to cause infringement, (2) an inducing act, and (3) direct (actual) infringement. There are two knowledge prongs evaluated under the totality of the circumstances: (1) knowledge of the existence of the patent; and (2) knowledge that the induced acts constitute patent infringement. However, willful ignorance may be enough if a defendant: (1) subjectively believes there is a high probability of a patent, and (2) deliberately avoids learning of the patent.

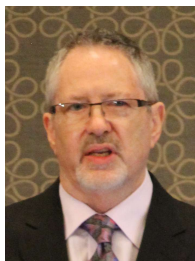
Mr. Shehadeh noted that it is black-letter law that demonstrated belief of non-infringement is relevant to show that an accused infringer lacked specific intent. And in *Commil USA*,

LLC v. Cisco Systems, Inc., 720 F.3d 1361 (Fed. Cir. 2013), the Federal Circuit recognized that a good-faith belief of invalidity may negate the requisite intent for induced infringement. Mr. Shehadeh also noted that the *en banc* Federal Circuit, in *Akamai Techs. Inc. v. Limelight Networks, Inc.*, 692 F.3d 1301 (Fed. Cir. 2012) held that the underlying infringement required for inducement need not be performed by a single actor. The Supreme Court granted *certiorari*, and briefing is ongoing.

Mr. Shehadeh further noted that the law continues to develop to include a range of acts that can constitute inducement, including a recent example in *Suprema, Inc. v. ITC*, 742 F.3d 1350 (Fed. Cir. 2013), in which the Federal Circuit vacated an exclusion order for biometric scanning hardware that did not infringe when imported but would infringe when used. The Court held that the conduct of the inducer was outside the scope of Section 337, which is limited to “articles that infringe.” A petition for rehearing *en banc* has been granted.

Lanham Act Injunctions - Aftermath of the eBay Decision

Drawing on his experience as a trademark practitioner at Hitchcock Evert, as an adjunct professor at Southern Methodist University’s School of Law, and as a member of the board of editors of *The Intellectual Property Strategist*, John M. Cone provided an insightful analysis of *eBay, Inc. vs. MercExchange, LLC*, 547 U.S. 388 (2006) and its effect on the ability of a trademark owner to obtain permanent injunctions against future acts of infringement as a matter of law.



John Cone

Mr. Cone stated first that *eBay* was essentially a patent infringement action in which the patent holder was not granted a

permanent injunction from infringement despite the lower court’s ruling of the patent to be valid and infringed and a presumption (albeit rebuttable) of irreparable harm. He noted that the Federal Circuit had applied a long-standing general rule that courts will issue permanent injunctions against patent infringement absent exceptional circumstances to reverse the lower court’s ruling, but the Supreme Court rejected this general rule and applied a new 4-factor test to determine the equity of issuing such a permanent injunction. Mr. Cone postulated that, given the broad general language of the new test and the Supreme Court’s citation to copyright injunction cases in support of this new test, this ruling leaves open the door for this new *eBay* 4-part test to be applied in the context of trademark infringement. Mr. Cone then outlined the post-*eBay* attempts by various circuit courts to apply this new test to trademarks when “irreparable harm” and damages are not easily quantifiable.

A trademark owner should not expect a permanent injunction to automatically issue where infringement is proven based on a likelihood of confusion. Instead, the trademark owner should provide sufficient evidence to prove that the infringing conduct will continue absent an injunction, that such harm is irreparable, and that money damages cannot be an adequate remedy.

Pitfalls of Software Licensing: Negotiating for Worst Case Scenarios

Software licensing typically is not the bailiwick for patent litigators; however, Lavonne Burke Hopkins has built upon her pre-law school experience and her biomedical engineering pedigree from John Hopkins University and Howard University to lead in the pursuit of intellectual property licensing and technology



Lavonne Burke Hopkins

transactions at the Houston office of Vinson & Elkins, LLP.

Ms. Hopkins provided practical tips for general IP practitioners to avoid pitfalls in software license negotiations, with special emphasis on the “cloud” and bankruptcy and M&A acquisitions. She focused on the common types of software license used in the industry and the standard terms found in those types of software licenses. Ms. Hopkins then highlighted where such basic standard terms may not favor the licensee, including automatic renewal, limitations on assignment, and automatic termination rights. Ms. Hopkins further explained that the use of software in a “cloud” environment can bring additional risks to data security. With respect to M&A issues, Hopkins outlined tips for software escrow and ensuring on-going use by affiliates and divested entities after sale.

Ms. Hopkins ended the presentation by stressing best practices for an attorney negotiating license agreements. She encouraged the audience to be open to negotiating “everything” and to be aware of the “gotchas” commonly found in standard form contracts.

IP Lawyers as Expert Witnesses

Russell T. Wong, of Wong, Cabello, Lutsch, Rutherford & Brucculeri L.L.P. in Houston, spoke about IP lawyers as Expert Witnesses. Mr. Wong noted that IP lawyers may serve as expert witnesses for a wide variety of topics because they can opine on several different issues ranging from licensing agreements to the procedures and practices of the Patent and Trademark Office.

Mr. Wong spoke at length regarding the main areas for which IP lawyers are called as expert witnesses: IP licensing agreements; IP industry norms; willfulness



Russell Wong

of infringement; ownership and assignment agreements; the practices and procedures of the USPTO; inequitable conduct; attorney malpractice; and the reasonableness of attorney’s fees.

Mr. Wong concluded with ethical considerations that attorneys should consider when serving as IP expert witnesses, including whether a firm conflicts out and whether the expert or the firm that hires the expert should write the expert’s report.

A special thanks to our contributing writers who shared their summaries of the CLE presentations for this edition of the Advanced Intellectual Property Law Course Report.



Matthew Baca

Matt Baca is a registered patent attorney having both law firm and in-house counsel experience in the areas of patent prosecution, IP agreements, and patent litigation. He has been a member of the State Bar of Texas since 1999 and is currently Senior IP Counsel with Delizio Gilliam PLLC in Austin.



Cathryn Berryman

Cathryn Berryman is a shareholder in Winstead P.C.’s Intellectual Property Practice Group. Her practice focuses on domestic and international intellectual property licensing and transactional work for a wide variety of industries representing both individuals and start-up, private and publicly traded technology companies. Cathryn also serves as the chairman of the State Bar of Texas, Women in IP Committee.



Indranil Chowdhury

Indranil Chowdhury is a principal in the Houston office of Chowdhury & Georgakis, P.C. Mr. Chowdhury has a comprehensive intellectual property practice that includes patent preparation and prosecution, counseling, licensing, and litigation in high-technology matters.



Peter Corcoran

Peter Corcoran is the founder of Corcoran IP Law and specializes his practice in plaintiff's patent litigation. Peter earned his electrical engineering and law degrees and worked at some of the nation's top patent litigation firms before starting his own practice. Peter clerked for the former Chief Judge Randall Rader of the Federal Circuit and the former Chief Judge David Folsom of the Eastern District of Texas.



David DeZern

David T. DeZern is an associate in Sidley Austin's Dallas office. Mr. DeZern's practice focuses primarily on patent litigation. Mr. DeZern has represented both plaintiffs and defendants in patent litigation involving a variety of technologies, including power converters, software, and electronic design automation, and at all stages, including initial pleadings, fact and expert discovery, claim construction, trial, and appeals. Mr. DeZern received his bachelor of science in electrical engineering and law degree from the University of Texas.



Greg Hasley

Greg Hasley is an attorney with Hasley Scarano, L.L.P. Mr. Hasley has a general intellectual property practice that includes prosecution, litigation, and transactional matters.



Michael Hawes

Michael Hawes is a partner in the Intellectual Property group of Baker Botts. Mr. Hawes assists companies seeking to resolve technology disputes, handling negotiations and cases dealing with patent and copyright infringement, antitrust violations, trade secret misappropriation and violation of the intellectual property provisions of employment agreements, especially concerning software.



Peggy Keene

Pei-Chih "Peggy" H. Keene, an Associate with Klemchuk Kubasta LLP, works with clients in all aspects of trademark law, including domestic and foreign prosecution, opposition and cancellation proceedings, and general enforcement. Ms. Keene prepares various intellectual property agreements, including licensing and assignments, mergers and acquisitions transactions, domain name disputes, Internet website policies, and copyrights. She also provides litigation support for intellectual property trials and assists with representing clients in trademark disputes and proceedings before the Trademark Trial and Appeal Board. She earned a J.D. from Southern Methodist University, Dedman School of Law, and a Bachelor of Arts Degree from Duke University.



Michael Paul

Michael Paul is an attorney with Gunn, Lee & Cave, P.C., a San Antonio boutique intellectual property firm. He holds a J.D. from St. Mary's, as well as a B.S. in Electrical Engineering and an MBA from Texas A&M.



Eagle Robinson

Eagle Robinson is a senior associate in the Austin office of Norton Rose Fulbright. He practices patent law, both litigation and transactional, primarily related to mechanical and electrical technologies.

The above reports express the views of the authors and not that of the State Bar of Texas IP Law Section.
