

The Sedona Conference
WG9 and WG10 Joint Midyear Meeting
The Langham Huntington Hotel,
Pasadena, California

DAY ONE: Thursday, February 11, 2016 [Jan. 26 ver.]

7:30 — 8:30 Continental Breakfast & Registration

8:30 — 8:45 Welcome and Introductions
(Hoffman, Jeffries, Weinlein)

8:45 — 9:45 How early in the process can litigants learn the amount of alleged patent damages? Getting to the elephant in the room—What is the applicable royalty base?
(Chatterjee, Finocchio, Grewal (J), Jeffries*, Morando, Nawrocki)

Materials:

- [1] *Pretrial Principles and Best Practices, Ch. III of WG9 Commentary on Patent Damages and Remedies* (Feb. 2016 ver.)
- [2] *WG9 Commentary on Patent Damages and Remedies: Proposed Model Rule for Damages Contentions* (Dec. 2015 ver.)
- [3] *WG10 Commentary on Patent Litigation Best Practices: Case Management Issues from the Judicial Perspective* (Dec. 2015 Edition)
- [4] *WG10 Commentary on Patent Litigation Best Practices: Discovery Chapter* (Dec. 2015 Edition)
- [5] *WG10 Commentary on Patent Litigation Best Practices: Use of Experts, Daubert, and Motions in Limine Chapter* (Dec. 2015 Edition)

9:45 — 10:45 Heightened pleadings standard—New world post-Form 18: Is more required and if so then what?
(Bencivengo (J), Brandt, Fishman, Key, Spears*)

Materials:

- [6] *WG10 Commentary on Patent Litigation Best Practices: Heightened Pleadings Standard Chapter* (Feb. 2016 ver.)

10:45 — 11:00 Morning Break

11:00 — 12:00 Patent mediation—a continuing process to define and simplify the issues for helping to resolve the dispute.
(Burns, Garbis (J), Ludington, Thompson, Wine*)

Materials:

- [7] *WG10 Commentary on Patent Litigation Best Practices: Mediation Chapter* (Feb. 2016 ver.)

12:00 — 1:15 Lunch

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1:15 — 2:15 Potential ramifications of *Alice*—Impact on diagnostics, biotech, and computer software?

(Elson, Hutz, Powers*, Shih, Supko)

Materials:

- [8] *Alice/Section 101 Motions, Sect. of WG10 Commentary on Patent Litigation Best Practices: Case Management Issues from the Judicial Perspective* (Feb. 2016 ver.)
- [9] Natalie Hanlon Leh, Nora Q.E. Passamaneck, Christian Hollweg, *Claim Construction Issues Raised by Alice* (Feb. 2016).
- [10] Vera Elson & Sara Rose, *Section 101: Should Clear and Convincing Standard Apply* (Sept. 2015)
- [11] *WG10 Commentary on Patent Litigation Best Practices: Summary Judgment Chapter* (Oct. 2015 Edition)

2:15 — 3:15 Management of Pharma/Bio Patent Litigations—Understanding their special issues.

(Cannella, Fishman*, Hutz, Rurka, Storto)

Materials:

- [12] *WG10 Commentary on Patent Litigation Best Practices: Biopharma Litigation Chapter, Project Charter* (Feb. 2016 ver.)
- [13] Deborah Fishman, [Biopharma Related Excerpts from] *PATENT LITIGATION STRATEGIES HANDBOOK* (2015).

3:15 — 3:30 Afternoon Break

3:30 — 4:30 FRAND/SEP—Effective case management to focus the issues and advance the litigation

(Antush, Long*, Meyer, O'Quinn, Selwyn)

Materials:

- [14] *WG9 Commentary on Patent Damages and Remedies: SEP/FRAND Litigation Chapter* (Feb. 2016 ver.)

4:30 — 5:30 International Trade Commission section 337 investigations

(Busey, Schaumberg*, Scott, Thomases)

Materials:

- [16] *WG10 Commentary on Patent Litigation Best Practices: International Trade Commission Section 337 Investigations Chapter, Project Charter* (Feb. 2016 ver.)
- [17] Tom M. Schaumberg, ed., *A LAWYER'S GUIDE TO SECTION 337 INVESTIGATIONS BEFORE THE U.S. INTERNATIONAL TRADE COMMISSION* (3d ed., 2016)

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7:30 — 8:30 Continental Breakfast & Registration

8:30 — 9:45 Is the patent system inherently abusive or is the abuse of the patent system (and of the courts) the issue?

(Arnold, Conti (J), Elson, Hoffman, Scott)*

Materials:

- [19] *WG10 Commentary on Patent Litigation Best Practices: Introductory Chapter* (July 2015 Edition)
- [20] Chief Judge John G. Roberts Jr., *2015 Year-End Report on the Federal Judiciary* (Jan. 2016)
- [21] Hon. Elizabeth D. Laporte and Jonathan M. Redgrave, *A Practical Guide to Achieving Proportionality Under New Federal Rule of Civil Procedure 26* (2015)
- [22] Ambassador Michael B.G. Froman, United States Trade Representative, *2015 Special 301 Report* (Apr. 2015)
- [23] Christopher Beauchamp, *The First Patent Litigation Explosion* (2016, forthcoming)
- [24] Vera Elson, *Change in Marking Statute Would Curtail Troll Litigation* (Mar. 2015)

9:45 — 11:00 Best practices for USPTO/PTAB proceedings and effective coordination between the USPTO/PTAB and district court proceedings

(Banowitz, Morin, Obermann (J), Rea, Stroud, Thompson)*

Materials:

- [25] *WG10 Commentary on Patent Litigation Best Practices: Parallel USPTO Proceedings Chapter* (Feb. 2016 ver.)

11:00 — 11:15 Morning Break

11:15 — 12:30 When do exceptional case issues give rise to ethical concerns?

(Arnold, Beckwith, Porter (J), Trybus, Waterland)*

Recent amendments to the Comments to the Model Rules of Professional Conduct recommend that all attorneys “keep abreast of changes in the law and its practice, including the benefits and risks associated with relevant technology” in representing clients and supervising the work of staff and assistants. The overall goal of the changes is to make the process more efficient and minimize abuse. This panel explores the increased emphasis on cooperation, proportionality, and civility in litigation which requires attorneys to take a fresh look at the Rules of Professional Conduct in relationship to the newly amended Rule 1 of the Federal Rules of Civil Procedure, the landmark State Bar of

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California Formal Opinion 2015–193, and developing case law under 35 U.S.C. § 285, which authorizes attorney fee shifting in "exceptional cases."

"Exceptional case" analyses have always been premised on some proactive conduct by counsel or a party, such as obstructing depositions or overzealously pursuing weak claims. With the new emphasis on technological competence found in the ABA Model Rules and the California ethics opinion, could attorneys' fees based on a finding of "exceptional case" also be awarded for negligent technological incompetence, such as:

- the failure to use available technology to more fully research a claim, defense, or witness, e.g., for plaintiff's prefiling investigation of accused infringing products as necessary to comply with Rule 11;
- the refusal to engage opposing counsel in discussions around the use of advanced technology and a Rule 502(d) order to, for example:
 - cull large documents collections of nonresponsive and irrelevant documents before production;
 - reduce the cost of privilege review and logging; and
- the misapplied use of technology-assisted review in document review and production resulting in responsive documents not being produced?

Materials:

- [27] *WG10 Commentary on Patent Litigation Best Practices: Section on Exceptional Case Determinations* (Dec. 2016 ver.)
- [28] *The State Bar of California Standing Committee on Professional Responsibility and Conduct, Formal Opinion No. 2015-193* (June 2015)
- [29] Robert Hilson, *Five Ways to Avoid Getting Sued for Discovery Malpractice* (Jan. 2016)

12:30 — 12:35 Closing Statements

(Weinlein)

12:35 — 1:30 Grab and Go Lunch (provided)