



**HIPLA**



**1993  
9TH ANNUAL  
INTELLECTUAL PROPERTY LAW INSTITUTE**

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*San Luis Hotel, Galveston, Texas  
September 30 - October 2, 1993*

*Co-Sponsored by*  
**HOUSTON INTELLECTUAL PROPERTY LAW ASSOCIATION**  
*AND*  
**UNIVERSITY OF HOUSTON LAW CENTER**  
**INTELLECTUAL PROPERTY PROGRAM**

*Generously Underwritten by:*

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**THE PROGRAM HAS BEEN DESIGNED TO PROVIDE:**

DON DUNNER ON EFFECTIVE ADVOCACY BEFORE THE FEDERAL CIRCUIT  
NEW THINKING ON VENTURE CAPITAL FOR HIGH-TECHNOLOGY ENTERPRISES  
COPYRIGHT UPDATE: FAIR USE AFTER *TEXACO*; DATA COMPILATIONS AFTER *FEIST*

**PANEL DISCUSSIONS ON:**  
EXPANDING ROLE OF IN-HOUSE COUNSEL IN LITIGATION  
INTERACTION OF LAWYERS AND ACCOUNTANTS ON FINANCIAL ISSUES

**BREAKOUT SESSIONS ON:**  
OVERVIEW OF IP LAW FOR BEGINNERS AND NON-IP LAWYERS  
DRAFTING OF OPINION LETTERS  
HANDLING REISSUES AND REEXAMINATIONS



# 9TH ANNUAL INTELLECTUAL PROPERTY LAW INSTITUTE

San Luis Hotel, Galveston, Texas · Sept. 30 - Oct. 2, 1993

## PROGRAM

### THURSDAY, SEPTEMBER 30, 1993

- 2:00 Registration
- 2:30-5:00 **Overview of IP Law for New and Non-IP Lawyers**  
 Moderator: Tim Headley (*Baker & Botts*)  
 2:30 Patents Tim Cook (*Gunn & Kuffner*)  
 3:05 Trade Secrets Jennifer Sickler (*Jenkins & Gilchrist*)
- 3:40 Copyrights Prof. Philip Page (*South Texas College of Law*)
- 4:20 Trademarks and Unfair Competition Richard Redano (*Rosenblatt & Associates*)
- 2:30-4:00 **Workshop: Drafting IP Opinions** Frank Vaden and Sarah Harris (*Vaden, Eickenroht*)
- 4:15-5:45 **Workshop: Handling Reissues and Reexaminations** J.B. Thompson and Jeff Pyle (*Vaden, Eickenroht*)
- 6:00 Cocktail Reception, San Luis Hotel
- 7:00 Dinner (on your own)

### FRIDAY, OCTOBER 1, 1993

- 7:30 Continental Breakfast
- 8:20 Opening Remarks Paul Van Slyke (*Program Chairman*)  
 Morning Program Moderator: Irene Kosturakis (*Compaq Computer Corp.*)
- 8:30 IP Statutory Update Dean Joyce, Prof. Janicke (*Univ. of Houston Law Center IPP*)
- 9:00 Effective Advocacy Before the Federal Circuit Don Dunner (*Finnegan, Henderson*)
- 9:30 Coffee Break
- 9:45 Proving Likelihood of Confusion in the Fifth Circuit Bill Barber (*Arnold, White & Durkee*)
- 10:15 Fair Use After *Texaco*, and The Copyright Clearance Center Kim Muller (*Shell Oil Co.*)
- 10:45 Experimental Use Exception to Patent Infringement Russell Wong (*Arnold, White & Durkee*) Lester
- 11:15 Alternatives to Patents in Protecting Intellectual Workproducts Hewitt (*Pravel, Hewitt, Kimball & Krieger*)
- 11:45 Reception and Luncheon Speaker: Hon. Randall Rader (*U.S. Court of Appeals for the Federal Circuit, "Biotechnology and Computer Software"*)

### Afternoon Program

- Moderator: Paul Janicke (*Univ. Of Houston Law Center IPP*)
- 1:15 Doctrine of Equivalents and Its Impact On "Designing Around" Paul Katz (*Honigman, Miller*)
- 1:45 Extraordinary Remedies in Trademark and Copyright Cases Paul DeVerter (*Fulbright & Jaworski*)
- 2:15 Ripples In the Wake of *Feist* Prof. Ray Patterson (*Univ. of Georgia*)

- 2:45 Coffee Break
- 3:00 **Panel: Interaction of Lawyers and Accountants on Financial Issues**  
 Panel Moderator: Mark Gilbreth (*Jenkins & Gilchrist*); Walt Bratic (*Price Waterhouse*); Barbara Duganier (*Arthur Andersen*); Herbert Warner (*KPMG Peat Marwick*); Stephen Willis (*Peterson Consulting*); Richard Domercq (*Grant Thornton*)
- 4:00 The Venture Capital Process and Raising Money for New Enterprises Walt Cunningham (*Acorn Fund*)
- 4:30 The Double Bursting Bubble: Laches and Estoppel After *Auckerman* Jeff Tayon (*Conley, Rose & Tayon*)
- 6:00 Evening Social

### SATURDAY, OCT. 2

- 7:15 Continental Breakfast
- 8:10 Announcements Paul Van Slyke (*Program Chairman*); Morning Moderator: Raul Montes (*Exxon Exploration Co.*)
- 8:15 Ten Commandments of Persuading Patent Juries Dr. Ross Laguzza (*DecisionQuest*)
- 8:45 How To Win Intellectual Property Trials Chief Judge Norman Black (*Southern District of Texas*)
- 9:15 Is It A Trademark License, Franchise, or Business Opportunity? Greg Maag (*Conley, Rose & Tayon*)
- 9:45 Coffee Break
- 10:00 **Panel: The Expanding Role of In-House Counsel in Litigation Management and Cost Control**  
 Panel Moderator: Paul Van Slyke (*Pravel, Hewitt*); Allen Lackey, General Counsel, (*Shell Oil Co.*); Jeff Pendergraft, General Counsel, (*Lyondell Petrochemical Co.*); Bill Fargo (*General Counsel, Compaq Computer Corp.*); Howard Rudge (*General Counsel, Conoco Inc.*); David Garten (*NL Industries Inc.*)
- 11:30 Overview of ITC Practice Relating to IP Rights Bill LaFuze (*Vinson & Elkins*, President, American Intellectual Property Law Association)
- 12:00 Computer Law Update Tom Adolph (*Baker & Botts*)

### SATURDAY AFTERNOON

- Golf:** Call Jim Riley, *Pravel, Hewitt, Kimball & Krieger* for details (713-850-0909)
- Tennis:** Call Jennifer Sickler, *Jenkins & Gilchrist* for details (713-951-3300)

**Friday AM Spouse Activities:**  
 Call Karen Van Slyke for details (713-850-0873)



## BACKGROUND OF PARTICIPANTS

### TOM ADOLPH

Mr. Adolph is an IP partner with Baker & Botts, Houston. He is Regional Director of the International Computer and Technology Law Committee of the International Bar Association, and serves on two AIPLA committees.

### BILL BARBER

Bill Barber is an associate with Arnold, White & Durkee's Austin office. His practice has involved extensive trademark litigation, particularly in the Fifth Circuit.

### NORMAN BLACK

As Chief Judge of the U.S. District Court for the Southern District of Texas, Judge Black presides over one of the most active IP district courts in the United States. He is a frequent lecturer on patent litigation topics.

### WALT BRATIC

Walter Bratic is a partner in the Houston office of Price Waterhouse. He has extensive IP experience, including matters relating to licensing, determination of reasonable royalties, calculation of lost profits, antitrust issues as well as valuation of intellectual property.

### TIM COOK

Mr. Cook is with the Houston IP firm of Gunn & Kuffner, where he practices in both the prosecution and litigation arenas, primarily in the electrical and mechanical arts.

### WALT CUNNINGHAM

Walter Cunningham is a physicist who began his career as a Marine Corps fighter pilot and holds the rank of Colonel, USMCR-Retired. He was one of NASA's first civilian astronauts and the pilot of Apollo 7 - the first manned flight of the Apollo program. He is currently the Managing General Partner of The Genesis Fund, a \$16 million venture capital pool with a portfolio of 20 start-up and early stage companies.

### PAUL DeVERTER

Paul DeVerter has been an IP lawyer with Fulbright & Jaworski since 1959. He practices primarily in unfair competition and trademark law. He has handled both trademark counterfeit raids and computer software raids.

### RICHARD DOMERCQ

As a partner in Grant Thornton's Houston office, Mr. Domercq directs a practice

group which performs damage analyses and accounting investigations in business litigation matters, including intellectual property disputes. He is a CPA and graduate of MIT with degrees in electrical engineering and management.

### DON DUNNER

Mr. Dunner is a partner in the Washington D.C. firm of Finnegan, Henderson, Farabow, Garrett & Dunner. He is a past President of AIPLA and is a Council Member of the IP Law Section of ABA. He was Chairman of the Advisory Committee of the Federal Circuit Court of Appeals from 1982 to 1992. Mr. Dunner is a co-author of *Court of Appeals for the Federal Circuit: Practice and Procedure*.

### BARBARA DUGANIER

Ms. Duganier is Partner-in-Charge of Arthur Andersen's Houston Litigation Services Practice, and has served as a consulting and testifying expert on damages in numerous cases. She is a CPA and a Certified Fraud Examiner.

### BILL FARGO

Bill Fargo is Vice President and General Counsel of Compaq Computer Corp. He was previously with Texas Instruments, and in both capacities dealt with large-scale litigation in the IP area.

### DAVID GARTEN

Graduated from Yale Law School in 1977. After a clerkship with Judge Anthony Kennedy, then on the Court of Appeals for the Ninth Circuit, he joined Kirkland & Ellis in Chicago. In 1990 he became Vice President and General Counsel of NL Industries, Inc. in Houston.

### MARK GILBRETH

J. Mark Gilbreth is a member of the Jenkins & Gilchrist Intellectual Property Section in Houston, and received a B.S.Ch.E. from the University of Arkansas and a J.D. from the University of Tulsa.

### SARAH T. HARRIS

Sarah Harris has been associated with the law firm of Vaden, Eickenroht, Thompson, Boulware & Feather for two years. Her practice is concentrated in the area of patent and trademark prosecution.

### TIM HEADLEY

Tim Headley is an attorney with Baker

and Botts. He is the co-author of several IP publications including "Jury Trials in Patent Cases".

### LESTER HEWITT

Les Hewitt is a shareholder in Pravel, Hewitt, Kimball & Krieger. He is actively involved in all phases of intellectual property litigation and problem-solving. He is a Past-President of HIPLA.

### PAUL JANICKE

Prof. Janicke is Co-Director, with Associate Dean Craig Joyce, of the Intellectual Property Program at the University of Houston Law Center, and is Of Counsel to Arnold, White & Durkee.

### CRAIG JOYCE

Dean Joyce is Associate Dean of the University of Houston Law Center, and Co-director of the Intellectual Property Program there. He is a leading copyright authority, and he co-authored the leading article cited by the Supreme Court in *Feist*.

### IRENE KOSTURAKIS

Irene Kosturakis is in-house Patent Attorney for Compaq Computer Corporation.

### PAUL KATZ

Paul Katz is with the IP section of Honigman Miller Schwartz & Cohn in Houston. Formerly a practicing electrical engineer, his practice concentrates in electronic patent matters.

### ALLEN LACKEY

Mr. Lackey is Vice-President and General Counsel of Shell Oil Co. He has been active in the development of in-house litigation capabilities at Shell, and has had a managerial role in numerous IP litigations.

### BILL LaFUZE

Bill LaFuze is a partner in the Houston office of Vinson & Elkins, is very active in national and local bar work, and is the current President of AIPLA. His practice is primarily in patent litigation.

### ROSS LAGUZZA

Dr. Ross Laguzza is Managing Partner of DecisionQuest, a leading trial consulting firm. He has consulted with attorneys on over 500 trials in 36 states and Puerto Rico. He specializes in complex litigation.

### GREG MAAG

Greg Maag, a director with Conley, Rose



## BACKGROUND OF PARTICIPANTS (cont'd)

and Tayon, specializes in IP litigation and franchising. He has extensive experience in franchise structuring, disclosure law compliance, and in operational issues.

### RAUL MONTES

Raul Montes is a patent attorney for Exxon Exploration Company.

### KIM MULLER

Mr. Muller is a senior trademark attorney with Shell Oil Co., and is involved in both prosecution and litigation in the trademark and copyright areas. A frequent lecturer on IP law topics, he is a past Secretary of HIPLA.

### PHILLIP EDWARD PAGE

Phillip Edward Page is professor of law at South Texas College of Law, where he has taught various intellectual property courses since joining the faculty in 1984.

### RAY PATTERSON

Prof. Patterson is Pope Brock Professor of Law at the University of Georgia, and specializes in copyright. He is the author of influential copyright articles and two books on copyright.

### JEFF PENDERGRAFT

Senior Vice President and General Counsel of Lyondell Petrochemical Company, a finalist for the Malcolm Baldrige National Quality Award in 1991 and 1992. Graduate of Stanford Law School.

### JEFFREY PYLE

Jeff Pyle has been an associate with Vaden, Eickenroht since 1989. His practice has involved all aspects of IP law, including patent prosecution and litigation.

### RANDALL RADER

Judge Rader is an Associate Judge of the Federal Circuit Court of Appeals.

### RICHARD REDANO

Richard Redano practices IP law with Rosenblatt & Associates, Houston. His practice is devoted largely to litigation in the areas of unfair competition, copyright, and trade secrets.

### HOWARD RUDGE

Howard J. Rudge is senior vice president and general counsel of Conoco and vice president and assistant general counsel of the DuPont Company. He is a member of the Houston, Virginia, and District of Columbia Bar Associations. He currently serves on the board of Directors of the Houston Bar Foundation.

### JENNIFER SICKLER

Ms. Sickler is an IP lawyer with Jenkins & Gilchrist in Houston. She is a former law clerk for Houston Federal District Judge Simeon Lake. Her practice has emphasized trade secret litigation.

### JEFF TAYON

Jeff Tayon is a director of Conley, Rose & Tayon, specializing in IP litigation. He is the current President of HIPLA, and is a former Examiner in the medical arts and Law Clerk to Federal Circuit Judge Jack Miller.

### J.B. THOMPSON

J.B. Thompson is a partner in Vaden, Eickenroht, Thompson, Boulware & Feather. He has over thirty years' experience in intellectual property law practice.

### FRANK VADEN

Frank Vaden is founding partner of Vaden, Eickenroht, Thompson, Boulware & Feather. He has counselled clients on IP matters for over 30 years. He now spends a significant amount of his time as an expert witness in patent litigation and in mediation of patent disputes.

### PAUL VAN SLYKE

Paul Van Slyke is a shareholder in Pravel, Hewitt, Kimball & Krieger, and has been litigating IP cases for over 25 years. In addition to teaching law-school courses, he is a frequent lecturer and writer on IP topics and has served as an expert witness in patent and trademark cases.

### HERB WARNER

Mr. Warner, Partner-in-charge of KPMG Peat Marwick's Southwest Litigation

Services Group, has provided attorneys financial, accounting, and economic analyses of claims ranging from thousands to billions of dollars.

### STEPHEN WILLIS

Stephen I. Willis is an executive vice president of Peterson Consulting Limited Partnership having firmwide responsibility for the intellectual property consulting practice. Mr. Willis has substantial experience in the determination and evaluation of lost profits, reasonable royalty and prejudgement interest in connection with IP litigation.

### RUSSELL WONG

Russell Wong is a member of the Houston office of Arnold, White & Durkee, where his practice is concentrated in the area of patent litigation.

## PROGRAM ADMINISTRATION

Paul Van Slyke, Pravel, Hewitt, Kimball & Krieger, *Chairman*; Prof. Paul Janicke, University of Houston Law Center, *Vice-Chairman*; Randy Smith, Pravel, Hewitt, Kimball & Krieger, *Arrangements*; Karen Van Slyke, *Spouse Tour*; Kimberly Lopez, IPP, *Coordinator*.

### Committee Members:

Margaret Anderson, Meg Boulware, Marc Delflache, Mark Gilbreth, Alan Gordon, Tim Headley, Mike Heim, Dean Craig Joyce, Irene Kosturakis, Ken Kuffner, Kim Muller, Prof. Ray Nimmer, Jeff Tayon, Frank Vaden.

**Houston Intellectual Property Law Association:** Jeffrey Tayon, *President*, Margaret Boulware, *President-Elect*, Margaret Anderson, *Secretary*, Raul Montes, *Treasurer*, Harold Delhommer, *Immediate Past President*.

**Intellectual Property Law Program of the University of Houston Law Center:** Prof. Paul Janicke and Associate Dean Craig Joyce, *Co-Directors*.



## REGISTRATION INFORMATION

### REGISTER IN ADVANCE

#### Fees:

\$275.00 ..... HIPLA members up to September 1  
\$325.00 ..... Non-HIPLA members up to September 1  
\$350.00 ..... HIPLA members after September 1  
\$400.00 ..... Non-HIPLA member after September 1

Refunds will be granted only if they are requested in writing and postmarked no later than September 8, 1993. If you do not attend the program and do not request a refund, you will be mailed the written materials.

#### QUESTIONS?

If you have any questions about the Program, please call Kimberly Lopez of UHIPP, at (713) 743-2180.

### WRITTEN MATERIALS

Extensive articles on the presentations will be bound as a Program book and included in the registration fee and handed out during registration.

### HOTEL ACCOMMODATIONS

You must communicate directly with the San Luis Hotel in order to reserve a room. A registration form is included in this brochure which should be completed and mailed to the San Luis Hotel. The deadline for making your reservation is September 7, 1993. After this date, reservations are made on a space available basis only. Telephone Number is (800) 392-5937.

## REGISTRATION FORM

INTELLECTUAL PROPERTY LAW INSTITUTE • SEPTEMBER 30 - OCTOBER 2, 1993

*San Luis Hotel, Galveston, Texas*

MAIL REGISTRATION FORM or Program BOOK REQUEST TO:

Kimberly Lopez, University of Houston Law Center • Houston, TX 77204-6371

NAME
AFFILIATION
ADDRESS
CITY/STATE/ZIP
PHONE NUMBER
SPOUSE/PARTNER NAME (If Attending)

#### I. REGISTRATION FEES (CHECK ONE)

- ☐ \$275 HIPLA members up to Sept. 1 (book incl.)  
☐ \$325 Non-HIPLA members up to Sept. 1 (book incl.)  
☐ \$350 HIPLA members after Sept. 1 (book incl.)  
☐ \$400 Non-HIPLA members after Sept. 1 (book incl.)  
☐ \$ 35 Limited Student Enrollment (lunch not incl.)  
☐ \$ 75 Program Book only (will not attend seminar)

#### AMOUNT

#### II. OTHER EXPENSES (CHECK ALL THAT APPLY)

- ☐ Friday Lunch  
\$30 ea. x \_\_\_\_\_ (# of reservations) = \_\_\_\_\_  
☐ Friday Spouse's Tour, includes lunch  
\$35 ea. x \_\_\_\_\_ (# of reservations) = \_\_\_\_\_  
☐ Friday night Reception, Dinner and Cruise  
\$45 ea. x \_\_\_\_\_ (# of reservations) = \_\_\_\_\_  
☐ Golf Saturday Afternoon (24 person limit)  
\$60 ea. x \_\_\_\_\_ (# of reservations) = \_\_\_\_\_  
Please indicate handicap ( \_\_\_\_\_ )  
☐ Tennis Saturday Afternoon  
\$20 ea. x \_\_\_\_\_ (# of reservations) = \_\_\_\_\_

## HOTEL REGISTRATION FORM

9TH ANNUAL INTELLECTUAL PROPERTY LAW INSTITUTE

#### Mail Hotel Registration to:

San Luis Hotel  
5222 Seawall Blvd.  
Galveston Island, Texas 77550

**Registrations Must Be Received By September 7, 1993**

(800) 392-5937

Single or Double: ☐ \$87 night (all have ocean view)

☐ VISA ☐ American Express ☐ MasterCard ☐ Other \_\_\_\_\_ Card Number: \_\_\_\_\_ Exp. Date: \_\_\_\_\_

Cardholder's Name: \_\_\_\_\_

Arrival Date: \_\_\_\_\_ Departure Date: \_\_\_\_\_

Name: \_\_\_\_\_ Roommate: \_\_\_\_\_

Company/Organization: \_\_\_\_\_ Phone: \_\_\_\_\_

Address: \_\_\_\_\_ City/State/Zip: \_\_\_\_\_

**ANY CANCELLATIONS MUST BE RECEIVED AT LEAST 24 HRS PRIOR TO ARRIVAL DATE**

*All requests subject to availability. Reservations will be considered tentative unless guaranteed by first night's deposit or major credit card.*

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## Summary of the Program

*Casual Attire is encouraged for all aspects of the Program.*

### THURSDAY WORKSHOPS AND IP OVERVIEW

- Thursday afternoon workshops on: (1) Drafting IP Opinions; (2) Handling Reissues and Reexaminations.
- Thursday afternoon Overview of IP: introductory discussions for new and non-IP lawyers.

### FRIDAY & SATURDAY SESSIONS

- Sixteen lectures on topics of current IP interest.
- Special Features:
  - (1) Panel on Interaction of Lawyers and Accountants on Financial Issues
  - (2) Panel on The Expanding Role of In-House Counsel in Litigation.
  - (3) Lunch with Judge Randall Rader of the Federal Circuit.

### RECREATIONAL AND SOCIAL ACTIVITIES

- **COCKTAIL RECEPTION:** Cocktails and soft drinks will be served at the San Luis Hotel on Friday evening.
- **TOUR OF ELISSA:** The three-masted sailing ship *Elissa* will be open for a private showing to our Program registrants and their guests on Friday evening. Beer, wine and soft drinks will be served. Boarding begins at 6:00 pm (No high heels allowed.)
- **DINNER ABOARD COLONEL:** The Victorian-style paddlewheel steamer *Colonel*, berthed next door to *Elissa*, will be our dinner

cruise ship Friday night. It features an open-air promenade, dancing to live music, and dining in the air-conditioned dining room. A pay bar will be available. Boarding begins at 7:00 pm, with underway time at 8:00 pm. Return at 10:00 pm.

- **SPOUSE TRIP TO MOODY GARDENS:** Begins Friday morning at the 3-D IMAX Theater (one of only three in the world). The award-winning film *The Last Buffalo* becomes incredibly realistic as images seem to leap from a six-story-tall screen. Then experience the rain forests of Africa, Asia, and South America in the ten-story-tall glass pyramid. After lunch at the waterfront Garden Restaurant, the group will be returned to the San Luis Hotel. Those wishing to shop will be deposited at the Strand, but must arrange their own transportation back to the hotel. Total Cost: \$35.00.

### MINIMUM CONTINUING LEGAL EDUCATION

This program is pending approval for Minimum Continuing Legal Education credit by the State Bar of Texas. The Friday and Saturday portions will be 10.0 hours with an additional 3.0 hours for the Thursday workshops.

### LOCATION

The San Luis Hotel is located in Galveston, Texas, on Seawall Boulevard. From Houston, take I-45 South to the Seawall. Proceed south (turn right) on Seawall Boulevard to 5222 Seawall Boulevard. Telephone number: 800-392-5937; Houston 713-280-3924.

Kimberly Lopez  
University of Houston Law Center  
Houston, Texas 77204

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