

# THIRTEENTH ANNUAL INSTITUTE ON INTELLECTUAL PROPERTY LAW

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*Tremont House Hotel, Galveston, Texas  
September 25 - 27, 1997*

*Co-Sponsored by:*

**HOUSTON INTELLECTUAL PROPERTY  
LAW ASSOCIATION**

**UNIVERSITY OF HOUSTON LAW CENTER  
INTELLECTUAL PROPERTY PROGRAM**

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## **PROGRAM HIGHLIGHTS**

**Luncheon with Eleventh Circuit Judge Stanley Birch, Jr.**

**The Impact of *Hilton Davis* on Patent Practitioners**

**Panel on Insurance Coverage Relating to Intellectual Property**

**Panel on Scope of Copyright Protection for Computer Software**

**Panel on Malpractice: Pitfalls for the Unwary**

**Panel on Ethics: Ethics and the Practice of IP Law**

# HIPLA



In studying the history of the human mind one is impressed again and again by the fact that the growth of the mind is the widening of the range of consciousness, and that each step forward has been a most painful and laborious achievement...Ask those who have tried to introduce a new idea!

*Carl Jung*

# 13TH ANNUAL INSTITUTE ON INTELLECTUAL PROPERTY LAW

The Tremont House, Galveston, Texas • September 25 - 27, 1997

## PROGRAM

### THURSDAY, SEPTEMBER 25, 1997

#### Afternoon Program

- |      |  |   |
|------|--|---|
|      | Moderator  | <i>Mark Gilbreth</i>  |
| 1:00 | Registration   |   |
| 1:45 | Opening Remarks  | <i>Jim Repass, Chairman</i>   |
| 2:15 | File Wrapper Estoppel:<br>Proper Application and<br>Respective Roles of Judge<br>& Jury in Deciding Estoppel | <i>Mike Heim</i>  |
| 2:45 | Copyright Ownership —<br>Photographs, Architectural<br>Drawings, Computer Software                           | <i>Al Payne</i>   |
| 3:15 | Design Patent Infringement<br>and the Federal Circuit  | <i>John Jones</i>   |
| 3:45 | Break  |   |
| 4:00 | <b>Panel: Ethics Vignettes — Ethics<br/>and the Practice of Intellectual<br/>Property Law</b>                | <i>Mark Gilbreth, Sarah Harris,<br/>Gregory Beaves, Margaret Kirick<br/>Moderator: David Hricik</i> |
| 5:00 | Section 112, Paragraph 6:<br>Past, Present and Future  | <i>Thomas Miller</i>  |
| 6:00 | Cocktail Reception   |   |
| 7:00 | Dinner (On Your Own)   |   |

### FRIDAY, SEPTEMBER 26, 1997

#### Morning Program

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|-------|--|--|
|       | Moderator  | <i>Charles Walker</i>  |
| 7:30  | Continental Breakfast  |  |
| 8:20  | Opening Remarks  | <i>Jim Repass, Chairman</i>  |
| 8:30  | <i>Hilton-Davis</i>  | <i>Bill Pravel</i>   |
| 9:00  | State Immunity Against<br>Intellectual Property Claims                             | <i>Ken Kuffner</i>   |
| 9:30  | Break  |  |
| 9:45  | Libel in Cyberspace  | <i>Don Tomlinson, Robert Wiley</i>   |
| 10:45 | <b>Panel: Emerging Insurance<br/>Coverage Related to Intellectual<br/>Property</b> | <i>Richard Antognini, Edward Joyce,<br/>Joby Hughes<br/>Moderator: Rob Lytle</i> |
| 12:00 | Luncheon (Tremont House)<br>Speaker  | <i>Judge Stanley Birch, Jr.</i>  |

#### Afternoon Program

- |      |   |   |
|------|---|---|
|      | Moderator   | <i>Peter Mims</i>   |
| 1:30 | Claim Construction is a Question<br>of Law, Reviewed <i>De Novo</i> on<br>Appeal — True or False? | <i>Donald Dunner</i>  |
| 2:00 | Patent Damages, Particularly<br>Convoyed Sales in Light of<br><i>Rite-Hite</i>                    | <i>Paul Krieger</i>   |
| 2:30 | Copyright Damages   | <i>Doug Y'Barbo</i>   |
| 3:00 | Break   |   |
| 3:15 | The Antitrust and Other Legal<br>Ramifications of Standard Setting                                | <i>David Healey</i>   |
| 3:45 | <b>Panel: Scope of Copyright<br/>Protection for Computer<br/>Software</b>                         | <i>Lori Lesser, D.C. Toedt<br/>Moderator: Assoc. Dean<br/>Craig Joyce</i> |
| 6:00 | Evening Social<br>(Dinner at Railroad Museum)   |   |

### SATURDAY, SEPTEMBER 27, 1997

#### Morning Program

- |      |   |   |
|------|---|---|
|      | Moderator   | <i>Sharon Israel</i>  |
| 8:30 | Developments in obtaining and<br>enforcing intellectual property<br>rights in Europe and Japan                      | <i>John Pegram</i>  |
| 9:00 | An Elvis by any other name...<br>Protecting the name, image, and<br>likeness of the famous and the<br>not so famous | <i>Suzanne Tomkies</i>  |
| 9:30 | Break   |   |
| 9:45 | <b>Panel: Malpractice Pitfalls<br/>for the Unwary</b>   | <i>Sandra Haberman, Jett Hanna,<br/>David Beck, Thomas Bousquet<br/>Moderator: Les Hewitt</i> |



## BACKGROUND OF PARTICIPANTS

### RICHARD ANTOGNINI

Richard Antognini is a partner in the Sacramento, California office of *Lewis, D'Amato, Brisbois & Bisgaard*, where he specializes in analyzing coverage for intellectual property cases. He received his J.D. in 1977 from the University of California, Hastings College of Law.

### GREGORY BEAVES

Gregory Beaves is a graduate of the Air Force Academy and received his J.D. from South Texas College of Law. He is currently employed as a Rice University Police Officer.

### DAVID BECK

David Beck is a partner in the firm *Beck, Redden & Secrest*. He is an expert in lawyer liability issues.

### STANLEY F. BIRCH, JR.

Judge Stanley Birch, Jr., is a United States Circuit Judge for the Eleventh Circuit. He is a graduate of the University of Virginia and of Emory University Law School (J.D. and L.L.M. degrees), and was in private practice in Gainesville and Atlanta, Georgia, until appointed to the Eleventh Circuit by President Bush in 1990.

### THOMAS G. BOUSQUET

Tom Bousquet graduated from Texas Law School in 1958. He is certified in Civil Trial Law and is Special Assistant Disciplinary Counsel to the Texas Commission for Lawyer Discipline.

### DONALD DUNNER

Donald Dunner is in the Washington firm of *Finnegan, Henderson, Farabow, Garrett & Dunner*, specializing in patent law. Mr. Dunner is a past president of AIPLA.

### ROGER FULGHUM

Roger Fulghum is with the Houston office of *Baker & Botts*, where his efforts are devoted largely to commercial software issues.

### MARK GILBRETH

Mark Gilbreth is a founding shareholder of the Houston firm of *Gilbreth & Strozier*, with twelve years intellectual property experience. Additionally, he is an adjunct professor at South Texas College of Law.

### SANDRA HABERMAN

Sandra Haberman is Vice-President of *PilotLegis* RPG in Santa Ana, California. Since joining *PilotLegis*, she has conducted over 60 law firm risk management reviews.

### JETT HANNA

Jett Hanna has served as Vice President for Underwriting and Administration for Texas Lawyers' Insurance Exchange for the past two years. Mr. Hanna received his B.B.A. Summa Cum Laude in Management Science and Computers from Southern Methodist University in 1980, and his J.D. from the University of Texas School of Law in 1983.

### SARAH HARRIS

Sarah Harris is with the legal department of Compaq Computer Corporation.

### DAVID HEALY

David Healy is with the Houston office of *Arnold, White & Durkee*. He specializes in antitrust cases.

### MIKE HEIM

Mike Heim is a partner in the Houston office of *Conley, Rose & Tayan*, and is President-Elect of HIPLA. Mr. Heim is a former Patent Examiner and a frequent author and speaker on intellectual property issues.

### LESTER HEWITT

Les Hewitt is a partner in the firm *Pravel, Hewitt, Kimball & Krieger* and is an adjunct faculty member with the University of Houston Law Center.

### DAVID HRICIK

David Hricik is Special Counsel in the Austin office of *Baker & Botts, L.L.P.* He has written and lectured extensively on legal, ethical and intellectual property issues.

### JOBY HUGHES

Joby Hughes is the founder and president of Litigation Risk Management, Inc. Mr. Hughes practices litigation and licensing.

### SHARON ISRAEL

Sharon Israel is a member of the firm *Fish & Richardson*. Ms. Israel is formerly a law clerk to Judge Lourie of the Federal Circuit and practices litigation, prosecution, and licensing.

### PAUL JANICKE

Paul Janicke is Associate Professor of Law and Director of the IP Program at the University of Houston Law Center. He was until 1992 a member of *Arnold, White & Durkee*, with a practice predominantly in patent litigation.

### JOHN WILSON JONES

John Wilson Jones is a partner in the Intellectual Property and Technical Section of *Lidell, Sapp, Zivley, Hill & LaBoon*. His practice is presently focused on patent, trademark, and trade secret litigation and licensing.

### CRAIG JOYCE

Craig Joyce is Associate Dean for Graduate Studies & Special Programs at the University of Houston Law Center. Professor Joyce is a leading scholar in copyright law.

### EDWARD JOYCE

Edward Joyce is a member of *Anderson, Kill & Olick, P.C.* Mr. Joyce is an expert in the insurance coverage area of law and is a frequent lecturer on insurance coverage matters.



## BACKGROUND OF PARTICIPANTS (cont'd)

### MARGARET KIRICK

Margaret Kirick is in the IP Section of *Pennzoil Company*.

### PAUL KRIEGER

Paul Krieger is a member of *Pravel, Hewitt, Kimball & Krieger* and an adjunct faculty member at the University of Houston Law Center. He has authored many articles on topics ranging from trademark issues to patent litigation and licensing.

### KENNETH KUFFNER

Kenneth Kuffner heads *Kuffner & Associates* in Houston. He is a frequent lecturer on patent law topics and is one of the founders of the HIPLA fall institute series.

### LORI LESSER

Lori Lesser is an associate in the New York office of *Simpson, Thacher & Bartlett*, specializing in intellectual property law. Ms. Lesser is a graduate of Harvard College and Harvard Law School.

### ROBERT LYTLE

Robert Lytle is an associate with *Arnold, White & Durkee*. He also teaches intellectual property law as an Adjunct Professor at local law schools.

### THOMAS MILLER

Thomas Miller is a partner with *Arnold, White & Durkee*. His expertise is complex patent litigation. He has handled numerous litigations for clients in the semiconductor and electronics industries.

### PETER MIMS

Peter Mims is a partner in *Vinson & Elkins, L.L.P.* Mr. Mims has co-authored many papers on a variety of intellectual property subjects, including patent litigation and non-competition agreements.

### AL PAYNE

Al Payne is a partner in *Sroufe, Payne & Lundeen, L.L.P.*

### JOHN PEGRAM

John Pegram is a partner in *Fish & Richardson's* New York office. He is a frequent lecturer on patent law topics.

### BILL PRAVEL

Bill Pravel is the founding partner of *Pravel, Hewitt, Kimball & Krieger*. Mr. Pravel practices in all areas of intellectual property law and is a former AIPLA president.

### JIM REPASS

Jim Repass is a partner in *Fulbright & Jaworski's* Houston office. He focuses his practice on intellectual property litigation, with an emphasis on patents, copyright, trade secrets and trademarks.

### D.C. TOEDT

D.C. Toedt is a partner in *Arnold, White & Durkee, PC*, in the Houston office. Mr. Toedt practices in patent law relating to software- and telecommunications-based technologies.

### SUZANNE TOMKIES

Suzanne Tomkies is a sole practitioner specializing in trademark, copyright, and general civil litigation.

### DON TOMLINSON

Don Tomlinson is a Professor of Mass Communications at Texas A&M University and an Adjunct Professor at the University of Houston Law Center, where he received an L.L.M. in Intellectual Property Law.

### CHARLES WALKER, JR.

Charles Walker is an associate with *Fulbright & Jaworski, L.L.P.* Mr. Walker is developing a practice in intellectual property matters. He is a graduate of Rice University and the University of Texas Law School.

### ROBERT WILEY

Robert Wiley is a partner with the firm, *Lidell, Sapp, Zivley, Hill & LaBoon, L.L.P.* He is an expert on defamation cases.

### DOUG Y'BARBO

Doug Y'Barbo graduated from M.I.T. with an M.S. in Chemical Engineering in 1992. In 1995, he received a J.D. from the University of Chicago. Mr. Y'Barbo is an Associate in the Intellectual Property and Technology section at the Houston Office of *Fulbright & Jaworski*.

### Houston Intellectual Property Law

**Association:** Mike Sutton, *President*; Mike Heim, *President-Elect*; Todd Patterson, *Secretary*; Denise Wolfs, *Treasurer*; John Norris, *Immediate Past President*.

**University of Houston Law Center:** Paul Janicke, *Director of the Intellectual Property Program*; Craig Joyce, *Associate Dean for Graduate Studies & Special Programs*; Raymond T. Nimmer, *Leonard Childs Professor of Law*.

### PROGRAM ADMINISTRATION

Jim Repass, *Chairman*; Professor Paul Janicke, *Vice-Chairman*; Kristi Barr, *Legal Assistant*, and Andre' Washington, *Program Coordinator*.

### Committee Members:

Margaret Anderson, David Clonts, Marc Delflache, Paul DeVerter, Mike Fletcher, Jack Goldstein, Les Hewitt, David Hricik, Paul Janicke, John Jones, Rob Lytle, Dwayne Mason, John Norris, Les Payne, Sue Shaper, Randy Smith, Jim Repass, Al Riddle, Carl Rowold, Keith Tackett, Suzanne Tomkies, Tamsen Valoir, John Vick, Charles Walker, Denise Wolfs.

## REGISTRATION INFORMATION

### REGISTER IN ADVANCE

Fees:

\$275.00 ..... HIPLA members up to August 15  
\$325.00 ..... Non-HIPLA members up to August 15  
\$350.00 ..... HIPLA members after August 15  
\$400.00 ..... Non-HIPLA member after August 15

Refunds will be granted only if they are requested in writing and postmarked no later than September 4, 1997. 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 the Intellectual Property Program at 713-743-2180.

### WRITTEN MATERIALS

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

### HOTEL ACCOMMODATIONS

You must communicate directly with the Tremont House in order to reserve a room. A registration form is included in this brochure, which should be completed and mailed to the Tremont House. The deadline for making your reservation is September 4, 1997. After this date, reservations are made on a space-available basis only. Telephone: 800-874-2300.

## REGISTRATION FORM

INSTITUTE ON INTELLECTUAL PROPERTY LAW • SEPTEMBER 25 - 27, 1997

*The Tremont House, Galveston, Texas*

MAIL REGISTRATION FORM or PROGRAM BOOK REQUEST to:

Intellectual Property Program, University of Houston Law Center • Houston, TX 77204-6371

Please make check payable to HIPLA or use

☐ VISA ☐ MasterCard Card #: \_\_\_\_\_ Exp. Date: \_\_\_\_\_

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

### I. REGISTRATION FEES (CHECK ONE)

### AMOUNT

- ☐ \$275 HIPLA members up to Aug. 15 (book included) \_\_\_\_\_  
☐ \$325 Non-HIPLA members up to Aug. 15 (book included) \_\_\_\_\_  
☐ \$350 HIPLA members after Sept. 1 (book included) \_\_\_\_\_  
☐ \$400 Non-HIPLA members after Aug. 15 (book included) \_\_\_\_\_  
☐ \$ 35 Limited Student Enrollment (lunch not included) \_\_\_\_\_  
☐ \$ 75 Program Book only (will not attend) \_\_\_\_\_

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

- ☐ Friday Lunch  
\$30 ea. x \_\_\_\_\_ (# of reservations) = \_\_\_\_\_  
☐ Friday Night Dinner  
\$45 ea. x \_\_\_\_\_ (# of reservations) = \_\_\_\_\_

## HOTEL REGISTRATION FORM

13TH ANNUAL INSTITUTE ON INTELLECTUAL PROPERTY LAW

Mail Hotel Registration to:

**All Registrations Must Be Received By September 4, 1997**

The Tremont House

2300 Ships Mechanic Row, Galveston Island, Texas 77550-1520  
800-874-2300

Single, Double, Triple or Quads: ☐ \$98 night Suite: ☐ \$200 VIP Suite ☐ \$300

☐ 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 HOURS 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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Tremont House Hotel, Galveston, Texas • September 25 - 27, 1997

## Summary of the Program

*Casual attire is encouraged for all aspects of the program.*

### THURSDAY SESSIONS

- Thursday afternoon sessions will include: File Wrapper Estoppel; Copyright Ownership; Design Patent Development; How to Avoid Errors in Writing Patent Applications
- Thursday afternoon panel: Ethics Vignettes—Ethics and the Practice of Intellectual Property Law.

### FRIDAY & SATURDAY SESSIONS

- Eight lectures on topics of current IP interest, Patent Damages, and First Amendment Rights in Cyberspace.
- Panel on Insurance Coverage Relating to IP Claims.
- Panel on Scope of Copyright Protection.
- Panel on Malpractice Pitfalls for the Unwary.
- Lunch with Judge Birch.

### MINIMUM CONTINUING LEGAL EDUCATION

Approval for State Bar of Texas CLE credit for 8.5 hours for the Friday-Saturday sessions, and 4 hours for the Thursday sessions, is pending. 1 hour of ethics is included in the program.

### RECREATIONAL AND SOCIAL ACTIVITIES

- **THURSDAY COCKTAIL RECEPTION:**  
Cocktails and soft drinks will be served at the Tremont House on Thursday evening.
- **FRIDAY LUNCHEON:**  
The Tremont House will be the setting for a luncheon with Judge Stanley F. Birch, Jr., of the U.S. Court of Appeals for the 11th Circuit.
- **FRIDAY DINNER:**  
The setting for dinner Friday night will be Galveston Island's famous five-acre Railroad Museum. Walk through vintage Pullman sleeper cars from the 1920s and inspect the steam locomotives and cabooses, mail car and box cars. Wait for a train in the Santa Fe Station, an authentic station filled with sculptures depicting travelers past. Visitors will dine aboard a streamlined diner from the 1940s.

### LOCATION

The Tremont House is located on Galveston Island. Take I-45 south until I-45 turns into Broadway. Make a left turn on 23rd Street (Tremont). Go seven blocks to Ship's Mechanic Row and take a left. Toll-Free: 800-874-2300. Houston: 713-480-8201.

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Intellectual Property Program  
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