

# FOURTEENTH ANNUAL INSTITUTE ON INTELLECTUAL PROPERTY LAW

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*San Luis Hotel, Galveston, Texas  
October 1 - 3, 1998*

*Co-Sponsored by:*

**HOUSTON INTELLECTUAL PROPERTY  
LAW ASSOCIATION**

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

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Litigation Services Group 

## **PROGRAM HIGHLIGHTS**

**Luncheon with Justice Greg Abbott, Texas Supreme Court**

**Panel on Model Case Management Order for Patent Litigation**

**Panel on Replay of Actual Markman Hearing**

**Panel on PCT/EPO Practice**

**Panel on State Secrets and Federal Cases, A Trade Secret Update**

**2.5 Hours of Ethics**

**HIPLA**



Life always rides in strength  
to victory, not through  
internationalism . . . but only  
through the direct responsi-  
bility of the individual.

*Frank Lloyd Wright*

# 14TH ANNUAL INSTITUTE ON INTELLECTUAL PROPERTY LAW

San Luis Hotel, Galveston, Texas • October 1 - 3, 1998

## PROGRAM

### THURSDAY, OCTOBER 1, 1998

#### Afternoon Program

	Moderator	<i>Louis Brucculeri</i>
12:00	Registration	
1:00	Opening Remarks	<i>Tim Headley, Chairman</i>
1:15	Intellectual Property Portfolio Management	<i>Don Fancher, Bruce Burton</i>
2:00	Rice - PTO Office	<i>John Mings</i>
3:00	Break	
3:15	Creating Double Patenting by Delaying Prosecution	<i>Keith Tackett</i>
3:45	Licensing & Electronic Commerce Under UCC Article 2B	<i>Irene Kosturakis</i>
4:15	Export Issues	<i>D. Arlon Groves</i>
4:45	<b>Panel: Model Case Management Order for Patent Litigation</b>	<i>Ken Adamo, John Lowe</i> <i>Moderator: D.C. Toedt, III</i>
6:00	Cocktail Reception - San Luis Hotel	
7:00	Dinner (On Your Own)	

### FRIDAY, OCTOBER 2, 1998

#### Morning Program

	Moderator	<i>Paul Janicke</i>
7:30	Continental Breakfast	
8:00	To Re or Not to Re, That is the Examination Question	<i>Frank Vaden</i>
8:30	European Trade Mark Harmonisation: An Impossible Dream?	<i>John Olsen</i>
9:00	Protection of IP Rights Against Bankruptcy	<i>Paula Morris</i>
9:30	Break	
9:45	Recent Developments and Trends in Patent Law: CAFC Decisions from August 1997 to July 1998	<i>Les Payne</i>
10:15	Update - Trademark and Copyright Law	<i>Matthew Reeves</i>

10:45	<b>Panel: Replay of Actual Markman Hearing</b>	<i>Michael Cohen, Ralph Midkiff</i>
12:00	Luncheon Why Do We Do This Thing We Do?	<i>Justice Greg Abbott</i>

#### Afternoon Program

	Moderator	<i>Paul Janicke</i>
1:30	What You Need to Know About Section 112, Paragraph 6 in View of Recent Federal Circuit Case Law	<i>Randy Smith</i>
2:00	Patent Term Extensions	<i>Karen Tripp</i>
2:30	<b>Video &amp; Panel: Ethics Vignettes</b>	<i>Moderator: Melinda Patterson</i>
4:00	Break	
4:15	Patent Misuse	<i>Constance Rhebergen, Frank Turner</i>
5:00	<b>Panel: Filing Internationally: An Examination of PCT and EPO Practice</b>	<i>Moderators: Paul Morico, Irene Kosturakis</i>
7:00	Evening Social (Cocktail Reception and Dinner at Moody Gardens)	

### SATURDAY, OCTOBER 3, 1998

#### Morning Program

	Moderator	<i>Byron Spruell</i>
7:30	Continental Breakfast	
8:20	Opening Remarks	<i>Tim Headley</i>
8:30	Legal Issues Related to the Internet	<i>Anita Kadala</i>
9:30	Defensive Driving for the IP Practitioner, Fasten Your Seatbelt!	<i>Walter W. Steele, David Hricik, Rodney Caldwell</i>
10:30	Break	
10:45	<b>Panel: State Secrets and Federal Cases, A Trade Secret Update</b>	<i>John Vick, Patty Meier, Douglas Monahan</i> <i>Moderators: Al Riddle, Jim Repass</i>



## BACKGROUND OF PARTICIPANTS

### GREG ABBOTT

Justice Greg Abbott was appointed to the Texas Supreme Court by Governor Bush and was later elected to that position in November 1996. He received his law degree from Vanderbilt University and is a Texas Constitutional Law Professor at the University of Texas.

### KEN ADAMO

Ken Adamo is a partner with *Jones, Day, Reavis & Pogue*, Cleveland, Ohio, and Dallas, Texas. His practice comprises a broad spectrum of U.S. and foreign intellectual property law activities including patent, trademark, copyright and trade secret causes.

### LOUIS BRUCCULERI

Louis Brucculeri is a Licensing Counsel for *Compaq* focusing on intellectual property litigation and licensing. Lou has served as Director, Secretary and Committee Chair for HIPLA and as Treasurer for the State Bar IPL Section.

### BRUCE W. BURTON

Bruce W. Burton heads the Intellectual Property Consulting practice at *Deloitte & Touche L.L.P.* and specializes in intellectual property consulting and analysis of intellectual property infringement matters.

### RODNEY CALDWELL

Rodney Caldwell is a shareholder with *Arnold, White & Durkee* in Houston, where he has practiced in the fields of patent and trademark law, including prosecution, litigation and licensing.

### MICHAEL LEE COHEN

Michael Lee Cohen received his JD from Harvard University in 1991. He is with the firm of *Cohen, Darnell & Cohen* and specializes in civil and employment litigation.

### J. DONALD FANCHER

J. Donald Fancher is the Director of Gulf Coast Dispute Consulting Services in *Deloitte & Touche L.L.P.*'s Houston office. He specializes in intellectual property issues.

### D. ARLON GROVES

D. Arlon Groves received his J.D. from the University of Houston. He is the Managing Partner of *Groves & Glover, L.L.P.* and was the Special Master, U.S.D.Ct. Southern District of Texas 1990-1993.

### TIM HEADLEY

Tim Headley is a partner in the Houston Office of *Haynes and Boone, L.L.P.* He practices in all areas of intellectual property law, but focuses on technologies involving computer software.

### DAVID HRICIK

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

### 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.

### ANITA KADALA

Anita Kadala received a B.S. Computer Engineering from Southern Methodist University and J.D. from the University of Houston. She is an associate at *Arnold, White & Durkee* practicing primarily in patent, trademark, copyright, and trade secret litigation.

### IRENE KOSTURAKIS

Irene Kosturakis is *Compaq Computer Corporation's* Manager of Worldwide Patent Development and is responsible for the protection of the Company's intellectual property rights through patents and for the development of an assertable patent portfolio.

### JOHN C. LOWE

John C. Lowe is a partner in the Intellectual Property Law Firm of *Finnegan, Henderson, Farabow, Garret & Dunner, L.L.P.* in Washington, D.C. He specializes in trials of complex litigation.

### PATTY MEIER

Patty Meier is an associate with *Tobor and Goldstein, L.L.P.* She has spoken on and authored papers relating to trade secret law.

### RALPH A. MIDKIFF

Ralph A. Midkiff is a partner with *Clements, O'Neill, Pierce & Nickens, L.L.P.* Ralph obtained his law degree from the University of Texas, *Order of the Coif* and *Texas Law Review*. He is a business trial lawyer.

### JOHN MINGS

John Mings is a Participating Associate at *Fulbright & Jaworski, L.L.P.* He practices patent, trade secret, copyright and trademark law.

### DOUGLAS MONAHAN

Douglas Monahan has been employed by the FBI since July of 1974. He currently works for Foreign Counter Intelligence matters, specifically, Russian Matters and Russian Organized Crime and is cross designated as a US Customs Service Special Agent working to prevent the loss of critical US technology and proprietary information.

### PAUL MORICO

Paul Morico is an associate at *Arnold, White & Durkee*. He also teaches a course in international intellectual property law at the University of Houston and South Texas College of Law.

### PAULA MORRIS

Paula Morris is a member of *Madan & Morris, PLLC*, and co-author of a paper and Licensing Law Handbook chapter regarding bankruptcy and IP rights.

## BACKGROUND OF PARTICIPANTS (cont'd)

### JOHN R. OLSEN

John R. Olsen is head of the International Trade Marks and Designs Group at *SJ Berwin & Co.* He specializes in trade mark law and has headed up substantial trade mark departments at companies in both Europe and the USA.

### MELINDA PATTERSON

Melinda Patterson has been practicing with *Arnold, White & Durkee* for approximately ten years. Her practice is primarily in the area of patents, both litigation and prosecution, with an emphasis on the technical area of biotechnology.

### LESLIE V. PAYNE

Leslie V. Payne joined the Houston office of *Conley, Rose & Tayon* after graduating from Vanderbilt Law School in 1992. He specializes in intellectual property litigation.

### MATTHEW REEVES

Matthew Reeves is with the law firm of *Liddell, Sapp, Zivley, Hill & LaBoon* in Houston, Texas. He practices in all areas of intellectual property law and is licensed to practice before the United States Patent and Trademark Office.

### 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.

### CONSTANCE GAIL RHEBERGEN

Constance Gail Rhebergen is an associate at the firm of *Vaden, Eickenroht & Thompson, L.L.P.*, and received her Juris Doctor Degree from the University of Houston Law Center. Ms. Rhebergen's practice encompasses prosecution and litigation.

### AL RIDDLE

Al Riddle currently serves as Division Patent Counsel for *Baker Hughes, Inc.* He is a graduate of the University of Texas at Austin (BSEE) and South Texas College of Law (JD).

### E. RANDALL SMITH

Randy Smith is with the Houston office of *Conley, Rose & Tayon* and is a former Director of HIPLA. His practice is devoted to intellectual property litigation and prosecution.

### BYRON O. SPRUELL

Byron O. Spruell is a senior manager and intellectual property specialist in the Dispute Consulting Services group of *Deloitte & Touch L.L.P.'s* Houston office.

### WALTER W. STEELE, JR.

Walter Steele, Jr. is an Emeritus Professor at Southern Methodist University School of Law where he taught professional responsibility for over twenty years. He is a member of the Texas Board of Legal Examiners.

### KEITH TACKETT

Keith Tackett is an associate in the firm *Patterson & Streets, L.L.P.*, with thirteen years of patent prosecution experience including lead attorney in the interference proceeding that resulted in the double patenting decision.

### D.C. TOEDT, III

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

### KAREN TRIPP

Karen Tripp is a partner with *Winstead, Sechrest & Minick* in Houston, Texas. Her broad intellectual property practice frequently includes rendering patent validity and infringement opinions.

### FRANK C. TURNER

Frank C. Turner is an associate attorney with the firm of *Vaden, Eickenroht & Thompson L.L.P.* Mr. Turner's practice encompasses all areas of Intellectual Property with an emphasis on prosecution.

### FRANK S. VADEN, III

Frank S. Vaden, III was HIPLA President the year that the Annual Fall Institute was established. He also served as Chair of the IP Section of the State Bar of Texas.

### JOHN VICK

John Vick is legal counsel for the Dowell division of *Schlumberger Technology Corporation*. His practice includes primarily patent law and licensing.

### Houston Intellectual Property Law

**Association:** Michael Heim, *President*; Jim Repass, *President-Elect*; Irene Kosturakis, *Secretary*; David Clonts, *Treasurer*; Mike Sutton, *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

Tim Headley, *Chairman*; Professor Paul Janicke, *Vice-Chairman*; Michelle Baxter, Andre' Washington, *Program Coordinators*, and Jennifer Sickler, *McCarroll & Oaks, Hartline, LLP*.

### 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:

\$315.00 ..... HIPLA members up to August 15  
\$365.00 ..... Non-HIPLA members up to August 15  
\$390.00 ..... HIPLA members after August 15  
\$440.00 ..... Non-HIPLA member after August 15

Refunds will be granted only if they are requested in writing and postmarked no later than September 4, 1998. 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 conference, 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 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 reserving blocked rooms is September 8, 1998. After this date, reservations are made on a space available basis only. Telephone: 800-392-5937.

## REGISTRATION FORM

INSTITUTE ON INTELLECTUAL PROPERTY LAW • OCTOBER 1 - 3, 1998

MAIL TO:

INTELLECTUAL PROPERTY PROGRAM, UNIVERSITY OF HOUSTON LAW CENTER • HOUSTON, TX 77204-6371

Please make check payable to HIPLA or use

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

NAME	
AFFILIATION	
ADDRESS	
CITY/STATE/ZIP	
PHONE NUMBER	FAX NUMBER
SPOUSE/PARTNER NAME (If Attending)	
SIGNATURE OF CARDHOLDER	

### I. REGISTRATION FEES (CHECK ONE)

### AMOUNT

- ☐ \$315 HIPLA members up to Aug. 15 (book included) \_\_\_\_\_  
☐ \$365 Non-HIPLA members up to Aug. 15 (book included) \_\_\_\_\_  
☐ \$390 HIPLA members after Aug. 15 (book included) \_\_\_\_\_  
☐ \$440 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  
\$55 ea. x \_\_\_\_\_ (# of reservations) = \_\_\_\_\_

## HOTEL REGISTRATION FORM

14TH ANNUAL HIPLA INSTITUTE ON INTELLECTUAL PROPERTY LAW

Mail Hotel Registration to:

The San Luis Resort and Conference Center

5222 Seawall Boulevard, Galveston, Texas 77551

800-392-5937

**All Registrations Must Be Received By September 8, 1998**

Single or Double: ☐ \$129 night Suite: ☐ \$279  
☐ VISA ☐ American Express ☐ MasterCard ☐ Other \_\_\_\_\_ Card Number: \_\_\_\_\_ Exp. Date: \_\_\_\_\_  
Cardholder's Name: \_\_\_\_\_ Signature: \_\_\_\_\_  
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Company/Organization: \_\_\_\_\_ Phone: \_\_\_\_\_  
Address: \_\_\_\_\_ City/State/Zip: \_\_\_\_\_

**ANY CANCELLATIONS MUST BE RECEIVED AT LEAST 72 HOURS PRIOR TO ARRIVAL DATE TO AVOID CHARGES.**

*All requests subject to availability. Reservations are 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 SESSIONS

- Thursday afternoon sessions will include: Intellectual Property Portfolio Management; Rice - PTO Office; Creating Double Patenting by Delaying Prosecution; Licensing & Electronic Commerce Under UCC Article 2B, Export Issues
- Thursday afternoon panel: Model Case Management Order for Patent Litigation

### FRIDAY & SATURDAY SESSIONS

- Ten lectures on topics of current IP interest, Patent Damages and First Amendment Rights in Cyberspace.
- Panel on Replay of Actual Markman Hearing
- Friday afternoon panel: Ethics Vignettes
- Panel on PCT/EPO Practice
- Lunch with Judge Greg Abbott

### MINIMUM CONTINUING LEGAL EDUCATION

Approval for State Bar of Texas CLE credit for 10.75 hours for the Friday-Saturday sessions, and 4 hours for the Thursday sessions, is pending. 2.5 hour of ethics is included in the program.

### RECREATIONAL AND SOCIAL ACTIVITIES

- **THURSDAY COCKTAIL RECEPTION:**  
Cocktails and soft drinks will be served at the San Luis around the pool deck and hill overlooking the Gulf of Mexico.
- **FRIDAY LUNCHEON:**  
The San Luis Hotel will be the setting for a luncheon with Justice Greg Abbott, Texas Supreme Court.
- **FRIDAY COCKTAIL RECEPTION AND DINNER:**  
The setting for dinner Friday night will be at Moody Gardens, one of the most popular Galveston attractions. Cocktails will be served at the Moody Gardens waterfall garden and rainforest. Dinner will follow in the Garden Lobby adjacent to the Rainforest overlooking a waterlife pond. Moody Gardens features a 10 story, 40,000 square-foot Rainforest Pyramid, housing thousands of exotic plants, birds, butterflies and fish, offering an incredible tropical environment complete with waterfalls, cliffs, caverns, wetlands and forests.

### LOCATION

The San Luis Resort and Conference Center is located on Galveston Island. Take I-45 south from Houston to Galveston. Cross Causeway Bridge, exit 61st street and turn right. Head south on 61st Street to Seawall Boulevard. Turn left onto Seawall Boulevard. Head east eight blocks to the San Luis Resort and Conference Center.

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Intellectual Property Program  
Houston, Texas 77204-6371

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