

KIRKLAND & ELLIS LLP
11th Annual Technology & Law Seminar
Friday, May 7, 2004

(All times listed below are CDT)

- 9:30 - 10:00 a.m.** **Registration and Continental Breakfast**
- 10:00 - 10:10 a.m.** **Introduction**
Speaker: William A. Streff, Jr.
- 10:10 - 10:40 a.m.** **Nuisance Patents**
Speaker: Paul R. Steadman
The plaintiffs' patent bar has increasingly used "industry-wide" licensing campaigns designed to extract small but significant license fees on patents that are claimed to have "fundamental" or "industry-wide" application. This presentation will offer practical options for responding to these types of assertions, including methods for classifying and quantifying the threat, as well as cost-effective ways to prevent and manage any subsequent litigation.
- 10:40 - 10:50 a.m.** **Break**
- 10:50 - 11:20 a.m.** **EU Technology Licensing: The New Rules**
Speakers: Stephen Johnson, Pierre-André Dubois
May 2004 will be one of the most important months for European competition law and its effects on technology companies. On May 1, 2004, the system of notification to the European Commission (in place since the EU was created) will be abolished, shifting a major part of the burden of compliance to companies. At the same time, the Technology Transfer Block Exemption of 1996 will be replaced by a new, substantially different Block Exemption. These changes will impact the structure and terms of most international licensing deals across many technology sectors. This session will present an overview of these significant reforms.
- 11:20 a.m. - 12:00 p.m.** **Electronic Evidence – Theory and Reality**
Speakers: Paul R. Steadman, Craig D. Leavell, Colby Anne Kingsbury
Electronic evidence continues to be a Pandora's Box for companies in discovery and litigation. The explosion of electronic information makes discovery burdensome to both sides -- but electronic "signatures" and metadata may be so important to the case as to make discovery of electronic information extremely important. Courts are increasingly aware of both the breathtaking scope of discovery, and its costs. The Sedona Conference has just updated its "best practices" for electronic discovery, but many questions remain unanswered. In order to explore this topic, we will stage a discovery hearing to "play out" some of the more interesting issues, and moderate a roundtable discussion so that participants can learn current own "best practices" in this ever more complex environment.
- 12:00 - 12:30 p.m.** **Lunch**

12:30 - 1:00 p.m.

Breakout Sessions

Breakout Session #1: Information Technology Devices and Company Policies -- Camera Phones in the Boardroom?

Videoconferenced in Los Angeles, New York, San Francisco

Speakers: Seth Traxler, Gianni L. Cutri, Soo Choi

The information technology that allows companies and their employees to succeed in a fast-paced and global marketplace presents a host of internal legal issues for companies. Has one of your executives lost a PDA that was loaded with sensitive business information? Do your employees trade music and movie files over your company's network? Have you drafted an agreement that contains metadata revealing its drafting history? Do your executives use potentially-unprotected wireless networks in airports or hotels? As information technology devices proliferate, and the line between business use and personal use blurs, companies face legal issues under trade secret, copyright, data security, data privacy, and privilege laws. This break-out session will walk through specific examples and offer practical tips for dealing with these issues. Attendees will be encouraged to share their experiences and suggestions about how in-house counsel can help their companies handle these issues. (Please note that this presentation will not overlap with topics covered in the "Electronic Evidence" seminar).

Breakout Session #2: "Have Made" Rights and Software

Videoconferenced in Los Angeles, New York

Speaker: Jeffery S. Norman, David Rokach

This session will explore the practical application of "have made" license rights to the development and distribution of computer software. License rights that include the right to have the licensee's products manufactured by a third party are fairly common, but the application of "have made" rights to specific manufacturing arrangements remains difficult despite the numerous semiconductor cases that have addressed the issue. Software development and licensing involving "have made" rights presents further complications because the product is intangible and typically licensed rather than sold to customers. The first part of this session will briefly summarize both seminal and the most recent case law involving "have made" rights. The second part will be devoted to practical tips for the licensee in structuring development and distribution relationships so as to maintain the protection afforded under the "have made" license, and for the licensor in drafting tight "have made" license grants that avoid undesirable hidden grants of rights to third parties.

San Francisco Breakout: Business Method Patents: Where Are We Now?

San Francisco office only

Speakers: Stephen Johnson, Pierre-André Dubois, Eric R. Lamison

This break-out session will be hosted live in San Francisco, and will discuss current trends in business method patents in the U.S. and Europe. The discussion will include the status of Patent Office initiatives and a brief overview of the Federal Circuit's claim construction trends.

1:00 - 1:30 p.m.

The FTC's 10 Proposals to Change Patent Law and Policy

Speakers: Daniel F. Attridge, Gregory F. Corbett

After lengthy public hearings, the Federal Trade Commission issued a 250-page report entitled "To Promote Innovation: The Proper Balance of Competition and Patent Law and Policy." In the report, the FTC makes 10 specific recommendations to change the patent system in the interests of enhancing competition. In this session, we will review and discuss these recommendations and their likely impact on technology innovation at U.S. companies.

1:30 - 2:00 p.m.

Outsourcing: Globalization Meets Local Politics

Speakers: Gregg G. Kirchoefer, Neil S. Hirshman

Outsourcing continues to be an important and attractive option in IT services and other markets and has become a political hot-button issue in this election year. Companies are increasingly looking to offshore service providers to provide high-quality outsourced functions at lower costs than domestic service providers, while attempting to mitigate the risks inherent in outsourcing important functions overseas and the effects of legal developments at home and abroad. The U.S. Congress and a majority of the states have pending or proposed legislation to govern certain aspects of outsourcing for both governmental and private entities. This session will present an overview of the current market trends and need for outsourcing, practice tips to mitigate risks and other important issues in outsourcing, and legislative and regulatory developments targeted at outsourcing.

2:00 - 2:15 p.m.

Break

2:15 - 2:45 p.m.

Changes in the Japanese Intellectual Property Law Environment — New Risks For Technology Development and Recent Enforcement Trends in Japan

Speakers: Krista L. Nunemaker, Fumiharu Hiromoto (visiting attorney from Mori Hamada & Matsumoto), Shunsuke Saeki (visiting attorney from Tozai Sogo Law Office)

Does your company have any research or development facilities in Japan? Do you have joint ventures? Do you license any intellectual property from Japanese companies' portfolios? Has your company developed a plan for how it will handle Japanese patent litigation? Surprising developments – under-publicized in the United States – may put any company with Japanese technology development or sales at risk. Researchers in Japan are entitled to "reasonable" compensation from their employers for inventions, but recent Japanese Court decisions have created a wave of litigation to define "reasonable," sometimes resulting in awards to inventors of tens or even hundreds of millions of dollars, despite pre-existing agreements assigning technology to the employer. Developments in Japan have created a tricky (and risky) environment for companies operating there due to recent procedural changes in Japanese litigation, and a strong stance by major Japanese technology companies that are now willing to fight to protect their IP portfolios. We will review these new developments, and discuss where Japanese technology law may be headed next.

2:45 p.m.

Reception in Chicago and New York

