

American Conference Institute's
Advanced Forum on

ITC LITIGATION

Managing and litigating high-stakes Section 337 actions under extreme time constraints

January 27-28, 2009 | The Madison, Washington DC

Featuring Addresses from Government Representatives including:

Hon. Paul J. Luckern

Chief Administrative Law Judge
United States International Trade Commission

George F. McCray

Chief, Intellectual Property Rights Branch
US Customs & Border Protection

Lynn I. Levine

Office of Unfair Import Investigations
United States International Trade Commission

Distinguished Co-Chairs:

Sturgis Sobin

Partner
Covington & Burling LLP (Washington, D.C.)

Alice A. Kipel

Partner
Step toe & Johnson LLP (Washington, D.C.)

Plus, Don't Miss our Pre-Conference Workshop:

**Drafting an ITC Complaint: Developing Strategies
and Composing the Necessary Documents**

Monday, January 26, 2009 | 12:30- 4:30 pm

Skilled ITC litigators will share their insights on how to:

- › **WEIGH** the financial benefits and competitive edge vs. extreme cost and time constraints of an ITC action
- › **IMPLEMENT** strategies to prepare for a potential ITC action whether initiating or as a potential respondent
- › **COLLABORATE** with multiple parties in a Section 337 action under extreme time constraints
- › **CONTROL** extremely high volumes of discovery responses and **OVERCOME** the practical challenges such as foreign translations, multiple copies, database management
- › **DEVISE** practices for efficiently working with the United States Customs office and other enforcement organizations
- › **IDENTIFY** action plans to successfully work with the ITC courts, commission and counsel's office

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“...more patent infringement complaints have been filed with the ITC this fiscal year than in any other since at least 2000....” Cal Law, June 5, 2008

As any intellectual property or international trade attorney has seen, Section 337 litigation has developed from a relatively obscure niche practice into a booming industry that is growing exponentially. As a result, the **high speed, high pressure, high results docket** is struggling under the magnitude and number of recently filed cases. The timetable for cases continues to grow longer, adding additional costs and delaying the potential injunctive relief. Even the most experienced ITC litigators are stumped by the high slowing of motion practice, the high volume of document review, and the increase in number of parties on any given case.

As ITC develops into a mainstay of intellectual property litigation, knowing how to navigate the Commission and the ITC courts has never been so important. Now an essential component of every business' overall patent strategy, managing time and cost in an ITC action, as well as discovery, can offer a tremendous advantage over a competitor. The court is seeing an astounding number of foreign complainants avail themselves of the significant, concrete remedies that the court can provide in a whirlwind time period. The growth of cases filed by telecommunication, electrical, software, and other high-tech industries is staggering and complicated. Discovery demands and responses, once overwhelming in their breadth and volume, continue to explode in size as respondents may number in the dozens, and may represent that number of nations of origin. It is essential to have policies and strategies, as well as experienced practitioners, cognizant and familiar with all ITC practices.

ACI has developed a program that scrutinizes the most common struggles of any ITC action and offers practical solutions to these challenges. Insights from the Chief Judge of the ITC on perspective of court, as well as from Commission Staff and U.S. Customs will be invaluable to any ITC practitioner, as well as any business that faces a Section 337 action. The faculty for the **Advanced Forum on ITC Litigation** – including senior practitioners and Commission staff – will offer insights into current trends and issues involved in an ITC action, including:

- Fallout from the decision in *Broadcomm v. Qualcomm*
- Drafting the Exclusion Order, and working with enforcement agents to ensure it is carried out
- Preparing arguments to pass the Domestic Industry test, particularly with the growth of licenses
- Managing documents, foreign witnesses, and minimizing costs
- Avoiding redundancy in discovery review and expert witnesses
- Utilizing a Section 337 action as a means to settling, and in conjunction with, other actions in federal court

In addition, ACI is offering our Pre-Conference Workshop “**Drafting an ITC Complaint**” where senior practitioners apply insider tips and strategies to compose the most effective and extensive complaint to survive both scrutiny by the Commission and subsequent review by the courts.

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For more information about this program or our global portfolio of events, please contact:

Wendy Tyler

Group Leader & Business Development Executive
American Conference Institute

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Pre-Conference Workshop Drafting an ITC Complaint: Developing Strategies and Composing the Necessary Documents

Monday, January 26, 2009

12:30pm - 4:30pm (Registration begins at 12:00pm)

Richard M. McDermott

Partner, Alston & Bird LLP (Charlotte, NC)

Paul F. Brinkman

Partner, Alston & Bird LLP (Washington, D.C.)

The greatest advantage of an ITC action is the complaint. Not only is an adversary caught off guard upon receipt, but they are obligated to respond to broad discovery demands and motion practice almost instantly. In addition, the complainant has the advantage of having the Commission itself review and critique the documents before they are ever submitted for filing.

Despite this, oftentimes the complaint falls short, for many reasons. In their haste, a complainant will often not develop a full strategy of the litigation, plan for the extensive discovery, or prepare themselves for the inevitable rushed motion practice and reciprocal demands. Most egregious, they do not take the time to have the Commission staff review their complaint for faults, issues, or just for a second pair of eyes.

The leaders of this hands-on workshop will instruct participants on the essentials of drafting, and go beyond that by offering real tools to optimize the complaint to their advantage. The faculty will stress topics that tend to catch many complainants, and incorporate into the discussion their years of experience working with the Commission to ensure that the essential, early documents provide a concise and formidable argument.

Day One: January 27, 2009

7:30 **Registration and Breakfast**

8:30 **Co-Chairs' Opening Remarks**

9:00 **View from the Bench: Honorable Judge Paul J. Luckern**

Chief Administrative Law Judge Luckern will offer his perspective on current challenges and issues arising in Section 337 litigation. Relying on his experience of over 24 years as an administrative law judge at the ITC, Judge Luckern will provide insight into the growing number and size of ITC actions, discuss recent ITC decisions important to the industry, and other topics of importance to ITC practitioners.

10:15 **Morning Coffee Break**

10:30 **View from the ITC Commission: Director of the Office of Unfair Import Investigations, Lynn I. Levine**

Director Levine will discuss challenges faced by practitioners and the issues that arise when a complaint reaches the Office of Unfair Import Investigations for review. In addition, Director Levine will discuss the impact of the first changes in ITC rules in over twelve years, and will examine how they affect standard practices before the Commission.

12:00 **Networking Lunch for Speakers and Delegates**

1:15 **Exploring New and Developing Challenges in ITC Litigation**

Yar R. Chaikovsky

Partner, Sonnenschein Nath & Rosenthal (Palo Alto, CA)

Lyle Vander Schaaf

Partner, Bryan Cave LLP (Washington, D.C.)

- Solutions to the palpable effects of the profound increase in the volume and size of cases filed at the ITC
 - Strategies to maintain the "rocket docket"
- Examining the individual styles of the Administrative Law Judges
 - Identifying what to expect from each when a case is brought before them
 - Review of the judicial training for highly technical cases
 - The pros and cons of a Markman hearing for an ITC action
- Maintaining speed on motion practice including discovery motions
 - Amongst adversaries
 - On the judicial calendar
- Adapting to the implementation of the new ITC administrative rules
- Examining the court's perspective on newer "unfair acts" as causes of action in litigation
 - Child labor
 - Prison labor
 - Slave labor
- Working with to ITC to acquire an Exclusionary Order as the result of an adversary's defaults

2:30 **Afternoon Coffee Break**

2:45 **Maximizing Relationships with the ITC: Initiating an Action, Working with the Staff, and Instituting the Best Practices for a Favorable Outcome**

Alice A. Kipel

Partner, Steptoe & Johnson LLP (Washington, D.C.)

David H. Hollander, Jr.

Associate, Former Investigative Attorney in the ITC Office of Unfair Import Investigations
Adduci, Mastriani and Schaumberg, LLP (Washington, D.C.)

- Identifying the various roles of the ITC
- Assessing the impact of the heavy Section 337 caseload
 - Increasing size and volume of cases
 - Escalating reliance in licensing-based domestic industry
 - Evaluating how the Commission is addressing practical issues such as the backlog of cases, need for more judges, and lack of courtroom space
- Working with the ITC staff as a third party in litigation
 - Pre-filing review of complaints
 - Exploring the role of the investigative Staff in a multi-party action
 - Reviewing the impact of open communication as a result of permissible discussions with Staff attorneys
- Resolving questions concerning eDiscovery
 - Reviewing policies and measures to safeguard client trade secrets
 - Practices to ensure appropriate documents are provided to the court
 - Lack of Commission rules concerning eDiscovery
- Avoiding actions that can lead to Commission penalties
 - Compliance with Protective Order restrictions
 - Compliance with Exclusion and Cease and Desist Orders
 - Penalties for violations
 - Methods for minimizing a company's violations
 - Successfully communicating the severity of violations to the companies

4:00 **Broadcom v Qualcomm: Updates of the Federal Appeal, and the Overall Status of Downstream Products**

Kathryn L. Clune

Partner, Crowell & Moring, LLP (Washington, D.C.)

Joanna M. Ritcey-Donohue

Attorney, White & Case LLP (Washington, D.C.)

Thomas J. Filarski

Partner, Brinks Hofer Gilson & Lione (Chicago, IL)

Alexander J. Hadjis

Partner, Morrison Foerster LLP (Washington, D.C.)

After determining that Qualcomm's baseband processor chips with a certain power-saving software infringed Broadcom's patent, the ITC issued a limited exclusion order (LEO) that excluded from importation the accused Qualcomm chips and the downstream products of non-respondent third parties that contained the same. The third parties were granted a stay of the LEO pending appeal, which the Federal Circuit heard on July 8, 2008. The issue on appeal is whether the ITC exceeded its authority by issuing an LEO excluding products of third parties who were not respondents and were not found in violation of Section 337. The decision in this case will have a profound and immediate impact on the issuance of limited exclusion orders against all "downstream" products. A panel of experts will provide a review the significant portions of the decision, dissect the likelihood of further appeal of the Enforcement Action filed by Broadcom against the design around issued by Qualcomm, and examine the concrete effects this ruling will have on current and future ITC actions involving downstream products.

5:15 **Conference Adjourns**

Day Two: January 28, 2009

7:30 **Registration and Breakfast**

8:45 **Co-Chairs' Opening Remarks**

9:00 **Enforcement Address: George F. McCray**

George F. McCray is the Chief of Intellectual Property Rights Branch, Department of Homeland Security, U.S. Customs and Border Protection, Washington DC. His office is responsible for administration of CBP's Intellectual Property Rights (IPR) border enforcement program which includes developing IPR enforcement policies, guidelines, and regulations; issuing binding legal rulings and decisions; and overseeing IPR training for the agency. Mr. McCray will discuss current issues and challenges related to domestic and international IPR border enforcement, with particular focus on Section 337 actions.

10:00 **Morning Coffee Break**

10:10 **Maximizing Your Relationship with Customs: Securing Enforcement and to Preparing for Subsequent Product Questions**

Lars-Erik A. Hjelms

Partner, Akin Gump Strauss Hauer & Feld LLP (Washington, D.C.)

Peter A. Quinter

Shareholder, Becker & Poliakoff P.A. (Ft. Lauderdale, FL)

- Addressing product changes that continue to violate the Exclusion Order

- Steps to remedy this situation when there is a later-developed products
- Developing arguments in support of or diffuse claims that subsequent products differentiate from those excluded
 - Strategies that demonstrate how little- or how much- the product differentiates from that described in the order
- Working with the Customs IP Branch, Office of Regulations and Rulings
 - Identifying the mechanics of what to do when an order is entered
 - Preparing for Customs certification
 - Ensuring an order is specific yet accessible for customs enforcement
 - Considering the multiple Customs locales where the order must be enforced
- Ensuring a desired outcome when there are disputes over the Exclusion Order's intended language
 - Quasi-judicial proceeding regarding the scope of an ITC order
 - Preparing for the lack of formal rules and lack of transparency
- Obtaining an Advisory Opinion
 - Considering factors such as time, effort, and overall goals
- Preparing for the requirements of the post-hearing process
 - Alerting Customs to specific criteria to look for when an excluded product enters the US
- Strategies to keep Customs abreast of viable violations of the Exclusion Order

11:20 **Foreign Company Case Study: Preparing A Client for an ITC Action, and Addressing Their Questions, Fears and Challenges**

Laura Beth Miller

Partner, Brinks Hofer Gilson & Lione (Chicago, IL)

Kevin O'Brien

Partner, Baker & McKenzie LLP (Washington, D.C.)

Ralph A. Mittleberger

Counsel, Arent Fox LLP (Washington, D.C.)

- Identifying companies who face a potential ITC action as a likely third party respondent
 - Instilling a procedure to prepare them for probable discovery demands
- Addressing clients' questions when there is limited knowledge about US jurisprudence and a lack of understanding about the ITC
 - Common questions regarding the scope of discovery
 - Understanding severe penalties and their potent effects on the business
- Synthesizing overseas patent systems with US patents to effectively respond to an action
- Identifying and preparing key persons within a corporation for a deposition
 - Securing time and locations in accordance with the Hague convention and the laws of both the corporation headquarters and the named office or warehouse
 - Locating reliable translators and other service agents for quick turnaround for an ITC action
- Protecting a client's trade secrets during an ITC action
 - Addressing their concerns when they are not allowed in the courtroom
 - Acceptable procedures to allow the client to remain up to date on the litigation without violating confidentiality
- Initiating a foreign ITC action

- Recognizing conditions that lend themselves to a successful ITC action
- Organizing the client and the discovery for large scale action by a foreign based corporation with multiple layers
- Resolving challenges of a foreign action against a US corporation vs. a foreign action vs. another foreign corporation

12:30 Networking Luncheon for Speakers and Delegates

1:45 Operating in the Eye of the Storm: Effective Strategies for Litigating an ITC Action

Sturgis Sobin

Partner, Covington & Burling LLP (Washington, D.C.)

Colleen M. Coyle

Partner, Akin Gump Strauss Hauer Feld LLP (Washington, D.C.)

Jeffrey M. Telep

Partner, King & Spalding LLP (Washington, D.C.)

- Establishing a clear definition of the client's business objectives
 - Complainant issues, Respondent issues
- Deciding what issues can and must be litigated within the constraints of the 337 process
 - Focus is King!
 - What are the consequences of overloading the litigation objectives
 - How many parties, patents, claims (defenses) are too many?
- Forming an effective case team including:
 - Structure of team, Responsibilities of team members, Documented protocols, Communication
- Optimizing back-office systems and personnel for 337
 - Identifying where systems built for district court litigation may not work at the ITC
- Establishing a practical case timeline
 - Establishment of incremental target dates for critical tasks
 - Discovery cycles, Depositions, Contention interrogatories, Claim construction, Expert reports, Trial planning
 - Tips for managing to the internal schedule
- Building constructive relationships with ITC staff and adverse parties
- Effective hearing strategies
- Building a successful end-game plan including:
 - Precise terms of remedy position, Design-arounds, Review and appeal, Customs enforcement strategy

3:00 Afternoon Coffee Break

3:15 Section 337 Litigation Business Advantages: ITC vs. Federal District Court

Jim Adduci

Partner, Adduci, Mastriani, and Schaumberg, LLP (Washington, D.C.)

Stephen L. Sulzer

Partner, Connolly Bove Lodge & Hutz LLP (Washington, D.C.)

Keith Askoff

General Counsel, Varian Medical Systems, Inc. (Palo Alto, CA)

- Selecting a venue: Evaluating ITC vs. District Court
 - Procedural differences between ITC and District Court
 - Comparing the available remedies
 - Weighing the client's goals
 - Calculating cost benefits and time for each action
 - Identifying the legal and business advantages

- Strategies for dual actions in Federal District Court and before the ITC
 - Benefits and disadvantages of staying a parallel district court action
 - What you need to know for an ITC proceeding
 - How the Commission determines whether an investigation should be commenced
 - Utilizing accelerated discovery and the role of expert witnesses
 - Requesting a stay
 - Settlement negotiations
 - Avoiding the most common pitfalls in fast track litigation
 - *Res judicata* issues
- Post-determination proceedings
 - Stay of relief/Presidential review
 - Federal Circuit appeals
 - Enforcement of exclusion orders and/or cease and desist orders

4:15 Passing the Domestic Industry Test with the Rise of Licensing and Trademark Cases

Elizabeth A. Niermeyer

Partner, Finnegan, Henderson, Farabow, Garrett & Dunner, L.L.P. (Washington, D.C.)

Bas de Blank

Partner, Orrick, Herrington & Sutcliffe (Menlo Park, CA)

- Review of attempts to satisfy the domestic industry requirement through licensing activities.
 - Exploring the growth of licensing-based domestic industry complainants and their business practices in light of the traditional domestic industry two-prong test for non-licensing based domestic industries
 - Cases where the licensee did not meet the acceptable standard as a result of their business practices
 - Reviewing the question of a "critical license"
- Post-determination proceedings
 - Stay of relief/Presidential review
 - Federal Circuit appeals
 - Enforcement of exclusion orders and/or cease and desist orders
- Licensees who cannot avail themselves of the ITC

5:30 Conference Adjourns

Who You Will Meet

In house Counsel and Law Firm attorneys specializing in Patent, Electronic Patent, Trademarks, International Trade and Customs, Licenses and Intellectual Property

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