

全國工業總會研討會：
美國國際貿易委員會訴訟之進階策略
CNFI Seminar: Advanced ITC Litigation Strategies



全國工業總會
Chinese National Federation of Industries (CNFI)



博欽律師事務所
Perkins Coie LLP

博欽外國法事務律師事務所
Perkins Coie Foreign Legal Affairs Attorneys at Law

對美國國際貿易委員會專利訴訟爭端之進階法律策略

Advanced Legal Strategies for Litigating Patent Disputes at the
U.S. International Trade Commission.



民國 102 年 10 月 23 日，星期三，上午 9 點 30 分至下午 4 點 15 分
WEDNESDAY, OCTOBER 23, 2013 – TAIPEI (9:30AM – 4:15 PM)
國立台灣大學法律學院 霖澤館國際會議廳
CONFERENCE HALL OF TSAI LECTURE HALL
COLLEAGUE OF LAW, NATIONAL TAIWAN UNIVERSITY
台北市羅斯福路 4 段 1 號（霖澤館 1 樓）
位於台大第二校門（辛亥路及復興南路口）
1ST FLOOR OF TSAI LECTURE HALL, NO. 1, SEC. 4, ROOSEVELT
ROAD, TAIPEI CITY, TAIWAN (NEARBY HSINHI ROAD AND FUSIN SOUTH ROAD)

備註：各講座以英語或中文進行，英文之演講會提供部分之中文節譯
5.25 HOURS CLE CREDIT (5.25 小時 CLE 學分)

Perkins Coie LLP and Chinese National Federation of Industries (CNFI) are pleased to co-host a symposium for those who already have a basic knowledge of patent litigation procedures at the U.S. International Trade Commission ("ITC"). The symposium will address advanced patent litigation topics, strategies and practice pointers and practical tips in view of the ITC's most recent rule changes, opinions and orders. Topics will include:

- Advanced Techniques for Non-U.S. Companies to Satisfy or Defeat Domestic Industry Allegations In View Of Recent ITC Decisions
- Achieving A Successful Result at The ITC Cost-Effectively whether Alone or as Part of a Joint Defense Group: Everything Your Outside Counsel Is Not Telling You
- Litigating Against Non-Practicing Entities at The ITC
- Dealing With ITC Exclusion Orders: Are They a "Toothless Dog?"
- Defending against an ITC Enforcement Proceeding

聯合主辦

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研討會的主題與安排

Topics & Schedule



9:30 – 9:45 AM

簽到 REGISTRATION

9:45 – 10:30 AM

戰勝專利權人主張國內工業要件之進階技巧

ADVANCED TECHNIQUES FOR DEFEATING A PATENT OWNER'S DOMESTIC INDUSTRY ALLEGATIONS

- Taking advantage of the ITC's pilot program for early evaluation of domestic industry: 337-874
- Traditional strategies and the impact of recent Federal Circuit and Commission Decisions
- New strategies available given recent Federal Circuit and Commission Decisions
- Examples and case studies

10:30 – 11:15 PM

非美國公司建立國內工業要件之進階技巧

ADVANCED TECHNIQUES FOR NON-U.S. BASED COMPANIES TO ESTABLISH A DOMESTIC INDUSTRY

- Overview of the domestic industry requirement including most recent related Federal Circuit and Commission decisions
- Tradition methods for establishing a domestic industry claim
- New methods and strategies for establishing a domestic industry claim
 - Leveraging activities of U.S. licensees to satisfy 19 U.S.C. § 1337(a)(3)(A)-(C)
 - Leveraging activities relating to products that practice the asserted patents and the activities of third parties
- Examples and case studies

11:15 – 12:15 PM

在美國國際貿易委員會對非實施主體之訴訟策略

STRATEGIES FOR LITIGATING AGAINST NON-PRACTICING ENTITIES AT THE ITC

- Patent trends impacting NPEs at the ITC
- Obtaining early resolution of dispositive issues
- Forcing early contentions to preclude new arguments later
- Effectively using NPEs infringement, validity and domestic industry arguments against them
- Attacking NPEs domestic industry allegations

12:15 PM – 1:30 PM

午餐 LUNCH

1:30 – 2:45 PM

符合成本效益地達到美國國際貿易委員會之訴訟成功：聘僱律師應該告訴你的事

ACHIEVING SUCCESS AT THE ITC COST-EFFECTIVELY: WHAT YOUR OUTSIDE COUNSEL SHOULD BE TELLING YOU

- Methods and practice tips for keeping costs down whether or not you participate in a joint defense group
- Effectively using PTO proceedings to advantage your ITC defense
- Potential problems that can arise when participating in a joint defense groups with competitors
- Examples and case studies

2:45 – 3:30 PM

美國國際貿易委員會救濟：他們是“沒有牙齒的狗嗎？”

ITC REMEDIES: ARE THEY A “TOOTHLESS DOG?”

- Navigating the U.S. Department of Customs
- Obtaining approval for “design around” devices: *Apple v. HTC* and *Microsoft v. U.S.*
- Dealing with The U.S. Trade Representative

3:30 – 4:15 PM

於美國國際貿易委員會強制執行時之防禦方式

DEFENDING YOUR COMPANY IN AN ITC ENFORCEMENT PROCEEDING

- Advanced Techniques to Avoid Being Found In Violation Of An ITC Exclusion Order: *DC-DC Controllers*, Inv. No. 337-TA-698

4:15 PM

Q&A

About the Speakers



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John Schnurer (施良嘉) is a partner in the firm's Patent Litigation group and co-chair of the firm's Section 337 investigations practice. He litigates and tries cases in courts throughout the country, including over 25 Section 337 investigations before the United States International Trade Commission (ITC) including eight jury trials and nineteen bench trials, six of which were patent trials U.S. ITC. He is recognized as a premiere intellectual property strategist, particularly with respect to the development and execution of global patent litigation strategies. John also prepares provides strategic intellectual property counseling including advice on patent infringement, validity, re-examinations, and large portfolio due diligence studies, whether for acquisitions, licensing, or pre-suit purposes. He achieves optimum results by partnering with his clients to devise and execute customized legal strategies that are consistent with his clients' tactical and strategic business objectives. His experience as a former electrical engineer complements his legal practice.

He has represented Taiwanese companies in patent litigation, such as HTC, ASUS, Largan Precision, ATEN and Pegatron. He wins and does so cost-effectively. He was lead counsel for ASUS in *IBM v. ASUSTeK Computer, Inc. and ASUS Computer International* (337-TA-628)-- a patent case concerning products implementing power supplies, variable speed fans, network address port translation. His efforts resulted in a win at trial with the initial determination (ALJ Essex) finding no infringement. The Commission decided not to review the initial determination, which became final. Prior to this case, the Commission had reversed in whole or in part all five of ALJ Essex's initial determinations. Additionally, he is lead counsel for HTC in *FlashPoint v. HTC Corporation et al.* (337-TA-726)-- a patent case concerning various camera functionality in smartphones. His efforts resulted in a win at trial with the initial determination (ALJ Luckern) finding no infringement, no domestic industry and one of the patents invalid due to on-sale commercial activities. Significantly, other respondents including Nokia and RIM settled shortly before trial and LG settled after trial but prior to the initial determination, each paying substantial licensing fees. The Commission affirmed the initial determination, and also found HTC had an implied license to practice the asserted patents for its Windows-based products.



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James B. Coughlan Jim has extensive patent litigation experience before the U.S. International Trade Commission both as a partner in private practice and in his former position as a lead staff attorney at the ITC's Office of Unfair Import Investigations. Jim has served as lead ITC counsel in over 40 ITC investigations, has litigated 14 actions through to trial at the ITC and has also litigated 4 ITC actions on appeal before the U.S. Court of Appeals for the Federal Circuit. Jim served as lead ITC counsel in a major dispute involving two well-known, competing smart phone operating systems, and represented two cell phone manufacturers in one of the largest and most significant ITC actions on record which resulted in the Federal Circuit's Kyocera decision. He has represented clients before the U.S. Department of Customs and Border Protection and the Office of the U.S. Trade Representative after the conclusion of the ITC proceedings to obtain approval for design around devices and a delay in the imposition of ITC remedial orders. Jim's representations have involved patents relating to various technologies including wireless communication devices, 4G communication technologies, streaming video software, portable digital media players, integrated circuits, jet engines, hardware logic emulation devices, adhesives, biotechnology methods for producing growth hormones, smoke suppressants and welding wire. Jim belongs to the ITC Trial Lawyers Association. In addition to his experience before the ITC, Jim served as legal counsel for U.S. Senator Carl Levin and as judicial law clerk for the Hon. Marion T. Bennett, U.S. Court of Appeals for the Federal Circuit.



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Kevin Patariu is an associate with the firm's Patent Litigation practice. Kevin practices in the areas of patent litigation and Section 337 investigations, due diligence and freedom to operate investigations, patent prosecution and counseling, and preparation of infringement and validity opinions. Kevin is experienced in the following technical areas: semiconductor device design, fabrication, characterization, and testing, software design and testing, computer architecture and embedded systems, automated mechanical transmission systems, wired and wireless communication devices and systems, and activated carbon processing. Prior to law school, Kevin worked as an electrical engineer for eight years, designing integrated circuits for a variety of applications, including copier/printer/scanner products, satellite and digital cable set top boxes, removable media card interfaces, and forward looking infrared array (FLIR) sensors. Kevin is the co-inventor of several patents in the field of data encryption/decryption.



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Louise Lu (陸筠) is an associate with Perkins Coie's patent practice. Louise practices in the areas of patent litigation in federal district courts and Section 337 investigations, preparation of non-infringement and invalidity opinions, post-grant proceedings, patent prosecution and counseling. Louise has represented Taiwanese companies such as HTC and ASUS in patent litigation (and also various Taiwanese clients in the indemnification context) in the forums including ITC and federal district courts. Louise is experienced in the following technical areas, including: computer architecture and design, wired and wireless communication systems and devices, network systems, software design and testing, computer database programming, and semiconductor devices and design. Prior to law school, Louise has obtained a master of intellectual property degree and worked as a project coordinator in computer database and network system programming and design.

Firm Overview



With more than 800 lawyers in 19 offices in United States, China and Taiwan, Perkins Coie is a leading international law firm and represents thousands of great companies across all industries and stages of growth—from start-ups to FORTUNE 50 public companies. Perkins Coie's 100-year tradition of partnering with our clients to build great companies has earned our firm the privilege of representing leading Taiwanese companies and other industry-leading companies such as HTC, ASUSTeK, Largan Precision, ATEN International, Microsoft, Intel, Google, Boeing and Starbucks, to name just a few.

CAPABILITIES

Perkins Coie attorneys represent a wide range of clients—individuals, partnerships, non-profit organizations, government bodies, for-profit entities, international organizations—and provide counsel in every major area of commercial and regulatory law and litigation. While the firm offers a broad range of specialized services, we focus intensively on patent litigation, patent procurement, other intellectual property and technology; M&A, corporate finance and other strategic transactions; complex litigation; labor and employment law; political law and government affairs; and real estate.

The firm has a strong international capability through our offices in Taipei, Beijing and Shanghai, the ongoing experience of our attorneys in the United States and our relationships with foreign law firms.

PROFESSIONAL RECOGNITION

Perkins Coie was named the fifth busiest law firm in the country for patent litigation defense and seventh for overall patent litigation by *Corporate Counsel* magazine in 2011. A total of 161 Perkins Coie lawyers were named among the 2012 "Best Lawyers in America;" 232 of our lawyers have received the highest "AV" rating from Martindale Hubbell; 100 attorneys received *Chambers USA* recognition with 29 attorneys receiving the #1 rank in their respective practices in 2011. Perkins Coie also obtained Band 1 placement in 18 practice areas with top rankings in ten key markets across the country. In addition, Perkins Coie was named one of the nation's "100 Best Companies to Work For" in 2011 by FORTUNE magazine for our tenth year in a row.

OFFICE LOCATIONS

Anchorage, Alaska	Denver, Colorado	Portland, Oregon
Beijing, China	Los Angeles, California	San Diego, California
Bellevue, Washington	Madison, Wisconsin	San Francisco, California
Boise, Idaho	New York, New York	Seattle, Washington
Chicago, Illinois	Palo Alto, California	Shanghai, China
Dallas, Texas	Phoenix, Arizona	Taipei, Taiwan
		Washington, D.C.

Patent Practice

Ranked in 2013 by Chambers and Partners as a leading firm for Intellectual Property law nationally and in several markets



OVERVIEW

In today's economy, a company is often defined in the global marketplace by its success in procuring, managing and enforcing its intellectual property. Perkins Coie's lawyers work closely with clients to develop comprehensive solutions to complicated intellectual property issues that companies face at all stages of growth.

The Perkins Coie Patent practice has more than 175 patent attorneys and agents that support the prosecution and litigation needs of our clients. Nearly 100 members of the group have science degrees, including more than 50 with electrical engineering, computer engineering or computer science backgrounds. Few firms, if any, in the country have our expertise plus such a deep technical bench. We also have more than 40 patent litigators and prosecutors with degrees in numerous life sciences disciplines.

Our Patent practice is part of the firmwide Intellectual Property group, which includes more than 250 lawyers focused on IP litigation, patent and trademark prosecution, technology licensing, copyrights, and trade secret and unfair competition counseling. Our clients include companies in all technologies and industries around the world. The IP group also has extensive experience litigating patent and trademark infringement actions, Internet-related disputes and gray market and anti-counterfeiting claims for companies in the software, online retail, search and electronics industries. Our clients benefit from our interdisciplinary approach to matters, which combines extensive legal and technical experience with strong corporate and litigation resources in a leading technology law firm.

ASIAN CLIENT EXPERIENCE

Perkins Coie has strong experience representing Asian companies, particularly in patent litigation and other intellectual property matters. We assist Asian companies in obtaining, enforcing and protecting their intellectual property assets in a variety of disciplines including semiconductors, telecommunications, biotechnology, pharmaceutical, medical devices and industrial chemistry and manufacturing.

The firm represents technology companies such as HTC, ASUSTeK, ATEN International, Largan Precision, Princo Corporation, Lite-On Group and Monolithic Power Systems in patent litigation and patent prosecution. Recently, we secured an important patent litigation victory for HTC Corporation before the U.S. International Trade Commission in a case filed

ACCOLADES

Ranked in 2013 by *Corporate Counsel* as the No. 1 law firm for handling the most cases in the ITC

Named 2012-2013 Patent "Law Firm of the Year" by *U.S. News – Best Lawyers*

Ranked by *Corporate Counsel* as the 5th busiest law firm in the country for patent litigation defense and 7th for overall patent litigation

Ranked National Tier 1 in Patent Law by *U.S. News – Best Lawyers*

Ranked by *Law360 and IP Law & Business* as having one of the largest patent litigation practices in the U.S.

Ranked in the Top 5 firms for patent quality in the Information Technology area

against it and others by FlashPoint Technologies, a subsidiary of Apple (337-ITC-726). We also recently obtained a favorable result in the ITC for HTC in a case brought by Apple (337-ITC-710).

We recently opened an office in the Taipei 101 Tower, which marks the third Perkins Coie office in Asia. Our offices in Beijing and Shanghai represent Chinese and multinational companies in intellectual property matters in the areas of technology and life sciences.

and 6th overall by Ocean Tomo and *Intellectual Asset Management Magazine*.

Four patent litigators are Fellows in the American College of Trial Lawyers.