

Fundamentals of Patent Prosecution 2010: A Boot Camp for Claim Drafting & Amendment Writing

New York City,* June 16-18, 2010

San Francisco, July 7-9, 2010

- A unique combination of patent prosecution lectures and senior patent prosecutor mentoring
- One-of-a-kind, one-on-one clinics to develop and polish patent writing skills
- Learn to prepare a successful patent application
- How to avoid common mistakes during patent prosecution
- Litigation issues relevant to patent prosecution and how to avoid pitfalls

**This is an approved transitional program*

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Nicholas J. DuBois
McAfee, New Jersey

“Great program!”

Otto L. Steinbusch
Patent Agent, Carr & Ferrell LLP
Palo Alto

Fundamentals of Patent Prosecution 2010:

A Boot Camp for Claim Drafting & Amendment Writing

New York City, June 16-18, 2010
San Francisco, July 7-9, 2010

A PLI Basic Patent Program To Help You On Your Way

This three-day program is directed to patent attorneys, litigation attorneys and patent agents with little patent experience. It will focus on teaching the basics of claim drafting, patent application preparation and prosecution, as well as a review of recent developments in the law. It is designed to provide a practical and solid foundation on which to build a stronger professional patent practice. The clinics offer a unique supplement to the kind of mentoring that senior attorneys are hard-pressed to provide to less experienced attorneys and agents.

Structure

This three-day program will feature lectures each morning followed by small clinic sessions in the afternoon. Both the lecture sessions and the clinics will follow the patent application process — from invention disclosure and patent preparation (Day 1), through prosecution and issuance (Day 2) and into litigation (Day 3). Homework is different for each program and is specially designed to complement the New York City and San Francisco programs. Homework must be completed and submitted upon registering on-site at the program. More information about the homework will be made available at www.pli.edu at a later date.

The lectures are designed to provide a review of the patent preparation and prosecution process and explain:

- How to interview the inventor
- How to identify the invention
- How to decide what elements of the invention should be included in the patent
- How to prosecute an application to result in allowance of an enforceable patent
- How to interview an Examiner
- How to use reissues, reexaminations and other post-issuance proceedings
- How to anticipate patent litigation issues during the patent prosecution process

Practical Special Features

- Morning lectures on critical patent application topics
- One-of-a-kind, one-on-one clinics with experienced patent prosecutors to develop and polish patent writing skills

Reserve your place today, call (800) 260-4PLI.

Jeanne C. Curtis

Ropes & Gray LLP
New York City

Michael A. Davitz, M.D.

Axinn, Veltrop & Harkrider LLP
New York City

Marta E. Delsignore, Ph.D.

Goodwin Procter LLP
New York City

Robert C. Faber

Ostrolenk Faber LLP
New York City

Author, *Faber on Mechanics of Patent Claim Drafting* (PLI)

William S. Frommer

Frommer Lawrence & Haug LLP
New York City

Thomas J. Kowalski

Frommer Lawrence & Haug LLP
New York City

Robert D. Schaffer

Pearl Cohen Zedek Latzer LLP
New York City

Len S. Smith

Principal Intellectual Property Counsel
Medicis Pharmaceutical Corporation
Scottsdale, Arizona

Samuel S. Woodley, Ph.D.

Fish & Richardson P.C.
New York City

Brandon Baum

Mayer Brown LLP
Palo Alto

Jennifer R. Bush

Fenwick & West LLP
Mountain View, California

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NEW YORK CITY



Co-Chairs: Adda C. Gogoris
Merchant & Gould
New York City



John A. O'Brien
Law Offices of John A. O'Brien, P.C.
New York City



Louis S. Sorell
Goodwin Procter LLP
New York City

New York City Clinic Instructors

N.B. The New York City Clinic Instructor team changes each day of the program.
On each of the 3 days the faculty size is approximately 10.

Jonathan Berschadsky

Fitzpatrick, Cella, Harper & Scinto
New York City

Hua (Helene) Gao

Cohen Pontani Lieberman & Pavane LLP
New York City

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Assistant Patent Counsel
Johnson & Johnson
New Brunswick, New Jersey

Nada Jain, Ph.D.

Principal & Founder
NADA JAIN, P.C.
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Danbury, Connecticut

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Director and Chief Patent Counsel of
Americas Group Intellectual Property
UBS AG
Stamford, Connecticut

Richard Straussman

Short Hills, New Jersey

Nanette S. Thomas

Senior Intellectual Property Counsel
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Franklin Lakes, New Jersey

Carl B. Wischhusen

Cohen Pontani Lieberman & Pavane LLP
New York City

Lock See Yu-Jahnes, Ph.D.

Fitzpatrick, Cella, Harper & Scinto
New York City

SAN FRANCISCO



Chair: Michael A. Molano
Sheppard Mullin Richter & Hampton LLP
Menlo Park, California

Wendy A. Choi

Kilpatrick Stockton LLP
Atlanta

Stephen C. Durant

Schwegman, Lundberg & Woessner, P.A.
San Jose

Mary A. Fuller

Executive Director and Associate
General Counsel, IP
Maxim Integrated Products, Inc.
Sunnyvale, California

Marc A. Sockol

Sheppard Mullin Richter & Hampton LLP
Menlo Park, California

San Francisco Clinic Instructors:

N.B. The San Francisco Faculty is the
Clinic Instructor team and remains the
same for the entire 3-day program. On
each of the 3 days the faculty size is
approximately 7.

PROGRAM SCHEDULE

DAY ONE: 9:00 A.M. – 5:00 P.M.

Morning Session: 9:00 a.m. – 12:30 p.m.

9:00

Program Overview

The program begins with a review of the three-day schedule.

NYC: John A. O'Brien

SF: Michael A. Molano

9:15

Taking Invention Disclosures

An explanation of how to take an effective invention disclosure. A review of how to determine inventorship, ethical obligations related to who the client is and the prior art known by the inventor or others, exploring on-sale bar issues and other common pitfalls in inventor interviews (e.g., explaining best mode and other 112 requirements to the inventor).

NYC: John A. O'Brien

SF: Marc A. Sockol

10:15

Overview of Claim Drafting and Preparation of Patent Application

This presentation focuses on analyzing the invention disclosure, preparing drawings and claims, choosing embodiments, and preparing the specification and filing the patent application.

NYC: William S. Frommer

SF: Wendy A. Choi

11:15 *Networking Break*

11:30

Claim Drafting

Basic claim drafting principles and formats; preparing claims in different statutory classes, different technologies, including mechanical, electrical and chemical, and filing the application.

NYC: Robert C. Faber

SF: Wendy A. Choi

12:30 *Lunch Break*

Afternoon Session: 2:00 p.m. – 5:00 p.m.

2:00

Clinic I

NYC: You will draft, analyze and amend claims to provided inventions. Your claims will be reviewed and analyzed on a one-on-one basis with the clinic tutor.

SF: You will analyze and draft claims to a sample invention. Your claims will be reviewed and analyzed on a one-on-one basis with the clinic tutor.

NYC Clinic Instructors: Jonathan Berschadsky, Robert C. Faber, William S. Frommer, Steven F. Meyer, Douglas A. Miro, Thomas F. Presson, Richard Straussman, Nanette S. Thomas, Carl B. Wischhusen, Lock See Yu-Jahnes

SF Clinic Instructors: Brandon Baum, Jennifer R. Bush, Wendy A. Choi, Stephen C. Durant, Mary A. Fuller, Michael A. Molano, Marc A. Sockol

4:30

Review of Model Claims

5:00 *Adjourn*

PLI's Nationally Acclaimed Course Handbooks

All program attendees will receive a copy of the **Fundamentals of Patent Prosecution 2010: A Boot Camp for Claim Drafting & Amendment Writing** Course Handbook. This bound volume is prepared specifically for this program and also stands alone as a permanent reference. PLI's Course Handbooks represent the definitive thinking of the nation's finest legal minds, and are considered the standard reference in the field. *The Course Handbook will be available on the first day of the program.*

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There is no easier way to complete your MCLE requirement than with PLI's **CLE Now Web Segments/Programs**: We've taken PLI's extensive library of previously recorded programs and made them available online 24/7 via streaming video and/or audio. These are conveniently broken down into 1/2 - 3 hour programs so you get only the information you want. With over 1,500 hours of content to choose from, you're sure to find a Web Segment that will meet your needs. As an added bonus, you'll continue to have access to your Web Segments for one full year and will be able to download the online Course Materials that accompany your Web Segment. At more than 60% off the regular price, there's never been a faster, easier, more affordable way to meet your MCLE requirement.

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Since 1933, PLI has been the comprehensive resource for the training and development needs of legal professionals. PLI is heavily involved in pro bono and research and development activities to ensure that all practicing attorneys and law students remain on the cutting edge. These activities include awarding full and partial scholarships to our Institutes and Programs, assisting public interest organizations in their training needs, and helping law students become first-rate attorneys by posting free lectures on our web site and offering free MPRE courses. For more information, go online to pro-bono.pli.edu.

PLI Scholarships

Please check the Registration Information section of this brochure for more information about PLI scholarships.

Please plan to arrive with enough time to register before the conference begins.
A networking breakfast will be available upon your arrival.

DAY TWO: 9:00 A.M. – 5:00 P.M.

Morning Session: 9:00 a.m. – 12:15 p.m.

9:00

Patent Prosecution

This presentation will give an overview of patent prosecution and include a review of common mistakes made during patent prosecution in responding to Office Actions, understanding differences between objections/rejections, how to respond to each, how to amend the specification, claims and drawings, and how to analyze references. Also, responses to final actions, appeals, reissues, and other post-issuance matters will be covered. Lastly, recent changes in the law relating to patent prosecution and ethical issues for Information Disclosure Statements will be discussed.

NYC: Adda C. Gogoris, Thomas J. Kowalski, Len S. Smith

SF: Jennifer R. Bush

11:00 *Networking Break*

11:15

Conducting the Examiner Interview

After receiving an Office Action, an Examiner interview is a golden opportunity for a patent applicant and an Examiner to arrive at a mutual understanding of the issues in a case. A mock interview format will be used to illustrate the interview process from the perspectives of the applicant and the Examiner, as well as to highlight important aspects of patent prosecution. You will learn how to prepare for and conduct an effective interview and how to create an accurate record of what was agreed upon during the interview.

NYC: Michael A. Davitz, Samuel S. Woodley

SF: Stephen C. Durant

12:15 *Lunch Break*

Afternoon Session: 1:45 p.m. – 5:00 p.m.

1:45

Clinic II

You will receive an amendment problem relating to the sample invention to work on individually. After general discussion, the clinic tutor will review your responses on a one-on-one basis.

NYC Clinic Instructors: Hua (Helene) Gao, Adda C. Gogoris, Nada Jain, Deborah L. Lu, Len S. Smith, Carmella L. Stephens, Samuel S. Woodley

SF Clinic Instructors: Brandon Baum, Jennifer R. Bush, Wendy A. Choi, Stephen C. Durant, Mary A. Fuller, Michael A. Molano, Marc A. Sockol

4:30

Review of Model Amendment

5:00 *Adjourn*

DAY THREE: 9:00 A.M. – 5:00 P.M.

Morning Session: 9:00 a.m. – 12:30 p.m.

9:00

Litigation Issues

Litigation issues relevant to patent prosecution with particular emphasis on prosecution issues in claim construction, means plus function claim language, Doctrine of Equivalents analysis in view of the *Festo* decisions, inequitable conduct, and the preparation of non-infringement and invalidity opinions.

NYC: Jeanne C. Curtis, Marta E. Delsignore, Robert D. Schaffer, Louis S. Sorell

SF: Brandon Baum, Mary A. Fuller, Michael A. Molano

11:15 *Networking Break*

11:30

Litigation Issues (Continued)

12:30 *Lunch Break*

Afternoon Session: 2:00 p.m. – 5:00 p.m.

2:00

Clinic III

NYC: You will work on problems relevant to patent prosecution issues and opinion drafting. You and the clinic tutor will then review and discuss your responses on a one-on-one basis.

SF: You will prepare a claim chart to enforce the sample invention that has now issued into a U.S. patent. You and the clinic tutor will then review and discuss your work on a one-on-one basis.

NYC Clinic Instructors: Marta E. Delsignore, Sharon E. Hayner, Kristin J. McNamara, Leslie Morioka, Paul J. Otterstedt, Leonardo Renna, Lindsey A. Repose, Alicia Russo, Robert D. Schaffer, Mary Anne Schofield, David M. Shofi, Louis S. Sorell, Robert A. Stewart

SF Clinic Instructors: Brandon Baum, Jennifer R. Bush, Wendy A. Choi, Stephen C. Durant, Mary A. Fuller, Michael A. Molano, Marc A. Sockol

3:15 *Networking Break*

3:30

Clinic III (Continued)

5:00 *Adjourn*

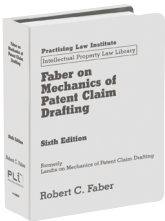
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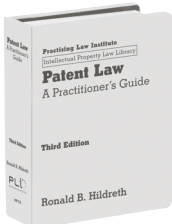


Faber on Mechanics of Patent Claim Drafting Sixth Edition

Robert C. Faber

(Ostrolenk Faber LLP, New York City)

*1 looseleaf volume, 904 pages, \$390 (Updated annually or as needed:
No charge for revision within 3 months of purchase)*



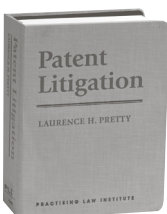
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Patent Litigation

Edited by Laurence H. Pretty

(Law Office of Laurence H. Pretty, Los Angeles)

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810 Seventh Avenue, New York, NY 10019
Fax or mail completed Registration/Order Form on back cover

New York City Seminar Location: PLI New York Center, 810 Seventh Avenue at 53rd Street (21st floor), New York, New York 10019. Message Center, program days only: (212) 824-5733.

New York City Hotel Accommodations:
Due to high demand and limited inventory in NYC, we recommend reserving hotel rooms as early as possible.

Hilton New York Hotel, 1335 Avenue of the Americas, New York, New York 10019. Reservations (877) NYC-HILT. Please mention you are booking a room under the Practising Law Institute Corporate Rate and the Client File N# is 0495741. You may also book reservations online: go to www.pli.edu for this program, click Hilton link to see preferred rates. Enter requested dates and Practising Law Institute rates will appear.

Warwick New York Hotel, 65 West 54th Street, New York, NY 10019. 1 block from PLI Center. Reservations 800-223-4099 or hotel direct 212-247-2700. Please mention that you are booking a room under the Practising Law Institute Corporate Rate. Reservations online at www.warwickhotelnyc.com Click reservations in menu bar on left. Select desired dates. In 'Special Rates' drop down window select Corporate Rate. In 'Rate Code' enter PLIN. Click search and select desired room type and rate plan. Or, you may email reservation requests to: res.ny@warwickhotels.com

San Francisco Seminar Location: PLI California Center, 685 Market Street, San Francisco, California 94105. (415) 498-2800.

San Francisco Hotel Accommodations:
Due to high demand in SF, we recommend reserving hotel rooms as early as possible.

The Palace Hotel, 2 New Montgomery Street, San Francisco, California 94105. Call (800) 917-7456 seven days a week from 6:00 a.m. to 12:00 a.m. (PT) and mention you are attending this PLI program at Practising Law Institute to receive the preferred rate. For online reservations, go to www.SFPALACE.com and enter SET No. 287179 to receive the preferred rate.

Payment Policy: Registration fees are due in advance. Attendees may pay by check, Visa, MasterCard, American Express or Diners Club.

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the PLI Scholarship Committee. All applications must be accompanied by a \$25 application fee (this fee is waived for judicial law clerks), and must be submitted four weeks before the date of the program you wish to attend. (Applicants may pay by check or credit card.) If the request for a scholarship is denied, the \$25 application fee will be returned. Students must also submit a copy of their student ID card.

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Make necessary corrections on mailing address.

YES, please register me for the following session:

Fundamentals of Patent Prosecution 2010

- 24112 **New York City Seminar,*** June 16-18, 2010, PLI New York Center, \$1,795²
- 24113 **San Francisco Seminar,*** July 7-9, 2010, PLI California Center, \$1,795²

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- 24114 Course Handbook only, \$199
- 16966 Faber on Mechanics of Patent Claim Drafting, 6th Ed., 1 looseleaf volume, \$390
- 613 Patent Law: A Practitioner's Guide, 3rd Ed., 1 looseleaf volume, \$275
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