

Fundamentals of Patent Prosecution 2013: A Boot Camp for Claim Drafting & Amendment Writing

Chicago, May 14-16, 2013

New York City, June 12-14, 2013

San Francisco, July 10-12, 2013

**Clinic instruction
in small groups
each day.**

- A unique combination of patent prosecution lectures and mentoring, including the impact of the **America Invents Act**
- Sharpen your patent writing skills in small group writing and critique clinics with seasoned patent prosecutors
- Learn to prepare a successful patent application and avoid common mistakes during patent prosecution
- Master lessons from litigation and how to avoid patent prosecution pitfalls

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Fundamentals of Patent Prosecution 2013: A Boot Camp for Claim Drafting & Amendment Writing

Chicago, May 14-16, 2013

New York City, June 12-14, 2013

San Francisco, July 10-12, 2013

Why You Should Attend

This program is directed to patent prosecuting and litigating attorneys and patent agents with or without a Patent Office registration number or 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. A litigator's perspective is presented to show how drafting and prosecution can influence the development, and often the outcome, of subsequent patent litigation. The clinics offer a unique supplement to the kind of hands-on mentoring that senior attorneys are hard-pressed to provide to less experienced attorneys and agents.

What You Will Learn

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) to litigation/opinion drafting (Day 3). Homework is different for each location and is specially designed to complement Chicago, New York City and San Francisco. Homework must be completed and submitted upon registering onsite 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 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, reexamination supplemental examinations and other post-issuance proceedings
- How to anticipate patent litigation issues during the patent prosecution process
- How to approach patent opinion drafting

Special Features

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

Who Should Attend

Patent attorneys, patent agents, technical advisors and patent liaisons with no or very little patent prosecution experience will benefit from this program.

Anthony E. Dowell

Dowell IP, P.C.
Lafayette, Indiana

Edward D. Manzo

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Chicago

William E. McCracken

McCracken & Frank LLC
Chicago

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Vedder Price P.C.
Chicago

Mark H. Remus

Steptoe & Johnson LLP
Chicago

Lisa A. Schneider

Sidley Austin LLP
Chicago

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

Vedder Price P.C.
New York City

Gene W. Lee

Ropes & Gray LLP
New York City

Leslie Morioka

White & Case LLP
New York City

Byron Cooper

TekLaw.Co
Palo Alto

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Executive Director and Associate
General Counsel, IP
Maxim Integrated Products, Inc.
San Jose

Kanda V. Ishihara

Patent Law Works LLP
Los Altos, California

Robin W. Reasoner

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Donald L. Zuhn, Jr., Ph.D.
McDonnell Boehnen Hulbert &
Berghoff LLP
Chicago

Chicago Clinic Instructors
N.B. The Chicago Clinic Instructor
team changes each day of the
program. On each of the 3 days the
faculty size is approximately 7.

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New York City

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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 9.

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of the program. On each of the
3 days the faculty size is
approximately 8.

Martin Bader
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Hampton LLP
San Diego

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Sheppard Mullin Richter &
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IP Counsel
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Alexander R. Trimble, Ph.D.
Kilpatrick Townsend & Stockton LLP
San Francisco

Kenneth A. Weber, Ph.D.
Kilpatrick Townsend & Stockton LLP
San Francisco

Program Attorney: John M. Mola

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

A review of the three-day schedule.

CHI: *Kevin E. Noonan*

NYC: *Jonathan Berschadsky*

SF: *Wendy A. Choi*

9:15

Taking Invention Disclosures

This segment will offer an explanation on how to take an effective invention disclosure. It will discuss the manners 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).

CHI: *Kevin E. Noonan*

NYC: *Jonathan Berschadsky*

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.

CHI: *Donald L. Zuhn, Jr.*

NYC: *William S. Frommer*

SF: *Wendy A. Choi*

11:15 *Networking Break*

11:30

Claim Drafting

This segment will cover the basic claim drafting principles and formats; preparing claims in different statutory classes; different technologies, including mechanical, electrical and chemical; and filing the application.

CHI: *Edward D. Manzo*

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

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

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

CHI Clinic Instructors: *Janet M. Garetto, Adam G. Kelly, Paul R. Kitch, Edward D. Manzo, Thomas C. McDonough, James P. Muraff, Janet A. Pioli, David L. Schwartz, Christopher P. Singer*

NYC Clinic Instructors: *Frank J. DeRosa, Raymond A. DiPerna, Robert C. Faber, William S. Frommer, Douglas A. Miro, Robert D. Schaffer, Richard Straussman, Nanette S. Thomas, Carl B. Wischhusen, Lock See Yu-Jahnes*

SF Clinic Instructors: *Wendy A. Choi, Cathy E. Cretsinger, Sanjeet K. Dutta, Pauline Farmer-Koppenol, Mark H. Hopkins, Arrienne "Angel" Lezak, Marc A. Sockol, Alexander R. Trimble, Kenneth A. Weber*

3:15 *Networking Break*

3:30

Clinic I, Continued

4:30

Review of Model Claims

5:00 *Adjourn*

“ . . . I learned a ton, great program.”

- Katherine D. Buchanan, Patent Engineer,
Registered Patent Agent, Kids II, Inc.,
Atlanta

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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

An overview of patent prosecution, including changes made by the America Invents Act. The presentation includes a review of common mistakes made in responding to Office Actions, an explanation of differences between objections/rejections (and advice for responding to each), amending the specification, claims and drawings, analyzing references and addressing double-patenting issues. Responses to final actions, appeals, reexaminations, reissues, and other post-issuance matters, including the new third-party submissions, supplemental examination and contested administrative proceedings (*inter partes*, post-grant review, etc.), will also be covered. Lastly, ethical issues (duty of disclosure) will be discussed.

CHI: Christopher P. Moreno

NYC: Adda C. Gogoris, Thomas J. Kowalski,
Peter C. Schechter

SF: Kanda V. Ishihara

11:00 Networking Break

11:15

Conducting the Examiner Interview

After receiving an Office Action (or in certain cases even prior), an Examiner interview is a good opportunity for a patent applicant to define, and if possible, resolve some of the issues. The interview process will be described and deconstructed to illustrate what can be achieved and how. 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.

CHI: William E. McCracken

NYC: Samuel S. Woodley

SF: Jennifer R. Bush, Robin W. Reasoner

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 responses in a small group and on a one-on-one basis.

CHI Clinic Instructors: Romi N. Bose,
Patrick G. Burns, David Lesht,
Raymond M. Mehler, John S. Mortimer,
Thomas D. Paulius, Thomas J. Ring,
Mary C. Till

NYC Clinic Instructors: Adda C. Gogoris,
Andrew K. Holmes, Deborah L. Lu,
Anna D. DiGabriele Petti, Carmella L. Stephens,
Samuel S. Woodley

SF Clinic Instructors: Jennifer R. Bush,
Pauline Farmer-Koppenol, Emily M. Haliday,
Mark H. Hopkins, Kanda V. Ishihara,
Arrienne "Angel" Lezak, David C. Pauling,
Kenneth A. Weber

3:15 Networking Break

3:30

Clinic II, Continued

4:30

Review of Model Amendment

5:00 Adjourn

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All attendees will also receive a copy of the Course Handbook, either in one bound volume or on a flash drive. The Course Handbook 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.

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.

CHI: *Anthony E. Dowell, Richard T. McCaulley, Jr., Mark H. Remus, Lisa A. Schneider*

NYC: *Marta E. Delsignore, Gene W. Lee, Leslie Morioka, Robert D. Schaffer, Louis S. Sorell*

SF: *Byron Cooper, Mary Fuller, Michael A. Molano*

11:15 *Networking Break*

11:30

Litigation Issues, Continued

12:30 *Lunch Break*

“Great program. I had no experience, and the program provided foundation, knowledge, and skills essential for a new practitioner.”

- Jacob Song, Ropers, Majeski, Kohn & Bentley, Los Angeles

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

2:00

Clinic III

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

NYC: You will work on problems relevant to patent prosecution issues and opinion drafting. In a small group, the clinic tutor will then review and discuss responses and provide individual critiques.

CHI Clinic Instructors: *Marc A. Cavan, Anthony E. Dowell, Richard T. McCaulley, Jr., Mark H. Remus, Lisa A. Schneider*

NYC Clinic Instructors: *Andrew T. Block, Marta E. Delsignore, Sharon E. Hayner, Janet M. MacLeod, Kristin J. McNamara, Leslie Morioka, Paul J. Otterstedt, Leonardo Renna, Robert D. Schaffer, Mary Anne Schofield, David M. Shofi, Louis S. Sorell*

SF Clinic Instructors: *Martin Bader, Graham (Gray) M. Buccigross, Eric B. Evans, Erin C. Jones, Jennifer T. Lorch, Michael A. Molano, David C. Pauling*

3:15 *Networking Break*

3:30

Clinic III, Continued

4:30

Review and Wrap-Up

5:00 *Adjourn*

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Chicago Seminar Location: University of Chicago Gleacher Center, 450 N. Cityfront Plaza Drive, Chicago, Illinois 60611. (312) 464-8787.

Chicago Hotel Accommodations: InterContinental Chicago Magnificent Mile, 505 North Michigan Avenue, Chicago, Illinois 60611. (800) 628-2112. Please contact hotel directly in order to receive the preferred rate. When calling, please mention PLI and the name of the program you are attending. The cut-off date for the preferred rate is April 23, 2013.

Sheraton Chicago Hotel & Towers, 301 E. North Water Street, Chicago, Illinois 60611. (312) 464-1000. When calling, please mention PLI and the name of the program you are attending. The cut-off date for the preferred rate is April 14, 2013.

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: (800) 260-4754.

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Sheraton New York Hotel & Towers, 811 7th Avenue, New York, New York 10019. (212) 581-1000. When calling, mention Practising Law Institute and SET #311155.

San Francisco Seminar Location: PLI California Center, 685 Market Street, Suite 100, 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/pli to receive the preferred rate.

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Fundamentals of Patent Prosecution 2013

Chicago, May 14-16, 2013

New York City, June 12-14, 2013

San Francisco, July 10-12, 2013

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YES, please register me for the following session:

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Fundamentals of Patent Prosecution 2013

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