

# 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*

*“Outstanding and well-prepared presenters.”*

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](http://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

# FACULTY

## 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

#### Sharon E. Hayner

Assistant Patent Counsel  
Johnson & Johnson  
New Brunswick, New Jersey

#### Nada Jain, Ph.D.

Principal & Founder  
NADA JAIN, P.C.  
Tarrytown, New York

#### Deborah L. Lu, Ph.D.

Frommer Lawrence & Haug LLP  
New York City

#### Kristin J. McNamara

Patent Attorney  
Novozymes North America Inc.  
New York City

#### Steven F. Meyer

Locke Lord Bissell & Liddell LLP  
New York City

#### Douglas A. Miro

Ostrolenk Faber LLP  
New York City

#### Leslie Morioka

White & Case LLP  
New York City

#### Paul J. Otterstedt

Ryan, Mason & Lewis, LLP  
Fairfield, Connecticut

#### Thomas F. Presson

Frommer Lawrence & Haug LLP  
New York City

#### Leonardo Renna

Counsel, Intellectual Property  
and Technology  
MasterCard Worldwide  
Purchase, New York

#### Lindsey A. Repose

Goodwin Procter LLP  
New York City

#### Alicia Russo

Fitzpatrick, Cella, Harper & Scinto  
New York City

#### Mary Anne Schofield, Ph.D.

Crowell & Moring LLP  
Washington, D.C.

#### David M. Shofi

Chief Intellectual Property Counsel  
ATMI, Inc.  
Danbury, Connecticut

#### Carmella L. Stephens, Ph.D.

Kenyon & Kenyon LLP  
New York City

#### Robert A. Stewart

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  
Becton, Dickinson and Company  
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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## **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*

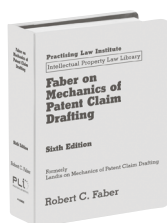
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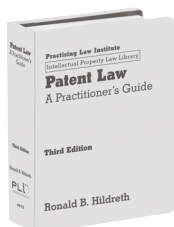


#### **Faber on Mechanics of Patent Claim Drafting Sixth Edition**

**Robert C. Faber**

*(Ostrolenk Faber LLP, New York City)*

*1 looseleaf volume, 904 pages, \$390 (Updated annually or as needed:  
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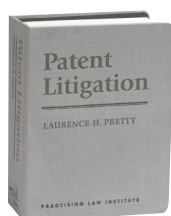
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*(Retired; Formerly of Baker Botts L.L.P., New York City)*

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#### **Patent Litigation**

**Edited by Laurence H. Pretty**

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

*1 looseleaf volume, 871 pages, \$295 (Updated annually or as needed:  
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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.

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*Due to high demand and limited inventory in NYC, we recommend reserving hotel rooms as early as possible.*

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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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- 24112 **New York City Seminar,\*** June 16-18, 2010, PLI New York Center, \$1,795<sup>2</sup>
- 24113 **San Francisco Seminar,\*** July 7-9, 2010, PLI California Center, \$1,795<sup>2</sup>

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- 613 Patent Law: A Practitioner's Guide, 3rd Ed., 1 looseleaf volume, \$275
- 638 Patent Litigation,<sup>1</sup> 1 looseleaf volume, \$295

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