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Fundamentals of

# Patent Prosecution 2007

**A Boot Camp for Claim Drafting & Amendment Writing**

- 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



**New York City,\* June 20-22, 2007**



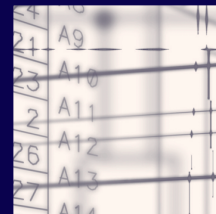
**San Francisco, July 11-13, 2007**

*\*This is an approved transitional program*

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# Fundamentals of Patent Prosecution 2007

## A Boot Camp for Claim Drafting & Amendment Writing



New York City, June 20-22, 2007



San Francisco, July 11-13, 2007

### 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 to lay the groundwork for 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 have lecture sessions each morning followed by small clinic group 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 and San Francisco programs. Homework will be available to students before the program by going to the following web links on or after June 1, 2007;

[http://www.pli.edu/public/patpro/SF\\_homework.pdf](http://www.pli.edu/public/patpro/SF_homework.pdf)

[http://www.pli.edu/public/patpro/NY\\_homework.pdf](http://www.pli.edu/public/patpro/NY_homework.pdf)

### The lecture sessions will provide a review of the patent preparation and prosecution process such as:

- 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

### PLI's Nationally Acclaimed Course Handbooks

All program attendees will receive a copy of the Course Handbook. This softcover, bound volume was prepared specifically for this program and will also stand alone as a permanent reference. PLI's Course Handbooks represent the definitive thinking of the nation's finest legal minds, and are often the standard reference in the field.

### Pro Bono Efforts

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# PROGRAM SCHEDULE

Please plan to arrive sufficiently in advance of the conference start time to register.

A continental breakfast will be available upon your arrival.

## First Day: 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 *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*

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

2:00

### Clinic I

NYC: You will analyze and draft claims to problems. 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:**

*Robert C. Faber, William S. Frommer, Steven F. Meyer, Douglas A. Miro, Eustus Dwayne Nelson, 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, Dennis S. Corgill, Mary A. Fuller, John F. Griffith, Loren H. McRoss, Michael A. Molano, Vera A. Nackovic, Scott D. Sanford, Marc A. Sockol, Brian N. Young*

4:30

### Review of Model Claims

5:00 *Adjourn*

## Second Day 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 will 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:** *Rajiv P. Patel*

11:00 *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:** *David E. Wildman, Samuel S. Woodley*

**SF:** *John F. Griffith*

12:15 *Lunch*

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

1:45

### Clinic II

NYC: You will get 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.

SF: You will get 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:**

*Pamela C. Ancona, Michael A. Davitz, Michael J. Doyle, Hua (Helene) Gao, Adda C. Gogoris, Nada Jain, Jay P. Lessler, Len S. Smith, Carmella L. Stepbens*

**SF Clinic Instructors:**

*Brandon Baum, Jennifer R. Bush, Wendy A. Choi, Dennis S. Corgill, Mary A. Fuller, John F. Griffith, Loren H. McRoss, Michael A. Molano, Vera A. Nackovic, Scott D. Sanford, Marc A. Sockol, Brian N. Young*

4:30

### Review of Model Amendment

5:00 *Adjourn*

## Third Day 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, Leonardo Renna, Louis S. Sorell*

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

11:15 *Break*

11:30

### Litigation Issues, Continued

12:30 *Lunch*

*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:**

*Sharon E. Hayner, Leslie Morioka, Paul J. Otterstedt, Leonardo Renna, Robert D. Schaffer, David M. Shofi, Louis S. Sorell*

**SF Clinic Instructors:**

*Brandon Baum, Jennifer R. Bush, Dennis S. Corgill, Wendy A. Choi, Mary A. Fuller, John F. Griffith, Loren H. McRoss, Michael A. Molano, Vera A. Nackovic, Scott D. Sanford, Marc A. Sockol, Brian N. Young*

3:15 *Break*

3:30

### Clinic III, Continued

5:00 *Adjourn*

## Other Relevant Products From PLI

### COURSE HANDBOOK

**Fundamentals of Patent Prosecution 2007: A Boot Camp for Claim Drafting & Amendment Writing**, \$179. *The Course Handbook will be available on the first day of the program.*

### TREATISES

**Landis on Mechanics of Patent Claim Drafting** Fifth Edition

**Robert C. Faber** (*Ostrolenk, Faber, Gerb & Soffen, LLP, New York City*)

*"This work must be included in the library of anyone who considers himself or herself an attorney [in the field]."*

**The Licensing Journal**

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*1 looseleaf volume, 970 pages, \$325 (Revised annually/as necessary:*

*No charge for revision within 3 months of purchase)*

**How to Write a Patent Application**

**Jeffrey G. Sheldon** (*Sbeldon & Mak, Pasadena, CA*)

Called "one of the most thorough treatments of the subject" by *The Licensing Journal*, this indispensable guide covers all the legal requirements, formal documents, and drafting and drawing techniques that are essential to developing airtight patent applications.

Packed with checklists and sample documents, language, and drawings, **How to Write a Patent Application** shows you how to obtain complete information from an inventor to prepare an effective patent application and how to avoid such claiming errors as inconsistent terminology, wrong alternative language, and deficient functional language.

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Darby & Darby P.C.  
New York City



**John A. O'Brien**  
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New York City



**Louis S. Sorell**  
Goodwin Procter LLP  
New York City

**Jeanne C. Curtis**  
Ropes & Gray LLP  
New York City

**Marta E. Delsignore, Ph.D.**  
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**William S. Frommer**  
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Frommer Lawrence & Haug LLP  
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**Leonardo Renna**  
Vice President & Senior Counsel  
MasterCard Worldwide  
Purchase, New York

**Len S. Smith**  
Senior Patent Counsel  
Novo Nordisk Inc.  
Princeton, New Jersey

**David E. Wildman, Ph.D.**  
Senior Counsel, Patent Law Department  
Hoffmann-La Roche Inc.  
Nutley, New Jersey

**Samuel S. Woodley, Ph.D.**  
Darby & Darby P.C.  
New York City

## New York Clinic Instructors

**N.B.** The New York Clinic Instructor team changes each day of the program.

**Pamela C. Ancona, Ph.D.**  
Crowell & Moring, LLP  
New York City

**Michael A. Davitz, Ph.D.**  
Vice President - Intellectual Property  
Taro Pharmaceuticals, U.S.A., Inc.  
Hawthorne, New York

**Michael J. Doyle**  
Calhelha and Doyle, LLC  
Cornwall, New York

**Hua (Helene) Gao**  
Dickstein Shapiro 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

**Jay P. Lessler**  
Darby & Darby P.C.  
New York City

**Steven F. Meyer**  
Morgan & Finnegan, LLP  
New York City

**Douglas A. Miro**  
Ostrolenk, Faber, Gerb & Soffen, LLP  
New York City

**Leslie Morioka**  
White & Case LLP  
New York City

**Eustus Dwayne Nelson**  
Staff Attorney, Intellectual Property Law  
IBM Corporation - IBM TJ Watson  
Research Center  
Yorktown Heights, New York

**Paul J. Otterstedt**  
Ryan, Mason & Lewis, LLP  
Fairfield, Connecticut

**Thomas F. Presson**  
Frommer Lawrence & Haug LLP  
New York City

**Robert D. Schaffer**  
Pearl Cohen Zedek Latzer LLP  
New York City

**David M. Shofi**  
IP Counsel  
ATMI, Inc.  
Danbury, Connecticut

**Carmella L. Stephens, Ph.D.**  
Kenyon & Kenyon LLP  
New York City

**Richard Straussman**  
Morgan & Finnegan, LLP  
New York City

**Nanette S. Thomas**  
Senior Intellectual Property Counsel  
Becton, Dickinson and Company  
Franklin Lakes, New Jersey

**Carl B. Wischhusen**  
Fitzpatrick, Cella, Harper & Scinto  
New York City

**Lock See Yu-Jahnes, Ph.D.**  
Fitzpatrick, Cella, Harper & Scinto  
New York City

## San Francisco

Chair:



**Michael A. Molano**  
Mayer, Brown, Rowe & Maw LLP  
Palo Alto

**Brandon Baum**  
Mayer, Brown, Rowe & Maw LLP  
Palo Alto

**Wendy A. Choi**  
Woodcock Washburn LLP  
Atlanta

**Mary A. Fuller**  
Marvell Semiconductor, Inc.  
Santa Clara

**John F. Griffith**  
Beyer Weaver LLP  
Oakland, California

**Rajiv P. Patel**  
Fenwick & West LLP  
Mountain View, California

**Marc A. Sockol**  
Thelen Reid Brown Raysman & Steiner LLP  
Palo Alto

## San Francisco Clinic Instructors

**N.B.** The San Francisco Clinic Instructor team remains the same for the entire 3-day program.

**Jennifer R. Bush**  
Fenwick & West LLP  
Mountain View, California

**Dennis S. Corgill**  
Mayer, Brown, Rowe & Maw LLP  
Palo Alto

**Loren H. McRoss**  
Corporate Counsel, Intellectual Property  
Phoenix Technologies Ltd.  
Milpitas, California

**Vera A. Nackovic**  
Mayer, Brown, Rowe & Maw LLP  
Chicago

**Scott D. Sanford**  
O'Melveny & Myers LLP  
San Francisco

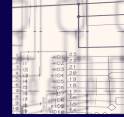
**Brian N. Young**  
Trellis Intellectual Property Law Group, PC  
Palo Alto

**Program Attorney: John M. Mola**

# Fundamentals of Patent Prosecution 2007

## A Boot Camp for Claim Drafting & Amendment Writing

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**New York City, June 20-22, 2007** **San Francisco, July 11-13, 2007**

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

**San Francisco Hotel Accommodations:** The Palace Hotel, 2 New Montgomery Street, San Francisco, California 94105. Call (800) 917-7456 seven days a week from 6:00 am to 12:00 am (PDT) 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](http://www.SFPALACE.com) and enter SET No. 287179 to receive the preferred rate.

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- 11260 Course Handbook only, \$179
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