

Satisfy Your CLE Requirements!

Advanced Patent Prosecution Workshop 2013: Claim Drafting & Amendment Writing

New York City, July 18-19, 2013 San Francisco, August 19-20, 2013

- A unique opportunity to receive hands-on drafting experience under the guidance of experienced patent prosecutors
- Work in small groups focusing on your discipline
- Receive individualized feedback on your claim drafting and amendment writing skills
- Learn practical techniques for avoiding prosecution pitfalls
- Learn the latest developments in patent law, including patent prosecution and the impact of the America Invents Act

Advanced Patent Prosecution Workshop 2013: Claim Drafting & Amendment Writing

New York City, July 18-19, 2013 San Francisco, August 19-20, 2013

Why You Should Attend

In this advanced two-day program, you will have a unique opportunity to receive hands-on drafting experience under the guidance of experienced patent prosecutors. By working in small technologically-distinct groups, you will receive individualized feedback on claim drafting and amendment writing skills, as well as learn practical techniques for avoiding prosecution pitfalls. Guidance will be provided on the America Invents Act and its implementation by the Patent and Trademark Office, including the new post-grant review and *inter partes* review systems. Course material will include sample problems and model solutions.

Structure of the Programs

The New York City Workshop is organized into four technology sections: Biotechnology, Chemical/Pharmaceutical, Electromechanical and Electronics/Computers. The San Francisco Workshop is organized into three technology sections: Electromechanical/Mechanical, Electronics/Computers, and Life Sciences (Biotechnology, Chemical/Pharmaceutical). Enrollment in these sections is limited, and two or three senior patent attorneys will lead each section. Homework review and realistic claim drafting and amendment writing exercises are also a special feature of these workshops. 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.

Important! Early registration is advisable as enrollment is limited.

Who Should Attend

This program is designed for private or corporate practitioners with patent experience who wish to improve their general claim drafting and amendment writing skills. Registrants will have the opportunity to concentrate for two days on the specialized skills required in their technological area.

PLI's Nationally Acclaimed Course Handbooks

The Course Handbook for this program is now available online to all attendees!

If you would like to review the material or prepare questions for faculty ahead of time, login to www.pli.edu and go to My Online Library and click on the Course Materials tab. You will find the Course Handbook there several days prior to the program. You will have access to the Course Handbook for one year from the program date. *Please note: If you should cancel or not be able to attend the program for any reason, the online version of the Course Handbook will no longer be available to you.*

All attendees at the live program 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.

FACULTY

New York City

Co-Chairs:



Jay P. Lessler Blank Rome LLP New York City

Mitchell Bernstein, Ph.D. Fish & Richardson P.C. New York City

Michael A. Davitz, M.D. Fahmi, Sellers, Embert & Davitz LLP San Jose, California

J. Robert Dean, Jr. Ohlandt, Greeley, Ruggiero & Perle, L.L.P. Stamford, Connecticut

Gerard F. Diebner Tannenbaum Helpern Syracuse & Hirschtritt LLP New York City



Michael P. Dunnam

Philadelphia

Robert C. Faber

New York Citv

Ostrolenk Faber LLP

Deborah L. Lu, Ph.D.

Ann M. McCrackin

Woessner, P.A. Minneapolis

Schwegman Lundberg &

Vedder Price P.C.

New York Citv

Woodcock Washburn LLP

Author, Faber on Mechanics of

Patent Claim Drafting (PLI)

Kenneth N. Nigon RatnerPrestia Berwyn, Pennsylvania

> **Rebecca Goldman Rudich** Vedder Price P.C. Washington, D.C.

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

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

John C. Todaro Managing Counsel, Intellectual Property Group Merck & Co., Inc. Rahway, New Jersey

San Francisco

Chair:



Rajiv P. Patel

Fenwick & West LLP Mountain View, California

Kavita Aggarwal

Law Offices of Kavita Aggarwal; Fractional Patent Counsel, Kachyng and NRI Technologies Mountain View, California

Daniel R. Brownstone Fenwick & West LLP San Francisco

Rimma Budnitskaya Former Senior IP Counsel at NetApp Burlingame, California

Sanjeet K. Dutta King & Spalding LLP Redwood Shores, California

Pauline Farmer-Koppenol Fenwick & West LLP San Francisco

Brian M. Hoffman

Fenwick & West LLP San Francisco

Robert Hulse Fenwick & West LLP Mountain View, California

Tina E. Hulse, M.D. Finnegan, Henderson, Farabow, Garrett & Dunner, LLP Palo Alto

Burt Magen Vierra Magen Marcus LLP San Francisco

Jeffrey A. Miller

Dickstein Shapiro LLP Palo Alto

Danielle Pasqualone, Ph.D.

Assistant General Counsel Genentech, Inc. South San Francisco, California

Rebecca Scarr, Ph.D. Casimir Jones, S.C. Middleton, Wisconsin

Yuko Soneoka, Ph.D. Director of IP Genomic Health, Inc. Redwood City, California

Christopher M. Tobin Rader, Fishman & Grauer PLLC Washington, D.C.

PROGRAM SCHEDULE

New York City

Day One: 9:00 a.m. - 4:30 p.m.

Morning Session: 9:00 a.m. – 12:30 p.m. (Homework due at 9:00 a.m.) 9:00

Program Overview

Jay P. Lessler

9:15

Ethics in the PTO

The USPTO imposes a duty of candor and good faith on the applicant and the patent attorney, including an obligation of full disclosure of information material to patentability. The current version of USPTO Rule 56, which was revised in view of *Therasense v. Becton Dickinson*, will be discussed. In addition, an examiner can request information about the development of the invention and prior activities of the inventor and others related to the invention. These areas of inquiry will be discussed. In apparent conflict, the privileges in litigation in court protect against disclosure of attorney-client communications, which are likely to relate to the activities and information that an applicant and the patent attorney must disclose to the USPTO. Resolution of this apparent conflict between the rules and requirements of the USPTO and the courts will be discussed.

Robert C. Faber

Registrants will break out into four separate groups: Biotechnology, Chemical/Pharmaceutical, Electromechanical, and Electronics/Computers. Registrants must select one technology for both days. For more details about the workshops, please check the PLI website at www.pli.edu

10:15 Networking Break

10:30

Concurrent Sessions I

Advanced Specification Drafting Issues

Concurrent lectures specific to each technology will cover advanced issues in drafting of patent specifications. Areas will include the written description, enablement and best mode requirements of 35 USC §112, as well as practical tips for ensuring the specification is truly a primary source of claim interpretation.

Biotechnology – Techniques for preparing a specification that will meet the utility, written description and enablement requirements, as well as obviousness issues raised by *KSR*, *Ex parte Kubin*, and the PTO obviousness guidelines, will be discussed. Requirements for submission of sequence listings and biological deposits, and tips for avoiding inequitable conduct issues and overly limited definitions and disclaimers will also be discussed.

Carmella L. Stephens

Chemical/Pharmaceutical – Techniques for drafting effective specifications directed to new compounds, solid state forms of compounds, pharmaceutical formulations including those having particular pharmacokinetic properties, and methods of treatment, in addition to the case law of written description and enablement, will be discussed. Tips will be provided to avoid inequitable conduct issues. *John C. Todaro*

Electromechanical – Discussions will include post-KSR decisions (*Wyers, Schwemberger, Tokai Corp.*) and the characterization of the problem to be solved in the specification; the seminal Federal Circuit cases (*Gentry Gallery, Scimed, Tronzo*) and the recent Federal Circuit cases concerning interpretations of specifications that limit the scope of the invention (*Arlington Industries, Retractable Technologies, Laryngeal Mask Co.*); and the impact on the written description and enablement requirements when limitations are imported from the specification (*Lizardtech, Atlantic Research, Crown Packaging*). Tips will be provided to draft specifications that support broad claims and to avoid unwanted limitations.

Rebecca Goldman Rudich

Electronics/Computers – Discussions will include techniques for preparing patent applications for electronic and computer inventions in view of the America Invents Act and the Guidelines for Determining Compliance With 35 U.S.C. §112, as well as several recent cases from the Supreme Court, Federal Circuit and the BPAI, including *KSR*, *Bilski, Ariad* and *Therasense*. The presentation provides practical guidelines for drafting patent specifications to support broad claims, to avoid creating specification disclaimer and to avoid Best Mode problems.

Kenneth N. Nigon

11:30

Concurrent Sessions II

Advanced Claim Drafting Issues

The presentation will include a review of advanced claim drafting issues specific to each technology discipline. The focus will be on language and techniques to avoid, as well as tips for improvement. The discussion will also include recent CAFC law applicable to each technology.

Biotechnology – Methods for maximizing patent protection through claims to screening methods, methods of treatment, and methods of preparation, as well as to nucleic acids (DNA and RNA), proteins, antibodies, nucleic acid vectors, and transgenic organisms, while satisfying the written description and enablement requirements, will be discussed. *Mitchell Bernstein*

Chemical/Pharmaceutical – Techniques for drafting chemical compound, composition, method of preparation, and method of treatment claims for maximum protection while avoiding the prior art will be discussed, including the use of functional claim language, the law regarding intended use recitations in the preamble, and compliance with the written description and enablement requirements.

Michael A. Davitz

Electromechanical – The author of PLI's Faber on Mechanics of Patent Claim Drafting will discuss the requirements of the USPTO and precedents of the Federal Circuit as applied to the mechanical and electrical arts, and will include observations as to what experienced practitioners have learned and put into practice to write what may be viewed as good claim form.

Robert C. Faber

1:45

Electronics/Computers – Advanced rules of claim drafting are discussed, including electronic circuit and hardware claims, claims for an interface, software claims, computer-readable medium claims, data structured claims, API and protocol claims, and method of doing business claims. Ann M. McCrackin

12:30 Lunch Break

Afternoon Session: 1:45 p.m. - 4:30 p.m.

Concurrent Workshops I

Advanced Claim Drafting

The separate technology groups will participate in claim drafting workshops. Included will be individual review of students' homework and additional claim drafting problems. It will be a unique opportunity for questions to be answered individually or in group discussions, and for students to receive individualized feedback.

Biotechnology: Mitchell Bernstein, Gerard F. Diebner,

Carmella L. Stephens

Chemical/Pharmaceutical: J. Robert Dean, Jr., Deborah L. Lu, John C. Todaro

Electromechanical: Robert C. Faber, Rebecca Goldman Rudich, Robert D. Schaffer

Electronics/Computers: Michael P. Dunnam, Ann M. McCrackin, Kenneth N. Nigon

3:15 Networking Break

3:30

Concurrent Workshops I (continued)

4:30 Adjourn

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

New York City

Day Two: 9:00 a.m. - 4:30 p.m.

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

9.00

How the AIA, Supporting Rules and New Fees Affect Patent Prosecution

First-inventor-to-file will coexist with first to invent for several years. The prior art available and the applicability of rules under these two regimes are significantly different. The USPTO has provided new procedures such as supplemental examination and preissuance submissance to improve patent quality. In addition, the fees have been set to discourage multiple RCE filings and Appeals. These changes will be discussed along with practice strategies to help you achieve a favorable outcome.

Kenneth N. Nigon

9.45

Post-Grant Proceedings in the PTO

An overview of the new post-grant review, inter partes review, and supplemental examination proceedings provided by the America Invents Act, including the PTO's implementation of them, will be provided. The discussion will include strategies for how patentees can use these procedures to strengthen their patents, and for how patent challengers can most effectively use the lower standard of proof required to invalidate patents before the PTO.

Gerard F. Diebner

Registrants will break out into four separate groups: Biotechnology, Chemical/Pharmaceutical, Electromechanical, and Electronics /Computers. Registrants must select one technology for both days. For more details about the workshops, please check the PLI website at www.pli.edu

10:15 Networking Break

10:30

Concurrent Sessions III

Advanced Patent Prosecution Issues

Concurrent lectures specific to each technology will cover advanced issues, including post-Festo decisions and strategies for avoiding prosecution history estoppel, affidavits under rules 131 and 132, compliance with the duty of disclosure, performing Examiner interviews, requesting pre-appeal conferences, and accelerated examination. Biotechnology - The discussion will cover techniques for addressing obviousness rejections in view of Ex parte Kubin, KSR, and the PTO obviousness guidelines, responding to restriction requirements and written description and enablement rejections, minimizing prosecution history estoppel when submitting arguments and amendments, proper drafting of affidavits, how and when to perform interviews, and complying with the duty of disclosure requirement.

Gerard F. Diebner

Chemical/Pharmaceutical - The discussion will cover strategies for traversing restriction requirements, minimizing prosecution history estoppel, responding to obviousness rejections in view of KSR and the new PTO guidelines, proper drafting of affidavits, how and when to perform interviews, complying with the duty of disclosure, and accelerated examination.

Deborah L. Lu

Electromechanical - The discussion will cover the use of means-plusfunction claims, how to decide whether to amend or not amend claims, and how to structure patentability arguments to gain allowance without undue estoppels.

Rebecca Goldman Rudich, Robert D. Schaffer

Electronics/Computers - The discussion will address techniques for challenging and defending patent applications under the America Invents Act, accelerating examination, minimizing or avoiding prosecution history estoppel, maximizing results of examiner interviews, minimizing prosecution delays, overcoming obviousness (Section 103) rejections and subject matter (Subject 101) rejections, determining when to appeal, and preparing applications for appeal. Michael P. Dunnam

11:30

Concurrent Workshops II

Advanced Amendment Drafting

The separate technology groups will draft amendments and apply substantive patent law to practical patent prosecution problems under personal faculty guidance. Faculty will review and critique each individual student's amendments from the homework assignment sample amendment drafting problems in each technology discipline will also be assigned and discussed.

Biotechnology: Mitchell Bernstein, Gerard F. Diebner, Carmella L. Stephens

Chemical/Pharmaceutical: J. Robert Dean, Jr., Deborah L. Lu, John C. Todaro

Electromechanical: Rebecca Goldman Rudich, Robert D. Schaffer Electronics/Computers: Michael P. Dunnam, Ann M. McCrackin, Kenneth N. Nigon

12:30 Lunch Break

Afternoon Session: 1:45 p.m. - 4:30 p.m.

1.45

Concurrent Workshops II (continued)

3:15 Networking Break

3:30

Roundtable Discussions and Wrap-Up

The faculty will discuss USPTO trends across all technology areas, such as allowance rates, pendency, length of time to first office action, etc., and will provide tips and recommend strategies for effectively prosecuting applications in view of these trends. Moderator: Ann M. McCrackin

4:30 Adjourn

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San Francisco

Day One: 9:00 a.m. – 4:30 p.m.

Morning Session: 9:00 a.m. – 12:30 p.m. (Homework due at 9:00 a.m.) 9:00

General Introduction

Rajiv P. Patel

9:15

Ethics for Patent Prosecutors

The various ethical requirements imposed by the Code of Federal Regulations, Manual of Patent Examining Procedure (MPEP), and general rules of professional conduct will be reviewed as they relate to Patent Prosecution Practice.

Burt Magen

10:00

The New 35 USC §102

The America Invents Act (AIA) changed the U.S. patent system from a First-to-Invent (FTI) system to a new First-Inventor-to-File (FITF) system. This section will review the new 35 U.S.C. §102 section of the Patent Statute and provide a practical review and analysis of it as well as tips for applying this new law.

Kavita Aggarwal

10:45 Networking Break

Registrants will break out into three separate groups: Electromechanical/ Mechanical, Electronics/Computers and Life Sciences (Biotechnology, Chemical/Pharmaceutical). Registrants must select one technology for both days. For more details about the workshops, please check the PLI website at www.pli.edu

11:00

Advanced Claim Drafting Issues

A review of advanced drafting issues will be presented. The focus will be on language and techniques to avoid, as well as tips for improvement. Electromechanical/Mechanical, Electronics/Computers: Burt Magen

Life Sciences (Biotechnology, Chemical/Pharmaceutical): Tina E. Hulse, Danielle Pasqualone, Rebecca Scarr, Yuko Soneoka

11:45

Patentable Subject Matter

The discussion will highlight recent cases, including recent decisions on patentable subject matter under 35 U.S.C. §101, such as *Research Corp. v. Microsoft, Cybersource v. Retail Decisions, Ultramercial v. Hulu, The Association for Molecular Pathology v. Myriad Genetics, Prometheus v. Mayo,* as well as recent rules from the U.S. Patent Trademark Office. **Electromechanical/Mechanical, Electronics/Computers:** *Burt Magen*

Life Sciences (Biotechnology, Chemical/Pharmaceutical): Tina E. Hulse, Danielle Pasqualone, Rebecca Scarr, Yuko Soneoka

12:30 Lunch Break

Afternoon Session: 2:00 p.m. – 4:30 p.m. 2:00

2.00

Claim Drafting Workshops

Separate groups in Electromechanical/Mechanical, Electronics/ Computers and Life Sciences (Biotechnology, Chemical/Pharmaceutical) will participate in claim drafting workshops. These workshops will include: individual review of students' homework; in-depth discussion of claim drafting techniques; and application of substantive patent law to claim drafting problems. Additional claim drafting problems in each technology discipline will be assigned and thoroughly discussed in small groups. Electromechanical/Mechanical: Pauline Farmer-Koppenol, Robert Hulse

Electronics/Computers: Daniel R. Brownstone, Rimma Budnitskaya, Sanjeet K. Dutta, Rajiv P. Patel, Christopher M. Tobin

Life Sciences (Biotechnology, Chemical/Pharmaceutical): Tina E. Hulse, Danielle Pasqualone, Rebecca Scarr, Yuko Soneoka

3:15 Networking Break

3:30

Claim Drafting Workshops (continued)

4:30 Adjourn

Day Two: 9:00 a.m. - 4:30 p.m.

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

Advanced Issues for Written Description

As Judge Newman has said, "There are few, if any, legal documents more difficult to craft, more fraught with pitfalls than patent applications[.]" Patent preparation requires significant strategic consideration, particularly in an environment where even one inartfully crafted paragraph in a specification may have negative implications on the scope of patent coverage. This presentation will discuss some notable Federal Circuit decisions pertinent to the specification and corresponding claim interpretation, and will offer practical tips for avoiding such pitfalls. The presentation will also include some tips for drafting in view of the first to disclose aspects of the America Invents Act (AIA). **Electromechanical/Mechanical, Electronics/Computers:**

Christopher M. Tobin

Life Sciences (Biotechnology, Chemical/Pharmaceutical): Tina E. Hulse, Danielle Pasqualone, Rebecca Scarr, Yuko Soneoka

9.4

Countering the Obviousness Rejection

After the KSR decision, examiners have had more flexibility in asserting obviousness rejections. This session reviews strategies for countering obviousness rejections with the goal of advancing prosecution past the asserted rejection.

Sanjeet K. Dutta

10:30 Networking Break

10:45

Post Final Practice

Post Final Practice reviews a Final Office Action received from the U.S. Patent and Trademark Office and covers options and strategy for responding to the Final Office Action. The session will include an overview of considerations for continuations practice and appeals to the Patent Trial and Appeals Board.

Brian M. Hoffman

11:30

Supplemental Examination and Derivation

Proceedings

This presentation highlights two new prosecution related mechanisms under the America Invents Act (AIA). Supplemental examination allows a patent owner to seek a low-level review of an issued patent to make sure that it was properly issued based upon some newly submitted information. Derivation proceedings are a new type of proceeding that is available to ensure the person obtaining a patent is a true inventor and did not derive the invention from another. This section provides an introduction to each proceeding and considerations for their use.

Jeffrey A. Miller

12:15 Lunch Break

Afternoon Session: 2:00 p.m. – 4:30 p.m. 2:00

Amendment Workshops

Separate groups in Electromechanical/Mechanical, Electronics/ Computers, Life Sciences (Biotechnology, Chemical/Pharmaceutical) will draft amendments and apply substantive patent law to practical patent prosecution problems under personal faculty guidance. Faculty will review and critique each individual student's amendments from the homework assignment; sample amendment drafting problems in each technology discipline will also be assigned and discussed. Electromechanical/Mechanical: Pauline Farmer-Koppenol, Robert Hulse

Electronics/Computers: Sanjeet K. Dutta, Jeffrey A. Miller, Rajiv P. Patel, Christopher M. Tobin

Life Sciences (Biotechnology, Chemical/Pharmaceutical): Tina E. Hulse, Danielle Pasqualone, Rebecca Scarr, Yuko Soneoka

3:15 Networking Break

3:30

Amendment Workshops (continued)

4:30 Adjourn

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REGISTRATION/HOTEL INFORMATION

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WEB:

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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.

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 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, New York 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.warwickhotelny.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

Sheraton New York Times Square Hotel, 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.

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

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New York State CLE Credit: In accordance with the requirements of the New York State Continuing Legal Education Board, these non-transitional continuing legal education programs are NOT approved for the newly admitted attorney within the first two years of admission to the Bar. Advanced Patent Prosecution Workshop 2013: Claim Drafting & Amendment Writing (New York) has been approved for experienced attorneys for a maximum of 13.5 credit hours, of which 1.0 credit hour can be applied toward the ethics requirement, and 12.5 credit hours can be applied toward the professional practice requirement. Advanced Patent Prosecution Workshop 2013: Claim Drafting & Amendment Writing (San Francisco) has

been approved for experienced attorneys for a maximum of 12.5 credit hours, of which 0.5 credit hour can be applied toward the ethics requirement, and 12.0 credit hours can be applied toward the professional practice requirement.

California MCLE Credit: PLI is a State Bar of California approved MCLE provider. Advanced Patent Prosecution Workshop 2013: Claim Drafting & Amendment Writing (New York) has been approved for MCLE credit in the amount of 11.25 hours, of which 1.0 hour will apply to legal ethics. Advanced Patent Prosecution Workshop 2013: Claim Drafting & Amendment Writing (San Francisco) has been approved for MCLE credit in the amount of 10.5 hours, of which 0.76 hour will apply to legal ethics. PLI will retain the required MCLE records for this program. California Paralegals: You can satisfy your new continuing legal education

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Advanced Patent Prosecution Workshop 2013

New York City, July 18-19, 2013 San Francisco, August 19-20, 2013

REGISTRATION/ORDER FORM YES, please register me for the following session:

When Registering, Please Refer to Priority Code: LFD3 Make necessary corrections on mailing address.

Advanced Patent Prosecution Workshop 2013

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