Advanced Patent Prosecution Workshop 2014: Claim Drafting & Amendment Writing

• **New!** Evaluate the latest developments in patent law, including patent prosecution and the impact of the America Invents Act and implementation of the Patent Law Treaty
• Compose claims and amendments under the guidance of experienced patent prosecutors
• Practice in small groups focusing on your discipline
• Receive individualized feedback on your claim drafting and amendment writing skills
• Assess practical techniques for avoiding prosecution pitfalls

New York City, July 17-18, 2014
San Francisco, August 18-19, 2014
Chicago, September 11-12, 2014

Register Today at www.pli.edu/TGH4 or Call (800) 260-4PLI
Advanced Patent Prosecution Workshop 2014: Claim Drafting & Amendment Writing

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 and Chicago Workshops are 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.

Register Today at www.pli.edu/TGH4 or Call (800) 260-4PLI
Advanced Specification Drafting Issues

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 which 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 descriptions will also be discussed.

NYC: Adda C. Gogoris

CHI: Adam G. Kelly, Kevin E. Noonan, John Petravich, Nabeela Rasheed, Sharon M. Sintich, Donald L. Zuhn, Jr.

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.

NYC: Michael A. Davitz, M.D.

CHI: Bradley W. Crawford, Suresh B. Pillai, Prof. David L. Schwartz, Christopher P. Singer, George Wheeler

Electromechanical – The author of PLI’s Freeman 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.

NYC: Robert C. Faber

CHI: Bradley J. Hubert, Amanda Lowerre O’Donnell, Thomas E. Wettermann

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.

NYC: Ann M. McCrackin

CHI: Joseph A. Herndon, Robert J. Irvine

12:30 Lunch

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

1:45 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 in or group discussions, and for students to receive individualized feedback.

NYC: Biotechnology: Mitchell Bernstein, Gerard F. Diebner, Adda C. Gogoris

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

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

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

Day One: 9:00 a.m. – 4:30 p.m.

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

(Homework due at 8:00 a.m.)

9:00 Program Overview

NYC: Jay P. Lester

CHI: Donald L. Zuhn, Jr.

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 and the determination of inequitable conduct according to 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.

NYC: Robert C. Faber

CHI: Prof. David L. Schwartz

10:15 Networking Break

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.

10:30 Concurrent Sessions I

Advanced Claim 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 – Discussion 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 (Denty Gallery, Scerned, Trovax) and the recent Federal Circuit cases concerning interpretations of specifications that limit the scope of the invention, with several cases concerning the Supreme Court, Federal Circuit and the BPAI, including KSR, Bilski, CLS, Aviad and Therasense. The presentation provides practical guidelines for drafting patent specifications to support broad claims, to avoid creating specification disclaimers and to avoid Best Mode problems.

NYC: Kenneth N. Nigon

CHI: Joseph A. Herndon, Robert J. Irvine

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 subject matter eligibility, written description and enablement requirements, will be discussed.

NYC: Mitchell Bernstein

CHI: Adam G. Kelly, Kevin E. Noonan, John Petravich, Nabeela Rasheed, Sharon M. Sintich, Donald L. Zuhn, Jr.

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.

NYC: Michael A. Davitz, M.D.

CHI: Bradley W. Crawford, Suresh B. Pillai, Prof. David L. Schwartz, Christopher P. Singer, George Wheeler

Electromechanical – The author of PLI’s Freeman 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.

NYC: Robert C. Faber

CHI: Bradley J. Hubert, Amanda Lowerre O’Donnell, Thomas E. Wettermann

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.

NYC: Ann M. McCrackin

CHI: Joseph A. Herndon, Robert J. Irvine

12:30 Lunch

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

1:45 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 in or group discussions, and for students to receive individualized feedback.

NYC: Biotechnology: Mitchell Bernstein, Gerard F. Diebner, Adda C. Gogoris

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

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

Electronics/Computers: Michael P. Dunnann, Ann M. McCrackin, Kenneth N. Nigon
Day Two: 9:00 a.m. – 4:30 p.m.

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

9:00 How to Work with Patent Examiners Toward Allowance

This presentation will focus on understanding the environment in which patent examiners work and best practices for productively engaging with them to advance prosecution. The material covered will include an overview of the count system used to assess patent examiner performance, as well as advanced interview strategies. The presentation will also describe various PTO initiatives to facilitate productive communication with the PTO, including the Ombudsman program and the After Final Consideration Pilot Program 2.0.

NYC: Michael P. Dunnam
CHI: Adam G. Kelly


The new novelty and obviousness statutes created by the America Invents Act and the PTO’s guidelines for their implementation will be discussed. The presentation will provide an easy-to-understand framework as to what constitutes prior art (such as public uses, sales, or “otherwise available to the public”), and the exceptions to prior art (such as the one year grace period), and commonly owned inventions created under a joint research agreement. The presentation will also address the new rules implementing the Patent Law Treaty.

NYC: Kenneth N. Nigon
CHI: Kevin E. Noonan, Donald L. Zuhn, Jr.

10:15 Networking Break

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.

10:30 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, adequacy of disclosure, and understanding the environment in which patent examiners work and best practices for productively engaging with them to advance prosecution. The material covered will include an overview of the count system used to assess patent examiner performance, as well as advanced interview strategies. The presentation will also describe various PTO initiatives to facilitate productive communication with the PTO, including the Ombudsman program and the After Final Consideration Pilot Program 2.0.

Biotechnology – The discussion will cover the use of enabling features in claims, as well as the exceptions to prior art (such as public uses, sales, or “otherwise available to the public”). The exceptions to prior art (such as the one year grace period), and commonly owned inventions created under a joint research agreement. The presentation will also address the new rules implementing the Patent Law Treaty.

NYC: Donald L. Zuhn, Jr.
CHI: Moderator: Donald L. Zuhn, Jr.

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.

NYC: Deborah L. Lu
CHI: Bradley W. Crawford, Suresh B. Pillai, Prof. David L. Schwartz, Christopher P. Singer, George Wheeler

Electromechanical – The discussion will cover the use of means-plus-function claims, how to decide whether to amend for traversing restriction requirements, minimizing 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.

NYC: Michael P. Dunnham
CHI: Joseph A. Herndon, Robert J. Irvine

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.

NYC: Addison C. Gogoris
Chemical/Pharmaceutical: J. Robert Dean, Jr., Dianna G. El Houm, Deborah L. Lu, John C. Todaro
Electromechanical: Rebecca Goldman Rudich, Robert D. Schaffer
Electronics/Computers: Michael P. Dunnam, Ann M. McCrackin, Kenneth N. Nigon

CHI: Biotechnology: Adam G. Kelly, Kevin E. Noonan, John Petravich, Nabeela Rasheed, Sharon M. Sintich, Donald L. Zuhn, Jr.

12:30 Lunch

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.

NYC: Moderator: Ann M. McCrackin
CHI: Moderator: Donald L. Zuhn, Jr.

4:30 Adjourn
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.
Rene DuBord Brown
10:45
Networking Break
Registants 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 FBI website at www.fbi.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:
Life Sciences (Biotechnology, Chemical/Pharmaceutical):
Danielle Pasqualone, Rebecca Scarr
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 Decisons, 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:
Rajiv P. Patel
Life Sciences (Biotechnology, Chemical/Pharmaceutical):
Yuko Soneoka
12:30 Lunch
Afternoon Session: 2:00 p.m. – 4:30 p.m.

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:
Daniel R. Brownstone, Pauline Farmer-Koppenol
Electronics/Computers:
Rajiv P. Patel, Christopher M. Tobin
Life Sciences (Biotechnology, Chemical/Pharmaceutical):
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. – 4:00 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:
Life Sciences (Biotechnology, Chemical/Pharmaceutical):
Danielle Pasqualone, Rebecca Scarr
9:45
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.
Sanjeeet 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
Afternoon Session: 1:30 p.m. – 4:00 p.m.

1:30
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:
Sanjeeet K. Dutta, Jeffrey A. Miller, Rajiv P. Patel, Christopher M. Tobin
Life Sciences (Biotechnology, Chemical/Pharmaceutical):
Danielle Pasqualone, Rebecca Scarr, Yuko Soneoka
2:45 Networking Break
3:00
Amendment Workshops (continued)
4:00 Adjourn
FACULTY

New York City

Co-Chairs:

Mitchell Bernstein, Ph.D.
Assistant Chief Counsel,
Global Intellectual Property
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Florham Park, New Jersey
Michael A. Davitz, M.D.
Ascenda Law Group, PC
New York City
J. Robert Dean, Jr.
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Jay P. Lessler
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Kenneth N. Nigon
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Gerard F. Diebner
Tannenbaum Helfpurn Syracuse & Hirschtitt LLP
New York City
Michael P. Dunnam
BakerHostetler
Philadelphia
Dianna G. El Hioum
Merchant & Gould PC
New York City
Robert C. Faber
Ostrolen Faber LLP
New York City
Author, Faber on Mechanics of Patent Claim Drafting (PLI)

Adda C. Gogoris
Merchant & Gould PC
New York City
Deborah L. Lu, Ph.D.
Vedder Price PC
New York City
Ann M. McCrackin
Schweigman Lundberg & Woessner, PA.
Minneapolis
Rebecca Goldman Rudich
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Robert D. Schaffer
Law Office of Robert D. Schaffer
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John C. Todaro
Managing Counsel,
Intellectual Property Group
Merck & Co., Inc.
Rahway, New Jersey

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Mountain View, California

Pauline Farmer-Koppenol
Fenwick & West LLP
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Brian M. Hoffman
Fenwick & West LLP
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Danielle Pasquale, Ph.D.
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South San Francisco, California

Rebecca Scarr, Ph.D.
Casmir Jones, S.C.
Middleton, Wisconsin
Yuko Soneoka, Ph.D.
Chief Patent Counsel
Marrone Bio Innovations
Davis, California
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Vice President of
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Prof. David L. Schwartz
Associate Professor of Law
Chicago-Kent College of Law
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Christopher P. Singer, Ph.D.
McAndrews, Held & Malloy, Ltd.
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Sharon M. Sintich, Ph.D.
Marshall, Gerstein & Borun LLP
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Thomas E. Wetttermann
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Program Attorney: John M. Mola
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Advanced Patent Prosecution Workshop 2014

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☐ 51826 New York City Seminar,* July 17-18, 2014, PLI New York Center, $1,795
☐ 51827 San Francisco Seminar,* August 18-19, 2014, PLI California Center, $1,795
☐ 55096 Chicago Seminar,* September 11-12, 2014, Intercontinental Chicago, $1,795

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☐ 51828 Course Handbook only, $220

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*Includes Course Handbook, in either bound volume or flash drive format for program attendees, and in digital format for Webcast participants. All attendees will have access to a downloadable version of the Handbook several days prior to the program.

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