Advanced Patent Prosecution Seminar 2015: Claim Drafting & Amendment Writing

• **New!** Evaluate the latest developments in patent law, including patent prosecution and the impact of the America Invents Act, the implementation of the Patent Law Treaty and the impact of recent Supreme Court and Federal Circuit decisions

• 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 16-17, 2015
San Francisco, August 10-11, 2015
Chicago, September 10-11, 2015

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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 implementation by the Patent and Trademark Office, including the new post-grant review and inter partes review, as well as covered business methods patents. The practice impact of recent Supreme Court and Federal Circuit decisions, e.g., Myriad, Alice, and KSR, will be explained. Course material will include sample problems and model solutions.

The New York City and Chicago Seminars are organized into four technology sections: Biotechnology, Chemical/Pharmaceutical, Electromechanical and Electronics/Computers. The San Francisco Seminar is organized into three technology sections: Electromechanical/Mechanical, Electronics/Computers, and Life Sciences (Biotechnology, Chemical/Pharmaceutical). 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 seminars. 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.

Who Should Attend

This program is designed for private or corporate and other in-house 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.
FACULTY

New York City

Co-Chairs:

Jay P. Lessler
Blank Rome LLP
New York City

Kenneth N. Nigon
Ratner Prestia
Berwyn, Pennsylvania

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

Michael P. Dunnam
Baker Hostetler LLP
Philadelphia

Dianna G. El Hioum
Merchant & Gould PC.
New York City

Robert C. Faber
Ostrolenek Faber LLP
New York City

Deborah L. Lu, Ph.D.
Vedder Price PC.
New York City

Robert D. Schaffer
Law Office of Robert D. Schaffer
New York City

Ann M. McCrackin
Schwegman Lundberg & Woessner, PA.
Minneapolis

Rebecca Goldman Rudich
Vedder Price PC.
Washington, D.C.

Robert D. Schaffer
Author, Faber on Mechanics of Patent Claim Drafting (PLI)

San Francisco

Chair:

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

Sanjeet K. Dutta
Steptoe & Johnson LLP
Palo Alto

Pauline Farmer-Koppenol
Associate General Counsel - Patents
Bio-Rad Laboratories, Inc.
Hercules, California

Gloria M. Gusler
Squire Patton Boggs (US) LLP
Palo Alto

Brian M. Hoffman
Fenwick & West LLP
San Francisco

Robert Hulse
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Roger C. Kuan
Business Unit Lead IP Counsel (Single Use Technologies and Biosciences Instrumentation), Life Sciences Solutions Thermofisher Scientific Inc.
Pleasanton, California

Burt Magen
Vierra Magen Marcus LLP
San Francisco

Jeffrey A. Miller
Kaye Scholer LLP
Palo Alto

Yuko Soneoka, Ph.D.
Senior Patent Counsel
Theranos, Inc.
Palo Alto

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

Chicago

Chair:

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McDonnell Boehnen Hulbert & Berghoff LLP
Chicago

Robert J. Irvine
Invention Mine LLC
Chicago

Adam G. Kelly
Loeb & Loeb LLP
Chicago

Kevin E. Noonan, Ph.D.
McDonnell Boehnen Hulbert & Berghoff LLP
Chicago

Amanda Loewerre O’Donnell
Fitch, Even, Tabin & Flannery LLP
Chicago

John Petravich
Deputy General Counsel & Vice President of Intellectual Property Integrated DNA Technologies, Inc.
Corvalis, Oregon

Suresh B. Pillai, Ph.D.
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Associate Professor of Law
Chicago-Kent College of Law
Chicago

Thomas E. Wettermann
McDonnell Boehnen Hulbert & Berghoff LLP
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George Wheeler
McAndrews, Held & Malloy, Ltd.
Chicago

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.
Chicago

Sharon M. Sintich, Ph.D.
Marshall, Gerstein & Borun LLP
Chicago

Daniel P. Williams
Invention Mine LLC
Chicago

Program Attorney: John M. Mola
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. 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. Resolution of this apparent conflict between the rules and requirements of the USPTO and the courts will be discussed. Ethical considerations in dealing with the PTAB will also 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.

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 U.S.C. § 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 Kubro, and the PTO obviousness guidelines, requirements for submission of sequence listings and biological deposits, and tips for avoiding inequitable conduct issues and overly limited definitions and disclaimers will be discussed.

NYC: Adda C. Gogoris  
CHI: John Petrovich  
Chemical/Pharmaceutical – Techniques for drafting specifications directed to new compounds, solid state forms of compounds, pharmaceutical formulations including those having particular pharmacokinetic properties, methods of treatment, case law of written description and enablement, and tips to avoid inequitable conduct issues will be discussed.

NYC: Dianna G. El Hium, John C. Todaro  
CHI: Brad W. Crawford  
Electromechanical – Discussions will include post-KSR decisions (Wyers, Schwenberger, Tokai Corp.) and the characterization of the problem to be solved in the specification; Federal Circuit cases (Gentry Gallery, Scaled, Tronzo) and the recent Federal Circuit cases concerning interpretations of specifications that limit the scope of the invention (Arlington Industries, Retractable Technologies, Lanyarg Mask Co.) and the impact on the written description and enablement requirements when limitations are imported from the specification (Lizardtech, Atlantic Research, Crown Packaging) and tips to draft specifications that support broad claims and to avoid unwanted limitations.

NYC: Rebecca Goldman Rudich  
CHI: Thomas E. Wetttermann  
Electronics/Computers – Discussions include techniques for preparing patent applications for electronic and computer inventions in view of the AIA and the Guidelines for Determining Compliance With 35 U.S.C. § 112; cases from the Supreme Court, Federal Circuit and the BPAI, including KSR, Bilski, CLS, Ariad and Therasense; and 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: Daniel P. Williams
Day Two: 9:00 a.m. – 4:30 p.m.

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

9:00

Patent Eligible Subject Matter After Myriad, Alice and the PTO Interim Guidance

This presentation will focus on understanding the limits of patent eligible subject matter following the U.S. Supreme Court decisions in Assoc. for Molecular Pathology v. Myriad Genetics, Inc. and Alice Corp. v. CLS Bank, Int’l. in view of the Interim Guidance issued by the USPTO on December 16, 2014. The speakers will provide guidance on what can and cannot be patented and provide tips for drafting applications to avoid rejections under 35 U.S.C. § 101 and responding to Office Actions including rejections under 35 U.S.C. § 101.

NYC: Michael P. Dunnam, Jay P. Lessler

CHI: Kevin E. Noonan, Donald L. Zuhn, Jr.

9:45 Lessons Learned from Two Years of Post-Grant Proceedings

Inter Partes Reviews (IPRs) and proceedings under the Transitional Program for Covered Business Method Patents (CBMs) have been in effect for over two years. Post-Grant Review (PGR) trials are just now being filed and processed by the PTAB. This presentation will cover the basics of each of these proceedings and provide guidance on pitfalls to avoid and how to both file a successful request and effectively defend against a request.

NYC: Gerard F. Diebner

CHI: Adam G. Kelly

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 seminars, 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; techniques for addressing obviousness rejections in view of Ex parte Kubin, KSR, and the PTO obviousness guidelines; affidavits under Rules 131 and 132; compliance with the duty of disclosure; performing Examiner interviews; requesting pre-appeal conferences; and accelerated examination.

Biotechnology

NYC: Gerard F. Diebner

CHI: Kevin E. Noonan, Donald L. Zuhn, Jr.

Chemical/Pharmaceutical

NYC: Deborah L. Lu

CHI: Christopher P. Singer

Electromechanical

NYC: Rebecca Goldman Rudich, Robert D. Schaffer

CHI: Amanda Lowerre O’Donnell

Electronics/Computers

NYC: Michael P. Dunnam

CHI: Joseph A. Herndon

11:30

Concurrent Seminars 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 student’s amendments from the homework assignment; sample amendment drafting problems in each technology discipline will also be assigned and discussed.

NYC:

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

Chemical/Pharmaceutical: J. Robert Dean, Jr., Dianne 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: Karen Imgrund Deak, Adam G. Kelly, Kevin E. Noonan, John Petravich, Sharon M. Sintich, Donald L. Zuhn, Jr.

Chemical/Pharmaceutical: Brad W. Crawford, Suresh B. Pillai, Prof. David L. Schwartz, Christopher P. Singer, George Wheeler

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

Electronics/Computers: Joseph A. Herndon, Robert J. Irvine, Daniel P. Williams

12:30 Lunch Break

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

1:45

Concurrent Seminars II (continued)

3:15 Networking Break

3:30 Roundtable Discussions and Wrap-Up

The faculty will discuss USPTO trends across all technology areas, including allowance rates, pendency, length of time to first office action, etc.; and also provide tips and recommend strategies for effectively prosecuting applications in view of these trends.

NYC: Moderator: Ann M. McCrackin, Gerard F. Diebner, Michael P. Dunnam, Jay P. Lessler, Kenneth N. Nigon, Robert D. Schaffer


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.

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Our Course Handbooks represent the definitive thinking of the nation’s finest legal minds, and are considered the standard reference in the field. The Handbook is prepared specifically for this program and stands alone as a permanent reference. The Course Handbook will be available online several days prior to the program! Log in to www.pli.edu, go to My Online Library and click on the Course Materials tab. You can review the material or prepare questions to raise at the program. You will have access to the Course Handbook for one year from the program date. All attendees at the live program and Groupcast locations will also receive a bound or flash drive copy.

New York City and Chicago
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.
Burt Magen
10:00
The America Invents Act (AIA) changed the U.S. patent system from a first to Invent (FIT) system to a new First-Inventor-to-File (FITF) system. This session will review the new 35 U.S.C. § 102 and provide a practical review and analysis of it, as well as tips for applying this new law.
Renée DuBord Brown
10:45 Networking Break
Registrants will break out into three separate groups: Electromechanical/Mechanical, Electronics/Computers, and Life Sciences (Biotechnology, Chemical/Pharmaceutical).

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): Pauline Farmer-Koppenschol, Moderator; Elizabeth A. Doherty, Gloria M. Gusler, Yuko Soneoka
11:45 Patentable Subject Matter
This presentation will focus on understanding the limits of patent eligible subject matter following the U.S. Supreme Court decisions in Assoc. for Molecular Pathology v. Myriad Genetics, Inc. and Alice Corp. v. CLS Bank, I.O.T. The session will also review the most recent USPTO guidelines for patent eligible subject matter. The speakers will provide guidance on what can and cannot be patented and provide tips for drafting applications to avoid rejections under 35 U.S.C. § 101 and responding to Office Actions.
Electromechanical/Mechanical, Electronics/Computers: Rajiv P. Patel
Life Sciences (Biotechnology, Chemical/Pharmaceutical): Yuko Soneoka, Moderator; Elizabeth A. Doherty, Pauline Farmer-Koppenschol, Gloria M. Gusler
12:30 Lunch Break

Afternoon Session: 2:00 p.m. – 4:30 p.m.
2:00
Claim Drafting Seminars
The three technology groups will participate in claim drafting seminars. These seminars 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 will be assigned and thoroughly discussed in small groups.
Electromechanical/Mechanical: Robert Hulse
Electronics/Computers: Rajiv P. Patel, Christopher M. Tobin
Life Sciences (Biotechnology, Chemical/Pharmaceutical): Elizabeth A. Doherty, Pauline Farmer-Koppenschol, Gloria M. Gusler, Yuko Soneoka
3:15 Networking Break
3:30 Claim Drafting Seminars (continued)

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
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 Federal Circuit decisions pertinent to the specification and corresponding claim interpretation, and will also include tips for drafting in view of the first-to-disclose aspects of the AIA.
Electromechanical/Mechanical, Electronics/Computers: Christopher M. Tobin
Life Sciences (Biotechnology, Chemical/Pharmaceutical): Elizabeth A. Doherty, Moderator; Pauline Farmer-Koppenschol, Gloria M. Gusler, Roger C. Kuan
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.
Electromechanical/Mechanical, Electronics/Computers: Sanjeeet K. Dutta
Life Sciences (Biotechnology, Chemical/Pharmaceutical): Gloria M. Gusler, Roger C. Kuan, Moderators; Elizabeth A. Doherty, Pauline Farmer-Koppenschol, Yuko Soneoka
10:30 Networking Break
10:45 Post Final Practice
Post Final Practice reviews a Final Office Action 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 The Litigation Perspective on Patent Prosecution
This presentation culminates the two days of lessons by reviewing the impact from prosecution of an application in subsequent enforcement activity. The presentation covers common errors, ways to avoid those errors and lessons to take back for prosecution practice.
Jeffrey A. Miller
12:15 Lunch Break

Afternoon Session: 1:30 p.m. – 4:00 p.m.
1:30
Amendment Seminars
The three 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.
Electromechanical/Mechanical: Daniel R. Brownstone
Electronics/Computers: Sanjeeet K. Dutta, Jeffrey A. Miller, Rajiv P. Patel, Christopher M. Tobin
Life Sciences (Biotechnology, Chemical/Pharmaceutical): Elizabeth A. Doherty, Pauline Farmer-Koppenschol, Gloria M. Gusler, Roger C. Kuan, Yuko Soneoka
2:45 Networking Break
3:00 Amendment Seminars (continued)
4:00 Adjourn
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