

PATENT LAW INSTITUTE 2018

CRITICAL ISSUES & BEST PRACTICES

The **Institute** is designed to be of ultimate practice value to all three subgroups in the patent law community: patent prosecutors, patent litigators, and strategic/transactional lawyers. The two-day schedule includes six plenary sessions of interest to all patent lawyers and six breakout sessions in each of the three subgroups.

New York
& Live Webcast
April 5-6

San Francisco
April 26-27

Credit Available: CLE and CPD



REGISTER TODAY

800.260.4754
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BREAKOUT SESSIONS INCLUDE

Prosecution Breakout Track: Two sessions focused on the latest USPTO rulemaking efforts. Painlessly stay current with the rulemakers and guideline writer priorities: correcting filing receipts, ePetition filing, PPH and correcting the ADS! How has “regime change” affected the USPTO in the near and medium term? Are the emphasis and/or methods changing?

The USPTO is all about the Supreme Court, CAFC and PTAB. Is ongoing incremental change at the USPTO what we can expect? Are software-implemented methods making a comeback in view of new policies? Do the USPTO guidelines reflect reality – or some USPTO variation – in the law? Is the CAFC getting a “handle” on how to implement Supreme Court decisions? Come to our USPTO intensive breakouts for Chemical, Bio and Software practice and discover the trends!

Litigation Breakout Track: The changing landscape of patent litigation post-*TC Heartland*; comparative analysis of litigation procedures in foreign courts; PTAB practice overview – the latest law and statistics concerning IPR, CBM and PGR proceedings; hot topics in litigation ethics; and strategies for proving and defending patent damages.

Strategic/Transactional Breakout Track: The key issues concerning patent-eligible subject matter and enhanced damages in view of recent Federal Circuit decisions that continue to greatly affect patent practitioners; hot topics in patent licensing that every transactional lawyer should know (but might not); and what U.S. practitioners need to know about prosecuting and opposing applications in Europe.

SPECIAL FEATURES

- Earn **two hours** of Ethics credit!
- Customize your **Institute** by choosing from 18 breakout sessions!

TOPICS INCLUDE

- **New!** Judges, in-house counsel, and outside counsel discuss the future of the profession, including training young attorneys, managing increasing client demands, and promoting diversity
- **New!** Judges decide discovery disputes in real time with insider feedback
- **New!** Damages experts highlight best practices for marshalling and presenting evidence
- Experts weigh in on how the Trump administration has changed patent policy and practice
- Corporate counsel discuss how to build a strong patent portfolio
- Review and analysis of recent Supreme Court and Federal Circuit decisions
- Federal judges from increasingly relevant patent venues provide insights on patent litigation
- What effect does *Halo* continue to have on willful infringement, enhanced damages and opinions of counsel
- Prosecution “safe harbors” for computer methods and medical therapies in view of Supreme Court and Federal Circuit decisions and USPTO guidelines

AGENDA DAY 1

A networking breakfast will be available each day upon your arrival.

Morning Session:

9:00

OPENING REMARKS

NY, SF & WEB: Scott M. Alter, Douglas R. Nemece, John M. White

9:15

FEATURED SPEAKER: A SYSTEM-WIDE PATENT REPORT CARD

- Supreme Court reflections and directions
 - CAFC on District Court and PTAB decisions
 - Legislative momentum
 - Suggestions for decision makers
 - The role practitioners can play
- NY, SF & WEB:** Hon. Paul R. Michel (Ret.)

10:15

PATENT LAW: A YEAR OF SUPREME COURT AND FEDERAL CIRCUIT DECISIONS IN REVIEW

- Supreme Court review: what was decided and what is pending
 - Future of the IPR after *Oil States*
 - Reinterpreted venue restrictions after *TC Heartland*
 - Patent amendment rules following *Aqua Products*
- NY & WEB:** Annemarie Hassett
SF: Prof. Pamela Samuelson

11:15 Networking Break

11:30

THE FUTURE OF THE PATENT LAW PROFESSION

- Perspectives on training young attorneys both inside and outside the courtroom
 - Billing and staffing practices: evolutions, revolutions, and revolts
 - Promoting diversity in the patent law profession
 - Relationships between clients and outside counsel
- NY & WEB:** Douglas R. Nemece, Panel Leader; Hon. Denise L. Cote, Kevin B. Jordan, Diana G. Santos
SF: Douglas R. Nemece, Panel Leader; Hon. William Alsup, Diana Luo, Alison R. Watkins

12:30 Lunch

Afternoon Session:

1:45

BREAKOUT SESSION NO. 1A: LITIGATION – BOWLING FOR DOLLARS: TIPS FOR PREPARING AND PRESENTING PATENT DAMAGES EVIDENCE FOR TRIAL

- Strategies for marshalling effective damages evidence during discovery
 - Techniques for presenting damages evidence to juries and judges effectively
 - Emphasizing core themes and incorporating storytelling into damages testimony
 - Cross-applying damages expertise on non-damages issues
- NY, SF & WEB:** Dawn Rice Hall, L. Scott Oliver

1:45

BREAKOUT SESSION NO. 1B: PROSECUTION – USPTO RULES TO REMEMBER

- Securing a filing date: Rule 53, filing alternatives
 - Submitting an oath/declaration: Rule 60 – what could be a problem?
 - Duty of disclosure: Rule 56 – can prior art be auto-cited from related cases?
 - Representing the “applicant” – power of attorney
 - Proposed new fee package and practice impacts
- NY:** Kathleen Fonda (Invited), Brian Hanlon (Invited)
SF: Brian Hanlon (Invited), Robert J. Spar

1:45

BREAKOUT SESSION NO. 1C: STRATEGIC & TRANSACTIONAL – THE TOP HOT TOPICS IN PATENT LICENSING: WHAT YOU DON'T KNOW CAN HURT YOU*

- What are the big issues facing patent owners trying to license their patents?
- How can patent owners maximize license revenue?
- What are the most common mistakes in drafting agreements?

NY & WEB: D. Brian Kacedon
SF: Burch A. Harper

2:45

BREAKOUT SESSION NO. 2A: LITIGATION – UNCERTAIN FUTURE: IMPLICATIONS OF SUPREME COURT JURISPRUDENCE ON *INTER PARTES* REVIEW

- Constitutionality of *Inter Partes* Review in light of *Oil States*
 - The PTAB’s ability to determine which claims must be instituted
 - Evolving procedures for claim amendments before the PTAB
 - The continued role of the PTAB in patent practice
- NY:** James R. Klaiber
SF: Brent K. Yamashita

2:45

BREAKOUT SESSION NO. 2B: PROSECUTION – USPTO RULES TO LEARN TO IMPROVE PROSECUTION EFFECTIVENESS

- Track 1 Prioritized Examination
 - Interview before 1st Action
 - After Final pilot – extra time for examiner
 - QPIDS – the extra IDS filing
- NY:** Kathleen Fonda (Invited), Brian Hanlon (Invited)
SF: Brian Hanlon (Invited), Robert J. Spar

2:45

BREAKOUT SESSION NO. 2C: STRATEGIC & TRANSACTIONAL – DRAFTING GLOBALLY COMPLIANT PATENT APPLICATIONS: DREAM OR REALITY?*

- Is drafting globally compliant patent applications practically possible in every technology?
 - Best practices for preparing global patent applications
 - Tips and tricks for reducing costs associated with global patent applications
 - Why to file in some countries, but not in others
 - IT and bio patent issues outside the U.S.
- NY & WEB:** Valerie Calloway, Tobias Hahn, James Jun Pan, Robert D. Wells
SF: Martin Köhler, James Jun Pan, Phyllis T. Turner-Brim, Robert D. Wells

3:45 Networking Break

4:00

BREAKOUT SESSION NO. 3A: LITIGATION – NAVIGATING THE ETHICAL QUAGMIRE: A PATENT PRACTITIONER’S JOURNEY

- Spoliation under the updated Rule 37 standard
 - The ethical implications of third-party patent monitoring
 - Unauthorized practice of law and the proper scope of pro hac vice practice
 - Client’s duty to perform patent searches
 - Inequitable conduct following *Regeneron*
- NY:** Noah M. Leibowitz
SF: Jason R. Bartlett

4:00

BREAKOUT SESSION NO. 3B: PROSECUTION – AVOIDING PATENT MALPRACTICE AT THE USPTO

- Differences in the USPTO Ethics Rules and the ABA Model Rules
 - Recent disciplinary decisions from the Office of Enrollment & Discipline
 - Spillover ethical issues: prosecution to litigation
- NY:** Eugene R. Quinn, Jr.
SF: Burt Magen

4:00

BREAKOUT SESSION NO. 3C: STRATEGIC & TRANSACTIONAL – THE ETHICS OF OUTSOURCING LEGAL SERVICES AND FUNCTIONS: WHAT PATENT PROSECUTORS AND LITIGATORS NEED TO KNOW TO SURVIVE*

- Supervising and diligence to ensure outsourced work is compatible with ethical obligations
 - Protecting client confidentiality
 - Obtaining client consent and reasonableness of fees
 - Avoiding the unauthorized practice of law
- NY & WEB:** Prof. Lisa A. Dolak
SF: Merri A. Baldwin

5:00 Adjourn

*Live Webcast of breakout session

AGENDA DAY 2

Morning Session:

9:00

BREAKOUT SESSION NO. 4A: LITIGATION – POINT COUNTERPOINT: A PATENT PRACTITIONER’S TENNIS MATCH WITH A JUDICIAL UMPIRE

- Common discovery tactics for both plaintiff and defense counsel
 - Judicial determination of disputed discovery issues
 - Practice points for perfecting a winning argument in the future
 - Discovery disputes worth fighting
- NY:** Marti A. Johnson, Panel Leader;
Hon. Christopher J. Burke, Matthew Moffa
SF: Marti A. Johnson, Panel Leader;
Hon. Jacqueline Scott Corley, Robert S. Magee

9:00

BREAKOUT SESSION NO. 4B: PROSECUTION – RECENT DEVELOPMENTS IN CHEM/PHARMA AND BIO PATENTS

- Claim interpretation from District Court decisions
 - Claim interpretation as it relates to infringement and validity
 - Rule 12 motions: 35 USC 101 patent subject matter eligibility
- NY:** Laura Donnelly, Gerald M. Murphy, Jr.
SF: MJ Edwards, Craig A. McRobbie

9:00

BREAKOUT SESSION NO. 4C: STRATEGIC & TRANSACTIONAL – WHY DO YOUR IPHONE AND OTHER ELECTRONICS COST SO MUCH?! WHO DO PATENT POOLS REALLY BENEFIT?*

- The current and future effects of multiple patent pools on licensing
 - What are the motivations and business models behind recent pools?
 - How does cross-licensing affect your decision to license from a pool?
 - Dealing with patent pools as a potential licensee and/or licensor
- NY, SF & WEB:** Judson Cary, Tony E. Piotrowski

10:00

BREAKOUT SESSION NO. 5A: LITIGATION – MUSICAL CHAIRS IN PATENT VENUE: THE PRACTICAL IMPLICATIONS OF *TC HEARTLAND*

- Comparison of various venues for patent litigation suitability
 - Analysis of the effects of *TC Heartland* in practice
 - Review of various local rules benefiting patent litigation
 - Predictions of future “patent venues”
- NY:** Sapna W. Palla
SF: Benjamin C. Elacqua

10:00

BREAKOUT SESSION NO. 5B: PROSECUTION – PTAB DECISIONS FOR CHEM/PHARMA AND BIO PATENTS

- Case studies in recent PTAB trials and related appeals.
 - Tips to Win: PTAB trials and procedures
 - Recent *ex parte* PTAB decisions
 - Updates to USPTO 101 guidelines
- NY:** Heather Champion Brady, Gerald M. Murphy, Jr.
SF: MJ Edwards, Craig A. McRobbie

10:00

BREAKOUT SESSION NO. 5C: STRATEGIC & TRANSACTIONAL – THE FAST-CHANGING WORLD OF SOFTWARE-RELATED PATENTS: CRITICAL ISSUES YOU NEED TO KNOW NOW*

- Operating in a post-*Alice* world
 - Forecasting the evolution of Section 101
 - The stealthy effects of functional claiming under Section 112
 - Developing trends in “nonce” words triggering means-plus-function interpretations
 - Practical litigation and prosecution advice for dealing with software patents
- NY & WEB:** Richard M. Marsh, Jr., Mark C. Vallone
SF: Richard M. Marsh, Jr., Marian Underweiser

11:00 **Networking Break**

11:15

BREAKOUT SESSION NO. 6A: LITIGATION – INTERNATIONAL PATENT LITIGATION: A WORLD TOUR OF PATENT ENFORCEMENT

- Comparison of major patent venues, including the U.S., Germany, China, and others
 - Review of remedies and the various methods for seeking them in foreign jurisdictions
 - Procedural restrictions and hurdles around the globe
 - Coordinating multinational patent right enforcement strategies
- NY & SF:** Douglas R. Nemeck

11:15

BREAKOUT SESSION NO. 6B: PROSECUTION – SOFTWARE-IMPLEMENTED METHODS AT THE USPTO

- The current 101 guidelines
 - Any safe harbors in sight – CAFC?
 - How much “system” is necessary?
 - Is the playing field leveling AU to AU?
 - Where is this headed? Trends
- NY, SF & WEB:** Raina S. Haque

11:15

BREAKOUT SESSION NO. 6C: STRATEGIC & TRANSACTIONAL – BUILDING A STRONG PATENT PORTFOLIO: VIEWS FROM IN-HOUSE*

- Strategic considerations
 - Invention harvesting and management
 - The role of outside counsel
 - Cost-effective strategies for enhancing patent quality
- NY & WEB:** Subroto Bose, Mark J. Schildkraut, Robert J. Sinnema, Catherine J. Toppin
SF: Subroto Bose, David T. Dutcher, Kevin McLintock

12:15 Lunch

Afternoon Session:

1:45

HALO AND ITS EFFECT ON WILLFUL INFRINGEMENT AND ENHANCED DAMAGES

- Trends in the lower courts post-*Halo*
 - Current effect of opinions of counsel for mitigating willful infringement and enhanced damages
 - Litigation perspectives, including privilege and waiver
 - Practical considerations when receiving unsolicited letters
- NY, SF & WEB:** Scott M. Alter, Jon R. Trembath

2:45

CORPORATE COUNSEL PANEL: WHAT’S KEEPING CORPORATE COUNSEL AWAKE AT NIGHT

- Effects of recent court decisions and USPTO activity
 - The changing landscape of litigation
 - Concerns regarding newly enacted and pending legislation
 - The economy . . .
 - Other patent issues weighing on the minds of corporate counsel
- NY & WEB:** Robert DeBerardine, Vladimir Elgort, James E. Hanft, Steven P. Klocinski, Ryan D. Phillips
SF: Diane Gabl Kratz, Benjamin S. Lee, Stephen MacKenzie, Michael Moore, Matthew Sarboraria

3:45 **Networking Break**

4:00

ETHICS FOR PATENT PRACTITIONERS

- Rapid innovation can lead to ethics issues of delayed filings – in a first-to-file system
 - Ethics surrounding advice in the circumstance of a weakened patent regime
 - Writing applications to set up provisional damages – ethics of published applications
 - To patent or not to patent – the ethics of trade secret style protection
 - Reducing pendency via Track 1 examination – ethics regarding term commencement
- NY, SF & WEB:** Prof. David Hricik

5:00 **Adjourn**

*Live Webcast of breakout session

FACULTY

CO-CHAIRS

Scott M. Alter
Lathrop Gage LLP
Denver

Douglas R. Nemec
Skadden, Arps, Slate,
Meagher & Flom LLP
New York City

John M. White
PLI's Director of Patent Professional
Development; Director, Soryn IP Group
New York City
Berenato & White, LLC
Bethesda, MD

New York & Live Webcast April 5-6

Subroto Bose
Senior Director, Global
Patent Strategy and
IP Operations
Dolby Laboratories, Inc.
San Francisco

**Heather Champion
Brady**
Senior Patent Counsel
Johnson & Johnson
New Brunswick, NJ

**Hon. Christopher
J. Burke**
Magistrate Judge
United States District
Court, District
of Delaware
Wilmington, DE

Valerie Calloway
Chief Intellectual
Property Counsel
Alltech, Inc.
Nicholasville, KY

Judson Cary
Vice President
and Deputy
General Counsel
CableLabs
Louisville, CO

Hon. Denise L. Cote
District Judge
United States District
Court, Southern
District of New York
New York City

Robert DeBerardine
Worldwide Vice
President, Chief
Intellectual Property
Counsel
Johnson & Johnson
New Brunswick, NJ

Prof. Lisa A. Dolak
Senior Vice President
and University
Secretary
Angela S. Cooney
Professor of Law
Syracuse University
College of Law
Syracuse, NY

Laura Donnelly
Assistant General
Counsel – Patents
Johnson & Johnson
New Brunswick, NJ

Vladimir Elgort
Vice President,
Intellectual Property
Counsel
Sony Corporation
of America
Park Ridge, NJ

Kathleen Fonda
(Invited)
Senior Legal Advisor,
Office of Patent
Legal Administration
United States Patent
and Trademark Office
Alexandria, VA

Tobias Hahn
Hoyng Rokh Monegier
Düsseldorf

Dawn Rice Hall
Managing Director –
Forensic & Litigation
Consulting
FTI Consulting, Inc.
New York City

James E. Hanft
Director and Sr.
Corporate Counsel, IP
DISH Network L.L.C.
Englewood, CO

Brian Hanlon (Invited)
Director, Office of Patent
Legal Administration
United States Patent
and Trademark Office
Alexandria, VA

Raina S. Haque
Erdős Intellectual
Property Law
+ Startup Legal
Winston-Salem, NC

Annemarie Hassett
Executive Director
Engelberg Center on
Innovation Law
& Policy
NYU School of Law
New York City

Prof. David Hricik
Professor of Law
Mercer University
School of Law
Macon, GA

Marti A. Johnson
Skadden, Arps, Slate,
Meagher & Flom LLP
New York City

San Francisco April 26-27

Hon. William Alsup
District Judge
United States District
Court, Northern
District of California
San Francisco

Merri A. Baldwin
Rogers Joseph
O'Donnell, PC
San Francisco

Jason R. Bartlett
Mauriel Kapouytian
Woods LLP
San Francisco

Subroto Bose
Senior Director, Global
Patent Strategy and
IP Operations
Dolby Laboratories, Inc.
San Francisco

Judson Cary
Vice President and
Deputy General
Counsel
CableLabs
Louisville, CO

**Hon. Jacqueline
Scott Corley**
Magistrate Judge
United States District
Court, Northern
District of California
San Francisco

David T. Dutcher
Assistant General
Counsel, IP
Western Digital
Salt Lake City

MJ Edwards
Senior Counsel,
Intellectual Property
Gilead Sciences, Inc.
Foster City, CA

Benjamin C. Elacqua
Fish & Richardson PC
Houston

Dawn Rice Hall
Managing Director –
Forensic & Litigation
Consulting
FTI Consulting, Inc.
New York City

Brian Hanlon (Invited)
Director, Office of Patent
Legal Administration
United States Patent
and Trademark Office
Alexandria, VA

Raina S. Haque
Erdős Intellectual
Property Law +
Startup Legal
Winston-Salem, NC

Burch A. Harper
Vice President
and Deputy
General Counsel
for Intellectual
Property
Kateeva, Inc.
Newark, CA

Prof. David Hricik
Professor of Law
Mercer University
School of Law
Macon, GA

Marti A. Johnson
Skadden, Arps, Slate,
Meagher & Flom LLP
New York City

Martin Köhler
Hoyng Rokh Monegier
Düsseldorf

Diane Gabl Kratz
Senior Corporate
Counsel, Intellectual
Property
Seagate Technology
Cupertino, CA

Benjamin S. Lee
Deputy General Counsel
Airbnb, Inc.
San Francisco

Diana Luo
Senior Associate
General Counsel
Walmart Global
eCommerce
San Bruno, CA

Stephen MacKenzie
Senior Counsel,
Intellectual Property
and IP Litigation
Koch Industries Inc.
Wichita, KS

Senior Program Manager, California:

Ivo Mijac

Kevin B. Jordan

Global Counsel for IP
Litigation and
Brand Enforcement
JP Morgan Chase & Co.
New York City

D. Brian Kacedon

Finnegan, Henderson,
Farabow, Garrett &
Dunner, LLP
Washington, DC

James R. Klaiber

Hughes Hubbard &
Reed LLP
New York City

Steven P. Klocinski

Senior Managing
Intellectual Property
Counsel
Mastercard
Purchase, NY

Noah M. Leibowitz

Simpson Thacher &
Bartlett LLP
New York City

Richard M. Marsh, Jr.

Faegre Baker
Daniels LLP
Denver

**Hon. Paul R. Michel
(Ret.)**

Former Chief Judge,
United States Court of
Appeals for the
Federal Circuit (CAFC)
Alexandria, VA

Matthew Moffa

Perkins Coie LLP
New York City

Gerald M. Murphy, Jr.

Birch, Stewart, Kolasch
& Birch, LLP
Falls Church, VA

L. Scott Oliver

Orrick, Herrington &
Sutcliffe LLP
Menlo Park, CA

Sapna W. Pala

Wiggin & Dana LLP
New York City

James Jun Pan

Smart & Biggar/
Fetherstonhaugh
Toronto

Ryan D. Phillips

Director and Managing
IP Counsel
Broadcom Limited
Denver

Tony E. Piotrowski

General Counsel
MPEG LA LLC
Washington, DC

Eugene R. Quinn, Jr.

President and Founder
IP Watchdog, Inc.
Leesburg, VA

Diana G. Santos

Willkie Farr &
Gallagher LLP
New York City

Mark J. Schildkraut

Assistant General
Counsel – IP and
Cybersecurity
Becton, Dickinson
and Company
Franklin Lakes, NJ

Robert J. Sinnema

Vice President and
Counsel, Intellectual
Property
Sikorsky, a Lockheed
Martin Company
Stratford, CT

Catherine J. Toppin

Senior Patent Counsel
and Manager
GE Global Patent
Operation
Norwalk, CT

Jon R. Trembath

Lathrop Gage LLP
Denver

Mark C. Vallone

IP Counsel, IBM Cloud
IBM Corporation
Endicott, NY

Robert D. Wells

Rock IP, PLLC
Washington, DC

Robert S. Magee

Weil, Gotshal &
Manges LLP
Redwood Shores, CA

Burt Magen

Vierra Magen
Marcus LLP
San Francisco

Richard M. Marsh, Jr.

Faegre Baker
Daniels LLP
Denver

Kevin McLintock

Director, Worldwide
Patent and IP Strategy
Logitech Inc
Newark, CA

Craig A. McRobbie

Birch, Stewart, Kolasch
& Birch, LLP
Falls Church, VA

**Hon. Paul R. Michel
(Ret.)**

Former Chief Judge,
United States Court of
Appeals for the
Federal Circuit (CAFC)
Alexandria, VA

Michael Moore

Director, Product
Legal Services
Pure Storage
Mountain View, CA

L. Scott Oliver

Orrick, Herrington &
Sutcliffe LLP
Menlo Park, CA

James Jun Pan

Smart & Biggar/
Fetherstonhaugh
Toronto

Tony E. Piotrowski

General Counsel
MPEG LA LLC
Washington, DC

**Prof. Pamela
Samuelson**

Professor of Law
UC Berkeley School
of Law
Berkeley, CA

Matthew Sarboraria

Vice President,
Associate General
Counsel
Oracle
Redwood City, CA

Robert J. Spar

Patent Prosecution
and Practice
Specialist, Director
(Ret.)
OPLA, USPTO
Silver Spring, MD

Jon R. Trembath

Lathrop Gage LLP
Denver

Phyllis T. Turner-Brim

Vice President,
Assistant General
Counsel IP and
Technology
Starbucks Coffee
Company
Seattle

Marian Underweiser

Senior Counsel –
Research IP Law
IBM Research –
Almaden
San Jose

Alison R. Watkins

Gibson, Dunn &
Crutcher LLP
Palo Alto

Robert D. Wells

Rock IP, PLLC
Washington, DC

Brent K. Yamashita

DLA Piper LLP (US)
East Palo Alto, CA

2018 PROGRAM DETAILS

LOCATIONS, PAYMENT & CANCELLATION POLICIES, CREDITS, ETC.

April 5-6

NEW YORK

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April 26-27

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