

U.S. TRADEMARK PRACTICE FOR PARALEGALS

Seminar Agenda

Choosing Your Trademark Options

- ▶ Current state of U.S. trademark law
- ▶ Identifying the elements you want to protect
 - Trademark
 - Trade name
 - Trade dress
- ▶ Methods of protection
 - Common law
 - State law
 - Federal law
- ▶ Requirements for federal registration
- ▶ Bars to federal registration

Searching U.S. Trademarks

- ▶ Reasons to conduct a trademark search
- ▶ Types of trademark registrability searches
 - Limited
 - Full
- ▶ Identifying elements of the mark to search
- ▶ Choosing search resources
- ▶ Workshop: conducting a sample search and reviewing the results
 - Federal register
 - State registrations
 - Common law

Prosecuting U.S. Trademark Applications

- ▶ Preparing to file online with the USPTO
 - Identifying the mark, the owner, and the goods and services
 - Making claims of use
 - Handling special issues
 - Addressing distinctiveness
- ▶ Filing online
- ▶ Responding to office actions and the challenges of online responses
- ▶ Overcoming objections of examiner
 - Likelihood of confusion
 - Functionality
- ▶ Options after a final refusal
- ▶ Maintaining and renewing the registration

Policing and Enforcing U.S. Trademarks

- ▶ Using the internet to police a trademark
- ▶ Consequences of failure to police a trademark
- ▶ Using cancellations and oppositions as an enforcement strategy
- ▶ Using the courts as an enforcement strategy
- ▶ Licensing trademarks
- ▶ Assigning trademarks

U.S. TRADEMARK PRACTICE FOR PARALEGALS

– New York, NY – June 10, 2008 • Seminar Faculty –

Jeffrey Barton Cahn is senior counsel with Sills Cummis & Gross, P.C., in Newark. Mr. Cahn focuses his practice on intellectual property, specializing in trademarks, copyrights, and trade secrets litigation and prosecution. He daily handles trademark registration prosecutions in the United States, Canada, and the United Kingdom, as well as from Hong Kong and Australia to Israel, Norway, the European Common Market, and Central and South America. In registering one of the earliest intangible trademarks used only on computer screens, Mr. Cahn helped to create the guidelines which the United States Patent and Trademark Office currently uses to examine and register the increasing number of familiar computer-related and other intangible marks. He is the principal editor of *Trademark Administration: A Guide for Paralegals and Trademark Administrators* (3rd edition), International Trademark Association (2005).

Leslie K. Mitchell is a member in the intellectual property group of Arent Fox, LLP, in New York. Ms. Mitchell has extensive experience in trademark, copyright, and unfair competition law. Since 1983 her practice has involved the clearance of trademarks, application prosecutions, domestic and international portfolio management, trademark infringement policing and litigation in the federal district courts. Ms. Mitchell regularly counsels clients, as well as advertising, marketing and package design agencies on trademark-related matters. In addition, Ms. Mitchell's practice includes counseling on licensing, copyright, and transactional matters.

Katrin Lewertoff is an associate in the intellectual property group of Arent Fox, LLP, in New York. Ms. Lewertoff's practice focuses on trademark law. She represents clients in U.S. and foreign jurisdictions on a variety of trademark matters, including clearance and adoption of marks, prosecution of trademark and copyright applications, trademark clearance searches and investigations, and litigation of internet domain name disputes. Ms. Lewertoff also has experience with global intellectual property transactions, including mergers and acquisitions and secured financing.

Keith A. Weltsch is an associate with Scully, Scott, Murphy & Presser, PC, in Garden City, New York. Mr. Weltsch specializes in U.S. and foreign trademark prosecution and clearance. He is experienced in oppositions and cancellations before the Trademark Trial and Appeal Board, conducting settlement negotiations and preparing consent and coexistence agreements relating to trademark litigation. He is also knowledgeable in copyright and domain name dispute laws and litigation. Mr. Weltsch was a trademark examining attorney at the U.S. Patent and Trademark Office from 1999-2002, including a special work detail at the Office of Legislative and International Affairs.

Visit our web site at
www.halfmoonseminars.com
 for information on other upcoming seminars.

U.S. TRADEMARK PRACTICE FOR PARALEGALS

– San Francisco, CA – June 24, 2008 • Seminar Faculty –

Lynn M. Humphreys is of counsel in the San Francisco office of Morrison & Foerster. Her practice focuses on counseling clients with respect to intellectual property concerns, i.e., trademark clearance in the United States and abroad, prosecution of trademark applications, monitoring and enforcement of trademarks, opposition proceedings, domain name disputes, copyright registration, and infringement litigation. Ms. Humphreys also counsels clients regarding advertising and promotional matters. In addition, she has drafted and negotiated software and website development agreements, co-marketing arrangements, and promotion contracts. Her litigation experience includes commercial disputes, antitrust, false advertising, and trademark and copyright infringement claims. She has a B.A. degree in Chemistry, with honors, and a J.D. degree from the University of Virginia.

Kelly P. McCarthy is an attorney in the Intellectual Property Transactions and Litigation Group and the Corporate Transactions Group at Sideman & Bancroft, LLP, in San Francisco. Ms. McCarthy represents business entities and individuals in commercial, corporate, and intellectual property transactions, with a focus on brand protection issues and trademark and copyright portfolio management. She has a B.A. degree, *cum laude*, from Loyola Marymount University and a J.D. degree from the University of California, Hastings College of the Law. Ms. McCarthy is a member of the International Trademark Association and the Intellectual Property Section of the State Bar of California.

Dana Brody-Brown is an attorney with White & Case, LLP, in Palo Alto, who practices in the area of trademark counseling and prosecution, including trademark audits, portfolio analysis and strategic counseling, selection and searching of trademarks, domestic and worldwide registration and enforcement, and licensing. Ms. Brody-Brown also handles trademark disputes, including domain name issues and opposition and cancellation proceedings before the Trademark Trial and Appeal Board of the United States Patent & Trademark Office. In addition, she has special interest and expertise in the area of advertising and marketing law.

Maria Teresa Becerra is a trademark paralegal in the Palo Alto office of White & Case, LLP. Ms. Becerra prepares and processes trademark filings in the United States and foreign countries, and she communicates directly with clients and foreign offices. Ms. Becerra has worked as a paralegal since 1981, the last seven years in trademark practice.

Jennifer L. Co is an attorney in the Intellectual Property group at White & Case, LLP, starting in the New York office before joining the Palo Alto office in 2007. Ms. Co handles copyright, trademark, and domain name disputes before federal courts, the Trademark Trial and Appeal Board, the World Intellectual Property Organization Arbitration and Mediation Center, and the National Arbitration Forum. She also practices in the areas of trademark counseling, clearance, and prosecution, as well as intellectual property transactions and licensing. Ms. Co has a B.A. degree from the University of California, Berkeley and a J.D. degree from Columbia University School of Law. She is a member of the International Trademark Association, where she served as an Eastern Regionals Coordinator for the Lefkowitz Moot Court Competition in 2006-2007, and The Copyright Society of the U.S.A.

OVERVIEW

If You're a Paralegal and You Work in Intellectual Property, These Seminars are Designed Just for You!

For twelve years HalfMoon Seminars has been presenting an annual conference on intellectual property practice designed especially for paralegals. Unlike most intellectual property law seminars which are designed primarily for attorneys, our conference is designed to give practical tips that paralegals and legal assistants can use every day.

Each day of the conference we go in-depth into one area of intellectual property practice, to give you tips and pointers to make you more efficient and effective. You'll learn how and when to use different types of patent and trademark searches. You'll get tips on filing applications on-line with the USPTO. You'll compare different methods of filing for international trademark and patent protection, and you'll get tips on enforcing patents and trademarks.

Take Home a Trademark or Patent Practice Handbook!

With your registration you'll receive a practical manual, prepared by the seminar faculty, which you can take home as a guide and reference to all the topics covered at the seminar.

Who Should Attend?

Each day of this national conference is designed for paralegals, legal assistants and other legal staff who work in intellectual property law. Whether you're in-house with a large corporation, on the staff of an intellectual property boutique law firm, or the only assistant in a small firm that handles occasional intellectual property matters, you'll get practical tips you can use in your practice.

Register Today!

Don't miss these one-of-a-kind seminars. Register today. You can register on-line at www.halfmoonseminars.com, or you can register by phone at 715-835-5900. You can also fill out the registration form in this brochure and mail it to us, or you can fax it to us at 715-835-6066.

CD/Manual Packages Available!

If your schedule does not allow you to attend the conference, you can order a live digital audio recording of the program of your choice. The CD package includes a copy of the program manual and any other written materials distributed at the program.

INTELLECTUAL PROPERTY LAW PRACTICE FOR PARALEGALS
Twelfth Annual
NYC Seminar & Conference Center, New York, NY – June 10-13, 2008
Best Western Grosvenor Hotel, San Francisco, CA – June 24-27, 2008



5 REASONS... You Won't Want To Miss These Seminars!

1. You'll get practical tips on prosecuting, policing, and enforcing U.S. trademarks.
2. You'll learn about European Community trademark registration (CTM) and registration under the Madrid Agreement/Protocol.
3. You'll get tips on prosecuting U.S. patent applications and preserving U.S. patent rights.
4. You'll learn about patent registration under the European Patent Convention and the Patent Cooperation Treaty.
5. You'll network with other intellectual property paralegals from across the country.

SEARCHING • US PATENT AND TRADEMARK PRACTICE • INVENTION • TRADE MARK OFFICE • PATENT AND TRADEMARK PRACTICE FOR PARALEGALS • INTERNATIONAL • PATENT AND TRADEMARK PRACTICE FOR PARALEGALS • APPLICATION • TRADE MARK OFFICE • PATENT AND TRADEMARK PRACTICE FOR PARALEGALS • CLEARANCE • TRADE MARK OFFICE • PATENT AND TRADEMARK PRACTICE FOR PARALEGALS • PROSECUTION • PATENT AND TRADEMARK PRACTICE FOR PARALEGALS • COMMUNITY REGISTRATION • PATENT AND TRADEMARK PRACTICE FOR PARALEGALS • INVENTION • CLEARANCE • TRADE MARK OFFICE

Twelfth Annual National Conference

Intellectual Property Law Practice for Paralegals

Four practical one-day seminars on trademark and patent practice, *designed exclusively for paralegals and legal assistants:*

- ▶ U.S. Trademark Practice
- ▶ International Trademark Practice
- ▶ U.S. Patent Practice
- ▶ International Patent Practice

New York, NY – June 10-13, 2008
 San Francisco, CA – June 24-27, 2008

Each One-day Seminar Offers:
 6.0 CLE Hours for California
 Paralegals & Attorneys
 6.0 NALA CLAE Hours
 6.0 NFPA CLE Hours
 (See inside for details.)

Visit our web site at www.halfmoonseminars.com

Continuing Legal Education
 a division of HalfMoon LLC

REGISTRATION FORM

Twelfth Annual Intellectual Property Law Practice for Paralegals

1. Check appropriate conference(s):

Tuition: • \$249.00 per person, per program, course manual included.
 • Multiple registration discount: \$225.00 per person, per program, when registering three or more people or for three or more one-day seminars.

- | | |
|--|---|
| <input type="checkbox"/> U.S. Trademark Practice, New York, NY
Tuesday, June 10, 2008 MM #08154-NYNY | <input type="checkbox"/> U.S. Trademark Practice, San Francisco, CA
Tuesday, June 24, 2008 LF #08158-SANF |
| <input type="checkbox"/> International Trademark Practice, New York, NY
Wednesday, June 11, 2008 MM #08155-NYNY | <input type="checkbox"/> International Trademark Practice, San Francisco, CA
Wednesday, June 25, 2008 LF #08159-SANF |
| <input type="checkbox"/> U.S. Patent Practice, New York, NY
Thursday, June 12, 2008 CP #08156-NYNY | <input type="checkbox"/> U.S. Patent Practice, San Francisco, CA
Thursday, June 26, 2008 ND #08160-SANF |
| <input type="checkbox"/> International Patent Practice, New York, NY
Friday, June 13, 2008 CP #08157-NYNY | <input type="checkbox"/> International Patent Practice, San Francisco, CA
Friday, June 27, 2008 ND #08161-SANF |

2. Check appropriate product(s):

Each manual \$66.00, includes shipping/handling.

<input type="checkbox"/> U.S. Trademark Practice manual	<input type="checkbox"/> New York	<input type="checkbox"/> San Francisco
<input type="checkbox"/> International Trademark Practice manual	<input type="checkbox"/> New York	<input type="checkbox"/> San Francisco
<input type="checkbox"/> U.S. Patent manual	<input type="checkbox"/> New York	<input type="checkbox"/> San Francisco
<input type="checkbox"/> International Patent manual	<input type="checkbox"/> New York	<input type="checkbox"/> San Francisco

Each CD/manual package \$259.00, includes shipping/handling.

<input type="checkbox"/> U.S. Trademark Practice CD/manual	<input type="checkbox"/> New York	<input type="checkbox"/> San Francisco
<input type="checkbox"/> International Trademark CD/manual	<input type="checkbox"/> New York	<input type="checkbox"/> San Francisco
<input type="checkbox"/> U.S. Patent CD/manual	<input type="checkbox"/> New York	<input type="checkbox"/> San Francisco
<input type="checkbox"/> International Patent CD/manual	<input type="checkbox"/> New York	<input type="checkbox"/> San Francisco

3. Please complete for each registrant: (Attach duplicate forms if necessary.)

Name: _____
 Position: _____
 Name: _____
 Position: _____
 Company/Firm: _____
 Street Address: _____
 City: _____ State: _____ Zip: _____
 Phone where we can reach you: (_____) _____ - _____

I need special accommodations. Please contact me.

4. I am making payment by:

Check payable to HalfMoon LLC (____ Yes, I was pre-registered by phone or fax.)
 MC VISA AmEx Discover
 Card No: _____ Expires: _____
 Cardholder Name: _____
 Signature: _____
 E-mail Address (for credit card receipt only): _____

5. Detach entire panel and send via fax to 715-835-6066 or by mail to: HMS, PO Box 268, Eau Claire, WI 54702-0268.
Thank you.

ADDITIONAL INFORMATION

▶ **Tuition:** \$249.00 per day for a single registration, or \$225.00 per person/per day when registering three people, or when registering one person for three one-day seminars. Please make check payable to **HalfMoon LLC**. Each registration for a one-day seminar includes one copy of the manual for that program. **Pre-registration is recommended.** Walk-in registrations will be accepted at the program if space is available.

▶ **Send Registrations to:** HMS, PO Box 268, Eau Claire, WI 54702-0268. You may also register via fax at 715-835-6066, or register by phone at 715-835-5900, or on-line at www.halfmoonseminars.com. **We do not send confirmations.** You will be contacted if any scheduling changes occur.

▶ Locations:

June 10-13, 2008
NYC Seminar and Conference Center • (800) 326-5494
 71 West 23rd Street
 New York, NY 10010

June 24-27, 2008
Best Western Grosvenor Hotel at San Francisco Int'l Airport
(650) 873-3200
 380 South Airport Blvd.
 South San Francisco, CA 94080

▶ Daily Schedule:

Registration	8:00 - 8:30 a.m.
Morning Session	8:30 - 11:45 a.m.
Lunch	11:45 a.m. - 1:00 p.m. (On your own.)
Afternoon Session	1:00 - 4:15 p.m.

▶ **Cancellations:** If your schedule changes and you contact us at least **48 hours before the start of the seminar (CDT)**, we will offer you a full tuition refund, minus a \$10 service charge for each registrant. If you contact us after that time, we will offer you a credit toward another seminar or a credit toward the CD/manual package. *If you desire, you may send another person to take your place at the seminar.*

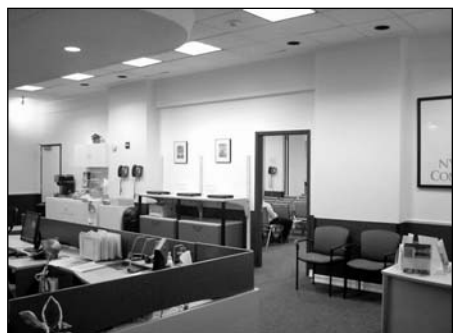
▶ **CD/Manual Package:** A full recording of each one-day seminar is available for \$259.00, including shipping and handling. *Please allow five weeks from the seminar date for delivery.*

Visit our web site at www.halfmoonseminars.com
 for information on other upcoming seminars.

SEMINAR ACCOMMODATIONS

Our New York City conference location is

NYC Seminar and Conference Center. The conference center is located in Manhattan's Chelsea district, near major subway lines, Penn Station, and several fine hotels. The district has many unique shops and restaurants. While in Manhattan, you may also choose to attend a Broadway show, visit a museum, tour the Statue of Liberty, or walk through Central Park. **Overnight accommodations are not included in the prices of the seminars.** You need to make your own hotel arrangements. You can call HalfMoon for a list of hotels near the conference center.



Our San Francisco conference location is

Best Western Grosvenor Hotel at San Francisco International Airport, which is located 10 miles from downtown San Francisco and five miles from 3Com Park. You'll be staying just minutes away from the famous San Francisco historic waterfront, with its exciting shops and restaurants. Take a ride on the cable cars, explore Chinatown, tour Alcatraz Island Prison or visit one of the city's many art galleries or museums. **Overnight accommodations are not included in the prices of the seminars.** The Best Western has made a limited number of rooms available for registrants. Please call the hotel at (650) 873-3200 and ask for the HalfMoon Seminars conference rate.



CONTINUING EDUCATION CREDITS

Each one-day seminar is designed to qualify for 6.0 CLE hours for California paralegals under the Business & Professions Code 6450. Continuing education programs for paralegals are not pre-approved by the state. The State Bar of California has approved HalfMoon LLC as an MCLE sponsor, and HalfMoon LLC certifies this program for 6.0 CLE hours for California attorneys. The National Association of Legal Assistants has approved each program for 6.0 CLAE hours toward maintenance of the Certified Legal Assistant credential. The National Federation of Paralegal Associations has approved each program for 6.0 CLE hours toward the maintenance of the PACE Registered Paralegal credential. *Please email doug@halfmoonseminars.com or call HMS at 715-835-5900 with any continuing education questions.*

INTERNATIONAL TRADEMARK PRACTICE FOR PARALEGALS

Seminar Agenda

Understanding International Trademark Protection Laws

- ▶ Overview of international agreements protecting trademarks
 - The Paris Convention
 - The Madrid Agreement and the Madrid Protocol
 - European Community Trademarks
 - Trademark Law Treaty
 - Trade-Related Intellectual Property (TRIPS)
 - Lisbon Arrangement
 - North American Free Trade Agreement (NAFTA)
 - Other agreements and treaties

Searching Trademarks in Foreign Countries and

Developing an International Trademark Protection Strategy

- ▶ Reasons to conduct an international trademark search
- ▶ Types of international trademark searches
- ▶ Formulating search strategy
- ▶ Choosing search resources
- ▶ Workshop: conducting a sample search and reviewing the results
- ▶ Developing an international trademark protection strategy
 - Identifying goals
 - Reviewing options
 - Budget constraints and other practical matters

Using European Community Registration (CTM)

- ▶ Current status of CTM law
 - Advantages/disadvantages
- ▶ Searching and clearance
- ▶ Community trademark prosecution
 - Preparing the application
 - Post-filing procedures
 - Filing the application
 - Registration or refusal
- ▶ Renewal
- ▶ Infringement
- ▶ Transfer of CTM rights
- ▶ Marking and use

Registration under the Madrid Agreement/Protocol

- ▶ Current status of Madrid system
 - Advantages/disadvantages
- ▶ Searching and clearance
- ▶ Madrid system prosecution
 - Preparing the application
 - Post-filing procedures
 - Filing the application
 - Registration or refusal
- ▶ Renewal
- ▶ Infringement
- ▶ Transfer of rights
- ▶ Marking and use

- New York, NY - June 11, 2008 • Seminar Faculty -

L. Donald Prutzman is a partner with Tannenbaum Helpert Syracuse & Hirschtritt, LLP, in the New York office. Mr. Prutzman has a broad-based intellectual property and trade regulation practice that encompasses both litigation and non-litigated matters. He has experience in commercial litigation, particularly disputes involving trademark, copyright, and antitrust issues. Other areas in which Mr. Prutzman is an experienced litigator include securities regulation and insurance coverage. His most recent publication is "Non-U.S. Trademark Owners Should Consider Protecting Trademarks in the U.S. Even if There Is No Current U.S. Use," in the November 2007 issue of the *Intellectual Property & Technology Law Journal*.

Max Vern is an associate with Amster Rothstein & Ebenstein, LLP, in New York. Mr. Vern practices international intellectual property law with emphasis on securing and enforcing trademark rights. He has significant experience in developing brand strategy and maximizing global trademark portfolio protection. Mr. Vern's practice involves trademark searches and opinions, and filing, prosecution, due diligence, licensing, acquisitions, and enforcement of trademark rights, including oppositions and cancellation actions. The practice encompasses a wide range of industries - electronics, internet, entertainment, retail, banking, medical products, pharmaceuticals, food products and services, construction, and real estate.

Dermot M. Sheridan is an associate attorney with Epstein Drangel Bazerman & James, LLP, in New York. Mr. Sheridan is a registered Irish & European trademark attorney. He has a multi-jurisdictional global background in patent and trademark prosecution, having practiced with leading Irish firms prior to joining the Epstein Drangel in 2003. In the field of trademarks, Mr. Sheridan has extensive experience in the prosecution of U.S., Irish, European Community (CTM), and international trademark applications (Madrid Protocol) on behalf of U.S., Irish, and international clients. He also conducts trademark and brand clearance searches, and he monitors clients' global intellectual property portfolios. In addition, he is well versed in the prosecution of European patents.

Dennis S. Pahl is a partner with Ladas & Parry, LLP, in the New York office. Mr. Pahl specializes in the areas of international trademark, copyright, domain name, right of publicity, and unfair competition law. He has represented and advised a wide range of clients, from multinational corporations to individuals, in diverse fields. Mr. Pahl has authored and co-authored several publications on the topics of trademark law, unfair competition, merchandising, and domain names. He has been a guest lecturer on the topics of international trademark law and intellectual property at the Benjamin N. Cardozo School of Law, the Fordham University School of Business, Fordham Law School, and Baruch College, and he has been a speaker at numerous intellectual property conferences throughout the United States.

- San Francisco, CA - June 25, 2008 • Seminar Faculty -

Gretchen R. Stroud is a special counsel in the Trademark, Copyright & Advertising practice group at Cooley Godward Kronish, LLP, where she is a member of the litigation department. Ms. Stroud works in the firm's Palo Alto office. She manages worldwide trademark portfolios for clients in a wide variety of industries, including pharmaceuticals, medical devices, venture capital, consumer electronics, and internet-based companies. She advises clients on a variety of trademark matters, including worldwide clearance, licensing, infringement actions, and opposition and cancellation proceedings. Ms. Stroud also counsels clients on domain name issues. She is a graduate of Stanford University Law School and is a member of the International Trademark Association.

Joi White is an associate attorney in the Intellectual Property Practice Group of Carr & Ferrell, LLP, in Palo Alto, specializing in intellectual property law, with an emphasis on international and domestic trademark prosecution, counseling, and enforcement. Ms. White counsels a wide range of businesses in managing their trademark portfolios, clearing new marks, developing and implementing enforcement strategies, and navigating various trademark and domain name disputes. Prior to joining Carr & Ferrell, Ms. White worked at an electronic design automation (EDA) company where she contributed to management of the trademark portfolio and provided support to in-house clients regarding clearance, adoption, and use of new marks. She is a member of the WHOIS Subcommittee of the International Trademark Association's Internet Committee, and she has supervised the Internet and Intellectual Property Justice Clinic as an adjunct faculty member at the University of San Francisco School of Law.

Connie L. Ellerbach is a partner in the Mountain View, California, office of Fenwick & West, LLP, where she is a member of the firm's Intellectual Property Group. Ms. Ellerbach's practice focuses on trademark and trade name counseling, including developing and managing domestic and international trademark portfolios, resolving conflicts over disputed marks, and establishing and enforcing rights in trademarks used on the Internet. She is a member of the American Intellectual Property Law Association, the California Bar Association's Intellectual Property Section, and the American Bar Association's section on Patent, Trademark and Copyright Law. Ms. Ellerbach is also a member of the International Trademark Association, where she serves on the Fair Use and Other Boundaries Subcommittee.

James R. Cady is a senior associate in the East Palo Alto office of Howrey, LLP. Mr. Cady has seven years of experience in intellectual property law, primarily in trademarks, including experience as an examining attorney at the U.S. Patent and Trademark Office and as in-house trademark counsel at a major manufacturer of energy drinks in Austria. He handles domestic and international trademark clearance and prosecution, opposition and cancellation proceedings, intellectual property licensing and transfers, due diligence, copyright prosecution and clearance, and rights of publicity. Mr. Cady has a J.D. degree from the College of William and Mary and an LL.M. degree from the University of London. He is a member of the American Bar Association and the International Trademark Association.

U.S. PATENT PRACTICE FOR PARALEGALS

Seminar Agenda

Understanding the Basics of U.S. Patent Law

- ▶ IP: Forms of intellectual property
- ▶ Legal basis for U.S. patents
 - Patentable subject matter
- ▶ Requirements for obtaining a patent
 - Utility, novelty, non-obviousness
- ▶ Parts of a patent
 - Specification, drawings, claims
- ▶ Inventorship and ownership

Assembling Information about the Invention and Existing Patents

- ▶ Collecting information about the invention
- ▶ Searching for existing patents
 - Search options

Preparing U.S. Patent Applications

- ▶ Identifying the invention
- ▶ Identifying the inventors
- ▶ Drafting patent applications
- ▶ Filing applications

Assisting with U.S. Patent Prosecution

- ▶ Docketing of applications
- ▶ Preparing information disclosure statements
- ▶ Making status inquiries
- ▶ Preparing amendments
- ▶ Receiving and responding to office actions
- ▶ Reviewing the notice of allowance
- ▶ Reviewing the patent
- ▶ Case study: examining a patent file

Preserving U.S. Patent Rights

- ▶ Maintaining the patent
 - Obligatory requirements
 - Elective requirements
- ▶ Licensing patent rights
- ▶ Assigning patent rights
- ▶ Handling patent issues in corporate transactions
- ▶ Handling patent infringement issues

- New York, NY - June 12, 2008 • Seminar Faculty -

Salvatore Anastasi is a partner with Barley Snyder, LLC, in Berwyn, Pennsylvania. Mr. Anastasi is a patent attorney and chairs the firm's Intellectual Property Law Group. He counsels clients on all aspects of intellectual property, including domestic and international patent preparation and prosecution and intellectual property litigation. He prepares and prosecutes U.S. and international patent applications in the electrical and electromechanical arts and prepares and prosecutes trademark applications. Mr. Anastasi litigates intellectual property matters, and he prepares licensing agreements and patentability, trademark, validity, and infringement opinions. In addition to his legal experience, Mr. Anastasi's professional experience includes work as a practicing engineer in the electrical and electromechanical fields. He received his J.D. degree from Widener School of Law and his B.S. degree in Electrical Engineering from Drexel University.

Jay H. Anderson is a counsel with the firm Wiggin and Dana, in the New York office. He has been a registered patent practitioner since 1994. He has prepared and prosecuted patent applications for electrical switches, household appliances, semiconductor devices, computer software, internet applications and business methods. He was previously a staff patent attorney at a Fortune 10 corporation and an associate at a leading New York intellectual property firm. Jay holds an S.B. degree from MIT, master's degrees from the University of Illinois, and a J.D. degree, *cum laude*, from Pace University School of Law.

Linda Shudy Lecomte is a partner in the New York office of Kenyon & Kenyon, LLP, focusing primarily on patent prosecution (both foreign and domestic) and counseling, including opinions, licensing, due diligence evaluations, and transactions, as well as pre-litigation preparation and litigation. Ms. Lecomte has counseled a wide range of clients, from multinational corporations to small businesses to individuals, on a vast range of technologies, with particular emphasis in the electrical, computer software, mechanical and biomedical arts. She received her B.S. degree in Electrical Engineering and her J.D. degree from the University of Minnesota.

Dana Copeland is a patent paralegal who is experienced in all areas of patent prosecution having worked in-house as a patent administrator for a major Fortune 500 Corporation and currently as a prosecution paralegal for Kenyon & Kenyon, LLP, in New York. Ms. Copeland has extensive experience in U.S., PCT, and foreign filings and in management of complex dockets. She trains legal assistants and assists inventors, patent strategic managers and analysts, and patent attorneys. Ms. Copeland has a diploma in Paralegal Studies from New York University and a B.S. degree in Business Management & Administration (Concentration: Finance) from Mount Saint Mary College.

- San Francisco, CA - June 26, 2008 • Seminar Faculty -

Stephen R. Bachmann is an attorney at Vierra, Magen, Marcus & DeNiro, LLP, where he practices in the areas of patents, trademarks, and copyrights. He provides services of U.S. and foreign patent and trademark prosecution, investigation, licensing, counseling, and strategic planning. Mr. Bachmann has worked as an electrical engineer at National Semiconductor. He received a B.S. degree from San Jose State University and a J.D. degree from Golden Gate University.

Mary O'Malley has worked in the Intellectual Property field for more than 20 years, specializing in patent prosecution. She is the Patent Administrator at eBay Inc. in San Jose, and was responsible for the integration and implementation of eBay's patent database in 2006. She manages and oversees all ongoing aspects of the patent database for eBay and its subsidiaries, including the invention disclosure process and intake module which is accessible to more than 15,000 employees in more than 30 countries. Ms. O'Malley has extensive patent experience in both corporations and law firms, and offers valuable perspectives from each.

D. Benjamin Borson, J.D., Ph.D., recently founded and is president of the Borson Law Group, PC, in Concord, California, where he and his associates carry out a diverse intellectual property practice. He provides legal, scientific, business, and technical advice to help companies build and exploit business relationships and intellectual assets through developing intellectual property and technology strategies, including the drafting and prosecution of patents and trademarks and the preparation of legal opinions and licensing. He is a frequent author on intellectual property law, with more than a dozen publications in legal journals, and he has presented more than 30 lectures on legal matters to industry, academic organizations, and legal organizations. Dr. Borson is licensed to practice law in the State of California, the Federal District Court for the Northern District of California, and the United States Patent and Trademark Office.

INTERNATIONAL PATENT PRACTICE FOR PARALEGALS

Seminar Agenda

Understanding the Basics of International Patent Law

- ▶ History and development of international patent law
- ▶ Searching for international patent information
 - How to find information on technology, competitors, and existing patents
- ▶ Determining where to seek patents
- ▶ Deciding which procedures to use

Practice under the European Patent Convention

- ▶ European Patent Convention fundamentals
- ▶ Preparing applications for filing in Europe
- ▶ Validating countries of interest
- ▶ Lodging patents in member countries
- ▶ Maintaining European patents and applications
- ▶ Obtaining patent protection in Hong Kong via EPC
- ▶ Filing directly vs. filing via Patent Cooperation Treaty

Patent Cooperation Treaty (PCT) Practice

- ▶ Understanding the purposes and limitations of the PCT
- ▶ PCT fundamentals
- ▶ Chapter I: basic process
 - Preparing the international application
 - Preparing the PCT request
 - Submitting the request and application
- ▶ Chapter II
 - When required?
 - Preparing and submitting the PCT demand
- ▶ National and regional phases

Understanding European Community Designs and

National Utility Models

- ▶ Definition of what designs and utility models are and what rights these provide
- ▶ Filing requirements: The specific information and documents that are needed for filing designs and utility models
- ▶ Time line: When it is too late to file patents, designs, and utility models might still be a possible alternative

- New York, NY - June 13, 2008 • Seminar Faculty -

Samson Helfgott is a partner and director of patents at Katten Muchin Rosenman, LLP, in New York. Mr. Helfgott has practiced for more than 30 years in domestic and international patent, trademark and copyright matters, international patent strategy, and patent and trademark administration before foreign patent tribunals. Mr. Helfgott is a member of the American Bar Association (Intellectual Property Law Section) where he has been elected a member of Council. He is chairman of the International Committee of the New York Patent, Trademark and Copyright Law Association (Board of Directors 1986-89). Mr. Helfgott is chairman of the Foreign Practice Committee of the Intellectual Property Owners Association. He has chaired many committees at the American Intellectual Law Association and has been elected a Fellow of that organization. He serves on the U.S. Bar European Patent Office (EPO) Liaison Council, having previously been its chairman. He was the founder and first chairman of the U.S. Bar/Japan Patent Office (JPO) Liaison Council. He also is Advisory Board Member and contributor to *World Intellectual Property Report*, BNA International, Inc., London, England.

John Richards started work in the patent profession in the patent department of the British chemical company Albright & Wilson in 1966. He joined Ladas & Parry in New York in 1973, becoming a partner in 1982. Mr. Richards is the general editor of *Legal Aspects of Introducing Products to the United States* (Kluwer 1988) and co-author of *Intellectual Property and the Internal Market of the European Community* (Graham & Trotman 1993). He is an adjunct associate professor at Fordham University School of Law where he teaches U.S. and international patent law. Mr. Richards has written and spoken frequently on international intellectual property issues, especially in the fields of patents and copyrights in the United States, Canada, India, and the Far East. Mr. Richards specializes in chemical and biochemical patent matters, including the drafting and prosecution of patent applications in these fields in the United States and abroad. He is also widely experienced in the negotiation and drafting of patent and know-how license agreements.

Mary Anne Schofield is of counsel in the Intellectual Property Group in Crowell & Moring's Washington DC office. Ms. Schofield focuses her practice on counseling clients in transactional matters, patent portfolio management, evaluation of intellectual property for clearance and right to use, and patent prosecution. She prepares opinions on infringement, patentability, and freedom to operate and has extensive experience drafting collaboration agreements, as well as drafting and prosecuting U.S. and international patent applications. Prior to practicing law, Ms. Schofield was a registered patent agent (1992-1996) and a postdoctoral fellow at the Molecular Biology Institute, UCLA (1988-1991), where her research involved generation and analysis of mutant bacterial strains with altered rates of gene rearrangements. She earned her Ph.D. with Harold Varmus at the University of California, San Francisco.

- San Francisco, CA - June 27, 2008 • Seminar Faculty -

Alexander R. Schlee, who graduated as a mechanical engineer (Dipl.-Ing.), is registered as a European Patent Attorney, as a European Trademark Attorney, and as a German Patentanwalt. He is also a registered U.S. Patent Attorney admitted to practice before the United States Patent and Trademark Office. He is admitted to practice law in California and is a registered Foreign Legal Consultant with the State Bar of California. In the year 2000, Mr. Schlee founded the former Viering Jentschura & Partner (VJP) Los Angeles office, reconfigured in 2006 into Schlee IP International, P.C. Mr. Schlee handles prosecution of all types of international intellectual property rights, in particular utility and design patents and trademarks with respect to prosecution, oppositions, infringement and validity opinion work. He also works on invalidity suits before the German Patent Court and is involved in the technical aspect of patent infringement cases. Mr. Schlee is an immediate former member of the Executive Committee of the International Law Section (ILS) of the State Bar of California, is a current officer on the Board of Directors of the Los Angeles Intellectual Property Association (LAIPA), and is chair of the International IP Practice Committee of the Orange County Intellectual Property Law Association (OCPLA).

Hilary Piore is a German patent attorney, a U.S. patent agent and a European trademark and design attorney. She is involved in prosecution, opposition, and infringement matters concerning German and European patents in the pharmaceutical and biotechnology field and has been working for the law firm df-mp in Munich, Germany since 2004. She earned both her M.A. and B.A. degrees in Biology from the University of Pennsylvania in Philadelphia in 1998, and her Ph.D. in Genetics from the University of Cologne, Germany, in 2003. Her scientific background includes molecular biology, genetics, developmental biology, neurobiology, histology and physiology, as well as ecology and conservation biology.

Visit our web site at
www.halfmoonseminars.com
 for information on other upcoming seminars.