

HOW YOU WILL BENEFIT FROM ATTENDING THIS WORKSHOP

An application originating in Europe frequently encounters substantial difficulties before the USPTO. Recurrently, claims issued to a European applicant are unnecessarily narrow by US standards or unexpectedly constrained by US principles of disavowal, disclaimer and estoppel. Claim amendments and patentability arguments that are highly effective for the EPO often prove entirely inadequate before US Patent Examiners and the PTAB.

This workshop addresses the parallel, but substantially different, rules for drafting and prosecuting patents required by the Examiners and Appeal Boards of the EPO and USPTO.

You will study the contrasting approaches of the EPO and USPTO and learn the experts' techniques for drafting an application for, and responding to, rejections issued by the two offices.

PRACTICAL APPLICATIONS

- You and the other delegates will be invited to correct and modify a sample application to be filed with both the EPO and USPTO.
- You will be asked to develop effective arguments, for the EPO and USPTO, with respect to hypothetical patent office rejections.
- The workshop will include ongoing opportunities for you to ask questions and discuss individual concerns.

WHO SHOULD ATTEND

- Patent professionals and other executives who are responsible for patent applications that are filed in, and prosecuted before, both the European and US Patent Offices.
- Managers overseeing and evaluating the multinational patent prosecution.

SPEAKERS

Bradley Hulbert is a founding partner in McDonnell Boehnen Hulbert & Berghoff, an 80-lawyer patent firm in Chicago. Mr. Hulbert has overseen the development of a diverse range of extensive, international patent portfolios and is also an adjunct professor of law at the Chicago-Kent Law School.

David Meldrum has a background in electronic engineering and is a Partner of D. Young & Co LLP, Patent and Trademark Attorneys, a large IP practice based in London and Southampton. He advises medium and large corporations on their IP strategies as well as handling patent procurement matters directly before the EPO and UKIPO and indirectly worldwide.

ATTENDANCE LIMITED – EARLY REGISTRATION RECOMMENDED

This limitation, a unique feature of all **MANAGEMENT FORUM** seminars will give participants the opportunity for a thorough discussion of the complex issues to be covered by the programme.

Reserve your place at the course by registering online now at www.management-forum.co.uk or by fax **+44 (0)1483 730008**. Any questions? e-mail josephine.leak@management-forum.co.uk

This workshop merits 5.5 hours CPD and may also be relevant training under the IPReg CPD self-accreditation scheme

DOCUMENTATION

Participants will receive a course material folder containing comprehensive documentation provided by the speakers, which will be a valuable source of reference for the future.

Programme

- ▶ **Differences in the statutory systems of the EPO and USPTO - and the common consequences of drafting for only one system**
 - Legal aspects
 - Procedural aspects
 - Substantive aspects
 - Formal aspects
- ▶ **'Best Practices' for preparing one specification to comply with the European and US requirements for:**
 - Priority
 - Added subject matter/new matter
 - Industrial application/utility
 - Inventive step/non-obviousness
 - Description and sufficient basis/enablement and written description
 - Claim clarity and conciseness/'distinct claiming'
 - Limiting estoppel
- ▶ **EPO/US Definitions of Prior Art and Priority**
 - EPO
 - Article 54 definitions of 'State of the Art'
 - US
 - Definitions of 'Prior Art' for anticipation and obviousness
 - Ramifications of the America Invents Act
- ▶ **Responding to EPO and UPTO rejections, based on a single, optimised specification**
 - Burdens of proof
 - Use of provisional and non-provisional applications
 - Interviews/hearings
 - Inventive Step (EPO) vs Obviousness (USPTO)
 - EPO/US: Strategies for persuading the Examiner and Board
- ▶ **Prosecution History Estoppel in the US**
 - Estoppel variants
 - Controlling the adverse impact of arguments to the USPTO
 - Effect of representations made in corresponding, non-US applications
- ▶ **Arguments on Non-Technical (EPO) and Non-Eligible (US) Subject Matter**
 - Article 52(2), (3) exclusions
 - 'Technical'
 - Two hurdles
 - Computer program/signal claims
 - Arguments to the USPTO after *Myriad* and *Alice*
 - Abstract limitations v. "something more"
 - USPTO "guidance" on subject matter eligibility
- ▶ **Worked Examples**
 - Delegates will be invited to analyse and develop approaches for a sample application suitable for an EPO and USPTO prosecution

A Certificate of Attendance for Professional Development will be given to each participant who completes the workshop