

# THE IMPACT OF PATENT CONSTRUCTION HOW TO PROVE INFRINGEMENT and VALIDITY in the USA, UK and GERMANY

5.5 CPD  
HOURS  
SOLICITORS  
REGULATION  
AUTHORITY

## Included in this conference:

- Contrasting the doctrines of equivalents and purposive construction
- Examining the principles of claim construction and validity determination in the context of the specification and the art
- Preparing for the ‘Pincer’ argument (or ‘Gillette’ defence):
  - questionable validity of broad claims?
  - non-infringement of narrow claims?
- Discussing approaches for assessing the inventor’s intention within the claim language
- Assessing the significance of the effect of variants on the way the invention works
- Exploring best practice in the use of expert evidence
- Determining of claim scope and validity by a US examiner, judge & jury and the effect of prosecution history estoppel
- Ensuring or challenging compliance with EPC Article 69 and related protocol

**Bradley Hulbert** McDonnell Boehnen Hulbert & Berghoff, Chicago

**Ulrich Blumenröder** Grünecker, Kinkeldey, Stockmair & Schwanhäusser, Munich

**William Cook** Marks & Clerk Solicitors, London

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## THE COURSE WILL PROVIDE:

- A unique opportunity to spend a whole day in detailed analysis with recognised experts
- A comprehensive overview of the principles of patent claim interpretation and validity determination in the US, UK and Germany
- A comparison and explanation of the varying approaches for determining when a patent claim that does not literally describe an accused system is nonetheless infringed
- An analysis of the conclusions reached in the US, UK and Germany regarding the claim validity
- Recommendations for the preparation and prosecution of patent applications, as well as the litigation of issued patents
- Ongoing opportunities for participants to ask questions and discuss individual concerns

## WHO SHOULD ATTEND

- Patent professionals in private practice, including patent attorneys and lawyers
- Heads of IP, Heads of Patents and in-house patent counsel at every level
- Patent engineers, inventors and everyone else whose responsibilities include the need to understand the scope of patent coverage

## ATTENDANCE IS LIMITED; EARLY REGISTRATION IS 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.

## FORTHCOMING EVENTS

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You may make a registration and request a brochure on-line.

## SPEAKERS:

**Bradley Hulbert** is a founding partner in McDonnell Boehnen Hulbert & Berghoff, an 80-lawyer patent firm in Chicago. Mr. Hulbert has been lead counsel in a wide range of successful patent lawsuits and is an adjunct professor of law and Director, Academic and Professional Program Development, at the Chicago-Kent Law School.

**Ulrich Blumenröder** is a partner at Grünecker, Kinkeldey, Stockmair & Schwanhäusser, an IP-firm in Munich, which focuses equally on both IP-litigation and IP-prosecution. Mr. Blumenröder is active in all fields of intellectual property but primarily specialises in patent litigation. He has litigated for both plaintiffs and defendants in all prominent German courts in normal as well as preliminary injunction proceedings. Mr. Blumenröder frequently gives lectures on various topics of patent law.

**William Cook** is a partner in Marks & Clerk Solicitors in London. He is involved in all aspects of IP work, specialising in particular in patent litigation. As well as leading infringement and validity litigation in the UK and co-ordinating in the EU, USA and Asia, he works on FRAND licensing, patent essentiality, exhaustion of rights and IP/competition law issues.

This course merits 5.5 hours under the UK Solicitors Regulation Authority self-accreditation scheme

Ref: CJA/MAFO

It is also potentially relevant CPD for Fellows of CIPA

## DOCUMENTATION

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

## IN-HOUSE TRAINING

If you would like to discuss running this or any other course on an in-house basis, please contact Josephine Leak at:

[josephine.leak@management-forum.co.uk](mailto:josephine.leak@management-forum.co.uk)

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

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Any questions? e-mail [josephine.leak@management-forum.co.uk](mailto:josephine.leak@management-forum.co.uk)

# PROGRAMME

## I. PATENT CLAIM CONSTRUCTION GENERALLY

### A. In the US

- Inherent ambiguities of the 'All Elements Rule'
- Use of intrinsic and extrinsic evidence
- Counterintuitive interpretation of 'means for' claims

### B. In the UK

- Interpreting the claim in the context of the specification and the art
- The literal or primary meaning of the claim or integer
- Purposive construction, as defined in *Catnic* and restated by the House of Lords in *Amgen* in 2004
- Any residual relevance of the guidelines in *Improver?*
- Compliance with EPC Article 69 and Protocol

### C. In Germany

- No claim construction below wording
- 'Purposive construction' as part of literal wording
- Meaning of 'Means' in claims
- Relationship between claims and specification

## II. DOCTRINES OF EQUIVALENTS & PURPOSIVE CONSTRUCTION

### A. In the US

- Sub-tests for determining equivalents
- Counterweights to 'equivalence'
  - Vitiating
  - Prosecution history estoppel and its variants

### B. In the UK

- The effect of *Amgen*: How simple is the approach; are judges given any structured approach at all?
- Continuing significance of 'variants' in slower-moving technologies?

- Material considered by the court
- Expert evidence
- Compliance with EPC Article 69 and Protocol

### C. In Germany

- Expert evidence, admissible evidence
- No prosecution history estoppel
- The 'Formstein' estoppel
- Infringement by patented variant

## III. VALIDITY ANALYSIS

### A. In the US

- Four-part nonobvious analysis after *KSR* and the AIA
- Reliance on the specification to construe the claims and avoid the art
- Traps for European specifications filed in the US

### B. In the UK

- Four-step 'Pozzoli' test for obviousness (*Windsurfing*)
- Application in latest case law
- Fundamental shift in the approach of the Court over the last few years

### C. In Germany

- Split infringement / invalidity proceedings
- Requirements for combination of documents

## IV. COMPARATIVE EXAMPLES AND CASE STUDIES

- Presentation and panel discussion on the construction, infringement and validity of granted patents: comparative analysis and case studies



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## HOW TO PROVE INFRINGEMENT and VALIDITY in the USA, UK and GERMANY



Application to Register

**16 May 2013**  
**Conference Ref: H5-3213**  
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 Management Forum Ltd, 98-100  
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**Dates**

16 May 2013 Start 09.30 – Finish 17.00

**Registration & Coffee**

16 May 2013 09.00

**Venue and Accommodation**

The Cavendish Hotel, 81 Jermyn Street,  
 London SW1Y 6JF  
 (main entrance in Duke Street),  
 Hotel Tel: +44(0)20 7930 2111.  
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 Email: [Reservations@thecavendishlondon.co.uk](mailto:Reservations@thecavendishlondon.co.uk)

Subject to availability, a limited number of bedrooms have been reserved at the hotel at a special rate. **All bookings should be made directly with the hotel quoting Management Forum and your credit card number.**

**Directions**

The nearest underground stations are Piccadilly Circus, Green Park and Charing Cross – all are only short walk away. There is also a railway station at Charing Cross. Map available on our website under Links, Hotels.

**Fee**

**£575 + VAT if applicable.**

*Reduced to £495 if you also register for the course on Friday 17 May 2013 – Prosecution of EPO and US Patent Applications Stemming from a Single Specification. Ref. H5-3313*

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