



US PATENT PRACTICE

Application to Register

5 & 6 November 2014
Conf. No. H11-3214

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To Register

If you have NOT received confirmation seven days after registering, please contact Registration Department.

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Exhibition spaces and promotional opportunities will be available at this meeting.
For further information please contact Robert Sinclair
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Dates 5 & 6 November 2014
Times 5 November 2014
Start 09.30 - Finish 17.00
6 November 2014
Start 09.00 - Finish 17.00

Registration Information

Registration & Coffee
5 November 2014 09.00

Venue & Accommodation
The Rembrandt Hotel, 11 Thurloe Place,
London SW7 2RS
Hotel Tel: +44(0)20 7589 8100
Hotel Fax: +44(0)20 7225 3476
Email: reservations_rembrandt@sarova.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 or online at www.sarova.com/rembrandt, quoting promo code 'manforum'.**

Directions
Opposite V&A Museum. Nearest underground station: South Kensington.
www.sarova-rembrandthotel.com/location-local-attractions

Conference Fee
£1,100 & VAT (if applicable)
The fee includes course documentation as well as mid-session refreshments and lunch. Invoice and confirmation will be forwarded to you.

Conference No. H11-3214

Discounted Rates
Available on application for personnel from non-profit making organisations and registered charities.
Group discount available on request

Cancellation Policy:
Over 14 days prior to the Seminar: Cancellation fee of £75. 7/14 days prior to the Seminar: 50% of the fee. Fewer than 7 days or if no notification received: Registrant liable to pay FULL seminar fee.
NB: Cancellations must be received in writing by registrations@management-forum.co.uk
Management Forum reserves the right to cancel/alter the programme, the speakers, the date or venue. If an event is cancelled Management Forum is not responsible for airfare, hotel or other costs incurred by registered delegates.

Intellectual Property Magazine

'People who want to be updated with US Patent law trends should not miss this seminar.'
'A good combination of subjects, very valuable for me in the future.'

11 CPD HOURS

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US PATENT PRACTICE

WHAT EUROPEAN PATENT ATTORNEYS NEED TO KNOW

Issues to be addressed:

- **US Patent Law Update**
 - The America Invents Act (AIA)
 - Recent US Supreme Court and Federal Circuit cases of interest
- **Claim Interpretation**
- **Subject Matter Eligibility**
- **Sufficiency of Disclosure**
 - Written Description
 - Enablement
 - Best Mode
- **Novelty, Nonobviousness, Utility**
- **Inventorship**
- **Double Patenting**
- **Inequitable Conduct and the Duty of Candor**
- **Procedural aspects of US Patent Prosecution**
- **Interferences and Derivation Proceedings**
- **Post-grant Review under the AIA**
- **Reexamination and Supplemental Examination**
- **Reissues**
- **Direct and Indirect Infringement**
- **Patent Litigation**

COURSE LEADERS

James V. Suggs and **Lisa Schoedel**
McDonnell Boehnen Hulbert & Berghoff LLP, Chicago

You can register online at
www.management-forum.co.uk
or by phone on +44 (0)1483 730071, fax 730008

5 & 6 November 2014
The Rembrandt Hotel, London



INTRODUCTION

US and European patent practice differ in many essential ways. The comprehensive programme of this course, with practical examples, will highlight and explain these differences from the US point of view, giving delegates a better understanding of the US system, and enabling them to work more effectively with their US counterparts and draft applications that can most effectively serve as priority applications in the US.

This interactive seminar will explain:

- The latest changes in statutory law, including the provisions of the AIA
- Recent Federal Circuit and Supreme Court jurisprudence and its impact on the patent right
- Claim construction - the different ways the USPTO and the courts determine claim meaning and scope
- Successful US claim drafting - tools, strategies and pitfalls
- Subject Matter Eligibility - including *Prometheus* (diagnostic methods) and *Bilski* (software and business methods)
- Sufficiency of the specification: Enablement, Written Description, Best Mode
- Novelty and the transition to 'First-to-File' under the AIA
- Nonobviousness - the impact of *KSR* in the predictable and unpredictable arts and how to argue against the (inevitable) allegation of obviousness
- Double Patenting - a trap for the unwary corporate client
- Fulfilling the Duty of Candor and avoiding the scourge of inequitable conduct
- Patent prosecution: Rules, Regulations and Best practices, including restriction and continuation practice
- Interference and derivation proceedings - contested inventions before and after the AIA
- Post-grant procedures including post-grant review, reexaminations, supplemental examination and reissue
- Direct and Indirect Infringement - including liability of suppliers and contractors
- Patent Litigation - and how to protect against the liberal discovery in US courts

And much more!

WHO SHOULD ATTEND

- Corporate Patent Counsel
- Patent Attorneys from corporate and private practice
- Intellectual Property Consultants
- Patent Managers and Engineers
- Company Legal Advisers
- All those involved with patent protection in the United States

And anyone drafting patent applications that might serve as a priority application in the US

COURSE LEADERS

James V. Suggs is a partner in the Chicago intellectual property law firm of MBHB, LLP, where he practices patent law. He prepares and prosecutes patent applications, prepares opinions of counsel, performs patent due diligence studies and provides patent counselling in a variety of technologies, including pharmaceutical, chemical, materials science, integrated optics, and related technologies. His litigation experience includes federal district court and appellate practice as well as advocacy in forums such as the International Trade Commission, and spans a diverse range of technologies.

Lisa Schoedel is a partner with MBHB, LLP. She practices in all areas of intellectual property law, with a particular emphasis on patent litigation, patent preparation and prosecution, and counselling in the areas of electrical engineering, computing, and telecommunications. Her litigation experience covers a wide range of technologies, including electronic circuits, computer software, telecommunications, and mechanical products. She has experience drafting and prosecuting patent applications in the areas of circuits, sensors, microelectromechanical systems (MEMS), semiconductor processing, telecommunications, speech recognition, software, business methods, and mechanical devices.

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

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.

ACCREDITATION

This course merits 11 CPD hours, and may also be relevant training under the IPReg CPD self-accreditation scheme.

**Reserve your place at the seminar 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**

PROGRAMME

Introduction

Throughout, we will provide the latest state of US Patent Law, including the latest legislative changes under the America Invents Act, recent and pending US Supreme and other Court decisions of importance, and current happenings in the US Patent and Trademark Office.

And throughout, we will highlight specification and claim drafting tips that will provide your applications with a solid footing for US prosecution and enforcement.

▶ Claim Construction

- How the Courts and the USPTO determine claim meaning
- Claim drafting best practices

▶ 35 U.S.C. § 112 - Specification, Enablement, Written Description, Claims

- Written Description
 - *Ariad v. Eli Lilly*
- Enablement
 - *In re Wands* Factors
- Best Mode, pre- and post-AIA
- Means-Plus-Function claiming (35 U.S.C. § 112 ¶ 6)
- "Definiteness" of claims

▶ 35 U.S.C. § 101 - Patentable Subject Matter

- Patentable subject matter
- Computer-implemented inventions and business methods
 - *In re Bilski*
- Medical diagnostic and treatment methods
 - *Prometheus v. Mayo Clinic*
- Products of nature
 - *Myriad* gene patenting litigation

▶ 35 U.S.C. § 101 - Utility

▶ 35 U.S.C. § 102 - Novelty

- All elements rule
 - Genus/species considerations
 - Enabling disclosure
 - Inherency
- Analysis of pre-AIA 35 U.S.C. § 102(a)-(g)
 - On sale bar
 - Secret prior art - 35 U.S.C. § 102(e)
- Analysis of post-AIA 35 § 102 - comparison and contrast with pre-AIA law
- How the USPTO is adapting to change to 'first-to-file' system

▶ 35 U.S.C. § 103 - Non-obviousness

- The factual inquiries of *Graham v. John Deere*
- The Supreme Court's latest guidance - *KSR v. Teleflex*
- Responding to obviousness rejections in the USPTO
- Common ownership, joint development and obviousness
- Obviousness under the AIA - how changes in the definition of prior art affect obviousness determinations

▶ Patent Prosecution

- Provisional applications
- Continuation and Continuation-in-Part applications
- Restriction Practice and Divisional applications
- Patent term and Patent term adjustment
- Accelerated and Prioritized Examination
- Patent Prosecution Highway

▶ Obviousness - Type Double Patenting

▶ The Duty of Candor

- Avoiding inequitable conduct
- Time and manner of citing prior art
- Disclosure of related prosecution

▶ Inventorship

▶ Interference and Derivation Proceedings

- Interferences - pre-AIA applications
- Conception and reduction to practice
- Derivation proceedings in post-AIA applications, as compared to interferences
- Best practices in documenting conception, diligence and reduction to practice

▶ Post Issue Practice

- Post-grant review under the AIA
- Re-examination procedure and strategy
- Supplemental examination
- Re-issue
- Certificates of Correction

▶ 35 U.S.C. § 271 - Infringement

- *Markman* proceedings in the courts
- Literal Infringement
- Doctrine of Equivalents analysis
 - *Hilton Davis v. Warner Jenkinson*
 - *Festo*
- Indirect Infringement - liability for infringement by others
- Joint infringement - method claims with a third-party performing a "step"
- Infringement by importation into the US - 35 U.S.C. § 271(g)
- Willful infringement
 - Opinions of counsel
 - Significance (*Knorr-Bremse, In re Seagate*)
- Notice of Infringement preparation, and response: Declaratory Judgments

▶ Patent Litigation and the Liberal Scope of Discovery

▶ Remedies - to the Victor Belong the Spoils

- Damages: How determined, how to factor into your claim drafting
 - *i4i v. Microsoft*
 - *Lucent v. Gateway*
 - "Entire Market Value"
- Injunctions
 - *eBay v. MercExchange*