

PROSECUTION OF EPO AND US PATENT APPLICATIONS BASED ON A SINGLE SPECIFICATION

An intensive, practical course on how to prosecute patent applications under the differing requirements of the EPC and USPTO

5.5 CPD
HOURS
SOLICITORS
REGULATION
AUTHORITY

Included in this conference:

- EPO/US Prosecution Procedures and Timelines
- EPO/US Definitions of Prior Art
- The Effect of Different EPO and USPTO Priority Rules on the Right to Amend Claims
- How to Draft Effective Responses to EPO and USPTO Rejections
 - Inventive Step and Obviousness Arguments
 - Technical Effect and Subject Matter Arguments
 - Limiting Prosecution History Estoppel in the US
- Worked Examples of Office Action Responses

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With

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David Meldrum D Young & Co LLP, London

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



HOW YOU WILL BENEFIT FROM ATTENDING THIS SEMINAR

The different rules and analyses of the European and US Patent Offices invariably cause difficulties to applicants who adopt a single approach for amending claims and arguing for the patentability of their inventions. Claim amendments and patentability arguments that are highly effective for the EPO often prove entirely inadequate for the USPTO.

The seminar addresses the parallel, but substantially different, standards for patentability employed by the Examiners and Appeal Boards of the EPO and USPTO. By attending, you will see the contrast in practices before the EPO and USPTO and learn the experts' techniques for responding to rejections issued by each of the patent offices.

This seminar can be attended as a standalone event, but will also be of particular benefit to delegates who have previously attended the Management Forum Course, *Claim and Specification Drafting for a Single EPO/USPTO Patent Application*.

WHO SHOULD ATTEND

- Patent professionals who are responsible for prosecuting patent applications pending before both the European and US Patent Offices
- Executives called upon to evaluate Patent Office Rejections and assess likely outcomes
- Those who have already attended the course, *Claim and Specification Drafting for a Single EPO/USPTO Patent Application*

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.

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

SPEAKERS

Bradley Hulbert is a founding partner in McDonnell Boehnen Hulbert & Berghoff, an 80-lawyer patent firm in Chicago. Mr. Hulbert continues to oversee the development of a diverse range of extensive, international patent portfolios and is also an adjunct professor of law and Director, Academic and Professional Program Development, 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.

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

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

FORTHCOMING EVENTS

For a full list of forthcoming conferences and seminars please visit our website at: www.management-forum.co.uk. You may make a registration and request a brochure on-line.

PROGRAMME

- **EPO/US: Prosecution and Appeal Procedures**
 - Likely timelines and statutory deadlines
 - EPO
 - Euro-PCT
 - USPTO
 - Burdens of proof
 - Use of provisional and non-provisional applications after the AIA
 - Objections and rejections
 - Non-final and final Office Actions
 - Interviews
 - Patent Office Appeals
 - Judicial appeals

- **EPO/US Definitions of Prior Art and Priority**
 - EPO
 - Article 54 definitions of 'State of the Art'
 - US
 - Sections 102 & 103 definitions of 'Prior Art'
 - Ramifications of the America Invents Act

- **EPO/US: Rejections and Responses**
 - 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 effect of arguments to the USPTO
 - Effect of representations made in corresponding, non-US applications
 - Rule 56 obligations after *Therasense*

- **Arguments on Non-Technical (EPO) and Subject Matter (US)**
 - Article 52(2), (3) exclusions
 - 'Technical'
 - Two hurdles
 - Potential technical effect T26/86 Koch & Sterzel
 - Computer program/signal claims
 - Arguments to the USPTO after *Bilski* and *Myriad*
 - Abstract vs. Structural limitations
 - Remains of the "machine or transformation" test

- **Worked Examples**
 - Office Actions from the EPO and USPTO
 - Winning (and losing) arguments for overcoming inventive step/obviousness rejections



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Application to Register

17 May, 2013
Conference Ref: H5-3313
Please PRINT your details:

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To Register

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

If you do not want to receive future mailings from Management Forum please contact nick@management-forum.co.uk
If you do not wish to receive selected third party mailings please contact nick@management-forum.co.uk

Dates

17 May 2013 Start 09.30 – Finish 17.00

Registration & Coffee

17 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.
 Hotel Fax: +44(0)20 7839 4369.
 Email: 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 Thursday 16 May – Impact of Patent Construction – How to Prove Infringement and Validity in US, UK and Germany Ref. H5-3213

Conference No. H5-3313

I would like to attend (Please tick)

- 16 May 2013 Conf No H5-3213
- 17 May 2013 Conf No H5-3313

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.

Exhibition spaces and promotional opportunities will be available at this meeting.
For further information please contact Robert Sinclair
(email: robert@management-forum.co.uk)