



EU AND US PATENT APPLICATIONS: Specification and Prosecution Strategies for a Single Application

Application to Register

19-21 November 2014
Conf. No. H11-3014

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

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Registration Information

Dates 19-21 November 2014
Times 19 November 2014 Start 09.30 - Finish 17.00
20 November 2014 Start 09.00 - Finish 17.00
21 November 2014 Start 09.00 - Finish 12.30
with Lunch

Registration & Coffee
19 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_rembbrandt@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
£1,600 + 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. H11-3014

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.



A NEW THREE-DAY WORKSHOP

EU and US PATENT APPLICATIONS:

Specification and Prosecution Strategies for a Single Application

How to reconcile the differing requirements of the EPO and USPTO

- Key, major differences between EPO and US practice
- 'Best practices' for specification drafting for both the EPO and USPTO:
 - Maximising scope of protection
 - Reducing potential objections
 - Minimising costs and maximising flexibility
 - EPO and USPTO definitions of prior art and priority
- Prosecution procedures and timelines
 - EPO and USPTO views on what constitutes a proper rejection and how to respond
 - Arguments on non-technical (EPO) and ineligible (US) subject matter
 - Prosecution history estoppel in the US
 - Expediting prosecution & grant
- Worked examples followed by a plenary discussion

15 CPD HOURS

JOIN US ON



Seminar Leaders

Bradley Hulbert

McDonnell Boehnen Hulbert & Berghoff LLP, Chicago

David Meldrum

D Young & Co LLP, London

You can register online at
www.management-forum.co.uk
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19-21 November 2014
The Rembrandt Hotel, London



HOW YOU WILL BENEFIT FROM ATTENDING THIS SEMINAR

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 for US Patent Examiners and the PTAB.

This seminar 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, and learn the experts' techniques for responding to rejections issued by each of the patent offices

SEMINAR LEADERS

Bradley Hulbert is a founding partner in McDonnell Boehnen Hulbert & Berghoff LLP, 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 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.

ACCREDITATION

This course merits **15 CPD hours**, and may 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

PRACTICAL APPLICATIONS

- You and the other delegates will be invited to correct and modify sample applications to be filed with both the EPO and USPTO.
- You will all be asked to develop effective arguments, for the EPO and for USPTO, with respect to a series of hypothetical patent office rejections.
- During plenary sessions you will discuss the worked examples, with the speakers and other delegates, to produce optimal specifications acceptable to both the EPO and USPTO. Arguments for allowance that are honed for the different expectations of EPO and USPTO examiners will also be developed.
- The seminar 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 European and US Patent Offices.
- Managers overseeing and evaluating the multinational patent prosecution.

DOCUMENTATION

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

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.

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

PROGRAMME

► Review of the similarities and differences in the statutory systems of the EPO and USPTO

- 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
- Novelty
- Inventive step/non obviousness
- Description and sufficient basis/enablement and written description
- Claim clarity and conciseness/'distinct claiming'
- Limiting estoppel and implications of the AIA

► 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
- 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
 - Definitions of 'Prior Art' for anticipation and obviousness
 - 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 adverse impact of arguments to the USPTO
- Effect of representations made in corresponding, non-US applications
- Disclosure 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 *Myriad* and *CLS Bank*
 - Abstract vs Structural limitations
 - USPTO "Examination Instructions"

► Worked Examples

- Delegates will be invited to analyse and modify sample applications suitable for the EPO and USPTO
- Delegates will be asked to develop effective arguments, for the EPO and USPTO, with respect to a series of hypothetical office actions

► Plenary Session

Delegates and speakers will discuss the worked examples with the aim of optimising specifications acceptable to both the EPO and USPTO