

# US PATENT PRACTICE

## What Every European Patent Practitioner Should Understand

### WEBCAST

#### COURSE LEADERS

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**Matthew J. Sampson** is partner of the Chicago Law Firm McDonnell, Boehnen, Hulbert & Berghoff LLP. He has more than 18 years' experience in the practice of intellectual property law, with a particular emphasis on litigation, prosecution and client counselling.

**Kevin E. Noonan** is a partner in the Chicago law firm of McDonnell, Boehnen, Hulbert & Berghoff, LLP. He has extensive experience in biotechnology and the chemical arts. Dr. Noonan brings many years of experience as a molecular biologist working on high-technology problems to his legal work. He has wide experience in all aspects of patent prosecution and client counselling on validity, infringement, and patenting strategy matters.

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US and European patent practice differ in many essential ways. The comprehensive programme of this webcast will highlight and explain these differences from the US point of view, giving viewers a better understanding of the US system, and enabling them to work more effectively with their US counterparts.

#### **This webcast will explain:**

- ▶ Introductory update on US Patent Law
- ▶ Summary of Statutory Requirements for Patentability in the USA
- ▶ Types of claims
- ▶ 35 USC§ 112 – Specification, Enablement, Written Description, Claims
- ▶ 35 USC§ 101 – Utility
- ▶ 35 USC§ 102 – Novelty
- ▶ 35 USC§ 103 – Non-obviousness
- ▶ Twenty year term, publication, liability for published claims
- ▶ Provisional Application practice
- ▶ Patent prosecution
- ▶ Patent disputes
- ▶ Patent litigation
- ▶ Appellate practice
- ▶ Interference, Priority, Opinions

**FOR FULL PROGRAMME SCROLL DOWN**

## PROGRAMME DAY ONE

### Introduction

Brief update on US Patent Law, including an overview of the current status of affairs of the US Patent Office, recent and pending legislation and US Supreme Court decisions.

### Summary of Statutory Requirements for Patentability

#### Types of Claims

#### 35 USC § 112 – Specification, Enablement, Written Description, Claims

- ▶ **Enablement**
  - In re Wands Factors
- ▶ Written Description
  - Lilly Enzo
  - Gentry Gallery/Tronzo
- ▶ Best Mode
- ▶ Means plus function (35 USC § 112 ¶ 6)
- ▶ Definiteness
- ▶ Common Errors in Claim Drafting
- ▶ Successful US Claim Drafting
- ▶ Claim Construction
  - Drafting and Prosecution Considerations

## PROGRAMME DAY TWO

#### 35 USC § 101 – Utility

- ▶ Patentable subject matter
- ▶ Computer implemented inventions
- ▶ Biotech utility
  - Chemical and Biotech utility

#### 35 USC § 102 – Novelty

- ▶ Analysis of 35 USC § 102(a) through (g)
- ▶ Printed publications
- ▶ On sale
- ▶ Public use

#### 35 USC § 103 – Non-obviousness

- ▶ *Graham v. John Deere* (Supreme Court's tool for determining obviousness)
- ▶ *In re Papesch*
- ▶ *In re Dillon*
- ▶ *In re O'Farrell*
- ▶ *KSR v. Teleflex*
- ▶ Responding to obviousness rejections
- ▶ Common ownership and obviousness
- ▶ Doubling patenting and terminal disclaimers

### Twenty year term, publication of US Patent Applications, liability for published claims

#### Electronic Filing of Papers

#### Provisional Application Practice

- ▶ Disclosure requirements
- ▶ Conversion to or from a Regular National Application
- ▶ Provisional filing strategies

- ▶ Continuation, Divisional and CIP applications
- ▶ Overcoming rejections, objections and requirements
- ▶ Patent application appeal process
- ▶ Techniques for maximizing patent validity
- ▶ Fee structure
- ▶ Avoiding inequitable conduct
  - Time and manner of citing prior art
  - Disclosure of related prosecution

#### Patent Prosecution

- ▶ Understanding and dealing with the US PTO

## PROGRAMME DAY THREE

#### Patent Disputes

- ▶ Claim construction/Markman
- ▶ Literal Infringement
- ▶ Doctrine of Equivalents Analysis
  - *Hilton Davis v. Warner Jenkinson*
  - *Festo*
- ▶ Infringement by importation into the U.S.; §271(g) analysis
- ▶ Infringement and Validity Analysis
- ▶ Willful infringement/opinions of counsel
- ▶ Notice of Infringement preparation and response, Declaratory Judgments

#### Patent Litigation Overview

- ▶ Pleading
  - Complaint
  - Answer
- ▶ Discovery

- Document discovery
- Privilege
- Interrogatories
- Deposition
- ▶ Trial Plan
  - Bench and Jury trial
- ▶ Markman Hearing – the central focus of trial practice
- ▶ Damages
- ▶ Injunctions
  - *eBay v. MercExchange*
- ▶ Settlement

#### Appellate Practice

- ▶ Mechanics/Timing of the appeal
- ▶ Issues on appeal
- ▶ Standard of review

#### Post Issue Practice

- ▶ Re-examination procedure and strategy
- ▶ Re-issue

- ▶ Certificate of Correction

#### Interference Overview

- ▶ Inventorship
- ▶ Procedure
- ▶ Strategy
- ▶ Settlement

#### Priority Issues

- ▶ 37 CFR § 1.131 declarations for Non-US inventor
- ▶ Lab notebooks
- ▶ Documenting Conception, Diligence, Reduction to Practice

#### Opinions

- ▶ Freedom to operate
- ▶ Invalidity
- ▶ Significance (*Knorr-Bremse, In re Seagate*)