

US PATENT PRACTICE

What Every European Patent Practitioner Should Understand

WEBCAST

COURSE LEADERS

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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.

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.

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

Patent Prosecution

- ▶ Understanding and dealing with the US PTO

- ▶ 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