

# 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 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*)