

U.S. Patent Law and Practice: An In-depth Course for the European Practitioner

Strategy, Drafting, Prosecution and Enforcement Issues that European Applicants and Practitioners Should Know When Dealing with a US Patent Professional

Barcelona, 25th and 26th, April 2005

• Venue:

Aula Fèlix Serratosa - Edifici Modular
Parc Científic de Barcelona
Josep Samitier 1-5
08028 Barcelona

• Time:

From 10:00 to 18:30 h (lunch break from 13:00 to 14:30 h)

• Registration:

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• Attendance Fee:

550 € (VAT not applicable). It includes course documentation, mid-session refreshments and lunch.

• Payment:

Send a cheque payable to Fundació Bosch i Gimpera (projecte 3584) or a bank transfer to the account No. 2013-0088-63-0200326711. **Payment must be received before 15th April.** Provide invoice details. Invoice and confirmation will be forwarded to you.

• Cancellation Policy:

Fee will be refunded (less 4% administration expenses) if cancellation is made before 15th April.

With the collaboration of

**Oficina Española de Patentes y Marcas
(OEPM)**



• Introduction:

TRIPs implementation and PCT reform may suggest that patent globalization has been nearly achieved. However, there are still some major differences in patent law and practice between EPC countries and the U.S. If ignored, these differences can represent a source of problems for a European company or a European patent practitioner when attempting to obtain and enforce patent protection in the U.S. A patent can encounter enforcement problems if, for example, a true co-inventor is not identified or if an assignment is not properly obtained. In a world of collaborative research knowing the effect of a joint R&D agreement and its impact on patent rights is critical. Ignoring the *first-to-invent* system, keeping laboratory notebooks (particularly electronically), proving an early date of invention, and other details, can cause serious problems to an unaware applicant. U.S. claim drafting practices should be taken into account when drafting any application destined for the U.S. Non compliance with the USPTO additional requirements for patentability (best mode, written description, duty of disclosure...) can render a patent invalid or unenforceable. Knowing whether communications will be privileged and protected from discovery in the U.S., how to select the best patent litigation strategy, and how to effectively work with a U.S. counsel is of the utmost importance when a patent conflict arises. Recent changes in U.S. patent law (publication of applications, third-party participation in reexamination, patent appeal conferences and continuing application...) are key to European practitioners being able to deal effectively with their U.S. patent counsel for the benefit of their clients.

• Objective:

This two-day course will provide a comprehensive, in-depth and updated analysis, including differences between U.S. and European countries, related to all aspects of the U.S. patent system. The course will concentrate on how Spanish or European applicants can take full advantage of the U.S. patent system.

• Who should attend:

Spanish or European patent attorneys, patent lawyers, experts from patent departments in industry, patent examiners, intellectual property consultants, etc.

Program

• Key Differences Between the U.S. Common Law System and the Rest of the World

- First to invent versus first to file
- Inventors as the applicant
- Grace period versus absolute novelty
- Best mode requirement
- Discovery in a U.S. litigation

• How to determine inventorship

• Prior Art: What's different in the U.S. ?

- Understanding the Grace period
- Understanding 102(e)
- What is public use

• Drafting Foreign Priority Applications to Comply with U.S. Requirements

- Claim Construction in the U.S.

• Prosecuting the U.S. Application with an Eye Towards Future Enforcement

- Practices before the U.S. Patent Office Board of Appeals and Interferences and effective use of the Appeals process.
- Inequitable Conduct
- Privilege Issues when Instructing U.S. Counsel

• Patent Correction

- Certificates of Correction
- Reissue/Reexam
- Is the US moving towards an opposition like proceeding?

• Opinions of Counsel

- Recent changes in US Law regarding opinions.

• Litigation in the U.S.

- Understanding the U.S. Judicial System
- The U.S. jury system.
- Discovery
- Damages
- Understanding attorney/client privilege

Speakers

• Lori-Ann Johnson

U.S. Patent Attorney and frequent lecturer on U.S. patent practice and licensing. Managing Partner of Finnegan, Henderson, Farabow, Garrett & Dunner's Belgium office in Brussels.

She worked for four years as a patent examiner for the U.S. Patent and Trademark Office (PTO).

She has a J.D. degree from George Washington University National Law Center and a B.S.Ch.E. degree from Worcester Polytechnic Institute.



• Anthony Tridico

U.S. Patent Attorney and member of the Finnegan, Henderson, Farabow, Garrett & Dunner's Bio/Pharmaceutical Practice Group in Brussels office.

He has considerable legal and litigation experience.

He has J.D. degree from Georgetown University Law Center, a Ph.D. in Physical Chemistry from Georgetown University and a B.A. degree in Chemistry from La Salle University.

