IPI Academy

MANAGEMENT forum



Presented by
Management Forum

How to Avoid Common Pitfalls in Combined EU/US Patent Applications

This training course addresses the parallel, but substantially different, rules for drafting and prosecuting patents required by the Examiners and Appeal Boards of the EPO and USPTO.

Format:
Bespoke training

CPD:
12 hours for your records (depending on your requirements)

Certificate of completion

Course overview

This practical and interactive training course will demystify the complex area of combined EU/US patent applications. The expert trainers will address the parallel – but substantially different – rules for drafting and prosecuting patents required by the Examiners and Boards of Appeal of the EPO and USPTO. They will highlight the risks and pitfalls to be aware of and explain how to avoid them or deal with them if challenged by the patent offices.

The comprehensive training programme will ensure that you get to grips with the contrasting approaches of the EPO and USPTO and understand the experts' techniques for drafting an application for, and responding to, rejections issued by the two offices.

During the practical exercises you will learn how to correct and modify a sample application to be filed with both the EPO and USPTO and practise developing effective arguments for the EPO and USPTO, taking into account hypothetical patent office rejections.

You will also have the opportunity to discuss your particular questions and concerns with the expert trainers, as well as share experiences with like-minded professionals.

Key topics to be covered include:

- The often unseen traps posed by differing EU and US requirements
- 'Best practices' for reconciling the EU and US requirements and drafting an application to:
  - Maximise scope of protection
  - Reduce objections
  - Minimise costs and maximise flexibility
- Prosecution procedures
  - EPO and USPTO approaches to rejections
  - Responding to EPO and USPTO rejections, based on an optimised specification
  - Limiting US prosecution history estoppel
- Practical session using worked examples to help embed the learning

Benefits of attending

By attending this training course you will:

- **Consider** the similarities and differences between the EPO and USPTO
- **Learn** about the best practices for preparing to comply with European and US requirements
- **Expand** your knowledge on prosecution and appeal procedures
- **Get to grips** with EPO and US definitions of prior art and priority
- **Understand** inventive step (EPO) vs obviousness (US)
- **Explore** the arguments on non-technical (EPO) and subject matter (US)

Who should attend?

This training course has been specially designed for:

- Patent professionals and other executives who are responsible for patent applications that are filed in and prosecuted before both the European and US Patent Offices
- Managers overseeing and evaluating multinational patent prosecution

Reviews

★★★★★

Very relevant to point out the differences in the US audience (examiners, judges, jury) and the differences to European examiners. A lot of examples from court cases etc. Good, practical tips on how to find the golden mean when preparing a patent application that can work both in EP and in the US. Course content, presentation and speakers all amazing. An eye opener for anyone familiar with EP practice, but not so much with US practice (or vice versa) - avoiding ethnocentrism. Expert level course (ideal for me with 20 years EP experience). Very knowledgeable and experienced speakers who could pinpoint the trouble points for EP practitioners.

Lars Hald
Senior Patent Manager
Ambu A/S
Nov 8 2023

★★★★☆

I felt very important to remind that none of the system is better, the systems are different. The course was very interesting and gave some useful practical information for improving our work as patent attorneys.

Alexandra GOREAUD
Patent attorney
GERMAIN MAUREAU
May 15 2019

★★★★★

Great

Miruna Enescu
Patent Attorney
ROMINVENT
May 16 2018

★★★★★

Very good

Tajeshwar Singh
Patent Attorney
Protector IP AS
May 17 2017

Run this programme in-house for your whole team

Coming to IPI Academy for your in-house training provides an all-inclusive service which gives you access to a wide variety of content, learning platforms and delivery mechanisms as well as your own personal training adviser who will work with you from the initial enquiry through to feedback and follow-up after the programme.

With over 600 trainers, all practitioners and experts across a huge range of fields, we can provide the training you need, where you need it, when you need it, and at a price which suits your budget. Our approach to tailored learning and development consists of designing and delivering the appropriate solution for each client.

For your FREE consultation and to find out more about how we can work with you to solve your training needs, please contact our training advisers:



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IPI Academy

IPI Academy is a training initiative of Falconbury and Management Forum; leading providers of industry training for over 30 years, based in the UK.

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