IPI Academy

MANAGEMENT forum



Presented by
Management Forum

Mastering US Patent Practice: Prosecution, Strategy and Recent Developments

18-21 May 27
+ 2-5 November 27

What all European patent attorneys need to know - an intensive and highly interactive training course that includes discussions on US patent law and strategies and tactics for patent prosecution at the US Patent Office

Format:
Live online

CPD:
12 hours for your records

Certificate of completion

Course overview

The United States remains one of the world's most important and commercially significant patent jurisdictions. However, US patent law continues to evolve rapidly, creating challenges for patent attorneys, in-house counsel and IP professionals responsible for protecting innovation globally.

This comprehensive and highly practical training course provides a detailed understanding of modern US patent practice, prosecution strategy and enforcement. Delegates will gain valuable insight into the latest developments at the USPTO, key Federal Circuit and Supreme Court decisions, and emerging trends affecting patentability, claim drafting, prosecution and post-grant proceedings.

The course will explain the critical differences between US and European patent practice and provide practical guidance on drafting and prosecuting stronger US patent applications. Particular attention will be given to subject matter eligibility, enablement, written description requirements, restriction practice, continuation practice, PTAB proceedings and recent developments impacting software, AI and technology-based inventions.

Attendees will learn how to navigate the US patent system more effectively, maximise patent value, reduce prosecution risk and work more efficiently with US counsel and inventors.

Key topics covered:

- Legal framework
- Claim construction and drafting
- US patent prosecution practice and procedure
- Written description and enablement
- Alice and its continuing impact on subject matter eligibility
- Software
- AI-assisted inventions
- Novelty and prior art
- Obviousness
- Functional claiming
- Method claims
- Provisional and continuing applications
- Restriction practice
- Current PTAB trends
- Inventorship and ownership
- Direct and indirect infringement
- Licensing considerations
- Emerging USPTO initiatives
- International developments impacting US practice

Through practical examples, case studies and interactive discussions, delegates will gain the knowledge and confidence needed to develop effective US patent strategies in an increasingly complex legal environment.

This training course will also give you the opportunity to ask questions and discuss your real-life challenges with the expert trainer.

Benefits of attending

This is a fantastic opportunity to take full advantage of the open training course environment that this programme offers. With a high degree of interaction with the expert trainer, as well as other participants, this is a great forum for discussing your particular questions and challenges.

Offering a wide-ranging and detailed understanding, this training course covers what every European patent practitioner should know about US patent practice.

By attending this training course you will:

- **Gain** a practical understanding of modern US patent prosecution practice
- **Understand** the key differences between US and European patent systems
- **Learn** how recent USPTO guidance and court decisions affect patentability
- **Explore** current approaches to software, AI and computer-implemented inventions
- **Improve** patent drafting strategies for US prosecution and enforcement
- **Build** knowledge on continuation, divisional and provisional application strategies
- **Develop** practical approaches to overcoming novelty and obviousness objections
- **Identify** how PTAB proceedings can impact patent portfolios
- **Evaluate** recent developments in patent term adjustment and terminal disclaimers
- **Explore** infringement, enforcement and litigation considerations
- **Stay up to date** with current USPTO initiatives and examination trends
- **Gain** practical insight into managing US patent portfolios more effectively

Who should attend?

This training course has been specially designed for:

- Corporate patent counsel
- Patent attorneys from in-house and private practice
- European patent lawyers
- UK patent lawyers
- US patent attorneys
- Patent managers
- Patent engineers
- IP directors
- Technology transfer professionals
- Intellectual property consultants
- R&D managers
- Patent analysts, patent search and information specialists
- Technology lawyers
- All those involved with patent filings and prosecution in the United States

Programme

Day 1

Module 1: Foundations of US Patent Practice

Overview of the US patent system

- Courts, USPTO and PTAB
- Key differences between US and European practice
- Patentability requirements
- Recent legislative and judicial developments

Claim construction and drafting for success

- Claim interpretation in US courts
- USPTO claim examination standards
- Drafting claims for prosecution and enforcement
- Common drafting pitfalls

Day 2

Module 2: Patentability and prosecution strategy

Written description and enablement

- Current Federal Circuit guidance
- Possession requirement
- Enablement after Amgen
- Practical drafting strategies

Subject matter eligibility

- Alice and its continuing impact
- Software and AI inventions
- USPTO guidance updates
- Emerging trends

Novelty and prior art

- First-to-file framework
- Prior art considerations
- Grace periods
- Inventor disclosures

Day 3

Module 3: Building stronger US patent portfolios

Obviousness

- Current obviousness standards
- KSR and subsequent developments
- Drafting and prosecution strategies

Functional claiming

Method claims

- Impossibility
- Judicial interpretation

Strategic filing approaches

- Provisional applications
- Continuations
- Continuations-in-part
- Divisionals
- Global filing considerations

Restriction practice

- Restriction requirements
- Election of species
- Rejoinder practice

Programme

Day 4

Module 4: PTAB, enforcement and emerging issues

Post grant challenges

- Inter Partes Review (IPR)
- Post-Grant Review (PGR)
- Reissue and re-examination
- Current PTAB trends

Patent term and portfolio management

- Patent term adjustment
- Patent term extension
- Terminal disclaimers
- Recent developments

Inventorship and ownership

- Joint inventorship
- AI-assisted inventions
- Ownership disputes
- Assignment issues

Enforcement and litigation

- Direct and indirect infringement
- Doctrine of equivalents
- Willfulness
- Damages and remedies
- Licensing considerations

Future trends

- AI and patent practice
- Emerging USPTO initiatives
- Key cases to watch
- International developments impacting US practice

Presenter



James Suggs

James V. Suggs is a partner in the intellectual property law firm McDonnell Boehnen Hulbert & Berghoff LLP, located in Chicago, where he practices patent law and serves as Chair of the firm's Chemical Practice Group. He applies his broad technical experience in a wide variety of chemical, polymer, materials science, pharmaceutical, optical, photonic, semiconductor and related technologies. He handles all facets of patent law, with an especial focus in patent procurement, strategic counseling, freedom-to-operate and due diligence opinions.

He also has an active inter partes review practice. His litigation experience includes federal district court and appellate practice as well as advocacy in forums such as the International Trade Commission, and spans a diverse range of technologies. He has experience with all kinds of clients, from large multinational corporations, to science-based startups, to academic research institutions, and works with law firms in Europe and worldwide to successfully prosecute their applications at the USPTO.

Course dates

18-21 May 27	**Live online** 13:30-17:00 **UK (London)** (UTC+01) *Course code 17225*	GBP **1,199** ~~1,399~~ EUR **1,679** ~~1,959~~ USD **1,927** ~~2,239~~ **Until 23 Mar**
2-5 November 27	**Live online** 13:30-17:00 **UK (London)** (UTC+00) *Course code 17447*	GBP **1,199** ~~1,399~~ EUR **1,679** ~~1,959~~ USD **1,927** ~~2,239~~ **Until 07 Sep**

How to book

Online:
ipi.academy/988

Alternatively contact us to book, or if you have any queries:

Email:
info@ipiacademy.com

Phone:
+44 (0)20 7749 4749

Discounts

- Booking more than one delegate on any one date qualifies for a **30% discount** on the second and subsequent places.
- Most events qualify for an **early booking discount** prior to 6 weeks before the course date. Be sure to check on our website, where the latest discounts will be shown.

Further information

Fee
The fee includes all meals and refreshments for the duration of the course (for venue-based courses) and a complete set of course materials (provided electronically). If you have any particular requirements, please advise customer services when booking.

Please note
IPI Academy (and our training partners) reserve the right to change the content and timing of the programme, the speakers, the date and venue due to reasons beyond their control. In the unlikely event that the course is cancelled, we will refund the registration fee and disclaim any further liability.

Terms and conditions
The rest of the our terms, the event cancellation policy and the terms and conditions are on our website, please visit ipi.academy/content/terms-and-conditions

Reviews

★★★★★

Great course materials with plenty of detail which I can use in the future.

Sarah James
Patent Attorney
Unilever
Jun 13 2024

★★★★☆

The content, the presentation and the speaker were very good. All topics were presented in a clear manner.

MARIA LUISA MARCHESI
Italian Patent Attorney
ENI CORPORATE UNIVERSITY SPA
Dec 15 2022

★★★★★

Excellent! Very good and helpful overview of US patent law with a focus on the differences to European law. I particularly liked the very interactive discussions.

Hendrik Freudenberger
IP Legal Advisor
Sasol Chemie GmbH & Co. KG
Dec 5 2019

★★★★★

Very thorough and well presented.

Elisabetta Mauri
Director of Intellectual Property
Dompé Farmaceutici SPA
Dec 5 2019

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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