

# Best Practices for Parallel EP & US Patent Applications

## Topics

- EPO vs. USPTO: important differences to keep in mind when drafting patent claims and applications
- Recommendations for prosecuting an application through parallel grant procedures at the EPO and USPTO
- Avoid duplication of work through an optimised patent application
- Best practices for drafting an optimised EP and US Patent Application

**Save time  
and money!**

## Your speakers



**Thomas P. Canty**  
US Patent Attorney und US  
Attorney-at-Law,  
Leydig, Voit & Mayer,  
Frankfurt (Germany)



**Dr. Simone Haiber**  
European Patent Attorney,  
TRUMPF GmbH + Co. KG,  
Ditzingen (Germany)

# Best Practices for Parallel EP & US Patent Applications

## Aims and objectives

Those seeking to have a patent granted by the EPO and USPTO for the same invention face the challenge of satisfying different requirements for the two jurisdictions. For example, a claim granted by the EPO may have a different scope than one granted by the USPTO. Moreover claim amendments permissible at the EPO might be impermissible at the USPTO and vice versa.

You will save time and money by optimising your patent applications for both offices. By keeping in mind major differences, you can avoid duplicating work and achieve better results. Using concrete examples, our speakers will develop with you guidelines for preparing a patent application optimised for undergoing parallel procedures at the EPO and USPTO.

## Who should attend?

Do you work in a corporate patent/IP department or as a patent attorney in private practice and do you deal regularly with patent prosecutions before EPO and USPTO?

Then this course is designed for you. Knowledge on patents is assumed.

## What our participants say

- 'High practical relevance with regard to application draft and FTO analysis'  
(Patent Attorney)
- 'Very relevant content, well presented'  
(IP Manager)

## Your speakers



**Thomas P. Canty**  
US Patent Attorney und US  
Attorney-at-Law,  
Leydig, Voit & Mayer,  
Frankfurt (Germany)

Thomas advises Europe-based clients doing business in the United States on their IP matters. A focus of his practice is on US patent law which includes patent applications, post-grant proceedings, patent litigation and providing expert opinions. Thomas contributes a regular column on recent developments in US patent law to one of the leading German IP law journals.



**Dr. Simone Haiber**  
European Patent Attorney,  
TRUMPF GmbH + Co. KG,  
Ditzingen (Germany)

Simone is a European Patent Attorney and is active for the patents and licenses department of TRUMPF since 2008. Simone is involved in applying for patents worldwide, including application at the EPO and USPTO, for the provider of lasers and machine tools. She has gained much experience in drafting patent specifications that meet European as well as US requirements.

**14 May 2019, 09:00-17:00**

## **EPA vs. USPTO: the main differences in drafting US patent claims and the grant procedure at the USPTO**

- Procedural aspects
  - Official letter /office action
  - Appeal proceedings/after final practice
  - Unity/restriction; priority claims
- Formal aspects
  - Fees, number of pages, number of claims; renewal fees/annuities
  - Drafting: antecedent basis, two-part form, preamble
  - USPTO: duty of disclosure
- Substantive aspects/prior art
  - Inventive step: problem-solution-approach vs. obviousness
  - Description and sufficient basis/enablement and written description
  - Typical claim differences
  - Clarity and conciseness/distinct claiming
  - Claim interpretation and prosecution history estoppel
  - Non-technical subject matter/patent eligibility
  - Claim amendment (inadmissible extension)/added subject matter
  - Specification contents

## **Recommendations for parallel patent granting procedures at the EPO and USPTO**

- Drafting of patent claims
- Preparing the specification
- Prosecuting through parallel granting procedures

## **Best practices for drafting an optimised EP and US patent application**

- Lessons learned
- Avoiding duplication of work
- Repeated use of work results
- What an optimised patent application could look like

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## How to register

■ **Registration: +49 6221 500-500**  
■ **Conference no.: 19 05 183**

### ■ Date and venue

Tuesday, 14 May 2019 in Amsterdam  
09:00-17:00

DoubleTree by Hilton Amsterdam Centraal Station  
Oosterdokstraat 4 · NL 1011 Amsterdam  
Tel. +31 20 5300800 · Fax +31 20 5300801

### ■ Fee

€ 1180.00 (+ 21% VAT)

The fee includes course documentation (including  
free download) as well as refreshments, lunch and a  
certificate. You will receive an invoice as well as  
confirmation.

## Any Further Questions?



Please feel free to contact me if  
you have any questions.

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