



# Advanced Approaches for Protecting Patentable Ideas in the United States

February 18 - 19, 2009

**PRV**

SWEDISH PATENT AND REGISTRATION OFFICE

# Advanced Approaches for Protecting Patentable Ideas in the United States

## The seminar

A comprehensive 2 day-long program offering the latest information, insight and analysis into some of the more complex points of U.S. patent practice. The seminar is in cooperation with Mr. Richard R. Michaud, Esq. Managing Partner and Mr. John T. Duffy, Esq. Administrative Partner, Michaud-Duffy Group LLP - Intellectual Property Law.

## Who should attend

Patent attorneys, patent agents, senior patent paralegals and others working professionally with patents.

## Speaker

Mr. Richard R. Michaud, Esq. He is a founding member and the managing partner of the Michaud-Duffy Group LLP, a ten-lawyer international intellectual property law firm headquartered in Middletown, Connecticut. He maintains a broad and busy intellectual property practice and has extensive experience in all aspects of intellectual property law including foreign and domestic patent preparation, prosecution and litigation and in negotiating and drafting licenses. He is admitted to practice before the U.S. Court of Appeals for the Second Circuit, U.S. Court of Appeals for the Federal Circuit, U.S. District Court for the District of Connecticut. He is also admitted to the Bar of the State of Connecticut and is registered to practice before the U.S. Patent and Trademark Office.

## Venue

The Swedish Patent and Registration Office (PRV), Valhallavägen 136, Stockholm, Sweden.

## Registration

Registration for the seminar can be made online at [www.prv.se/kurser](http://www.prv.se/kurser). If you are interested in attending the seminar, please register no later than February 2, 2009. Please note that the seminar will be carried out only if a sufficient number of participants register.

## Accommodation

We can recommend:

1. Hotel Karlaplan, Skeppargatan 82, Stockholm, phone: +46 8 31 32 20.

Website: [www.hotelkarlapan.se](http://www.hotelkarlapan.se)

2. Hotel Mornington, Nybrogatan 53, Stockholm, phone: +46 8 507 330 00.

Website: [www.mornington.se](http://www.mornington.se)

You make your own reservation by phone or via the website. For present price state the reservation code: PRV.

## Information

For further information on this seminar, please contact: Ms. Inger Halvarsson (+46 8 782 28 84), e-mail: [inger.halvarsson@prv.se](mailto:inger.halvarsson@prv.se)

## Programme

The seminar will begin at 09.00 and end at 16.00 both days. Break for lunch will be around 12.00 - 13.15 each day, and there will be several short breaks during the days. After the seminar, on the 18th of February, a glass of wine and a light snack will be served.

- Part 1 Introduction/Foundations of U.S. Patent Law
  - Described in the U.S. Constitution
  - Substantive requirements for patentability
- Part 2 *Conflicts in U.S. and International Practice*
- Part 3 How PCT Practice Impacts Patent Filings in the U.S.
  - International stage: non-English PCT applications do not have a §102(e) date
- Part 4 Latest Developments in U.S. Law
  - Status of recently proposed USPTO Rule changes
  - Status of Patent Reform legislation in the U.S. Congress - computer-based methods patent
  - Obviousness after KSR INTERNATIONAL CO. v. TELEFLEX, INC., ET AL (U.S. Supreme Court)
  - "Doctrine of Equivalents", the FESTO case and beyond
  - Unusual applications - Patents that set industry standards
  - Status of business methods - available "safe harbors"
- Part 5 *Drafting Difficult Applications*
  - Drafting traps to avoid in U.S. practice
  - Matching the scope of claims to the scope of disclosure
  - Revising claims for U.S. practice
  - Preambles
  - Transitions - comprising essentially of:
    - \* Specific expressions
    - \* Negative limitations
    - \* Mathematical expressions

- \* Business methods – computer-based “safe harbor”
- \* Acceptable alternative language

Part 6 *Advanced Topics in U.S. Prosecution Procedure*

- General discussion of Translations, Inventors’ Declaration (which can be filed w/ PCT Application)
- Inventor’s declaration on filing; supplemental declaration
- Cases involving the death of inventor, recalcitrant inventor...
- Expediting U.S. patent examination:
  - \*Petition to make Special- based on inventor’s advanced age or poor health
  - \*“First-Action Interview Pilot Program” (for certain computer-related applications that were filed before November 2006 and that have not yet had a first action on the merits)
  - \*There is also a “fast track” for applicants with application pending in the U.S. and Japan;
  - \*Accelerated Examination requested upon filing with Examination Support Document, etc.

Part 7 *Ownership, Assignment and Related Issues*

- Apply in name of actual inventors - identifying inventors and co-inventors in the national stage
- Need for recorded assignment, even to employer. Legally, patent will issue to Applicants unless special request is filed under 37 CFR 3.81, which is optional
- Since the U.S. grants a patent based on the first to invent, evidence of co ception and reduction to practice is important (Among WTO member ountries, interference issues; corroboration issues, etc. arise)
- There are two different ways to enter the National stage: PCT-national stage 371, or Continuation from PCT
- Also, if one misses the 30 month deadline, it is still possible to file a Petition to Revive

Part 8 *Related Applications*

- Domestic priority Continuations, CIPs, Divisionals, Design/Utility
- CIPs with the possibility of different claims having different priority dates; terminal disclaimer practice. Contrast Divisional practice.
- Anticipation - statutory bars – in general, aspects of sales “in this

country” that can occur outside the U.S.

- Duty of Disclosure - applies to inventors and others; IDS as vehicle for disclosure
- IDS Timing requirements

Part 9 *Issued Patents:*

- Patent Term Extensions or Adjustments
  - \*for Delays within the USPTO under 35 U.S.C. 154
  - \*for Delays at other Agencies under 35 U.S.C. 156

Part 10 *Patent Infringement/Remedies/U.S. Courts/Conflict Resolution*

- Extraterritorial Effect
- Infringement of a process patent based on the importation, sale, offer for sale, or use of a product which is made from a process patented in the United States (35 U.S.C. § 295)
- Almost any effort to enforce or exploit patent invites possible invalidity challenge
- Infringement by joint infringers
- Earlier inventor defense limited to business methods (35 U.S.C. § 273)
- Statutory consequences of ADR (35 U.S.C. § 294)
- Legal Action for declaration of non-infringement
- Litigation -what to expect/ how to prepare for and assist U.S. counsel in ADR, Litigation
- Liability of State and Federal governments for patent infringement (35 U.S.C. § 296)

Part 11 *Business Considerations*

- Emerging use of Provisional Patents in the U.S.
- Favorable exchange rate
- Xerox model in staffing a corporate law department and applications to smaller firms
- IP audits and related procedures within companies

Part 12 *Essential Licensing Issues*

- Licensing issues - exclusive vs. nonexclusive; antitrust considerations; effect on litigation strategy
- Licenses are recordable (recommended for exclusive licensees)
- International case study

Conclusion *Review and Q & A*



The Swedish Patent and Registration Office (PRV), provides protection and exclusive rights for technological ideas, trademarks and industrial designs. We also give you the possibility to change your personal name, obtain a certificate for journals, or “periodicals” as they are also known. In addition, we offer commission services within in all our areas of operation. PRV also provides courses within the field of intellectual property.

PRV is a fee-financed central government agency that is based in Stockholm and Söderhamn. We have around 450 employees.

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