



Presented by
Management Forum

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

5-6 November 2025

This seminar 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:
Classroom



CPD:
12 hours for your records



Certificate of completion

Course overview

This practical and interactive 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 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 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 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

Programme

Day 1

Review of the similarities and differences in the statutory systems of the EPO and USPTO

- Legal aspects
- Procedures
- Formalities

'Best practices' for preparing one specification to comply with the European and US requirements for:

- Priority
- Added subject matter/new matter
- Industrial application/utility
- Novelty
- Inventive step/non-obviousness
- Description and sufficient basis/enablement and written description
- Claim clarity and conciseness/'distinct claiming'
- Limiting estoppel and implications of the AIA

EPO/US: Prosecution and appeal procedures

- Likely timelines and statutory deadlines
 - EPO
 - Euro-PCT
 - USPTO
- Burdens of proof
- Use of provisional and non-provisional applications
- Objections and rejections
- Non-final and final Office Actions
- Interviews
- Patent Office appeals
- Judicial appeals

EPO/US definitions of prior art and priority

- EPO
 - Article 54 definitions of 'state of the art'
- US
 - Definitions of 'prior art' for anticipation and obviousness

Day 2

EPO/US: Rejections and responses

- Inventive step (EPO) vs obviousness (USPTO)
- EPO/US: Strategies for persuading the Examiner and Board

Prosecution history estoppel in the US

- Estoppel variants
- Controlling the adverse impact of arguments to the USPTO
- Effect of representations made in corresponding, non-US applications
- Disclosure obligations after *Therasense*

Arguments on non-technical (EPO) and subject matter (US)

- Article 52(2), (3) exclusions – 'Technical'
 - Two hurdles
 - Potential technical effect T26/86 Koch & Sterzel
 - Computer program/signal claims
- Arguments to the USPTO after *Alice*
 - Abstract vs structural limitations
 - USPTO 'examination instructions'

Worked examples

- Delegates will be invited to analyse and modify sample applications suitable for the EPO and USPTO
- Delegates will be asked to develop effective arguments for the EPO and USPTO with respect to a series of hypothetical office actions

Plenary session

- Delegates and speakers will discuss the worked examples with the aim of optimising specifications acceptable to both the EPO and USPTO

Presenters



David Meldrum

David Meldrum has been in private practice since 1998 and joined D Young & Co in 2001 and became a partner in 2006. David practises in a variety of engineering disciplines including computer hardware and software, electronics, optics, nanotechnology, medical devices, automotive engineering and registered designs. He is experienced in all aspects of patent procurement including drafting specifications, international filing programmes and patent prosecution, and in portfolio management and competitor monitoring. He is a member of the Institution of Engineering and Technology (IET) and a member of the Institute of Electrical and Electronics Engineers (IEEE). David's clients include multi-national corporations and SMEs based in the UK, Europe and worldwide and he regularly presents IP lectures for clients and associates. He is a contributor to the D Young & Co Patent Newsletter.



Bradley Hulbert

Bradley Hulbert is a founding partner in McDonnell Boehnen Hulbert & Berghoff LLP, an 80-lawyer patent firm based in Chicago. Bradley has been lead counsel in a wide range of successful patent lawsuits and is an adjunct professor of law at the Chicago-Kent Law School.

Course date

5-6 November 2025

Classroom

London

Course code 15043

GBP **1,399** ~~1,599~~

EUR **1,959** ~~2,239~~

USD **2,247** ~~2,559~~

Until 01 Oct

How to book



Online:

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



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Discounts

- Booking more than one delegate on any one date qualifies for a **15% 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

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

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.

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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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