



Presented by
Management Forum

Navigating the EPO and the European Patent System - Summer School

15-19 July 2024

An intensive 5-day course that will give you a valuable insight and a comprehensive understanding of the European Patent Office processes.



Format:
Live online



CPD:
30 hours for your records



Certificate of completion

Course overview

This practical and highly interactive summer school will help all patent administrative staff in the competent preparation, application and defence of patents at the EPO.

Days one and two focus on the highly complex area and the procedural steps to be followed when preparing an application for filing before the EPO. The expert trainer will take you through the formalities procedures, including details of time limits and fee payments.

Covering electronic filing, transfer of rights, examination procedure, post-grant proceedings and an overview of PCT, these two days will deepen your understanding and enable you to be more efficient in your role.

Days three and four combine a full day of claim drafting fundamentals with a day of focussed workshops. *Attendees can choose to attend either a mechanical or chemical workshop.*

These intensive two days will help refine your drafting skills and master the art of successfully preparing and defending claims according to European practice. Covering key techniques to achieve adequate protection while meeting official requirements and analysing the crucial aspects of good description, amendment and interpretation will give you the edge in claim drafting.

Day five deals with the technicalities of Article 123(2), dealing with added subject matter, and Article 56, inventive step and the problem-solution approach.

Amendments made during the grant procedure to incorporate new prior art amount to added subject matter, which is often fatal in opposition procedure before the EPO and in nullity proceedings before national courts. The expert trainer will identify problems of added subject matter and show how they can be avoided.

The 'problem-solution' approach has been developed by case law and it is now hard to find a decision of the Boards of Appeal that don't rely on this to decide on inventive step. It's important to understand how to effectively use the problem-solution approach to gain an edge over other parties.

By attending this summer school, you will improve your knowledge and be better equipped and more efficient in your role. The course also offers the opportunity to network with like-minded professionals from other companies and question the expert trainers on the procedures.

Benefits of attending

By attending this seminar, you will:

- **Master** the art of competently preparing an application for filing before the EPO
- **Receive** guidance and insights on all the latest administrative aspects
- **Learn** which documents are required on filing
- **Understand** the procedural steps involved and how to complete them successfully
- **Get to grips** with prior art and inventive step
- **Learn** about the importance of achieving adequate protection in drafting
- **Review** the differences and compromises between European and US practice
- **Identify** and deal effectively with added subject matter
- **Understand** inventive step and the role of the problem-solution approach

Who should attend?

This summer school is relevant for all those who need a good understanding of the formal requirements of the European patent system, including:

- Patent administrators and patent formalities staff
- European patent attorneys
- Patent attorneys in private practice
- Corporate patent attorneys and lawyers
- People working or training in intellectual property
- US attorneys working in Europe
- Trainee patent attorneys
- Patent consultants and agents
- EQE candidates

Programme

Day 1

Module 1: The Formal Requirements of the European Patent System

Introduction to the European patent system

- History and development
- Organisation of the EPO
- Departmental responsibilities

The European patent application

- Documents needed on filing
- Accordance of a date of filing

The European patent application continued

- Formalities examination
- Missing parts of the description and missing drawings
- Case management

Practical exercise: Divisional application

Introduction to electronic filing

- Case management system
- Web-form filing

Procedure before the receiving section and search divisions

- Search report and search opinion
- Response to the search opinion
- Publication of the application

Fees

- Modes of payment
- Reductions
- Refunds

Practical exercise: Fee payment

Day 2

Time limits – notification

- Calculation
- Extensions
- Notification

Loss of rights – remedies

- Further processing
- Re-establishment of rights
- Transfer of rights

Practical exercise: Time limits

Substantive examination – examining division

- Formal procedures up to grant of the European patent
- Refusal of the application
- Withdrawal of the application
- Deemed to be withdrawn
- Accelerated examination

Post-grant proceedings

- Opposition
- Limitation
- Appeal

Overview of PCT

- Overview of the international phase
- Entry in the regional phase

Regional entry before the EPO as designated office

- EPO Form 1200
- Payment of fees
- Supplementary European search
- Substantive examination

Summary and questions

Day 3

Module 2: The Art of European Claim Drafting

Introduction

Know the invention

- Know the client
- Understand the invention
- Novelty
- The invention and the prior art
- Inventive step

Claim drafting fundamentals

- Clarity and clarity issues
- Claim scope
- Dos and don'ts

The importance of a good description

- Structure of the description
- Amendments and clarity
- Sufficiency of disclosure

Amendments

- Legal background
- In the priority year
- After filing
- Limitation
- Opposition
- Inescapable trap

Claim interpretation

- Art. 69 EPC
- Before and after grant
- EP vs US

International considerations

- US
- PCT
- Asia
- Drafting a global application
- PCT applications and priority pitfalls

Programme

Day 4

Module 3: Chemical or Mechanical Workshop - delegates choose which to attend

Chemical workshop

Chemical workshop - Introduction

- Warm-up exercises
- Chemical claim types

Chemical workshop - Further considerations for chemical drafting

- Exclusion from patentability
- Exceptions to patentability
- Parameters
- Selection inventions
- Disclaimers
- Inventive step vs sufficiency
- Sufficiency vs clarity
- Drafting to allow for future amendments

Chemical workshop - Claim drafting exercise

- Invention description
- Essential features
- Optional features
- Examples

Chemical workshop - Claim drafting exercise continued

- Technical effects
- Prior art
- Drafting independent claims
- Drafting dependent claims
- Drafting the description

Mechanical workshop

Mechanical workshop - Preparation phase

- Closest prior art selection
- Novel and inventive features
- Claim categories, technical fields

Mechanical workshop - Claim sketching

- Requirements of a patent
- Novelty
- Inventive step
- Clarity
- Essential features

Mechanical workshop - Claim drafting

- Functional claiming
- Mere juxtaposition of features
- One- and two-part claims
- Scope of protection. How broad?

Mechanical workshop - Dependent claims

- Claim trees
- Claim dependencies

Mechanical workshop - Drafting the description

- Support inventive step
- Create fall-back positions

Mechanical workshop - Exercises

- The problem-solution approach
- Closest prior art selection
- Claim categories
- Novelty and inventive features

Day 5

Module 4: Effective Defence of EPO Patent Applications

How to identify and deal effectively with added subject matter at the EPO – Article 123(2)

- Documents of reference for the application of Art 123(2)
- Decisions of the Enlarged Board of Appeal
- Tools available in order to assess added subject matter
- Main criterion directly and unambiguously derivable
- Examples of amendments not allowable under Art 123(2)
- Examples of amendments allowable under Art 123(2)
- Necessity to indicate amendments and their basis
- Added subject matter and clarity

How to identify and deal effectively with added subject matter at the EPO – Article 123(2) continued

- Other not-allowable cases of adding subject matter
- Broadening of features or intermediate generalisation
- Revision of the stated technical problem
- Prior art disclosed in the application/patent
- Divisional applications
- Correction of errors
- Added subject matter and extension of protection
- Disclosed and undisclosed disclaimers

Practical workshop: Exercises to exemplify the concepts learnt

Inventive step and how to master the problem-solution approach – Article 56

- Legal definition
- State of the art
- Obvious
- Problem-solution approach – identifying the nearest/closest prior art
- Formulating the objective technical problem

Inventive step and how to master the problem-solution approach – Article 56 continued

- Does the claimed subject matter solve the objective problem?
- Partial problems
- Aggregation/juxtaposition
- Mix of technical and non-technical features
- Deciding on inventive step and positive pointers

Practical workshop: Exercises to exemplify the concepts learnt

Recent case law and its implications for defending your EPO patent applications

- Notable decisions on inventive step

Presenters



Richard Gillespie

Richard Gillespie, European and Irish Patent Attorney and owner of Inventorship, an intellectual property advice and services company, has over fifteen years' experience in diverse technical fields (such as medical devices, computers, electronics, and telecoms) from his work at top tier patent practices in Dublin and London. He organises CEIPI tutorials for preparing Irish trainees to become European Patent Attorneys. He also tutors on European and Irish law relating to inventive step.

Richard is a qualified European and Irish patent attorney and a qualified design representative before the European Union's Intellectual Property Office (EUIPO). He holds a degree in computer and electronic engineering from Trinity College Dublin. While there he completed a research master's degree on the power consumption of CMOS binary multipliers, kayaked and played the guitar. During this time, he enjoyed teaching undergraduate laboratory courses in telecommunications.



Leythem Wall

Leythem Wall is a European and UK patent attorney and litigator specialising in the chemical, consumer products, energy, material, mechanical, medical and pharmaceutical sectors. Prior to founding Oxon IP, he was a Partner in major European and US Intellectual Property law firms, and before then in-house patent counsel for ExxonMobil and AkzoNobel. He has extensive experience in patent drafting, prosecution and particularly oppositions before the European Patent Office. Having worked in private practice and industry for European and US companies, he has significant knowledge of the US patent system, and how this compares with Europe.



Joeri Beetz

Joeri Beetz, Patent Attorney, Keltie LLP, specialises in patents in the fields of mechanical engineering, physics and control software. Amongst all the different technologies he has been extensively involved in are optical recording, medical devices, agricultural equipment, lighting, displays and automotive. He regularly represents clients in opposition procedures at the EPO, both to defend and to attack patents.

Joeri spent nine years in a Dutch patent firm based in Eindhoven, after five years of working at the in-house patent department of CNH Industrial. He joined Keltie in 2017. During his in-house period he managed a large patent portfolio for a broad range of different combine harvesters. At CNH Industrial, he built an extensive expertise in freedom to operate and patent infringement analysis and gained a keen insight in the commercial implications of different IP strategies.

In 2002, Joeri obtained his masters degree in physics at the University of Utrecht. In his final year at University, he built and tested equipment for testing particle detectors for the ALICE experiment at the Large Hadron Collider at CERN.

Presenters



Daniel X Thomas

Daniel X. Thomas is an electronics engineer by training. He started his career in the patent field as search examiner at the former Institut International des Brevets in The Hague in 1971. After incorporation of the IIB into the EPO in 1978, he was search examiner in the EPO's DG1. He joined the EPO's DG2 in 1979 as substantive examiner in the field of computers and memories. He became a Director in DG2 in 1989, and subsequently headed directorates in various fields of electronics, physics and mechanics.

Although he retired from active service at the EPO on 1 January 2013, Daniel continues to be active in the field of training patent specialists. He still regularly gives lectures at different universities over Europe, including CEIPI in Strasbourg, and also leads workshops/seminars relating to various aspects of the European granting procedure for the EPI and the Academy of the EPO, including preparation of candidates for the European Qualification Examination, and also 'grandfathers' for new Contracting States.

Course date

15-19 July 2024

Live online

09:00-17:00 **UK (London)** (UTC+01)

Course code 14379

GBP **2,499**

EUR **3,589**

USD **4,089**

How to book



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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.

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