



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:**  
Classroom



**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

## Classroom

London

Course code 14379

GBP **2,499** ~~2,999~~

EUR **3,599** ~~4,299~~

USD **4,119** ~~4,899~~

**Until 10 Jun**

## How to book



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