



Presented by  
**Management Forum**

# US Patent Practice

7-10 October 2025

What all European patent attorneys need to know - an intensive and highly interactive seminar including discussions on US patent law and strategies and tactics for patent prosecution at the US Patent Office



**Format:**  
Live online



**CPD:**  
12 hours for your records



Certificate of completion

# Course overview

## **The area of US patent practice can be complex and confusing. Are you up to date with the latest court decisions and best practice?**

This highly interactive seminar will give you a comprehensive understanding of the US patent system and enable you to work more effectively with your US counterparts. It will highlight the important differences between US and European patent practice and provide you with the opportunity for in-depth discussions about prosecution practice and procedure throughout the course.

The programme covers important tactics to get the most out of your prosecution dollar, and provides lots of claim drafting tips to give your application a solid footing for US prosecution and enforcement.

This event will bring you right up to date on the latest legislative changes under the America Invents Act (AIA), as well as all the recent and pending US Supreme and other court decisions of importance. You will also get to grips with current happenings in the USPTO that could impact on your role.

### **Key topics covered:**

- Legal framework
- Claim construction
- US patent prosecution practice and procedure
- The written description, enablement and best mode requirements
- Definiteness
- Statutory subject matter
- Novelty and prior art
- Obviousness
- Provisional and continuing applications
- Restriction practice and obviousness
- Type double patenting
- USPTO programs
- Patent Law Treaty implementation
- Duty of candor
- Infringement
- Patent litigation and damages

The balanced mix of theory, discussion and examples that the expert trainers use will give you a greater understanding of the cornerstones of US patent law and the main differences between US and EP patent practice.

The course will also give you the opportunity to ask and discuss your questions with the expert trainers.

## Why you should attend

This is a fantastic opportunity to take full advantage of the open seminar environment that this event offers. With a high degree of interaction with the expert trainers, as well as other participants, this is a great forum for discussing your particular questions and concerns.

Offering a wide-ranging and detailed understanding, this seminar covers what every European patent practitioner should know about US patent practice.

By attending this course you will:

- **Understand** claims construction rules and guidelines in the USPTO
- **Learn** about the interplay of enablement and with written description
- **Expand** your knowledge on the effect of the AIA
- **Get to grips** with the latest on judicial interpretation
- **Explore** obviousness and type double patenting
- **Examine** inventorship, joint inventorship and derivation actions
- **Clarify** post issuance practice
- **Consider** infringement: direct, contributory, extraterritorial and exhaustion
- **Master** the doctrine of equivalents
- **Get up to date** with the latest in litigation, damages and remedies

## Who should attend?

This course will be of particular help and interest for:

- Corporate patent counsel
- Patent attorneys from corporate and private practice
- Intellectual property consultants
- Patent managers and engineers
- Company legal advisers
- All those involved with patent protection in the United States

# Programme

## Day 1

### Legal framework

- Statutes and rules
- Courts and agencies
- Requirements for patentability

### Claim construction

- *Phillips* – broad multifaceted inquiry
- Claim construction rules and guidelines
- Claim construction in the USPTO

### US patent prosecution – general flow of events

#### Written description

- 'Possession' of claimed invention
- *Ariad* – increased focus on what inventors actually did
- Written description guidelines
- Negative limitations

#### Enablement

- *Wands* factors – to show whether the amount of experimentation necessary would be 'undue'
- Interplay with written description requirement

#### Best mode

- Effect of the AIA

## Day 2

### Definiteness

- *Nautilus* – the 'reasonable certainty' standard
- USPTO practice

### Means-plus-function claiming

#### Statutory subject matter

- Supreme Court jurisprudence
- USPTO guidance
- Court of Appeal

#### Utility

- Impossibility
- Judicial interpretation

### Patent Law Treaty implementation

#### Novelty and prior art

- Anticipation
- Pre-AIA – 'first to invent'
- Post-AIA – 'first to file'

## Day 3

### Obviousness

- *Graham* and *KSR*
- USPTO practice – *prima facie* obviousness
- USPTO *KSR* guidelines
- Method claims

### Provisional applications

- Pre-AIA vs post-AIA

### Continuing applications

- Continuations, divisionals, continuations-in-part

## Day 4

### Restriction practice

- Restriction requirement
- Restriction vs Election of Species
- Rejoinder

### Patent term and PTA

#### Obviousness – type double patenting

- *Gilead* cases
- Terminal disclaimers

#### USPTO programs

- Terminal disclaimers

### Patent Law Treaty implementation

#### Obviousness – type double patenting (continued)

- Accelerated examination, track one, patent prosecution highway
- First action interview, after-final consideration, pre-appeal brief request for review pilot programs

#### Duty of candor

- Citation of references
- Inequitable conduct

#### Inventorship

- Conception
- Joint inventorship
- Interference practice
- Derivation actions

#### Post-issuance practice

- Re-examination and re-issue
- *Inter partes* review
- Post-grant review
- Covered business method review
- Supplemental examination
- Certificates of correction

#### Infringement

- Direct infringement
- Contributory infringement and inducement
- Extraterritorial infringement
- Exhaustion

#### Doctrine of equivalents

- Function/way/result test
- *Festo* – prosecution history estoppel
- Licensing

#### Willfulness

- Opinions

#### Declaratory judgment

- Burdens of proof

#### Patent litigation and damages

- Remedies
- Entire market value
- Injunctive relief

# Presenters



## James Suggs

James V. Suggs is a partner in the intellectual property law firm McDonnell Boehnen Hulbert & Berghoff LLP, located in Chicago, where he practices patent law and serves as Chair of the firm's Chemical Practice Group. He applies his broad technical experience in a wide variety of chemical, polymer, materials science, pharmaceutical, optical, photonic, semiconductor and related technologies. He handles all facets of patent law, with an especial focus in patent procurement, strategic counseling, freedom-to-operate and due diligence opinions.

He also has an active inter partes review practice. His litigation experience includes federal district court and appellate practice as well as advocacy in forums such as the International Trade Commission, and spans a diverse range of technologies. He has experience with all kinds of clients, from large multinational corporations, to science-based startups, to academic research institutions, and works with law firms in Europe and worldwide to successfully prosecute their applications at the USPTO.



## Nicole Reifman

Nicole Reifman is a partner with McDonnell Boehnen Hulbert & Berghoff LLP, Chicago where she has gained diverse experience in obtaining, evaluating and enforcing intellectual property. She has experience in all phases of patent preparation and prosecution, and concentrates in representing clients in the mechanical and electrical arts, including drive train systems, medical devices, electromechanical, telecommunications and material sciences matters. She also has experience in all phases of patent litigation.

She provides counselling regarding the procurement, enforcement, and licensing of intellectual property rights, including trademark, trade secret and copyright issues. She actively manages trademark portfolios and develops brand building and protection strategies for her clients. She is also the Recent Developments Editor of the University of Illinois Journal of Law, Technology, and Policy.

# Course date

7-10 October 2025

Live online

13:30-17:00 **UK (London)** (UTC+01)

Course code 14984

GBP **1,199** ~~1,399~~

EUR **1,679** ~~1,959~~

USD **1,927** ~~2,239~~

Until 02 Sep

## How to book



**Online:**

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- 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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# Reviews



**Great course materials with plenty of detail which I can use in the future.**



**Sarah James**  
Patent Attorney  
Unilever  
Jun 13 2024



**The content, the presentation and the speaker were very good. All topics were presented in a clear manner.**



**MARIA LUISA MARCHESI**  
Italian Patent Attorney  
Eni SpA  
Dec 15 2022



**Excellent! Very good and helpful overview of US patent law with a focus on the differences to European law. I particularly liked the very interactive discussions.**



**Hendrik Freudenberger**  
IP Legal Advisor  
Sasol Chemie GmbH & Co. KG  
Dec 5 2019



**Very thorough and well presented.**



**Elisabetta Mauri**  
Director of Intellectual Property  
Dompé Farmaceutici SPA  
Dec 5 2019

## Run this programme in-house for your whole team

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