Patent Resources Group in Partnership with Management Forum

Claim & Specification Drafting for a Single EPO/USPTO Patent Application

I. Review of the Similarities and Differences in the Statutory Systems of the EPO and USPTO

A. Legal Aspects

B. Procedural Aspects

C. Substantive Aspects

D. Formal Aspects

II. 'Best Practices' for Preparing One Specification to Comply with the European and US Requirements for:

A. EPO "Priority" (initial claiming requirements)

B. EPO "Added subject matter" v. new matter

C. Claiming
- EPO claim "clarity and conciseness" v. distinct claiming
- EPO functional claims v. peripheral claims

D. EPO "Industrial application" v. utility

E. EPO "Technical effect" v. patentable subject matter

F. EPO "Novelty"

G. EPO "Description and sufficient basis" v. §112

H. EPO "Inventive step" v. nonobviousness

I. Limiting estoppel/disclaimer/disavowal

III. Best Practices Group Exercise

Attendees will be divided into groups to analyze, modify and prepare sample applications suitable for the EPO and USPTO. Attendees and faculty will discuss the worked examples with the aim of optimizing specifications for filing in both Europe and the US.