

III JORNADA DE PROPIEDAD INDUSTRIAL E INTELECTUAL: UNITED STATES PATENT AND TRADEMARK RULE CHANGES SEMINAR

The U.S. Patent and Trademark Office (USPTO) has proposed new rules that will fundamentally alter U.S. patent prosecution strategy. The new rules are intended to help the USPTO to issue higher quality patents faster. One effect is, however, for certain—they will place a greater burden on patent applicants. Directed to the three areas of claim examination, continuation practice, and prior art submissions, the new rules will:

- restrict the number of claims that will be initially examined,
- limit opportunities for continuing prosecution, and
- curtail when and how prior art may be submitted to satisfy the duty of candor, and place new limits on accelerated examination procedures.

This seminar will describe not only the requirements and implications of the new rules, but will teach strategies for operating most effectively in this new environment. Learning how to maneuver within the USPTO's new rule system will be crucial for anyone managing U.S. patent issues.

Besides the USPTO's new rules, this seminar will also cover additional developments that could impact U.S. patent practice, such as: efforts by the U.S. Congress to reform the governing U.S. patent law, and cases pending before the U.S. Supreme Court, which has agreed to hear a high number of patent cases in 2006.

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PROGRAM

- 09:30h – 10:00h Registration
- 10:00h – 10:15h Presentation
- 10:15h – 11:00h What—According to the USPTO—Caused this Mess?
- 11:00h – 11:30h Coffee
- 11:30h – 12:30h The New Rules for U.S. Prosecution
 - Examination of Claims
 - Limit of TEN claims for examination
 - “Examination Support Document” — the cost to having more claims examined
 - Continuation Practice
 - Limit to ONE continuing application (RCE, continuation, divisional, or continuation-in-part)
 - Ability to petition for further examination
 - Implications (or concerns) for related applications
 - Information Disclosure Statements
 - New framework of escalating disclosure requirements
 - “Explanations” and “Patentability Justifications” — when you will be forced to make them
- 12:30h – 14:00h Strategies for the New Environment
 - Take Action Now - Review Your Portfolio
 - Retroactive effect of new rules
 - Avoiding loss of rights
 - New Patent Applications
 - Crafting claim sets under the new regime
 - Submitting prior art: when and how to do it (with limited damage)
 - Prosecution Strategies
 - Avoiding estoppels
 - Balancing thorough and aggressive prosecution with the new limits on continuations and examination of claims
 - Effective use of the appeals process

Para más información llame al 902 43 18 68 – www.fundacionjosepons.org

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- 15:30h – 18:00h Other Significant Changes to U.S. Patent Practice
 - Efforts for Legislative Reform of U.S. Patent Law
 - Opposition proceedings, first-to-file, inequitable conduct
 - Recent U.S. Supreme Court Cases