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- Clifford Chance LLP
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- Kangxin Partners P.C.
- KattenMuchinRosenman LLP
- Kilburn & Strode
- Knobbe Martens Olson & Bear LLP
- R-O-Y-A-L Patent & Law Office

### Who Should Attend:

*Patent attorneys in private, corporate, or public agency practice, patent managers, inventors, and anyone dealing with international patent preparation and prosecution*

*A Comprehensive One-Day Workshop on Successfully Drafting*

# Multilateral Patents

How best to use the system internationally for preparation and prosecution featuring international speakers

June 23, 2008

San Francisco, California

Hotel 480 Union Square

**Credits:** CA MCLE 6.75 (call about others)  
**Quick when/where:** 8:30 a.m., 480 Sutter Street

### Multilateral Patents Workshop

June 23, 2008 | San Francisco, California  
 Hotel 480 Union Square

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08PATMLCA WS



**8:00 Registration and Continental Breakfast**

**8:30 Introduction and Overview**  
**Christopher J. Palermo, Esq., *Program Co-Chair***  
 Hickman Palermo Truong & Becker LLP ~ San Jose, CA  
**Gwilym V. Roberts, Esq., *Program Co-Chair***  
 Kilburn & Strode ~ London, United Kingdom

**8:45 Focus on Europe: Prosecution Trends; Analysis of Practice on Divisional Applications; Impact of the EPC Revision Act; The Effects of the London Agreement**  
 Formal requirements for the description and claims in the EPO; recent case decisions affecting how descriptions and claims should be drafted for success; EPO operational issues  
**Gwilym V. Roberts, Esq., *Program Co-Chair***

**9:30 Focus on Japan: Successful Preparation and Prosecution**  
 How the JPO determines lack of inventive step; how the description and claims should be drafted for success  
**David W. Hill, Esq.**  
 Finnegan Henderson Farabow Garrett & Dunner LLP  
 Reston, VA

**10:00 Focus on Korea: Successful Preparation and Prosecution**  
 Preparing specifications and claims to maximize patent protection in Korea; tips and strategies for expediting Korea patent prosecution  
**Kyungwan Park, Esq.**  
 R-O-Y-A-L Patent & Law Office ~ Seoul, Korea

**10:30 Break**

**10:45 Focus on China: Successful Preparation and Prosecution**  
 Perspectives and suggestions on patent prosecution in China; the current patent system and development trends of patent law in China  
**Samson G. Yu, Esq.**  
 Kangxin Partners P.C. ~ Beijing, China

**11:15 Fast Track Patenting**  
 Using new fast track programs including U.S. accelerated examination, Patent Prosecution Highway, and New Route, and similar efforts in other countries; risks; compare and contrast schemes - speed and effectiveness; impact on pendency, enforcement  
**Samson Helfgott, Esq.**  
 KattenMuchinRosenman LLP ~ New York, NY

**12:00 Lunch (on your own)**

**1:15 Key Industry-Specific Trends in Global Prosecution**  
 U.K. patent office is reviewing whether inventive steps is treated at different levels for different industries; other contrasts in the ways different countries treat different industries  
**Daniel E. Altman, Esq.**  
 Knobbe Martens Olson & Bear LLP ~ Irvine, CA

**1:45 Drafting Specification and Claims in a Multilateral Patent Application**  
 Can a U.S. application be drafted for later successful foreign prosecution with minimal changes in the specifications? Proposed form introduced; interactive panel addressing benefits and drawbacks; drafting issues; multiple jurisdiction claims  
**Christopher J. Palermo, Esq., *Program Co-Chair, Moderator***  
**Gwilym V. Roberts, Esq., *Program Co-Chair***  
**David W. Hill, Esq.**  
 Finnegan Henderson Farabow Garrett & Dunner LLP  
 Reston, VA  
**Kyungwan Park, Esq.**  
 R-O-Y-A-L Patent & Law Office ~ Seoul, Korea  
**Samson G. Yu, Esq.**  
 Kangxin Partners P.C. ~ Beijing, China

**3:30 Break**

**3:45 Interpreting Claims and Litigating Patents Overseas: Country-Specific Considerations**  
 Pre-filing considerations, discovery issues, trial procedures, remedies, and cultural issues of interpreting claims and litigating patents in the U.K., Germany, France, Netherlands, Japan and China  
**Gwilym V. Roberts, Esq., *Program Co-Chair, Moderator***  
**David W. Hill, Esq.**  
 Finnegan Henderson Farabow Garrett & Dunner LLP  
 Reston, VA  
**Samson G. Yu, Esq.**  
 Kangxin Partners P.C. ~ Beijing, China  
**Kyungwan Park, Esq.**  
 R-O-Y-A-L Patent & Law Office ~ Seoul, Korea  
**Eifion Morris, Esq.**  
 Clifford Chance LLP ~ London, United Kingdom

**5:00 Evaluations and Adjourn**



### About the Workshop

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*The seminar builds on last year's review of the increasing significance of the modern patent application description as it extends beyond considerations of enablement, support and basis for amendment, and carries ever more weight in interpreting patent claims. Major-market jurisdictions such as the European Patent Office, Japan, China and Korea have country-specific requirements for a description that will be successful both in prosecution and enforcement. Further, companies filing applications in multiple countries are constantly searching for methods of efficiency and maximum impact in multilateral prosecution taking into account the latest developments in international IP law and practice.*

*Our faculty will recap related legal and practice issues and enable attendees to understand the interplay of the specification and claims in several major jurisdictions, in light of an evolving legislative landscape, and in conjunction with a committedly practical review of how best to use systems internationally. The day will culminate in a discussion and redrafting of an actual patent specification for a simple mechanical invention, covering best practices for drafting the same description for success in multiple countries, and will answer questions such as: Can a multilateral application satisfy the EPO "problem-solution" approach without unduly limiting the claims elsewhere? How do jurisdictions differ on claim interpretation? What particular statements could broaden the scope of equivalents? What statements are unintentionally limiting?*

~ Program Co-Chairs: Christopher J. Palermo, Esq. and Gwilym V. Roberts, Esq.



**Christopher J. Palermo**, *Program Co-Chair*, partner at Hickman, Palermo, Truong and Becker, LLC, concentrates on patent, trademark, licensing, and technology development matters. He primarily advises companies in the fields of networking, telecommunications, object-oriented software and the World Wide Web. He was named a Super-Lawyer in Intellectual Property in *Northern California Super Lawyers 2007*.

**Gwilym V. Roberts**, *Program Co-Chair*, partner with Kilburn & Strode, London, practices as a Chartered Patent Attorney, European Patent Attorney and certified Patent Agent Litigator. His focus is in the physics, computing and communications fields, addressing worldwide patent filing strategies, problems of capturing and exploiting IP with a special interest in basic mechanics of patent drafting. He wrote *A Practical Guide to Drafting Patents* published by Sweet & Maxwell.

**Daniel E. Altman**, partner at Knobbe Martens Olson & Bear LLP, focuses on patent protection and related licensing issues, for the biotechnology, pharmaceutical and chemical industries, specializing in foreign patent protection. He is an adjunct professor at the University of San Diego School of Law and has spoken on patent law in the United States and abroad.

**Samson Helfgott**, partner and director of patents at KattenMuchinRosenman LLP, focuses on domestic and international patent, trademark and copyright matters, international patent strategy and patent and trademark administration.

**David W. Hill**, partner at Finnegan Henderson Farabow Garrett & Dunner LLP, focuses on patent and trademark litigation, prosecution, licensing negotiations, dispute resolution, and portfolio management. He opened the firm's Tokyo branch office and spent three years in Japan as the resident partner of the firm.

**Eifion Morris** is a partner in the London law firm of Clifford Chance LLP.

**Kyungwan Park** is a senior partner and patent attorney in the firm of R-O-Y-A-L Patent & Law Office. He provides practical information on Korean patent litigation and prosecution matters.

**Samson G. Yu**, managing partner at Kangxin Partners P.C., focuses on all aspects of Intellectual Property law specializing in patent and trademark prosecution, trademark clearance, intellectual property due diligence, litigation and client counseling. He is a frequent lecturer on Intellectual Property issues internationally.



## Registration & Other Workshop Information

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that time, we will credit your tuition toward attendance at another program or the purchase of a Homestudy. There is a \$25 cancellation fee for Course Materials orders and \$50 for Homestudy orders.

**Seminar Location:** The workshop will be held at the Hotel 480 Union Square at 480 Sutter Street in San Francisco, CA 94108. Call the hotel directly at (415) 398-8900 for reservations at the special negotiated rate of \$249 and mention that you are attending a Law Seminars International workshop. Rooms are on a first come, first served basis.

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## You Will Learn About:

- Successful international patent preparation and prosecution
- Managing multilateral patent procurement
- Selecting foreign jurisdictions most appropriate for patent applications
- Fast track patenting
- Industry specific trends in global prosecution
- Drafting specification and claims in a multilateral patent application
- Country-specific considerations for litigation overseas

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[kate@lawseminars.com](mailto:kate@lawseminars.com)

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Technology Law	July 10 & 11, 2008	Boise, ID
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