



FICPI SWEDEN

Invitation

FICPI SWEDEN is the Swedish part of FICPI which is an international organization, with members from more than 80 countries. FICPI works for patent and trademark attorneys in the free profession, with issues relating to their daily work as well as IP law issues on a global scale.

The membership in FICPI SWEDEN, which is prerequisite for membership in FICPI International, provides a global network of IP professionals, and a possibility to understand and participate in the development of IP law throughout the world.

FICPI SWEDEN runs regular seminars in Sweden focusing on current issues and trends in IP. The speakers are normally FICPI members from other countries of the world. The seminars are open for all, but FICPI members enjoy a reduced registration fee.

On this occasion, we will deal with the possibilities of making claim amendments during prosecution of a patent application, before grant, or once a patent has already been granted. When drafting a patent application, a diligent patent attorney analyzes the prior art, but it is still a frequent situation that additional prior art is found after filing the application, often after a relatively long period of time. Then, we face the challenge of limiting the scope of the claims whilst protecting the foreseeable embodiments of the invention. In virtually all jurisdictions, such amendments requires support in application as filed. However, the law and practice varies across the jurisdictions. At the seminar, we will try to find out whether there are any significant differences.



Seminar on Admissible Claim Amendments in Europe, Japan, US and India

Date: Thursday 12 February, 2015

Venue: Westmanska Palatset, Room "Bryggarkungen", Stockholm

Attractive price: 2500 SEK (1500 SEK for FICPI members), including lunch

Informal mingling and refreshments after seminar (optional, 300 SEK)

See attached general information and detailed Program:



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General Information

Date:

Thursday 12 February, 09.00 – 17.00, followed by optional mingling

Venue:

Westmanska Palatset, Room “Bryggarkungen”, Holländargatan 17, Stockholm, Sweden
(see www.westmanskapalatset.se)

Hotels:

Please book a hotel room directly with the hotel. There are several hotels nearby, and also near the Arlanda Express Railway station, in different price categories: Frey’s Hotel, Radisson Blue Royal Viking Hotel, Radisson Blue Waterfront Hotel, Rica Hotel, Hotel Terminus, Best Western Hotel Bentleys, Nordic Sea Hotel, Clarion Hotel Sign, Tegnerlunden, Queen’s Hotel, Kungsbron Hotel, Scandic Norra Bantorget.

See e.g. www.booking.com (hotel at Normalm, Stockholm)

Registration:

You just send an email to info@ficpiseden.se. Please indicate:

your name and invoice address,

whether you are a FICPI member (individual member or member of a national group), and

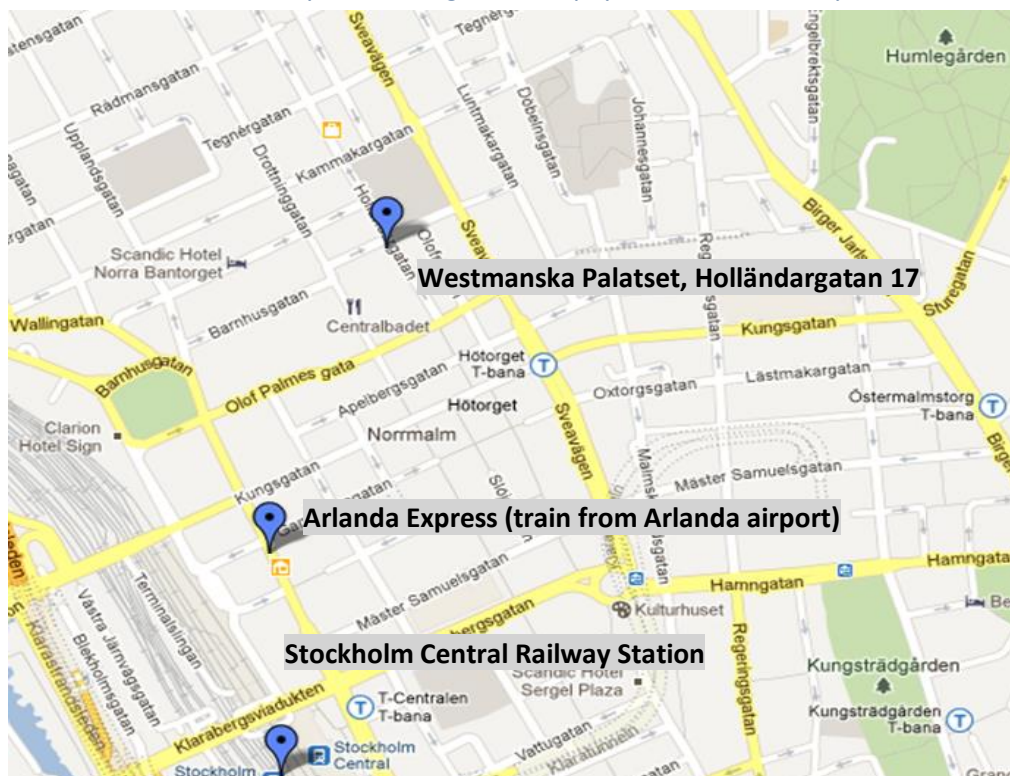
whether you wish to participate in an optional mingle with refreshments after the seminar at 17.00 – 18.30, extra charge 300 SEK

Price:

2500 SEK (1500 SEK for FICPI members), including lunch

300 SEK, optional mingle with refreshments.

An invoice will be sent to you after registration, payment within 10 days.





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Program:

08.30 – 09.00 **Registration at Westmanska Palatset, Holländargatan 17
Room "Bryggarkungen"**

09.00 - 09.15 **Welcome address**
Lars Thyresson, President, FICPI Sweden

Introduction to topics and speakers
Jan Modin, Moderator, Program Manager, FICPI Sweden

Applicable Law and practice at EPO – admissible claim amendments
(the laws in Germany, UK and Sweden being aligned with EPC,
there will be no presentations on those laws)

09.15 – 09.30 Jérôme Collin, Cabinet REGIMBEAU, Paris, France:
"Applicable EPC provisions and Guidelines"



09.30 – 09.45 Alfred Spigarelli, Director Patent Procedures
Management, EPO
"EPO practice as regards Art 123(2) EPC"



Applicable Law and practice in Japan

09.45- 10.05 Hirohito Katsunuma, Kyowa Patent and Law Office, Tokyo, Japan
"Applicable law and practice at JPO in respect of
claim amendments"



Applicable Law and practice in the US

10.05 – 10.25 Alan J. Kasper, Sughrue Mion, PLLC, Washington D.C., USA
"Post grant amendments at the USPTO under AIA"



Applicable Law and practice in India

10.25 – 10.45 Esseneese Obhan, Obhan & Associates, New Delhi, India
"What claim amendments are permissible under the Patents
Act, 1970 and the Patents Rules, 2003?"



10.45 – 10.55 **Short break**



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Example No. 1 “Intermediate Generalization”

Consider the case of a patent application with an initial claim 1 having a generic form covering three embodiments which are described in the description of the patent application. If this initial, generic claim is not accepted by the Examiner, consider now the situation where the applicant files an amended claim 1, covering one of the three embodiments (say, embodiment 3), but having a scope which is broader than the described embodiment. Amended claim 1 covers embodiment 3, but also some variations of this embodiment. Is this amendment acceptable? Or does it add subject matter into the patent application? Is this a case of a so-called ‘intermediate generalization’?

10.55 – 11.20 Presentation of the above example by Jérôme Collin, followed by comments by Alfred Spigarelli whether the amendment would be accepted by the EPO, and further comments by Hirohito Katsunuma as to the likely assessment of this issue by the JPO.

11.20 – 11.45 Discussion of this example, including comments by the other panel members, including Alexander Wyrwoll, at the firm Winter, Brandl, Munich, Germany, and Simon Rees, UK, followed by questions and observations from the audience, if time permits.



Example No. 2 “Amendment based on drawing”

This example relates to an amendment which is based on subject matter taken mainly from a drawing, without any explicit support in the text as filed for the wording used in the amended claim. This example explores the extent to which drawings can be used to support claim amendments. In addition, this example explores whether an amendment is permissible if the wording of the amended claim is indeed supported or derivable from the drawing, but where the wording might also cover other embodiments which are not explicitly disclosed.

11.45 – 12.30 Presentation of this example by Simon Rees, Haseltine Lake LLP Bristol, UK, followed by comments from the other panel members and a general discussion. To what extent is it possible to rely on support in the drawings when making claim amendments? Will features which are not unambiguous always be regarded as “new matter”?



12.30 – 13.30 Lunch (at Westmanska Palatset)



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Moderator after lunch: Lennart Karlström, Vice President, FICPI Sweden

Example No. 3 “Implicit support”

A method for charging vehicle batteries that are connected in series, which is particularly advantageous in cold weather. The question is whether addition of the phrase “in response to the battery temperature” to claim 1 is an allowable amendment. There is no literal support for the phrase in the application as filed.

13.30 – 14.15 Presentation of this example (a real case) by Jens Waltin, senior Patent Examiner at the Swedish Patent and Registration Office, PRV, followed by comments from other panel members and a general discussion.



Example No. 4 “Prioritization of certain mode of operation” – post grant amendment in the US

An original patented claim to a method of operating a vehicle air conditioning system based on engine power and, when the engine is not running, with alternative power, specifically stored electric power, was determined to be anticipated during an *inter partes* review procedure. A post grant claim amendment was proposed by the patent owner to further define the prioritization of the use of shore power over battery power (amendments underlined):

A method of operating a vehicle air conditioning system, the vehicle having an engine, to provide engine on and engine off operation, comprising the steps of: operating the air conditioning system with at least electric power generated as a result of the engine running when the engine is running and stored electric power from a battery is available; [and] operating the air conditioning system with stored electric power from the battery when the engine is not running; and upon simultaneously receiving at the air conditioning system electric power from the battery and shore power to run the air conditioning system, automatically prioritizing use of shore power over battery power.

The claim was not broadened and adequate support for the amendment in the original disclosure could be demonstrated. The critical issue for acceptance of the claim amendment involved the ability of the patent owner to demonstrate patentability of the amended claim.

14.15 – 15.00 Presentation of the above example by Alan J. Kasper, Sughrue Mion, PLLC, Washington D.C., USA, and comments from other panel members, and a general discussion





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- 15.00 – 15.30** **Coffee/Tea break**
- 15.30 – 16.45** **Panel discussion with all speakers:**
- Jérôme Collin, FR**
Alfred Spigarelli, EPO
Alexander Wyrwoll, DE
Simon Rees, UK
Jens Waltin, SE
Hirohito Katsunuma, JP
Alan Kasper, US
Essenese Obhan, IN
- Further comments on the above four examples, identifying significant similarities and differences across the various jurisdictions and at the Offices, questions and observations from the audience, and a general discussion**
- 16.45 – 17.00** **Briefing of upcoming FICPI meetings:**
Congress in Cape Town
Next FICPI Sweden seminar
- 17.00** **End of seminar**
- 17.00 – 18.30** **Optional mingling with refreshments at Westmanska**

