

## 2011 專利申請書撰寫技巧及權利完全保護策略

Patent Application Drafting and Infringement Avoidance Strategies (PADIAS)

3 months (10 weeks) -- 17classes, 34 hours (Taipei)

### 2011 訓練課程 (台北)

■說明：

企業創新與研發成果能否完全保護、充分應用及獲利，此與研發工程師之創新理念是否能藉由專利申請書適切之展現以及專利說明書撰寫之品質是息息相關的！為提昇科技產業專利說明書撰寫技巧及使研發工程師與專利工程師或專利代理人之間溝通順暢，並提升專利品質，本會特邀請具有專利說明書撰寫豐富經驗及實務之 Lowe Hauptman Ham & Berner LLP 事務所知名專家，傳授如何將科技與法律高度靈活運用結合，並展現於專利說明書撰寫中，使企業智財權得以獲得最大權益之精采實務課程。

■主辦單位：中華民國全國工業總會、財團法人資訊工業策進會科技法律研究所、財團法人工業技術研究院、Lowe Hauptman Ham & Berner LLP(LHHB)、財團法人亞太智慧財產權發展基金會(APIPA)共同主辦。

■協辦單位：Franklin Pierce Law Center 台灣校友會。

■講師：Mr. Benjamin J. Hauptman、Mr. Yoon S. Ham、Mr. Randy A. Noranbrock and Dr. Sean A. Passino (講師簡歷詳如附件 2)。

■時間：2011 年 3 月 7 日起三個月(課程表詳如附件 1)。

■地點：台北-中華民國全國工業總會 9 樓第一會議室([台北市復興南路一段 390 號](#))。

■費用：原價每位 NTD50,000 元整，2 月 14 日前報名繳費或同機構 3 位以上報名，優惠每位僅收 NTD30,000 元。

■結業證明：全程參與之學員，美國 Franklin Pierce Center for IP 將頒發證書。

■名額：預計 35 名，依報名並繳費順序，額滿為止(報名表詳如附件)。若報名人數未達 25 位時，本課程將取消並辦理退款，請知悉。

■適合對象：研發人員、企業、專利事務所專利工程師，具理工、生技、醫農相關背景者尤佳。

■報名方式：請填妥下列報名表致本會 陳宥汝 經理 TEL：03-5919082，以傳真(03-583-3325)或 e-mail：[YHChen@apipa.org.tw](mailto:YHChen@apipa.org.tw)。

■PADIAS 結業學員推薦：

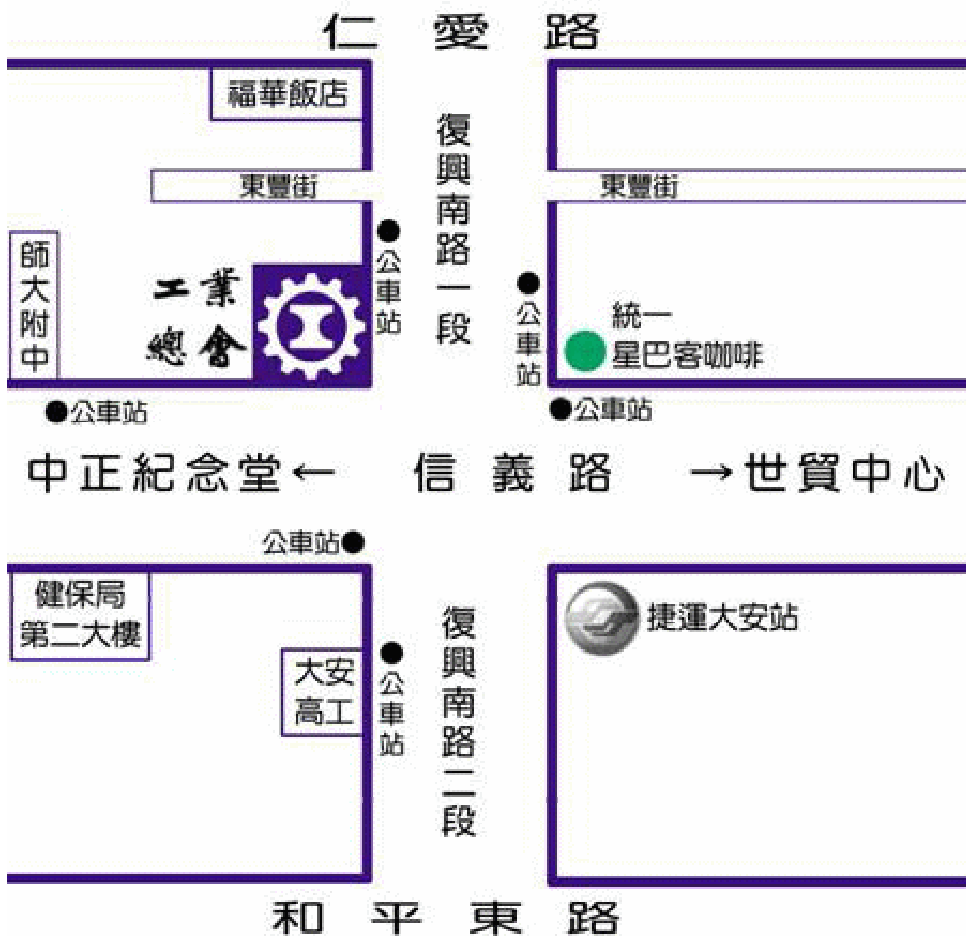
2010 學員 Doris Tsai  
(專利工程師)

整體來說，本次課程內容豐富，收穫良多  
主要學習撰寫美國說明書應該注意的事項，以及如何變化各種不同種類的權利項寫法，用以如何完整保護發明內容。  
並學習克服 OA 中常見之新穎性核駁及非顯而易見性核駁如何克服。

2010 學員 Amy Ou  
(專利工程師)

PADIAS 專利課程，除了讓我了解如何更完善的撰寫結構完整的專利之外，  
也幫助了我更能掌握專利分析的 Key point，  
以及更了解美國專利法的組織與架構，是個很值得參加的課程。

■全國工業總會交通位置圖：



捷 運：木柵線大安站下車      停車場：大安高工公有停車場、建國南路停車場、農會停車場（東豐街）  
公 車：復興南路、信義路口站（0 東、信義幹線、20、22、38、74、226、278、41、204、265）

## 2011 專利申請書撰寫技巧及權利完全保護策略 (台北)

## 報名表

(請工整填妥 fax:03-583-3325)

服務機構	機構名稱			
	統一編號		承辦人姓名	
	聯絡地址			
	聯絡電話(必填)		傳真	
參加人員	姓名	服務部門	職稱	e-mail(必填)
費用	<input type="checkbox"/> NTD30,000	2月14日前報名繳費或同機構3位以上報名,每位優惠價。		
	<input type="checkbox"/> NTD50,000	定價/每位(含點心、便當、講義、證書)。		
繳費方式	請勾選繳費方式：			
	<input type="checkbox"/> 信用卡 卡名： <input type="checkbox"/> VISA <input type="checkbox"/> MASTER <input type="checkbox"/> JCB <input type="checkbox"/> U CARD 發卡銀行：_____ 卡號：_____ 信用卡簽名欄末三碼： <input type="checkbox"/> <input type="checkbox"/> <input type="checkbox"/> (自2005/4/01起聯合信用卡處理中心要求必須提供的資料) 信用卡有效截止日期：____年____月 持卡人姓名：_____ (請以正楷書寫) 持卡人簽名：_____ (與信用卡上簽名一致) 持卡人身分證字號：_____ 付款總額：新台幣_____ (請填具阿拉伯數字) 銀行對 APIPA 授權號：_____ (此欄請勿填寫)			
發票資料	<input type="checkbox"/> 銀行匯款			
	戶名：財團法人亞太智慧財產權發展基金會；銀行：土地銀行南港分行 帳號：004001146985；若是由ATM轉帳，土地銀行代碼：005 匯款後請將單據影本連同報名表傳真至03-5833325 企推處 陳宥汝經理(單據影本的資料須清楚)			
附註	發票抬頭：			
	發票種類： <input type="checkbox"/> 二聯式 <input type="checkbox"/> 三聯式 統一編號：			
1. 費用收訖後，報名始完成。 2. 報名後若未克出席，恕不退款，但可改換他人替代，並請於上課兩日前通知本會作業。 3. 主辦單位得保留課程變更之權利。 4. 若報名人數未達25位時，本課程將取消並辦理退款，請知悉。				

Attachment 1 (Schedule)

Patent Application Drafting and Infringement Avoidance Strategies (PADIAS) in Taipei  
 3 months (10 weeks) -- 17 classes, 34 hours (Taipei)

**Objectives:**

- Deliver lectures regarding details of US patent system, including patent application drafting; amendment preparation (both first office action and final rejection); appeal brief preparation; infringement and invalidity opinion preparation.
- Prepare two fully drafted patent applications.
- Prepare at least one Amendment in response to an Office Action from the USPTO.
- Review full patent prosecution proceedings from first to final responses and appeal based on actual case studies involving the above patent applications.
- Mock interviews with U.S. patent examiner and inventors

Day	Class	Time	Subject	Assignment
Home Assignment		Handout: First Application Invention Disclosure Homework: Draft one independent claim and 2-4 dependent claims for first application. DUE: Three days prior to Class 1.		
March 7 Monday		9:00-9:30	<ul style="list-style-type: none"> <li>• Opening Remark</li> </ul>	
	1	9:30-12:00	<ul style="list-style-type: none"> <li>• Lecture: Overview of US patent system review parts of a patent application; explain statutory requirements of patentability Application drafting - detailed explanation of the purpose of each part (title, technical field, cross reference to related applications, background, summary, detailed description, claims, abstract and drawings) of the patent application based on existing case law, including detailed drafting strategies</li> </ul>	
	2	13:00-14:30	<ul style="list-style-type: none"> <li>• Lecture: Application drafting (continued from class 1); conduct mock inventor interview</li> <li>• Handout: Application drafting checklist</li> </ul>	
	3	14:30-16:30	<ul style="list-style-type: none"> <li>• Lecture: Application drafting (continued from class 2); Inventorship identification and correction of inventorship; detailed discussion and analysis of claims (graded by faculty but does not count toward grade)</li> <li>• Handout: corrected claim set for first application</li> </ul>	
		16:30-17:00	<ul style="list-style-type: none"> <li>• Quiz / Q &amp; A session</li> </ul>	

March 8 Tuesday	4	9:00-11:00	<ul style="list-style-type: none"> <li>Lecture: Advanced Patent Application Drafting practice- advanced claim drafting topics such as claim trees, dependent claims, means plus function limitations, Laitram, In re Donaldson, Halliburton, unnecessary claim limitations.</li> </ul>	
	5	11:00-12:00 13:00-14:00	<ul style="list-style-type: none"> <li>Lecture: continuation of advanced claim drafting topics-Jepson claims, Markush claims, redrafting European claims to U.S. format; after arising technology</li> </ul>	
	6	14:00-16:00	<ul style="list-style-type: none"> <li>Lecture: discussion of advanced specification drafting topics; written description, enablement, best mode requirements; listing of advantages; strategies for drafting complex patent specifications.</li> <li>Handout: specification drafting checklist</li> </ul>	Homework: Preparation of a complete patent application based on First Application Disclosure.
	16:00-17:00		<ul style="list-style-type: none"> <li>Quiz / Q &amp; A session</li> </ul>	
4 weeks home assignment	<p>All students will have three weeks to draft a complete patent application based on the first application invention disclosure. The completed applications will be sent by e-mail to the faculties.</p> <p>Between Class 6 and Class 7, the faculties will review and mark up each student's application with detailed stylistic and substantive changes in the same manner as he would review an associate's work product. The faculties will then provide each student with an anonymous 'marked up' copy of everyone's application. These marked up applications will then be the subject of discussion in Class 7. It is the standard of the detailed review in conjunction with the sharing of similarly extensively revised copies of everyone's work product which both enhances and accelerates the learning process of patent application drafting because each student sees not only what they did correctly or incorrectly, but also (anonymously) what their fellow students did. What happens is that the student learns, on an accelerated learning curve, the right way and the wrong way of drafting each application.</p>			

April 11 Monday	7	9:00-12:00	<ul style="list-style-type: none"> <li>• Discussion: analysis of students' first application; detailed section by section analysis of all applications to identify acceptable practices and potential problems associated with poor drafting. All applications reviewed will not have the students name so no one will be embarrassed.</li> <li>• Handout: corrected/graded first patent application; Second Application Invention Disclosure</li> </ul>	Homework Due: draft one independent claim and 2-4 dependent claims for Second Invention disclosure
	8	13:00-15:00	<ul style="list-style-type: none"> <li>• Lecture: Detailed discussion of first office action and amendment practice in response to first office action; anticipation and non-obviousness and 35 USC 112 practice.</li> <li>• Handout: corrected claim set for second application; actual patent for first invention; first office action rejection of actual patent claims with applied references.</li> </ul>	Homework: Preparation of First Amendment in response to first office action.
	9	15:00-16:00	<ul style="list-style-type: none"> <li>• conduct mock inventor interview for second invention</li> </ul>	
	16:00-17:00		<ul style="list-style-type: none"> <li>• Quiz / Q &amp; A session</li> </ul>	
April 12 Tuesday	10	9:00-11:00	<ul style="list-style-type: none"> <li>• Lecture: Review draft claims for second invention.</li> </ul>	
	11	11:00-12:00 13:00-14:00	<ul style="list-style-type: none"> <li>• Lecture: detailed study of Appeals Practice &amp; Procedure; overview of Pre-Appeal Conference Request and Practice Tips.</li> </ul>	
	12	14:00-16:00	<ul style="list-style-type: none"> <li>• Lecture: KSR, Rule 131, and Rule 132 secondary consideration practice</li> <li>• Handout: checklist for preparing Rule 132 declarations</li> </ul>	Homework: Preparation of a complete patent application based on Second Application Invention Disclosure and revised claims
	16:00-17:00		<ul style="list-style-type: none"> <li>• Quiz / Q &amp; A session</li> </ul>	

4 weeks home assignment		<p>All students will have three weeks to complete a full patent application based on the second application invention disclosure. The completed applications will be sent by e-mail to Professor Hauptman.</p> <p>Between Class 12 and Class 13, Professor Hauptman will personally review each student's application and mark it up with detailed stylistic and substantive changes in the same manner as he reviewed the students' first applications.</p>		
May 9 Monday	13	9:00-11:00	<ul style="list-style-type: none"> <li>• Discussion: analysis of students' second application; detailed section by section analysis of all applications to identify acceptable practices and potential problems associated with poor drafting.</li> <li>• Handout: corrected/graded second patent application.</li> </ul>	
	14	11:00-12:00 13:00-14:00	<ul style="list-style-type: none"> <li>• Lecture: Infringement Analysis, Literal and DOE.</li> <li>• Lecture: Strategic claim drafting and prosecution strategies to minimize or avoid Festo effect.</li> </ul>	
	15	14:00-16:00	<ul style="list-style-type: none"> <li>• Lecture: Strategic claim drafting and prosecution strategies to minimize or avoid Festo effect. (continued)</li> <li>• Lecture: Designing around valid U.S. Patents</li> <li>• Handout: Festo analysis chart.</li> </ul>	
	Take Home Final Exam		<ul style="list-style-type: none"> <li>• Final Exam</li> </ul>	
May 10 Tuesday	16	9:00-11:00	<ul style="list-style-type: none"> <li>• Lecture: Software and Section 101; Ex parte Bilski and most recent cases</li> </ul>	
	17	11:00-12:00 13:00-14:00	<ul style="list-style-type: none"> <li>• Lecture: Claim construction in recent cases.</li> <li>• Lecture: Examiner-based patent prosecution strategies.</li> </ul>	
	14:00-16:00		<ul style="list-style-type: none"> <li>• Survey</li> <li>• Graduation</li> </ul>	

Instructors will be assigned from the group consisting of Benjamin J. Hauptman, Yoon S. Ham, Randy A. Noranbrock, and Dr. Sean A. Passino of Lowe Hauptman Ham & Berner, LLP.

## Attachment 2 (Speaker Bio)

### **Mr. Benjamin J. Hauptman**



Mr. Hauptman has practiced for more than 20 years in the fields of patent and trademark matters, including preparing and prosecuting patent applications in the complex mechanical and electrical arts, and in counseling clients in all aspects of intellectual property protection, including enforcement and infringement of intellectual property rights. In particular, Mr. Hauptman has had extensive experience in all patent prosecution aspects of semiconductor and display technologies, automotive, laser machining and complex mechanical and instrumentation arts. Mr. Hauptman is also an Adjunct Professor of Law at the Franklin Pierce Law Center where he lectures on intellectual property topics, with emphasis on patent applications and infringement opinion drafting. Mr. Hauptman is also a Professor of Law at the National Law School of India University in Bangalore, India.

Mr. Hauptman holds a Bachelor's Degree in Engineering from the Massachusetts Institute of Technology and a Juris Doctor Degree from the Franklin Pierce Law Center. He is admitted to practice in the District of Columbia and Virginia, and before the U.S. Court of Appeals for the District of Columbia Circuit, U.S. Court of Appeals for the Federal Circuit, U.S. District Court, Eastern District of Virginia and the U.S. Patent and Trademark Office.

Mr. Hauptman serves as coordinator of and lecturer at the Firm's intellectual law seminars presented from time to time for foreign practitioners both in the United States and abroad. He also works closely with foreign associates in obtaining worldwide patent protection. Mr. Hauptman is also primarily responsible for the training of foreign trainees (e.g., from Japan, Korea, China, and Vietnam) who train within the Firm on a regular basis, often in satisfaction of their masters in intellectual property (M.I.P) degree from Franklin Pierce Law Center in Concord, New Hampshire. He is also a member of the Advisory Committee on Intellectual Property, Franklin Pierce Law Center and the Brooklyn Technical High School Research Foundation. Mr. Hauptman's Professional associations include the Virginia State Bar Association (Member Intellectual Property Law Section), American Intellectual Property Law Association, Patent and Trademark and Copyright Research Foundation, and International Association for the Protection of Industrial Property.



## Mr. Yoon S. Ham



Yoon S. Ham concentrates his practice in the area of intellectual property law, including prosecuting United States and foreign patents, patent litigation, intellectual property licensing, and preparing opinions on patent validity and infringement. He counsels clients on the protection, enforcement, licensing and acquisition of patent, trademark, copyright, and other intellectual property rights. In connection therewith, Mr. Ham conducts negotiations and prepares agreements and relating documents. Mr. Ham also has extensive experience in negotiating technology licensing, distribution and supply agreements as well as other types of international commercial contracts. His clients include international Fortune 500 companies as well as small emerging technology and manufacturing companies in electronics, telecommunications, computer software and hardware, metal, optical, and consumer goods industries. Mr. Ham helps those clients define and protect their intellectual property while exploiting its competitive advantage. He also brings hands-on industry experience, having worked as a semiconductor research engineer for a major Korean electronics corporation.

Mr. Ham is a frequent guest speaker to the Korean electronics industry, universities and professional associations. Recently, Mr. Ham was the keynote speaker at the Annual Joint Conference of the Korea and Japan Patent Attorneys Associations (October, 2004). He also contributes articles to numerous publications, including *The Monthly Intellectual Property Magazine of Korea*, *Korea Mail Daily Business Newspaper*, *IP Journal and Patent and Invention*.

Employment: Mayer, Brown, Rowe & Maw, LLP, Washington, DC (Partner, Jan. 2005 – Feb. 2007) • Piper Rudnick, LLP, Washington, DC (Partner, Sept. 2004 – Dec. 2004) • Jacobson Holman, PLLC, Washington, DC (Partner, May 1997 – Aug. 2004) • Keck, Mahin & Cate, Washington, DC (Associate, July. 1995 – Apr. 1997) • Dickstein, Shapiro & Morin, LLP, Washington, DC (Associate, Aug. 1994 – Jul. 1995) Education: Franklin Pierce Law Center, JD, 1994; Franklin Pierce Law Center, Master of Intellectual Property, 1992; Korea University, MS, 1986 (Electrical Engineering); Korea University, BS, 1984 (Electrical Engineering)

Bar Admissions: District of Columbia Bar; Pennsylvania Bar; U.S. Patent and Trademark Office

Foreign Language Capabilities: Korean

Publications: Patent Prosecution Strategy in view of *KSR v. Teleflex*, *Invention and Patent*, pp. 28-32 (August 2007) • A U.S. Patent lawyer on

Invention and Patent, *Hankuk Daily News* (April 27, 1995) • Introduction of Website-Bounty Quest, *Korean Maeil Daily Business Newspaper* (April 22, 2000) • Proving Invention Date in Obtaining U.S. Patent, *IP Journal* (Spring 1996) • GATT Changes Patents, *The Monthly Intellectual Property Magazine of Korea*, pp. 50-54 (May 1995) • Patentability of Software Related Inventions, *The Monthly Intellectual Property Magazine of Korea*, pp. 22-26 (July 1993); pp. 24-32 (August 1993); pp. 38-42 (September 1993).

### **Mr. Randy A. Noranbrock**



Mr. Noranbrock's practice is primarily directed to preparing and prosecuting patent applications for U.S. and foreign clients in the electrical, software, Internet, business methods, and mechanical arts.

Mr. Noranbrock has counseled clients ranging from sole inventors to large international corporations in the areas of application drafting and prosecution before the U.S. Patent and Trademark Office. Mr. Noranbrock has also prepared opinions concerning patent validity, infringement, and right-to-use.

Mr. Noranbrock is also a Professor of Law at the National Law School of India University in Bangalore, India.

Mr. Noranbrock has over ten years of engineering experience in the areas of computer and software engineering including real-time system design, object oriented design, embedded system design, and programming.

Mr. Noranbrock holds a Bachelor's degree in Electrical Engineering with a concentration in Computer Engineering from the George Washington University and a Juris Doctor degree from the George Mason University School of Law. He is admitted to practice in the Commonwealth of Virginia, and before the U.S. Patent and Trademark Office. Mr. Noranbrock's professional associations include the American Intellectual Property Law Association and the American Bar Association (Member, Intellectual Property Law Section).

## Dr. Sean A. Passino



Dr. Passino's practice concentrates on counseling about intellectual property management, patent prosecution, opinions, license agreements, and interference strategy. In particular, Dr. Passino's practice typically involves clients in the businesses of promoting the life sciences and/or nanotechnology, including pharmaceuticals, proteins, nucleic acids, fermentation, vaccine development, genetic engineering, diagnostics, antibody design, biopolymer production and use, food and drug formulations, and small molecule synthesis.

Dr. Passino proved his counseling experience by creating patent prosecution practices from scratch, setting policies for managing IP issues ranging from standard forms through firm-wide training, and advising other attorneys that erred. Moreover, Dr. Passino participated in parallel litigations and reexaminations; filed reissue applications; assisted experts; filed petitions and appeals; prepared and prosecuted patent applications; and applied for Patent Term Adjustments and Hatch-Waxman Patent Term Extensions. When appropriate, Dr. Passino filed suit against the United States Patent and Trademark Office. And, especially for his life sciences clients, Dr. Passino copied claims to provoke interferences, and he was a counsel of record during interferences.

Dr. Passino has continued to innovate and educate. For example, he recently was an invited speaker at The American Academy of Nanomedicine, in Potomac, MD, in September 2008, The European Union's IPR in Nanotechnology Workshop, in Brussels, Belgium, in April 2007, and the Symposium on Nanotechnology at the World Future Society, in Minneapolis, MN, in July 2007. Additionally, he published several articles, including the following: Sean Passino, Rule changes at the PTO remain in limbo, *The Nat'l Law Journal*, Aug. 17, 2009; Sean Passino, et al., Proposed rules seek to reduce pendency, backlog, *The Nat'l Law Journal*, Dec. 4, 2006; Sean Passino, et al., En banc decisions play important role in recent patent cases, *Nat'l Law Journal*, Feb. 28, 2005; Sean Passino, et al., Re-examinations are ordered due to 'public outcry', *Nat'l Law Journal*, May 10, 2004; Sean Passino, et al., Written Description Traps for Antibody Claims, 86 *J. Pat. & Trademark Off. Soc'y* 317, 318-19 (2004); and Sean Passino, et al., Foreign-Filed PCT Patent Applications: An Asymmetrical Patent-Defeating Effect, 85 *J. Pat. & Trademark Off. Soc'y* 11 Nov. 2003.

Dr. Passino graduated first in his college's class at The Pennsylvania State University, before he earned a Ph.D. from the University of Chicago. After a postdoctoral position, he started working at an international patent law firm, registered as a patent agent in the United States Patent and Trademark Office, and attended law school at the Georgetown University Law Center.

Since graduating from Georgetown Law, he has been admitted to the Virginia State Bar, District of Columbia Bar, Supreme Court of the United States, United States Court of Appeals for the Federal Circuit, United States District Court for the District of Columbia, and United States District Court Eastern District of Virginia. Dr. Passino is a Registered Patent Attorney in the USPTO.