

# LAW 294 - PATENT PROSECUTION

## Spring 2009

**Instructor:** Michael Messinger    Tel: (202) 772-8667    E-Mail: mikem@skgf.com

**Class Hours:** Thursdays 8:00 to 9:50 PM                      **Classroom:** 356

**Required Textbook:** MPEP (Available at <http://www.uspto.gov/web/offices/pac/dapp/mpepmain.html>)

**Recommend Book:** Patent Prosecution: Law, Practice, and Procedure (5th Edition) by Irah H. Donner  
(There is no need to buy this book, unless you want it. It is very expensive.)

**Other Course Material:** Peer to Patent Review, <http://www.peertopatent.org/>

Guest lecturers will also be invited for selected topics.

---

### **ASSIGNMENTS:**

#### **Week 1 (January 8, 2009):**

**Discussion Topics:** (1) Overview of Patent Prosecution Practice and Procedure; (2) Concept of the Prima Facie Case of Unpatentability; (3) Prosecution Effects on Patent Value; (4) How to Formulate a Reply Strategy; (5) Work of U.S. Patent Examiner

**Reading Assignment:** None

**Class Handouts:** None, in-class exercise Peer-to-Patent Review

**Homework Due:** None

#### **Week 2 (January 15, 2009):**

**Discussion Topics:** (1) Application Pre-Filing Practice; (2) Declarations, Assignments, and Other Formal Documents; (3) Duty of Disclosure and Information Disclosure Statements

**Reading Assignment:** MPEP Chapter 2000

**Class Handouts:** Sample Application File (Will Be Used For Homework Assignments)

**Homework Due:** None

#### **Week 3 (January 22, 2009):**

**Discussion Topics:** (1) Traversing 35 U.S.C. § 102 Rejections; (2) 37 C.F.R. § 1.131 affidavits

**Reading Assignment:** MPEP Chapter 700, Sections 706.02-706.02(i)

**Class Handouts:** Sample Non-Final Office Action; Sample 131 Affidavit; Sample Amendment and Reply

**Homework Due:** None

**Week 4 (January 29, 2009):**

**Discussion Topics:** (1) Traversing 35 U.S.C. § 103 Rejections; (2) 37 C.F.R. § 1.132 affidavits  
**Reading Assignment:** MPEP Sections 706.02(j)-706.02(n), and Section 2143  
**Class Handouts:** Sample 132 Affidavit  
**Homework Due:** None

**Week 5 (February 5, 2009):**

**Discussion Topics:** (1) Traversing 35 U.S.C. § 101 Rejections; (2) Traversing 35 U.S.C. § 112 Rejections; (3) Double Patenting and Disclaimers  
**Reading Assignment:** MPEP Sections 706.03-706.03(d)  
**Class Handouts:** Sample Terminal Disclaimer  
**Homework Due:** Reply to 35 U.S.C. § 102 Rejections in Sample Non-Final Office Action

**Week 6 (February 12, 2009):**

**Discussion Topics:** (1) Examiner Interviews; (2) Responding to Final Office Actions; (3) Continued Examination Practice; (4) Amendments to Drawings  
**Reading Assignment:** MPEP Chapter 700, Sections 706.07-706.07(h)  
**Class Handouts:** Sample Interview Summary; Sample Final Office Action  
**Homework Due:** None

**Week 7 (February 19, 2009):**

**Discussion Topics:** (1) Post-Allowance Practices; (2) 37 C.F.R. §1.312 Amendments; (3) Continuation Practices  
**Reading Assignment:** MPEP Chapter 1300  
**Class Handouts:** Sample Notice of Allowance; Sample 312 Amendment  
**Homework Due:** Reply to 35 U.S.C. § 103 Rejections in Sample Non-Final Office Action

**Week 8 (February 26, 2009):**

**Discussion Topics:** (1) Appeals; (2) In-Class Appeal Exercise  
**Reading Assignment:** MPEP Chapter 1200  
**Class Handouts:** Materials for In-Class Exercise  
**Homework Due:** None

**Week 9 (March 5, 2009):**

**Discussion Topics:** (1) Certificates of Correction; (2) Reissue Practice  
**Reading Assignment:** MPEP Chapter 1400, Sections 1480-1485  
**Class Handouts:** Sample Certificate of Correction; Sample Reissue Declaration  
**Homework Due:** Reply to 35 U.S.C. § 101 Rejections in Sample Non-Final Office Action

**(Spring Break)**

**Week 10 (March 19, 2009):**

**Discussion Topics:** (1) Restriction Practices; (2) Provisional Patent Application Practices  
**Reading Assignment:** MPEP Chapter 800  
**Class Handouts:** Sample Restriction Requirement  
**Homework Due:** None

**Week 11 (March 26, 2009):**

**Discussion Topics:** (1) Inventorship; (2) Patent Publication; (3) Small Entity Status; (4) Government Rights  
**Reading Assignment:** None  
**Class Handouts:** None  
**Homework Due:** Reply to 35 U.S.C. § 112 Rejections in Sample Non-Final Office Action

**Week 12 (April 2, 2009):**

**Discussion Topics:** (1) Foreign Filing Practices; (2) Patent Cooperation Treaty Practices  
**Reading Assignment:** MPEP Chapter 1800, Sections 1801-1812 and 1893-1896  
**Class Handouts:** None  
**Homework Due:** None

**Week 13 (April 9, 2009):**

**Discussion Topics:** (1) Ex Parte Reexamination; (2) Inter Partes Reexamination  
**Reading Assignment:** MPEP Chapter 2200, Sections 2209-2222  
**Class Handouts:** Sample Request for Ex Parte Reexamination  
**Homework Due:** None

**Week 14 (April 16, 2009):**

**Discussion Topics:** (1) In-Class Exercise Relating to Patent Prosecution; (2) Course Review  
**Reading Assignment:** Review class notes in preparation for course review  
**Class Handouts:** Client instructions for in-class exercise  
**Homework Due:** None

**Exam (May 1, 2009, at 6:00 PM)**

Exam will be open notes and books.