LAW 294 - PATENT PROSECUTION

Spring 2016

Instructor: Carla Ji-Eun Kim http://www.skgf.com/carlakim

Tel: (202) 772-8619 (o) E-Mail: ckim@skgf.com

Class Hours: Thursdays 8:00 to 9:50 PM Classroom: ___ Hazel

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

Other Course Materials: To be announced.

Recommended Optional Books:

- Patent Prosecution: Law, Practice, and Procedure (7th Edition) and 2012 Supplement by Irah H. Donner;


(Good resources. There is no need to buy these books for this course unless you want them for your personal library. They are expensive.)

Guest lecturers may also be invited for selected topics. Modest supplementary reading and course materials will be provided as the semester progresses and course discussion evolves. Course will emphasize aspects of patent prosecution including law, rules, pleadings and forms, strategy, trends, and client counseling. This course intended to be very practical. We will discuss real examples and strategies in an interactive way. Assignments are tailored to questions and analysis likely to be asked of a practicing patent attorney.

Assignments should be submitted electronically through the course’s TWEN webpage.

Grading

- Three in-semester assignments (60%)
- Final semester assignment (40%)
- There is no final exam. Grading will be based on the four written assignments. Late submission of assignments will result in a reduced grade unless a petition for extension of time is approved in advance.
- Grades will be adjusted to account for exceptional class participation in accordance with GMU policy.
ASSIGNMENTS:

Week 1 (January 7, 2016): The Business Decision to Get a Patent
Discussion Topics: (1) Value of Patents; (2) Prosecution Effects on Patent Value; (3) Overview of Patent Prosecution Practice and Procedure; (4) How to Formulate a Reply Strategy; (5) Work of U.S. Patent Examiner
Class Handouts: U.S. Patent No. 8,039,030 (copy available at www.pat2pdf.org or www.uspto.gov or TWEN)

Week 2 (January 14, 2016): Filing
Discussion Topics: (1) Application Pre-Filing Practice; (2) Declarations, Assignments, and Other Formal Documents; (3) Duty of Disclosure and Information Disclosure Statements; (4) Fast-Track Applications
Reading Assignment: MPEP Chapter 2000; Review Case Study material (Patent)

Week 3 (January 21, 2016): Overcoming PTO Rejections
Discussion Topics: (1) Traversing 35 U.S.C. § 101 Rejections; (2) Traversing 35 U.S.C. § 112 Rejections
Reading Assignment: MPEP Sections 706.03-706.03(d)
*Assignment #1 Distributed

Week 4 (January 28, 2016): Overcoming PTO Rejections
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); Review Case Study material (Original Prosecution History)
Class Handouts: Sample Non-Final Office Action; Sample 131 Affidavit; Sample Amendment and Reply

Week 5 (February 4, 2016): Overcoming PTO Rejections
Discussion Topics: (1) Traversing 35 U.S.C. § 103 Rejections; (2) Providing Evidence of Non-obviousness
Reading Assignment: MPEP Sections 706.02(j)-706.02(n), and Section 2143; MPEP Sections 706.02(j)-706.02(n), and Section 2143
Class Handouts: Sample 132 Affidavit
*Assignment #1 Due

Week 6 (February 11, 2016):
Discussion Topics: Traversing 35 U.S.C. § 112, 1st paragraph, 2nd paragraph, and 6th paragraph Rejections
Reading Assignment: MPEP Sections 706.03-706.03 (d)
*Assignment #2 Distributed
Week 7 (February 18, 2016): Midcourse Practice

**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

Week 8 (February 25, 2016): Midcourse Practice

**Discussion Topics:** (1) Restriction Practices; (2) Double Patenting and Disclaimers; (3) Provisional Patent Application Practices

**Reading Assignment:** MPEP Chapter 800

**Class Handouts:** Sample Restriction Requirement, Sample Terminal Disclaimer

*Assignment #2 Due*

Week 9 (March 3, 2016): Midcourse Practice

**Discussion Topics:** (1) Responding to Final Office Actions; (2) Continued Examination Practice; (3) Restriction Practices; and (4) Double Patenting and Disclaimers

**Reading Assignment:** MPEP Chapter 700, Sections 706.07-706.07(h) and MPEP Chapter 800

**Class Handouts:** Sample Final Office Action; Sample Restriction Requirement, Sample Terminal Disclaimer

*Assignment #2 Due*

(Spring Recess: March 7, 2016 – March 13, 2016)

Week 10 (March 17, 2016): Post-Allowance Practice

**Discussion Topics:** (1) Post-Allowance Practices; (2) 37 C.F.R. §1.312 Amendments; (3) Continuation Practices; (4) Patent Term Adjustment; (5) Patent Term Extension; and (6) Patent Term Calculation

**Reading Assignment:** MPEP Chapter 1300; MPEP 2701, 2710, 2720, 2730, 2731, 2732, 2733, 2734, 2735, 2750-2764

**Class Handouts:** Sample Notice of Allowance; Sample 312 Amendment

*Assignment #3 Distributed*

Week 11 (March 24, 2016): Correction of Patents

**Discussion Topics:** (1) Certificates of Correction; (2) Reissue Practice; (3) Supplemental Examination under the America Invents Act (AIA)

**Reading Assignment:** MPEP Chapter 1400, Sections 1480-1485

**Class Handouts:** Sample Certificate of Correction; Sample Reissue Declaration

Week 12 (March 31, 2016): International Patent Arena

**Discussion Topics:** (1) Foreign Filing Practices (Direct Filing v. PCT); (2) Patent Cooperation
Treaty Practices; and (3) Foreign Prosecution

Reading Assignment: MPEP Chapter 1800, Sections 1801-1812 and 1893-1896

*Assignment #3 Due

Week 13 (April 7, 2016): Administrative Appeal
Discussion Topics: 1) Appeals; (2) In-Class Appeal Exercise;
Reading Assignment: MPEP Chapter 1200
*Final Assignment #4 Distributed

Week 14 (April 14, 2016): Freedom to Operate
Discussion Topics: (1) Due Diligence; (2) Freedom to Operate Searches;
Reading Assignment: TBD
Final Assignment #4 Due

Week 15 (April 21, 2016): PTO Litigation
Discussion Topics: (1) Ex Parte Reexamination; (2) Inter Partes Reexam (Legacy); (3) Inter Partes Review; (4) Covered Business Methods; (5) Post Grant Review
Reading Assignment: To be handed out.
Final Assignment #4 Due

(Reading Period: April 22, 2016 – April 24, 2016)