LAW 294 - PATENT PROSECUTION  
Spring 2012

Instructor:  Michael Messinger   Tel: (202) 772-8667  E-Mail: mikem@skgf.com  
Class Hours: Thursdays 8:00 to 9:50 PM  
Classroom:  222 Hazel  
Required Textbook: MPEP (Available at http://www.uspto.gov/web/offices/pac/dapp/mpepmain.html)  

(There is no need to buy this book, unless you want it. It is very 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 practical aspects of patent prosecution including law, rules, pleadings and forms, strategy, trends, and client counseling.

ASSIGNMENTS:

Week 1 (January 12, 2012):  
  Discussion Topics: (1) Overview of Patent Prosecution Practice and Procedure; (2) Concept of the Prima Facia Case of Unpatentability; (3) Prosecution Effects on Patent Value; (4) How to Formulate a Reply Strategy; (5) Work of U.S. Patent Examiner  
  Class Handouts: Model Patent Jury Instructions, prepared by The National Jury Instruction Project June 17, 2009

Week 2 (January 19, 2012):  
  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 Written Homework Assignments)

Week 3 (January 26, 2012):  
  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
Week 4 (February 2, 2012):
Discussion Topics: Traversing 35 U.S.C. § 103 Rejections
Reading Assignment: MPEP Sections 706.02(j)-706.02(n), and Section 2143
Class Handouts: Sample 132 Affidavit

Week 5 (February 9, 2012):
Discussion Topics: Providing Evidence of Non-obviousness
Reading Assignment: MPEP Sections 706.02(j)-706.02(n), and Section 2143

Week 6 (February 16, 2012):
Reading Assignment: MPEP Sections 706.03-706.03(d)
Homework Due: Reply to 35 U.S.C. § 102 and 103 Rejections in Sample Non-Final Office Action

Week 7 (February 23, 2012):
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 (March 1, 2012):
Discussion Topics: (1) Restriction Practices; (3) Double Patenting and Disclaimers; (3) Provisional Patent Application Practices
Reading Assignment: MPEP Chapter 800
Class Handouts: Sample Restriction Requirement, Sample Terminal Disclaimer
Homework Due: Draft 132 Declaration for Expert

Week 9 (March 8, 2012):
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
Written Homework Assignment Due: Reply to 35 U.S.C. § 101 Rejections in Sample Non-Final Office Action

(March 12 to March 18 – Spring Recess)
Week 10 (March 22, 2012):
  Discussion Topics:  (1) Appeals; (2) In-Class Appeal Exercise
  Reading Assignment:  MPEP Chapter 1200

Week 11 (March 29, 2012):
  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

Week 12 (April 5, 2012):
  Discussion Topics:  (1) Foreign Filing Practices; (2) Patent Cooperation Treaty Practices
  Reading Assignment:  MPEP Chapter 1800, Sections 1801-1812 and 1893-1896

Week 13 (April 12, 2012):
  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

Week 14 (April 19, 2012):
  Discussion Topics:  (1) In-Class Exercise Relating to Patent Prosecution; (2) Course Review
  Reading Assignment:  Review class notes in preparation for course review

(April 24 to April 26 – Reading Period)

Final Exam
  Wednesday May 2, 2012 at 6 pm.  Exam will be open notes and books.

Grading:  Final Exam (100%) with up to 1/3 grade adjustment for class participation; three written homework assignments (ungraded) with feedback