LAW 294 - PATENT PROSECUTION

Spring 2014

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Class Hours:  Thursdays 8:00 to 9:50 PM          Classroom:  224 Hazel


Other Course Materials:  Case Study, U.S. Pat. No. 6,772,142 (the "Birding" case) – Available on TWEN.

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 9, 2014): The Business Decision to Get a Patent
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

Week 2 (January 16, 2014): Filing
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; Review Case Study material (Patent)
*Assignment #1 Distributed

Week 3 (January 23, 2014): 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 4 (January 30, 2014): Overcoming PTO Rejections
Discussion Topics: Traversing 35 U.S.C. § 101 Rejections
Reading Assignment: MPEP Sections 706.02(j)-706.02(n), and Section 2143
Class Handouts: Sample 132 Affidavit
*Assignment #1 Due

Week 5 (February 6, 2014): Overcoming PTO Rejections
Discussion Topics: Providing Evidence of Non-obviousness
Reading Assignment: MPEP Sections 706.02(j)-706.02(n), and Section 2143

Week 6 (February 13, 2014): 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 #2 Distributed
Week 7 (February 20, 2014): 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 27, 2014): 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 6, 2014): Post-Allowance Practice
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

(Spring Recess: March 10, 2014 – March 16, 2014)

Week 10 (March 20, 2014): International Patent Arena
Discussion Topics: (1) Foreign Filing Practices; (2) Patent Cooperation Treaty Practices
Reading Assignment: MPEP Chapter 1800, Sections 1801-1812 and 1893-1896
*Assignment #3 Distributed

Week 11 (March 27, 2014): 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 (April 3, 2014): Administrative Appeal
Discussion Topics: 1) Appeals; (2) In-Class Appeal Exercise;
Reading Assignment: MPEP Chapter 1200
*Assignment #3 Due
*Final Assignment #4 Distributed
Week 13 (April 10, 2014): 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: Chapter 1, Patent Office Litigation
Class Handouts: Is this Patent a Covered Business Method?; Post-Grant Challenges

Week 14 (April 17, 2014): PTO Litigation
Discussion Topics: (1) America Invents Act, cont. (2) Concurrent Prosecution and Litigation Strategies; (3) Course Review
Reading Assignment: Chapter 15, Patent Office Litigation
*Final Assignment #4 Due

(Reading Period: April 22, 2014 – April 24, 2014)