LAW 294 - PATENT PROSECUTION

Spring 2017

Instructor: Carla Ji-Eun Kim http://www.skgf.com/carlakim
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Class Hours: Thursdays 8:00 to 9:50 PM

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 (9th 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 presentation (40%)
- There is no final exam. Grading will be based on the three written assignments and one presentation. 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 19, 2017): 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) Types of patent applications; (5) Types of patent work
- **Class Handouts:** U.S. Patent No. 8,039,030 (copy available at www.pat2pdf.org or www.uspto.gov or TWEN)

**Week 2 (January 26, 2017): 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 (February 2, 2017): Overcoming PTO Rejections**
- **Discussion Topics:** (1) Traversing 35 U.S.C. § 101 Rejections; (2) Traversing 35 U.S.C. § 112; 1st paragraph, 2nd paragraph, and 6th paragraph Rejections
- *Assignment #1 Distributed*

**Week 4 (February 9, 2017): 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 16, 2017): 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 23, 2017): Overcoming PTO Rejections**
- **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
*Assignment #2 Distributed

Week 7 (March 2, 2017): 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

Week 8 (March 9, 2017): Midcourse 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 #2 Due

(Spring Recess: March 13, 2016 – March 19, 2016)

Week 9 (March 23, 2017): After Issuance
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
*Assignment #3 Distributed

Week 10 (March 30, 2017): 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

Week 11 (April 6, 2017): Certificate of Correction
Discussion Topics: (1) Due Diligence; (2) Freedom to Operate Searches;
Reading Assignment: TBD
*Assignment #3 Due

Week 12 (April 13, 2017): Post Issuance
Discussion Topics: (1) Appeal; (2) PGR; (3) IPR;
Reading Assignment: TBD
*Final Presentation outline due

**Week 13 (April 20, 2017):** Final Examination Presentation I

**Week 14 (April 27, 2017):** Final Examination Presentation II

(Reading Period: May 2, 2017-May 3, 2017)