LAW 294 - PATENT PROSECUTION

Spring 2019

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


Other Course Materials: To be announced.

Recommended Optional Books:

(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
- Two in-semester assignments (60%)
- Final semester presentation (40%)
- There is no final exam. Grading will be based on the two 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 17, 2019): 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 24, 2019): 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 31, 2019): 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

Week 4 (February 7, 2019): 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
*Assignment #1 Distributed

Week 5 (February 14, 2019): 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

Week 6 (February 21, 2019): 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 #1 Due

Week 7 (February 28, 2019): 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 7, 2019): 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 Distributed

(Spring Recess: March 11, 2019 – March 17, 2019)

Week 9 (March 21, 2019): 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


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 #2 Due

Week 11 (April 4, 2019): Certificate of Correction

Discussion Topics: (1) Due Diligence; (2) Freedom to Operate Searches;

Reading Assignment: TBD

*Final Presentation: Application selection due

Week 12 (April 11, 2019): Post Issuance

Discussion Topics: (1) Appeal; (2) PGR; (3) IPR;

Reading Assignment: TBD

*Final Presentation outline due
Week 13 (April 18, 2019): Final Examination Presentation

Week 14 (April 25, 2019): Final Examination Presentation

(Reading Period: April 30, 2019-May 1, 2019)