

LAW 294 - PATENT PROSECUTION

Spring 2022

Instructor: Carla Ji-Eun Kim <http://www.sterneckessler.com/carlakim>

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Class Hours: Thursdays 8:10 to 10:10 PM

Classroom: TBD

Required Textbook: MPEP (Available at <https://www.uspto.gov/web/offices/pac/mpep/index.html>)

Other Course Materials: To be announced.

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 or be emailed directly to me.

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.

Learning Outcomes

- Understand the overall patent prosecution/examination process in the US and foreign countries.
- Understand how to respond to office actions (e.g., restriction requirement, obviousness type double patenting rejections, and/or rejections under 35 U.S.C. §§ 101, 102, 103, and/or 112)
- Understand formalities (e.g., assignment, declaration, power of attorney, etc) at the patent office.
- Understand the interplay between inter partes proceedings (IPR, PGR, litigation, European opposition, etc) or ex parte proceedings (third party submission, ex parte reexamination, supplemental examination) and prosecution.

ASSIGNMENTS:

Week 1 (January 20, 2022): 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)

Week 2 (January 27, 2022): 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; (5) Patent Prosecution Highway (PPH) applications

Reading Assignment: MPEP Chapter 2000; MPEP 506; Review Case Study material (Patent)

Week 3 (February 3, 2022): 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

Reading Assignment: USPTO Patent Eligibility Guideline (<https://www.uspto.gov/patent/laws-and-regulations/examination-policy/2014-interim-guidance-subject-matter-eligibility-0>) MPEP Sections 706.03-706.03(d)

Week 4 (February 10, 2022): 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 Amendment and Reply

***Assignment #1 Distributed**

Week 5 (February 17, 2022): 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

Week 6 (February 24, 2022): 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 (March 3, 2022): Midcourse Practice

Discussion Topics: (1) Restriction/Unity of Invention Practices; (2) Double Patenting and Disclaimers; (3) Create Act/35 USC 102(c); (4) Joint Research Agreement

Reading Assignment: MPEP Chapter 800

Class Handouts: Sample Restriction Requirement, Sample Terminal Disclaimer

Week 8 (March 10, 2022): 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 Break: March 14 – Mar. 18

Week 9. (March 24, 2022): After Issuance

Discussion Topics: (1) Certificates of Correction; (2) Reissue Practice; (3) Supplemental Examination under the America Invents Act (AIA); (4) Ex parte reexamination

Reading Assignment: MPEP Chapter 1400, Sections 1480-1485

Class Handouts: Sample Certificate of Correction; Sample Reissue Declaration

Week 10 (March 31, 2022): 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 #2 Due**

Week 11 (April 7, 2022): Searches

Discussion Topics: (1) Due Diligence; (2) Freedom to Operate Searches; (3) Landscape Search; (4) Patentability Search

Reading Assignment: TBD

***Final Presentation: Application selection due**

Last updated January 8, 2022

Week 12 (April 14, 2022): Post Issuance

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

Reading Assignment: TBD

***Final Presentation outline due**

Week 13 (April 21, 2022): Final Examination Presentation

(Reading Period: April 26, 2022-April 27, 2022)

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