



FALL 2025 COURSE SYLLABUS

Course Number: 294-001
Course Title: Patent Prosecution
Credit Hours: 2
Grading Mode: LETTER GRADE
Meeting Time(s): WED 8:10-10:10P
Meeting Mode: ON CAMPUS
Exam Time(s): N/A
Exam Mode: N/A
Prerequisite(s): Law 338: Patent Law, or Law 284: Patent Law I and Law 292: Patent Law II

Corequisite(s): N/A

Instructor(s):

[Timothy L. Tang](#) | [Brian Dudley, Ph.D.](#)

Contact Info:

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Reading(s) & Supplement(s):

[MPEP](#)

Other course materials are to be announced. Modest supplementary reading and course materials will be provided as the semester progresses and course discussion evolves.

Course Overview

The course will emphasize aspects of patent prosecution including law, rules, pleadings and forms, strategy, trends, and client counseling. This course is 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.

Course Learning Outcomes

- 1) Understand the overall patent prosecution/examination process in the US and foreign countries.
- 2) 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)
- 3) Understand formalities (e.g., assignment, declaration, power of attorney, etc.) at the patent office.
- 4) 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.

Grading Policies

- 1) Two in-semester assignments (60%)
- 2) Final semester presentation (40%)
- 3) 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.
- 4) Grades will be adjusted to account for exceptional class participation in accordance with GMU policy.
- 5) Guest lecturers may also be invited for selected topics.

Classroom Policies

Attendance: Per AR 3-1.4, “maintenance of matriculation requires regular class preparation, participation and attendance, registration in the course of study required for the student’s program (full-time or part-time), successive registration for each fall and spring term of each academic year until study is completed, and compliance with all other relevant requirements.”

Absences: Per AR 4-1.1, “if a student is absent for any reason for more than 20 percent of the sessions of a course, the student is not eligible for credit in that course. A student who is not present for at least 75 percent of a session of the course is absent from that session.”

Participation & Preparation:

In-class participation may impact your final grade. Students are expected to be active and thoughtful participants in classroom discussions. Exceptional performance may result in an upward adjustment of your final grade by one step (e.g., from B+ to A -); a significant lack of in-class participation may result in a downward adjustment of your final grade by one step (e.g., from B+ to B). The instructors expect students to be engaged during in-class discussions and to have reviewed assigned readings prior to each class. Additional instruction and guidance will be provided at the end of each class for the preparation and reading required for the next class meeting.

Use of Technology & AI:

Strict Use Policy: The use of generative AI tools is not permitted for any coursework in this course. Unauthorized use will be treated as a violation of academic standards.

Course Schedule & Assignments

Assignments should be emailed directly to Tim and Brian at the above-provided e-mail addresses.

Week 1:

Date: August 20

Topic (s): 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:

Date: August 27

Topic (s): 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:

Date: September 10

Topic (s): Overcoming PTO Rejections

Discussion Topics: (1) Traversing 35 U.S.C. § 101 Rejections; (2) Traversing 35 U.S.C. § 112(a), 112(b), and 112(e) Rejections

Reading Assignment: USPTO Patent Eligibility Guidelines

(<https://www.uspto.gov/patents/laws/examination-policy/subject-matter-eligibility>); MPEP

Sections 706.03-706.03(d); 2024 Eligibility Guidance Including Artificial Intelligence

(<https://www.federalregister.gov/documents/2024/07/17/2024-15377/2024-guidance-update-on-patent-subject-matter-eligibility-including-on-artificial-intelligence>).

Week 4:

Date: September 17

Topic (s): 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:

Date: September 24

Topic (s): Overcoming PTO Rejections

Discussion Topics: (1) Traversing 35 U.S.C. § 103 Rejections; (2) Providing Evidence of Nonobviousness

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:

Date: October 1

Topic (s): 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:

Date: October 8

Topic (s): 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:

Date: October 15

Topic (s): 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

Week 9:

Date: October 22

Topic (s): 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:

Date: October 29

Topic (s): 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:

Date: November 11

Topic (s): 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

Week 12:

Date: November 12

Topic (s): Appeals and Post Issuance

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

Reading Assignment: TBD

*Final Presentation outline due

Week 13:

Date: November 19

Topic (s): Final Examination Presentation

[Student Resources](#)

[Antonin Scalia Law School Academic Regulations](#)

[GMU Common Course Policies Addendum](#)

[Mason Square Services](#)

[Mason Square Police](#)

Van Metre Hall, Room 110

Emergency - Dial 911

Escort Services - 703-993-8070

Dispatch – 703-993-2810

[Student Support and Advocacy Center \(SSAC\)](#)

Mason Square Sexual Assault Services:

Van Metre Hall, Room 222D

703-993-8186

[Notice of Mandatory Reporting of Sexual Assault, Sexual Harassment, Interpersonal Violence, and Stalking:](#)

As a faculty member, I am designated as a “Non-Confidential Employee,” and must report all disclosures of sexual assault, sexual harassment, interpersonal violence, and stalking to Mason’s Title IX Coordinator per University Policy 1202. If a student wishes to speak with someone confidentially, please contact one of Mason’s confidential resources, such as Student Support and Advocacy Center (SSAC) at 703 -380-1434 or Counseling and Psychological Services (CAPS) at 703 -993-2380. Students may also seek assistance or support measures from Mason’s Title IX Coordinator by calling 703 -993-8730, or emailing titleix@gmu.edu.

[Mason Square Clinic](#)

Van Metre Hall, Room B102

703-991-2831

[Counseling and Psychological Services](#)

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