

Patent Drafting and Prosecution

Course Description

This course covers the application of patent doctrine to the procurement of patent protection from the United States Patent and Trademark Office. Topics include the substantive law and procedure of drafting and prosecuting utility patent applications, strategies of drafting to obtain enforceable and defensible patent claims that can withstand pre-litigation and litigation challenges, the appeal process, and post-issuance administrative proceedings. Students will learn to draft various documents necessary to obtain a United States patent and also receive some exposure to foreign counterpart patent protection. Patent Law is a prerequisite for this course. 2 credits.

The class is on Mondays and Wednesdays from 6:15 to 8:15.

Student Learning Objectives

Students will be able to interact with inventors to identify possible patentable technology and to advise inventors against common pitfalls.

Students will be able to read, understand and prepare patent applications on basic mechanical technology.

Students will be able to read, understand and prepare collateral documents most commonly needed for patent applications including declarations, assignments and other formal documents.

Students will learn to compare an invention to the prior art to determine its scope and to prepare a basic claim set laying out the “metes and bounds” of the invention.

Students will learn to evaluate and respond to rejections and other common communications by the Patent Office. Rejections include rejections of the claims as reading on the prior art or being obvious in view of the prior art. Other rejections include patentable subject matter and lack of written description rejections.

Students will learn how to move an allowed patent application to issuance and how to preserve pendency for the capture of additional inventions through filing of continuations.

Students will learn how to address final rejections, including preparation and filing of administrative and judicial appeals.

Students will learn to navigate post-grant procedures for issued patents, including reissue proceedings and post-grant review.

Students will learn the basics of foreign prosecution strategies including the advantage of a Patent Cooperation Treaty (PCT) filing as well as direct entry into foreign jurisdictions.

On the final exam, students will be able to identify an invention based on a disclosure and prior art, prepare a basic claim set and address a rejection of the claims. Students will also be able to identify strategies, based on Patent Office rules and procedures, for protecting an invention in the U.S. and foreign countries. Students will also need to answer selected multiple choice questions from past Patent Bar Examinations

Required Materials

No text is required. However, required reading for each class will be identified in the U.S.

Patent and Trademark Office Manual of Patent Examining Procedure (available at <http://www.uspto.gov/web/offices/pac/dapp/mpepmain.html>)

Also, required reading will at times include selected portions of the Code of Federal Regulations, Title 37 (available at http://ecfr.gpoaccess.gov/cgi/t/text/text-idx?sid=a7dab9baf35812094c90c93e36a8f150&c=ecfr&tpl=/ecfrbrowse/Title37/37cfrv1_02.tpl#100)

Select cases will be supplied by the instructors in advance of each class.

Sample prosecution file histories (e.g., Office Actions, applicant Responses and Amendments, affidavits) will also be supplied by the instructors in advance of each class.

Please bring to each class a copy of the week's required reading materials.

Recommended Materials

These materials are to be kept in the library on reserve.

Ronald D. Slusky, *Invention Analysis and Claiming: A Patent Lawyer's Guide*

Robert C. Faber, *FABER ON MECHANICS OF PATENT CLAIM DRAFTING* (6th ed.)

Irah H. Donner, *PATENT PROSECUTION: LAW, PRACTICE, AND PROCEDURE* (4th ed.)

Assignments

| | |
|------|---|
| 5/29 | Overview of patent prosecution Types of patent applications Invention disclosures Inventor interviews |
| 6/3 | Analysis of prior art Types of claims Drafting claims Inventorship/ownership determination |
| 6/5 | Drafting claims continued |
| 6/10 | Meeting § 112 requirements Required components of the written description Drafting the written description |
| 6/12 | Declarations, assignments, and other formal documents Duty of disclosure Information disclosure statements Inequitable conduct |

| | |
|-----------|--|
| 6/17 (GC) | Prosecution history estoppel Amendment and argument practice Examiner interviews |
| 6/19 (GC) | Traversing § 102 rejections Double patenting |
| 6/24 | Traversing § 103 rejections Restriction practice |
| 6/26 | Traversing § 101 and 112 rejections Traversing rejections to the drawings |
| 7/1 | Design patents |
| 7/8 | Allowance Correcting Errors Post-allowance strategies Continuation practice |
| 7/10 | Final rejections Administrative appeals Judicial appeals |
| 7/15 (CC) | Reissue applications Post grant review Reexamination |
| 7/17 (CC) | Patent Cooperation Treaty Foreign prosecution strategies |