

6205 Patent Prosecution
Spring 2022 (10-18-21)

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Office Hours: Immediately after class or by appointment via email request.

Introduction

Welcome! This simulation course approaches patent prosecution from a practical perspective, aiming to equip you with fundamental skills not only in claim drafting, but also in argumentation, advocacy, and collaboration with inventors, clients, and patent examiners. In my experience, some new practitioners jump headfirst into the “weeds” of patent prosecution, never to get out – taking a highly technical, methodical approach that may yield many patents, but too often patents of questionable value to clients. Thus, an overarching goal of this course is to help you begin developing an identity as an intellectual property counselor – a practitioner whose mission is far broader than merely to secure patent protection. By the end of the semester, I hope you’ll be in a strong position to chart a course in your career that leverages patent prosecution as a means to an end that serves your clients’ interests, rather than as the end itself.

This is a highly interactive course. As such, our collective success depends heavily on you engaging actively and thoughtfully with the reading and homework assignments, and with your fellow students, guest lecturers, and me during class. Speaking of guests, throughout the semester, we’ll be visited by seasoned IP professionals, who will generously share insights with us. You’ll also get the chance to individually meet and interview a practitioner.

Course Materials: Robert C. Faber, *Faber on Mechanics of Patent Claim Drafting* (“Faber”) https://www.pli.edu/Content/Treatise/Faber_on_Mechanics_of_Patent_Claim_Drafting/_/N-4lZ1z141du?Ns=sort_title%7C0&ID=262323

Faber is available at a highly discounted rate (about one-fourth the commercial cost) for student use in this course; book ordering is centralized with a Law Center administrative support person. Please email Mr. Harold Bradford at hbradfo@central.uh.edu, copying the professor, and Mr. Bradford will check your course enrollment and then provide you with a special form to order the book. Please respect the publisher’s terms and conditions: the special rate is only for students enrolled in this course.

Assigned reading also may include portions of the Manual of Patent Examining Procedure (MPEP), available at <https://www.uspto.gov/web/offices/pac/mpep/>, as well as other provided or referenced materials.

Blackboard: *Details will be provided later.*

Attendance via Zoom

This class will be taught via this Zoom. The link is as follows:

[To be provided later]

- You must be logged in with a computer (not a phone) with your video camera turned on and microphone muted (note: the class will be set up to mute you automatically upon entry). Video must stay on for the entire class.
- You must identify yourself with your first and last name in the Zoom videoconferencing software.
- You must present yourself professionally in the video stream, both in attire and in conduct.
- Professor Cotrone may travel to Houston during the course of the semester. Subject to student interest and room availability at the Law Center, selected classes may meet both in person and via Zoom. These classes will be announced in advance; in-person attendance is not required though encouraged.

Grading & Homework: The final grade is based on (1) graded homework assignments (65% of final grade), and (2) a final exam including a mixture of drafting questions and essay questions (35% of final grade), including possible adjustment up or down one grade level (e.g., from a B to a B+ or to a B-) based on class participation. The course also includes required reading and non-graded homework.

Homework:

- A: Online patent resources exercise (10 points) and claim drafting exercise #1 (not graded)
- B: Claim drafting exercise #2 (10 points)
- C: Claim drafting exercise #3 (10 points)
- D: Draft patent application (20 points)
- E: Prepare reporting communication to client regarding Office action / analyze Office action response (10 points)
- F: Interview IP practitioner and write summary report (10 points)
- G: Prepare response to Office action (20 points)
- H: Deliver short presentation on assigned topic (10 points) [*Presentations will be delivered on multiple class days, ending on April 13. A schedule will be distributed.*]
- I: Prepare request for examiner interview (10 points)
- J: Prepare mission statement and professional development checklist and discuss with Professor Cotrone (not graded)

There are ten homework assignments and fourteen weeks of classes. Thus, most weeks will include an assignment. Most assignments will require you to write the equivalent of about one or two pages of material (approximately 500 to 1000 words). The patent application and Office action response assignments necessarily are more involved. **All homework instruction documents, as well as your work product, must be kept confidential and not disclosed to others, except as permitted by Professor Cotrone.**

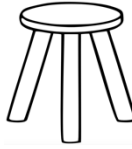
Course Objectives

- 1) Understand the process of (1) drafting a patent application and (2) prosecuting it at the United States Patent and Trademark Office (USPTO).
- 2) Build a foundation in the drafting of claims.
- 3) Understand how claim drafting decisions can impact patentability, validity, and enforceability of claims and damages recoverable in litigation.
- 4) Appreciate how advocacy can be exhibited during patent prosecution, such as through written argumentation, examiner interviews, oral hearings, and use of USPTO initiatives.
- 5) Learn techniques for strategic patent prosecution, including the use of provisional applications and continuing applications.
- 6) Build skills for communicating with inventors, corporate clients, and colleagues in connection with patent prosecution matters.
- 7) Understand the duty of disclosure and the USPTO Rules of Professional Conduct.
- 8) Learn techniques for global patent prosecution, including the use of PCT (Patent Cooperation Treaty) applications.
- 9) Understand the importance of proactively self-directing one's career in patent prosecution, with a focus on aspects such as building a professional brand, networking, continuous learning, client and team collaboration, and pitching services to prospective clients.

Class Schedule

Class No.	Date	Guest(s)	Topics	Pre-Class Reading	Homework Due
1	Jan. 19		<p>Introduction: "Patent Prosecutor" or "IP Counselor"?</p> <p>Refresher on patent fundamentals</p> <p>Overview of a U.S. utility patent application and prosecution process/timelines</p> <p>What is a patent claim?</p> <p>Types of claims</p> <p>Parts of claims</p> <p>Antecedent basis</p> <p>Examples</p>	<p>https://www.ipwatcdog.com/2017/08/06/patent-prosecutor-ip-counselor-choose-wisely/id=86443/</p> <p>https://www.uspto.gov/patents-getting-started/patent-process-overview#step1</p> <p>http://www.ipwatcdog.com/2014/03/15/an-overview-of-the-u-s-patent-process-2/id=48506/</p>	None
2	Jan. 26		<p>Claim drafting details</p> <p>Art of description</p> <p>Definiteness</p> <p>Patentable subject matter</p> <p>Apparatus claims</p>	<p>Faber, Introduction & Chapter 2</p> <p>MPEP § 200</p>	<p>A</p> <p>Subscribe to IPWatchdog blog</p>

Class No.	Date	Guest(s)	Topics	Pre-Class Reading	Homework Due
			Method claims Genus/species claims Markush claims Jepson claims Product-by-process claims Means-plus-function Step-plus-function MPEP USPTO portal (PAIR) Utility patent application – nonprovisional Provisional application Priority claims Design patent application		
3	Feb. 2		Claims (ctd.) Claim scope	Faber, Chapters 3 & 10	B
4	Feb. 9	IP Strategist	Detailed discussion of how to prepare parts of an application including: Field of the Invention; Background; Summary of the Invention; Brief Description of the Drawings; Detailed Description; Abstract; and Drawings Incorporation by reference Examples of good and bad application drafting practices	Faber, Chapters 4, 5, & 6 MPEP § 600 *Review Invention Disclosure (Homework D)	C
5	Feb. 16	Law Firm Partner & Inventor/Entrepreneur	Counseling clients Interviewing inventors Reporting correspondence Working with partners, other supervising attorneys, paralegals, and legal assistants Fee arrangements Estimating costs Patent prosecution technology Docketing procedures/software	“USPTO Ethics Rules May Change The Way You Email Clients,” Law360, Dec. 2014	None

Class No.	Date	Guest(s)	Topics	Pre-Class Reading	Homework Due
6	Feb. 23		Pre-exam formalities Restriction requirements and responses Office actions Types of rejections Responding to 102 and 103 rejections Double patenting	Faber, Chapters 7 & 8	D
7	Mar. 2	Law Firm Senior Associate	Responding to 102 and 103 rejections (ctd.); group exercise (assessing patent claims, specs, argumentation, etc.)	MPEP § 700	E
8	Mar. 9	Corporate IP Practitioner	Master class on claiming In-class claim drafting exercises and critiques Provide course feedback	MPEP § 800	Draft and bring to class one independent claim directed to a three-legged stool as shown below: 
	Mar. 16	Spring Break	No Class		
9	Mar. 23	USPTO Patent Examiner & Law Firm Partner	Advocacy Examiner interviews USPTO initiatives Examiner analytics software Navigating the USPTO In-class critiques of reporting communications and 102 and 103 arguments; discuss insights gleaned from practitioner interviews	"Patent Examiner Interviews Post-Bilski," Law360, Aug. 2010 https://www.ipwatchdog.com/2019/01/08/ip-counselors-checklist-adding-value-during-patent-prosecution/id=104601/	F & G

Class No.	Date	Guest(s)	Topics	Pre-Class Reading	Homework Due
10	Mar. 30	TBA	Patents versus trade secrets Patent prosecution informed by a litigation mindset Direct/indirect/divided infringement DOE and estoppel Subject matter eligibility	Faber, Chapter 1 MPEP § 2100	None
11	Apr. 6	Corporate IP Practitioner & Law Firm Partner	Duty of candor Information disclosure statements Ethics rules Conflicts of interest in patent prosecution After final practice RCE Allowance Correcting errors Post-allowance strategy Appeal process Pre-appeal Appeal to PTAB Oral hearings Appeal to Fed. Cir. Reissue applications Reexamination	Review content on https://www.ipethicslaw.com MPEP § 2000 MPEP § 1200, 1300, 1400, 2200 37 CFR, Part 11 https://www.ipwatcldog.com/2020/08/10/autopilot-advocate-raising-bar-ex-parte-appeals-uspto/id=123914/	I
12	Apr. 13	IP Strategist / Law Firm Partner	Patent prosecution in the biological and chemical arts Continuing applications Patent portfolio development strategies	MPEP § 200 https://www.yospinlaw.com/2019/10/02/continuation-application-strategies	None [Last day for remaining presentations – Homework H]
13	Apr. 20	Law Firm Partners	Business development techniques / pitching patent prosecution services to prospective clients Global filing strategies Working with foreign law firms and agents	https://www.natlawreview.com/article/business-development-101-future-law-firm-leaders	None

Class No.	Date	Guest(s)	Topics	Pre-Class Reading	Homework Due
			PCT applications Overview of PCT prosecution Foreign filing licenses	https://www.ipwatc.hdog.com/2020/12/17/using-linkedin-ip-business-development-winning-losing-strategies/id=128245 https://www.ipwatc.hdog.com/2017/05/15/seven-hallmarks-rational-global-patent-strategy/id=83227/ MPEP § 1800	
14	Apr. 27	Panel of Practitioners	Self-directing one's career in patent prosecution - building a professional brand, networking, continuous learning, and client and team collaboration Conclusion: "Patent Prosecutor" or "IP Counselor"? Provide course feedback	https://www.ipwatc.hdog.com/2019/07/26/dear-law-firm-ip-clients-satirical-love-letter/id=111266/ https://www.ipwatc.hdog.com/2019/08/15/the-law-firms-reply-a-satirical-sequel-to-the-ip-clients-love-letter/id=112173/	J

Attendance Policy

This course follows the Law Center's minimum 80% attendance policy for students. Any student who attends fewer than the minimum percentage of classes (i.e., fewer than 11.2 classes) may be dropped from the class. **Please notify the professor in advance of any foreseen absence.**

Counseling and Psychological Services (CAPS)

CAPS can help students who are having difficulties managing stress, adjusting to the demands of a professional program, or feeling sad and hopeless. You can reach CAPS (www.uh.edu/caps) by calling 713-743-5454 during and after business hours for routine appointments or if you or someone you know is in crisis. No appointment is necessary for the "Let's Talk" program, a drop-

in consultation service at convenient locations and hours around campus.
<https://uh.edu/caps/outreach/lets-talk>

Anti-Discrimination and Sexual Misconduct Policies

The University is committed to maintaining and strengthening an educational, working, and living environment where students, faculty, staff, and visitors are free from discrimination and sexual misconduct. If you have experienced an incident of discrimination or sexual misconduct, there is a confidential reporting process available to you. For more information, please refer to the University system's Anti-Discrimination Policy SAM 01.D.07 and Sexual Misconduct Policy SAM 01.D.08, available here:

<http://www.uhsystem.edu/compliance-ethics/uhs-policies/sams/01-general-information/index.php>

http://www.uhsystem.edu/compliance-ethics/_docs/sam/01/1d7.pdf (antidiscrimination)

http://www.uhsystem.edu/compliance-ethics/_docs/sam/01/1d8.pdf (sexual misconduct)

Please be aware that under the sexual misconduct policy, SAM 01.D.08, faculty are required to report to the University any information received regarding sexual misconduct as defined in the policy. Please note that the reporting obligations under the sexual misconduct policy reach to employees and students. Also, as a required reporting party, Law Center employees and faculty members are not a confidential resource.

Names and Pronouns

Chosen names and preferred pronouns (including non-binary ones such as they/them/their) must be respected in my classroom. Please feel free to reach out to me at any time if you want to make me aware of your chosen name or preferred pronoun, or if you have concerns about how I or your classmates address you.

Recording of Class

Students may not record all or part of class, livestream all or part of class, or make/distribute screen captures, without advanced written consent of the instructor. If you have or think you may have a disability such that you need to record class-related activities, please contact the [Center for Students with DisABILITIES](#). If you have an accommodation to record class-related activities, those recordings may not be shared with any other student, whether in this course or not, or with any other person or on any other platform. Classes may be recorded by the instructor. Students may use the instructor's recordings for their own studying and notetaking. The instructor's recordings are not authorized to be shared with *anyone* without the prior written approval of the instructor. Failure to comply with requirements regarding recordings will result in a disciplinary referral to the Dean of Students Office and may result in disciplinary action.

Syllabus Changes

Due to the changing nature of the COVID-19 pandemic, please note that the instructor may need to make modifications to the course syllabus and may do so at any time. Such modifications may

include changes to the mode(s) of assessment for the course. Notice of such changes will be announced as quickly as possible through email and Blackboard.

Honor Code Statement

Students may be asked to sign an honor code statement as part of their submission of any graded work, including but not limited to homework assignments, projects, quizzes, and exams: *"I understand and agree to abide by the provisions in the Law Center Honor Code. I understand that academic honesty is taken very seriously and, in the cases of violations, penalties may include suspension or expulsion from the University of Houston."*