

Syllabus for Patent Prosecution (6205/13687)
Spring 2026 • M 5:30 to 7:30 pm
(Updated 10-8-25)

Professor: Carlo Cotrone – ccotrone.ip@gmail.com – [LinkedIn](#)

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

Mode of Instruction: Synchronous Online

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, patent examiners, and colleagues. 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 speakers, 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: Thomas J. Kowalski, *Faber & Kowalski on Mechanics of Patent Claim Drafting* (Eighth Edition) (“Faber”)

<https://www.pli.edu/catalog/publications/treatise/faber--kowalski-on-mechanics-of-patent-claim-drafting>

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 team member. Please email Ms. Fariba Pouraryan at fpourary@central.uh.edu, copying the professor, and Ms. Pouraryan 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 includes 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.

Canvas: *Details will be provided later.*

Attendance via Zoom

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

[Details will be provided later]

- You must be logged in with a computer (not a phone) with its webcam turned 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.
- 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 and, in updated versions of this syllabus, marked below with the notation [****In-person option**]; in-person attendance is not required though highly encouraged.

Grading & Homework: The final grade is based on (1) graded homework assignments (40% of final grade), and (2) a summative final exam (60% 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 (a) reading assignments and (b) non-graded homework assignments. Points will be deducted for late submissions of required work product, both graded and non-graded; in the event of any conflict between a due date listed below and that specified in Canvas, such below due date shall control. Consistent with the below Prohibition on Use of AI, your submitted work product in this course must be exclusively your own, with help from no other person or technological system; no artificial intelligence systems may be a part of your process to generate work product.

Homework:

- A: Online patent resources exercise and claim drafting exercise #1 (not graded)
- B: Claim drafting exercise #2 (not graded)
- C: Claim drafting exercise #3 (not graded)
- D: Draft patent application (20 points)
- E: Prepare reporting communication to client regarding Office action / analyze Office action response (not graded)
- 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 13th. Timing will be announced later.*]
- I: Prepare request for examiner interview (not graded)
- J: Prepare mission statement and professional development checklist and discuss with Professor Cotrone (not graded)

There are ten homework assignments and thirteen 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 and final exam documents, as well as your associated work product, must be kept confidential and not disclosed to others, except as permitted by Professor Cotrone.**

Learning Objectives/Goals/Outcomes

- 1) Understand the process of (1) drafting a patent application and (2) filing and 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 (*denotes graded)
1	Jan. 26		Introduction: "Patent Prosecutor" or "IP Counselor"? Refresher on patent fundamentals Overview of a U.S. utility patent application and prosecution process/timelines What is a patent claim? Types of claims Parts of claims Antecedent basis Examples	https://www.ipwachtldog.com/2017/08/06/patent-prosecutor-ip-counselor-choose-wisely/id=86443/ https://www.uspto.gov/patents-getting-started/patent-process-overview#step1	None

Class No.	Date	Guest(s)	Topics	Pre-Class Reading	Homework Due (*denotes graded)
				http://www.ipwatchdog.com/2014/03/15/an-overview-of-the-u-s-patent-process-2/id=48506/	
2	Feb. 2		Drafting claims Definiteness Patentable subject matter Apparatus claims Method claims Genus/species claims Markush claims Jepson claims Product-by-process claims Means-plus-function Step-plus-function MPEP USPTO portal (Patent Center & Private PAIR) Utility patent application – nonprovisional Provisional application Priority claims Design patent application	Faber, Introduction & Chapter 2 MPEP § 200 https://ipwatchdog.com/2022/11/19/how-to-use-the-uspto-patent-public-search-tool/id=153391/#	A Subscribe to IPWatchdog blog
3	Feb. 9	IP Strategist	Claims (ctd.) Claim scope Novelty and nonobviousness Interpretation of claim terms Analysis and application of prior art	Faber, Chapters 3 & 10 MPEP § 2100	B
4	Feb. 16		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	Faber, Chapters 4, 5, & 6 MPEP § 600 *Review Invention Disclosure (Homework D)	C

Class No.	Date	Guest(s)	Topics	Pre-Class Reading	Homework Due (*denotes graded)
			Examples of good and bad application drafting practices		
5	Feb. 23	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
6	Mar. 2		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. 9	Law Firm Senior IP Counsel & Corporate IP Practitioner/Strategist	Responding to 102 and 103 rejections (ctd.); group exercise (assessing patent claims, specs, argumentation, etc.) Master class on claiming In-class claim drafting exercises and critiques Provide course feedback	MPEP § 700, 800	E Draft and bring to class one independent claim directed to a three-legged stool as shown below: 

Class No.	Date	Guest(s)	Topics	Pre-Class Reading	Homework Due (*denotes graded)
	Mar. 16	Spring Break	No Class		
8	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*
9	Mar. 30	Law Firm Partner & IP Software & Services Professionals	AI patent drafting strategies and solutions IP docketing systems / software IP management systems/software (IPMSs) Patent searching providers and IP analytics tools Patent drawings	https://ipwatchdog.com/2024/04/21/ai-tools-patent-drafting-llms-will-likely-never-write-claims-well-humans https://ipwatchdog.com/2025/05/01/invention-harvesting-leveraging-ai-greater-impact	None
10	Apr. 6	Corporate IP Practitioners/ IP Strategists	Patents versus trade secrets Patent prosecution informed by a litigation mindset Direct/indirect/divided infringement DOE and estoppel Subject matter eligibility Continuing applications	Faber, Chapter 1 MPEP § 2100 MPEP § 200 https://www.yospinlaw.com/2019/10/02/continuation-	None

Class No.	Date	Guest(s)	Topics	Pre-Class Reading	Homework Due (*denotes graded)
			Patent portfolio development strategies Driving innovation Invention harvesting	application-strategies	
11	Apr. 13	Law Firm Shareholder	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.ipwatchdog.com/2020/08/10/autopilot-advocate-raising-bar-ex-parte-appeals-uspto/id=123914/	I [Last day for remaining presentations – Homework H*]
12	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 PCT applications Overview of PCT prosecution Foreign filing licenses	https://www.natlawreview.com/article/business-development-101-future-law-firm-leaders https://ipwatchdog.com/2024/03/14/becoming-rainmaker-importance-expertise-reputation-	None

Class No.	Date	Guest(s)	Topics	Pre-Class Reading	Homework Due (*denotes graded)
				personality/id=174286/ https://www.ipwatchdog.com/2020/12/17/using-linkedin-ip-business-development-winning-losing-strategies/id=128245 https://www.ipwatchdog.com/2017/05/15/seven-hallmarks-rational-global-patent-strategy/id=83227/ MPEP § 1800	
13	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.ipwatchdog.com/2019/07/26/dear-law-firm-ip-clients-satirical-love-letter/id=111266/ https://www.ipwatchdog.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 10.4 classes) may be dropped from the class. **Please notify the professor in advance of any foreseen absence.**

Syllabus Changes

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 Canvas.

Honor Code

The UHLC Honor Code applies to all aspects of this course. You are responsible for knowing all Honor Code provisions and for complying with the Honor Code. Please inquire if you have any questions regarding how the Honor Code's provisions apply to specific activities or situations related to this course. Your continuing enrollment in this course is deemed to be a pledge by you under the Honor Code to comply with the Honor Code in relation to this course and to comply with the instructions in the course syllabus.

Use of Computers

Out of respect for other students and the class environment, during class sessions computers are to be used only for note taking purposes. This prohibits computer use for Internet surfing, chat rooms, e-mail, or other uses not related to note taking for class. I reserve the right to treat violations of this policy as either a lack of preparation, a constructive lack of attendance, or, in appropriate circumstances, as a disruption of the class.

Prohibition on Use of AI

The software technology known as artificial intelligence has recently expanded its capability to generate text and other work product (AI Generated Work Product). Examples of the technology include what are known as "generative" large language models (LLMs), and a specific implementation what is well known in the general public is ChatGPT. These systems can generate text and other work product in response to prompts and/or input of other text/documents/code/images. The output, the AI Generated Work Product, appears to have human mimicking "intelligence" and is thus potentially usable as a substitute for material one might generate themselves. AI Generated Work Product can include computer code or programs as well as human language content and materials.

Your continuing enrollment in this course obligates you to not knowingly prompt, generate, or use any AI Generated Work Product in relation to any activity or assessment in this course. This applies to AI Generated Work Product from yourself or others. This obligation includes that your assessment materials in the course be without any contribution from AI Generated Work Product. This obligation specifically extends to not plagiarize any writing required of you for assessment in the course: AI Generated Work Product will be treated as from another/others in applying the plagiarism policy to this course. The term "assessment" means any material generated for this course that is submitted to the instructor or presented in a class session, regardless whether it is

graded content or not. Assessments include mid-terms and final exams. AI Generated Work Product may not be used in the development or drafting of any assessments created by you in a non proctored environment, such as a “take home” final examination.

Inclusion and Wellness

This is an inclusive learning space.

At UHLC, we are committed to ensuring inclusive online and classroom learning spaces, where you'll be treated with respect and dignity, and where everyone is provided the equitable opportunity to participate, to contribute, and to succeed.

In this course, all students are welcome regardless of socio-economic status, age, race, ethnicity, disability, religion, national origin, veteran's status, sex, sexual orientation, gender identity, gender expression, political affiliation, marital status and other diverse identities that we each bring to class. Our class is richer for this diversity.

Inclusive learning spaces facilitate the innovation and creative thought that enhance student success. This success arises from the participation, support, and understanding of you and your colleagues. I encourage you to speak up and to share your views, but also understand that you are doing so in a learning environment in which we're all expected to engage respectfully and with regard to the dignity of all others.

If you feel like your class performance is impacted in any way by your experiences inside or outside of class, please reach out to me. I want to be a resource for you. If you feel more comfortable speaking with someone besides me, the Office of Student Affairs (OSA) is an excellent resource.

Chosen Names and Preferred Pronouns

I want to address each of you in a manner that corresponds to your identity. Although mistakes happen, chosen names and preferred pronouns—including non-binary ones such as they|them|their—and honorifics, such as Rev., Mr. Ms. Mx. Dr., will 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.

My pronouns are he/him/his. You may call me Professor Cotrone.

Mental Health and Wellness Resources

The University of Houston has a number of resources to support students' mental health and overall wellness, including CoogsCARE and the UH Go App. UH Counseling and Psychological Services (CAPS) offers 24/7 mental health support for all students, addressing various concerns like stress, college adjustment and sadness. CAPS provides individual and couples counseling, group therapy, workshops and connections to other support services on and off-campus. For assistance visit uh.edu/caps, call 713-743-5454, or visit a Let's Talk location in-person or virtually.

Let's Talk are daily, informal confidential consultations with CAPS therapists where no appointment or paperwork is needed.

Need Support Now? - If you or someone you know is struggling or in crisis, help is available. Call CAPS crisis support 24/7 at 713-743-5454, or the National Suicide and Crisis Lifeline: call or text 988, or chat 988lifeline.org.

Title IX/Sexual Misconduct

Per the UHS Sexual Misconduct Policy, your instructor is a "responsible employee" for reporting purposes under Title IX regulations and state law and must report incidents of sexual misconduct (sexual harassment, non-consensual sexual contact, sexual assault, sexual exploitation, sexual intimidation, intimate partner violence, or stalking) about which they become aware to the Title IX office. Please know there are places on campus where you can make a report in confidence. You can find more information about resources on the Title IX website at <https://uh.edu/equal-opportunity/title-ix-sexual-misconduct/resources/>.

Reasonable Academic Adjustments/Auxiliary Aids

The University of Houston is committed to providing an academic environment and educational programs that are accessible for its students. Any student with a disability who is experiencing barriers to learning, assessment or participation is encouraged to contact the Justin Dart, Jr. Student Accessibility Center (Dart Center) to learn more about academic accommodations and support that may be available to them. Students seeking academic accommodations will need to register with the Dart Center as soon as possible to ensure timely implementation of approved accommodations. Please contact the Dart Center by visiting the website: <https://uh.edu/accessibility/> calling (713) 743-5400, or emailing jdcenter@Central.UH.EDU.

The Student Health Center offers a Psychiatry Clinic for enrolled UH students. Call 713-743-5149 during clinic hours, Monday through Friday 8 a.m. - 4:30 p.m. to schedule an appointment.

The A.D. Bruce Religion Center offers spiritual support and a variety of programs centered on well-being.

The Center for Student Advocacy and Community (CSAC) is where you can go if you need help but don't know where to start. CSAC is a "home away from home" and serves as a resource hub to help you get the resources needed to support academic and personal success. Through our Cougar Cupboard, all students can get up to 30 lbs of FREE groceries a week. Additionally, we provide 1:1 appointments to get you connected to on- and off-campus resources related to essential needs, safety and advocacy, and more. The Cougar Closet is a registered student organization advised by our office and offers free clothes to students so that all Coogs can feel good in their fit. We also host a series of cultural and community-based events that fosters social connection and helps the cougar community come closer together. Visit the CSAC homepage or follow us on Instagram: @uh_CSAC and @uhcupbrd. YOU belong here.

Women and Gender Resource Center

The mission of the WGRC is to advance the University of Houston and promote the success of all students, faculty, and staff through educating, empowering, and supporting the UH community. The WGRC suite is open to you. Stop by the office for a study space, to take a break, grab a snack, or check out one of the WGRC programs or resources. Stop by Student Center South room B12 (Basement floor near Starbucks and down the hall from Creation Station) from 9 am to 5 pm Monday through Friday.

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 Justin Dart, Jr. Student Accessibility Center. 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 instructor's recordings for their own studying and notetaking. 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.