

## Fall 2017 Syllabus for Patent Prosecution

Prof. Valerie Friedrich and Ray Ashburg

**Office Hours: Thursday 5:30-7:30 PM** - Immediately after class or scheduled meetings via email request in advance.

**Email questions to:** [UHLawPatentProsecution@gmail.com](mailto:UHLawPatentProsecution@gmail.com)  
(Please allow 24 hours for a response).

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The final grade is based on a final exam including both multiple choice questions and essay questions. The course also includes required non-graded homework including drafting claims, specification, and responding to office actions.

| Date        | Instructor | Subjects                                                                                                                                                                                               |
|-------------|------------|--------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|
| August 24   | Ashburg    | Utility Patent Application –<br>Non-Provisional<br>What is a patent claim?<br>Types of Claims<br>Parts of Claims<br>Antecedent Basis<br>Claim Examples<br>In Class Drafting Exercises plus<br>Homework |
| August 31   | Ashburg    | Claim drafting details<br>Art of description<br>Definiteness<br>Patentable Subject Matter<br>Method Claims<br>Genus/Species Claims<br>Markush Claims<br>Jepson Claims                                  |
| September 7 | Ashburg    | Product by Process Claims<br>Means Plus Function<br>Step Plus Function                                                                                                                                 |

|              |           |                                                                                                                                                                              |
|--------------|-----------|------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|
|              |           | Overview of a U.S. Patent Application and the Application Process                                                                                                            |
| September 14 | Friedrich | Detailed Discussion of How to Prepare Parts of an Application including: Field of the Invention; Background; Summary of the Invention; and Brief Description of the Drawings |
| September 21 | Friedrich | Detailed Discussion of How to Prepare Parts of an Application including: Detailed Description; Abstract; and Drawings                                                        |
| September 28 | Friedrich | Strategy in Preparing Patent Applications:<br>Accidental limitations of claim scope                                                                                          |
| October 5    | Guest     | To be determined                                                                                                                                                             |
| October 12   | TBD       | Duty of Candor<br>Information disclosure statements<br>Continuing Applications<br>Pre-Exam Formalities                                                                       |
| October 19   | Friedrich | Restriction Requirements and Responses<br>Types of Rejections<br>Responding to 102 Rejections<br>Inherent Anticipation                                                       |
| October 26   | Friedrich | Responding to 103 rejections<br>Double patenting<br>Prosecution Strategy<br>DOE and estoppel<br>Examiner Interviews                                                          |

|             |           |                                                                                                                               |
|-------------|-----------|-------------------------------------------------------------------------------------------------------------------------------|
| November 2  | Friedrich | After Final Practice<br>RCE<br>Allowance<br>Correcting errors<br>Post-allowance strategy                                      |
| November 9  | Ashburg   | Appeal Process:<br>Pre-Appeal<br>Appeal to PTAB<br>Appeal to Fed. Cir.                                                        |
| November 16 | Ashburg   | Appeal to Fed. Cir.                                                                                                           |
| November 23 | Friedrich | Reissue applications<br>Reexamination<br>PCT Applications<br>Overview of PCT Prosecution<br>Peculiarities of Foreign Practice |