

**6205 Patent Prosecution**  
**Spring 2020 (revised 10-14-19)**

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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 to begin developing an identity as an intellectual property counselor – a practitioner whose mission is far broader than merely to secure patent protection. At 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.

**Course Materials:** Robert C. Faber, *Faber on Mechanics of Patent Claim Drafting* (new edition expected December 2019) (“Faber”)

[https://www.pli.edu/Content/Treatise/Faber\\_on\\_Mechanics\\_of\\_Patent\\_Claim\\_Drafting/\\_/N-4lZ1z141du?Ns=sort\\_title%7C0&ID=262323](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 [hpbradfo@central.uh.edu](mailto:hpbradfo@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.*

**Zoom:** *Information will be provided later.*

**Grading & Homework:** The final grade is based on (1) graded homework assignments (60% of final grade), and (2) a final exam including both multiple-choice questions and essay questions (40% 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 potentially additional non-graded homework.

## Homework:

- A: Online patent resources exercise (10 points) and non-graded claim drafting exercise #1
- 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 throughout the semester, ending on April 7. A schedule will be distributed early in the course.*]
- I: Prepare request for examiner interview / intro to appeal brief (10 points)
- J: Prepare mission statement and professional development checklist (10 points)

There are ten graded homework assignments and fourteen weeks of classes. Thus, most weeks will include an assignment. Please note that the expectation is that most assignments will require you to write the equivalent of about one or two pages of material (approximately 500 to 1000 words). **All homework instruction documents, as well as your work product, must be kept confidential and not disclosed to others except as permitted by the professor.**

## 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, and client and team collaboration.

## Class Schedule

This is the planned roadmap for the course. However, as the semester unfolds, we may need to make adjustments.

Class No.	Date	Guest(s)	Topics	Pre-Class Reading	Homework Due
1	Jan. 14		<p>Introduction: "Patent Prosecutor" or "IP Counselor"?</p> <p>Refresher on patent fundamentals</p> <p>Overview of a U.S. 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><a href="https://www.ipwatc-hdog.com/2017/08/06/patent-prosecutor-ip-counselor-choose-wisely/id=86443/">https://www.ipwatc-hdog.com/2017/08/06/patent-prosecutor-ip-counselor-choose-wisely/id=86443/</a></p> <p><a href="https://www.uspto.gov/patents-getting-started/patent-process-overview#step1">https://www.uspto.gov/patents-getting-started/patent-process-overview#step1</a></p> <p><a href="http://www.ipwatc-hdog.com/2014/03/15/an-overview-of-the-u-s-patent-process-2/id=48506/">http://www.ipwatc-hdog.com/2014/03/15/an-overview-of-the-u-s-patent-process-2/id=48506/</a></p>	None
2	Jan. 21		<p>Claim drafting details</p> <p>Art of description</p> <p>Definiteness</p> <p>Patentable subject matter</p> <p>Apparatus claims</p> <p>Method claims</p> <p>Genus/species claims</p> <p>Markush claims</p> <p>Jepson claims</p> <p>Product-by-process claims</p> <p>Means-plus-function</p> <p>Step-plus-function</p> <p>MPEP</p> <p>USPTO portal (PAIR)</p> <p>Utility patent application – nonprovisional</p> <p>Provisional application</p> <p>Priority claims</p>	<p>Faber, Introduction &amp; Chapter 2</p> <p>MPEP § 200</p>	A
3	Jan. 28		Claims (ctd.)	Faber, Chapters 3 & 10	B

Class No.	Date	Guest(s)	Topics	Pre-Class Reading	Homework Due
4	Feb. 4		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	C
5	Feb. 11	Law Firm Partner & Inventor/ Client	Master class on claiming In-class claim drafting exercises and critiques	*Review Invention Disclosure (Homework D)  Faber, Chapter 10  MPEP § 600	Prepare for master class; prepare questions for inventor
6	Feb. 18	Law Firm Partner	Counseling clients Interviewing inventors Reporting correspondence Working with partners or other supervising attorneys Fee arrangements Estimating costs Patent prosecution technology Docketing procedures/software	“USPTO Ethics Rules May Change The Way You Email Clients,” Law360, Dec. 2014  Faber, Chapters 7 & 8	None
7	Feb. 25	<a href="#">Gene Quinn</a> & Law Firm Senior Associate	Pre-exam formalities Restriction requirements and responses Office actions Types of rejections Responding to 102 and 103 rejections Double patenting	MPEP § 700, 800	D
8	Mar. 3		Responding to 102 and 103 rejections (ctd.); group exercise (assessing patent claims, specs, argumentation, etc.)  Provide course feedback	MPEP § 700	E

Class No.	Date	Guest(s)	Topics	Pre-Class Reading	Homework Due
9	Mar. 17	USPTO Patent Examiner	Advocacy Examiner interviews USPTO initiatives Examiner analytics software Navigating the USPTO	"Patent Examiner Interviews Post-Bilski," Law360, Aug. 2010	F
10	Mar. 24		In-class critiques of reporting communications and 102 and 103 arguments; discuss insights gleaned from practitioner interviews	<a href="https://www.ipwatc hdog.com/2019/01/08/ip-counselors-checklist-adding-value-during-patent-prosecution/id=104601/">https://www.ipwatc hdog.com/2019/01/08/ip-counselors-checklist-adding-value-during-patent-prosecution/id=104601/</a>	G
11	Mar. 31	<a href="#">Paul Herman</a>	Duty of candor Information disclosure statements Ethics rules Patent prosecution informed by a litigation mindset Direct/indirect/divided infringement DOE and estoppel Subject matter eligibility	Faber, Chapters 1  MPEP § 2000, 2100  37 CFR, Part 11	None
12	Apr. 7	<a href="#">Prof. James Beebe</a>	Patents versus trade secrets Continuing applications Patent portfolio development strategies 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	MPEP § 1200, 1300, 1400, 2200	[Last day for remaining presentations – Homework H]

Class No.	Date	Guest(s)	Topics	Pre-Class Reading	Homework Due
13	Apr. 14	Panel of Practitioners	Self-directing one's career in patent prosecution - building a professional brand, networking, continuous learning, and client and team collaboration	<a href="https://www.ipwatchdog.com/2019/07/26/dear-law-firm-ip-clients-satirical-love-letter/id=111266/">https://www.ipwatchdog.com/2019/07/26/dear-law-firm-ip-clients-satirical-love-letter/id=111266/</a>  <a href="https://www.ipwatchdog.com/2019/08/15/the-law-firms-reply-a-satirical-sequel-to-the-ip-clients-love-letter/id=112173/">https://www.ipwatchdog.com/2019/08/15/the-law-firms-reply-a-satirical-sequel-to-the-ip-clients-love-letter/id=112173/</a>	I
14	Apr. 21		Global filing strategies Working with foreign law firms and agents PCT applications Overview of PCT prosecution Peculiarities of foreign practice Foreign filing licenses  Conclusion: "Patent Prosecutor" or "IP Counselor"?  Provide course feedback	<a href="https://www.ipwatchdog.com/2017/05/15/seven-hallmarks-rational-global-patent-strategy/id=83227/">https://www.ipwatchdog.com/2017/05/15/seven-hallmarks-rational-global-patent-strategy/id=83227/</a>  MPEP § 1800	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.**

### **Counseling and Psychological Services (CAPS)**

Counseling and Psychological Services (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](http://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. [http://www.uh.edu/caps/outreach/lets\\_talk.html](http://www.uh.edu/caps/outreach/lets_talk.html)