

# PATENT PROSECUTION (6205/25773)

University of Houston Law Center | Fall 2026

T 4:00 to 6:00 pm | Room **TBD**

**Professor:** Basil Angelo – [basil@angeloip.com](mailto:basil@angeloip.com); (832) 934-8899; [Martindale-Avvo](#)

**Office Hours:** Immediately after class or by appointment

**Mode of Instruction:** Face-to-face in class at UHLC

## **Introduction:**

Welcome! This is a simulation course that immerses you in the real-world practice of patent prosecution. While the core competency of a patent prosecutor is the ability to draft, prosecute, and issue enforceable patents, the practice of a patent attorney is broader still—we provide strategic advice to clients regarding domestic and foreign intellectual property, opinions of counsel on validity and infringement, due diligence for sales and acquisitions, and strategic counseling for transactions, enforcement actions, and litigation. In addition, we negotiate and draft licensing agreements and other complex business contracts relating to intellectual property.

Given the time limitations of this course, our focus will be primarily on the core competency, namely, drafting and prosecuting a patent application before the United States Patent and Trademark Office, but we will endeavor to simulate this in the context of the broader scope of the practice. My hope is that by the end of the semester, you will have a better sense of whether you wish to pursue a career in patent prosecution—and, if so, you will have a solid foundation from which to begin your practice.

This is a highly interactive course, and our collective success depends on everyone's active engagement with the reading materials and timely completion of assignments—each one builds directly on the previous. I plan to invite one or more guest speakers during the semester to bring different perspectives and provide real-world simulation opportunities.

**Course Materials:** All course materials are available for free online or provided in class.

1. Title 35 United States Code (aka the “Patent Law”)

[https://www.uspto.gov/web/offices/pac/mpep/consolidated\\_laws.pdf](https://www.uspto.gov/web/offices/pac/mpep/consolidated_laws.pdf)

2. Title 37 Code of Federal Regulations (aka the “Patent Rules”)

[https://www.uspto.gov/web/offices/pac/mpep/consolidated\\_rules.pdf](https://www.uspto.gov/web/offices/pac/mpep/consolidated_rules.pdf)

3. USPTO Manual of Patent Examining Procedure (online searchable version)

<https://mpep.uspto.gov/RDMS/MPEP/current>

**Canvas:** *Details will be provided later.*

**Grading & Homework:** Your course grade will be based on the following graded drafting assignments (100%), including possible adjustment up or down one grade level (e.g., from B to a B+ or to a B-) based on class participation. Points will be deducted for late submissions of required work product, both graded and non-graded. Consistent with the below Prohibition on Use of AI, your submitted work product must be exclusively your own, with no help from classmates or others and without the use of AI or other technological system. There are ten drafting assignments spread out over 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). Some assignments are necessarily a little more involved. All assignments handed out in class as well as your associated work product must be kept confidential and not shared with others, except as permitted by Professor Angelo.

1) Claims drafting assignment	10%
2) Mini-specification drafting assignment	10%
3) Assignment drafting assignment	10%
4) Reply to restriction requirement drafting assignment	5%
5) Reply to 112 rejection drafting assignment	5%
6) Reply to 102 rejection drafting assignment	10%
7) Reply to 103 rejection drafting assignment	15%
8) Reply to 101 rejection drafting assignment	5%
9) Pre-appeal brief request for review drafting assignment	5%
10) Reply to complete office action drafting assignment	25%

### **Course Objectives and Learning Outcomes**

- 1) Demonstrate a comprehensive understanding of the patent application process, including the drafting of a utility patent application (specification, claims, drawings, and supporting documents) and prosecuting it before the USPTO through examination, office actions, responses, amendments, allowance or appeal.
- 2) Develop foundational skills in claim drafting including constructing independent and dependent claims using proper format and terminology and applying statutory requirements to define the scope of protection effectively.
- 3) Analyze how claim drafting decisions affect patentability, validity, enforceability, and litigation outcomes, including the impact on prior art susceptibility, infringement scope, doctrine of equivalents, indefiniteness risks, written description/enablement support, and potential damages.
- 4) Apply effective advocacy techniques during patent prosecution, such as crafting persuasive written arguments in responses to office actions, conducting productive examiner interviews, preparing for and participating in oral hearings before the PTAB, and leveraging USPTO programs (e.g., Track One, Pre-Appeal Brief Request for Review, or examiner interviews).
- 5) Employ strategic approaches to U.S. patent prosecution, including the effective use of provisional applications for priority, continuation/continuation-in-part/divisional

applications for refinement or broader protection, terminal disclaimers, and sequencing filings to optimize timing, cost, and scope in light of the first-to-file system.

- 6) Develop professional communication skills for patent prosecution, including interviewing and collaborating with inventors to elicit technical details, advising corporate clients on strategy and risks, drafting clear reports and correspondence, and coordinating effectively with colleagues, paralegals, and foreign associates.
- 7) Understand and apply the duty of disclosure (37 CFR 1.56) and relevant USPTO Rules of Professional Conduct, including identifying material information, preparing Information Disclosure Statements (IDS), managing conflicts of interest, maintaining client confidentiality, and ensuring candor to the USPTO.
- 8) Understand strategies for international patent protection, including the role and procedure of PCT applications, national phase entries, foreign filing licenses, Paris Convention priority claims, and coordinating prosecution across jurisdictions to maximize global coverage while managing costs and deadlines.
- 9) Proactively manage and advance a career in patent prosecution, including building a professional brand (e.g., through publications, speaking, and online presence), networking within the IP community, pursuing continuous learning (e.g., CLE, bar updates, professional associations), fostering strong client and team relationships, and developing skills for pitching services and securing new matters.

### Class Schedule:

Class No.	Date	Topics	Reference Materials	Assignment
1	8/25	<p><u>Topic: Patent fundamentals</u>            What is a patent?            Why are patents important?            Historical origins of the patent right            Origins/evolution of the US patent right            Framework of US patent system            Types of US patents            Anatomy of a patent application            Int'l patent law &amp; important treaties*            Comprehensive filing strategies*            *if time allows</p>	<p><a href="#">Introduction to Patent Systems</a></p> <p><a href="#">Types of Applications</a></p>	None
2	9/1	<p><u>Topic: Drafting patent claims</u>            What is a patent claim?            Why are claims important?            Types of patent claims            Anatomy of a patent claim            Functional language considerations</p>	<p><a href="#">Claim interpretation part 1</a></p> <p><a href="#">Claim interpretation part 2</a></p> <p><a href="#">Claim interpretation part 3</a></p>	<p>Draft claims, handed out in class;</p> <p>DUE 9/8</p>

		<p>Direct/indirect/ divided infringement considerations  Patent eligibility considerations  Broadest Reasonable Interpretation  Differences in claim interpretation between examination and litigation</p> <p><i>Discuss assignment for next week</i></p>	<p><a href="#">Broadest Reasonable Interpretation</a></p> <p><a href="#">Patent eligibility</a></p>	
3	9/8	<p><i>Review completed assignments in class</i></p> <p><i>Topic: Drafting an enabled written description</i></p> <p>Written description vs enablement requirement  Definitiveness requirement  Functional language considerations  Beware of European stricture</p> <p><i>Discuss assignment for next week</i></p>	<p><a href="#">35 USC 112(a)</a></p> <p><a href="#">35 USC 112 (b) &amp; (d)</a></p> <p><a href="#">35 USC 112(f)</a></p>	<p>Draft mini-specification, handed out in class;</p> <p>DUE 9/15</p>
4	9/15	<p><i>Review completed assignments in class</i></p> <p><i>Topic: Prosecution &amp; formalities issues</i></p> <p>Filing requirements  Formalities issues  Missing parts  Purpose of assignments  Requirements of assignments  Recordation of assignments  Overview of patent examination process</p> <p><i>Discuss assignment for next week</i></p>	<p><a href="#">Filing requirements</a></p> <p><a href="#">Patent examiner flow</a></p>	<p>Draft application assignment, handed out in class;</p> <p>DUE 9/29</p>
5	9/22	<p><u>Guest Speaker - TBA</u></p> <p>A client/inventor will join us to discuss their perspective on the patenting process, and we will give students the opportunity to simulate real-world interactions with the client</p>	<p>Client's patent handed out in class for discussion and use in simulation.</p>	<p>None</p>
6	9/29	<p><i>Review completed assignments in class</i></p> <p><i>Topic: Office Actions &amp; Formalities</i></p>	<p><a href="#">Restriction Practice - Part 1</a></p> <p><a href="#">MPEP Chapter 800</a></p>	<p>Draft reply to restriction requirement,</p>

		<p><u>Rejections</u>  Anatomy of an Office Action  Restriction requirement  Election of species requirement  Double patenting rejection</p> <p><u>Discuss assignment for next week</u></p>		<p>handed out in class;  DUE 10/6</p>
7	10/6	<p><u>Review completed assignments in class</u></p> <p><u>Topic: 112 rejections &amp; Drawing Issues</u>  Rejection for lack of written description  Rejection for indefiniteness  Rejection for failure to claim what the applicant regards as the invention  Rejection re means-plus-function language  Objection/Rejection for failure to show every feature of the claims in the drawings  Objection/Rejection for drawing inconsistencies  Objection/Rejection for unclear/indefinite drawing elements</p> <p><u>Discuss assignment for next week</u></p>	<p><a href="#">35 USC 112(a)</a>  <a href="#">35 USC 112 (b) &amp; (d)</a>    <a href="#">35 USC 112(f)</a></p>	<p>Draft reply to 112 &amp; drawings rejections, handed out in class;  DUE 10/13</p>
8	10/13	<p><u>Review completed assignments in class</u></p> <p><u>Topic: Substantive rejections under 102</u>  Novelty rejection under 102(a)(1)  Novelty rejection under 102(a)(2)  35 USC 102(b) exceptions  Strategies for responding  Amendments to the claims  Arguments traversing rejection</p> <p><u>Discuss assignment for next week</u></p>	<p><a href="#">Prior Art Rejections: An Introduction</a>    <a href="#">Introduction to 35 § U.S.C. 102(a)(1)</a>    <a href="#">Introduction to 35 § U.S.C. 102(a)(2)</a>    <a href="#">Introduction to 35 U.S.C. 102(b) Exceptions</a></p>	<p>Draft reply to 102 rejection, handed out in class;  DUE 10/20</p>
9	10/20	<p><u>Review completed assignments in class</u></p> <p><u>Topic: Substantive rejections under 103</u>  What is obviousness?  Legal conclusion based on underlying factual inquiries</p>	<p><a href="#">35 U.S.C. 103 Part 1 of 3</a>    <a href="#">35 U.S.C. 103 Part 2</a>    <a href="#">35 USC §103 – Part 3 of 3</a></p>	<p>Draft reply to 103 rejection, handed out in class;  DUE 10/27</p>

		<p>Prima facie obviousness  Scope and content of prior art (<i>Graham</i>)  Differences between prior art and claimed invention  Resolve level of ordinary skill in the art  <i>KSR v Teleflex</i>  Strategies for responding  Amendments to the claims  Arguments traversing rejection</p> <p><u>Discuss assignment for next week</u></p>		
10	10/27	<p><u>Review completed assignments in class</u></p> <p><u>Topic: Software &amp; Subject Matter Eligibility</u>  Statutory categories  Judicial exceptions  Alice/Mayo Two-Step Framework  Step 1  Step 2A  Step 2A Prong One  Step 2A Prong Two  Step 2B  What is significantly more?  Overcoming 101 rejections  Claim drafting strategies  Recite specific technical improvements  Avoid functional/result oriented language  Consider examiner interviews and amendments without new matter  USPTO guidance</p> <p><u>Discuss assignment for next week</u></p>		<p>Draft reply to 101 rejection, handed out in class;</p> <p>DUE 11/3</p>
11	11/3	<p><u>Review completed assignments in class</u></p> <p><u>Topic: Appeals &amp; Continued Examination</u>  Appellate process  Who can appeal and when  Pre-appeal options and alternatives  Applicant's appeal brief requirements  Effective brief writing  Examiner's answer  Applicant's optional reply  Optional oral hearings</p>		<p>Draft pre-appeal brief request for review, handed out in class;</p> <p>DUE 11/17</p>

		PTAB decisions Post PTAB-decision actions Strategic and practical considerations  <i>Discuss assignment for next week</i>		
12	11/10	<u>Guest Speaker - TBA</u> A patent litigator will join us to discuss the patenting process from the perspective of a litigator that enforces patent rights	None	None
13	11/17	<u>Review completed assignments in class</u>  <u>Topic: Miscellaneous Items</u> Notice of allowance Post-allowance considerations Continuing applications Corresponding foreign filings Strategies for uncertain market conditions  <i>Discuss assignment for next week</i>	None	Drafting reply to office action, handed out in class;  DUE 11/24
14	11/24	<u>Review completed assignments in class</u>  <u>Topic: Wrapping up and Q&amp;A</u> Patent ethics Duty of candor and good faith Finding your voice as an advocate AI analytics, decision tools, drafting aids  <u>Concluding comments</u>	None	None

### **Law Center 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.**

### **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.

### **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). 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.

### **Student Professionalism**

Our classroom is a learning space where each student is treated with respect and dignity and where everyone is provided the opportunity to participate, contribute, and succeed. In this course, all students are welcome regardless of background or identity. I encourage you to speak up and share your views appropriately throughout the semester. I also expect every class member to remember that in this learning environment, we will engage respectfully and with professionalism toward each other. I expect participants in the class to be respectful, civil to each other, incorporate constructive comments, and not dominate the discussion. This does not mean students cannot express disagreement in a significant way, but should do so using the sort of language they might use in court and in a way that displays respect for other persons in the class. In essence, students should argue in class as if they were arguing before a judge to engender the

good will of the judge yet working to state their case as persuasively as possible.

### **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](http://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](http://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](mailto: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.

### **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.

