

6205 Patent Prosecution
Spring 2023 (1-11-23)

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

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 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 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.

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. 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. Points will be deducted for late submissions. The course also includes required reading and non-graded homework. Your assessment work product 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 assessment work product.

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 10. 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 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, as well as your 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) 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. 23		<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.ipwatchdog.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.ipwatchdog.com/2014/03/15/an-overview-of-the-u-s-patent-process-2/id=48506/</p>	None
2	Jan. 30		<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>Faber, Introduction & Chapter 2</p> <p>MPEP § 200</p> <p>https://ipwatchdog.com/2022/11/19/how-to-use-the-uspto-</p>	<p>A</p> <p>Subscribe to IPWatchdog blog</p>

Class No.	Date	Guest(s)	Topics	Pre-Class Reading	Homework Due
			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	patent-public-search-tool/id=153391/#	
3	Feb. 6		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. 13	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. 20	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. 27		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. 6	Law Firm Senior Associate	Responding to 102 and 103 rejections (ctd.); group exercise (assessing patent claims, specs, argumentation, etc.) Provide course feedback	MPEP § 700	E
	Mar. 13	Spring Break	No Class		
8	Mar. 20	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. 27	Corporate IP Practitioner	Master class on claiming In-class claim drafting exercises and critiques	MPEP § 800	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
10	Apr. 3	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 Patent portfolio development strategies	Faber, Chapter 1 MPEP § 2100 MPEP § 200 https://www.yospinlaw.com/2019/10/02/continuation-application-strategies	None
11	Apr. 10	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.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. 17	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://www.ipwatchdog.com/2020/12/17/using-linkedin-ip-business-development-winning-losing-strategies/id=128245	None

Class No.	Date	Guest(s)	Topics	Pre-Class Reading	Homework Due
				https://www.ipwatcldog.com/2017/05/15/seven-hallmarks-rational-global-patent-strategy/id=83227/ MPEP § 1800	
13	Apr. 24	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.ipwatcldog.com/2019/07/26/dear-law-firm-ip-clients-satirical-love-letter/id=111266/ https://www.ipwatcldog.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.**

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 Blackboard.

Diversity, 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, Student Services is an excellent resource: 713-743-2182. Finally, I encourage you to bring any issues negatively impacting UHLC's openness to diversity and inclusion to the Law Center's Diversity and Inclusion committee. The D&I committee's charge includes "[building] on the Law Center's strengths as a diverse and inclusive environment." You can contact the committee directly at UHLCD&I@uh.edu.

Your suggestions are encouraged and appreciated. Please let me know ways to improve the effectiveness of this course for you personally, or for other students or student groups.

Accessibility and Accommodations

UHLC is committed to ensuring that all students enjoy equal access and full participation.

If you anticipate or experience barriers based on a disability (including any chronic or temporary medical or mental health condition), please feel free to reach out to me so that we may discuss options. If you require any support services, you may contact Ms. Samantha Ary, Academic Records Coordinator. Ms. Ary is located in room 44A TU-II in the Office of Student Services suite, and she can be reached at sary@central.uh.edu or 713-743-7466. Requests for accommodation that involve graded assignments **must be directed to Ms. Ary** and should be made as soon as possible to allow adequate time to document and to process the request.

If you observe religious or cultural holidays that will coincide with synchronous class sessions or conferences, please let me know as soon as possible, so that we may make arrangements.

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.

Honor Code

The UHLC Honor Code applies to all aspects of my class. *You are responsible for knowing all Honor Code provisions and for complying with the Honor Code.* Please ask me if you have **any** questions regarding how the Honor Code's provisions apply to specific activities or situations related to my course. *It is an Honor Code violation to review the graded assignments distributed to, or written by, any of my students from prior years.*

Counseling and Psychological Services

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 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.

The Texas Lawyers' Assistance Program ("TLAP") also supports law students who are dealing with stress, anxiety, depression, substance abuse, and other mental health problems. You can reach TLAP at any time at 1-800-343-8527. TLAP's website includes a page with links to sources about mental health that are of interest to law students: <https://www.tlaphelps.org/law-students>.

Anti-Discrimination and Sexual Misconduct Policies

UHLC and the University of Houston are 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, a confidential reporting process is 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.

Please be aware that under the sexual misconduct policy, SAM 01.D.08, faculty and other University employees are required to report to the University any information received regarding sexual misconduct as defined in the policy. Due to this reporting requirement, faculty members and other employees are not a confidential resource. The reporting obligations under the sexual misconduct policy extends to alleged conduct by University employees and students.

COVID-19 Information

Students are encouraged to visit the University's [COVID-19](#) website for important information including diagnosis and symptom protocols, testing, vaccine information, and post-exposure guidance. Please check the website throughout the semester for updates.

Reasonable Academic Adjustments/Auxiliary Aids

The University of Houston complies with Section 504 of the Rehabilitation Act of 1973 and the Americans with Disabilities Act of 1990, pertaining to the provision of reasonable academic adjustments/auxiliary aids for disabled students. In accordance with Section 504 and ADA guidelines, UH strives to provide reasonable academic adjustments/auxiliary aids to students who request and require them. If you believe that you have a disability requiring an academic

adjustments/auxiliary aid, please contact the [Justin Dart, Jr. Student Accessibility Center](#) (formerly the Justin Dart, Jr. Center for Students with DisABILITIES).

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.

Resources for Online Learning

The University of Houston is committed to student success, and provides information to optimize the online learning experience through our Power-On website. Please visit this website for a comprehensive set of resources, tools, and tips including: obtaining access to the internet, AccessUH, Blackboard, and Canvas; using your smartphone as a webcam; and downloading Microsoft Office 365 at no cost. For questions or assistance contact UHOnline@uh.edu.

UH Email

Please check and use your CougarNet email for communications related to this course. To access this email, [login](#) to your Microsoft 365 account with your CougarNet credentials.

Webcams

Access to a webcam is required for students participating remotely in this course. Webcams must be turned on at all times during class.

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>.

Security Escorts and Cougar Ride

UHPD continually works with the University community to make the campus a safe place to learn, work, and live. Our Security escort service is designed for the community members who have safety concerns and would like to have a Security Officer walk with them, for their safety,

as they make their way across campus. Based on availability either a UHPD Security Officer or Police Officer will escort students, faculty, and staff to locations beginning and ending on campus. If you feel that you need a Security Officer to walk with you for your safety please call 713-743-3333. Arrangements may be made for special needs.

Parking and Transportation Services also offers a late-night, on-demand shuttle service called Cougar Ride that provides rides to and from all on-campus shuttle stops, as well as the MD Anderson Library, Cougar Village/Moody Towers and the UH Technology Bridge. Rides can be requested through the UH Go app. Days and hours of operation can be found at <https://uh.edu/af-university-services/parking/cougar-ride>.

Other UH Resources

- [Diversity and Inclusion Statement](#)
- [Non-Discrimination Statement](#)
- [Center for Diversity and Inclusion](#)
- [Center for Students with DisABILITIES](#)
- [LGBTQ Resource Center](#)
- [Cougars in Recovery](#)
- [Counseling and Psychological Services](#) (see Section XIII)
- [Veterans Services](#)
- [Cougar Cupboard](#)
- [CoogsCare](#) (student assistance resources)
- [DACA: What You Need to Know](#)
- [Student Health Center](#)
- [Wellness](#)