

PATENT OFFICE PRACTICE and PROCEDURE

Spring, 2013

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Mondays – 3:15-6:00 p.m.
Room 208

TEXT = Selected photocopied cases – available at bookstore

1. **January 28** **The three requirements of patentability—review of basic patent law**
Text – pages 1-160 (and KSR decision)
 - utility, novelty, nonobviousness
 - 35 USC §§ 101, 102 and 103
review and discussion of selected case law – placing basic patent law doctrines in a real world context
 - America Invents Act (AIA) - background

2. **February 4** **Drafting patentability opinions**
Text – pages 161-222
 - invention disclosures, patentability searches
 - purposes of a patentability opinion
 - elements of a patentability opinion
 - attorney-client privilege/work product

3. **February 11** **Patentability opinion assignment due**
Drafting patent claims-the theory-what are we trying to accomplish?
Text – pages 223-298
 - 35 USC 112, second paragraph
 - parts of a patent claim
 - review and discussions of selected case law—claim scope and construction
 - common pitfalls in claim drafting

4. **February 18** **Drafting patent claims—in practice**
Text – pages 299-326
 - review and discussion of claims in issued patents
 - the claim drafting process
 - claim drafting exercises

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5. February 25 **Claim set assignment due**
Drafting patent applications-what are we trying to accomplish?
Text – pages 327-328, 525-632, 633-674
- 35 USC 112, first paragraph—enablement, description and best mode requirements (are description and enablement separate requirements?)
 - relevant portions of 37 CFR and the Manual of Patent Examining Procedure (MPEP)
 - quid pro quo theory of patent protection
 - do patents encourage or hinder innovation? (N.Y. Times 10/2012 article)
 - AIA and the best mode requirement – what disclosure is required?
 - review and discussion of sample patents
 - inventorship
6. March 4 **Drafting patent applications**
Patent prosecution – overview
Text – pages 329-441, 470-524
- practical aspects of patent application drafting
 - provisional applications
 - patent prosecution as a negotiation process
 - what is the goal?
 - effect of prosecution on patent term
 - USPTO expedited examination program
 - USPTO first interview program
7. March 11 **Patent application assignment due**
Patent prosecution – overview
Text – pages 675-858
- filing patent applications – new rules re: inventors' declarations
 - review study and discussion of Patent Office file wrapper
 - information disclosure statements
 - Dayco case and related cases – citation of related applications, office actions and foreign prosecution
 - restriction practice—-independent and distinct inventions – election of species
8. March 18 **NO CLASS – SPRING BREAK**
9. March 25 **Patent prosecution – formal and novelty rejections**
Text – pages 859-953
- parts of a PTO official action
 - parts of an amendment/response—amending claims
 - review of types of PTO rejections
 - review and discussion of selected case law and selected portions of the MPEP
 - formal rejections—responding to formal rejections
 - novelty rejections—responding to novelty rejections
 - what is prior art? (absolute bars vs. date of invention prior art)

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10. April 1 **Patent prosecution – obviousness rejections**
Text – pages 954-1076
- review and discussion of selected case law (including KSR)
 - what is *prima facie* obviousness?
 - responding to obviousness rejections (with *Festo* in mind)
 - * using argument
 - * using data and “secondary considerations” (objective indicia)
Rule 132 declarations
 - * swearing behind references—Rule 131 declarations
11. April 8 **Amendment assignment due**
Continuation practice
Text – pages 1077-1145
- relevant portions of 37 CFR and MPEP
 - continuation, continuation-in-part, and divisional applications
 - when used?
 - effective filing dates—35 USC 120
 - potential pitfalls
 - effect on patent term
 - double patenting
12. April 15 **The final stages of prosecution/Appeals**
Text – pages 1146-1208 and pages 1209-1312
- relevant portions of 37 CFR and MPEP
 - examiner interviews – USPTO first interview program
 - final rejections and amendments after final
 - advisory actions
 - allowances—notice of allowance-reasons for allowance
 - term extensions for USPTO delays
 - payment of the issue fee
 - post-issuance proceedings—reissue and reexamination (correction of issued patents)
 - Pre-appeal review
 - Notice of Appeal
 - appeal briefs—elements of an effective brief
 - oral arguments
 - appeals to the CAFC
13. April 22 **America Invents Act**
- Text – R. Armitage AIA paper
 - What constitutes prior art? (In re Hilmer will be out)
 - First inventor to file – the grace period
 - Post-grant review
 - Effective dates (March 16, 2013)
 - Prior user rights

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14. April 29

Appeal brief assignment due

Ethical and Liability issues in patent prosecution

Basic international patent concepts

Text – pages 1313-1394, 1411-1438

- 37 CFR 1.56 and 1.98
- Rule 56—duty of disclosure (Therasense decision)
- inequitable conduct
- ethical and liability issues – review common scenarios
- differences between US and international practice
- Paris Convention – priority dates
- Patent Cooperation Treaty (PCT)
- international filing patterns – portfolio management (balancing costs and benefits)