

**GEORGE MASON UNIVERSITY SCHOOL OF LAW
PATENT WRITING THEORY AND PRACTICE – LAW 351
SYLLABUS – FALL 2022**

<u>Professors:</u> John M. Covert	e: jcovert@sternekessler.com o: 202-772-8673
Jason Eisenberg	e: jasone@sternekessler.com o: 202-772-8645

Sterne, Kessler, Goldstein & Fox P.L.L.C.
1100 New York Avenue, N.W.
Washington, D.C. 20005-3934

Office hours available upon request

Submission of Assignments: It is requested that all writing assignments be submitted via email by 11:59 PM ET on the indicated due date to both Mr. Covert and Mr. Eisenberg to facilitate the process of providing meaningful and timely feedback to students. If the use of email presents a problem to any student, please discuss it with either professor so that accommodations can be made. Assignments should be submitted as attachments in Word format and must include the student's name and date. The e-mail subject line should read: “(Last name, first name) – Assignment #”.

Learning Outcomes: Students will learn through in-class exercises and written assignments how to:

- identify an application of a problem/solution approach to an inventive concept through mock interviews of scientists and engineers;
- draft individual independent and dependent claims of proper form and substance for examination at the U.S. Patent and Trademark Office;
- assemble a suite of claims in anticipation of enforcement of a U.S. patent in the federal courts;
- draft a specification to support the claimed invention and provide the basis for any needed amendments; and
- apply U.S. inventorship law to name the correct individuals as inventors on a patent application.

Pre-Req: Law 338 Patent Law, or Law 284 Patent Law I and Law 292 Patent Law II

Grading: Writing assignment 1 is worth 10% of the final grade. Writing assignments 2-5 are each worth 15% of the final grade. The final assignment (writing assignment 6) is worth 25% of the final grade. Class participation will be worth 5% of the final grade.

Class Structure:

This class will include approximately 28 hours of instruction time with approximately 18 hours of in person lecture, discussion, one-on-one assignment feedback, etc. and approximately 10 hours of flexible in person instruction.

Our first in person class will be the week of August 29, 2022, and then about every 2-3 weeks thereafter there will be some form of in person instruction as defined above.

The default for classroom instruction will be Monday at 6:00PM, but is subject to change based on student and professor conflicts. The one-on-one in person instruction may be scheduled for different days than classroom instruction as necessary, per student and professor schedules.

Each week we will post a self-paced Reading Assignment, comprising both case law and PowerPoint lectures, and a related Writing Assignment, comprising questions on the reading and practice writing, to TWEN based on the following schedule.

Class Schedule and Assignments

Week of	Class Topics	Assignments Due
August 22	Assign Reading #1: Claim interpretation and scope <ul style="list-style-type: none"> ➤ <i>Sage Prods., Inc. v. Devon Indus., Inc.</i>, 126 F.3d 1420 (Fed. Cir. 1997) ➤ <i>In re Morris</i>, 127 F.3d 1048 (Fed. Cir. 1997). ➤ <i>Apple Computer, Inc. v. Articulate Systems, Inc.</i>, 234 F.3d 14 (Fed. Cir. 2000). ➤ <i>Multiform Desiccants, Inc. v. Medzam, Ltd.</i>, 133 F.3d 1473 (Fed. Cir. 1998). ➤ <i>In re Donaldson Co.</i>, 16 F.3d 1189 (Fed. Cir. 1994). 	
August 29	In Person Live Instruction #1 (~2 hours) <ul style="list-style-type: none"> • How the course is organized • Overview of the patent writing process • What is an invention (problem-solution approach) • Parts, form, and content of a patent application -- A writing approach that works • Claim drafting, including discussion of types of claims • Claim Interpretation and Scope • Discuss assigned cases Assign Writing #1: Independent Claim Drafting <ul style="list-style-type: none"> ➤ <u>Due: 11:59PM ET September 12</u> ➤ Invention Disclosure - Leak Detector 	Reading Assignment #1
September 5	Assign Writing #2: Dependent Claim Drafting <ul style="list-style-type: none"> ➤ <u>Due: 11:59 PM ET September 19</u> Invention Disclosure (cont'd) – Leak Detector	
September 12	Assigned Reading Assignment #2 <i>Silicon Graphics, Inc. v. ATI Techs., Inc.</i> , 607 F.3d 784 (Fed. Cir. 2010).	Writing Assignment #1
September 19	In Person Live Instruction #2 (~2 hours): <ul style="list-style-type: none"> • Discuss Assigned Reading • One on One Review of Writing Assignment #1 • Claim drafting discussion • In-class claim drafting (Eyeglasses) 	Writing Assignment #2
September 26 (Jewish Holiday)	Assign Writing #3: Full Claim Set <ul style="list-style-type: none"> ➤ <u>Due: 11:59 PM ET October 3</u> ➤ Invention Disclosure – Chuck 	Reading Assignment #2

Class Schedule and Assignments

Week of	Class Topics	Assignments Due
<p>October 3</p>	<p>In Person Live Instruction #3 (~2 hours)</p> <ul style="list-style-type: none"> • Review of Writing Assignment #2 • Claim drafting including claim set strategy • Review of Writing Assignment #2 • [Guest Speaker] Biotech/Chemical Patent Applications • Inventorship • Discuss Inventorship Problem <p>Assign Reading #3: Inventorship</p> <ul style="list-style-type: none"> ➤ <u>Due: October 11</u> ➤ <i>Burroughs Wellcome Co. v. Barr Laboratories</i>, 40 F.3d 1223 (Fed. Cir. 1994). ➤ <i>Acromed Corp. v. Sofamor Danek Group, Inc. and Danek Medical, Inc.</i>, 253 F.3d 1371 (Fed. Cir. 2001). ➤ <i>BJ Services Co. v. Halliburton Energy Services, Inc.</i>, 338 F.3d 1368 (Fed. Cir. 2003) ➤ <i>Ethicon, Inc. v. U.S. Surgical Corp.</i>, 135 F.3d 1456 (Fed. Cir. 1998). ➤ Inventorship Problem (posted on TWEN) 	<p>Writing Assignment #3</p>
<p>October 11</p>	<p>Fall Break Week: Flexible Instruction #1 (~3-4 Hours)</p> <p>One on One: Review of Writing Assignment #3</p> <p>Instruction: Parts of the Application</p> <ul style="list-style-type: none"> ➤ Background of the Invention ➤ Drawings ➤ Brief ➤ Description of the Drawings ➤ Parts List ➤ Abstract and Title ➤ Summary of the Invention ➤ Detailed Description 	
<p>October 17</p>	<p>Assign Writing #4: Detailed Description</p> <ul style="list-style-type: none"> ➤ <u>Due: October 24</u> ➤ Leak Detector full detailed description 	

Class Schedule and Assignments

Week of	Class Topics	Assignments Due
October 24	<p>In Person Instruction #4 (~ 2 hours)</p> <ul style="list-style-type: none"> ➤ Claim drafting ➤ Discussion of claim sets and prior art ➤ Sample problems in class <p>Assign Writing #5: Prior Art</p> <ul style="list-style-type: none"> ➤ <u>Due: October 31</u> ➤ Water Heater claim set 	Writing Assignment #4
October 31	<p>Flexible Instruction #2 (~2-4 hours)</p> <ul style="list-style-type: none"> ➤ One on One Review of Writing Assignment #4 <p>Instruction:</p> <ul style="list-style-type: none"> ➤ Claim drafting and prior art discussion ➤ Sample problems in class <p>Assign Writing #6: Complete Patent Application</p> <ul style="list-style-type: none"> ➤ <u>Due: November 14</u> ➤ Invention Disclosure – Arrowhead <p>Assign Reading #4: Subject Matter Eligibility</p> <ul style="list-style-type: none"> ➤ <u>Due: November 7</u> ➤ USPTO Guidance on Subject Matter Eligibility 	Writing Assignment #5
November 7	<p>In Person Instruction #5 (~2-4 hours)</p> <p>One on One Review of Writing Assignment #5</p> <p>Instruction</p> <ul style="list-style-type: none"> ➤ Summary of application drafting principles and case study ➤ Subject Matter Eligibility (101) ➤ Altering claim scope (post-grant proceedings) ➤ Continuation applications (technology modifications) ➤ Design-around 	Reading Assignment #4
November 14	<p>In Person Instruction #6 (~ 2 hours)</p> <p>[Guest Speaker] Additional perspectives in patent writing</p>	Writing Assignment #6
November 21	<p>Flexible Instruction: One on One Meetings (~2-4 hours)</p> <p>Review of Writing Assignment #6</p>	