

# LAW 294 - PATENT PROSECUTION

Fall 2023

**Instructors:** Carla Ji-Eun Kim <http://www.sterneckessler.com/carlakim>

Tel: (202) 772-8619 (o) E-Mail: [ckim@sterneckessler.com](mailto:ckim@sterneckessler.com)

Daniel Choo <https://www.sterneckessler.com/professionals/daniel-k-choo-phd>

Tel: (202) 772-8568 (o) E-mail: [dchoo@sterneckessler.com](mailto:dchoo@sterneckessler.com)

*Office hours available by appointment*

**Class Hours:** Mondays 6:05 to 8:05 PM **Classroom:** Arlington Campus, Room TBD

**Required Textbook:** MPEP (Available at <https://www.uspto.gov/web/offices/pac/mpep/index.html>)

**Other Course Materials:** To be announced.

Guest lecturers may also be invited for selected topics. Modest supplementary reading and course materials will be provided as the semester progresses and course discussion evolves. Course will emphasize aspects of patent prosecution including law, rules, pleadings and forms, strategy, trends, and client counseling. This course intended to be very practical. We will discuss real examples and strategies in an interactive way. Assignments are tailored to questions and analysis likely to be asked of a practicing patent attorney.

Assignments should be emailed directly to Daniel at the above-provided e-mail address. .

## **Grading**

- Two in-semester assignments (60%)
- Final semester presentation (40%)
- There is no final exam. Grading will be based on the two written assignments and one presentation. Late submission of assignments will result in a reduced grade unless a petition for extension of time is approved in advance.
- Grades will be adjusted to account for exceptional class participation in accordance with GMU policy.

## **Learning Outcomes**

- Understand the overall patent prosecution/examination process in the US and foreign countries.
- Understand how to respond to office actions (e.g., restriction requirement, obviousness type double patenting rejections, and/or rejections under 35 U.S.C. §§ 101, 102, 103, and/or 112)
- Understand formalities (e.g., assignment, declaration, power of attorney, etc.) at the patent

office.

- Understand the interplay between inter partes proceedings (IPR, PGR, litigation, European opposition, etc.) or ex parte proceedings (third party submission, ex parte reexamination, supplemental examination) and prosecution.
- 

## **ASSIGNMENTS:**

### **Week 1 (August 21, 2023): The Business Decision to Get a Patent**

**Discussion Topics:** (1) Value of Patents; (2) Prosecution Effects on Patent Value; (3) Overview of Patent Prosecution Practice and Procedure; (4) Types of patent applications; (5) Types of patent work

**Class Handouts:** U.S. Patent No. 8,039,030 (copy available at [www.pat2pdf.org](http://www.pat2pdf.org) or [www.uspto.gov](http://www.uspto.gov))

### **Week 2 (August 28, 2023): Filing**

**Discussion Topics:** (1) Application Pre-Filing Practice; (2) Declarations, Assignments, and Other Formal Documents; (3) Duty of Disclosure and Information Disclosure Statements; (4) Fast-Track Applications; (5) Patent Prosecution Highway (PPH) applications

**Reading Assignment:** MPEP Chapter 2000; MPEP 506; Review Case Study material (Patent)

### **Labor Day (September 4, 2023) – No Class**

### **Week 3 (September 11, 2023): Overcoming PTO Rejections**

**Discussion Topics:** (1) Traversing 35 U.S.C. § 101 Rejections; (2) Traversing 35 U.S.C. § 112(a), 112(b), and 112(e) Rejections

**Reading Assignment:** USPTO Patent Eligibility Guideline (<https://www.uspto.gov/patent/laws-and-regulations/examination-policy/2014-interim-guidance-subject-matter-eligibility-0>) MPEP Sections 706.03-706.03(d)

### **Week 4 (September 18, 2023): Overcoming PTO Rejections**

**Discussion Topics:** (1) Traversing 35 U.S.C. § 102 Rejections; (2) 37 C.F.R. § 1.131 affidavits

**Reading Assignment:** MPEP Chapter 700, Sections 706.02-706.02(i); Review Case Study material (Original Prosecution History)

**Class Handouts:** Sample Non-Final Office Action; Sample Amendment and Reply

**\*Assignment #1 Distributed**

### **Week 5 (September 25, 2023): Overcoming PTO Rejections**

**Discussion Topics:** (1) Traversing 35 U.S.C. § 103 Rejections; (2) Providing Evidence of Non-

obviousness

**Reading Assignment:** MPEP Sections 706.02(j)-706.02(n), and Section 2143; MPEP Sections 706.02(j)-706.02(n), and Section 2143

**Week 6 (October 2, 2023): Overcoming PTO Rejections**

**Discussion Topics:** (1) Examiner Interviews; (2) Responding to Final Office Actions; (3) Continued Examination Practice; (4) Amendments to Drawings

**Reading Assignment:** MPEP Chapter 700, Sections 706.07-706.07(h)

**Class Handouts:** Sample Interview Summary; Sample Final Office Action

**\*Assignment #1 Due**

**Week 7 (Tuesday October 10, 2023): Midcourse Practice**

**Discussion Topics:** (1) Restriction/Unity of Invention Practices; (2) Double Patenting and Disclaimers; (3) Create Act/35 USC 102(c); (4) Joint Research Agreement

**Reading Assignment:** MPEP Chapter 800

**Class Handouts:** Sample Restriction Requirement, Sample Terminal Disclaimer

**Week 8 (October 16, 2023): Midcourse Practice**

**Discussion Topics:** (1) Post-Allowance Practices; (2) 37 C.F.R. §1.312 Amendments; (3) Continuation Practices; (4) Patent Term Adjustment; (5) Patent Term Extension; and (6) Patent Term Calculation

**Reading Assignment:** MPEP Chapter 1300; MPEP 2701, 2710, 2720, 2730, 2731, 2732, 2733, 2734, 2735, 2750-2764

**Class Handouts:** Sample Notice of Allowance; Sample 312 Amendment

**\*Assignment #2 Distributed**

**Week 9. (October 23, 2023): After Issuance**

**Discussion Topics:** (1) Certificates of Correction; (2) Reissue Practice; (3) Supplemental Examination under the America Invents Act (AIA); (4) Ex parte reexamination

**Reading Assignment:** MPEP Chapter 1400, Sections 1480-1485

**Class Handouts:** Sample Certificate of Correction; Sample Reissue Declaration

**Week 10 (October 30, 2023): International Patent Arena**

**Discussion Topics:** (1) Foreign Filing Practices (Direct Filing v. PCT); (2) Patent Cooperation Treaty Practices; and (3) Foreign Prosecution

**Reading Assignment:** MPEP Chapter 1800, Sections 1801-1812 and 1893-1896

**\*Assignment #2 Due**

**Week 11 (November 6, 2023): Searches**

**Discussion Topics:** (1) Due Diligence; (2) Freedom to Operate Searches; (3) Landscape Search;

(4) Patentability Search

**Reading Assignment:** TBD

**\*Final Presentation: Application selection due**

**Week 12 (November 13, 2023): Post Issuance**

**Discussion Topics:** (1) Appeal; (2) PGR; (3) IPR;

**Reading Assignment:** TBD

**\*Final Presentation outline due**

**Week 13 (November 20, 2023): Final Examination Presentation**

(Reading Period: November 27, 2023 – November 28, 2023)

20592301.3