



# PATENT PRACTICE FOR BEGINNERS

A PART OF THE IPWATCHDOG INSTITUTE

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## Syllabus and Schedule

# Patent Practice Training for Beginners: Everything You Need to Start Practicing

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| Faculty:   | John White & Gene Quinn   |
| Schedule:  | 6 days for 3 ½ hours; 18 hours of instruction plus 3 hours of Q&A<br>Classes meet on Mondays, Wednesdays & Fridays from 4pm ET to 7:30pm ET |
| Materials: | Course Book<br>6 months access to The Invent + Patent System™   |
| E-mail:    | Send assignments to Renee at <a href="mailto:beginners@ipwatchdog.com">beginners@ipwatchdog.com</a> .                                       |

You've passed the patent bar exam. Now what? Having a license to practice is just the beginning. Now you need to learn how to interact with clients, execute written agreements, handle money, prepare applications and respond to patent examiners. Knowing the rules is one thing, knowing how to do it in real life is quite another thing all together.

This course will provide all the tools necessary to hit the ground running. We will address everything you may need to do up to an appeal at the United States Patent and Trademark Office. Among other things, we will cover initial client intake, client agreements, patent searching, opinion letters, basic claim drafting, drafting patent applications, filing patent applications, responding to a restriction requirement, preliminary amendments, reporting office actions to a client, conducting examiner interviews, filing an amendment and response, the substantive law necessary to know for drafting and amending applications, and options for keeping a case alive after a final rejection.

At the end of this course students should have a strong grasp on the basics of day to day patent practice, and a catalogue of examples and templates to draw upon for a variety of the most common and likely occurrences in the life of a patent practitioner.

Familiarity with U.S. patent law and rules of practices is a prerequisite. This course is ideal for those patent practitioners with less than two years of experience, or law students entering a clerkship or internship between their second and third year of law school.

### Pre-Course Homework

At a minimum, please read *Course Materials* Pages 1 – 53 before class. We recommend you read as much of the *Course Materials* as possible prior to the first class and continue reading with Chapter 2100 of the *Abridged MPEP*.

### Day I – Initial Phase

Session #1  
4:00pm

Introduction to the Course

Ten Things Every Practitioner Should Know: (1) Writing patent applications; (2) The Patent Box; (3) Malpractice Insurance; (4) Finding clients; (5) Networking; (6) Overflow Work; (7) Reading patent files; (8) Patent searching; (9) Client trust accounts and accepting a retainer; and (10) Client agreements.

Client Intake: (1) Initial communications with potential clients; (2) Confidentiality owed to potential clients; (3) Conflict checks; (4) Initial discussions about the invention and advice about patents; (5) Knowing your limitations (legal and technical); (6) Managing expectations; (7) Engagement letters.

Session #2  
5:00pm

Evaluating a Patent Search: (1) Patent search vs. Google search vs. Real World Search; (2) Pros/cons of using Google and Free Patents Online for patent searches; (3) Preliminary patent searches; (4) How to work with a professional patent search firm; (5) Reviewing a professional patent search report; (6) Using Public PAIR to help formulate your opinion.

Writing a patentability opinion letter: (1) Defining the invention searched. (2) How detailed will you be? (3) What advice will you give? (4) Will you ever say absolutely no? (5) Are there insights you can provide based on the search done? (6) Is the project now complete? (7) Quoting further work.

Session #3  
6:00pm

Claim drafting 101. Basic claim drafting techniques for a variety of different types of claims including device claims, method claims, means plus function claims and systems claims.

Tutorial  
7pm

Open Q&A.

Homework #1

Reading, Claim Drafting & Search

## Day 2 – Drafting

Session #4  
4:00pm

A Prelude to Writing the Application: (1) The representation agreement and terms of payment; (2) Importance of filing a provisional patent application in a first to file system; (3) Scheduling work and informing the client; (4) Working with the patent illustrator; (5) Sketching out the patent claim.

Session #5  
5:00pm

Specification Drafting: (1) Defining the invention completely with alternatives and variations and with particular care to identify the improvements that will contribute to patentability; (2) Avoiding common mistakes that will unnecessarily limit the scope of protection; (3) Describing what matters and not sounding like an infomercial; and (4) The special case of software.

Session #6  
6:00pm

The Detailed Description of the Invention: (1) Hitting the happy medium between being specific and nuance while maintaining breadth; (2) Breaking down *Skeleton Bones* (i.e., hip bone connected to the thigh bone); and (3) Working with drawings.

Debriefing Homework #1

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| Tutorial<br>7:00pm | Open Q&A.  |
| Homework #2        | Reading & Drafting Assignment (i.e., Background & Summary) |

**Day 3 – Prosecution (Part I)**

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|---------------------------------|--|
| Session #7<br>4:00pm            | Filing and Fixing a Patent Application – Getting to Substantive Examination: (1) EFS Basics; (2) Application Data Sheet; (3) Oath/Declaration; (4) Making a priority claim; (5) Filing an Information Disclosure Statement (IDS); (6) Fixing common mistakes at the time of filing; (7) Filing a Preliminary Amendment; and (7) Responding to a Restriction Requirement. |
| Session #8<br>5:00pm            | Prosecution Basics: (1) Reviewing an Office Action; (2) Reporting an Office Action to a client; (3) Responding to the First Office Action on the Merits; (4) Using an interview with an examiner prior to responding to the First Office Action; (5) Amendment Writing; and (6) Examiner Interviews.   |
| Session #9<br>6:00pm            | Debrief Homework #2<br>Client Disclosure: <i>The Invent + Patent System</i> <sup>TM</sup>  |
| Tutorial<br>7:00pm              | Open Q&A.  |
| Homework #3                     | Reading  |
| <b>Day 4 – The Law (Part I)</b> |  |
| Session #10<br>4:00pm           | The law: 35 U.S.C. 101, 102, 103 and 112.  |
| Session #11<br>5:00pm           | The law (continued).   |
| Session #12<br>6:00pm           | The law (continued).   |
| Tutorial<br>7:00pm              | Open forum for Q&A.  |
| Homework #4                     | Reading.   |

### Day 5 – The Law (Part II)

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|-----------------------|--|
| Session #13<br>4:00pm | Arguing Rejections: Effectively & persuasively arguing 101 & 102 rejections in an Office Action. |
| Session #14<br>5:00pm | Arguing Rejections: Effectively & persuasively arguing 103 rejections in an Office Action.       |
| Session #15<br>6:00pm | A review of successful Office Action responses from a variety of different inventions.           |
| Tutorial<br>7:00pm    | Open Q&A.  |
| Homework #5           | Reading & Amendment & Response Exercise  |

### Day 6 – Prosecution (Part II)

|                       |  |
|-----------------------|--|
| Session #16<br>4:00pm | Filling in the Gaps with the <i>One of Everything</i> <sup>TM</sup> File: Request a Customer Number; Electronic Acknowledgement; Oath/Declaration; Substitute Statement; Nonpublication Request, Rescission of Nonpublication Request; Prioritized Examination; General Authorization, Petition to Reconsider; Notice to Correct Application Papers; Response to Notice to Correct Application Papers; Preliminary Amendment, Certificate of Mailing; ADS; Restriction; Response to Restriction; Request for Information; First Office Action on the Merits; Amendment & Response; Petition for Extension of Time 136(a); Petition for Extension of time 136(b); Double Patenting Rejection; Terminal Disclaimer; IDS; Request for Continued Examination; Continuation; Divisional; Continuation-in-Part; Declaration Under 1.132; AFCP 2.0; Pre-Appeal Brief Request for Review; Notice of Panel Decision Pre-Appeal Brief Review; Notice of Appeal; Request for Oral Hearing; Appeal Brief; <i>Ex parte Quayle</i> Amendment; Notice of Allowability; Notice of Allowance; Patent Term Adjustment; Request for Withdrawal; Statement of Interest 3.73(b); Power of Attorney; Express Abandonment 1.138; Express Abandonment; Electronic Patent Application Fee Transmittal; Design Patent Application; Continued Prosecution Application; U.S. National Phase Application. |
| Session #17<br>5:00pm | Filling in the gaps – <i>One of Everything</i> <sup>TM</sup> (continued)   |
| Session #18<br>6:00pm | Filling in the gaps – <i>One of Everything</i> <sup>TM</sup> (continued)<br>Debrief Homework #5  |
| Tutorial<br>7:00pm    | Open Q&A.  |