



Syllabus and Schedule

Patent Practice Training On-Demand: An Introduction to Patent Prosecution

Faculty:	John White & Gene Quinn
Schedule:	At your Own Pace (You have 3 months to complete the course)
Materials:	Course Book 6 months access to The Invent + Patent System™
E-mail:	Please send questions to Renee at PPT-On-Demand@ipwatchdog.com .

This course will provide all the tools necessary to hit the ground running in patent practice. 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 invention disclosures, client agreements, patent searching, opinion letters, basic claim drafting, drafting patent applications, filing patent applications, preliminary amendments, reporting office actions to clients, examiner interviews, filing an amendment and response, substantive law necessary for drafting and amending applications, making winning arguments, 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 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 – 38, and *Abridged MPEP* Pages 69-73; 104-109; 227-238; and 343-359. You are also encouraged to read as much as possible. Reading as much as possible before the course will make the course more manageable.

Section I – Initial Phase

Session #1 (1 hour)

Introduction to the Course

Materials 1-7

Twelve 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; (10) Client agreements; (11) Prospective clients; and (12) Ending a representation relationship.

Abridged MPEP 69-73

Patent App. 9-12; 31; 158-175

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.

Client Disclosure: *The Invent + Patent System*™

Session #2 (1 hour)
Materials 8-24
Patent App. 61-68; 222-236

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 advise will you give? (4) Will you every 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 (1 hour)
Materials Pgs. 25-38
Abridged MPEP 104-109;
227-238; 343-359

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.

Homework #1

Claim Drafting & Search Assignment Pgs. 39-42.
Read *Course Materials* Pgs. 43-103.

Section 2 – Drafting the Application

Session #4 (1 hour)
Materials 43-58
Patent App. 69-95

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 (1 hour)
Materials 59-82
Abridged MPEP 100-104
Patent App. 29-30; 69-95; 121-142

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

Session #6 (1 hour)
Materials 83-103

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); (3) Working with drawings; and (4) The special case of software

Debriefing Homework #1

Homework #2

Drafting Assignment Pgs. 104-113.
Read *Course Materials* Pgs. 114 – 122.
Abridged MPEP Chapter 700 Pgs. 129 – 166.

Section 3 – Prosecution (Part I)

Session #7 (1hour)
Abridged MPEP 54-61;
Materials 114

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 (1hour)
Materials 115-122
Abridged MPEP 152-166

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 (1hour)
Materials 103-113
Boxing GQ Edits PDF

Review Patent Application Course Materials Pgs. 123 – 143.
Debrief Homework #23

Homework #3 Abridged MPEP Pgs. 191 – 227; 241-308; 327-343.

Section 4 – The Law

Session #10 (1hour)
Abridged MPEP 191-227

The law: 35 U.S.C. 101

Session #11 (1hour)
Abridged MPEP 241-308

The law: 35 U.S.C. 102 & 103

Session #12 (1hour)
Abridged MPEP 327-343

The law: 35 U.S.C. 112

Homework #4 If you have not already completed the reading in Chapter 2100 of the *Abridged MPEP* please finish Chapter 2100.
Read *Course Materials* Pgs. 144 – 158.

Section 5 – Prosecution (Part II)

Session #13 (1hour)
Materials 144-158

Effectively & persuasively arguing 101 rejections in an Office Action.

Session #14 (1hour)

Effectively & persuasively arguing 103 rejections in an Office Action.

Abridged MPEP 169-174;
294-307

Session #15 (1hour)

Responding to 102 & 112 rejections in an Office Action.

Abridged MPEP 157-169;
174-182; 221-222;

A review of successful Office Action responses from a variety of different inventions.

Homework #5

Read *Course Materials* Pgs. 159 – 191.
Homework Assignment #5 on Pg. 185.
Abridged MPEP Chapter 200 Pgs. 5 – 26.
Abridge MPEP Chapter 500 Pgs. 35 – 69; 80-82; 115; 119; 183-190.

Section 6 – Prosecution (Part III)

Session #16 (1hour)

Abridged MPEP 5-26; 39-69;
183-190

Filling in the Gaps with the *One of Everything™* File: Request a Customer Number; Electronic Acknowledgement; Oath/Declaration; Substitute Statement; Nonpublication Requests; 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; *Ex parte Quayle* 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 (1hour)

Materials 159-191

Filling in the gaps –*One of Everything™* (continued)

Session #18 (1hour)

Abridged MPEP 10; 19; 23-24;
35-36; 50, 55-58; 66; 80-82;
115; 119

Filling in the gaps –*One of Everything™* (continued)

Debrief Homework #5