Syllabus and Schedule

Patent Practice Training:
An Introduction to Patent Prosecution

Faculty: John White & Gene Quinn

Schedule: Monday, May 4, 2020 – 7pm ET to 10:30pm ET
Wednesday, May 6, 2020 – 7pm ET to 10:30pm ET
Friday, May 8, 2020 – 7pm ET to 10:30pm ET
Monday May 11, 2020 – 7pm ET to 10:30pm ET
Wednesday, May 13, 2020 – 7pm ET to 10:30pm ET
Friday, May 15, 2020 – 7pm ET to 10:30pm ET
Monday, May 18, 2020 – 7pm ET to 10:30pm ET
Friday, May 22, 2020 – 7pm ET to 10:30pm ET

Materials: Course Materials
3 months access to The Invent + Patent System™

E-mail: Renee at PatentPractice@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, 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, strategic patent prosecution and more.

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 three years of experience.

Pre-Course Homework TBA
## Day 1 – Initial Phase

### Session #1
7:00pm EDT

Introduction to the Course

The Client Relationship: (1) Initial communications with potential clients; (2) Confidentiality; (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 and terms of payment; (8) Client trust accounts; and (9) Ending a Representation Relationship.

### Session #2
8:00pm EDT

Evaluating a Patent Search: (1) Patent search vs. Google search vs. Product search; (2) Pros/cons of using online sources for patent searching; (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 refine and formulate your opinion.

Patentability opinion letters: (1) Defining the invention searched. (2) How detailed will you be? (3) What advise will you give? (4) Will you every say no? (5) Insights you can provide based on the search done? (6) Is the project now complete? (7) Quoting future work.

### Session #3
9:00pm EDT

Claim Basics. Basic claim drafting techniques.

### Tutorial
10:00pm EDT

Open Q&A.

### Homework #1
TBA
Day 2 – Application Drafting (Part 1: The Basics)

Session #4
7:00pm EDT
A Prelude to Writing the Application: (1) Importance of filing a provisional patent application in a first to file system; (2) Scheduling work and informing the client; (3) Working with the patent illustrator and the importance of patent drawings; (4) Sketching out the patent claim.

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

Session #5
8:00pm EDT
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) Not confusing breadth with depth; (3) Avoiding the use of patent profanity without outsmarting yourself; (4) Avoiding common mistakes that will unnecessarily limit the scope of protection; and (5) Describing what matters and not sounding like an infomercial.

Session #6
9:00pm EDT
Introduction to The Invent & Patent System™
Debrief Homework #1

Tutorial
10:00pm EDT
Open Q&A.

Homework #2
TBA
Day 3 – Prosecution (Part I: The Basics)

Session #7
7:00pm EDT
Filing Basics: (1) Filing papers with the USPTO; (2) Depositing correspondence; (3) Completeness of the original application; (4) Deposit Accounts; (5) Large Entity vs. Small Entity vs. Micro Entity; (6) Postal service interruptions and emergencies; and (7) EFS-Web Basics.

Session #8
8:00pm EDT
Filing and Fixing a Patent Application – Getting to Substantive Examination: (1) Application Data Sheet; (2) Oath/Declaration; (3) Making a priority claim; (4) Filing an Information Disclosure Statement (IDS); and (5) Fixing common mistakes at the time of filing; (6) Filing a Preliminary Amendment; and (7) Responding to a Restriction Requirement.

Session #9
9:00pm EDT
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.

Tutorial
10:00pm EDT
Open Q&A.

Homework #3
TBA

Day 4 – The Law

Session #10
7:00pm EDT
The law: 35 U.S.C. 101

Session #11
8:00pm EDT
The law: 35 U.S.C. 102 & 103

Session #12
9:00pm EDT
The law: 35 U.S.C. 112

Tutorial
10:00pm EDT
Open forum for Q&A.

Homework #4
TBA
Day 5 – Application Drafting (Part II: The Examples)

Session #13 7:00pm EDT
Methods and Compounds. An examination of specifications and claims for a variety of different types of inventions that all qualify as either “methods” or “compounds”.

Session #14 8:00pm EDT
Devices. An examination of specifications and claims for a variety of different types of inventions that all qualify as “devices.”

Session #15 9:00pm EDT
Software. An examination of specifications and claims for software related innovations.

Tutorial 10:00pm EDT
Open Q&A.

Homework #5 TBA

Day 6 – Prosecution (Part II: Effectively Responding)

Session #16 7:00pm EDT
Effectively & persuasively arguing 101 rejections in an Office Action.

Session #17 8:00pm EDT
Effectively & persuasively arguing 103 rejections in an Office Action.

Session #18 9:00pm EDT
Responding to 102 & 112 rejections in an Office Action.

Tutorial 10:00pm EDT
Open Q&A.

Homework #6 TBA
Day 7 – Prosecution (Part III: Advanced Topics)

Session #19
7:00pm EDT
Tactics for Speeding up Allowances: (1) Can you cause a new examiner to be assigned? (2) Ombudsman; (3) Prioritized Examination (aka Track One); (4) Patent Prosecution Highway; and (5) Drafting with Purpose.

Session #20
8:00pm EDT
Supplementary Prosecution Topics: (1) Prosecution history disclaimer vs. Prosecution history estoppel; (2) Carefully considering infringers: Divided infringement; (3) Fixing problems before and after a Notice of Allowance; (4) Patent Law Treaty Reference Filing; and (5) QPIDS.

Session #21
9:00pm EDT

Tutorial
10:00pm EDT
Open Q&A.

Homework #7
TBA

Day 8 – Prosecution (Part IV)

Session #22
7:00pm EDT
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.
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