**PATENT PROSECUTION**

**SPRING TERM 2021**

**Law 6930 (Class Number 15172/23171)**

**3 Credits**

**Adjunct Professor**

Michael J. Colitz, III

**Required Text**

The required text for this course is:

Manual of Patent Examining Procedure (“MPEP”) Ninth Edition, Revision 10.2019 Last Revised June 2020 (<https://www.uspto.gov/web/offices/pac/mpep/index.html>).

Other handouts or materials may be assigned during the semester. You may access supplemental materials and view other course related information on the course TWEN® page. You are required to register on TWEN® by the end of the drop/add period for the semester. It is anticipated that you will spend approximately 2 hours out of class reading and/or preparing for in class assignments for every 1 hour in class.

**Classes**

Classes will be held on Wednesdays from 2:15-5:15 PM in classroom HH - 283/284

**Office Hours**

My office hours are on Wednesdays from Noon to 2:00 PM.

The office location is to be determined.

**Contact Information**

My contact information is as follows:

Michael J. Colitz, III

Email: colitz@law.ufl.edu

Phone: 813-857-3201

**Course Description**

This course teaches skills related to patent application preparation and prosecution for various technologies. Students will learn how to interview inventors, conduct a patentability search, render a patentability opinion, draft patent claims, draft a patent specification, electronically file a patent application, and respond to an office action. International patent protection and issues related to patent infringement will also be addressed. Most classes will include a lecture portion and a workshop portion. Patent bar eligibility is a prerequisite for the course and so is Patent Law.

**Student Learning Outcomes**

After completing this course, students should be able to:

1. Draft a utility patent application suitable for filing with the U.S. Patent and Trademark Office;

2. Prepare the formal paperwork associated with a utility patent application;

3. Conduct a patent search and render a patentability opinion;

4. Respond to an Office Action from the U.S. Patent and Trademark Office;

5. Effectively counsel a client on all matters related to patent application preparation and prosecution.

**Class Preparation, Participation, and Attendance**

**Class Preparation and Participation**

Preparation for class is mandatory. Before each class you must complete the assigned reading and writing assignments and be prepared to provide thoughtful answers to questions posed during class.

I expect you to participate meaningfully, professionally, and effectively in this course. Exceptional preparation and participation may, at my discretion, be rewarded with an increase of your final course grade by up to one letter grade. Conversely, those who are consistently unprepared and/or who do not participate meaningfully and professionally in class could be penalized with a deduction of up to one letter grade. My assessment of the strength of your participation in the course includes, but is not limited to, such factors as the quality of classroom comments, the amount of interest demonstrated in the subject, degree of preparation for class and willingness to respond to questions, demonstration of active engagement of the material via application to contemporaneous events, class attendance, disruptive, distracting, or unprofessional behavior in the classroom, and observance of course policies.

Please note that while I encourage the free exchange of ideas and opinions in class, expressions of disagreement must be made in a professional manner that is respectful of your classmates.

Conducting yourselves in a professional manner also means not engaging in any behavior during class that may distract us or your classmates. This includes, but is not limited to, playing computer games, surfing the web, sending e-mails, and any other use of your computers during class that does not involve note taking. Your failure to comply with this policy may be subject to the grade deduction for participation described above, your removal from the classroom, and/or loss of your privilege to use a laptop in the classroom.

Students should expect to spend at least two hours outside of class reading and preparing for every hour of class

**Class Attendance**

Attendance is mandatory and you are expected to be on time. It is your responsibility to locate and initial the sign-in sheet for each class session.

If you have three (3) or more absences, you may automatically fail this course. Alternatively, three (3) or more absences may result in a reduction of your grade as described above in the section describing grade adjustments for course participation. Please contact me if you anticipate missing class.

**Policy related to Make-up exams or other work**

The law school policy on delays in taking exams can be found at:

<https://www.law.ufl.edu/life-at-uf-law/office-of-student-affairs/current-students/forms-applications/exam-delays-accommodations-form>

**Statement related to accommodations for students with disabilities**

Students requesting classroom accommodation must first register with the Office of Disability Resources. The UF Office of Disability Resources will provide documentation to the student who must then provide this documentation to the Law School Office of Student Affairs when requesting accommodation.

**Grading**

Your final course grade will be based principally on the writing and drafting assignments during the semester, class participation, and possibly a practical test of patent procedure.

The reading and writing assignments will generally be due prior to the start of the next class. We will take time during class to review your writing assignments.

The law school grading policy is available at:

<https://www.law.ufl.edu/life-at-uf-law/office-of-student-affairs/current-students/uf-law-student-handbook-and-academic-policies>

**Recording Devices and Cell Phones**

Use of any recording devices (including audio and/or video) is not permitted in the classroom without my express permission. Cellular telephones should not be used during class, and ringers must be silenced.

**Student Course Evaluations**

Students can provide feedback on the quality of instruction in this course by completing online evaluations at https://evaluations.ufl.edu. Evaluations are typically open during the last two or three weeks of the semester, but students will receive notice of the specific times when they are open. Summary results of these assessments are available to students at <https://evaluations.ufl.edu/results/>

**Academic misconduct/honesty**

Academic honesty and integrity are fundamental values of the University community. Students should be sure that they understand the UF Student Honor Code at <https://www.law.ufl.edu/life-at-uf-law/office-of-student-affairs/additional-information/honor-code-and-committee/honor-code>

**Covid Related Practices**

Many students will have face-to-face instructional sessions to accomplish the student learning objectives of this course. In response to COVID-19, the following policies and requirements are in place to maintain your learning environment and to enhance the safety of our in-classroom interactions. I may take noncompliance into account when grading students or determining if a student may remain in the course.

* You are required to wear approved face coverings at all times during class and within buildings. Following and enforcing these policies and requirements are all of our responsibility. Failure to do so will lead to a report to the Office of Student Conduct and Conflict Resolution. You also will no longer be permitted on the UF Law campus. Finally, Dean Inman will also report your noncompliance to the relevant state board of bar examiners.
* This course has been assigned a physical classroom with enough capacity to maintain physical distancing (6 feet between individuals) requirements. Please utilize designated seats and maintain appropriate spacing between students. Please do not move desks or stations.
* Sanitizing supplies are available in the classroom if you wish to wipe down your desks prior to sitting down and at the end of the class.
* Be mindful of how to properly enter and exit the classroom.  Practice physical distancing to the extent possible when entering and exiting the classroom.
* If you are experiencing COVID-19 symptoms (<https://www.cdc.gov/coronavirus/2019-ncov/symptoms-testing/symptoms.html>), please do not come to campus or, if you are already on campus, please immediately leave campus. Please use the UF Health screening system and follow the instructions about when you are able to return to campus.  (See <https://coronavirus.ufhealth.org/screen-test-protect/covid-19-exposure-and-symptoms-who-do-i-call-if/>.)
* Course materials will be provided to you with an excused absence, and you will be given a reasonable amount of time to make up work. (See <https://catalog.ufl.edu/UGRD/academic-regulations/attendance-policies/)>.”

**Health and Wellness Resources**

* *U Matter, We Care*: If you or someone you know is in distress, please contact [umatter@ufl.edu,](mailto:umatter@ufl.edu) 352-392-1575, or visit [U Matter, We Care website](https://umatter.ufl.edu/) to refer or report a concern and a team member will reach out to the student in distress.
* *Counseling and Wellness Center*: [Visit the Counseling and Wellness Center website](https://counseling.ufl.edu/) or call 352-392-1575 for information on crisis services as well as non-crisis services.
* *Student Health Care Center*: Call 352-392-1161 for 24/7 information to help you find the care you need, or [visit the Student Health Care Center website](https://shcc.ufl.edu/).
* *University Police Department*: [Visit UF Police Department website](https://police.ufl.edu/) or call 352-392-1111 (or 9-1-1 for emergencies).
* *UF Health Shands Emergency Room / Trauma Center:* For immediate medical care call 352-733-0111 or go to the emergency room at 1515 SW Archer Road, Gainesville, FL 32608; [Visit the UF Health Emergency Room and Trauma Center website](https://ufhealth.org/emergency-room-trauma-center).

**TOPICS AND READING ASSIGNMENTS**

| **Lesson No.** | **Topic** | **Reading Assignment:**  **Manual of Patent Examining Procedure[[1]](#footnote-1)** |
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| Lesson 1 (01.20.21) | **Pre-Filing:**  Inventorship  Ownership  Utility  Eligibility | **Inventorship MPEP §2109**  <https://mpep.uspto.gov/RDMS/MPEP/current#/current/ch2100_d2c183_22374_28b.html>  **Ownership MPEP §301[[2]](#footnote-2)**  <https://mpep.uspto.gov/RDMS/MPEP/current#/current/d0e17683.html>  **Utility MPEP §2107- 2107.01**  <https://mpep.uspto.gov/RDMS/MPEP/current#/current/d0e198469.html>  **Subject Matter Eligibility MPEP §2106**  <https://mpep.uspto.gov/RDMS/MPEP/current#/current/d0e197244.html> |
| Lesson 2 (01.27.21) | **Pre-Filing:**  Time Bars | **Novelty and Non-obviousness MPEP §2151**  <https://mpep.uspto.gov/RDMS/MPEP/current#/current/ch2100_d2002f_22873_3d8.html>  **Sections 102(a) and 102(b) MPEP §2152-2152.06**  <https://mpep.uspto.gov/RDMS/MPEP/current#/current/ch2100_d20033_18e23_3ce.html>  **Prior Art Exceptions MPEP §2153-2153.02**  <https://mpep.uspto.gov/RDMS/MPEP/current#/current/ch2100_d20033_24b48_9c.html> |
| Lesson 3 (02.03.21) | **Pre-Filing:**  Novelty  Non-Obviousness  Patent Searching | **Form Patentability Opinion**  **Review of Cooperative Patent Classifications**  <https://www.uspto.gov/web/patents/classification/cpc/html/cpc.html> |
| Lesson 4 (02.10.21) | **Application Preparation:**  Drawings/  Nomenclature | **Drawings MPEP 608.02**  <https://mpep.uspto.gov/RDMS/MPEP/current#/current/d0e47639.html> |
| Lesson 5 (02.17.21) | **Application Preparation:**  Claim Drafting | **Form of Claims MPEP §608.01(i)**  <https://mpep.uspto.gov/RDMS/MPEP/current#/current/d0e44872.html>  **Numbering of Claims MPEP §608.01(j)**  <https://mpep.uspto.gov/RDMS/MPEP/current#/current/d0e44973.html>  **Requirement of Claims MPEP §608.01(k)**  <https://mpep.uspto.gov/RDMS/MPEP/current#/current/d0e45039.html>  **Claims as Part of Disclosure MPEP §608.01(l)**  <https://mpep.uspto.gov/RDMS/MPEP/current#/current/d0e45048.html>  **Form of Claims MPEP §608.01(m)**  <https://mpep.uspto.gov/RDMS/MPEP/current#/current/d0e45061.html> |
| Lesson 6 (02.24.21) | **Application Preparation:**  Dependent Claims  Means plus Function | **Dependent Claims MPEP §608.01(n)**  <https://mpep.uspto.gov/RDMS/MPEP/current#/current/d0e45256.html> |
| Lesson 7 (03.03.21) | **Application Preparation:**  Detailed Description | **Detailed Description MPEP §608.01(g)**  <https://mpep.uspto.gov/RDMS/MPEP/current#/current/d0e44731.html>  **Best Mode MPEP §608.01(h)**  <https://mpep.uspto.gov/RDMS/MPEP/current#/current/d0e44799.html> |
| Lesson 8 (03.10.21) | **Application Preparation:**  Background Summary | **Background MPEP §608.01(c)**  <https://mpep.uspto.gov/RDMS/MPEP/current#/current/d0e44561.html>  **Summary MPEP §608.01(d)**  <https://mpep.uspto.gov/RDMS/MPEP/current#/current/d0e44589.html> |
| Lesson 9  (03.17.21) | **Application Preparation:** Formal Papers  Information Disclosure Statements | **Application Data Sheet MPEP §601.05**  <https://mpep.uspto.gov/RDMS/MPEP/current#/current/d0e37403.html>  **Oath or Declaration MPEP §602.01-601.01(b)**  <https://mpep.uspto.gov/RDMS/MPEP/current#/current/d0e38244.html>  **Information Disclosure Statements MPEP §609**  <https://mpep.uspto.gov/RDMS/MPEP/current#/current/d0e52594.html> |
| Lesson 10 (03.24.21) | **Prosecution:**  Election  First Office Action | **Restriction: MPEP §802-§803**  <https://mpep.uspto.gov/RDMS/MPEP/current#/current/d0e97846.html>  <https://mpep.uspto.gov/RDMS/MPEP/current#/current/d0e98022.html>  **Distinctness and Independence: MPEP §806-§806.06**  <https://mpep.uspto.gov/RDMS/MPEP/current#/current/d0e103638.html>  **Election and Reply MPEP §818, §818.01-818.02**  <https://mpep.uspto.gov/RDMS/MPEP/current#/current/d0e107481.html>  **Manner of Making Amendments MPEP §714-714.05**  <https://mpep.uspto.gov/RDMS/MPEP/current#/current/d0e85040.html> |
| Lesson 11 (03.31.21) | **Prosecution:**  Foreign Filing | **Notes to the Request Form (PCT/RO/101)**  <http://www.wipo.int/export/sites/www/pct/en/forms/request/ed_request.pdf> |
| Lesson 12  (04.07.21) | **Prosecution:**  Interviews  After Final Practice | **Interviews MPEP §713**  <https://mpep.uspto.gov/RDMS/MPEP/current#/current/d0e84376.html>  **After Final Practice MPEP §714.12 - §714.13**  <https://mpep.uspto.gov/RDMS/MPEP/current#/current/d0e85040.html>  **Final Rejections MPEP §706-706.07**  <https://mpep.uspto.gov/RDMS/MPEP/current#/current/d0e57969.html> |
| Lesson 13  (4.14.21) | **Post Issuance:**  Maintenance  Reissue  Re-exam | **Maintenance MPEP §2501**  <https://mpep.uspto.gov/RDMS/MPEP/current#/current/d0e247910.html>  **Reissue MPEP §1400.01-1401**  <https://mpep.uspto.gov/RDMS/MPEP/current#/current/d0e134589.html>  <https://mpep.uspto.gov/RDMS/MPEP/current#/current/d0e134632.html>  **Re-Examination MPEP §2209**  <https://mpep.uspto.gov/RDMS/MPEP/current#/current/d0e221775.html> |

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1. Manual of Patent Examining Procedure (MPEP) Ninth Edition, Revision 10.2019 Last Revised June 2020 [↑](#footnote-ref-1)
2. MPEP citations do not include subsections unless otherwise specified. [↑](#footnote-ref-2)