**PATENT PROSECUTION**

**SPRING TERM 2019**

**Law 6930 (Class Number 16159)**

**3 Credits**

**Adjunct Professors**

Michael J. Colitz, III

Thomas C. McThenia, Jr.

**Required Text**

The required text for this course is How to Write a Patent Application, Second Edition, Practicing Law Institute, Jeffrey G. Sheldon (3rd Ed.)

Manual of Patent Examining Procedure (MPEP) Ninth Edition, Revision 08.2017, Last Revised January 2018

(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. Students should expect to spend, on average, approximately two hours preparing for every hour of class. That preparation will include reading and writing assignments as well as related research activities.

**Classes**

Classes will be held on Thursdays from 4:00-6:30 p.m. in classroom HH - 285A

**Office Hours**

Our office hours are on Thursdays from 2:00-4:00 p.m.

The office is in Holland Hall, Room 356.

**Contact Information**

Our office at the law school is in Holland Hall. Our e-mail addresses are:

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**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**

**A. 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.

We expect you to participate meaningfully, professionally, and effectively in this course. Exceptional preparation and participation may, at our 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. Our 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 we 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.

**B. 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 one of the instructors 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:

http://www.law.ufl.edu/student-affairs/current-students/academic-policies.

**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: http://www.law.ufl.edu/student-affairs/current-students/academic-policies.

**Recording Devices and Cell Phones**

Use of any recording devices (including audio and/or video) is not permitted in the classroom without our 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

**TOPICS AND READING ASSIGNMENTS**

| **Lesson No.** | **Topic** | **Reading Assignment:**  **Sheldon[[1]](#footnote-1)** | **Reading Assignment:**  **Manual of Patent Examining Procedure[[2]](#footnote-2)** |
| --- | --- | --- | --- |
| Lesson 1 (1.10.19) | Pre-Filing:  Inventorship | Sheldon Chapter 4 | None |
| Lesson 2 (1.17.19) | Pre-Filing:  Time Bars | None | Manual of Patent Examining Procedure (M.P.E.P.) §2151  http://www.uspto.gov/web/offices/pac/mpep/s2151.html  Manual of Patent Examining Procedure (M.P.E.P.) §2152  https://www.uspto.gov/web/offices/pac/mpep/s2152.html  Manual of Patent Examining Procedure (M.P.E.P.) §2153  http://www.uspto.gov/web/offices/pac/mpep/s2153.html |
| Lesson 3 (1.24.19) | Pre-Filing:  Patent Searching/  Opinions | Sheldon Chapter 5: The Patentability Search | None |
| Lesson 4 (1.31.19) | Preparing the Application:  Drawings/  Nomenclature | Sheldon Chapter 6: Drawings | None |
| Lesson 5 (2.7.19) | Preparing the Application:  Claim Drafting | Sheldon §8:1 - §8:3 | None |
| Lesson 6 (2.14.19) | Preparing the Application:  Dependent Claims, Means plus Function | Sheldon §8:4 - §8:5 | None |
| Lesson 7 (2.21.19) | Preparing the Application:  Method and System Claims | Sheldon §8:6 | None |
| Lesson 8 (2.28.19) | Preparing the Application:  Patent Specification | Sheldon §9:1- §9:3 | None |
| Lesson 9 (3.14.19) | Preparing the Application:  Background and Summary | Sheldon  §9:5 | None |
| Lesson 10 (3.21.19) | Preparing the Application: Disclosure of Prior Art,  Formal Papers | Sheldon  10; §2:1, §2:2, §2:3 | None |
| Lesson 11 (3.28.19) | Patent Prosecution:  First Office Action | None | Manual of Patent Examining Procedure (M.P.E.P.) §818  http://www.uspto.gov/web/offices/pac/mpep/s818.html  Manual of Patent Examining Procedure (M.P.E.P.) §714  http://www.uspto.gov/web/offices/pac/mpep/s714.html |
| Lesson 12 (4.4.19) | Foreign Filing | Sheldon Chapter 18 | Notes to the Request Form (PCT/RO/101)  (http://www.wipo.int/export/sites/www/pct/en/forms/request/ed\_request.pdf) |
| Lesson 13 (4.11.19) | Patent Prosecution:  After Final Practice | None | Manual of Patent Examining Procedure (M.P.E.P.) §713  (http://www.uspto.gov/web/offices/pac/mpep/s713.html)  Manual of Patent Examining Procedure (M.P.E.P.) §714.12 - §714.13  (<http://www.uspto.gov/web/offices/pac/mpep/s714.html#d0e88092>) |
| Lesson 14 (4.18.19) | Continuing Applications,  Post Grant Procedures | Sheldon, How to Write a Patent Application: §9:5.5 | Manual of Patent Examining Procedure (M.P.E.P.) §201  (https://www.uspto.gov/web/offices/pac/mpep/s201.html) |

1. How to Write a Patent Application, Second Edition, Practicing Law Institute, Jeffrey G. Sheldon (3rd Ed.) [↑](#footnote-ref-1)
2. Manual of Patent Examining Procedure (MPEP) Ninth Edition, Revision 08.2017, Last Revised January 2018 [↑](#footnote-ref-2)