**PATENT PROSECUTION**

**SPRING TERM 2023**

**Law 6930 (Class Number 13910)**

**3 Credits**

**INSTRUCTOR**

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Office Hours: Monday Noon to 2PM

**MEETING TIME:** Monday 3:30PM to 6:30 PM

**LOCATION:** HH - 270

**COURSE DESCRIPTION AND OBJECTIVES:**

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 Law is a prerequisite for the course.

**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.

**REQUIRED READING MATERIALS:**

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 CANVAS page.

**COURSE EXPECTATIONS AND GRADING EVALUATION:**

Your final course grade will be based principally on the writing and drafting assignments during the semester. This includes an initial memo, a patentability opinion, a final patent application, and an office action response. You participation in class will also contribute to your final grade.

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.

**CLASS ATTENDANCE POLICY:**  
Attendance in class is required by both the ABA and the Law School. Attendance will be taken at each class meeting. Students are allowed three (3) absences during the course of the semester. Students are responsible for ensuring that they are not recorded as absent if they come in late. A student who fails to meet the attendance requirement will be dropped from the course. The law school’s policy on attendance can be found [here](https://www.law.ufl.edu/life-at-uf-law/office-of-student-affairs/current-students/uf-law-student-handbook-and-academic-policies#:~:text=co%2Dcurricular%20activities.-,Attendance,regular%20and%20punctual%20class%20attendance.&text=UF%20Law%20policy%20permits%20dismissal,of%2012%20credits%20per%20semester.).

**UF LEVIN COLLEGE OF LAW STANDARD SYLLABUS POLICIES:**

Other information about UF Levin College of Law policies, including compliance with the UF Honor Code, Grading, Accommodations, Class Recordings, and Course Evaluations can be found at this link: https://ufl.instructure.com/courses/427635/files/74674656?wrap=1.

**ABA OUT-OF-CLASS HOURS REQUIREMENTS:** ABA Standard 310 requires that students devote 120 minutes to out-of-class preparation for every “classroom hour” of in-class instruction. Each weekly class is approximately 3 hours in length, requiring at least 6 hours of preparation outside of class including reading the assigned materials and working on your drafting assignment for that week.

**COURSE SCHEDULE OF TOPICS AND ASSIGNMENTS**

This syllabus is offered as a guide to the direction of the course. Our pace will depend in part on the level of interest and the level of difficulty of each section and is subject to change.

| **Lesson No.** | **Topic** | **Reading Assignment:**  **Manual of Patent Examining Procedure[[1]](#footnote-1)** |
| --- | --- | --- |
| Lesson 1 (01.23.23) | **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 (01.30.23) | **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 (02.06.23) | **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 (02.13.23) | **Application Preparation:**  Drawings/  Nomenclature | **Drawings MPEP 608.02**  <https://mpep.uspto.gov/RDMS/MPEP/current#/current/d0e47639.html> |
| Lesson 5 (02.20.23) | **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 (02.27.23) | **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 (03.06.23) | **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 (03.20.23) | **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  (03.27.23) | **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  (04.03.23) | **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 (04.10.23) | **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  (04.17.23) | **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  (4.24.23) | **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)