PATENT PROSECUTION UNIVERSITY OF FLORIDA LEVIN COLLEGE OF LAW SEMESTER SYLLABUS

SEMESTER SYLLABUS SPRING TERM 2025 Law 6930 (Class Number 23174) 3 Credits

Adjunct Professor

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Office Hours: Monday 2PM – 4PM

Office Location: 323F

Meeting Time: Mondays, 4:30PM to 7:30PM

Location: HH - 355A

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 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.

Required Reading Materials:

Manual of Patent Examining Procedure ("MPEP") Ninth Edition, Revision 10.2024 Last Revised January 2024 (https://www.uspto.gov/web/offices/pac/mpep/index.html).

Other handouts or materials may be assigned during 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.

Course Expectations and Grading Evaluation:

Your final course grade will be based principally on the writing and drafting assignments during the semester and class participation. More specifically, your grade will be based upon: an initial memorandum (20%), a patentability opinion (20%), a patent application (30%), an Office Action response, (20%), and class participation (10%).

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:

 $\frac{https://www.law.ufl.edu/life-at-uf-law/office-of-student-affairs/current-students/uf-law-student-handbook-and-academic-policies}{https://www.law.ufl.edu/life-at-uf-law/office-of-student-affairs/current-students/uf-law-student-handbook-and-academic-policies}\\$

Class Attendance Policy:

Compliance With Uf Honor Code:

Academic honesty and integrity are fundamental values of the University community. Students should be sure that they understand the UF Law Honor Code located here. The UF Law Honor Code also prohibits use of artificial intelligence, including, but not limited to, ChatGPT and Harvey, to assist in completing quizzes, exams, papers, or other assessments unless expressly authorized by the professor to do so.

Information On Uf Law Grading Policies:

The Levin College of Law's mean and mandatory distributions are posted on the College's website and this class adheres to that posted grading policy. The following chart describes the specific letter grade/grade point equivalent in place:

Letter	Point	Letter Grade	Point
Grade	Equivalent		Equivalent
A	4.0	С	2.0
(Excellent)		(Satisfactory)	
A-	3.67	C-	1.67
B+	3.33	D+	1.33
В	3.0	D (Poor)	1.0
B-	2.67	D-	0.67
C+	2.33	E (Failure)	0.0

The law school grading policy is available <u>here</u>.

Observance Of Religious Holidays:

UF Law respects students' observance of religious holidays.

- Students, upon prior notification to their instructors, shall be excused from class or other scheduled academic activity to observe a religious holy day of their faith.
- Students shall be permitted a reasonable amount of time to make up the material or activities covered in their absence.
- Students shall not be penalized due to absence from class or other scheduled academic activity because of religious observances.

Exam Delays And Accommodations:

The law school policy on exam delays and accommodations can be found <u>here</u>.

Statement Related To Accomodations For Students With Disabilities:

Students requesting accommodations for disabilities must first register with the Disability Resource Center (https://disability.ufl.edu/). Once registered, students will receive an accommodation letter, which must be presented to the Assistant Dean for Student Affairs (Assistant Dean Brian Mitchell). Students with disabilities should follow this procedure as early as possible in the semester. It is important for students to share their accommodation letter with their instructor and discuss their access needs as early as possible in the semester. Students may access information about various resources on the UF Law Student Resources Canvas page, available at https://ufl.instructure.com/courses/427635.

Student Course Evaluations:

Students are expected to provide professional and respectful feedback on the quality of instruction in this course by completing course evaluations online via GatorEvals. Click here for guidance on how to give feedback in a professional and respectful manner. Students will be notified when the evaluation period opens and may complete evaluations through the email they receive from GatorEvals, in their Canvas course menu under GatorEvals, or via https://ufl.bluera.com/ufl/. Summaries of course evaluation results are available to students here.

Recordings Of Class:

Students are allowed to record video or audio of class lectures. However, the purposes for which these recordings may be used are strictly controlled. The only allowable purposes are (1) for personal educational use, (2) in connection with a complaint to the university, or (3) as evidence in, or in preparation for, a criminal or civil proceeding. All other purposes are prohibited. Specifically, students may not publish recorded lectures without the written consent of the instructor. A "class lecture" is an educational presentation intended to inform or teach enrolled students about a particular subject, including any instructor-led discussions that form part of the presentation, and delivered by any instructor hired or appointed by the University, or by a guest

instructor, as part of a University of Florida course. A class lecture does not include lab sessions, student presentations, clinical presentations such as patient history, academic exercises involving solely student participation, assessments (quizzes, tests, exams), field trips, private conversations between students in the class or between a student and the faculty or guest lecturer during a class session. Publication without permission of the instructor is prohibited. To "publish" means to share, transmit, circulate, distribute, or provide access to a recording, regardless of format or medium, to another person (or persons), including but not limited to another student within the same class section. Additionally, a recording, or transcript of a recording, is considered published if it is posted on or uploaded to, in whole or in part, any media platform, including but not limited to social media, book, magazine, newspaper, leaflet, or third-party note/tutoring services. A student who publishes a recording without written consent may be subject to a civil cause of action instituted by a person injured by the publication and/or discipline under UF Regulation 4.040 Student Honor and Student Conduct Code.

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, writing critical analyses, and developing your final paper.

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.

TOPICS AND SUGGESTED READING ASSIGNMENTS

Lesson No.	Topics	Reading Assignment: Manual of Patent Examining Procedure ¹
Lesson 1	CLIENT	Inventorship (MPEP §2109)
(01.13.25)	COUNSELING:	https://mpep.uspto.gov/RDMS/MPEP/current#/current/ch21
		<u>00_d2c183_22374_28b.html</u>
	 Inventorship 	
	• Joint Inventorship	Joint Inventorship (MPEP §2109.01)
	 Ownership 	https://mpep.uspto.gov/RDMS/MPEP/current#/current/ch21 00 d2c1f8 278a7 1e6.html
	• Assignment	00_d2c118_278a7_feo.html
	• Utility	Ownership/Assignment (MPEP §301-308/324-325²)
	Eligibility	https://mpep.uspto.gov/RDMS/MPEP/current#/current/d0e1
		<u>7683.html</u>
		Utility (MPEP §2107- 2107.02)
		https://mpep.uspto.gov/RDMS/MPEP/current#/current/d0e1
		<u>98469.html</u>
		Eligibility (MPEP §2106-2106.06)
		https://mpep.uspto.gov/RDMS/MPEP/current#/current/d0e1
		<u>97244.html</u>
Lesson	Topics	Reading Assignment:
No.		Manual of Patent Examining Procedure
Lesson 2	CLIENT	AIA vs. Pre-AIA (MPEP §2151)
(01.27.25)	COUNSELING :	https://mpep.uspto.gov/RDMS/MPEP/current#/current/
	• AIA vs. Pre-AIA	<u>ch2100_d2002f_22873_3d8.html</u>
	• Time Bars	Sections 102(a) and 102(b) (MPEP §2152-2152.06)
	§102(a) -§102(b)	https://mpep.uspto.gov/RDMS/MPEP/current#/current/ch21
		00 d20033 18e23 3ce.html
		Prior Art Exceptions (MPEP §2153-2153.02)
		https://mpep.uspto.gov/RDMS/MPEP/current#/current/ch21
		00_d20033_24b48_9c.html

¹ Manual of Patent Examining Procedure (MPEP) Ninth Edition, Revision 01.2024 Last Revised January 2024 ² MPEP citations do not include subsections unless otherwise specified.

Lesson No.	Topics	Reading Assignment: Manual of Patent Examining Procedure ¹
Lesson 3 (02.03.25)	CLIENT COUNSELING: Novelty Non-Obviousness Patent Searches Patentability Opinions	Novelty (MPEP §2131-2131.05) https://mpep.uspto.gov/RDMS/MPEP/current#/current/d0e2 02959.html Non-Obviousness (MPEP §2141-2141.03) https://mpep.uspto.gov/RDMS/MPEP/current#/current/d0e2 08143.html Review of Cooperative Patent Classifications https://www.uspto.gov/web/patents/classification/cpc/html/cpc.html Form Patentability Opinion https://www.dropbox.com/scl/fi/xbsov6wjr9et5b3oyy4hh/F ORM-limited-patentability-opinion-letter-to-client.DOC?rlkey=0gxtykost7b1b7x8irn5wv93w&st=hopx4 4bz&dl=0
Lesson 4 (02.10.25)	 APPLICATION PREPARATION: Drawings Nomenclature Design Applications 	Drawings (MPEP §608.02) https://mpep.uspto.gov/RDMS/MPEP/current#/current/d0e4 7639.html Design Applications (MPEP §1503-1503.02) https://mpep.uspto.gov/RDMS/MPEP/current#/current/d0e1 50419.html

Lesson	Topics	Reading Assignment:
No.		Manual of Patent Examining Procedure ¹
Lesson 5	APPLICATION	Claims (MPEP §608.01(i))
(02.17.25)	PREPARATION:	https://mpep.uspto.gov/RDMS/MPEP/current#/current/d0e4
		4872.html
	Claims and	
	Claim Drafting	Numbering of Claims (MPEP §608.01(j))
	Claim Diaming	https://mpep.uspto.gov/RDMS/MPEP/current#/current/d0e4
		4973.html
		47/3.11tm
		Requirement of Claims (MPEP §608.01(k))
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		https://mpep.uspto.gov/RDMS/MPEP/current#/current/d0e4
		<u>5039.html</u>
		Cl-: D4 - CD:1 (MDED 2 (00 01 (1))
		Claims as Part of Disclosure (MPEP §608.01(l))
		https://mpep.uspto.gov/RDMS/MPEP/current#/current/d0e4
		<u>5048.html</u>
		Form of Claims MPEP (§608.01(m))
		https://mpep.uspto.gov/RDMS/MPEP/current#/current/d0e4
		<u>5061.html</u>
		Particularly Pointing Out and Distinctly Claiming the
		Invention (MPEP §2173-2173.06)
		https://mpep.uspto.gov/RDMS/MPEP/current#/current/d0e2
		17564.html
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Lesson No.	Topics	Reading Assignment: Manual of Patent Examining Procedure
Lesson 6 (02.24.25)	APPLICATION PREPARATION: • Dependent Claims • Means plus Function	Dependent Claims (MPEP §608.01(n)) https://mpep.uspto.gov/RDMS/MPEP/current#/current/d0e4 5256.html Means Plus Function Limitations (MPEP §2181) https://mpep.uspto.gov/RDMS/MPEP/current#/current/d0e2 19279.html
Lesson 7 (03.03.25)	APPLICATION PREPARATION: Specification Detailed Description Written Description Enablement Best Mode	Detailed Description (MPEP §608.01(g)) https://mpep.uspto.gov/RDMS/MPEP/current#/current/d0e4 4731.html Written Description, Enablement, and Best Mode (MPEP §2161) https://mpep.uspto.gov/RDMS/MPEP/current#/current/d0e2 13359.html Written Description (MPEP §2163.03) https://mpep.uspto.gov/RDMS/MPEP/current#/current/d0e2 14623.html Enablement (MPEP §2164-2164.06(a)) https://mpep.uspto.gov/RDMS/MPEP/current#/current/d0e2 15224.html Best Mode (MPEP §2165-2165.04) https://mpep.uspto.gov/RDMS/MPEP/current#/current/d0e2 16924.html Outline for Patent Application https://www.dropbox.com/scl/fi/ftqmyj5uqvopdlnlcjruf/FO RM-Utility-Patent-Application- Boilerplate.DOC?rlkey=85atz6x32zqtcjnupj87ob3ej&st=tgb ah0u0&dl=0

Lesson No.	Topics	Reading Assignment: Manual of Patent Examining Procedure
Lesson 8 (03.10.25)	APPLICATION PREPARATION: Specification Background Summary Brief Description of Drawings Abstract	Background MPEP (§608.01(c)) https://mpep.uspto.gov/RDMS/MPEP/current#/current/d0e4 4561.html Summary MPEP (§608.01(d)) https://mpep.uspto.gov/RDMS/MPEP/current#/current/d0e4 4589.html Brief Description of the Drawings (MPEP §608.01(f)) https://mpep.uspto.gov/RDMS/MPEP/current#/current/d0e4 4626.html Abstract of the Disclosure (MPEP §608.01(b)) https://mpep.uspto.gov/RDMS/MPEP/current#/current/d0e4 4136.html
Lesson 9 (03.24.25)	APPLICATION PREPARATION: Formal Papers ADS Oath/Declaration Power of Attorney Assignment Recordation Information Disclosure Statement	Application Data Sheet (MPEP §601.05) https://mpep.uspto.gov/RDMS/MPEP/current#/current/d0e3 7403.html Oath or Declaration (MPEP §602.01-601.01(b) https://mpep.uspto.gov/RDMS/MPEP/current#/current/d0e3 8244.html Power of Attorney (MPEP 402.02(a)) https://mpep.uspto.gov/RDMS/MPEP/current#/current/ch40 0_d1fe3a_237c2_34b.html Assignment Recordation (MPEP §302-308/§324-325) https://mpep.uspto.gov/RDMS/MPEP/current#/current/d0e1 8031.html Information Disclosure Statements (MPEP §609) https://mpep.uspto.gov/RDMS/MPEP/current#/current/d0e5 2594.html

Lesson No.	Topics	Reading Assignment: Manual of Patent Examining Procedure
Lesson 10	PROSECUTION:	Restriction (MPEP §802-§803)
(03.31.25)	TROSECUTION.	https://mpep.uspto.gov/RDMS/MPEP/current#/current/d0e9
(05.51.25)	Restriction	7846.html
	• Election	<u> </u>
	• First Office	https://mpep.uspto.gov/RDMS/MPEP/current#/current/d0e9
	Action	<u>8022.html</u>
	Office Action	
	Response	Distinctness and Independence: (MPEP §806-§806.06)
	Response	https://mpep.uspto.gov/RDMS/MPEP/current#/current/d0e1 03638.html
		<u>03038.IIIIII</u>
		Election and Reply (MPEP §818, §818.01-818.02)
		https://mpep.uspto.gov/RDMS/MPEP/current#/current/d0e1
		<u>07481.html</u>
		Manner of Making Amendments (MPEP §714-714.05)
		https://mpep.uspto.gov/RDMS/MPEP/current#/current/d0e8
		5040.html
		Outline for OA Response
		https://www.dropbox.com/scl/fi/bo3g8zpt4irogioq09jna/FO
		RM-Patent-Office-Action-response-boilerplate-
		amendment.DOC?rlkey=9zhhth1q4wgjivnr05dn490i0&st=0
		qgzbzwn&dl=0
Lesson 11	PROSECUTION:	Notes to the Request Form (PCT/RO/101)
(04.07.25)		https://www.wipo.int/documents/d/pct-system/docs-en-
	 Foreign Filing 	<u>forms-request-ed-request.pdf</u>
T 12	DDOCECUTION.	1
Lesson 12 (04.14.25)	PROSECUTION:	Interviews (MPEP §713) https://mpep.uspto.gov/RDMS/MPEP/current#/current/d0e8
(04.14.23)	• Examiner	4376.html
	Interviews	<u>1370.IIIIII</u>
	After Final	After Final Practice (MPEP §714.12 - §714.13)
	Practice	https://mpep.uspto.gov/RDMS/MPEP/current#/current/d0e8
	• Appeals	<u>5040.html</u>
	• Petitions	Einel Deine (MDED 9507 507 05)
	1 0000000	Final Rejections (MPEP §706-706.07)
		https://mpep.uspto.gov/RDMS/MPEP/current#/current/d0e5 7969.html
		Appeals/Petitions (MPEP §1201)
		https://mpep.uspto.gov/RDMS/MPEP/current#/current/d0e1
		<u>22292.html</u>
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Lesson	Topics	Reading Assignment:
Lesson No. Lesson 13 (4.21.25)	POST ISSUANCE: Maintenance Reissue Re-exam	Reading Assignment: Manual of Patent Examining Procedure 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 Ex Parte Reexamination (MPEP §2209) https://mpep.uspto.gov/RDMS/MPEP/current#/current/ d0e221775.html