

PATENT PROSECUTION
SPRING TERM 2023
Law 6930 (Class Number 13910)
3 Credits

INSTRUCTOR

Michael J. Colitz, III
Email: colitz@gmail.com
Phone: 813-857-3201
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. Your 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](#).

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 Procedure¹
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 §301² 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/d0e1

¹ Manual of Patent Examining Procedure (MPEP) Ninth Edition, Revision 10.2019 Last Revised June 2020

² MPEP citations do not include subsections unless otherwise specified.

Lesson No.	Topic	Reading Assignment: Manual of Patent Examining Procedure ¹
		97244.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 No.	Topic	Reading Assignment: Manual of Patent Examining Procedure¹
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 No.	Topic	Reading Assignment: Manual of Patent Examining Procedure ¹
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 No.	Topic	Reading Assignment: Manual of Patent Examining Procedure ¹
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