

JOHN MARSHALL LAW SCHOOL
PATENT LAW PRACTICE AND PLANNING
FALL SEMESTER 2009

SYLLABUS

Class 1

- A. Course introduction and description; discussion of content of:
- Article patent
 - Method patent
 - Design patent
 - Trademark registration
 - Copyright registration
- B. Explanation of differences between coverage afforded by each.
- C. Applicability of trade secret protection.
- D. Initiating patent prosecution process.
- (1) First contact with inventor.
 - (2) First meeting with inventor –what disclosure information to develop. (Ref. 35 USC §101, 102, 103 and 112)
- E. Assignment: Review notes; be prepared to obtain invention disclosure during Class II

Class II

- A. Analysis of invention by class to determine nature and elements of invention.
- B. Criteria re: preparation of patentability search request letter.
- C. Assignment: Draft patentability search letter.

Class III

- A. Analysis of prior art.
- 1. Using 35 USC §102 and §103 standards to determine question of “invention”.

2. Combining references – evidence of obviousness – summary of relevant law re: obviousness – examples of combining references.

- B. Discussion of search results and review of prior art.
- C. Criteria for preparing a patentability opinion letter.
- D. Assignment: Preparation of patentability opinion letter.

Class IV

- A. Preliminary review of criteria regarding contents of a patent application.
- B. Claim drafting discussion – Phase I, and exercise.
- C. Assignment – Draft of claim based on Phase I of discussion.

Class V

- A. Claim drafting exercise.
- B. Claim preparation criteria – Phase II, and exercise.
- C. Assignment – Draft one independent and three dependent claims.

Class VI

- A. Review of claims.
- B. Claim drafting discussion – Phase III and exercise.
- C. Assignment: prepare full set of broad, intermediate and limited claims directed to invention.

Class VII

- A. Review of broad, intermediate, and limited claims directed to invention.
- B. Criteria for preparation of specification of patent application with reference to 35 USC §112.
- C. Formal papers.
- D. Information Disclosure Statement and duty of disclosure under Rule 56.

- E. Assignment: based on claims previously drafted, prepare a complete patent application (3 week assignment).

Class VIII

- A. Method claims discussed.
- B. Exercise in drafting method claims.
- C. Jepson claims.
- D. Means plus function claims.
- E. Assignment: - Prepare one independent and two dependent method claims.

Class IX

- A. Hand in completed patent application.
- B. Discussion of patent examination procedure – review for information and application of prior art.
- C. Discussion of preparation of an amendment; Rule 131 and 132 affidavits.
- D. Assignment: Draft response to Patent Office Action.

Class X

- A. Review of response to Patent Office Action.
- B. Final rejections and appeals; interview with the Examiner.
- C. Review of divisional and continuing applications.
- D. Restriction requirements.
- E. Accelerated Examination Procedure.
- F. Issue and abandonment.
- G. Re-issues.
- H. Re-examination.
- I. Design patents.

Class XI

- A. Development of a trademark.
- B. Trademark search techniques; data bases and common law searches.
- C. Criteria for availability and registrability opinion letter; criteria re: likelihood of confusion and ability of term to function as a trademark.
- D. Preparation of Trademark and Service Mark application.
- E. Application based on intent to use.
- F. Prosecution of application.
- G. Publication and opposition.
- H. Rules governing opposition proceedings.
- I. Registration of mark; rights based on registration; Supplemental Register.
- J. Cancellation proceedings.
- K. Renewal – ten years with specimen of use.
- L. Section 8 & 15 Affidavits.
- M. Assignment: Preparation of trademark availability opinion letter.

Class XII

- A. Foreign patent, trademark and copyright issues.

Class XIV

- A. Licensing and assignment of patents.
- B. Advising clients as to profitable use of Intellectual Property Rights.
- C. Advising clients as to establishing an effective Intellectual Property development, enforcement and licensing program.