

Intellectual Property (IP) Prosecution before the United States Patent and Trademark Office (USPTO)

I. DESCRIPTION:

This course will focus on the practical skills of IP prosecution in the United States, and more specifically, the process of negotiating and obtaining patents and trademarks before the USPTO. The course will be separated into two halves--patent and trademark.

In the patent half, we will cover in detail how to procure U.S. patents including, for example, introduction to different types of patents, the basics of filing a patent application, the basics of a patent claim, different types of rejections and objections in office actions, how to successfully overcome the rejections and objections, various considerations in making the response, contacting the examiner and examiner interviews, the art of negotiation, continuing application and targeted prosecution practices, and last but not least, ethical obligations. There will be light reading, such as patent applications and office actions. There will also be homework assignments, such as drafting responses to office actions and appeal briefs.

In the trademark half, we will discuss topics including how to conduct trademark preliminary searches, trademark application procedures, grounds of ex-parte rejections and overcoming confusion and descriptiveness rejections, the *inter parte* opposition and cancellation proceedings, maintenance of trademarks rights, pre-litigation trademark enforcement actions, and international aspects of trademark practices. If time permits, we will also cover the domain name and UDRP practices. There will be light reading and homework assignments.

Note that this course will not cover patent and trademark application drafting.

II. REQUIREMENTS:

Having taken basic introductory course to intellectual property is strongly recommended. Having taken patent law and/or trademark law is recommended but not required. No technical background is required.

III. INSTRUCTORS:

Harvey Chen¹ and Irene Chang²

¹ Harvey Chen is a US lawyer with the IP group of *Perkins Coie LLP*. He focuses his practice on all aspects of IP matters with an emphasis on patent procurement, strategy planning and counseling, and litigation support for electrical and mechanical arts. In representing his clients, Harvey has developed a wide spectrum of technical knowledge including both hardware and software. Harvey has extensively drafted and prosecuted U.S. and foreign patent applications, including conducting invention disclosure meetings, examiner interviews and negotiations, as well as appellate proceedings. He helps companies of different sizes shape their patent portfolios and develop their IP strategies. He also provides support of patent litigation and post-grant proceedings, including preparing infringement and invalidity claim charts, performing prior art searches and providing client strategic consultation. For his full bio, please visit: <https://www.perkinscoie.com/en/professionals/han-wei-chen.html>

² Irene Chang is a US lawyer with the IP group of *Perkins Coie LLP*. She has experience with a range of trademark

IV. TEXTBOOKS AND REFERENCES:

- Manual of Patent Examining Procedure (MPEP)
- Trademark Manual of Examining Procedure (TMEP)
- Class handouts: There will occasional printouts of online articles written by IP professionals or recent Federal Circuit and/or United States Supreme Court decisions.

V. TEACHING METHOD:

The class will be taught in English. Most of the lessons will include both a lecture portion and a practical portion. The lecture portion will cover the legal grounds and rules specific for a prosecution topic and for the homework assignment. The practical portion will cover a live exercise in a number of selected teams, who will role play Applicant, Examiner, Inventor, and other persons applicable to the simulated scenario. The lecture portion will be mainly Powerpoint presentation occasionally blended with Socratic method. The practical portion will largely focus on conducting examiner interview and contacting examiner.

VI. GRADING:

The final grade will be based on class participation and homework assignments. There will be no final examinations.

VII. SYLLABUS (TENTATIVE):

Class # 1--

Introductions; Types of Intellectual Property; What is a Patent; Overview of Patent Prosecution; Anatomy of Patent Application and Letters Patent; Criteria for Patentability; Office Actions

Class # 2--

Claim Interpretation; Logics and Considerations behind a Response; Rejections under 35 U.S.C. § 102 Novelty; Arguments to Overcome § 102 Rejections; Qualifications of and Exceptions to § 102 Prior Art; Consideration on the Substantive Response; Prosecution History Estoppel (PHE)

matters, including conducting trademark searches, clearance and analysis and counseling clients on trademark portfolio maintenance. Irene provides guidance on trademark filing strategies and prepares filings for the U.S. Patent and Trademark Office and the Trademark Trial and Appeal Board. She also has experience negotiating and strategizing trademark settlements. Irene advises on copyright and trademark issues in a variety of industries, including wholesale trading, 3D printing, PCB manufacturing, music publishing, food and beverage and biotechnology. She has drafted trademark and copyright assignments, licensing agreements, terms of use and privacy policies for online service providers and music publishers. Irene also prepares responses to Office Actions and trademark cease and desist letters. For her full bio, please visit: <https://www.perkinscoie.com/en/professionals/irene-chang-ayden.html>

Class # 3--

Rejections under 35 U.S.C. § 103 Nonobviousness; Arguments to Overcome § 103 Rejections; Qualifications of and Exceptions to § 103 Prior Art; Consideration on the Substantive Response

Class # 4--

Rejections under 35 U.S.C. § 103 Nonobviousness (Continued); Arguments to Overcome § 103 Rejections; Qualifications of and Exceptions to § 103 Prior Art; Rejections under 35 U.S.C. § 101 Patentable Subject Matter; Arguments to Overcome § 101 Rejections

Class # 5--

Rejections under 35 U.S.C. § 101 Patentable Subject Matter (Continued); Arguments to Overcome § 101 Rejections

Class # 6--

Rejections under 35 U.S.C. § 112 Written Description / Enablement; Special Considerations for Software Inventions; Arguments to Overcome § 112 Rejections

Class # 7--

After-Final Practices -- Response, AFCP, Advisory Actions, RCE (or CPA), Appeal and Reply Briefs, 1.312 Amendment, Request for Certificate of Correction

Class # 8--

Miscellaneous (e.g., Restriction Requirement, Double Patenting and Terminal Disclaimer, Utility Rejection, IDS and duty, Substitute Statement, Formality and Figures, 1.131 Declarations (pre-AIA)); Arguing for Design Applications

Class # 9--

Introduction; Forms of Trademark Protection; US Trademark Application/Registration process and Loss of Trademark Rights; Grounds of Refusal/Infringement

Class # 10--

Search/Clearance; Pre-Filing Considerations; Trademark Portfolio Strategies

Class # 11--

Prosecution – Likelihood of Confusion Rejections

Class # 12--

Prosecution – Prosecution – Descriptiveness Rejections; Miscellaneous Rejections

Class # 13--

TTAB Practices: Oppositions/Cancellations; Ex-parte Appeal

Class # 14--

Trademark Enforcement (Non-litigation); Infringement/Cease and Desist (Non-litigation);
Settlement and Co-existence

Class # 15--

Domain Name and Internet Practices

Class # 16--

Trademark Maintenance; Watch Services; Specimen; International Practices; Madrid
Protocol