

ALBANY LAW SCHOOL
Patent Prosecution and Patent Drafting

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Justification: This course will provide students at Albany Law School with an interest in patent law to develop skills and knowledge used in the practice before the United States Patent Office. The United States Patent Office is the only government agency that requires practitioners take a bar exam (the Patent Bar) as a requirement for practice. This course will provide students with the advanced tools needed for patent drafting and prosecution to maximize licensing and enforcement value. This material does not significantly overlap with other course material at Albany Law School.

Course Description: This course will be a 2.0 credit hour course that will provide students with an in-depth knowledge of Patent Prosecution and Drafting. In particular, the course will focus on providing a student with the skills and knowledge necessary to assist the client/inventor in obtaining a patent, from the initial step of meeting with an inventor through the post patent issuance procedures. It will be assumed that the student has had a course in basic patent law.

Required Materials:

Manual of Patent Examining Procedure (hereinafter “MPEP”)

Class Packet

Patent Law and Policy Cases and Material (Hereinafter “PLP”), LexisNexis

Final Grade:

70 percent - Final Exam; and

30 percent - Class Assignments

Topics to be Covered:

January 9, 2011

Course Introduction

Drafting and Prosecuting Plant Patents and Design Patents

35 USC §101

35 USC §161

MPEP §§1600-1613

MPEP §§1500-1504.3

January 16, 2011 – No Class – Martin Luther King, Jr. Day

January 23, 2011
Workshop Handout

Client Interview, Search and Patentability Opinion (Patentability based on 35 USC 102 only)

MPEP 904-904.3
PLP Pgs. 24; 745-748; 357-416

Oddzon Products, Inc. v. Just Toys, Inc., 122 F.3d 1396, 43 U.S.P.Q.2D (BNA) 1641
(Fed. Cir. 1997) [**Ashworth**]

In re Robertson, 169 F.3d 743, 49 U.S.P.Q.2D (BNA) 1949 (Fed. Cir. 1999) [**Barth-King**]

In re Seaborg, 328 F.2d 996, 140 U.S.P.Q. (BNA) 662 (C.C.P.A. 1964) [**Goldman**]

Schering Corp. v. Geneva Pharmaceuticals, Inc., 339 F.3d 1373 (Fed. Cir. 2003)

In re Hafner, 410 F.2d 1403, 161 U.S.P.Q. (BNA) 783 (C.C.P.A. 1969)

National Tractor Pullers Ass'n v. Watkins, 205 U.S.P.Q. (BNA) 892 (N.D. Ill. 1980)
[**Hodge**]

Rosaire v. Baroid Sales Division, National Lead Co., 218 F.2d 72, 104 U.S.P.Q. 100 (5th
Cir. 1955) [**McParland**]

Jockmus v. Leviton, 28 F.2d 812 (2d Cir. 1928) [**Osterweil**]

In re Klopfenstein, 380 F.3d 1345 (Fed. Cir. 2004) [**Pignato**]

Reeves Bros. v. United States Laminating Corp., 282 F.Supp. 118, 157 U.S.P.Q. (BNA)
235 (E.D.N.Y. 1966), aff'd, 417 F.2d 869 (2d Cir. 1969) [**Stone**]

January 30, 2011

Parts of a Patent Application
In class claim drafting workshop

MPEP 608-608.01(n)
PLP 14-48

February 6, 2011

Office Actions
Restrictions and Double Patenting
Examination of Patent Applications on the Merits

MPEP 800-809.02(e)
MPEP 706-706.07(h)
PLP 1207-1238

Miller v. Eagle Manufacturing Co., 151 U.S. 186 (1894) [**Ashworth**]

In re Vogel, 422 F.2d 438 (C.C.P.A. 1970) [**Barth-King**]

In re Kaplan, 789 F.2d 1574 (Fed. Cir. 1986) [**Goldman**]

In re Berg, 140 F.3d 1428 (Fed. Cir. 1998) [**Hodge**]
Gerber Garment Technology, Inc. v. Lectra Systems, 916 F.2d 683 (Fed. Cir. 1990)
[**McParland**]

February 13, 2011

Responding to Office Actions 35 USC 101

Handout Claim Drafting Homework Packet #2

Patent 308,488 Burglar Trap (Nov. 25, 1884)
Patent 644,077 Acetyl Salicylic Acid (Feb. 27, 1900)
Patent 3,034,806 Digital Displays (Nov. 19, 1958)
Patent 4,424,786 Fuel Saving Device (Jan. 10, 1984)
Patent B1 4,424,786 Reexamination: Fuel Saving Device (Sept. 3, 1985)
Patent 4,666,425 Device For Perfusing An Animal Head (May 19, 1987)

MPEP 2105

PLP Pgs. 207-256

Lowell v. Lewis, 15 Fed. Cas. 1018 (C.C.D. Mass. 1817) [**Osterweil**]
Juicy Whip, Inc. v. Orange Bang, Inc., 185 F.3d 1364 (Fed. Cir. 1999); 51 U.S.P.Q.2D
(BNA) 1700 [**Pignato**]
Brenner v. Manson, 383 U.S. 519, 148 U.S.P.Q. (BNA) 689 (1966) [**Stone**]
In re Brana, 51 F.3d 1560, 34 U.S.P.Q.2d 1436 (Fed. Cir. 1995) [**Ashworth**]
In re Fisher, 421 F.3d 1365 (Fed. Cir. 2005) [**Barth-King**]

February 20, 2011 – (Class Change – Monday Classes will meet on Tuesday, Feb. 21)

*Preparing Patent Applications and
Responding to Office Actions 35 USC 112, Enablement*

PLP Pgs. 257-299

The Incandescent Lamp Patent, 159 U.S. 465 (1895) [**Bornick**]
In re Wands, 858 F.2d 731, 8 U.S.P.Q.2d 1400 (Fed. Cir. 1988) [**Flynn**]
In re Strahilevitz, 668 F.2d 1229, 212 U.S.P.Q. 561 (C.C.P.A. 1982) [**Goldman**]

February 27, 2011

*Preparing Patent Applications and
Responding to Office Actions 35 USC 112, Written Description and Best Mode
35 USC 112, 2nd paragraph*

PLP Pgs. 299-356
Claim Drafting Homework Packet #2 Due

The Gentry Gallery, Inc. v. The Berkline Corp., 134 F.3d 1473, 45 U.S.P.Q.2d 1489
(Fed. Cir. 1998) [**Grassi**]
University of Rochester v. G.D. Searle & Co., Inc., 358 F.3d 916 (Fed. Cir. 2003)
[**Hodge**]
Lizardtech, Inc. v. Earth Resource Mapping, Inc., 424 F.3d 1336 (Fed. Cir. 2005)
[**Osterweil**]
Lizardtech, Inc. v. Earth Resource Mapping, Inc., 433 F.3d 1373 (Fed. Cir. 2006)
[**Pignato**]
Orthokinetics, Inc. v. Safety Travel Chairs, Inc., 806 F.2d 1565, 1 U.S.P.Q.2d 1081
(Fed. Cir. 1986) [**Stone**]
Randomex, Inc. v. Scopus Corp., 849 F.2d 585, 7 U.S.P.Q.2d 1050 (Fed. Cir. 1988)
[**Ashworth**]
Chemcast Corp. v. Arco Industries, 913 F.2d 923, 16 U.S.P.Q.2d 1033 (Fed. Cir. 1990)
[**Barth-King**]

March 5, 2011

*Preparing Patent Applications and
Responding to Office Actions 35 USC 102(e), (f), (g)*

PLP 421-488

Alexander Milburn Co. v. Davis-Bournonville Co., 270 U.S. 390 (1926) [**Bornick**]
Campbell v. Spectrum Automation Co., 513 F.2d 932, 185 U.S.P.Q. (BNA) 718 (6th Cir.
1975) [**Flynn**]
Brown v. Barbacid, 276 F.3d 1327 (Fed. Cir. 2002) [**Goldman**]
Peeler v. Miller, 535 F.2d 647, 190 U.S.P.Q. (BNA) 117 (C.C.P.A. 1976) [**Grassi**]
Dow Chemical Company v. Astro-Valcour, Inc., 267 F.3d 1334, 60 U.S.P.Q.2D (BNA)
1519 (Fed. Cir. 2001) [**Hodge**]
In re Moore, 444 F.2d 572, 170 U.S.P.Q. (BNA) 260 (Fed. Cir. 1987) [**Osterweil**]

March 12, 2011 - No Class - Spring Break

March 19, 2011

*Preparing Patent Applications and
Responding to Office Actions 35 USC 103*

PLP 611-662

Hotchkiss v. Greenwood, 52 U.S. (11 How.) 248 (1851) [Pignato]
Graham v. John Deere Co., 383 U.S. 1, 148 U.S.P.Q. (BNA) 459 (1966) [Stone]
United States v. Adams, 383 U.S. 39, 148 U.S.P.Q. (BNA) 479 (1966) [Ashworth]

March 26, 2011

*Preparing Patent Applications and
Responding to Office Actions 35 USC 103*

PLP 663-724
Handout Homework Packet #3

KSR International Co. v. Teleflex Inc., 2007 U.S. LEXIS 4745 (April 30, 2007) [Barth-
King]
Arkie Lures, Inc. v. Gene Larew Tackle, Inc., 119 F.3d 953 (Fed. Cir. 1997) [Bornick]
Hybritech, Inc. v. Monoclonal Antibodies, Inc., 802 F.2d 1367, 231 U.S.P.Q. 81 (Fed.
Cir. 1986) [Flynn]
In re Winslow, 365 F.2d 1017, 151 U.S.P.Q. (BNA) 48 (C.C.P.A. 1966) [Goldman]

April 2, 2011

Responding to Office Actions 35 USC 103

MPEP 2141-2146

April 9, 2011

*Allocation of Power and
Correction of Patents - Reissue*

PLP Pgs. 1045-1092

Dennison Manufacturing Co. v. Panduit Corp., 475 U.S. 809 (1986) [Grassi]
Panduit Corp. v. Dennison Manufacturing Co., 810 F.2d 1561, 1 U.S.P.Q.2d (BNA)
1593 (Fed. Cir. 1987) [Hodge]
Dickinson v. Zurko, 527 U.S. 150 (1999) [Osterweil]
Merck & Co., Inc. v. Kessler, 80 F.3d 1543, 38 U.S.P.Q.2D (BNA) 1347 (Fed. Cir. 1996)
[Pignato]
Holmes Group, Inc. v. Vornado Air Circulation Systems, Inc., 535 U.S. 826 (2002)
[Stone]
Superior Fireplace Co. v. Majestic Products Co., 270 Fed. 3d 1358, 60 U.S.P.Q.2D
(BNA) 1668 (Fed. Cir. 2001) [Ashworth]
Mentor Corp. v. Colorplast Inc., 998 F.2d 992, 27 U.S.P.Q.2d 1521 (Fed. Cir. 1993)
[Barth-King]

Seattle Box Co. v. Industrial Crating & Packaging, Inc., 756 F.2d 1574, 225 U.S.P.Q. 357 (Fed. Cir. 1985) [**Bornick**]

April 16, 2011

Reexamination and Inequitable Conduct
PLP Pgs. 1092-1140
Homework Packet #3 Due

Quantum Corp. v. Rodime, PLC, 65 F.3d 1577, 36 U.S.P.Q.2D (BNA) 1162 (Fed. Cir. 1995) [**Flynn**]

J.P. Stevens & Co. v. Lex Tex Ltd., 747 F.2d 1553 (Fed. Cir. 1984) [**Goldman**]

Critikon, Inc. v. Becton Dickinson Vascular Access, Inc., 120 F.3d 1253 (Fed. Cir. 1997) [**Grassi**]

Kingsdown Medical Consultants, Ltd. v. Hollister, Inc., 863 F.2d 867, 9 U.S.P.Q.2d 1384 (Fed. Cir. 1988) [**Hodge**]

Symbol Technologies, Inc. v. Lemelson Medical, Ed. & Res. Fdn., L.P., 277 F.3d 1361 (Fed. Cir. 2002) [**Osterweil**]

April 23, 2011

Inventors and Owners
PLP Pgs. 1141-1192

Burroughs Wellcome Co. v. Barr Laboratories, Inc., 40 F.3d 1223 (Fed. Cir. 1994) [**Pignato**]

Stark v. Advanced Magnetics, Inc., 119 F.3d 1551 (Fed. Cir. 1997) [**Stone**]

Eli Lilly And Co. v. Aradigm Corp., 376 F.3d 1352 (Fed. Cir. 2004) [**Ashworth**]

Ethicon, Inc. v. United States Surgical Corp., 135 F.3d 1456 (Fed. Cir. 1998) [**Barth-King**]

Waterman v. Mackenzie., 138 U.S. 252 (1891) [**Bornick**]

Filmtec Corp. v. Allied-Signal Inc., 939 F.2d 1568 (Fed. Cir. 1991) [**Flynn**]

Quiz on Homework Packet #3

Review of Quiz

Final Exam Review