

# USPTO Video Conference Center 2003 Lecture Descriptions

## PATENTS

### **35 USC 101 & USC 112 § 1 - Examiners Guidelines for Utility and Enablement**

This fundamental class is a must for every patent prosecutor. First, attendees get an overview of the utility guidelines and the procedures to be followed when analyzing patent applications for compliance with the utility requirements of 35 U.S.C. §101. The primary purpose of this lecture is to define the meaning of the statutory requirements of utility and to disseminate current examination practice in regard to the analysis for compliance with the utility requirement. By the end of this class, you will be better able to:

- Identify the basic requirements for statutory utility
- List the types of applications requiring utility
- Define the meaning and requirements of utility in an application
- Locate areas of disclosure, which may raise questions of utility
- Understand how examiners treat utility problems encountered in applications, and
- Prepare possible responses to rejections based upon lack of utility.

### **Affidavit Practice: 37 CFR 1.131 & 1.132**

The information provided in this session is a great benefit to attorneys/applicants because it teaches the USPTO's way of doing things. The lecture is designed to teach examiners the analytical skills needed to evaluate whether an affidavit filed under 37 CFR 1.131 may be used as evidence to swear behind a reference and whether an affidavit filed under 37 CFR 1.132 may be used as evidence to overcome a ground of rejection or an objection. When attorneys/applicants know what is needed in each affidavit type, and when it is appropriate to employ an affidavit, prosecution can be more effective.

### **After Excel and Schrader, What is the Dispositive Test for Applying Section 101?**

This seminar will review case law development as to patent eligibility under 35 USC § 101 for computer related inventions. A focused analysis of *In re Alappat*, *State Street Bank* and *AT&T Corp* will be provided to address the question, "After Excel and Schrader, What is the Dispositive Test for Applying Section 101?"

### **Board of Patent Appeals and Interferences**

All you've ever wanted to know about the BPAI will be presented in this seminar: Who sits on the board, what training and experience are required, what is a panel, what does each member do, and caseload considerations start the session. How the BPAI judges are trimming appeals inventory and speeding up interferences will also be discussed.

The lecturer will explain the process and procedures required when making an Appeal to the Board including how to contact an oral conduct hearing, BPAI decisions and requests for rehearing. The BPAI also conducts and decides interferences, so the presenter will also cover the process used in an interference case.

### **Double Patenting**

Learn how the Patent Academy teaches examiners to treat applications containing claims which conflict with claims in applicant's other applications or patents, or claims in other commonly assigned (or owned) applications. Topics include:

- Grounds for prohibiting double patenting
- Treatment of conflicting claims
- Terminal disclaimers
- Protection against Double Patenting rejections
- Conflict between design and utility claims, and
- Duplicate claims

### **Examiner Guide for Computer-Related Inventions: \*\* (\*\*Currently undergoing a course update.)**

These guidelines have been developed to assist PTO personnel in the examination of applications drawn to computer-related inventions (includes inventions implemented in a computer and inventions employing computer-readable media). The guidelines are based on the Office's current understanding of the law and are believed to be fully consistent with binding precedent of the Supreme Court, the Federal Circuit and the Federal Circuit's predecessor courts. There will be an overview of these guidelines and then a demonstration of their application by use of a number of sample claims.

### **Final Rejection and After Final Practice**

This lecture provides valuable information to attendees because it is designed to help trainee examiners understand the reasoning behind the PTO's "m.o." regarding Office actions, Attendees will learn:

- To recognize when an Office action may and may not be made final
- To understand why actions are made final
- To discover what recourse is available to an applicant in response to a final rejection, and
- To recognize when an amendment after final should and should not be entered.

### **Hot Topics in Biotechnology Prosecution**

Latest topics of interest including written description, expressed sequence tags (EST's), single nucleotide polymorphisms (SNP's), common pitfalls in CPA and Rule 129 (a) practice, sequence rules, and deposit requirements.

### **New and Pending Issues in the USPTO**

This seminar will give an overview of recent and pending legislative issues affecting the US and international patent systems. Previous topics have included the following Harmonization Uruguay Round Table Agreements, NAFTA, US-Japan Accords, early publication, expanded reexamination, prior user rights and other issues.

### **Obviousness under 35 USC 103**

Understand the meaning of 35 USC 103. Learn to apply the standards used to establish a legal conclusion of obviousness. Treat the various issues that inevitably arise when applying 35 USC 103. By the end of this session, you should be able to recognize and understand the following concepts related to obviousness:

- The statute;
- Prima facie obviousness;
- The Graham test;
- Scope and content of prior art;
- Evidence of prior art comprising references, admissions and affidavits;
- Analogous art; and differences between the prior art and the claims at issue.

Attendees will also gain a level of skill in the pertinent art comprising:

- Motivation;
- Hindsight;
- Motivation different from applicant's
- Art recognized equivalence for the same purpose;
- Physical incorporation;
- Destroying a reference;
- Changing principle of operation and number of references combined.
- Secondary considerations comprising unexpected result; long felt need; and commercial success will also be discussed.

### **Novelty 35 USC 102**

Participants will learn to determine whether a reference qualifies as prior art under 35 USC 102 (a), (b), or (e) and determine whether a single reference teaches all the elements of a claimed invention.

### **Petitions**

Every patent attorney needs to know how to handle petitions expeditiously, efficiently and with a minimum of error. You will learn the basic principles of petition practice and the two main avenues of ex parte review – appeal and petition. Identify the various types and components of petitions handled in the Office of the Deputy Commissioner for Patent Examination Policy, as well as in the Examining Corp and the requirements that MUST be met to have a petition granted. Become more effective in your practice before the Office by getting guidance on how to 1) avoid the most common errors that lead to petitions in the first place, and 2) avoid errors in the petitions themselves.

### **Proposed New Rule Changes: (Based upon current or pending legislative issues)**

The presentation will cover changes in current rules and implementation being undertaken by the USPTO as they occur.

### **Re-Exam and Reissue**

The lecture provides an overview of the statutes (35 USC 251 and 35 USC 302-305), rules (37 CFR 1.171 – 1.179 and 37 CFR 1.510-1.552) and MPEP requirements governing reissue applications and ex parte reexamination proceedings, respectively. The objectives include enabling the practitioner to distinguish reissue practice from other means of correcting errors in issued patents, in particular ex parte reexamination practice. The attendee will also learn:

- To recognize the appearance of a reissue application or a reexamination proceeding by an inspection of its form and contents;
- To understand how the USPTO applies to the examination process the key provisions of the statutes;
- To recognize the importance of and the emphasis on a reissue oath/declaration and to be able to distinguish such from the oath or declaration of a utility application;
- Understand the primary similarities and differences between reissue applications, ex parte reexamination proceedings, and regular utility applications and their respective examinations.

### **35 USC 112-2 paragraph, Rejections Not Based on Prior Art**

This session will analyze the claims to determine whether or not one skilled in this art can determine the metes and bounds of a claim with a fair degree of certainty. Attendees will be taught to understand the criteria for determining clear and distinct claim language, and understand the criteria for determining clear

and distinct claim language, and understand the policy reasons for 35 USC 112-2. The session also enables the practitioner to understand appropriateness of rejections in accordance with 35 USC 112.

### **Rule Change**

The presentation will cover the current rules and implementation being undertaken by the USPTO. Included will be issues relating to USPTO implementation of the Technical Amendments Act of 2002 enacted 11/02/02 (H.R. 2215), such as Reexamination. Also included will be the mandatory Revised Amendment Practice, Information Disclosure Statements (IDS), Elimination of CPA Practice - Final Rule, Notice of Foreign Filing, Clarification of Power of Attorney Practice, and Revisions to Assignment Rules - Notice of Proposed Rule Making, Customer Number Bar Code Labels, Batch Updates and issues relating to USPTO implementation of the American Inventors Protection Act of 1999, such as Subtitle D - Patent Term Guarantee, Subtitle E - Domestic Publication of Patent. This includes topics such as how to calculate patent term adjustment and ongoing concerns regarding publication.

### **US Classification and IPC**

The basics of the US Classification System, the ideas behind classification, the structure of a class and the relationship between the subclasses in a particular class will be covered in the first hour. The second hour will cover the general structure of the IPC, features of the IPC, and aids to using the IPC. Also included will be how IPC is used in the USPTO and how some variants of the IPC are used in the USPTO.

### **Understanding Foreign Patent Documents**

During this session, the attendee will be shown how to interpret various foreign records that have been retrieved through database searches such as Dialog, Orbit and Questel. Using sample printouts, the instructor will demonstrate how to read symbols and codes to find bibliographic information, including information on filing, publication, priority, and where to find related prior art. Using these demonstrated techniques you will be able to interpret relevant information on any foreign database retrieved document.

### **The Patent Cooperation Treaty**

This is a two-part lecture on the Patent Cooperation Treaty. Representatives from the PCT Special Programs Office of the USPTO teach a basic seminar on practice and procedures of the Patent Cooperation Treaty from filing an international application to entering the national phase in the USPTO.

#### **Patent Cooperation Treaty (PCT) Part I**

The first session starts with an overview of the PCT process including the international phase and the national phase as well as the advantages of using PCT for filing foreign patent applications. Next the participants are given detailed information on how to file an international application. Participants are taught how to properly fill out a PCT Request form including information on using PCT-EASY, the self-validating software for generating the Request.

#### **Patent Cooperation Treaty (PCT) Part II**

The second session continues with information on filing a Demand for International Preliminary Examination. Next participants learn about national stage entry in the US under 35 USC 371 and an alternative strategy for filing a US patent based upon the international application. The session ends with helpful hints on the PCT process including how to record changes in the applicant, how to delay or prevent publication of the international application, and a discussion of important forms that should be monitored during the international phase.

## **TRADEMARKS**

### **E-TEAS**

It has never been easier to file for a Trademark. The Trademark Electronic Application System (TEAS) allows you to fill out an application form and check it for completeness over the Internet. Using e-TEAS you can then submit the application directly to the USPTO over the Internet, paying by credit card or through an existing USPTO deposit account. Using PrinTEAS, you can print out the completed application for mailing to the USPTO, paying by check or money order through an existing USPTO deposit account. Both e-TEAS and PrinTEAS are available from the Internet and will be covered in the lecture.

### **The Madrid Protocol: The Basics about the Rules and Implementation of this Important Treaty and Trademark Electronic Filing: Using the Internet and TEAS to Better Serve Your Clients**

The basic operation of the Madrid System, the high points of the proposed rules and the new drawing rules will be presented. Then a hands-on, "nuts-and-bolts" demonstration of all aspects of filing through the Trademark Electronic Application System (TEAS) will be presented. Topics covered in the part of the presentation will include using form wizards properly; creating templates for multiple filings; attaching image files; obtaining signatures; and saving work electronically.

### **Trademark Tips for Paralegals**

This seminar will provide an explanation of the trademark process aimed at non-attorney legal professionals. Legal Staff of the Office of the Commissioner for Trademarks will provide an explanation of the trademark process, including an overview of the Office and updates on pendency for new applications. They will provide insight on why trademark applications go abandoned; tips to avoid abandonment; and what to do when your application is abandoned. They will briefly explain the difference between a petition and an appeal and a petition and a request for reinstatement. They will also provide a list of contacts at the PTO and other handouts, to help you get the right answer, right away.

### **Substantive Trademark Refusals**

A discussion of the different substantive trademark refusals issued by the PTO and what you can do about them.

### **Trademark Classification Issues and Identification**

A presentation discussing the common practical problems in using the Trademark Classification System.

### **Trademark Trial and Appeal Board Issues**

Topics for discussion include: the pre-trial phase of opposition and cancellation proceedings including pleadings and discovery, the trial and decision phases of opposition and cancellation proceedings including the submission of trial evidence and how recently proposed rule changes would affect practice before the TTAB.