

Course Content/Outline

Week 1 - Forms of Intellectual Property

- Discussion of forms of IP, including copyright, trademark, designs, secrets
- Origins of the patent and distinction over other forms of IP

Week 2 - Structure of a Patent

- Description
- Drawings
- Claims

Week 3 : Patent: criteria for patentability

- Novelty
- Non-obviousness or inventiveness
- Utility

Week 4 - The Patent Description

- Notions of validity and infringement
- Construction of a claim
- Independent claims and dependent claims

Week 5 - Understanding a Patent – Practical Workshop

- Reading and understanding a patent description
- A study of the scope of claims

Week 6 - Drafting Claims – Practical Workshop

- Interactive exercises in drafting claims

Weeks 7 and 8 - The Patenting Process

- Filing timeline
- Concept of priority
- United States application
- PCT applications
- European patent

Week 9 – Examination of a Patent Application

- Filing timeline
- Concept of priority
- PCT applications
- European patent

Week 10 - Examination – Practical Workshop

- Interactive exercises in responding to Examination rejection

Week 11 - Prior Art as Scientific Literature

- What constitutes prior art
- How to read prior art
- Prior art searching
- Prior art databases

Week 12 - Commercialization and Exploitation of Patents

- Ownership
- Licensing
- Right to exclude

Week 13 - Patent Enforcement

- Further look at infringement and validity
- Steps to trial and trial
- Social implications of IP, patent trolls, counter movements to IP

Assessment/Evaluation:

Midterm (30%): closed book format, in which objective-type questions will be asked, as well as an opinion-type question: find weaknesses in a claim

Project (30%) : drafting a patent application based on prior art given by the course instructor.

Final Exam (40%) : closed book format, in which objective-type questions will be asked, a claim drafting question, and an opinion-type question on claim scope

Biography of Instructor

Pierre Nguyen's practice focuses on all aspects of management of patent and industrial design portfolios, including drafting and prosecuting patent applications. He also assists with developing international filing strategies for patent applications on behalf of several North American businesses. Mr. Nguyen has drafted and prosecuted numerous cases in the medical device industry, on subject matter including computer-assisted surgery, catheters, surgical tools, and surgical methods, for Fortune 1000 companies. He has been involved in all steps of prosecution, from inventor interviews to post-patent reviews, and has played an active role in the strategic management of patent portfolios in this industry. Mr. Nguyen has particular experience in drafting specifications taking into consideration the heterogeneous jurisdictional requirements for medical device claims.