

Global IP Laws, Rules and Practices

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Chapter 1: Global Patent Legal Infrastructure

U.S. Patent Infrastructure

Application Prosecution

Application files (Drawings, Claims, Specification, Declaration, ADS, Abstract)

Non-Final Office Action (NFOA)

§101 rejection

§102 rejection

§103 rejection

§112 rejection

Response to NFOA

defending §101 rejection

defending §102 rejection

defending §103 rejection

defending §112 rejection

Final Office Action (FOA)

Why is different from NFOA?

Totally rejected

Partially rejected, partially allowed

Response to FOA

Request for Reconsideration

Request for Continued Examination (RCE)

Continuation (CON)

Continuation-In-Part (CIP)

Strategy to select RCE, CON or CIP

Notice of Allowance

Issue Fee Payment

Prior-Issue Grace Period

Initial Claim and Amendment to Claims

System Claim

- Method Claim
- Base Claim
- Dependent Claim
- Claim Amendment (Original, Currently Amended, Previously Amended)
- Claim structure and strategy
- Family Expansion (Child Applications) and Strategy
 - Do you need Child Application?
 - What kind of Child Applications are available?
 - When can I file Child Application?
 - When is the best time to file Child Application?
 - How to file Child Application?
 - Who are parents of the Child Applications?
 - Advantage of the Child Application?
 - Disadvantage of the Child Application?
- Other matters: Double-patenting Rejection and Terminal Disclaimer

Patent Management

- Maintenance and Renewal (3.5 yrs, 7.5yrs, 11.5yrs)
- Claim Chart
 - Why Claim Chart is so important?
 - How to write Claim Chart?
 - Discovery strategy for infringed systems and methods
 - Base-Claim oriented Discovery
- Patent Family Updates
 - Which family member is to abandon?
 - Which family member is to continue?
 - Patent family optimization

Patent Evaluation System

- Key elements of the Patent Evaluation
- Patent Tree structure for Evaluation
- Court Consideration on patent evaluation
- Patent value is determined by court instead of patent office
- Patent value, patent right and patent allowance

Global Patent System via PCT

- Advantage of PCT
- Disadvantage of PCT
- Many courts actually do not endorse PCT

Chapter 2: Global Trademark Legal Infrastructure

U.S. Trademark Infrastructure

Application Prosecution

- Trademark/Service mark elements: mark and goods/services
- Classes of goods/services (009, 016, 035, 038, 041, 042, etc)
- Trademark protections: Common Law Right and/or Federal Registration
- Principal Register and Supplemental Register
- U.S. trademark right: first used in commerce and continuous use in commerce
- Definition of commercial use (distributing goods or services under the mark in interstate business)
- Application parts: mark, goods/services and specimen
- Application basis: Sec 1(a) or Sec 1(b)
- Non-Final Office Action (NFOA)
 - Sec2(d) rejection
 - Sec2(e)(1) rejection
 - Sec2(e)(2) rejection
 - Sec2(a) rejection
- Response to NFOA
 - defending Sec2(d) rejection
 - defending Sec2(e)(1) rejection
 - defending Sec2(e) (2)rejection
 - defending Sec2(a) rejection
- Final Office Action (FOA)
 - Why is different from NFOA?
 - Totally rejected
 - Mostly allowed
- Response to FOA
 - Request for Reconsideration
 - File Appeal
- Published for Opposition
 - Trademark Trial and Appeal Board (TTAB)
 - File Extension of Opposition
 - Notice of Opposition
- Notice of Allowance for Sec1(b) Application
 - Statement of Use
 - Extension of Use
 - Excusable Non-Use
- Notice of Opposition
 - File Proceeding before TTAB (Allegations)
 - Answer to Allegations
 - Discovery on denied Allegations
 - Deposition for Discovery
 - Motions in Proceeding
 - Motion to Dismiss

- Motion for Summary Judgment
- Motion to Compel
- Motion for Protective Order
- Motion to Strike allegations
- Motion to Suspend
- Allegation Basis: Sec2(d), Sec2(e)(1), Sec2(e)(2), Sec2(a), Fraud,
Common laws rights, Non-use abandonment
- Allegation on Fraud: Specimen or Commercial Use Evidence
- Allegation on Non-Use Abandonment
 - Consecutive Three-years' Nonuse, and
 - Intent Not To Resume Use
- Trial on Allegation
- Final Judgment

Post-Registration Management

- Petition of Cancellation after Registration: same proceeding as Notice of Opposition
- Converting Supplemental Register to Principal Register after Five Years under Sec 2(f)
- Renewal after five years of registration
 - Sec 15 filing for Principal Register
 - Sec 8 for continuous use in commerce (deleting those not using in commerce anymore)
- Renewal after nine years of registration
 - Sec 8 for continuous use in commerce (deleting those not using in commerce anymore)
 - Sec 9 for renewal of ten years
- Renewal after nineteen years of registration
 - Sec 8 for continuous use in commerce (deleting those not using in commerce anymore)
 - Sec 9 for renewal of ten years
- Maintaining Trademark Rights
 - Within five years of registration
 - After five years of registration for Principal Register
 - After five years of registration for Supplemental Register
- Watch your Rivals' Trademark Application or Registration
 - Letter of Protest before Examination
 - Notice of Opposition within the window of Published for Opposition
 - Petition of Cancellation after Registration before Sec 15 is filed
- Trademark Family Expansion
 - Sec 2(f) Principal Register of same or similar family application and expansion
 - Goods/Services expansion of same trademark or service mark

Non-Traditional Trademarks

- Shape of goods
- Color of goods
- Sound of goods or services
- Motion of goods or services
- Feeling of goods or services
- Process of services or making goods

Priority of Trademark Rights (First use in commerce instead of first filing of application)

Madrid Protocol of Global Trademark Protection

- Requirement of filing base
- Common practice of protections
- Subsequent expansion of protection
- Separation from home base

Chapter 3: Global Rules and Regulations

- World Trade Organization (WTO) rule
- North America (USMCA) rule
- Economic and Trade Agreement Between US and China

Chapter 4: Global Practices based on Goodwill, Good Faith and Due Diligence

- Goodwill
- Good Faith
- Due Diligence

Chapter 5: Case Studies (over 3,000 cases practiced and/or managed by Prof. LU)

Quiz and Test