

Comments On The Patent Application Drafting Assignment

- I. General
- II. Abstract
- III. Summary
- IV. Background
- V. Flowchart

I. General

- A. Good effort on everyone's part! I tried to make lots of comments
- B. Good job to everyone who incorporated the previous comments and revised their DD
- C. Watch out when writing "the invention does X" rather than "one embodiment of the invention does X" - it may be interpreted as limiting.
- D. Watch the recitation of undefined terms - "fuel efficiency"
- E. Don't use pronoun-like shortcut words, especially after complex sentences
The use may be unclear and may open the door to adverse interpretation.
Example: [sentence reciting several devices]. Such devices ..
OR "This device ..." (which one?)
Instead: "The solar panel devices ..." OR "the solar panel"
Even: "Such solar panel devices ..." would be ok as long as it is clear.
Lock down the meaning so that adverse parties can't tamper with it.
- F. Watch the slang - "runs on gas"
- G. Watch the statements of criticality: necessary, need, must
- H. Again, bad words include: means, consist, can/will/maybe

II. Abstract

- A. Limit the abstract to the independent claims. You can recite a chief advantage if you like, but it quickly get unwieldy if you let yourself go.
- B. Remember the PTO's 150 word limit.

III. Summary

- A. Limit the summary to the independent claims plus some advantages to respond to needs in Background. Don't try to summarize everything in your DD in the Summary.
- B. Do provide the general structure of your invention rather than just reciting the advantages of the invention.
- C. Don't discuss what the prior art does not teach in the Summary. What is lacking in the PA belongs in the Background.

IV. Background

- A. Most people probably found it more difficult to write the background than the DD because ICOA gives you a structure/outline and a starting point for your efforts. It's much more difficult to get started when you have no structure, right?
- B. You have a prior art patent. did you disclose it in your Background? The Background is a good place to explain the prior art and then differentiate your invention from the prior art. Also, the Examiner typically believes what you write in the background with regard to the PA and doubts your later responses to office actions.
- C. Try to be more clear when pointing out the limitations of the prior art. Mention that solar panels with adhesive backing appear in the prior art, but are limited to uses in a roof on a building.
- D. Treat the background with importance - it's the first thing that the Examiner will read and you can really sell your invention.
- E. Many of the backgrounds were not very focused and kind of wandered. It may help to outline the background before you start writing. It may also

help to let someone else see it after you have written it and then get comments from them.

- F. As you are writing the background, think about what you are writing. How does it advance the ball? How does it help the Examiner understand my differences from the prior art? AKA How does it create a clear differentiation in the mind of the Examiner between my invention and the prior art?

V. Flowchart

- A. Each box should be an action, not a structure

