

# Comments On The Patent Application Drafting Assignment

- I. Strive For Clarity
- II. Summary
- III. Background
- IV. Specification

## I. Strive For Clarity

### A. Subject, Verb, Predicate

Say exactly, precisely what you mean

Common English - "Oh, you kinda know what I mean" is not good enough

We need to lock down the language to withstand attack.

### B. One sentence, one concept

### C. Don't use pronoun-like shortcut words, especially after complex sentences

The use may be unclear and may open the door to adverse interpretation.

For example, "The coupon is downloaded and displayed on a removable device. This includes a barcode and other data and is stored on a server."

Coupon or device?

What if I erased "and is stored on a server?"

Can you clearly tell which one I am talking about?

Instead: "The coupon includes ... " or "The device includes"

Lock down the meaning so that adverse parties can't tamper with it.

### D. Use "because" when you mean "because" - not "since" or "as"

"Since" has a time element and "as" implies a comparison

### E. Still had some people writing "the invention does X" rather than "one embodiment of the invention does X" - Watch out! It may be binding.

### F. Watch the slang - "get the coupon into the hands of a user" "sunk cost"

### G. Watch the statements of criticality: necessary, need, must

### H. Again, bad words include: means, can/will/maybe

### I. Use Connectors for increased clarity

Examples: Thus, More Specifically, Instead, Conversely, Also, Additionally, Further,

- J. When drafting patent applications, we use certain language not because we are hidebound traditionalists, but because the language that we are using is very precise. Try to cultivate the habit of being very specific in your writing.

## II. Summary

- A. Limit the summary to an independent claim. Don't try to summarize everything in your DD in the Summary. Just hit the main points.
- B. Do provide the general structure of your invention rather than just reciting the advantages of the invention.
- C. No object statements

## III. 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? Feedback with regard to the experience?
- B. The Background can be taken as admitted prior art. Consequently, as we discussed in class, **DO NOT DISCLOSE YOUR INVENTION IN THE BACKGROUND**. What you view as your point of novelty should **NOT** be disclosed in the Background. Example:

NO – “The present invention ... “ (Outside the Filed Of The Invention)

NOTE: Field of the Invention was originally used for classification purposes. Not really used that way any more, but it is still on the books.

NO – “Consequently, a coupon delivery system with a website that lets manufacturers store coupons for downloading to a removable device that may then be brought into a store to electronically display coupon information would be highly desirable.”

OK – “Thus, a system that allows a user to more conveniently store and manage coupons is highly desirable.”

NOTE: "... would be highly desirable" is OK too. This is one of the few places where it is OK to use "would". However, it's a dangerous word to use elsewhere so I circled it to make you aware.

- C. You have at least two prior art references. Did you disclose them 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. Disclosing the PA references can help you more clearly point out to the Examiner what is missing in the prior art.
- D. When we talk about the prior art, give the Examiner some "hard" difference to focus on. The fact that a specific feature is not there is a hard difference. Stating that the prior art is not "convenient" or "easy" or "of dubious value" or any other "value word" is not a hard difference that appeals to the Examiner or buys you distinction for your claims. Focus on elements that you can differentiate in your claims.
- E. 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 your 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?
- F. Don't just point out something in the prior art and then move on. When you are pointing something out, you are doing so for a reason. STATE THE REASON. Why is the fact that you have highlighted important? What should the Examiner remember for later when he is looking at the claims with regard to what you just pointed out? Write out the conclusion that necessarily follows from the facts that you have just related. Don't assume that the user will make the same decision with regard to the facts that you did. Be specific. Be clear.  
EXAMPLE: "Prior art systems are not convenient. Kiosks print coupons."

How do these two concepts relate? You probably have mentally made a connection between these two concepts, but it's not on the paper.

- G. Remember that the Background is linked to your claims. Specifically, you are pointing out that the prior art does not teach what is in your claims. You are NOT just stating that a new coupon delivery system would be nice. You are focusing on the absence in the prior art of a specific feature. Your invention as claimed is what remedies that absence.
- H. 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, especially someone not familiar with the invention.
- I. In this regard, in some cases it felt like people have become so familiar with the invention that they may be losing the ability to go back and explain the basics to someone who has no experience with the invention. When you are writing the Background, try to think about how to provide an intro to someone who has no experience with the invention and only minimal experience with the field.  
Walk through the function of the PA in detail - Are you assuming that the inventor "knows how it works?" Lock down the PA examples. Reveal their limitations.
- J. Most people need better descriptions of the prior art  
Not quite the level of disclosure of the DD, but we want it to be clear to the Examiner what is going on  
That is, the Examiner needs to be clear about the SPECIFIC differences between your device and PA
  - 1) What PA does
  - 2) What PA does not do
  - 3) Why that matters
- K. Define your terms in the background – What is a coupon? What is "to redeem?" After we define our general terms, then we move on to defining the prior art.

- L. Proper citation to references:  
U.S. Pat. No. 6,568,599 (“the ‘599 patent”)  
U.S. Pat. App. Pub. No. 2006/0080173 (“the ‘173 publication”)  
or  
U.S. Pat. No. 6,568,599 which lists on its face Dennis Lahey as an  
inventor (“the Lahey patent”)  
or  
“as shown in Lahey, U.S. Pat. No. 6,568,599,”

IV. Specification

- A. Validations – identify each need/shortcoming mentioned in the background and provide a short (2-3 sentence) summary of the structure or function that the present invention has that provides for the need/shortcoming
1. We need a positive recitation of the structure or function, not just a blanket statement that “thus the invention satisfies need X”
  2. Sometimes this is hard for people to write because they feel like they just described everything in the previous 30 pages, why should they summarize it here?  
- Pretend that the Examiner did not read the spec (or did not read it thoroughly) and is just skipping to the end. Not that they would ever do that, right? No, of course not.
- B. Kudos to those who re-wrote their spec (or sections of it) You really get out of this class what you put into it. It’s easier to write the big block diagram when it is broken up, right?