

Comments On The Patent Application Drafting Assignment

I. General Comments

Great job on the patent applications. It is clear that everyone is really trying hard.

II. 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. Especially post *KSR*, the Background can be taken as admitted prior art. Remember that we no longer want to recite "long-felt needs" or other "motivational" statements in the Background because Examiners are using them against us.
- C. Additionally, think about what you are writing and whether it would give the Examiner something that they can say is a "motivation" for combination. For example, describing the prior art as being directed towards a problem – and a similar one that you are directed towards might be a problem. Additionally, if you get too specific about what the prior art fails to do, you start disclosing your invention.
- D. Did you consider all of the prior art references that you knew? In many other instances, you will also have websites that constitute prior art or other similar "less formal" references – don't forget to include them.
- E. Did you use the Background as your opportunity to point out the shortcomings of the most relevant prior art so that the Examiner would be able to appreciate your invention better as he reads the Detailed Description? Be aware that the Examiner typically believes what you write in the background with regard to the PA and doubts your later responses to office actions.

E. When we talk about the prior art, give the Examiner some specific “hard” difference to focus on. By “hard” we mean something that the Examiner can focus on as a potential claim limitation that differentiates you from the prior art. 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.

HOWEVER! We don’t want to explicitly say that the difference is a difference in our invention at this time. Instead, we want to be very clear about how the prior art works – and in the DD we will be clear about how we work differently.

F. When in doubt, move it out of the Background and into the Validation section.

G. Most people need better descriptions of the prior art’s limitations in order to make their advocacy more effective – DISCLOSE THE PRIOR ART IN TERMS OF ITS LIMITATIONS

Not quite the level of disclosure of the DD, but we want it to be clear to the Examiner what is going on – use repetition to drive home an idea – That is, the Examiner needs to be clear about the SPECIFIC aspect of the prior art – that will turn out to be a difference as you describe it in the DD

1) What PA does – in the Background

2) What PA does not do – maybe a little in the Background, but specifics in the DD and Validation section

3) Why that matters – DD and Validation section

Good words to start limiting phrases: only, limited to, requires

- Example:
- 1) Wang teaches a system that only transmits video one way, from the exterior camera to an interior screen or a mobile phone.
 - 2) Wilson teaches a system that is limited to unlocking a door security system.
 - 3) “provides an audio-only channel” “control is limited to”

- Bad Examples:
- 1) Wilson teaches a system that is limited to unlocking a door security system and does not teach locking the security system.
 - 2) Wang teaches a one-way video system, unlike other systems that show two-way communication.
 - 3) Wang teaches a system similar to previous systems that show two-way audio communication except Wang provides video and only one way.

III. Detailed Description

- A. Validation – This is your last opportunity to point out the differences between your invention and the prior art that you will have before the Examiner looks at your claims. Make it powerfully persuasive. Link back to the Background. Be specific about limitations that are in your embodiments, but not in the prior art. Don’t skip the validation section. You can include more exciting, “marketing-type” language and link it back to the description.
- B. We need a positive recitation of the structure or function, not just a blanket statement that “thus the invention satisfies need X”
- C. 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. Convince the Examiner of how great the invention is and he will likely be more helpful.

IV. Summary

Don't have to summarize each of your independent claims. You want a clear, understandable Summary of your invention. It will often be similar to your independent claims, but some independent claims are so vague/broad that you can't really tell what is going on. What you want to deliver is a concise explanation of your invention and how it works in a way that will be understandable to the examiner in order to help them understand the spec better.

V. Abstract

- A. Generally very good – use more understandable language than the independent claim if needed.
- B. Remember 150 word limit.