

Comments On The Patent Application Drafting Assignment

I. General Comments

- A. Great job on the patent applications. Just about everyone is really trying hard and making good progress.
- B. It seems like a few people are still being held back by poor word choices that were made early on and/or some structural faults in the application. These will get better with time, but are often difficult to correct because your brain “locks in” on the first thing that was created.
- C. In several instances, the newly added sections were markedly better than the previous sections.
- D. In order to maximize your gain from this exercise, take 20 minutes or so and really think about how you could have done it differently. What worked? What did not work out so well? What choices were you not happy with – and why did you make them – and how can you avoid making them in the future? It may be helpful to write out these insights and then refer to them before you start drafting your next patent application.
- E. In a larger sense, consciously thinking about how you could have made your product better is really one of the only ways you will improve because your feedback in the law firm will likely be pretty infrequent.

II. Background

- A. Most people may have 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. Also, avoid giving the Examiner easy admissions phrases that the Examiner can use in the Office Action. For example, “The X reference teaches a UV detection and adjustment system.” This may be true, but describing it in terms that are similar to your claim language just makes it easier for the Examiner to hit you with it in a rejection. Instead, talk about the limiting parts of the reference rather than trying to describe it totally.
- E. Do not recite your invention in the background. Outside of the Field of the Invention (first paragraph) no mention of “the present invention” or the “present system.
- F. 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

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 of the Figures.
- 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.
- D. It is also helpful because you can clearly point out distinct elements of the system or method that you regard as novel over the prior art. Otherwise, the Examiner may have just glossed over it during the previous 30 pages.

IV. Summary

- A. You 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 use language that is so vague/broad that you can't really tell what is going on.
- B. The summary can be quite short. One page is plenty.

V. Abstract

- A. Generally pretty good. For some people, the Summary was several pages long and the Abstract was a paragraph. In those instances, the Summary could be more like the Abstract.
- B. Remember 150 word limit.

VI. Figures

- A. Remember, lead lines must be curved (not straight) in the figures.
- B. Remember 1 inch margin requirements

VII. General Issues

- A. Don't paragraph number the section headers.
- B. How does the SPF determination relate to determining the MED?
- C. Use of Figs 5a, 5b, 5c
- D. Bell graph must be in figs.