2026 Comments On The Patent Application Drafting Assignment

I. General Comments

A. Great job on the patent applications. Most people are really trying hard and making good progress. Overall, the grades were very good.

B. Although it really seems like it has been mostly overcome, 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 all instances, I could see improvement in the application. Great!

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. What aspect of your patent drafting process helped you make the most progress in understanding the invention?

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.

F. 80% of Students had an issue with their page count in the header
-Figures are not counted
- Abstract was not included or there was strange renumbering

II. Background

A. Some 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. 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. Additionally, the Field of the Invention is just the Field for classifying the invention – NOT the point of novelty. Just think about "What field would the PTO classify this invention as?"

- Don't disclose the PON in the Background section.

- Especially post *KSR*, the Background can be taken as admitted prior art. Do not admit your PON is 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, don't say "The prior art shows X" unless you are absolutely certain you want to admit that on the record. Don't do the Examiner's job for them.

- Don't use terminology from your specification (or claims!) when discussing the prior art – if the prior art uses different terminology, then use that – or else it can be used by the Examiner as an admission.

E Most people did a good job with their descriptions of the prior art's limitations in order to make their advocacy more effective

– We always want to DISCLOSE THE PRIOR ART IN TERMS OF ITS LIMITATIONS- not the similarities to the present invention.

Good words to start limiting phrases for describing the prior art: only, limited to, requires

F. In many cases, recognition of disadvantages is itself an important part of the invention – or at least a motivation for one. Thus, don't put it in the Background.

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. It is also your opportunity to review the invention disclosure and include all of the "sales" language that the inventor wrote.

- This is also the section where you explain the "WHY" of the system. For example, it can be very powerful/persuasive to the Examiner to explain the problem that you are solving – that you are trying to save lives of those in custody – which is different than a lot of the prior art cited against you (which includes delivering a shock if they go to far away). These differences can form a good basis for a later argument to defeat a 103 rejection but providing evidence that a person of ordinary skill in the art would not combine the two references because they are used for different purposes or are otherwise not combinable.

- Don't say "the invention does X" – could be limiting. Instead use "in one embodiment" or just recite the system or component.

- Basically, the more awesome and revolutionary you can convince the Examiner that your invention is, the easier time you will have in examination. The validation section is your opportunity to do that!
- You know all of that marketing language that the inventor wrote in the specification, but you could not claim? This is where that language goes.
- Also, recent 101 case law frequently references specific (novel) applications taught in specification's validation to help overcome 101.

NOTE: You can include all of the "why" or "impact" of your invention rather than just the invention itself. You can really make the specific application seem like it adds "significantly more" than what was there before – and that the invention is "integrated in a specific technical/practical application." You can also actually recite why it is "significantly more" and "integrated". You can then later point it out in the specification itself in response to a 101 rejection.

B. Why include a validation paragraph?

1. As a check to make sure you include all commercially valuable features identified by the inventor.
2. Explicitly point out to the Examiner all commercially valuable features. (May help persuade Examiner or later jury). Otherwise, the Examiner may have just glossed over it during the previous 30 pages. This is something that you can point to in a later 101 or 103 rejection.
3. Emphasize improvements over the prior art / pre-argue obviousness rejection. That is, you can specifically point out why one or your embodiments teaches or does something that one or more of the prior art references do not.

C. We need a positive recitation of the structure or function that accomplishes the great new features, not just a blanket statement that "thus the invention satisfies need X". However, you can refer to the previous figures and the Background, so this should be straightforward.

D. 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? Convince the Examiner of how great the invention is and he will likely be more helpful.

E. 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.

F. 80% of students included a Validation paragraph.

G. Boilerplate paragraph – 80% of students included it. It might not do much in the US, but it can have a large impact in some foreign countries – and if it is omitted from the specification as filed, it can NOT be added later. Be sure to keep it.

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. Remember that "said" only belongs in the claims, so re-word the claims slightly.

B. Remember 150 word limit.

C. As mentioned in the lecture, it is a legal requirement that the Abstract (and claims begin on a new page). If they don't, then the PTO will reject your specification and require you to file a substitute specification in compliance with the rules.

D. Don't say "the invention does X" instead use something like "a system (or method) is provided which"

VI. Figures

A. Remember not to put numbers on top of other structural elements.

B. Remember 1 inch margin requirements

C. Text and Numbers 1/8 inch high (12-point maybe, 14-point OK)

D. Brief Description of Figures – Do not include reference numbers

E. Lead lines must contact the element they are identifying

F. Watch out for Fig 1(A, B, etc). Some Examiners require you to remove the A and B and revise the figure. It is best not to use them.

G. Best practice to keep the numbering easy to follow. Don't jump around between figures, don't number sequentially.

VII. Claims

A. Claims appear to be improving, but many claims still need work

Students are urged to work with each other to review each other's claims.

VIII. Overall Thoughts

A. Did you include all of the disclosure? Was in enabled? This is the biggest potential liability issue.

-Most students included all of the inventor's disclosure including the inventor's figures and enablement details like the Tesla self-driving system and other aspect.

B. You would want to recognize earlier in the process that you desired more information and then ask the inventor. If you don't have it, then try to walk through the system step-by-step so that at least you are enabling something.

C. If the Inventor signs the Declaration, then she/he is alleging under penalty of perjury that what is in the spec is her invention. If they did not read it and later try to blame it on you, you can point to the signed declaration- but they still won't like it. On the other hand, if whatever you added is not enabled, then they could try to put it back on you because you have the responsibility for making sure it is enabled.

D. Remember! Only items specifically mentioned in the spec can ever be claimed.