

Comments With Regard to Filing Paperwork

1. Application Transmittal
 - A. Remember to check off all of your documents, including IDS

2. Fee Transmittal
 - A. VERY IMPORTANT - Always give the PTO permission to charge the deposit account – not just for this filing, but for any needed fee. If you do not, and the PTO decides it needs an additional fee, then it won't ask for it – it will just abandon your application –Yikes!
 - B. Small entity – remember half off on the fee
 - C. Remember to enter the total fee at the top of the page
 - D. You don't have any multiple dependent claims

3. Power of Attorney

Not too many errors here – good job!

4. IDS
 - A. Disclose all references – a number of people did not disclose the patent, the publication, or the design patents
 - B. Disclose the websites
 - C. You don't have to identify relevant parts of the patent. Saying “whole reference” is ok, but may not be accurate

Comments On The Patent Application Drafting Assignment

I. General Comments

This is by far the best crop of patent applications that I have ever received in 4 years of teaching. Don't get complacent, but great job on your effort and quality of work. If you keep working at this level, you will do well in practice.

II. Summary

Not too many errors – good job!

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. Especially post *KSR*, the Background can be taken as admitted prior art. Most people did well in not disclosing their invention in the Background, but 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. The Background is a great opportunity for you to do some subtle advocacy for your invention. You can view it as kind of a pre-emptive response to an Office Action. For example, you disclose several prior art references in your IDS – the odds that the Examiner will cite those references against you go way, way down if you do a good job distinguishing from them in the Background. Some people go so far as to use the “1) reference teaches, 2) reference does not teach” structure that we saw for responses to 102 rejections.
- D. Did you disclose all of the prior art references that you knew? Both the patents and publications and the websites? More importantly, did you use

the Background as your opportunity to point out the shortcomings of the 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. Disclosing the PA references can help you more clearly point out to the Examiner what is missing in the prior art.

- 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.
- 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 your differences from the prior art? How does it create a clear differentiation in the mind of the Examiner between my invention and the prior art?
- G. 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 system is heavy and inconvenient”
Why does this matter? Emphasize the technological reason underlying this statement to provide a “hard” limitation for the Examiner. For

example, the prior art may be heavy because they are effectively carrying a full computer, including power source, standard monitor, wireless communication, and processor module, as well as a frame that must be quite weighty in order to support the weight of all of the other components.

H. Remember that the Background is linked to your claims. Specifically, you are pointing out that the prior art does not teach what will be in your claims. You are focusing on the absence in the prior art of a specific feature that will later be appearing in your claims.

I. Most people need better descriptions of the prior art's limitations in order to make their advocacy more effective

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

IV. 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.

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.