

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? 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 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

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 – “The prior includes a number of references that require a user to estimate and manually enter their information. A first reference that requires a user to estimate and manually enter their information is X. X teaches . . . A second reference that requires a user to estimate and manually enter their information is Y. Y teaches . . .

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

- H. Use the Publication numbers or Patent numbers when identifying prior art – not the application numbers.

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.
- 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.
- D. Still some strange word choices – e.g., “a system for neutralizing carbon”