

# PATENT DRAFTING

A Holistic Best Practices  
Drafting Approach to the  
*Leahy Smith America Invents Act*

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This is an electronic first edition of a work that is planned for a “regular” second edition in 2016.

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Articles expressing a differing points of view are particularly welcome; copies preferably in WORD format are appreciated.

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**Case Law Last Updated May 1, 2015**

**This version: May 18, 2015**

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## Preface

*Stop!*

Is this book addressed to you?

This book is for patent practitioners –attorneys and agents – with at least two years patent drafting experience, and for house counsel who wish to understand policy implications for the patent applications they draft.

Thus, familiarity with the fundamentals of patent practice is the *starting point* for use of this book. The reader thus starts, *here*, with the knowledge of how to construct individual claims, the law of inventorship, and a detailed knowledge of the state of the art.

There are many different ways to view substantive patent law and practice. Many texts look to substantive patent law and particularly to patent drafting through the hindsight lens of high stakes and well publicized patent litigation as it is concluded at the appellate stage. The individual elements of how claims *can* be drafted and how a specification *can* be written are seen through this rearward approach. This work instead takes a business approach to a *prospective* view of patent drafting and what *should* be accomplished in drafting a business-based application. Above all, the primary focus of this book about *drafting* the application in the first instance, drafting the *very first* application that will serve as the priority base for most patents. (Indeed, most patents claim priority based upon at least one provisional application *or* parent of a continuation, continuation-in-part or divisional *or* an overseas Paris Convention priority application.) The special role of this “first” first-to-file application is the particular focus of § 1[a][3], *First Application Elements in a First-to-File World*.

## **Wegner, Patent Drafting, A Holistic Approach (1st ed. 2015)**

This book is addressed to patent practitioners who *already* know the fundamentals of claim drafting and the elements of patent drafting, but, here, are provided with a holistic approach that focuses on the *essentials* necessary for a quality filing in a timely manner under first-to-file.

A second focus of this book is on the post grant challenges at the Patent and Trademark Office Patent Trial and Appeal Board. Here, drafting is considered from the standpoint of *avoiding* problems at the PTAB when the drafted application becomes a patent – and is then fair game in a PTAB challenge, as discussed under heading (II), *Top Ten Drafting Steps to Mitigate PTAB Formalities Challenges*.

Finally, it can be seen that there are some very simple reforms the Patent Office can make to improve the system that will result in better drafted patent applications: How can one create quality patents without a quality application in the first instance, as discussed under heading (III), *Low Hanging Fruit: Near Term PTO Reforms*.

### **(I) Keys to a Premium Priority Filing in the Shortest Time**

This book takes a holistic approach to patent drafting to provide a *simplified* patent application that is more efficiently drafted and provides better protection than the more complex application one would prepare if one were to follow the guidance of the *Manual of Patent Examining Procedure*.

## Wegner, Patent Drafting, A Holistic Approach (1st ed. 2015)

The focus of this book is on a *quality* first filing that takes no shortcut to the drafting of the *necessary elements* for a first filing, while an almost equally important objective is to permit the *most efficient* filing that thus produces a work product with the earliest filing date, the watchword of any first-to-file system. While the various aspects of these goals and how they are met are found in diverse sections of this book, *all* are tied together in § 1[a][3], *First Application Elements in a First-to-File World*. In particular, a primary emphasis is placed on several key elements for the first filing. See § 1[a][3][D], *Essential Elements for a First Filing*, while at the other end of the spectrum features sometimes or commonly found in patent applications are *entirely eliminated*. See § 1[a][3][F], *Elements that Should NOT be in a First Filing*.

Above all, this book is focused on the preparation of a *premium quality* first filing for priority in a first-to-file world. While the book throughout teaches various aspects of this strategy, everything is tied together in § 1[a][3], *First Application Elements in a First-to-File World* as discussed in the preface, *Keys to a Premium Priority Filing in the Shortest Time*.

## Two Reasons to Rethink Patent Drafting Techniques

There are two major reasons at this point in time to completely rethink the patent drafting process. First, and most obviously, the changes in the *Leahy Smith America Invents Act* represent the most serious revision of the American patent law since at least the 1836 creation of the modern patent examination system. Simplified, streamlined patent filing procedures are manifestly necessary in view of the introduction into the United States of the now global system of first-to-file. *See* § 1[a][1], *Cold Reality of First-to-File*. Procedural changes, too, bring challenges to patent validity home to the average patent practitioner such as the current reality that any new patent application drafted today will be subject to a Post Grant Review (PGR) proceeding immediately after grant.

More subtle is the fact that the *Manual of Patent Examining Procedure* does *not* comport with a best practices patent filing regime. To the contrary, the *Manual* all too often has antiquated advice that has negative consequences both for the applicant as well as increasing the workload of the examiner. *See* § 1[a][2], *Need to Abandon the Manual as Teacher of Patent Law*.

### Out of Date Procedures that Don't Mesh with First-to-File

Nearly half of all patents granted today have gone through the wringer of at least one refile in what is often a contentious and protracted give and take with the Patent Examiner, often with an at best ambiguous prosecution history that casts doubt on the breadth of protection or the validity of the claims – or both. A major reason for this problem is the piecemeal approach that is too often taken where applicants take a series of actions which, individually, may be fine, but collectively overwhelm the examination process. On the one hand, the Examiner is unable to

## Wegner, Patent Drafting, A Holistic Approach (1st ed. 2015)

wade through the many issues presented in a manner to fit within time requirements. On the other hand, the Examiner is unable to catch the small formal matters of lesser importance to the applicant and the public, but items which are considered by Quality Review: If the case is allowed, *then* Quality Review steps in to “grade” the Examiner.

### A Best Practices Approach

In contrast to the piecemeal approach, here, a holistic view to patent drafting is taken. This means in the first instance a focus on the critical elements necessary for an optimum patent document with each element *balanced* as part of the whole. The focus, here, is on a minimal set of claims (but with all claims necessary to satisfy the business interests of the applicant), a laser focus on a *Summary of the Invention* with all features necessary for examination and an absence of *any Background of the Invention* or prior art citation, discussion or argumentation.

Simplicity is the watchword of this holistic approach.

Five or six or seven claims are presented – instead of fifty or sixty or seventy.

Everything the examiner needs to know about the claimed invention is housed in a concise *Summary of the Invention* including definitions of terms at the point of novelty and examples of elements of the claimed invention.

Seven or eight prior art references are *cited* (but not characterized or otherwise argued) in a parallel Information Disclosure Statement (instead of any prior art reference in the specification and instead of seventy or eighty citations).



### An Early, Complete Examination for the First Filing

The simple application envisioned in this book *should* receive a complete examination within the short time frame allocated for each case.

This means that any ambiguities that would raise an issue under Section 112 for support or claiming particularity *will* be raised – and can then either be obviated by amendment or clarified to create a clean prosecution history. This will help in a defense of a Section 112 attack at the Patent Trial and Appeal Board in a Post Grant Review.

This means that the examiner will have confidence in allowing a patent without refiling, confident that he has caught all of the items necessary for a complete examination.

“Simplicity” goes beyond a focus on what *should* be included in the application. “Simplicity” also means *avoiding* inclusion of features that in the past have been included in an application but *should not* be included in the application such as the “gist” of the invention, “field of the invention”, “object” of the invention; “problems” faced by the inventor; “thrust” of the invention, “heart” of the invention, “essence” of the invention; “essential” feature of the invention; “key feature” of the invention; “key feature” of the invention; “nature” of the invention; “inventive concept”; “novel element” of the invention; and thrust” of the invention.

**The Simple Application as the Shortest and Best Path to Allowance**

Defenders of a more complex patent filing point to the *right* to file as many claims as desired and the *right* to cite an endless stream of prior art references. Lost in the shuffle is the fact that the exercise of such rights frustrates the possibility of allowance, and, in extreme cases, guarantees that an application will never be allowed without refiling or a Request for Continued Examination. A reality check is provided in the three “Simplicity” sections of the first chapter, and particularly § 1[h], *Simplicity, Why the Holistic Approach is Necessary*.

Exceptionally, Chapter Four provides a detailed discussion of the law of priority based upon an earlier filing. The disclosure standard for priority is now in play for more than fifty percent of all patents that are granted: Most patents are based upon at least one of a domestic continuing priority application under Section 120, a Request for Continued Examination or a Paris Convention priority application. There is a greater misunderstanding of priority standards than other areas of patent law.

***Some Aspects of the Manual are Bypassed***

To be sure, the best practices approach set forth in this book does not completely follow the guidance of the *Manual of Patent Examining Procedure*. For the patent law expert familiar with official guidance from either the European Patent Office or the Japan Patent Office this comes as a jarring reality.

## Wegner, Patent Drafting, A Holistic Approach (1st ed. 2015)

How can the guidance from an official source be deliberately avoided?

The answer in major part is due to the fact that some of the procedures in the *Manual of Patent Examining* at one time *were* in furtherance of the patent law *of the time* but in the meantime the underlying law behind the ongoing practice in the *Manual of Examining Procedure* has been *abolished*. (This is the case with the 1836 statutory requirement to disclose the “nature” of the invention which has not been a part of the patent law since January 1, 1953.) Other aspects of the law are anachronistic and serve no useful function. (The requirement for an *Abstract...* is from the pre-internet days to assist patent searches; the original purpose has disappeared in the era of internet searching.) Other practice points simply lack statutory basis or make no practical sense.

For anyone who is willing to follow the advice in this book without studying the underlying basis for the “best practices” approach outlined here, it is unnecessary to study the complexities of Chapter Six, *Manual of Patent Examining Procedure*. This chapter is reserved for anyone who wants to make a detailed study of the basis for the best practices approach that sharply departs from the *Manual of Patent Examining Procedure*.

## **(II) Top Ten Drafting Steps to Mitigate PTAB Formalities Challenges**

Heretofore post grant challenges through the Inter Partes Review (IPR) have focused upon prior art issues. Formalities challenges have not taken place through Post Grant Review (PGR) simply because the PGR provision is not retroactive to patents filed under the old law. Now, for first filings “today” any patent will be subject to the PGR post grant review that *includes* formalities.

A Top Ten List of actions at the drafting stage is provided in a special chapter devoted to avoiding or mitigating patent challenges under the new PGR proceedings. *See Chapter 7, Prophylactic Drafting to Mitigate Post Grant Challenges.*

## **(III) Low Hanging Fruit: Near Term PTO Reforms**

Two reforms are proposed in Chapter 8, *Near Term PTO Reforms, Harvesting the Low Hanging Fruit*, a better system to compel patent registration candidates to have a better practical understanding of the drafting process, § 8[a], *MPEP, a Failed Statutory Mandate to Teach Practitioner Skills*, and also to forcefully deal with “gamesmanship” that is rewarded today and not punished, § 8[c], *Drafting Gamesmanship, Abusive Business Techniques.*

## Wegner, Patent Drafting, A Holistic Approach (1st ed. 2015)

The statute authorizing practitioner licensure does not give the Patent Office free rein to arbitrarily focus its testing on procurement rules at the expense of the primary task to see that practitioners can, in the first instance, *write a decent patent application*: The critical, primary task of the patent draftsman is to draft a quality patent application. How can the Office hope to provide a quality patent as the output product of the Office unless the initial application has a high quality level? Thus, in the first instance, the statute requires the applicant to show that he is possessed of patent drafting skills. A proposal is made to modify the licensure examination and provide materials that – taken together – will better ensure such draftsmanship skills.

The overwhelming majority of patent practitioners are straightforward, honest folks who are doing their best to seek patent protection for the innovative community. A few work on the fringes of the system. Instead of focusing their efforts on a narrow set of five or six claims, a few present even *hundreds* of claims, either in a single application or a set of parallel applications. Nothing should impair the *right* of an applicant to present as many claims as necessary to define an invention. No arbitrary limit on the number of claims should be instituted. But, the Office must consider implementation of reforms well within its authority, as exemplified in § 8[c][7], *Examiner as the “Patent Policeman”*.

**“Footnote” Credits**

The writer acknowledges the influence of colleagues who have helped shape his thinking on patent practice as an Examiner – David G. Conlin, Kenneth E. Kuffner, Herbert Lidoff, Irving Marcus, Irving Pellman, Dr. Robert Raymond, Lorraine A. Weinberger, Richard K. Jackson, Sidney B. Williams; in boutique practice – James Elwood Armstrong III, Barry E. Bretschneider, Herbert I. Cantor, Prof. Donald S. Chisum, Ellsworth H. Mosher, Douglas P. Mueller, Helmuth A. Wegner, Lorraine A. Weinberger, Charles A. Wendel and John F. Witherspoon; and over the past generation colleagues at the Foley firm including its current its intellectual property practice leaders, Pavan A. Agarwal and Stephen B. Maebius, and now fellow Foley alumni Andrew S. Baluch, Hon. Sharon R. Barner, Hon. George Best, Hon. Richard Linn, C. Edward Polk, Leon Radomsky, Richard L. Schwaab, Kristel Schorr, Prof. A. Christal Sheppard, Jonathan R. Spivey and Prof. Sean Tu. In the early 1990’s, in particular, colleagues at the Bar Association of the District of Columbia played a significant role in shaping this writer’s thinking on patent issues, with particular thanks to Pamela Banner, Lynn Eccleston, Ron Kananen, Jim McKeown and Terry Rea.

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June 2015

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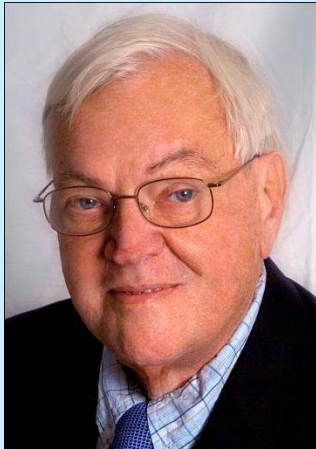
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