

# **FIRST TO FILE PATENT DRAFTING: A Practitioner's Guide**

**HAROLD C. WEGNER\***

Case Law Last Updated May 16, 2016

This version: May 16, 2016

[FirstToFilePatentDraftingMay16.pdf](#)

© MMXVI Harold C. Wegner

\* The author is President of The Naples Roundtable, Inc.<sup>TM</sup>, a Sec. 501(c)3 nonprofit organization “Exploring Ways to Strengthen and Improve the Patent System”, <https://www.thenaplesroundtable.org/>. This monograph is without endorsement or sponsorship from any other person or organization including The Naples Roundtable, Inc.<sup>TM</sup>.

## TOP TEN PATENT DRAFTING MYTHS

- Myth 1: “First Inventor to File” is a Unique System
- Myth 2: “The Same One Year Grace Period Still Exists”
- Myth 3: “Throw Away the Lab Notebooks, they are Unnecessary”
- Myth 4: “I can draft examples later, when I file the application”
- Myth 5: “Patent Searcher should not be Given Inventor’s Prior art”
- Myth 6: “We never file a provisional”
- Myth 7: “Always Get Me the Broadest Possible Claims”
- Myth 8: “I Always Cite Prior Art in a *Background of the Invention*”
- Myth 9: “I can always file a CIP to narrow the claims, if necessary”
- Myth 10: “I won’t Tell My Attorney about Possibly Narrowing Claims”

*The ten myths are all important but are unranked. They are listed, here, primarily by the sequence in the drafting process.*

### **Myth 1: “First Inventor to File” is a Unique System**

The new system is labelled as a “first inventor to file” system. In fact, the new American system is a classic “first to file” system. To be sure, the new American system is different from many other “first to file” systems. First, there is a limited grace period. Germany until it ratified the European Patent Convention, also had a grace period in its “first to file” system. Germany (and other countries) also is a first *inventor* to file system in the sense that if a third party files a patent application on subject matter derived from the first inventor, that first inventor is able to take title of the invention through legal proceedings in the German courts.

### **Myth 2: “The Same One Year Grace Period Still Exists”**

This is mythology: Under the literal wording of the grace period statute, the grace period disqualifies as prior art the publication of the *same invention* by a third party within the one year period after the inventor’s disclosure. But, the state of the art for measuring obviousness is based upon the *inventor’s filing date* where much may have been learned following the inventor’s publication, so that an invention *unobvious* at the time the invention was made is now *obvious* in view of the heightened level of the state of the art. Additionally, the literal wording of the

## Wegner, First to File Patent Drafting [2016]

grace period statute does *not* apply to exempt a third party's disclosure of an *obvious variation* of the invention.

Thus, the grace period disqualifies as prior art the publication of the *same invention* by a third party within the one year period after the inventor's disclosure. But, the state of the art for measuring obviousness is based upon the *inventor's filing date* where much may have been learned following the inventor's publication, so that an invention *unobvious* at the time the invention was made is now *obvious* in view of the heightened level of the state of the art. *See* § 2[a][6][C], *State of the Art as of the Filing Date*.

Additionally, the literal wording of the grace period statute does *not* apply to exempt a third party's disclosure of an *obvious variation* of the invention. The literal wording of the grace period and its interpretation by the Patent Office is that a third party publication of an *obvious variant* of the claimed invention is prior art against the subsequent filing of the first inventor's patent application: *The grace period does not apply to anything other than a disclosure of the same invention: "A disclosure \*\*\* of a claimed invention shall not be prior art to the claimed invention [as having been patented, described in a printed publication, or in public use, on sale, or otherwise available to the public before the effective filing date of the claimed invention] if \*\*\* the subject matter disclosed had, before such disclosure, been publicly disclosed by \*\*\* another who obtained the subject matter disclosed \*\*\* from the inventor \*\*\*."* 35 USC § 102(b)(1)(B)(integrating in brackets text from 35 USC § 102(a)(1))(emphasis added). Undoubtedly, at some point in time there will be a test case challenging the literal interpretation of this statutory provision.

### **Myth 3: "Throw Away the Lab Notebooks; they are Unnecessary"**

This is mythology: It *is* true that establishing a date of invention for priority purposes has lost meaning under the Leahy Smith America Invents Act.

But, *it is also true* that a Laboratory Notebook remains important to establish inventorship (which can be crucial in establishing a right to the grace period) and provide a contemporaneous record of what, precisely, was invented, and when.

The Laboratory Notebook helps pin down the inventive entity. The Laboratory Notebook provides evidence of derivation by a third party. The

## Wegner, First to File Patent Drafting [2016]

Notebook pins down inventorship (important in terms of the one year grace period that exempts the inventor's own disclosures as prior art but does *not* exempt a third party's disclosure of an obvious variant). The Notebook also provides a record of the prior art known to the inventor, to facilitate inclusion of that prior art in an Information Disclosure Statement, or helping to establish that the inventor was not aware of certain prior art in the drafting process.

### **Myth 4: "I can draft examples later, when I file the application"**

This is mythology: It is a difficult enough task to *contemporaneously* draft a "cook book" example to serve as "Example 1", but even more difficult at a much later date when the inventor tries to recreate what he did perhaps weeks or months earlier.

More importantly, a failure to *contemporaneously* draft the "cook book" example makes it more difficult to pin down who is the inventor of the subject matter. A key component of the Laboratory Notebook is the "cook book" example, which is the subject of a special chapter, § 9, "*Cook Book*" *Text of the Preferred Embodiment*.

While it is obvious that a trained patent attorney should supervise and actually draft the bulk of the patent application, it is also true that the *inventor* (or colleague working with the inventor on a daily basis) should keep a contemporaneous, running account of the development of the invention, including a "cook book" description of how to make and use the invention.

The cook book example of the preferred embodiment has plural functions. From the standpoint of drafting the patent application, an ideal "cook book" example can be simply "plugged into" the text of the application with only minor grammatical revisions. From the standpoint of establishing inventorship, the invention will only later be defined by the *claims*. Who invented what can be facilitated by *contemporaneous* record keeping, down to the level of a "cook book" example of the preferred embodiment.

### **Myth 5: "Patent Searcher should not be Given Inventor's Prior art"**

This is mythology: The inventor should name the most pertinent prior art references known to him in an Information Disclosure Statement. This will serve

## Wegner, First to File Patent Drafting [2016]

as basis for drafting an initial provisional application and also served as basis for an *informed* patentability search. Application preparation should *always* be conducted with full knowledge of what *the applicant* considers to be the most pertinent prior art. *First*, starting the patentability search with such knowledge will make this task more focused to find only prior art *as good as or better* than what the inventor has provided, ensuring that the search will produce fewer prior art references that will permit citation of only a few instead of perhaps dozens of references in an Information Disclosure Statement. *Second*, knowledge of the inventor's prior art information and the sharper focus this gives the searcher makes it much more likely that the best prior art *will* be discovered in the search. Third, of course, if the best prior art is missed in the search but was known to the inventor, there are manifest consequences of coming up short on the applicant's duty of disclosure under Rule 56.

Any prior art search should start with the inventor's own starting off point or other close prior art known by the inventor. To conceal this information when commissioning a search in the first instance may mean that the search will not discover such prior art. See § 10[a][3], *Avoiding a "Willfully Blind" Search* (discussing the *T-Fal Fryer* case, *SEB S.A. v. Montgomery Ward & Co.*, 594 F.3d 1360 (Fed. Cir. 2010)(Rader, J.), *modified*, *Global-Tech Appliances, Inc. v. SEB S.A.*, 131 S. Ct. 2060 (2011))(identify of commercial embodiment withheld from patent searcher and not found in his infringement search). More importantly, if the searcher starts from scratch he will pull many references in trying to pin down the state of the art, resulting in, say, forty or fifty references. If the searcher is given the inventor's best known prior art, the searcher may come up with *no further* prior art as pertinent a what the inventor has cited, or perhaps no more than two or three references as pertinent. Citing just the two or three references in an Information Disclosure Statement (instead of forty or fifty references) makes the examination more productive.

### **Myth 6: "We never file a provisional"**

This is mythology: A black and white position of this type is dangerous. Surely, there are some situations where a provisional *could be filed* based upon the "cook book" example and the prior art found in the Laboratory Notebook. If this disclosure is filed as a provisional before the subsequent Patent Committee approval, this gives the patentee valuable lead time in the first-to-file race to the Patent Office.

## Wegner, First to File Patent Drafting [2016]

It is important to file a provisional for many other situations: In large organizations an initial triage to determine which invention disclosures should result in a patent application may take several weeks that delay the filing. The local research unit should be delegated the responsibility of filing an early *provisional application* before the Patent Committee meets. The filing should consist essentially of the “cook book” example of the preferred embodiment with generic coverage informed by the inventor’s prior art knowledge.

It should also be understood that secrecy must be maintained until at least a filing decision is made by the Patent Committee as the provisional *will* provide defensive protection and be basis for *limited offensive* protection but *may not* serve as basis for generic protection.

***A “Bonus” Year of Patent Protection:*** The applicant who files a provisional application first enjoys a twenty-first year of patent protection, as the twenty year patent term does not start from the provisional filing date.

***Foreign Priority Application as the Equivalent of a Provisional:*** An Asian or European patent applicant should feel comfortable filing a “home country” Paris Convention priority application instead of a provisional application. The notorious *Hilmer* case that denied a patent-defeating effect to an application as of its priority date has been overruled. See § 1[a][3], *Defensive Patent Right as of the Priority Date (Hilmer Overruled)*(discussing *In re Hilmer*, 359 F.2d 859 (CCPA 1966)).

### **Myth 7: “Always Get Me the Broadest Possible Claims”**

This is mythology: A broad claim is *not* always a best goal of patent draftsmanship, particularly where either only narrow offensive protection is necessary or *any* defensive protection is the sole object of the application. To be sure, there *are* times when a broad claim *is* important, whenever broad *offensive* protection is important. But, the majority of situations do *not* require such broad protection: For **narrow offensive protection**, it may be counterproductive (and taken more time and money) to seek the broadest possible “claim 1”. For **purely defensive** business objective, it is *not* the claims but a specific embodiment, e.g., “Example 1”, disclosed in the specification that provides the patent-defeating

effect. Broad defensive protection requires multiple examples. *See Broad Defensive Protection Requires a “Matrix” Disclosure.*

**Broad Protection May Come with a High Price Tag:** Where the applicant is an early entrant into a field and wants *and needs* broad offensive protection, then by all means such protection can and should be sought. Thus, there *are* the relatively *rare* situations where obtaining the broadest possible claim *is* important, particularly where an inventor has a pioneer invention (which implies that there may be an absence of prior art that would permit obtaining a very broad “claim 1”, but this comes at a cost: The initial application with very broad protection should also have multiple layers of decreasing scope subgeneric claims (and disclosure), and in unpredictable areas include a matrix of examples that provide representative support for the broad scope of claim 1.

The obvious negatives to drafting a broad offensive patent application beyond the higher drafting cost is the problematic issues of first-to-file where such a filing may be delayed for days or weeks (during which a competitor may be the first-to-file) and the cost to produce a broad offensive application,

Beyond delays and cost considerations, the applicant with only broad generic claims generally cannot rely upon “claim 1” to take advantage of unobvious properties of the claimed invention because a showing of such unobvious properties may not have a “nexus” to the scope of claim 1. If claim 1 falls for formal or any other reasons, necessitating a new claim to a narrower generic scope, is one of the *originally disclosed* layers of decreasing scope generic coverage available (or, is there basis in the specification to retreat to this narrower layer).

**Assignee should Define the Needed Type of Protection:** It is rare occasion that the objective should be to gain the very broadest protection possible. Among the most common objectives for a corporate sponsor are: (a) Broadest possible offensive protection; (b) narrow offensive protection to safeguard a commercial embodiment and minor variations of that embodiment; (c) broad defensive protection to block a generic claim dominating a scope beyond the present embodiment; and (d) narrow defensive protection to block a patent that would dominate the present embodiment and close equivalents. Objective (a) may

## Wegner, First to File Patent Drafting [2016]

require a very sophisticated and time consuming drafting process involving generic, telescoping definitions of generic and subgeneric protection while at the opposite end of the spectrum a narrow purely defensive objective is achieved by filing *only* the disclosure of the “cook book” example (and at least one claim to satisfy statutory requirements); the purely defensive filing is operative upon publication of the application (after which it may be abandoned).

**A Written Understanding of the Business Objectives:** Where the applicant merely instructs the patent attorney to file an application, without business objectives, it is important for the patent attorney to clarify that he plans to seek the broadest possible protection possible (outlining the extra efforts needed for such an application) unless he provides contrary instructions (with an outline of what options exist for broad vs. narrow and offensive vs. defensive protection). Armed with a confirmation of instructions, this serves as a safeguard against the owner of the patent, years later, challenging the failure of the patent attorney to gain the maximum offensive protection possible.

### **Myth 8: “I Always Cite Prior Art in a *Background of the Invention*”**

This is mythology: It is wrong as a default filing policy for a first application to include a *Background of the Invention* section as the full state of the prior art is never known as of the filing date. Any characterization of the prior art in a *Background of the Invention* section may well create an argument for patentability that does not stand scrutiny (years later when other prior art is found) and arguments about the prior art may well be used as an admission against the patentee’s interests. *There is no duty to characterize the prior art, only a duty to cite the most relevant prior art. See §8[b], Background of the Invention.*

***Examiner-friendly Citation of Prior Art:*** At least in a first filing, an optimum procedure is to *avoid any citation or discussion* of prior art in the first filing. Even if a search has been conducted, the month or so after the first filing should be used to see whether there is any other prior art and to cull out any prior art that is not the most relevant prior art. In the end, the goal is to cite the three or four or so *most pertinent prior art* references, and not the thirty or forty or so references found in the patentability search. (If there is a doubt as to which of, say, seven of eight references is the most relevant, than all seven or eight should be cited – but not the thirty or forty found in the search.



## Wegner, First to File Patent Drafting [2016]

There may very well be good reasons to include a *Background of the Invention* section in a carefully drafted late stage continuation-in-part, but for a *first filing* the default should be to *never* file a first application with a *Background of the Invention*. This section will only hurt the applicant where the scope of protection may be construed to conform to limits of “objects” or “advantages” of the invention narrower than the claim wording; the statement of the prior art may be inaccurate (e.g., when later published but earlier filed published applications appear in the months after filing); the strength of the patent may be jeopardized by constructions of the invention inconsistent with the state of the art; or the section may explain the existence of a problem in the prior art, but this disclosure may very well provide the *motivation* to make the invention under *KSR* and hence destroy patentability.

(Of course, the duty of disclosure *must* be met: Meeting this duty is better accomplished through a simply Information Disclosure Statement that *lists* (but does not *characterize*) the most pertinent known references but includes copies of non-U.S. patent literature.)

***An Information Disclosure Statement under Rule 56:*** At least in a first filing, an optimum procedure is to *avoid any citation or discussion* of prior art in the first filing. Even if a search has been conducted, the month or so after the first filing should be used to see whether there is any other prior art and to cull out any prior art that is not the most relevant prior art. In the end, the goal is to cite the three or four or so *most pertinent prior art* references, and not the thirty or forty or so references found in the patentability search. (If there is a doubt as to which of, say, seven of eight references is the most relevant, than all seven or eight should be cited – but not the thirty or forty found in the search.)

To mitigate a searcher pulling too many references in his search, it is important that the search is not “willfully blind”: The inventor’s prior art information should be given to the searcher so that the searcher understands that he is looking for only prior art *as or more pertinent* as the inventor’s prior art.

**Myth 9: “I can always file a CIP to narrow the claims, if necessary**

This is mythology: It is a common misconception that if one starts with a broad claim or disclosure, if there is prior art to defeat the broad claim, one simply needs to file a continuation-in-part application *narrowing* the claims.

But, if there is no definition of the subgeneric retreat line in the original disclosure, the subgeneric definition may lack “written description” basis under Section 112(a). It is also not possible to avoid the “written description” problem by filing a continuation or continuation-in-part with the new subgeneric definition, assuming the original disclosure is now prior art: Under *Steenbock* a fresh subgeneric claim lacking “written description” basis in the parent stands naked as of the continuation or continuation-in-part filing date, and is hence barred due to lack of a priority right for the subgenus.

*Steenbock* applies if one presents a claim in a continuation-in-part that has a *different* scope than the parent disclosure, then the new claim lacks “written description” basis in the parent under Section 112(b), and thus stands naked as of the actual continuation-in-part filing date. The claim is thus barred under Section 102 if there is prior art prior to the continuation-in-part actual filing date. See § 11[d], *Steenbock “Rings” of Plural Generic Definitions* (discussing *In re Steenbock*, 83 F.2d 912 (CCPA 1936); *In re Ruscetta*, 255 F.2d 687 (CCPA 1958)(Rich, J.)); § 11[d][2], *Priority to Genus of Different Scope* (discussing *Steenbock*; see also § 11[d][4][A], *Narrowed Range Barred by Intervening Disclosure* (explaining *In re Lukach*, 442 F.2d 967, 968-70 (CCPA 1971), where a narrowed scope of protection lacked “written description” basis).

**Myth 10: “I won’t Tell My Attorney about Possibly Narrowing Claims”**

The mythology is that the attorney should always be fighting for the broadest claims. Telling the attorney that one is willing to accept narrowed claims is seen as an invitation for the attorney to unnecessarily compromise the scope of protection.

Both at the time of filing and forward during procurement the attorney should be given the latest goals. Is this application really important to dominate a field? Is narrower protection suitable?

The patent attorney often is called “at the last minute” by a Patent Examiner seeking to finally “dispose” of an application. The patent attorney needs to know the parameters as to how far he may compromise to gain an immediate allowance. Since the alternative may be a final rejection, it is important to always keep the patent attorney apprised as to the latest business objectives.

