

WINNING THE FIRST-TO-FILE RACE TO THE PATENT OFFICE: TEN THINGS *NOT* TO INCLUDE IN THE APPLICATION*

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Now that the *Leahy Smith America Invents Act* approaches its fifth anniversary of enactment, many practitioners have gained familiarity with specific requirements *necessary* for drafting claims and supporting disclosure. Yet, even today, Americans all too often take much longer to file a patent application than their European and Asian counterparts.

Of course, if an American first inventor is second-to-file because of delays inherent in the American system, this means that no matter how brilliant a job of patent drafting has led to the second-to-file application, his competitor, the second-to-invent but first-to-file applicant will upon publication of his application gain a patent-defeating right that vitiates the American first inventor's claims to the same invention.

A major culprit that slows down the American filing process is the ambiguous and outdated set of instructions in both the *Rules of Practice in Patent Cases* as well as the *Manual of Patent Examining Procedure*. Americans waste time in filing their first applications in order to comply with the requirements and suggestions in these documents which are outside the statute.

Among the requirements or practice suggestions that lack validity for a best practices approach may be mentioned the following myths:

(1) “I must recite the ‘field of the invention’”

The *Manual* states that the inventor should designate the “field” but there is no statutory basis for this requirement. See FIRST TO FILE PATENT DRAFTING: A PRACTITIONER’S GUIDE, § 6[c] *Background of the Invention* (quoting MPEP § 608.01(c), *Background of the Invention*, ¶ (1), *Field of the Invention*). See also § 6[c][1], “*Field of the Invention*”.

* Harold C. Wegner, FIRST TO FILE PATENT DRAFTING: A PRACTITIONER’S GUIDE (2016)

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(2) “I must “describ[e] * the prior art’ in the specification”**

There is absolutely no requirement to describe the prior art in the specification. See *id.*, ¶ (2), *Description of the related art including information disclosed under 37 CFR 1.97 and 37 CFR 1.98*.

(3) “The CFR says I should include a ‘[b]ackground of the invention”

See *id.* § 6[c], *Background of the Invention* (quoting 37 CFR § 77(b)(5)). The rule is lacking in statutory basis.

(4) “The MPEP says I should recite problems leading to the invention”

There is nothing in the statute to support this requirement of the *Manual*. See *id.* (quoting MPEP 608.01(c) *Background of the Invention*, ¶ 2 (“[T]he problems involved in the prior art or other information disclosed which are solved by the applicant’s invention should be indicated.”) Indication of “problems” may also be basis for substantive rejection of the claims. See § 6[c][3][B], *KSR-Related Problems with “Problems”*.

(5) “The MPEP says I should disclose the ‘gist’ of the invention”

Reciting a “gist” is an antiquated requirement of no basis in the statute today. See § 6[d], *Abstract of the Disclosure* (quoting *Guidelines*) (Abstract should permit upon cursory inspection “*the nature and gist of the technical disclosure*”).

(6) “I must disclose the best mode in the *original filing*”

A best mode defect is no longer fatal as the applicant under the new law may file a continuation-in-part that includes a best mode without loss of priority right. See MPEP § 608.01(h), *Mode of Operation of Invention* (“If the best mode contemplated by the inventor at the time of filing the application is not disclosed, such defect cannot be cured ***.”) But under the *Leahy Smith America Invents Act* (35 USC § 120) the best mode defect can be cured by filing continuation-in-part adding best mode.

(7) “I should cite prior art as part of the original application papers.”

There is no requirement to cite prior art in the specification *at any time* provided a parallel Information Disclosure Statement is filed within three months from the filing date. *See* MPEP § 609.04(b), *Timing Requirements for an Information Disclosure Statement*.

(8) “I should summarize the ‘nature and substance’ of the invention”

The “nature” requirement is statutory, dating back to the 1830’s, but not a part of the patent law since January 1, 1953. *See* MPEP § 608.01(d), *Brief Summary of the Invention* (quoting 37 CFR § 1.73, *Summary of the Invention*).

(9) “Any object recited should be that of the invention as claimed[.]”

This is a quotation from MPEP § 608.01(d), *Brief Summary of the Invention* (quoting 37 CFR § 1.73, *Summary of the Invention*). But, an “object” is not a statutory requirement.

(10) I should disclose “the exact nature, operation, and purpose ...”

See MPEP § 608.01(d), *Brief Summary of the Invention* (quoting 37 CFR § 1.73, *Summary of the Invention*). The “nature” requirement was introduced by statute in 1836 as a codification of case law dating to 1793. *See* § 6[b][4], “*Nature of the Invention*”: *1836 Statutory Basis*. By 1870, any reason to define the “nature” of the invention evaporated. *See* § 6[b][5], *1870 Law Mandating Claims to Define the Invention*.

Ambiguities in the Leahy Smith America Invents Act

To be sure, there remain ambiguities in the new patent law that offer multiple opportunities for differing ways to practice. None, however, should impact the Top Ten List above. For the remaining ambiguities there are several sources of key information pending resolution of test cases at the Federal Circuit:

First, Robert A. Armitage of the AIPLA is the one person who was involved with the entire legislative process dating back to the early 1990's. He has frequently written about specific issues as the legislation progressed through Congress. His various writings should be available through the AIPLA. Or, they may be obtained through a google search for the specific subject under consideration coupled with his name.

Second, for a quick study of what happened in Congress, Joe Matal kept copious notes from his perch with a Congressional staff responsible for the legislation. His information is compiled in an important two part series of articles, Joe Matal, *A Guide to the Legislative History of the America Invents Act: Part I of II*, 21 Federal Circuit B. J. 435 (2012); *id*, *Part II of II*, 21 Federal Circuit B. J. 539 (2012).

Also helpful in understanding the legislative process is an AIPLA treatise through recently published by Bloomberg BNA. *See* Alan J. Kasper, Brad D. Pedersen, Ann M. Mueiting, Gregory D. Allen & Brian R. Stanton, PATENTS AFTER THE AIA: EVOLVING LAW AND PRACTICE (Bloomberg BNA 2016).