

Holistic Approach to First-to-File: Necessary for Optimum Results

To properly draft and prosecute a patent application, a best practice is to take a holistic approach to the presentation of the application.

An excerpt is attached from the writer's monograph, FIRST TO FILE PATENT DRAFTING, A PRACTITIONER'S GUIDE, § 1[b], *A Holistic Approach to the New Patent Law*, pp. 55-61 (2016).

Regards,

Hal

June 15, 2016

FIRST TO FILE PATENT DRAFTING: A Practitioner's Guide

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Case Law Last Updated May 29, 2016

This version: June 15, 2016

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* The author is President of The Naples Roundtable, Inc.TM, 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.TM.

Wegner, First to File Patent Drafting [2016]

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§ 1[b] A *Holistic* Approach to the New Patent Law

§1[b][1] *Holistic* Patent Draftsmanship Defined

On a daily basis of patent examination in the first instance the challenge on the patent applicant is to present a clean application meeting the statutory requirements and in compliance with the duty of disclosure.

As a second aspect and a direct byproduct of a well drafted patent application is the *holistic* presentation of the patent application and prior art in a manner respectful of the Examiner's position and limited time for each examination.

The holistic approach focuses upon the entirety of the examination challenge. The holistic approach views the examiner's first action through the lens of a presentation that considers the whole of the examination challenge; the patent draftsman should put himself in the position of the Patent Examiner to see his side of the coin, his need to guard the public from overly broad or invalid patents while cooperating to see that the applicant gets his just results.

Holistic patent draftsmanship means the presentation of a patent application that takes into account the entirety of the examination challenge faced by the Patent Examiner (the claim analysis, the prior art search and the examination which is respectful of the Patent Examiner's time and effort.

The holistic approach is not at all *confrontational* where the patent draftsman seeks to avoid unnecessary controversies with the Examiner: There is a recognition that a confrontational approach is the antithesis of best practices.

§ 1[b][2] Elements of a Holistic Presentation

§ 1[b][2][A] Respect for the Examiner's Limited Time for Examination

Each Examiner has a quota of "disposals" per quarter that varies based upon the rated complexity of his particular technological art that he examines and his experience level. Reaching or exceeding the disposal goal is at the very center of the Examiner's professional life. Statistics are periodically released within each Art Unit that show precise disposal results. Substantially exceeding the disposal goal may result in a substantial cash bonus while repeated failure to meet the disposal goal may in an extreme case result in dismissal from the examining corps.

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As an example, consider the situation where a particular Examiner has a disposal goal such that he must complete a first action analysis, search and examination within, say, ten hours.

If the patent draftsman makes a presentation of a clean and easy to examine application with full citation of the best known prior art, then it may take, say, seven or eight hours for the complete first action analysis, search and examination.

Here, the Examiner generally *can and will* do a complete first action, including consideration of formal matters where a claim may appear to be indefinite. Here, the Examiner, upon finding patentable subject matter, will be prone to allow the application, perhaps after formalities have been met or claims have been narrowed to avoid the prior art. The apparent indefiniteness will either be (a) explained to show why the claims are definite, strengthening the prosecution history; or (b) overcome by amending the claims in a manner at least implicitly suggested by the Examiner.

If, however, the Examiner would need, say, sixteen hours to do a complete first action analysis, search and examination, the Examiner, under his production pressure, is likely to cap the examination at ten hours. To do this, it is quite likely that there will *not* be a complete formalities examination, leaving open a “Chef America” scenario where a claim defect renders the claims meaningless from an infringement standpoint. Additionally, the Examiner will do his best to search the application within primary search areas, but skip some aspects of the search due to time constraints. *Where the Examiner knows that he has not conducted a complete search on the merits he is more unlikely to ever agree to allow the application.* Instead, he will kick the can down the road, forcing the applicant to file an RCE or continuing application, and thus avoid allowing claims where the Examiner is uncertain whether the claims are patentable or not.

§ 1[b][2][B] Respect for the Examiner’s Position as a Quasi-Judicial Official

Holistic patent drafting means an honest presentation of the prior art but not in an arrogant or patronizing manner. In particular, this means that the patent draftsman should not include an argument concerning the prior art – whether in a *Background of the Invention* or Information Disclosure Statement.

Of course, the most pertinent prior art *should* be cited, but this does not mean that the patent draftsman should *characterize* or argue against the prior art. In the first instance, it is the task of the Examiner to pass judgment on patentability in his first action.

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If an Information Disclosure Statement is filed as a separate document, this may mean a simple list of the most pertinent known prior art, without more. (If one particular reference is of particular importance, this may be highlighted with a pinpoint citation of the most relevant page(s).) What should be the content of a *Background of the Invention*? Nothing, absolutely nothing.

§ 1[b][2][C] Respect for the Examiner's Position

The complexity of an examination is geometrically increased with the greater the number of claims. Thus, for example, it may well take ten times as long to analyze forty claims as an application with fifteen claims.

An applicant may have a *right* to file, say, sixty claims, but rarely if ever are sixty claims necessary to define a single invention. First, business considerations should dictate the filing of each claim: Is there a *business* reason for filing a particular claim. Second, for many situations a *disclosure* will have the same business benefit as a claim. For example, if the business object for a claim is purely defensive, particularly as a subclaim, the same objective is satisfied by a *disclosure* of the subject matter of the subclaim. Third, if there *is* a need for, say, sixty claims, one can consider segregating the claims into manageable units fit for a restriction requirement, so that only one subset of the overall claims is examined in the first application.

§ 1[b][2][D] Minimalist Prior Art Citations

Only the *most relevant* prior art should be cited. If there is any doubt whether one of say five references is the most pertinent prior art, then all five references should be cited. But, if there is a total of sixty prior art references and it is clear that fifty five are clearly much less pertinent, then the five should be cited and the mode of selection of the five references documented for future use.

An Information Disclosure Statement with, say, five references is far more useful to the Examiner than one with, say, fifty references. The IDS with just three references makes the Examiner's search much simpler: The Examiner can quickly go through the prior art and eliminate all but the references which are as or more pertinent than the three cited references.

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On the other hand, if fifty references are cited, this is an essentially useless submission of little value. Here, the Examiner is forced to go through all three hundred references, in essence conducting a parallel search to his regular search.

There is no excuse for citation of too many references. To avoid citing an overload of prior art references, there are things that can be done on a routine basis:

First, the patentability searcher should be armed with the *best known* prior art of the inventor and his patent attorney. The patentability searcher now will pull prior art references only as or more pertinent than the *best known* prior art.

Second, an intelligent judgment should be made by the patent attorney as to *which* references are the most pertinent. If, for example, a patent searcher pulls up sixty prior art references, surely forty or more are clearly *less pertinent* than the remaining twenty.

If the application is of extreme importance, the patent draftsman can retain an outside expert, furnished with (a) the prior art from the search; and (b) the patent draftsman's opinion as to which references are most pertinent. Then, the outside expert can give his conclusion as to which prior art references should be cited. (This is an expensive proposition relative to the average case. But, is it better to make this expenditure in a "cost is no object" application *versus* forcing the Examiner to wade through the sixty references?)

§ 1[b][2][E] A Simple Presentation Focused on the Claims and *Summary*

Beyond detailed drawings or examples of the preferred embodiment and the citation of the most relevant prior art, the two key features of the patent application for purposes of examination are the claims and the *Summary of the Invention*.

A minimalist claim drafting approach should result in, say, six – instead of sixty – claims.

Complementing the minimalist claims presentation should be a specific *definition* of any claim element at the point of novelty.

A Background of the Invention is unnecessary and should be avoided.

An *Abstract of the Disclosure* in the manner suggested in the *Manual of Patent Examining Procedure* should be avoided; the *Abstract* should parrot the definitions of claim elements using the same wording.

§ 1[b][2][F] Avoiding Side Show Argumentation

All too often, a *Background of the Invention* section will be included that includes a statement of unrecognized problems in the art and solutions achieved by the invention. Will the Examiner divert his efforts to showing that the problems *were* recognized in the art? Will this sideshow have any relevance to the objective consideration of nonobviousness.

§ 1[b][2][G] Avoiding Extraneous Manual Requirements

The *Manual of Patent Examining Procedure* does play an important role as a *procedural* “bible” for the patent practitioner. Beyond the *procedural requirements*, rote following of the *Manual* as a teaching of how to draft a patent application is quite dangerous. An entire chapter is the focus of the *Manual* and why it is wrong to blindly rely upon this document as a guidance for drafting a patent application. See § 6, *Role of the MPEP, the Manual of Patent Examining Procedure*. As a prime example as to why it is wrong to blindly rely upon the *Manual* as a teaching of how to draft a patent application, consider the *Summary of the Invention* section of the patent application. The *Summary* should be drafted to include a verbatim recitation of claim elements together with definitions of such elements, particularly at the point of novelty, as well as including alternatives to preferred elements. See § 6[b][2], *What the Manual Doesn't but Should Require*. Instead, the *Manual* includes a requirement keyed to the *Rules of Practice in Patent Cases* that the “nature” of the invention be set forth in the *Summary of the Invention*. This is a nineteenth century requirement. See § 6[b][4], “*Nature of the Invention*”: *1836 Statutory Basis*. But, by the mid-twentieth century the requirement had been eliminated from the patent law. See § 6[b][3], “*Nature of the Invention*”: *No Current Statutory Basis*. There are countless further examples in this monograph of practice rules and commentary that have no basis in the modern patent law.

§ 1[b][3] Sequential Filings to Meet Holistic Objectives

The application process should not be stalled due to an effort to file optimum claims and citation of prior art.

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In the first instance, prior art does not at all need to be cited at the time of first filing. It is perfectly proper and even *suggested* in the *Manual of Patent Examining Procedure* that prior art may be optimally cited up to three months after the filing date as part of an Information Disclosure Statement.

Additionally, an early filing date can be achieved by filing a *provisional* application and then, when all matters have been clarified, a regular application can be filed claiming priority to the provisional application.

§ 1[b][4] A Non-Confrontational, Respectful Approach

Holistic patent practice at first blush may appear to be too heavily focused upon an applicant making concessions to the Examiner and doing whatever the Examiner requests of the applicant.

Not at all.

A holistic approach does focus on cooperation with the Examiner and treating the Examiner with the respect his position deserves. This does not at all mean, however, that the applicant should acquiesce in an Examiner's position which the applicant considers unwarranted.

But, in traversing the rejection, the focus should be on a traverse of *the rejection* and not in any way an attack on the Examiner. Consider the following approaches:

Holistic approach: “The rejection of claims 1-3 as obvious under 35 USC § 103 over Smith in view of Jones is most respectfully traversed. The Smith reference fails to teach feature [X] as part of the claimed combination. Jones does teach feature [X], but there is no motivation to combine the Smith and Jones references, wherefore, it is requested that the rejection be withdrawn.”

Non-Holistic approach: “The Examiner's rejection of claims 1-3 as obvious under 35 USC § 103 over Smith in view of Jones is contrary to the case law. *See Graham v. John Deere & Co.*, 393 U.S. 1 (1966). The Examiner should withdraw the rejection because the Smith reference fails to teach feature [X] as part of the claimed combination. It is also clear that the Examiner's rejection is wrong

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as to Jones teaching feature [X] because the Jones patent provides no basis to combine that reference with Smith.”

Note that the holistic approach is non-argumentative and merely states the facts. The challenge is to “the rejection” and not stated as a challenge to the “Examiner’s rejection”. To the contrary, the non-holistic example, refers to the Examiner three times. The non-holistic example cites *Graham v. Deere*, one of the most well known cases in patent law. (Does the practitioner think that the Examiner is so dense that he does not know this case?)

§ 1[b][5] PTAB Appeals as Part of Holistic Prosecution

Holistic practice does not mean that the applicant should refrain from taking appeals to the Patent Trial and Appeal Board. Provided there is merit to an appeal and the appeal brief takes a non-confrontational, respectful tone, an appeal every once in a while *is* necessary to maintain the applicant’s credibility.

The holistic application is best for presentation on appeal to the PTAB, which is important at the examiner level of prosecution because if the examiner recognizes that there is a clean, simple presentation of issues at the PTAB, and where it is clear that the invention *is* patentable, there is far less of a chance that the PTAB will sustain the Examiner on appeal – and thus a greater chance that the Examiner will allow the application.

Even if the Examiner *does* issue a Final Rejection a neat, clean appeal brief focused on one issue and one or two claims presents a stark choice for the Examiner: Do I write an Examiner’s Answer and leave matters to the PTAB, or do I allow the application on brief. (Even though the application may have, say, fifteen claims, the appeal brief can argue only one of the claims. E.g., the appellant can state: “For purposes of this appeal only, appellant argues only claim 1 and accepts, *arguendo*, but only for purposes of the present appeal, that if claim 1 is unpatentable, the remaining claims stand or fall with claim 1.”)

About the Author



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