

Carolina Patent Copyright and Trademark Law Association, Inc.
Annual Fall Meeting

Top Ten First-to-File Patent Drafting Rules

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- The *Leahy Smith America Invents Act* of 2011 has two pressure points to compel the earliest possible filing date:
- (1) A genuine first-to-file system has been introduced: An inventor's most carefully drafted patent application is for naught if a junior inventor is first-to-file.
- (2) The grace period is problematic: An inventor's presentation at a public conference that stimulates an audience member to publish on an ***obvious variant*** may create a statutory bar against the inventor.

- The challenge is to draft a quality patent application within the time constraints of a true first-to-file system coupled with the potential loss of all patent rights with a premature prior art disclosure.
- Which is needed:
 - A promptly drafted application?
 - A quality application that meets the high standards for examination?
- The answer: ***Both!***

(A) The Inventor's Pre-Filing Instructions

Rule (1), Known Prior Art

Rule (2), Precise Drafting Goals

Rule (3) – Laboratory Notebook Records

Rule (1) Known Prior Art

- The “starting off” point – the departure from the prior art – should be identified, to provide the closest prior art *known to the inventor*.
- Providing the patent searcher with this “starting off” point permits the searcher to cull out all prior art in his search *except* for prior art more (or as) pertinent as the “starting off” point.

Rule (1) Known Prior Art

- Denying the patent searcher the “starting off” point will lead to the searcher pulling many patents to show the state of the art, which he would not do if he had known the “starting off” point.

Rule (1) Known Prior Art

- Denying the “starting off” point makes the patent searcher conduct a “willfully blind” search, where he may go off in the wrong direction altogether.

Rule (2) Precise Drafting Goals

- It is imperative that there is a clear understanding with the patent draftsman as to the *precise* goals for the patent filing – and that the goals be committed to writing.
- It is important to specify **which** objective is the goal of the patent process, as there are diametrically different ways to achieve the differing goals:

Rule (2) Precise Drafting Goals

- For example, if the goal is *offensive*, then the focus is upon the claims, to make sure that there is a solid claim position to dominate any person attempting to practice the claimed invention.
- But, if the goal is *defensive*, then the important point is to have a detailed “cook book” example setting forth each feature of the commercial embodiment, so that any third party junior application cannot gain a claim to dominate the commercial embodiment.

Rule (2) Precise Drafting Goals

- A very broad claim that may at first blush appear to provide broader coverage will not necessarily, by itself, provide any defensive protection because a junior applicant claiming a species may be able to argue that the broad senior claim does not anticipate the species; even if basis for prima facie obviousness, a species inventor may be able to establish unexpected properties and gain a patent.

Rule (2) Precise Drafting Goals

- Clear instructions should be provided as to (a) identity of the proposed commercial embodiment; and (b) specific instructions as to whether the protection to be sought is –
- **Rule (2a) Narrow, offensive** – to block third parties from copying the exact commercial embodiment;
- **Rule (2b) Broad, offensive** – to block third parties from copying the exact commercial embodiment and a range of equivalents beyond that embodiment; (con'd)

Rule (2) Precise Drafting Goals

- Rule (2c) Narrow, defensive – to safeguard the inventor's commercial embodiment from an infringement attack by a third party;
- Rule (2d) Broad, defensive – to safeguard the inventor's commercial embodiment from an infringement attack by a third party ***and also potential future embodiments with some differentiation from the current embodiment;*** or
- Rule (2e) A combination of two or more of the above objectives.

Rule (3) Lab Notebook Records

- In parallel with whatever laboratory notebook records are contemporaneously kept by the inventor, experiments should be drafted in Word as a “cook book” example that can be directly plugged into an application.
- The Word example can then be simply plugged into the specification, without the need for proof reading or delays in obtaining details from the inventor.

(B) Drafting Goals

Rule (4a) Broad, offensive protection

Rule (4b) Narrow offensive and defensive protection

Rule (4c) Broad defensive protection

Rule (4a) Broad, offensive protection

- Drafting the generic definition for a ***broad, offensive*** business goal requires careful prophecy as to the scope of enablement (based on the “cook book” example) coupled with the scope of generic patentability (based on the “starting off” point and the search).

Rule (4a) Broad, offensive protection

- In addition to the broadest definition of the invention for “claim 1”, care must be taken in the event the scope of enablement does not extend to the full scope of the claim *and/or* prior art may emerge which destroys patentability of embodiments at the outer periphery of “claim 1”.

Rule (4a) Broad, offensive protection

- As backup protection, definitions of decreasing scope should be included in the original application, so that there is “written description” basis for narrowed generic scope definitions that may be necessary if “claim 1” turns out to be invalid.

Rule (4a) Broad, offensive protection

- To add a subgeneric definition *unsupported in the original disclosure* is to invite a denial of patentability under 35 USC § 112(a), *or*, if a continuation is filed with the new definition, priority may be denied to the parent, exposing the claim in the continuation to a statutory bar based upon intervening activity.

Rule (4b) Narrow offensive *and* defensive protection

- The first critical integer is the “cook book” example that is all that is needed for narrow defensive protection.
- For *narrow offensive* protection it is critical to draft a claim that only focuses upon the point of novelty (as opposed to a claim that defines each and every feature of the invention, such that a third party who modifies any one of the elements may escape infringement under the “all elements” rule).

Rule (4c) Broad defensive protection

- If *broad defensive* protection is desired, consider setting forth several alternate, specific examples to complement the “cook book” example.
- The idea is to have a grid of *specific* working examples so that a junior inventor will be unable to obtain generic coverage.

Rule (5) Summary of the Invention

Rule (5a) “Summary of the Invention”, what it **SHOULD** include

Rule (5b) “Summary of the Invention” – what it **SHOULD NOT** include

Rule (5a) “Summary of the Invention”, what it **SHOULD** include

The *Summary of the Invention* should provide a *verbatim* recitation of each element within the claims, and include a specific *definition* of any such element (or combination of elements) at the point of novelty, to cabin an otherwise “broadest reasonable interpretation” of such element (or combination of elements).

Rule (5a) “Summary of the Invention”, what it **SHOULD** include

Where the specification discloses only one embodiment for a particular element, consideration should be given to naming *alternate* embodiments as part of the *Summary of the Invention*.

For chemical or biochemical inventions, the *Summary of the Invention* may include a specific usefulness for *all* of the products in the generic definition.

Rule (5a) “Summary of the Invention”, what it **SHOULD NOT** include

The specification should **NOT** follow Rule 73; this rule says that the *Summary* should “indicat[e] [the] *nature and substance* [of the invention]” and “may include a statement of the *object of the invention*”.

The *Summary* should not recite “an[] object.”

Rule (5a) “Summary of the Invention”, what it **SHOULD NOT** include

“Nature” , “substance” and “object” of the invention should NOT be recited.

Each is a nonstatutory feature that only serves to obfuscate the invention and take additional time to draft:

None of these features belongs in a patent application.

Rule (6) “Background of the Invention”

- ***A Background of the Invention* has no place in a first filing.**
- Neither the *Field of the Invention* nor the *Description of the Related Art* should be in the first filing; the former should ***never*** be in any filing while the latter should comprise a ***citation list*** that is part of an Information Disclosure Statement (IDS).

Rule (7) A Parallel Definition in the *Abstract of the Disclosure*

The *Abstract* should mirror the definition of the elements that are ***identically stated*** in the claims and the *Summary of the Invention*.

A creative *Abstract* with a different meaning is basis for a narrowed construction of the claimed invention. *See Hill-Rom Co. v. Kinetic Concepts, Inc.*, 209 F.3d 1337, 1341 n.* (Fed. Cir. 2000)(Bryson, J.); *Tate Access Floors, Inc. v. Maxcess Technologies, Inc.*, 222 F.3d 958, 965 n.2 (Fed. Cir. 2000).

Rule (8a) Prior Art Should be Cited in an IDS

Prior art citation should be delayed as much as possible, consistent with providing the information in a timely fashion for consideration by the Examiner.

If the first filing is a provisional, replaced 12 months later with a regular application, this gives the applicant a net 15 months from the priority date to file prior art within the guidelines of the Patent Office.

Rule (8a) Prior Art Should be Cited in an IDS

Prior art citation can be delayed even beyond the 15 month period and cited just before the Examiner's first action.

(If the Examiner's first action occurs before prior art citation, the applicant has a right to file an RCE and in that case cite the prior art without further penalty.)

Rule (8b) Prior Art Generally Should **NOT** be part of a First Filing:

Prior art should generally *not* be cited in a first filing which occurs at a time when the state of the art is unclear and where citation at the time of filing would slow down the drafting process.

Rule (9) Foreign Filings at the End of the Year

For the more important inventions which are planned for parallel overseas filing at the 12 month anniversary of the first U.S. filing, by about 10 months from the priority date serious in house collection of prior art should be made coupled with a prior art search.

Rule (9) Foreign Filings at the End of the Year

If the invention passes search muster, consideration should be given to consolidation of domestic and foreign patent rights into a single Patent Cooperation Treaty application with common claims and disclosure.

The caveat, of course, is that the claims of the PCT application should be either identical to or supported by the first filing.

Rule (10) Secondary Filings within 18 Months of the Priority Date

Assuming that the invention has been maintained in secrecy during the first 18 months from the priority date, consideration should be given to filing a new application *without priority* for various aspects of the first invention, and to make such filing *just before the automatic 18 month publication*.

Rule (10) Secondary Filings within 18 Months of the Priority Date

The secondary filing can serve as Paris Convention priority for Asian and European applications filed within 30 months from the first filing. Given that the secondary filings have a priority date *prior to publication* any novel advances in the secondary filings should also be patentable, assuming the basic invention in the first filing is patentable.

Special Uses of the Provisional Application: Complexities in Patent Drafting

- Particularly for broad, offensive protection, there may be several weeks of preparation time needed to create representative working examples or time may be needed to craft claims of generic and subgeneric scope, *while all this time* there is sufficient information to obtain narrow protection based upon, for example, the “cook book” disclosure of the preferred embodiment.

Special Uses of the Provisional Application: Complexities in Patent Drafting

- Here, it is *not* necessary to put all eggs in the one basket of the broad, offensive application. Instead, an immediate provisional application may be filed that will surely create basis for narrow offensive and defensive protection.

Special Uses of the Provisional Application: Complexities in Patent Drafting

- This provisional will then be followed by a “regular” application with all the offensive disclosure and claims *and the text of the provisional*:

Special Uses of the Provisional Application: Complexities in Patent Drafting

- In the event there is intervening prior art between the provisional and regular applications, the provisional will provide *narrow* offensive and defensive rights, and may well be basis for a cross-license with the applicant who has filed in the interval between the provisional and regular applications.

Special Uses of the Provisional Application: Deferred Prior Art Citations

- It is sometimes more convenient to defer the citation of prior art for up to fifteen months from first filing (vs. filing such prior art within three months of the first filing).

Special Uses of the Provisional Application: Deferred Prior Art Citations

- This is particularly the situation for the most important applications that will undergo parallel foreign filing, where a greater understanding of the prior art will be attained as a condition precedent to the decision for expensive global patent protection.

Special Uses of the Provisional Application: Deferred Prior Art Citations

- If a provisional is filed, first, and replaced by a regular application at 12 months later, then the earliest deadline for filing an Information Disclosure Statement is 15 months from the effective filing date. (There is no requirement for filing an IDS in a provisional application.)

Special Uses of the Provisional Application: Coordinated Global Filings

- It is helpful to have the same patent application text for *all* filings around the world. A standard today is to have such a filing as a Patent Cooperation Treaty application.
- Whether the U.S. application should be a part of the PCT filing or a separate filing, it is helpful in either case that the U.S. and PCT texts are essentially the same.

Special Uses of the Provisional Application

Coordinated Global Filings:

- Here, it is best to file the first U.S. application as a provisional, and then at the one year anniversary fold the U.S. case into the PCT application filed at that time, *or* to file a “regular” (non-provisional) with the same text.

Special Uses of the Provisional Application: Identical Priority Standards for All Situations

- Priority based upon a provisional application is *identical* to the requirements for priority based upon a regular application. *New Railhead Mfg. L.L.C. v. Vermeer Mfg. Co.*, 298 F.3d 1290 (Fed. Cir. 2002).

Special Uses of the Provisional Application: Identical Priority Standards for All Situations

- It is more convenient to rely upon a provisional (vs. a regular application) because of fewer formalities and the right to defer citation of prior art (which cannot be cited in a provisional application, unless part of the original specification).

Special Uses of the Provisional Application: Deferred Year of Patent Protection

- In the regulated chemical and biotechnology fields, a patent is unnecessary at the very beginning when a product is still undergoing its regulatory approval process. Yet, the final year of patent protection may be worth, literally, many millions of dollars for an important commercialized product.

Special Uses of the Provisional Application: Deferred Year of Patent Protection

- *Here*, it should be the standard practice to *defer* the patent term by filing a provisional application and then replacing that provisional application with the twenty year term of a regular filing: The pendency period of the provisional is not counted in the patent term.

Post-Filing Reviews: The Current Business Importance of the Application

- The business purpose behind an application may very well change, sometimes dramatically, over the course of prosecution:
- Do the present claims cover recently introduced commercial embodiments (both by the applicant and by competitors)?
- Can the claims be modified to cover such commercial embodiments?
- Is a new application required for such coverage?
- Are both amendments to the current claims and a new application the better approach?

Post-Filing Reviews: The Current Business Importance of the Application

- Has the original goal of broad offensive coverage been downgraded to a need for only *specific* offensive coverage for the commercial embodiment?
- Should a voluntary amendment be made to pare down the claims to those *necessary* for such protection?

Post-Filing Reviews: The Current Business Importance of the Application

- Has an original goal for offensive coverage been downgraded to a purely defensive protection goal?
- Should the applicant compromise with the Examiner for *any* claims at all that are suggested by the Examiner?
- If the application has already been published, should the application be expressly abandoned or permitted to become abandoned following a first action?

Why Patent, if the Business Goal is Purely Defensive?

- For purely *defensive purposes*, why not simply *publish* the invention (instead of filing a patent application)?
- The case *in favor of* publication is that immediately upon publication there is a global patent-defeating effect created as of this publication date.

Why Patent, if the Business Goal is Purely Defensive?

- The case *for filing* without immediate publication is that for eighteen months the inventor is able to maintain secrecy of the invention that will permit the inventor the ability to file *additional* patent applications on trivial (or major) improvements in this period free from competition (unless third parties somehow learn of the basic invention).

Why Patent, if the Business Goal is Purely Defensive?

- The case *for filing* a defensive application is that the applicant can change its position and maintain the application for offensive rights.
- The case *against filing* is what could be the enormous cost of global filing. To obtain a global patent defeating effect as of the filing date will require expensive foreign parallel applications.

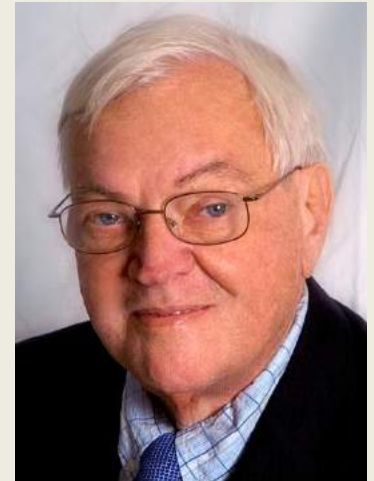
Thank you for your attention!

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About the Presenter

HAROLD C. WEGNER is President of The Naples Roundtable, Inc., a 501(c)3 nonprofit corporation; its mission is to “explor[e] ways to strengthen and improve the patent system”.
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Professor Wegner concluded a more than twenty year relationship with the George Washington University Law School where he had been Director of the Intellectual Property Law Program and Professor of Law and a member of the Dean’s Intellectual Property Advisory Board.