

FIRST TO FILE PATENT DRAFTING

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TEN STEPS TO REACH THE GOALS OF THIS MONOGRAPH

- (1) Few Claims
- (2) Argument Focused on “Claim 1”
- (3) Elimination of Alternate Issues
- (4) Combination Claims to Establish Patentability
- (5) A Concise *Summary*
- (6) *Detailed Description*
- (7) No *Background*
- (8) Neutral Statement of the Invention
- (9) An Information Disclosure Statement
- (10) Minimalist Citation of Prior Art

This monograph is focused upon a patent application drafted with a *simple presentation* of issues so that they can be readily understood at every level, whether the consideration is by an Assistant Examiner, a Supervisory Primary Examiner, the Patent Trial and Appeal Board or the Federal Circuit.

Given the anti-patentee hostility of the Administration of the Hon. Michelle K. Lee, and given the general view in the Office to deny patentability in close cases, the default for an Examiner is to *reject* the claims. At every level, presentation of a clean and easy to understand case is imperative for full and fair consideration.

The starting point is the examiner level: Each examiner has at most several hours for the first action, which includes a study of the claims, a prior art search and then a complete Office Action. If the applicant presents, say, sixty claims with complex “means”-defined elements and cites, say, forty prior art references, there is little likelihood that the examination can be conducted within the allotted time frame: Surely, the claims will be simply rejected, perhaps with a prior art rejection which is a mosaic combination of several references, with a formal rejection or two thrown in for good measure.

If an overly complex presentation will not pass muster with the Patent Examiner, there is, *a fortiori*, essentially no chance that a Supervisory Primary Examiner will intervene to overturn the Examiner in an interview or otherwise, given the fact that the issues are too complex for a quick review.

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Finally, at the level of the Patent Trial and Appeal Board, given that the record is quite complex, the PTAB is more likely to affirm the Examiner, secure in the knowledge that the record is so complex that if there *were* to be an appeal to the Federal Circuit a decision denying patentability would be affirmed.

There are ten steps the applicant should take:

(1) Few Claims: A tightly focused set of claims should be presented, say, five or six, and not fifty or sixty claims. *See* § 11[a][8], *Minimum Number of Prior Art Citations*.

If several “inventions” are recited, then additional claims may be included, but should be presented in a fashion to permit an easy restriction requirement to be made so that these additional claims are withdrawn from consideration. No argument should be included in the application critical of the prior art. *See* § 10[b][2], *Citation distinguished from Characterization*.

(2) Argument Focused on “Claim 1”: If there are, say, one independent claim and eleven dependent claims and the only key issue is patent-eligibility of claim 1, consideration should be given to *limitation* of the issues to “claim 1”.

For example, a Preliminary Amendment could include the following statement: “For purposes of the ex parte prosecution of this application, *only*, the applicant relies solely on the patentability of claim 1.”

By making a concession of this type, then the Examiner need only focus his or her attention on claim 1, greatly simplifying the search and examination by eliminating the need to examine claims 2-12 for patentability.

(3) Elimination of Alternate Issues: For a close case on patentability, it is imperative that there is only the *one* issue present. Where there are several issues presented on appeal, the PTAB only needs to affirm on one of the issues and the case is lost. If there are claims with issues under 35 USC § 112, the issues should be clarified or, possibly, the case should proceed only on the claims without such other issues.

(4) Combination Claims to Establish Patentability: Where nonobviousness is a close issue, consider the possibility of a *combination* claim where the case for patentability is stronger than for an element or subcombination. For example, an invention may comprise elements (A+B+C+D+E) and be defined either as the complete combination (A+B+C+D+E) or one of several subcombination levels, e.g., (B+C+D+E) and (A+B).

Here, it may be worthwhile to present three sets of claims to the combination and the two subcombinations for purposes of a restriction requirement, and then to elect the claims to the complete combination (A+B+C+D+E) as the basis to establish patentability and obtain a first patent. Then, claims to the nonelected subcombinations could be the subject of divisional applications.

(5) A Concise Summary: A specification may be, say, 200 pages long, but this is all right for simple examination if there is, say, a two page *Summary of the Invention*. Everything the examiner needs to know in the specification for his examination should be comprised in a tightly worded *Summary of the Invention* which includes a recitation of each of the features of the claim coupled with *definitions* of terms, particularly at the point of novelty.

(6) Detailed Description: The application should be segregated between the very brief *Summary of the Invention* which the Examiner *should* study, versus the lengthy main portion with examples and other exemplifications of the invention found in a *Detailed Description of the Invention*. This latter, possibly very lengthy section is included but is unnecessary for the examiner's consideration, given the separate *Summary of the Invention* which contains all the information needed for examination.

(7) No Background: There is no statutory basis for a *Background of the Invention* section which traditionally includes a discussion of the prior art. This section should be entirely *omitted* for the typical case.

(8) Neutral Statement of the Invention: The specification should provide a "neutral" representation of the invention *without* citation of prior art, *without* argumentation over the prior art and *without* a *Background of the Invention*. See § 11[a][9], *Neutral, Non-Argumentative Specification*.

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(9) An Information Disclosure Statement : The IDS is filed consisting of a *list* of the several, say, three or four, most pertinent prior art references (as opposed to thirty or forty references). If the patent searcher starts his task, given the best prior art known to the applicant, his search will cull out all the prior art that is less relevant, leaving a much smaller pool of prior art to consider. This is distinguished from conducting a “blind” prior art search without benefit of the applicant’s knowledge of the state of the art. *See* § 10[a][3], *Avoiding a “Willfully Blind” Search* (citing *Global-Tech Appliances, Inc. v. SEB S.A.*, 131 S. Ct. 2060 (2011)).

(10) Minimalist Citation of Prior Art: The applicant who dumps forty references into the Patent Office via an Information Disclosure Statement is implicitly saying, “I don’t have to find the most pertinent reference. That’s your job, Mr. Examiner.” Furthermore, there is an implicit thought on the part of some Examiners that where, say, forty references are cited, the applicant is hiding the best of the forty in such a bulk citation of references. In either case, the inference is negative and a surefire way to make sure that the first Office Action is a rejection of claims.

It would be expected since the Examiner will have the best prior art available through his search and with the minimal number of claims, a carefully thought out merits examination can be made as to the prior art, resulting in a minimal number of references being cited, *and* a careful exposition of real and apparent formal defects under 35 USC §112.

Any prior art rejection will likely be the best case scenario for a rejection, but with a minimal number of references cited, permitting a direct exchange on the issues.

As to the real or apparent defects uncovered by the Examiner on formal issues under 35 USC §112, the *real* defects can be dealt with through amendment while the *apparent* defects can be explained as apparent but not real, thereby strengthening the prosecution history.