



Patent Resources Group

Workshop: How to Craft, Draft, and Prosecute Patents That Win at the Federal Circuit Course Syllabus

- I. **Preparation for Writing and Prosecuting the Application**
 - A. Thoroughly Understand the Invention Before Conducting the Pre-Filing Search
 1. Confer With the Inventor and Other Technically-Cognizant Person(s) Before Conducting the Search
 2. What Were the Problems, Market Conditions and/or Other Circumstances That Motivated the Making of the Invention?
 3. Identify Prior Art Known to the Inventor(s) and the Other Conferees
 4. Identify Embodiments and Alternatives in Addition to Those in the Invention Disclosure
 5. Consider Possible Novelty of All Subcombinations and Components
 - B. A Thorough Pre-Filing Search Is the *Sine Qua Non* of LP-CD Practice
 1. The Search Must Uncover Prior Art at Least as Relevant as the Examiner Will Find
 2. Two Good Searches Are Better Than One
 3. Ancillary Positive Effects of the Optimum Search
 4. Ancillary Negative Effect of the Optimum Search (the Expense)
 5. Advantages of Having a Search Conducted by the Practitioner Who Will Prepare and Prosecute the Application
 6. Where the Practitioner Cannot Conduct the Search, All Communications With the Searcher Should Be Oral
 7. Analyze the Prior Art With the Inventor and Other Technically-Cognizant Persons
 8. Conduct a Follow-up Search if Analysis of the Prior Art With the Inventor Results in a Refined Appreciation of the Patentable Features of the Invention



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II. The Claims

- A. Organizing, Structuring and Drafting a Claim Set
 - 1. The Broadest Patentable Claims Must Be Submitted in the Application as Originally Filed to Avoid Having Claims Held Invalid for Want of §112, ¶1 Written Description Support
 - 2. The Original Claims Should Cover All Subject Matter Disclosed in the Specification to Guard Against Dedicating Disclosed But Unclaimed Subject Matter to the Public
 - 3. Narrow Claims Must Also Be Submitted in the Application as Originally Filed to Guard Against Further Validity Challenges Under §112, ¶1, for Failure of the Original Disclosure to Indicate That the Narrow Limitations are Part of the Invention
 - 4. Narrow Claims Preserve the Potential Benefit of the Doctrine of Claim Differentiation
 - 5. Inclusion of Both Combination and Subcombination Claims Maximize the Value of the Patent
 - 6. Numerous Claims of Narrowly Varying Scope Increase the Likelihood of Literal Infringement
 - 7. Claims in Different Statutory Classes Expand the Patentee's Scope of Protection
- B. LP-CD Preambles
 - 1. Preambles Should Be Terse
 - 2. Preambles in Claims to Biological Materials
- C. Transitional Phrases in LP-CD Practice
 - 1. Use Only the Transitional Term "Comprising" for Claims or Claim Elements Intended to Be Open-Ended
 - 2. Effective Use of "Consisting of" and "Consisting Essentially of" Transitional Terminology
 - 3. Consider Using Negative Limitations Instead of Closed or Partially-Closed Transitions



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- D. The Body of the Claim
 - 1. Fundamental Axiom: Only Those Elements and Limitations Intended to Restrict the Scope of the Claim Should Be Included in the Claim
 - 2. Consistency in Claim Recitations – Never Use Synonyms or Inconsistent Terminology
 - 3. The Body of the Claim Is a List of Interrelated Elements, But Not Necessarily All Directly Related to Each Other
 - 4. Advantages and Disadvantages of Reciting Claim Elements in Means-Plus-Function Format
 - 5. Effective Use of Functional Recitations in Apparatus, Product, and Composition Claims
 - 6. Creative Use of Process Recitations in Apparatus, Product, and Composition Claims
 - 7. Proper Recitation of Values and Ranges
 - E. Claim Drafting Checklist
- III. The Specification (The Written Description) and Drawings**
- A. Three LP-CD Objectives in Preparing the Specification
 - B. Satisfying the Three Requirements of 35 USC §112, ¶1
 - 1. Fulfilling the Written Description Requirement
 - 2. Fulfilling the Enablement Requirement
 - 3. Satisfying the Best Mode Requirement
 - 4. Effective Use of Incorporation by Reference
 - 5. How Optimally to Write the Abstract of the Disclosure
 - C. Make No Mention of Advantages, Objects, Background or Summary of the Invention; Avoid Discussion of the Prior Art; Do Not Use the Word "Invention" Except in "Embodiment of the Invention"
 - 1. The Federal Circuit Finds Broad Claims Invalid for Want of §112, ¶1 Written Description Support Based on Statements of Advantages, Objects, Background, and Summaries of the Invention in the Specification



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2. The Federal Circuit Interprets Broad Claims Narrowly and Finds Them Not Infringed Based on Statements of Advantages, Objects, Background, and Summaries of the Invention in the Specification
 3. References to "the Invention" in the Specification May Lead to Judgment of Noninfringement
 4. Neither the Patent Statute Nor the USPTO Regulations Require "Backgrounds," "Summaries," "Objects," or Discussions of "the Invention" in Specifications
- D. The Specification Should Describe Multiple Embodiments, Multiple Alternatives for Each Element, and Multiple Features (Shapes and Locations) for Each Element
1. The Federal Circuit Finds Broad Claims Invalid for Want of §112, ¶1 Written Description Support Based on the Fact That the Specification Discloses Only One Embodiment
 2. The Federal Circuit Frequently Bases Findings of Noninfringement on the Fact That the Specification Discloses Only One Embodiment
- E. The Drawings
- F. Checklist of LP-CD Tenets for Preparing a Specification
- G. *In re Curtis* – a Case Illustrative of the Dangers of Not Following LP-CD Practice
- IV. Prosecuting the Application**
- A. Maximizing Patent Term: Responding to OIPE Notices and Dealing With/Avoiding Restriction Requirements
 1. Complying With OIPE Requirements
 2. Dealing With Restriction Requirements
 - B. Responding to Rejections Under 35 USC §101 for Lack of Utility
 - C. Responding to Lack of Novelty or Anticipation Rejections Pursuant to 35 USC §102



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1. Reference Missing a Claim Limitation or Element
2. Reference Is Not Enabling
- D. Prosecution Responsive to a §103 Obviousness Rejection
 1. Non-LP-CD Attack of a Defective *Prima Facie* Obviousness Rejection (Akin to Rebuttal)
- E. Techniques to Overcome an Obviousness Rejection Without Discussing the Invention
 1. For a Defective *Prima Facie* Obviousness Rejection
 2. For a Proper *Prima Facie* Obviousness Rejection
- F. LP-CD Technique for Obviousness-Type (Judicial) Double Patenting Rejections
- G. LP-CD Responses to Rejections Under 35 USC §112, ¶¶1 and 2
 1. Written Description Requirement
 2. Enablement Requirement
 3. Indefiniteness Rejections
- H. Avoiding Foreign Filing and Prosecution Barriers to Effective LP-CD in U.S. Practice
- V. Summary of LP-CD Practice for Drafting and Prosecuting Winning Patents**
 - A. Chronology of LP-CD Practice Techniques for Every Winning Patent
 - B. Checklist for Crafting and Drafting Winning Patents
 - C. Modified LP-CD Practice