

# Building a Patent: Drafting & What Can Happen Afterward

Daniel L. Flamm

*Microtechnology Law & Analysis*

*Walnut Creek, CA 94596-5459*

*email: dlf@mtag.com*

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# What Patents Can Protect

- Virtually any item, compound, or process made by man “...any new and useful process, machine, manufacture, or composition of matter...”  
35 U.S.C. § 101

- But NOT:
  - law of nature or principle
  - mathematical formulae/algorithms (e.g.,  $E = MC^2$ )
  - inoperable device (e.g., perpetual motion)
  - An obvious improvement- but what is obvious?
  - Business method? Program instructions? Tax avoidance scheme?

# Components of a U.S. Utility Application

- Title, abstract, declaratory documents
- **Specification**
  - Background
  - Summary (of Invention)
  - Detailed description and drawings
- **Claims**

## Inventors (sidebar)

- **An individual whose ideas are not claimed is not an inventor (even if those ideas are disclosed in the specification)**
  - **Can be used offensively!**
- **Inventors have independent equal rights to use a patent.**

## Examination- Mainly The Claims, but ...

- **Type of Subject Matter Claimed (Restriction)**
  - inventions (claims) independent or distinct and a serious burden on examiner if the restriction not required.
- **Specification and Drawings (*support*)**
  - 35 USC § 112(1) ..Clear concise *written description* of manner and process of making and using, to *enable* any person skilled in the art ... to make and use.. and best mode...
  - New and/or amended claims .. must be supported by the written description & drawings .. MPEP 2163 (1)

# Claims

- Define the metes and bounds of the invention
- Examiners focus on the Claims; allow or reject.
- **Obviousness** is much harder to refute now (KSR)
- Claims strategy and types (**machine, processs...**), (**who can be sued**)?
- **Recent hot topic**- Whether a process is patentable (must it be tied to a machine or transform something? **Think: tax avoidance method**, business method, calculation in computer).

## Requirements for What is Claimed

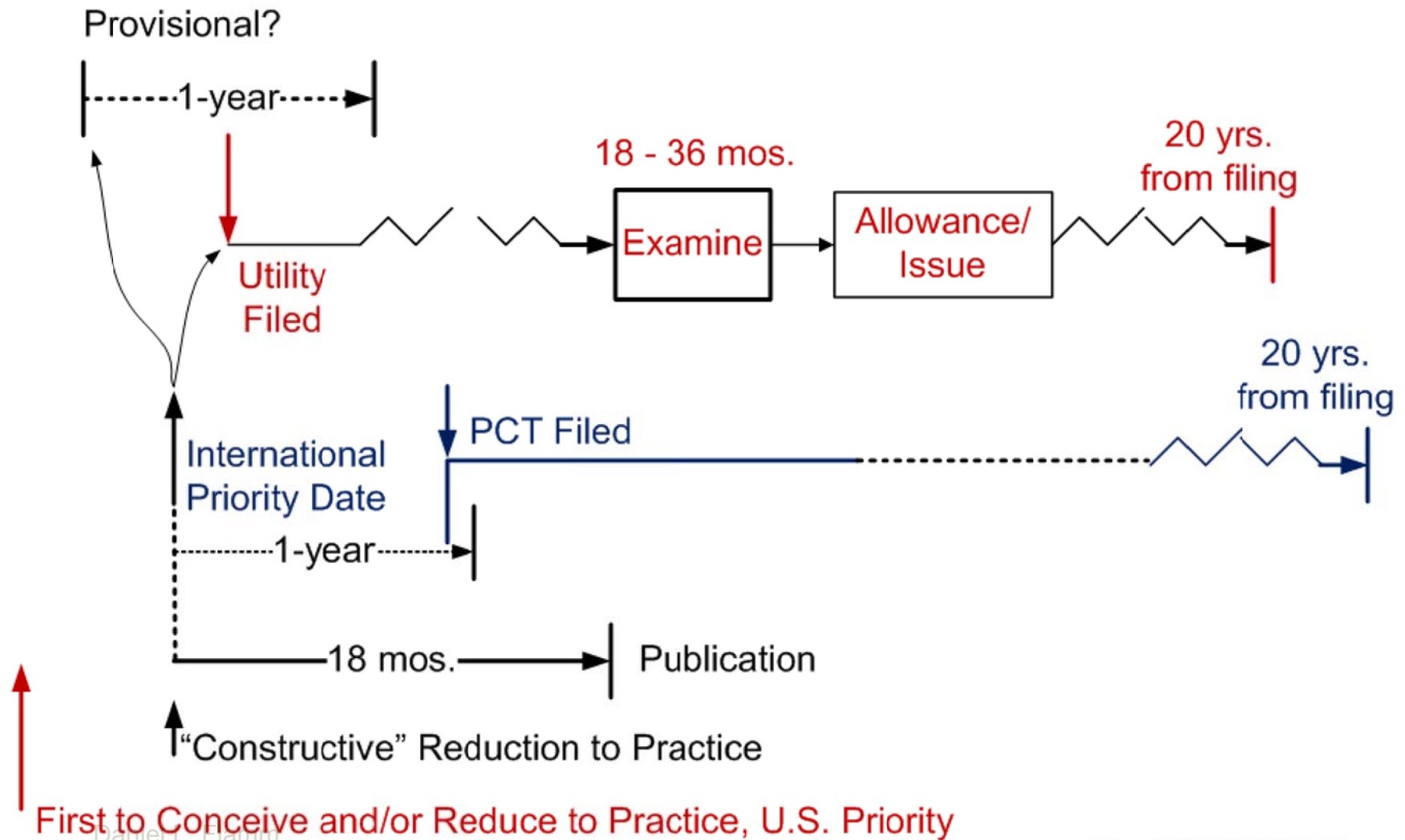
- New – 35 U.S.C. § 102
  - Useful – 35 U.S.C. § 101
  - Non-obvious – 35 U.S.C. § 103
  - Description fully discloses and enables a PHOSITA to practice the invention – 35 U.S.C. § 112
- No new matter after the application is filed.*

## Claims (II)

- Claim in a way that infringement will be apparent or at least easily testable.



# Patent Process (Simplified)



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Microtechnology Law & Analysis

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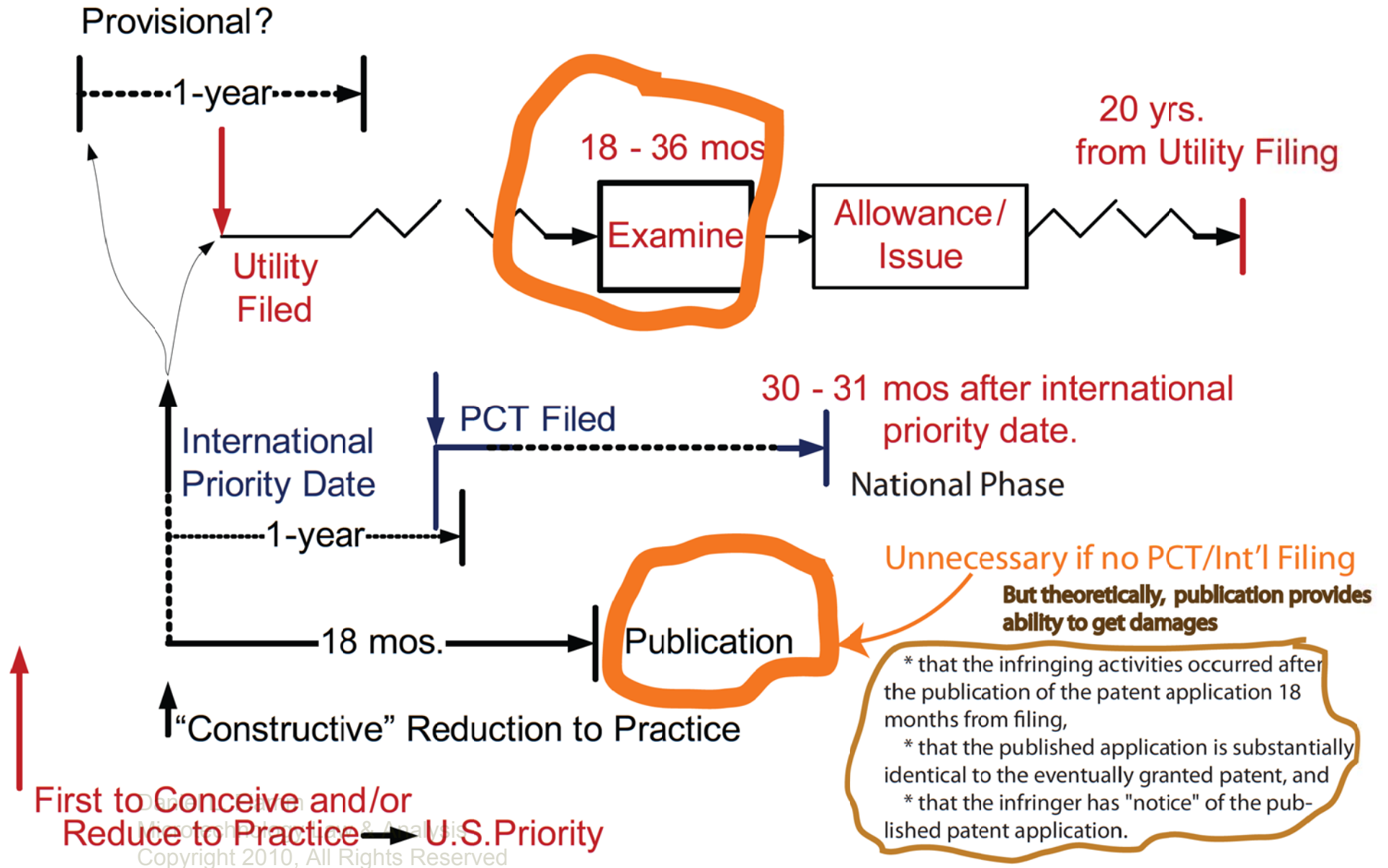


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## PCT (Patent Cooperation Treaty)

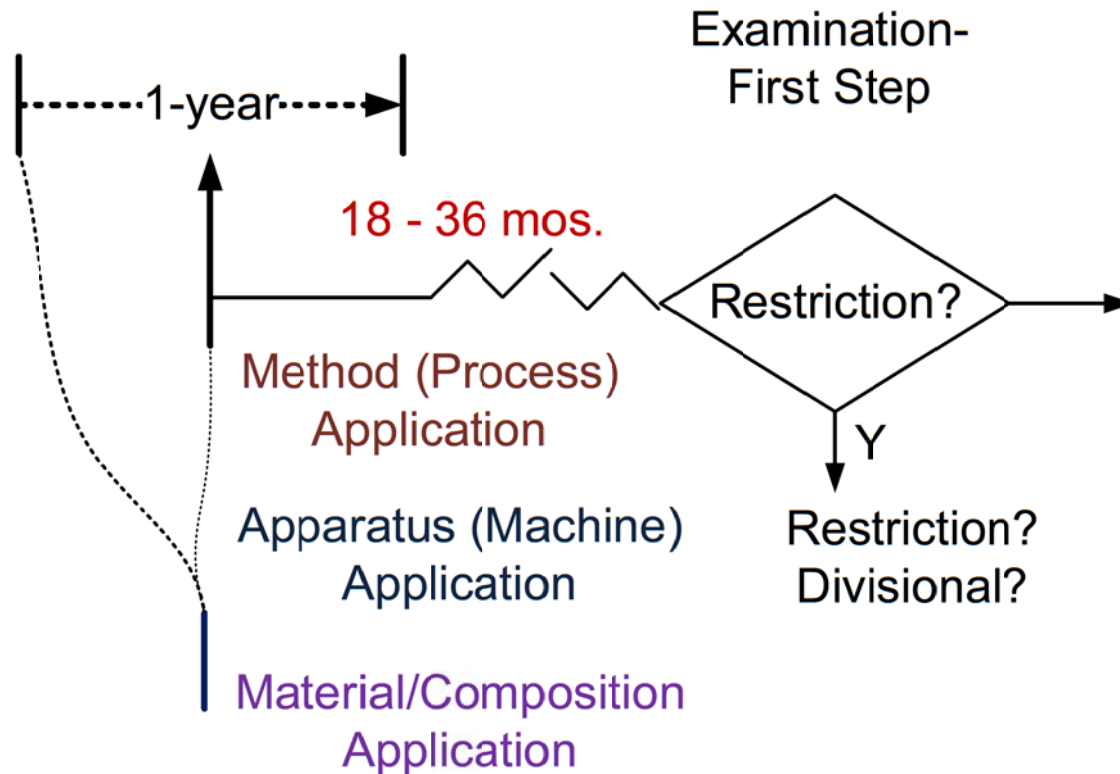
- **NOT** a patent application, but a right to file one
- Foreign applications are expensive, US is a bargain, small entity gets ½ price.
- PCT buys 30-31 mos. delay for \$4-5K
- Time to assess commercial value
- **National Phase** at 30-31 months, then use it or lose it.

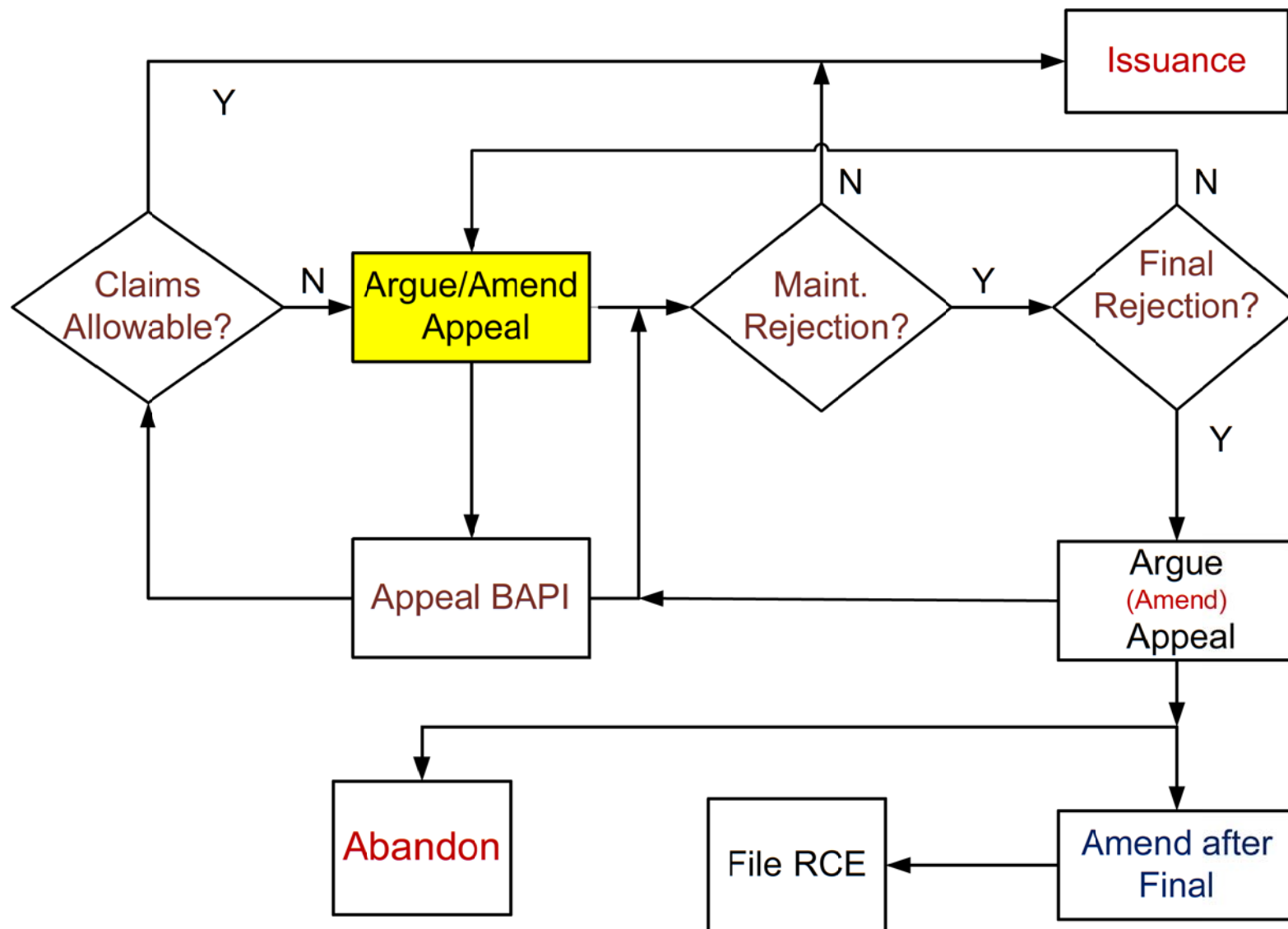
# Patenting Process (Simplified)



# Examination

- Restriction, strategy and its economic consequences
- Office Actions
  - Non-Final Rejections
    - 77% - 87% (Chemicals, Materials, Semiconductors)
  - Final Rejections
    - 27%-38%
  - Allowance
- Appeal
- Amendments- Focus on the claims





## What is Final Rejection

- Second or any subsequent actions on the merits shall be final,

except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims...

## Examination- It's The Claims, but ...

- What is claimed (type of subject matter)
- Specification (**support**)
  - 35 USC § 112(1) ..Clear concise *written description* of manner and process of making and using, to *enable* any person skilled in the art ... to make and use.. and best mode...
  - New and/or amended claims .. must be supported by the written description .. as filed MPEP 2163 (1)



## Specification

- What should be included
- Inadequate disclosure can result in an invalid patent
- **VERY Important:**
  - support for the claims,
  - for changing the claims (amendments),
  - and a reservoir that can support further claims.

## Empower the Specification for Prosecution

- **Specification** should provide broad, deep, accurate, quantitative and qualitative **technical support**.
- **Recite examples**, enumerate specific and/or broad fields of application, enumerate useful and specific numeric ranges and relative ranges, describe abstractions and alternative explanations of function(s), draw from first principles where applicable, but do not tie to any particular theory.
- Use figures that clearly show the essence of the invention(s). Best when understandable “standalone”.

# Provide a Foundation for Future Claims

## Divisionals, Continuations, Continuations in Part

- Describe and explain: Software, controls, usefulness in making other products; application in/with other machines, alternative chemistries, and/or variations using only a subset of the processes and/or steps.
- Describe parameters and their ranges based on relative values, absolute alternatives, and combinations and/or interrelationships with further things.
- Where plausible, extend into different machines, processes and/or transformations. Combine with networking, transactions, software and automation technologies but beware of prior art in other fields.

# Conclusions

- Claims define what is protected, the specification and figures are to support what is claimed.
- Consider timing, patent strategy, and think ahead -  
“It’s all in the timing” –D. Trump
- Rejections are the rule, so plan for them- build in broad, deep, and detailed technical support.
- An attorney with deep technical/scientific understanding and experience can build-in a solid support to amplify the IP.