

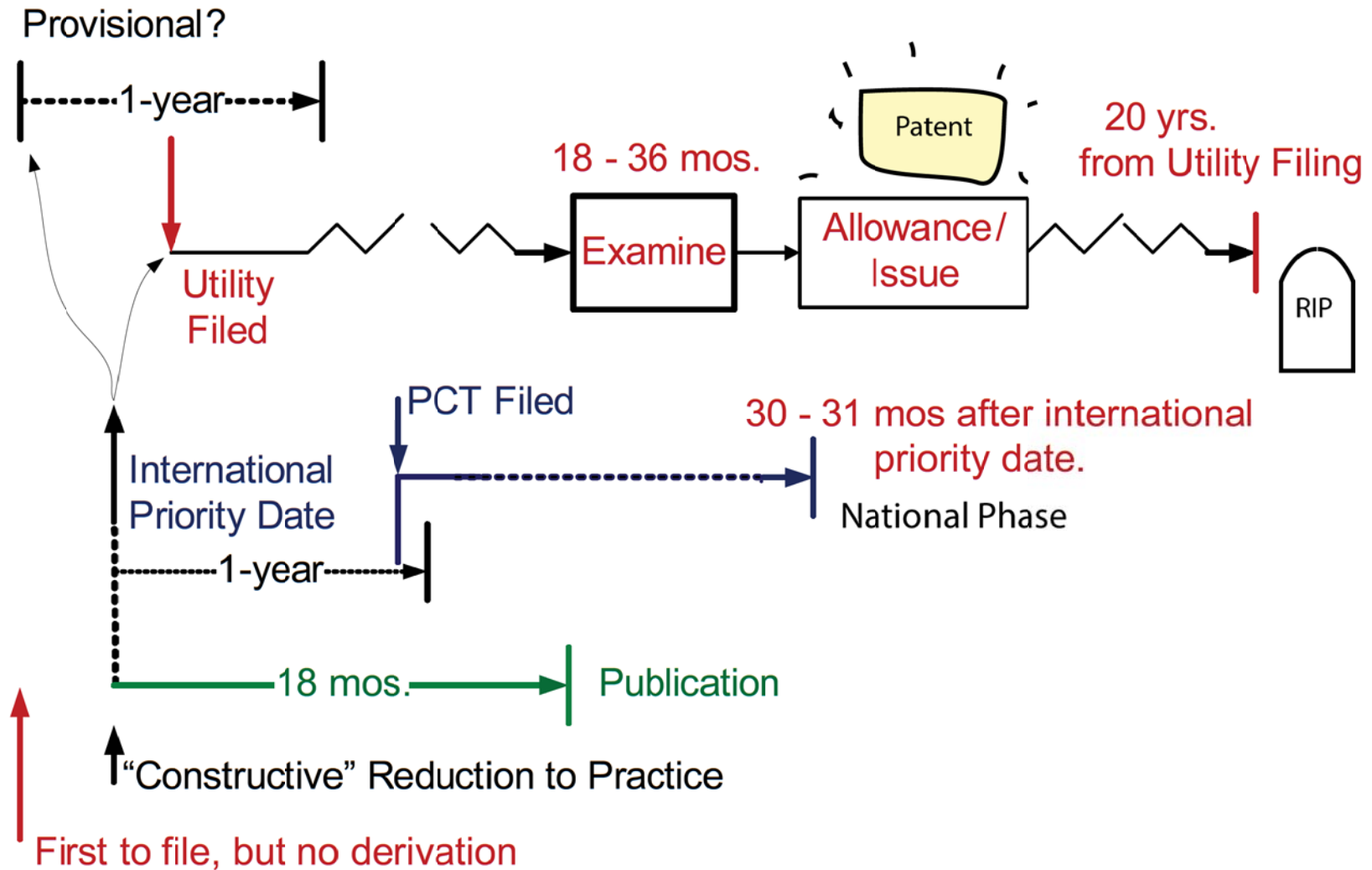
Nuts and Bolts of Getting a Patent

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Patent Process Mechanics

- **Inventing**
 - (Disclosing)
 - Drafting
 - Review and Revise
- **Filing**
 - Battle rejections
 - Allowance
- **Continuing**
 - Issuing
- **Asserting and Defending**

Patenting Process (Simplified)



File a Provisional Patent Application

A Provisional Patent (First to file –FTF)

- Stake out priority for invention (as it stands)
- Can change your mind-
- Can stay secret, unless date is claimed in an issued patent
- Claims are not *required*, but ...
- An extra year to work & sort things out.
- Important Requirements:
 - Enablement
 - ~~Best mode~~
- Low initial cost

Provisional Application (First to File)

- **Arm the provisional** with a detailed description of the invention, many examples of actual & “prophetic” embodiments, & lists/explanation naming the specific embodiments.
 - **To defeat improvement patents by others** and have **ample support/flexibility for adding claims** not yet in mind.
- Include ample drawings with reference numerals and written explanations of what they are and how things shown work. (Patent quality formal drawings unnecessary).

File Provisional FTF's

- Do not allow extensive provisional preparation to unduly delay filing.
- Can file successive provisionals, each one adding further detail & embodiments.
- Include notes and details showing how to use & make things.
- Do stake out priority using a provisional application-
- Under new AIA, can publish for priority (FTP), but publication can have harmful side-effects (incl. loss of foreign priority).

File a Utility Application

Components of a U.S. Utility Application

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

Quietly Watch Competitors and ...

- Find your competitors' patent applications and include in an [Application Data Sheet \(ADS\)](#).
- Identify and disclose “killer” prior art if possible.
- Craft a sound technical explanation of the prior art relevance, telegraphing absence of anticipation and/or obviousness.
- A patent attorney having deep technical insight in the subject matter can merge technical with legal “explanation”, and insure the submission will be compliant and entered into the application record.

Prepare. Include Technical Breath, Details, Many Prophetic and Specific Explanations

- It is important to craft a good application at the start-
- Repair work and arguments later prosecution are costly
- It is rarely possible to salvage all things you could have had.....
- No new matter. Generally stuck with the original specification/drawings- cannot add or claim what is not there, and cannot take away meaning that is there (except typos).

Prepare for Obviousness Rejection

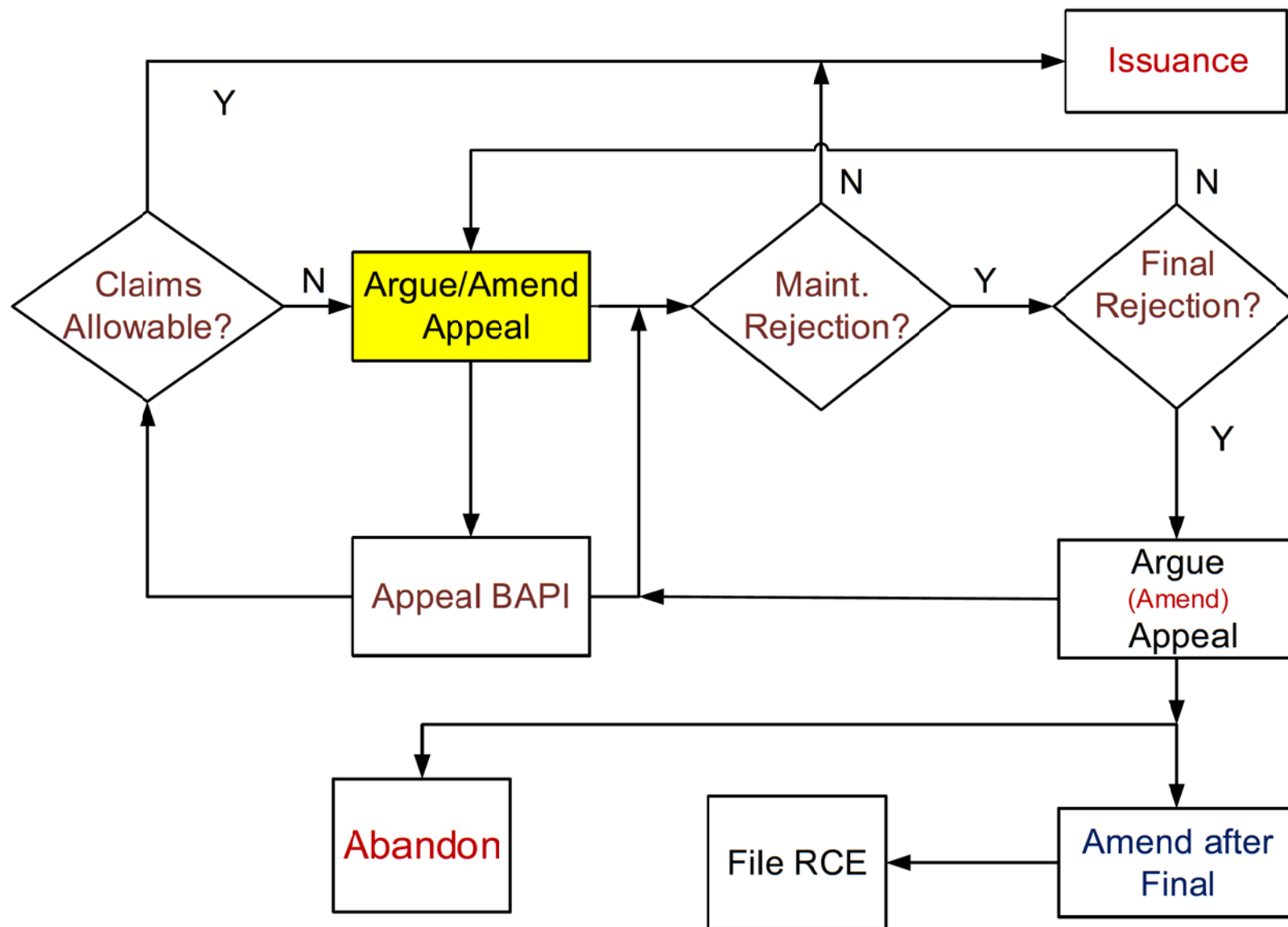
- After the 2007 KSR International Co. v Teleflex Inc. Supreme Court decision, obviousness rejections based on multiple references became ubiquitous.
- Example rejection: “Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Muisener, George and McGall as applied to claim 10-18, 20-22, 26, 28, and 30 above, and in further view of Sandhu et al.” “Muisener uses binders...”, “George states that ALD ...allows finer control”, “McGall discloses silanation”, “Sandhu discloses a method of ALD for depositing ... onto substrates”.
- Claims must be "given their broadest reasonable interpretation consistent with the specification."

NO NEW MATTER

- Cannot differentiate based on numerical ranges or values if they are not there, applications. Cannot limit/argue meaning of terms/language, scope of configurations, function of elements, and the like when not spelled out in the application.
- An Inventor can be his/her own lexicographer.
- Arm the written description with definitions that prevent language in the claims (and elsewhere) from covering prior art or more or less than intended.
- Include a reservoir of description and detail (support) that may be useful for arguing against rejections, making amendments to the claims, carrying priority to later continuations (e.g. another bite at the apple).

Claims

- It is the claims that define the invention
- Exact statements of precisely what the invention encompasses.
- Must be supported by the specification.
- Allowed or rejected.
- They can be amended or replaced during prosecution.
- Independent vs. dependent
- Method v. apparatus



Arguing Obviousness Rejections

- Does the reference really say what the examiner has written? Does a term have a different meaning in the reference? Is the reference prior art? Is the art from the same field of endeavor?
- Does combining the references make any sense? The rejection cannot be conclusory: the examiner must articulate reasons for rejection based on some rational underpinning. e.g. there must be a prima facie case.
- Has the examiner articulated a rational reason for combining references. Does the motive given make any sense technically to a person having ordinary skill in the art (PHOSITA)?

Obviousness Not Obvious

- Would the suggested combination change the principle of operation of the primary reference?
- Would combining make the make the primary reference inoperable for its intended purpose?
- Would a PHOSITA been able to combine the claimed elements by known methods?
- Is the reason for combining to achieve a feature of the claim rather than a basis found in the prior art?
- Does the prior art teach away from the combination?

