



Fast-Track Patent Protection for FiredUp Entrepreneurs™

Patent Application Review Tips

INTRODUCTION

If you're reading this, chances are you've created something new and valuable to share with the world, and are preparing to review a patent application intended to secure and enhance property rights in your innovation. To underscore the importance of this process, I note that some experts estimate that for technology companies, the cumulative value of intangible assets (patents, trademarks, copyrights, trade secrets, etc.) account for 75% or more of their total market valuations.)

These tips are based on 20 years (40,000 hours) of experience and continual learning in the art and legal science of patent making. I've had the privilege of learning not only from esteemed local and national patent attorneys in some of the top law firms and marquee corporations in the world, but also from studying hundreds of court decisions regarding patent cases, sharing countless stories with colleagues, and digesting thousands of patents.

The guidance I'm providing is organized into sections, the same way as your regular patent application. U.S. patent application generally includes the following sections: background, summary, brief description of drawings, detailed description, claims, and abstract. Below, I share some thoughts that should assist you in reviewing and adding value to these sections of the application. (Note that not all the sections are required, and provisional patent applications may not be organized in this way at all.)

BACKGROUND

The background of the application is intended to introduce a non-technical audience to the context of your invention by for example describing one or more technical problems that your invention solves or addresses. Imagine that the invention becomes massively successful and that there's a high-stakes courtroom battle over the patent rights with non-technical jurors, school teachers, construction workers, nurses, and barbers trying to make sense of the patent and its value. What can they glean from this section about the value of your invention. What will they learn from reading it.

In this section, it's particularly important to avoid not only characterizing something as "prior art" (i.e., as existing prior to your invention) when it's not, but also mischaracterizing the prior art. In general, "less is more" in this section; so, as a rule, I limit this section to a maximum length of two pages. In some instances (for example severe time or budget constraints) or for provisional patent application where it's not necessarily wise to commit to a position of what is prior art, it may be appropriate to omit this section entirely.

The key points are that this section should be accurate, without burdening the reader with undue technical depth, and without making admissions that are unnecessary in positioning the invention in a strategically significant way.

SUMMARY

The summary section, as its name suggests, summarizes your invention, or more precisely one or more embodiments (implementations) of your invention. Where time and budget permit, the section is targeted to a non-technical audience. It's particularly important in this section to avoid unduly narrowing statements regarding the scope of your invention. Many efforts to enforce patents have been thwarted or impaired by statements made in the summary section that were interpreted to limit the scope of the entire invention, even despite contrary language in the patent. Generally, it's best to keep this section to a page or less. In some instances, it may be appropriate to omit this section entirely.

BRIEF DESCRIPTION OF DRAWINGS

This section provides a listing of the figures in the drawings and a brief description of what each corresponding figure shows. If any of the figures are labeled as "prior art," your review should confirm whether or not this is the case. I generally don't include "prior art" figures, because they often can be used against us in ways never intended. A picture is worth a 1000 words, but in most cases you don't control what those words are.

DETAILED DESCRIPTION

The detailed description references the drawings by figure and part numbers. It also describes how to make and use your invention, including the best way of making and using the invention, in sufficient detail so that someone of ordinary skill in the pertinent art(s) can make use your invention without "undue experimentation." (Best is subjective, and thus based on what you believe, not on what others might believe.)

In this section, the target audience is one skilled in the art(s) of the invention. By definition you're an expert in your invention, so please be wary of assuming that others skilled in the art know as much as you. In reviewing you might ask yourself whether one of your junior colleagues (or a professional mechanic, engineer, computer programmer for example) could bring your invention to life based on his or her knowledge of the art and the description we've given. In addition to describing how to make and use the invention, it's also a good idea to describe alternative ways of implementing the invention. To this end, I may have made some efforts to extrapolate alternatives from your disclosure materials through interviewing you and/or embedding questions in the draft application; however, I'm certain that you can add some insights. In general, "more is more" in this section; however, we are bounded by time and money, and a law of diminishing returns is in effect.

CLAIMS

The claims are the numbered paragraphs at the end of the application. The claims define the metes and bounds of the invention, like a deed for real property. There are two basic types of claims: independent claims and dependent claims. Independent claims are "self-contained" legal definitions or expressions of an invention. Dependent claims must be read in conjunction with at least one other claim to be fully understood. Thus, by definition, an independent claim is broader than any dependent claim that depends on it. If you're familiar with Venn diagrams, you can view each individual independent claim as circumscribing a region and each of its dependent claims as circumscribing a subregion within the region.

Note that it is possible for dependent claims to refer to other dependent claims, and thus define a “subsubregion.”

Your main goals in reviewing the claims should be to ensure

- 1) that they define something that you presently believe is new (that is, something that did not exist prior to your invention) and
- 2) that they (at least the broadest ones) capture your inventive concept in the most general terms possible so that some one cannot exploit the essence of your invention without infringing the patent.

To do a proper review of the claims, you need to understand basic patent infringement. (There are multiple strategies at play, but you needn't understand these to review the claims effectively; so, I've not described them here. However, as always, I welcome any questions you have.) Note that due to budget constraints, the application may not include claims to every potentially separately patentable feature of your invention. We can discuss expanding the budget for this case to address any features that are not presently covered or alternatively, docket reminders to pursue claims to these features later on.

Patent infringement occurs when a process or device or composition meets all the requirements of at least one valid claim in an issued patent. Thus, if a claim recites a method comprising steps a, b, and c or a device (or system) comprising features a, b, and c, then a court would find infringement if a party performs steps a, b, c or provides a device with features a, b, c. There is no infringement if one of the recited steps or features is missing. Note that in general, adding a step or feature d would not avoid infringement, so long as a, b, and c are satisfied. So, in reviewing the claims, particularly the independent ones (the ones that don't reference other claims), you should imagine yourself as a scientist or engineer working for a competitor and trying to design something that achieves the same or at least the key results of your invention without infringing any of the claims. If you envision a way around the broadest claims or sense that something is quite not adding up for you, please call me to discuss. We both may learn something and ultimately we'll have a better set of claims and/or just a better understanding and working relationship. Either way, it's a win-win situation.

ABSTRACT

The abstract is a short description of your invention, specifically limited to 150 words by the Patent Office. Many patent applications simply paraphrase the broadest claim in the application, to reduce risk of inadvertently limiting the scope of any claim in the resulting patent(s). I appreciate this concern as well, but balance it against a desire to further advocate the invention. (When the patent issues, the abstract will be on the cover page, I believe that first impressions are important, particularly to judges and jurors and business executives; so, with this in mind, I usually take pains to frame an embodiment of the invention, rather the entire invention, as a solution to a problem, in a manner similar to the background section.

I hope this guide is helpful to you and look forward to your comments.