This is your Release #10 (January 2021)

How to Write a Patent Application

Third Edition

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Filing the application promptly: Some applications are filed principally for defensive purposes, namely to prevent a third party from patenting the same technology. Since patent applications when published have an effective prior art date as of the filing date, filing promptly can turn out to be important. See § 1:5.1.

Prioritized fast-track examination—COVID-19 relief program: Applications containing a claim to a product or process related to COVID-19 and subject to FDA approval for use can have the fees waived. This is limited to micro entity and small entity filings. Applications claiming priority to more than one nonprovisional U.S. application or international application designating the United States are not eligible. The USPTO aims to reach a final disposition (final rejection or allowance) within six months. See § 2:9.2, at note 116.1

Communications with clients: The patent attorney may find it useful to have a standard document to inform clients about the purposes, methods, and limits of patent searches and about the impossibility of guaranteeing that every application will lead to a valid patent. The author provides a sample Notice to Clients Regarding Patentability Studies. See new Exhibit 5-2.

Patentable subject matter—enablement: According to the Federal Circuit, even if a patent claim is enabled, that does not mean that the claim is patent-eligible (*Electronic Communication Technologies, LLC v. ShoppersChoice.com, LLC*). See § 7:4.1[A], at note 14.1.

Patentable subject matter—abstract ideas: Among other recent decisions, the Federal Circuit's *In re Rudy* found that an invention involving the mental process of selecting a fishing hook based on observed water conditions involved merely abstract ideas and not patentable subject matter. See § 7:4.1[B], at note 65.5.

(continued on reverse)

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Dependent claims: A dependent claim can help provide breadth to a claim from which it depends. According to the Federal Circuit in *Baxalta Inc. v. Genentech, Inc*., a claim construction is probably wrong if it excludes dependent claims. See § 8:4.1[C], at note 175.1.

***Markush* groups:** In *Amgen Inc. v. Amneal Pharmaceuticals, LLC*, the Federal Circuit noted that although "consisting of" was used in the *Markush* group, the claim language "at least one binder selected from the group consisting of A, B, or C" covers a composition that includes a binder in additional to those specified in the *Markush* group due to the use of the "at least one" language. See § 8:4.4[A], at note 193.1.

Background section of the application—stating the purpose of the invention: There can be an advantage to specifying the purpose of an invention. In *Kaken Pharmaceutical Co. v. Iancu*, the Federal Circuit notes: "A patent's statement of the described invention's purpose informs the proper construction of claim terms, including when the task is to identify the broadest reasonable interpretation." See § 9:5.8[B], at note 188.1.

Pharmaceutical patents—polymorphs: Polymorphs of small molecules are compounds having different crystalline forms, and different polymorphs can have different, and sometimes unobvious, properties. Techniques useful to differentiate between polymorphs include thermogravimetric analysis, X-ray powder diffraction, single crystal X-ray analysis, Raman spectroscopy, differential scanning calorimetry, and Fourier transform infrared spectroscopy. See § 17:5.7[P], at note 140.

Appendix B (selected regulations), the **Table of Authorities,** and the **Index** have also been updated.

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FILING INSTRUCTIONS

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