

This is your Release #7 (April 2019)

How to Write a Patent Application

Third Edition

by **Jeffrey G. Sheldon**
(*Cislo & Thomas LLP*)

In this release, the author expands and updates your treatise with practical information on the following topics and more:

Missing parts pilot program: The Patent Office's missing parts pilot program has expired. See § 2:10.

Identifying the inventors: According to the Federal Circuit, a difference in inventors between an earlier-filed application and a later-filed application can result in the earlier-filed application being prior art and thereby rendering the patent issuing on the later-filed application invalid (*Duncan Parking Technologies v. IPS Group, Inc.*). See § 4:3, at note 1.5.

Conflict checks: The initial interview with the inventor should include steps to avoid a conflict: clearly identifying the client, determining who controls prosecution, determining who is the owner of the invention and of any patent application, and more. See § 4:5, at note 43.1.

Privileged communications: Communications between inventors and their patent attorneys and patent agents are privileged when the inventors are seeking advice on patentability and obtaining legal services for preparing a patent application, but the author cautions against inadvertent waiver of the privilege. See new § 4:5.5.

Patentable subject matter—abstract ideas: The release offers a step-by-step treatment of the Patent Office's latest approach to claims touching upon abstract ideas, and provides an illustrative flowchart as well. See § 7:4.4[A].

Claims—"optimizing": Use of the term "optimizing" without providing any way to determine whether optimization has been achieved is indefinite, according to the Federal Circuit in *Intellectual Ventures I LLC v. T-Mobile USA, Inc.* See § 8:2.1, at note 15.1.

(continued on reverse)

Practising Law Institute
1177 Avenue of the Americas
New York, NY 10036
#266665

Method claims—advantages: An apparatus claim can be rendered unpatentable by a prior art apparatus that is capable of operating so as to meet a claim limitation that says the claimed apparatus is capable of performing a function, even if the prior art does not teach that such function is performed. However, as indicated in the Federal Circuit’s *ParkerVision, Inc. v. Qualcomm Inc.*, the prior art apparatus may not render unpatentable a method claim that actually requires performance of the function. See § 8:5.4, at note 224.1.

Numerical limitations—open-ended ranges: A claim containing an open-ended range can be indefinite. For example, “at least 5%,” without an upper limit, may be indefinite. Accordingly, for backup, it is recommended that at least a dependent claim be provided where the upper and lower limits of a range are provided. See new § 8:5.14[D].

Information disclosure statement: For certain patent applications, the Patent Office has an initiative whereby it will automatically import reference citations from a parent application into a continuing application, without submission of an information disclosure statement for those citations, and the citations will be printed on the face of the patent. No request to participate can be made; the Patent Office will decide if the application is entitled to the initiative, and if so, will issue a Notice of Imported Citations. But the initiative has certain limitations. See § 10:2.5[A].

Design patents—enablement: According to the Federal Circuit in *In re Maatita*, the enablement test for design patents is whether the specification sufficiently describes the design to enable an average designer to make the design. Generally, any issues relating to enablement are the same as issues concerning definiteness. See § 11:1.8, at note 39.2.

Provisional patent applications: If the applicant is uncertain whether the invention is worth the cost of a regular application, or if the parameters of the final invention are uncertain, it may make sense to file a provisional application as a lower-cost option to obtain an early filing date. See § 12:6.

Plant patents: The release provides a list of the current requirements to obtain a plant patent. See new § 13:2.3.

Computer-related inventions: January 2019 guidance from the Patent Office indicates that computer-implemented functional claims require sufficient disclosure of both the hardware and the software to teach how the claimed function is achieved. See § 15:5.1, at note 57.1.

Updated Exhibits: The release adds Exhibit 4-2, Record and Disclosure of Invention (U.S. Navy).

The **Table of Authorities** and the **Index** have also been updated.

FILING INSTRUCTIONS

How to Write a Patent Application

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