

# Table of Contents

---

<b>About the Author</b> .....	v
<b>Table of Chapters</b> .....	vii
<b>Table of Exhibits</b> .....	xxxiii
<b>Acknowledgments</b> .....	xxxix

## **Chapter 1      Introduction, When to File, Where to Prepare the Application, and Use of AI**

§ 1:1      Need for This Book.....	1-1
§ 1:2      How to Use This Book .....	1-4
§ 1:3      Organization of This Book.....	1-5
§ 1:4      Terminology Used in This Book .....	1-6
§ 1:5      How Quickly Should the Application Be Filed?.....	1-6
§ 1:5.1      Reasons for Filing Promptly .....	1-6
§ 1:5.2      Reasons for Not Filing Promptly .....	1-8
§ 1:5.3      Techniques for Speeding Up the Filing Process.....	1-8
§ 1:6      Where to Prepare the Application .....	1-10
§ 1:7      Use of Artificial Intelligence .....	1-11
§ 1:8      Conclusion .....	1-12

## **Chapter 2      Parts of a Patent Application (Including Obtaining Expedited Examination)**

§ 2:1      Introduction .....	2-3
§ 2:2      Parts of a Patent Application.....	2-3
§ 2:2.1      What Is Needed to Obtain a Filing Date .....	2-3
§ 2:2.2      Papers Filed in a "Typical" Application.....	2-4
§ 2:3      Formal Papers .....	2-5
§ 2:3.1      Oath or Declaration.....	2-5
§ 2:3.2      Power of Attorney .....	2-7
§ 2:3.3      Assignment.....	2-8
§ 2:3.4      Small Entity and Micro Entity Claims .....	2-12
§ 2:3.5      Application Data Sheet .....	2-16
§ 2:3.6      Nonpublication Request.....	2-18

§ 2:4	Drawings .....	2-18
§ 2:5	Specification .....	2-19
§ 2:5.1	Title of the Invention.....	2-21
§ 2:5.2	Cross-References to Related Applications.....	2-22
§ 2:5.3	Statement As to Invention Rights Under Federally Sponsored Research.....	2-23
§ 2:5.4	Miscellaneous Statements .....	2-23
§ 2:5.5	Compact Disc References .....	2-23
§ 2:5.6	Background .....	2-24
§ 2:5.7	Summary .....	2-24
§ 2:5.8	Description of the Drawings .....	2-24
§ 2:5.9	Description .....	2-25
§ 2:5.10	Claims .....	2-25
§ 2:5.11	Abstract .....	2-26
§ 2:6	Preliminary Amendments.....	2-27
§ 2:7	Information Disclosure Statement .....	2-27
§ 2:8	Claiming Foreign Priority .....	2-28
§ 2:9	Expedited Examination.....	2-31
§ 2:9.1	Introduction.....	2-31
§ 2:9.2	Grounds for Requesting Expedited Examination .....	2-32
§ 2:9.3	Procedure .....	2-43
§ 2:9.4	Potential Advantages of a Petition to Make Special.....	2-46
§ 2:9.5	Potential Disadvantages of a Petition to Make Special .....	2-47
§ 2:10	First Action Interview Program.....	2-47
§ 2:11	Filing the Application .....	2-48
§ 2:11.1	Cover Sheet and Filing Fees .....	2-48
§ 2:11.2	Postcard and Mailing .....	2-50
§ 2:11.3	Checklist .....	2-52
§ 2:12	Signatures.....	2-52
Exhibit 2-1	Declaration (37 C.F.R. § 1.63) for Utility or Design Application Using an Application Data Sheet (37 C.F.R. § 1.76) .....	2EX-1
Exhibit 2-2	Substitute Statement in Lieu of an Oath or Declaration for Utility or Design Patent Application (35 U.S.C. § 115(d) and 37 C.F.R. § 1.64) .....	2EX-3
Exhibit 2-3	Transmittal for Power of Attorney to One or More Registered Practitioners.....	2EX-5
Exhibit 2-4	Power of Attorney to Prosecute Applications Before the USPTO .....	2EX-9
Exhibit 2-5	Power of Attorney to One or More of the Joint Inventors and Change of Correspondence Address .....	2EX-11

## *Table of Contents*

Exhibit 2-6	Assignment .....	2EX-13
Exhibit 2-7	Combination Inventor's Declaration and Assignment .....	2EX-17
Exhibit 2-8	Assignment of Application .....	2EX-21
Exhibit 2-9	Recordation Form Cover Sheet .....	2EX-23
Exhibit 2-10	Definition of Small Entity Status.....	2EX-25
Exhibit 2-11	Micro Entity Status .....	2EX-27
Exhibit 2-12	Verified Statement Claiming Small Entity Status—Independent Inventor.....	2EX-29
Exhibit 2-13	Verified Statement Claiming Small Entity Status—Small Business Concern.....	2EX-31
Exhibit 2-14	Verified Statement Claiming Small Entity Status—Nonprofit Organization.....	2EX-33
Exhibit 2-15	Sample Patent.....	2EX-35
Exhibit 2-16	Information Disclosure Statement by Applicant.....	2EX-41
Exhibit 2-17	Utility Patent Application Transmittal .....	2EX-45
Exhibit 2-18	Patent Application Fee Determination Record .....	2EX-47
Exhibit 2-19	Postcard.....	2EX-49
Exhibit 2-20	Express Mail Certificate .....	2EX-51
Exhibit 2-21	Application Data Sheet.....	2EX-53
Exhibit 2-22	Checklist for Filing Patent Applications .....	2EX-61
Exhibit 2-23	Nonpublication Request Under 35 U.S.C. § 122(b)(2)(B)(i) .....	2EX-63
Exhibit 2-24	Rescission of Previous Nonpublication Request (35 U.S.C. § 122(b)(2)(B)(ii)) and, If Applicable, Notice of Foreign Filing (35 U.S.C. § 122(b)(2)(B)(iii)).....	2EX-65
Exhibit 2-25	Certification of Micro Entity Status (Gross Income Basis) .....	2EX-67
Exhibit 2-26	Certification of Micro Entity Status (Institution of Higher Education Basis) .....	2EX-69
Exhibit 2-27	Certificate of Mailing or Transmission Under 37 C.F.R. § 1.8.....	2EX-71

## **Chapter 3      Electronic Filing in the Patent Office**

§ 3:1	Introduction .....	3-1
§ 3:2	Overview of Electronic Filing.....	3-3
§ 3:3	Who Can Electronically File .....	3-3
§ 3:4	What Can Be Electronically Filed.....	3-3
§ 3:5	Hardware and Software Required.....	3-3
§ 3:6	Obtaining a Digital Certificate.....	3-5
§ 3:7	Preparing the Application for Electronic Filing.....	3-6

§ 3:8	Preparing the Drawings for Electronic Filing.....	3-7
§ 3:9	Preparing Additional Parts .....	3-8
§ 3:10	Filing the Application .....	3-8
§ 3:11	Using USPTO Fillable Forms .....	3-11
§ 3:12	Preparing Electronic Information Disclosure Statements .....	3-11
§ 3:13	Electronic Filing of Assignments.....	3-11
§ 3:14	EFS Signatures.....	3-11
§ 3:15	Useful Contact Information and Help Sources .....	3-12
§ 3:16	Conclusion .....	3-12
Exhibit 3-1	Electronic Acknowledgment Receipt.....	3EX-1

## **Chapter 4 Working with the Inventor and Inventorship**

§ 4:1	Introduction .....	4-1
§ 4:2	Investigating Whether an Application Should Be Filed .....	4-2
§ 4:3	Identifying the Inventor or Inventors.....	4-3
§ 4:4	Preparing for the Initial Interview.....	4-14
§ 4:5	Initial Interview, Including Conflict Check.....	4-14
§ 4:5.1	Let the Inventor Tell the Story .....	4-16
§ 4:5.2	Obtain an Enabling Disclosure .....	4-16
§ 4:5.3	Do Not Become an Inventor .....	4-18
§ 4:5.4	Avoiding Inequitable Conduct.....	4-18
§ 4:5.5	Maintaining the Privilege.....	4-19
§ 4:6	Sending the Draft Application to the Inventor.....	4-19
§ 4:7	Getting the Application Executed .....	4-19
Exhibit 4-1	Checklist for Patent Protection Evaluation .....	4EX-1
Exhibit 4-2	Record and Disclosure of Invention (U.S. Navy).....	4EX-5
Exhibit 4-3	Inventor Prior Art Information Disclosure .....	4EX-7

## **Chapter 5 The Patentability Search**

§ 5:1	Introduction .....	5-1
§ 5:2	What Is a Patentability Search?.....	5-2
§ 5:3	Why Order a Patentability Search?.....	5-3
§ 5:3.1	Economics .....	5-3
§ 5:3.2	A Better Application Can Be Prepared.....	5-3
§ 5:3.3	Commercial Reasons for Conducting a Patentability Search .....	5-4
§ 5:3.4	Avoid <i>Festo</i> .....	5-4
§ 5:3.5	Foreign Filing Decisions.....	5-5
§ 5:4	Why Not to Order a Patentability Search .....	5-5

## *Table of Contents*

§ 5:5	Procedure for Ordering a Patentability Search .....	5-6
§ 5:5.1	Selecting the Searcher .....	5-7
§ 5:5.2	Information to Include in the Search Request.....	5-7
§ 5:5.3	Scope of the Search.....	5-7
§ 5:5.4	Cost of the Search.....	5-8
§ 5:5.5	Example of a Search Request Letter .....	5-8
§ 5:6	Limitations of a Patentability Search .....	5-9
§ 5:7	Reporting the Results of the Patentability Search.....	5-9
Exhibit 5-1	Letter Ordering Patentability Search.....	5EX-1
Exhibit 5-2	Notice to Clients Regarding Patentability Searches .....	5EX-3
Exhibit 5-3	Letter Reporting Patentability Study Results (Favorable) .....	5EX-5
Exhibit 5-4	Letter Reporting Patentability Study Results (Negative) .....	5EX-9
Exhibit 5-5	Letter Reporting Patentability Study Results (Neutral).....	5EX-13

## **Chapter 6      Drawings**

§ 6:1	Introduction .....	6-2
§ 6:1.1	When Drawings Are Required.....	6-3
§ 6:1.2	When to Order Drawings.....	6-5
§ 6:1.3	Informal Versus Formal Drawings .....	6-6
§ 6:2	Contents of the Drawings.....	6-6
§ 6:2.1	What Should Be Included in the Drawings? .....	6-6
§ 6:2.2	What Can Be Excluded from the Drawings? .....	6-7
§ 6:2.3	Example of Drawings Showing Claimed Features ....	6-8
§ 6:3	Drawing the Invention .....	6-9
§ 6:3.1	Perspective Views.....	6-11
§ 6:3.2	Front, Side, and Top Views.....	6-11
§ 6:3.3	Sectional Views.....	6-12
§ 6:3.4	Exploded Views .....	6-13
§ 6:3.5	Graphs and Charts .....	6-14
§ 6:3.6	Flowcharts and Schematics.....	6-14
§ 6:3.7	Complex Chemical Structures .....	6-14
§ 6:3.8	Illustrating the Use of the Invention.....	6-15
§ 6:4	Formal Requirements .....	6-15
§ 6:4.1	Paper Type, Size, and Margins.....	6-16
§ 6:4.2	Drawing Ink and Erasure .....	6-16
§ 6:4.3	Scale .....	6-17
§ 6:4.4	Arrangement of Views .....	6-17
§ 6:4.5	Lines, Letters, and Reference Numerals .....	6-18
§ 6:4.6	Identification of Drawings .....	6-19

§ 6:5	Illustrative Styles and Symbols .....	6-19
§ 6:5.1	Types and Forms of Lines.....	6-19
[A]	Object Line .....	6-20
[B]	Cutting Plane Line.....	6-20
[C]	Projection Line.....	6-20
[D]	Hidden Line.....	6-20
[E]	Lead Line .....	6-21
[F]	Center Line.....	6-21
§ 6:5.2	Shading.....	6-21
§ 6:5.3	Hatching Patterns .....	6-22
§ 6:5.4	Mechanical Components.....	6-22
§ 6:5.5	Illustrative Symbols and Labeled Representations .....	6-23
§ 6:6	Special Forms of Illustration.....	6-24
§ 6:6.1	Black-and-White Photographs.....	6-24
§ 6:6.2	Colored Drawings and Photographs.....	6-25
§ 6:6.3	Computer Programming Lists.....	6-25
§ 6:7	Mailing.....	6-25
Exhibit 6-1	Front Views of a Grill Cleaner .....	6EX-1
Exhibit 6-2	Device for Lifting and Inverting Cylindrical Containers .....	6EX-3
Exhibit 6-3	Partially Broken Away Front Perspective View.....	6EX-5
Exhibit 6-4	Three Partial Sectional Views .....	6EX-7
Exhibit 6-5	Exploded Views.....	6EX-9
Exhibit 6-6	Plot of Unreacted Carbon .....	6EX-11
Exhibit 6-7	Flowchart (Catalytic Production of Hydrogen from Low Heating Value Gases).....	6EX-13
Exhibit 6-8	Flowchart (Decompiler for Industrial Controllers) .....	6EX-15
Exhibit 6-9	Schematic: Procedure for the Metered Addition of Copper Ions in Cheese Production.....	6EX-17
Exhibit 6-10	Schematic: Engine Spark Control Apparatus .....	6EX-19
Exhibit 6-11	Complex Chemical Structures.....	6EX-21
Exhibit 6-12	Use of an Invention.....	6EX-23
Exhibit 6-13	Types of Lines.....	6EX-25
Exhibit 6-14	Use of Lines .....	6EX-27
Exhibit 6-15	Circular Shading Lines .....	6EX-29
Exhibit 6-16	Oblique Shading Lines.....	6EX-31
Exhibit 6-17	Shading Lines for Inclined Surfaces Versus Flat Surfaces .....	6EX-33
Exhibit 6-18	Sanctioned Hatching Patterns .....	6EX-35
Exhibit 6-19	Threads—Conventional Methods.....	6EX-37
Exhibit 6-20	Gears.....	6EX-39

## Table of Contents

Exhibit 6-21	Worm Gear in Mesh.....	6EX-41
Exhibit 6-22	Symbols for Conventional Electrical and Mechanical Elements .....	6EX-43
Exhibit 6-23	Transmission Electron Micrograph of Fibrous Carbon Chain .....	6EX-47

## Chapter 7 Patentable Subject Matter

§ 7:1	Introduction .....	7-2
§ 7:2	Legislative Exceptions .....	7-5
§ 7:3	Judicial Exceptions: The General Approach .....	7-5
§ 7:4	The "Abstract" Exception.....	7-6
§ 7:4.1	What Is "Abstract"? .....	7-6
[A]	Lack of Definition of "Abstract" .....	7-6
[B]	Examples of Abstract Ideas .....	7-8
[C]	Nonabstract Ideas .....	7-16
§ 7:4.2	What Is "Significantly More"?.....	7-19
§ 7:4.3	<i>Bilski</i> Machine-or-Transformation Test .....	7-22
§ 7:4.4	Patent Office Guidelines .....	7-24
[A]	Current Guidelines and Informative PTAB Decisions.....	7-26
[B]	Prior Guidelines.....	7-36
§ 7:4.5	Case Law Post- <i>Bilski</i> .....	7-39
§ 7:4.6	Recommendations for Drafting Specifications and Claims to Avoid Abstractness .....	7-41
§ 7:4.7	Pre- <i>Bilski</i> and Pre- <i>Alice</i> Decisions.....	7-45
§ 7:4.8	Pre- <i>Bilski</i> Approved Claims for Computer/ Software Inventions .....	7-47
[A]	Exclude Algorithms from the Claims.....	7-48
[B]	Include Tangible Elements .....	7-51
[C]	Transform Something Physical .....	7-53
[D]	Include Post-Solution Activity .....	7-56
[E]	Produce a Useful, Concrete, Tangible Result.....	7-57
§ 7:5	Laws of Nature and Natural Phenomena.....	7-58
§ 7:5.1	Introduction.....	7-58
§ 7:5.2	Recent Supreme Court Cases.....	7-59
§ 7:5.3	Federal Circuit Authority .....	7-60
§ 7:5.4	Patent Office Guidelines .....	7-63
§ 7:5.5	Recommendation for Drafting Claims Not Directed Merely to Laws of Nature and Naturally Occurring Substances .....	7-67

## Chapter 8 Preparing the Claims

§ 8:1	Introduction .....	8-4
§ 8:1.1	Purpose of the Claims.....	8-5
§ 8:1.2	Basic Principles of Claim Drafting .....	8-5
§ 8:1.3	Start with the Claims.....	8-6
§ 8:2	Statutory Requirements for the Claims .....	8-7
§ 8:2.1	35 U.S.C. § 112 .....	8-7
§ 8:2.2	35 U.S.C. §§ 102 and 103.....	8-13
§ 8:2.3	35 U.S.C. § 101 .....	8-19
[A]	Exclusions from Patentable Subject Matter .....	8-21
§ 8:3	Claim Form and Language.....	8-22
§ 8:3.1	Claims Are Placed After the Specification .....	8-22
§ 8:3.2	Single Sentence .....	8-23
§ 8:3.3	Preamble.....	8-23
[A]	Purpose and Form of Preamble .....	8-23
[B]	Does the Preamble Limit the Claim Scope? .....	8-25
§ 8:3.4	Transitions: From Preamble to the Body and from Elements to Sub-Elements.....	8-30
[A]	“Comprising” and Equivalents .....	8-31
[B]	“Consisting of” .....	8-32
[C]	“Consisting Essentially of” .....	8-33
[D]	“Composed of” and “Having” .....	8-34
[E]	Nonuse of “Step of” in the Transition.....	8-34
[F]	Examples of Use of Transitions.....	8-35
§ 8:3.5	Body of Claim .....	8-36
[A]	Defining the Elements .....	8-37
[A][1]	Introducing the Elements .....	8-37
[A][2]	Single Clause.....	8-38
[A][3]	Structural Definitions .....	8-39
[A][4]	Functional Definitions .....	8-40
[A][4][a]	“Means for” (and Equivalents) and “Step for” Clauses.....	8-41
[A][4][b]	Functional Language .....	8-47
[A][4][c]	“Whereby” Clauses .....	8-49
[B]	Order of the Elements.....	8-50
[C]	Cooperation.....	8-52
[C][1]	Structural Cooperation.....	8-54
[C][2]	Functional Cooperation.....	8-55
[C][3]	Order of Steps .....	8-56
[D]	Claim Format .....	8-57
[E]	Reference Numbers.....	8-58
[F]	Method Steps.....	8-58
[G]	Use of “First” and “Second” .....	8-58
[H]	“Wherein” Clauses.....	8-59
§ 8:3.6	Arranging and Numbering the Claims .....	8-59

## Table of Contents

§ 8:4	Types of Claims .....	8-60
§ 8:4.1	Dependent Claims .....	8-61
[A]	Form of Dependent Claims.....	8-61
[B]	Content of Dependent Claims.....	8-62
[C]	Use of Dependent Claims.....	8-63
§ 8:4.2	Multiple Dependent Claims .....	8-64
§ 8:4.3	<i>Jepson</i> Claims.....	8-66
§ 8:4.4	<i>Markush</i> Groups.....	8-68
[A]	Form of <i>Markush</i> Claims.....	8-68
[B]	Relationship Between the Alternatives.....	8-69
[C]	Uses of <i>Markush</i> Claims.....	8-70
[D]	Patent Office Guidelines .....	8-71
[E]	Recommendations re <i>Markush</i> Claims .....	8-72
§ 8:4.5	Product-by-Process Claims.....	8-74
§ 8:4.6	New-Use Claims.....	8-76
§ 8:5	Strategy of Claim Drafting.....	8-77
§ 8:5.1	Obtaining Broad Coverage .....	8-77
§ 8:5.2	Drafting the Picture Claim .....	8-78
§ 8:5.3	Writing the Broadest Claim or Claims .....	8-79
[A]	Defining the Novel and Nonobvious Element or Elements.....	8-80
[B]	Avoid Unnecessary Limitations and Elements.....	8-80
[B][1]	In the Preamble .....	8-81
[B][2]	In the Transition .....	8-81
[B][3]	In the Body.....	8-82
[C]	Defining Elements by Their Function.....	8-83
[C][1]	Using Means Clauses.....	8-83
[C][2]	Using Functional Language .....	8-86
[D]	Comparing the Broadest Claim Against the Prior Art.....	8-88
[E]	Verifying Claim Structure with a Diagram.....	8-88
§ 8:5.4	Include Different Statutory Classes of Claims .....	8-89
§ 8:5.5	Converting Process Claims to Apparatus Claims .....	8-92
§ 8:5.6	Adding Limitations to a Claim Without Narrowing the Claim .....	8-93
§ 8:5.7	Claim the Environment of the Invention .....	8-93
§ 8:5.8	Using Dependent Claims.....	8-94
[A]	Strategic Use of Dependent Claims .....	8-94
[B]	Strategic Use of Multiple Dependent Claims .....	8-98
§ 8:5.9	Using Independent Claims of Different Scope Than the Broadest Claim.....	8-100
§ 8:5.10	Using Kit Claims .....	8-101
§ 8:5.11	Claim What Is Sold.....	8-102
§ 8:5.12	Controlling the Number of Claims .....	8-102

§ 8:5.13	Use of “About” and Other Terms of Approximation.....	8-103
§ 8:5.14	Use of Numerical Limitations .....	8-105
[A]	Avoid Precise Numbers.....	8-105
[B]	Use Functional Language in Lieu of Numerical Limits .....	8-106
[C]	Numerical Limitations Can Require Criticality .....	8-106
[D]	The Risk of an Open-Ended Range .....	8-107
§ 8:5.15	Negative Limitations .....	8-107
§ 8:5.16	Avoid the Doctrines of Patent Exhaustion and Implied License.....	8-108
§ 8:5.17	Carefully Use “a,” “an,” and “One”.....	8-109
§ 8:5.18	Avoid 35 U.S.C. § 287(c) .....	8-111
§ 8:5.19	Beware of “Including” .....	8-111
§ 8:5.20	Claim All Disclosed Embodiments .....	8-112
§ 8:5.21	Include Ambiguous Claims.....	8-113
§ 8:5.22	Claim to Avoid <i>Festo</i> .....	8-114
§ 8:5.23	Do Not Include Theory in the Claims .....	8-116
§ 8:5.24	Carefully Use Alternative Language .....	8-116
§ 8:5.25	Use a Dictionary When Drafting Claims .....	8-116
§ 8:5.26	Avoid Divided and Distributed Claims .....	8-117
§ 8:5.27	Drafting Claims with Consideration of a Restriction Requirement .....	8-119
§ 8:5.28	Carefully Use “and” and “or” .....	8-120
§ 8:5.29	Heading Off Indefiniteness Defenses .....	8-121
§ 8:5.30	Avoid CBM Review .....	8-122
§ 8:5.31	Use of Industry Standards in Claims .....	8-122
§ 8:5.32	Computer-Readable Medium .....	8-122
§ 8:5.33	Use of “the” and “said” .....	8-123
§ 8:6	Claim Deficiencies—What Not to Do .....	8-123
§ 8:6.1	Use of Inconsistent Terminology .....	8-123
§ 8:6.2	Wrong Verb Form .....	8-123
§ 8:6.3	Lack of Antecedent Basis, Support, or Both.....	8-124
[A]	Antecedent Basis in the Claim.....	8-124
[B]	Antecedent Basis in the Specification .....	8-125
[C]	Antecedent Basis in the Drawings .....	8-126
§ 8:6.4	Indefiniteness .....	8-126
[A]	Words of Degree and Relational Terms .....	8-129
[B]	Indefinite References to Antecedent Elements .....	8-131
[C]	Alternative Expressions .....	8-132
§ 8:6.5	Deficient Functional Language.....	8-133
[A]	Meaningless Means Clauses .....	8-133
[B]	Overly Broad.....	8-134
[C]	Nonexistent Novelty and Nonobviousness .....	8-135

## Table of Contents

§ 8:6.6	Surplusage .....	8-136
§ 8:6.7	Tainted Trademarks .....	8-136
§ 8:6.8	Incomplete Claims.....	8-138
§ 8:6.9	Nonexistent Operability.....	8-138
§ 8:6.10	Overbroad Ranges .....	8-138
§ 8:6.11	Avoid Having Claims with Priority Before and After March 16, 2013 .....	8-139
§ 8:6.12	Avoid Claims That Are in Two Statutory Classes.....	8-140
§ 8:7	Improving Claim Quality .....	8-140
Exhibit 8-1	Broad Claim for Shaking Apparatus of Exhibits 8-11 and 8-13 .....	8EX-1
Exhibit 8-2	Broad Claim for Strand-Collecting Apparatus.....	8EX-3
Exhibit 8-3	Proper and Improper Cooperation Among Elements of a Claim.....	8EX-5
Exhibit 8-4	Dependent Claim Sequences .....	8EX-7
Exhibit 8-5	Improper Multiple Dependant Claim Sequence.....	8EX-9
Exhibit 8-6	<i>Jepson</i> Apparatus Claim.....	8EX-11
Exhibit 8-7	<i>Jepson</i> Method Claim.....	8EX-13
Exhibit 8-8	<i>Jepson</i> Composition-of-Matter Claim .....	8EX-15
Exhibit 8-9	<i>Markush</i> Claim .....	8EX-17
Exhibit 8-10	Product-by-Process Claim.....	8EX-19
Exhibit 8-11	Drawings of Shaking Apparatus .....	8EX-21
Exhibit 8-12	Picture Claim of Shaking Apparatus of Exhibits 8-11 and 8-13 .....	8EX-23
Exhibit 8-13	Schematic of Broad Claim of Exhibit 8-1 .....	8EX-25
Exhibit 8-14	Checklist of Possible Claim Deficiencies .....	8EX-27
Exhibit 8-15	Example of Poor Claim Drafting: Suction Cleaner.....	8EX-29
Exhibit 8-16	Example of Poor Claim Drafting: Steam and Dry Iron .....	8EX-37

## Chapter 9 Writing the Specification

§ 9:1	Introduction: The Requirements of 35 U.S.C. § 112 and the Utility Requirement.....	9-4
§ 9:1.1	35 U.S.C. § 112 .....	9-4
§ 9:1.2	Utility .....	9-5
§ 9:2	Satisfying the Description Requirement of § 112 .....	9-10
§ 9:3	Satisfying the Enablement Requirement of § 112 .....	9-19
§ 9:3.1	What Is the Enablement Requirement?.....	9-19

§ 9:3.2	Guidelines for Satisfying the Enablement Requirement .....	9-21
[A]	The Enablement Requirement Applies Only to Claimed Subject Matter .....	9-21
[B]	The Specification Need Be Enabling Only to Someone Skilled in the Relevant Art.....	9-22
[C]	The "Skill of the Art" Is Determined As of the Date of Filing.....	9-25
[D]	The Specification Need Not Explain How or Why the Invention Works.....	9-25
[E]	Undue Experimentation Must Not Be Required to Reproduce the Invention.....	9-26
[F]	The Claimed Matter Must Not Be Unduly Broad in Relation to the Disclosure .....	9-28
[G]	The Specification Must Teach How to Make and Use Each Member of a <i>Markush</i> Group .....	9-30
[H]	Working and Prophetic Examples Can Be Used to Satisfy the Enablement Requirement.....	9-31
[I]	The Enablement Requirement Does Not Extend to Technology That Arises After the Time of Filing .....	9-32
[J]	How-To-Use Aspect of Enablement Requirement Requires Satisfaction of Utility Requirement .....	9-32
[K]	The Most Optimized Configuration of the Invention Does Not Need to Be Enabled.....	9-33
[L]	Testing in Animals Can Enable Use in Humans.....	9-33
§ 9:4	Satisfying the "Best Mode" Requirement of § 112.....	9-33
§ 9:4.1	What Is the "Best Mode" Requirement? .....	9-33
§ 9:4.2	Guidelines for Satisfying the "Best Mode" Requirement .....	9-34
[A]	The "Best Mode" Requirement Applies Only to Claimed Subject Matter and Unclaimed Elements Necessary for Operation of the Invention .....	9-35
[B]	Only the Best Mode As of the Filing Date Need Be Disclosed .....	9-37
[C]	The Best Mode Is Not Necessarily the Eventual Commercial Method .....	9-37
[D]	The Specification Need Only Disclose What the Inventor Subjectively Believes to Be the Best Mode.....	9-37
[E]	Violation of the "Best Mode" Standard Can Be Accidental.....	9-38
[F]	The Best Mode Must Be Disclosed Even If the Applicant Did Not Invent It .....	9-38

*Table of Contents*

[G]	The Description of the Best Mode Has to Be Objectively Enabling .....	9-39
[H]	The Use of Trademarks to Satisfy the Best Mode Requirement .....	9-40
[I]	The Disclosure of the Best Mode Cannot Rely on Prior Art That Is Nonconventional or Not Widely Known .....	9-41
[J]	The Best Mode Need Not Be Identified As Such, but It Should Not Be Hidden .....	9-42
[K]	The Public Cannot Be Misled As to the Best Mode .....	9-43
[L]	A Working Example Is an Effective Way to Disclose the Best Mode .....	9-44
[M]	Trade Secrets and the Best Mode Are Incompatible .....	9-44
[N]	The Best Mode Requirement Does Not Include Unclaimed Uses of the Invention .....	9-45
§ 9:5	Writing the Specification .....	9-46
§ 9:5.1	Introduction .....	9-46
§ 9:5.2	Parts of the Application .....	9-48
§ 9:5.3	Title .....	9-49
§ 9:5.4	Identification of Inventors .....	9-51
§ 9:5.5	Cross-References and Priority Claims .....	9-52
[A]	Types of Applications .....	9-54
§ 9:5.6	Government Rights .....	9-56
§ 9:5.7	Reference to CDs .....	9-56
§ 9:5.8	Background .....	9-56
[A]	Heading .....	9-57
[B]	What the Background Section Should Not Include .....	9-57
[C]	What the Background Section Should Include .....	9-59
§ 9:5.9	Summary Section .....	9-62
[A]	Heading .....	9-62
[B]	Opening .....	9-62
[C]	Contents .....	9-62
[D]	Closing .....	9-65
§ 9:5.10	Drawings .....	9-65
[A]	Transitional Clause .....	9-65
[B]	Refer to "Version" of the Invention .....	9-66
[C]	Use of Suffixes for Similar Drawings .....	9-66
[D]	Cross-Reference the Drawings .....	9-66
[E]	Refer to Different "Versions" of the Invention .....	9-66
§ 9:5.11	Description .....	9-67
[A]	Caption .....	9-67
[B]	Purpose of the Description .....	9-67

[C]	Outline of a Typical Description .....	9-67
[C][1]	The Opening.....	9-67
[C][2]	Definitions .....	9-69
[C][3]	Overview .....	9-70
[C][4]	Detailed Description of the Elements (Including Means-Plus-Function Elements) .....	9-72
[C][5]	How the Invention Is Used .....	9-77
[C][6]	Advantages of the Invention.....	9-77
[C][7]	Specific Embodiments and Examples .....	9-78
[C][8]	Alternatives and the Closing .....	9-80
[D]	Use of Prior Art Patents .....	9-82
[E]	Ranges and Preferences .....	9-82
[F]	Use of Trademarks .....	9-85
[G]	Incorporation by Reference .....	9-86
[H]	Reference Numbers.....	9-89
[H][1]	The Description Is Written As If No Reference Numbers Are Used.....	9-90
[H][2]	The Reference Numbers Should Be Kept Sequential .....	9-90
[H][3]	Numbers Higher Than Drawing Numbers Should Be Used .....	9-90
[H][4]	Chart the Reference Numbers .....	9-90
[H][5]	Skip the Reference Numbers .....	9-91
[H][6]	Use the Reference Numbers Consistently .....	9-91
[H][7]	Use Suffixes to Distinguish Similar Elements .....	9-91
[H][8]	Use Series of Numbers for Clarity .....	9-91
[I]	Antecedent .....	9-92
[J]	Use of Spatial Directions .....	9-92
[K]	Avoid Absolutes .....	9-92
[L]	Use Present Tense.....	9-93
[M]	Avoid "etc." and Carefully Use "i.e." .....	9-93
[N]	Copyright or Mask Work Notice .....	9-93
[O]	Line Numbers and Docket Numbers .....	9-94
[P]	Tabular Data.....	9-95
[Q]	Use of "Optional," "Preferable," and Other Equivocal Terms .....	9-95
[R]	Use of "Present Invention" and "Object of Invention".....	9-95
[S]	Support for Negative Limitations.....	9-96
[T]	Over Disclosure .....	9-96
[U]	Improving Patent Quality .....	9-97
§ 9:5.12	Abstract .....	9-97
§ 9:6	Strategic Writing of the Specification for Broad Claim Interpretation .....	9-99

## *Table of Contents*

Exhibit 9-1	Terminology .....	9EX-1
Exhibit 9-2	Chart of Numbered Elements (Partial).....	9EX-11
Exhibit 9-3	Tree Diagram of Numbered Elements.....	9EX-13

## **Chapter 10 Information Disclosure Statement**

§ 10:1	Introduction .....	10-1
§ 10:2	What Information Must Be Disclosed .....	10-3
§ 10:2.1	The Current Materiality Standard .....	10-3
§ 10:2.2	The Pre-1992 Standard.....	10-3
§ 10:2.3	The Current Patent Office Standard .....	10-4
§ 10:2.4	Ethical Considerations.....	10-4
§ 10:2.5	Recommendations .....	10-5
[A]	Checklist of Material Information .....	10-8
§ 10:3	When Should the Information Disclosure Statement Be Filed? .....	10-13
§ 10:4	Content of Information Disclosure Statement.....	10-15
§ 10:5	Submission of Listed Documents .....	10-18
§ 10:6	Electronic Filing of an Information Disclosure Statement.....	10-19
§ 10:7	Example.....	10-20
Exhibit 10-1	Sample Information Disclosure Statement.....	10EX-1

## **Chapter 11 Design Patent Applications**

§ 11:1	Subject Matter and Legal Standards .....	11-2
§ 11:1.1	Patentable Designs.....	11-2
§ 11:1.2	The Ornamentality Requirement.....	11-5
§ 11:1.3	"Concealed During Normal Use" Limitation .....	11-7
§ 11:1.4	Description Requirement.....	11-8
§ 11:1.5	Anticipation Test for Design Patents.....	11-8
§ 11:1.6	Obviousness Test for Design Patents.....	11-9
§ 11:1.7	Infringement Test for Design Patents .....	11-10
§ 11:1.8	Indefiniteness (and Enablement) Test for Design Patents .....	11-10
§ 11:1.9	Relationship Between Design Patents, Copyright, and Trademark .....	11-11
[A]	Overlap of Design Patent and Copyright.....	11-11
[B]	Overlap of Design Patent and Trademark.....	11-11
§ 11:2	Parts of the Application .....	11-11
§ 11:2.1	Specification .....	11-12
[A]	Preamble and Title.....	11-12
[B]	Cross-References.....	11-14

[C]	Description .....	11-14
[D]	Claim .....	11-16
§ 11:2.2	Drawings .....	11-17
[A]	Unitary Design Concept .....	11-17
[B]	Requirements for Adequate Drawings .....	11-19
[C]	Drawing the Invention .....	11-21
[D]	Formal Requirements .....	11-22
[E]	Illustrative Styles and Symbols .....	11-23
§ 11:2.3	Information Disclosure Statement .....	11-24
[A]	Novelty .....	11-25
[B]	Nonobviousness .....	11-25
[C]	Scope of Prior Art .....	11-25
§ 11:3	Expedited Examination .....	11-26
Exhibit 11-1	Design Patent Application Transmittal .....	11EX-1
Exhibit 11-2	Assignment for Design Patent .....	11EX-3
Exhibit 11-3	Photograph Display Design Patent .....	11EX-5
Exhibit 11-4	Decorative Glass Panel Design Patent .....	11EX-9
Exhibit 11-5	Dial Top-Housing for Telephone Handset or Similar Article Design Patent .....	11EX-11
Exhibit 11-6	Handle for an Article of Flatware Design Patent .....	11EX-15
Exhibit 11-7	Font of Type Design Patent .....	11EX-17
Exhibit 11-8	Automobile Design Patent .....	11EX-19
Exhibit 11-9	Scarf Design Patent .....	11EX-23
Exhibit 11-10	Request for Expedited Examination of a Design Application (37 C.F.R. § 1.155) .....	11EX-25

## Chapter 12 Provisional Patent Applications

§ 12:1	Introduction .....	12-1
§ 12:1.1	The Nature of Provisional Applications .....	12-1
§ 12:1.2	Conversion of Regular Applications .....	12-5
§ 12:1.3	Secrecy .....	12-5
§ 12:1.4	Inventorship .....	12-6
§ 12:1.5	Section 102(e) Date of Provisional Application .....	12-7
§ 12:2	Requirements for a Provisional Application .....	12-7
§ 12:3	Advantages and Disadvantages of Filing a Provisional Application .....	12-10
§ 12:4	The Claim(s) .....	12-15
§ 12:5	Marking .....	12-17
§ 12:6	Author's Recommendations .....	12-17
Exhibit 12-1	Potential Disadvantages of Initially Filing a Provisional Patent Application .....	12EX-1

## *Table of Contents*

Exhibit 12-2	Notice Regarding Conversion to Provisional Patent Application .....	12EX-3
Exhibit 12-3	Provisional Application for Patent Cover Sheet .....	12EX-5

## **Chapter 13 Plant Patent Applications**

§ 13:1	Introduction; Plant Variety Protection Act .....	13-1
§ 13:2	Patentable Subject Matter .....	13-2
§ 13:2.1	Types of Patentable Plants.....	13-2
§ 13:2.2	Asexual Reproduction .....	13-3
§ 13:2.3	Summary of Requirements for a Plant Patent .....	13-3
§ 13:2.4	Distinctiveness .....	13-4
§ 13:3	Novelty.....	13-5
§ 13:4	Inventorship .....	13-6
§ 13:5	Parts of the Application .....	13-6
§ 13:5.1	Oath or Declaration.....	13-7
§ 13:5.2	Title and Variety Name.....	13-7
§ 13:5.3	Specification .....	13-8
§ 13:5.4	Claim .....	13-10
§ 13:5.5	Drawings .....	13-10
§ 13:5.6	Specimens.....	13-11
Exhibit 13-1	Plant Patent Application Transmittal .....	13EX-1
Exhibit 13-2	Assignment for Plant Patent.....	13EX-3
Exhibit 13-3	Plant Patent Application (35 U.S.C. § 161) Declaration (37 C.F.R. § 1.63) .....	13EX-5
Exhibit 13-4	Plant Patent for Sprague Peach Bush .....	13EX-7
Exhibit 13-5	Plant Patent for Rose Plant Jaccart.....	13EX-13
Exhibit 13-6	Plant Patent for Cherry Tree (Aaron Gee) .....	13EX-17
Exhibit 13-7	Plant Patent for Chrysanthemum Plant Named Cartago .....	13EX-21

## **Chapter 14 Electrical Patent Applications**

§ 14:1	Introduction .....	14-1
§ 14:1.1	Scope of Patent Protection .....	14-2
§ 14:1.2	Other Forms of Protection .....	14-2
§ 14:2	Claims .....	14-3
§ 14:2.1	Principles of Claims for Electrical Inventions .....	14-3
[A]	Use of Functional Language .....	14-3
[B]	Signal Claims .....	14-6
[C]	Other Considerations .....	14-6
§ 14:2.2	Practice.....	14-7

§ 14:3	Drawings .....	14-9
§ 14:3.1	Content of the Drawings .....	14-9
§ 14:3.2	Format of the Drawings .....	14-11
§ 14:4	Description.....	14-12
§ 14:4.1	Content—Full Disclosure of Equivalents .....	14-12
§ 14:4.2	Style.....	14-15
Exhibit 14-1	Figure with Legends Added.....	14EX-1
Exhibit 14-2	Timing Diagram.....	14EX-3
Exhibit 14-3	Block Diagram of Ground Fault Detector Circuit.....	14EX-5
Exhibit 14-4	Details of Ground Fault Detector Circuit .....	14EX-7
Exhibit 14-5	Schematic Block Diagram of a Control System.....	14EX-9
Exhibit 14-6	Simple Analog Closed Loop Position Control System .....	14EX-11
Exhibit 14-7	Selected Logic Symbols for Members of a Series of Integrated Circuits .....	14EX-13
Exhibit 14-8	Table of Component Types and Common Industrial Designations .....	14EX-15
Exhibit 14-9	Operational Amplifier Circuit .....	14EX-17
Exhibit 14-10	Operational Amplifier Block.....	14EX-19

## **Chapter 15 Patent Applications for Software and Methods of Doing Business**

§ 15:1	Introduction .....	15-2
§ 15:1.1	Background and General Recommendations.....	15-2
§ 15:1.2	Alternative Forms of Protection .....	15-4
§ 15:1.3	Advantages of Utility Patents .....	15-5
§ 15:1.4	Definitions.....	15-5
§ 15:2	Patentable Subject Matter .....	15-6
§ 15:3	Obviousness .....	15-6
§ 15:4	Claims .....	15-6
§ 15:4.1	Identifying the Prior Art.....	15-7
§ 15:4.2	Types of Claims .....	15-7
[A]	Apparatus Claims .....	15-7
[B]	Method Claims.....	15-12
[C]	Software Product Claims.....	15-15
[D]	Signal Claims .....	15-15
[E]	<i>Beauregard</i> Claims.....	15-16
§ 15:4.3	Claim Drafting Considerations.....	15-17
[A]	Draft the Claims to Catch Infringers .....	15-17
[B]	Drafting Claims for a High Royalty Base .....	15-19

## Table of Contents

[C]	Drafting Claims Directed to Statutory Subject Matter .....	15-19
[C][1]	Exclude Algorithms from the Claims .....	15-20
[C][2]	Include Tangible Elements.....	15-23
[C][3]	Transform Something Physical.....	15-26
[C][4]	Post-Solution Activity.....	15-29
[C][5]	Produce a Useful, Concrete, Tangible Result .....	15-30
§ 15:5	Disclosure.....	15-31
§ 15:5.1	The Disclosure Must Satisfy 35 U.S.C. § 112 .....	15-31
§ 15:5.2	Sequence for the Description .....	15-36
[A]	Computer System Context .....	15-36
[B]	Major Component Overview .....	15-37
[C]	Major Component Details .....	15-38
[D]	Examples of Operation.....	15-40
§ 15:5.3	Standard Terminology.....	15-40
§ 15:5.4	Writing a Specification Defining Subject Matter Eligibility.....	15-41
§ 15:6	Drawings and Computer Program Listings .....	15-41
§ 15:6.1	Drawings .....	15-42
§ 15:6.2	Computer Program Listings .....	15-43
Exhibit 15-1	Inference Engine, U.S. Patent No. 4,890,240 .....	15EX-1
Exhibit 15-2	Set of Data Structures, U.S. Patent No. 4,890,240 .....	15EX-3
Exhibit 15-3	Called Routine, U.S. Patent No. 4,890,240 .....	15EX-5
Exhibit 15-4	Flow Diagram of the Overall Invention, U.S. Patent No. 4,890,240 .....	15EX-7

## Chapter 16 Patent Applications for the Chemical Invention

§ 16:1	Introduction .....	16-2
§ 16:2	Obviousness .....	16-2
§ 16:3	The Specification.....	16-4
§ 16:3.1	The Written Description Requirement.....	16-5
[A]	Paraphrase the Main Claim .....	16-5
[B]	Describe Species and Subgeneruses.....	16-6
§ 16:3.2	The Enablement Requirement .....	16-7
[A]	How to Make .....	16-7
[A][1]	Starting Materials.....	16-7
[A][2]	Reaction Conditions .....	16-8
[A][3]	Working Examples.....	16-8
[B]	Checklist for Enablement .....	16-10
[C]	How to Use and Utility.....	16-10
§ 16:3.3	The “Best Mode” Requirement .....	16-11
§ 16:3.4	Indefiniteness in the Claims.....	16-13

§ 16:4	Claiming the Chemical Invention .....	16-13
§ 16:4.1	What to Claim.....	16-13
§ 16:4.2	<i>Markush</i> Practice .....	16-15
§ 16:4.3	Product-by-Process Claims.....	16-16
§ 16:4.4	Use of Functional Expressions .....	16-17
§ 16:4.5	Operability.....	16-17
§ 16:4.6	Use of Broad Claim Language.....	16-18
§ 16:5	Other Considerations .....	16-19
Exhibit 16-1	Checklist for Enablement in Chemical Applications .....	16EX-1

## Chapter 17 Biotechnology Patent Applications

§ 17:1	Introduction .....	17-2
§ 17:1.1	Scope of This Chapter.....	17-2
§ 17:1.2	What Is Biotechnology? .....	17-2
§ 17:1.3	Alternative Forms of Protection .....	17-3
§ 17:1.4	Does a Patent Application Make Economic Sense?.....	17-4
§ 17:2	Identifying the Invention .....	17-5
§ 17:3	Patentability of Biotechnology Inventions .....	17-8
§ 17:3.1	Patentable Subject Matter .....	17-9
§ 17:3.2	Utility .....	17-9
[A]	General Principles.....	17-9
[B]	Utility Problems for Biotechnology Inventions.....	17-10
§ 17:3.3	Novelty .....	17-14
§ 17:3.4	Obviousness.....	17-16
§ 17:4	Satisfying the Requirements of 35 U.S.C. § 112 .....	17-19
§ 17:4.1	The Requirements of 35 U.S.C. § 112 .....	17-19
§ 17:4.2	Written Description .....	17-20
§ 17:4.3	Enablement.....	17-27
§ 17:4.4	Best Mode.....	17-32
§ 17:4.5	Deposits.....	17-33
§ 17:4.6	Presentation of Nucleotide or Amino Acid Sequence Data or Both.....	17-36
§ 17:5	Claims .....	17-39
§ 17:5.1	Claim-Breadth Problems.....	17-39
§ 17:5.2	Restriction Requirements.....	17-41
§ 17:5.3	Claim Format .....	17-41
§ 17:5.4	Claim Definiteness .....	17-43
§ 17:5.5	Use of Method Claims.....	17-44
§ 17:5.6	Exemplary Biotechnology Claims.....	17-44
§ 17:5.7	Claim Strategies for Biotechnology Inventions.....	17-52
[A]	Nucleic Acids.....	17-52
[B]	Promoter Sequences.....	17-55
[C]	Vectors and Transfected Cells .....	17-55

*Table of Contents*

[D]	Expressed Sequence Tags (ESTs) .....	17-56
[E]	Antisense Nucleic Acids .....	17-56
[F]	Transgenic Animals .....	17-57
[G]	Genetic Therapy .....	17-58
[H]	Polypeptides .....	17-59
[I]	Vaccines .....	17-61
[J]	Antibodies and Hybridomas .....	17-62
[K]	DNA Chips (Microarrays) and Their Use .....	17-63
[L]	Combinatorial Libraries .....	17-64
[M]	Assays for Biological Compounds .....	17-65
[N]	New Uses of Known Biological Molecules .....	17-67
[O]	Metabolites .....	17-68
[P]	Drugs .....	17-69

**Chapter 18    Preparing Foreign Patent Applications Based on  
a U.S. Application**

§ 18:1	Introduction .....	18-3
§ 18:1.1	Scope of This Chapter .....	18-3
§ 18:1.2	The Cost/Benefit Ratio of Foreign Filing .....	18-3
§ 18:1.3	Should the U.S. Specification Be Revised for Foreign Filing? .....	18-4
§ 18:2	The Basic Framework of Foreign Filing for Utility Applications .....	18-5
§ 18:2.1	Claiming Priority .....	18-5
§ 18:2.2	National, Patent Cooperation Treaty (PCT) and European Patent Convention (EPC) Filing Procedures .....	18-5
[A]	Choosing Between Different Filings .....	18-5
[B]	The European Patent Convention (EPC) .....	18-6
[C]	Other Regional Treaties .....	18-7
[D]	The Patent Cooperation Treaty (PCT) .....	18-7
[E]	Delayed Examination .....	18-9
[F]	Duty of Disclosure .....	18-9
[G]	Applicants .....	18-10
[H]	Foreign Associates .....	18-10
[I]	Translations .....	18-10
[J]	Assignments .....	18-10
[K]	Deposits .....	18-11
§ 18:3	Revising the U.S. Application .....	18-11
§ 18:3.1	General Considerations .....	18-11
[A]	Brevity .....	18-11
[B]	Clarity and Consistency, Especially with a View to Translation .....	18-12
[C]	Foreign Filing License .....	18-12

§ 18:3.2	Revising the Claims .....	18-12
[A]	Reducing the Number of Claims.....	18-12
[B]	Revising the Independent Claims .....	18-13
[B][1]	Has the Invention Changed Since the U.S. Filing? .....	18-13
[B][2]	Is the Same Prior Art Available Against the Foreign Applications As Against the U.S. Application? .....	18-13
[B][3]	Does the U.S. Application Contain Independent Claims That Depend Upon Different Features for Novelty?.....	18-14
[B][4]	Definitions in Independent Claims by Reference to Earlier Claims .....	18-15
[B][5]	Can Further Independent Claims Be Added?....	18-15
[B][6]	Who Will Infringe the Claims, and How Will Infringement Be Proved? .....	18-15
[B][7]	Construction of Claims.....	18-15
[B][8]	Should the Claims Include Reference Numerals? .....	18-16
[B][9]	How Many Independent Claims? .....	18-16
[B][10]	Characterizing and Pre-Characterizing Clauses.....	18-16
[B][11]	Issues of the 35 U.S.C. § 101 Type .....	18-17
[B][12]	Special Claim Formats .....	18-17
[C]	Drafting the Dependent Claims.....	18-17
[C][1]	Does the Foreign Specification Include New Subject Matter or Claim Two U.S. Priorities? .....	18-17
[C][2]	How Many Dependent Claims? .....	18-18
§ 18:3.3	Drafting the Description, Drawings, and Abstract .....	18-19
[A]	Reference to the Prior Art .....	18-19
[B]	Summary of the Invention.....	18-19
[C]	Detailed Description of the Invention.....	18-20
[C][1]	Basis for Features That May Be Needed to Limit the Claims.....	18-20
[C][2]	Disclosure of Best Mode.....	18-20
[C][3]	Adequacy of the Disclosure of the Invention .....	18-21
[C][4]	Incorporation by Reference .....	18-21
[C][5]	Non-Metric (Non-SI) Units .....	18-21
[C][6]	Should the Description Include Headings?....	18-22
[C][7]	Drafting a PCT Application Which Is to Become a CIP Application in the United States .....	18-22

## *Table of Contents*

[D]	Drawings .....	18-22
[E]	Abstract .....	18-22
§ 18:3.4	Different Specifications for Different Foreign Countries .....	18-23
§ 18:4	Design Applications .....	18-23
§ 18:5	Innovation Patents .....	18-24
§ 18:6	Conclusion .....	18-24
Exhibit 18-1	Factors to Be Considered When Filing Foreign Patent Applications Based on a U.S. Application .....	18EX-1
Exhibit 18-2	Model Assignment for Use When a PCT Application Containing Added Subject Matter Has Been Filed .....	18EX-3
Exhibit 18-3	Checklist for E-Filing of PCT Patent Applications .....	18EX-5
Exhibit 18-4	Countries Having Utility Model Patents .....	18EX-7

## **Chapter 19 Reissue Patent Applications**

§ 19:1	Procedure for Correcting an Issued Patent .....	19-1
§ 19:2	Introduction to Reissue Patents .....	19-3
§ 19:2.1	What Can Be Accomplished with a Reissue Patent .....	19-3
§ 19:2.2	What Cannot Be Accomplished with a Reissue Application .....	19-4
§ 19:2.3	Intervening Rights .....	19-5
§ 19:3	Procedural Aspects of the Reissue Application .....	19-6
§ 19:3.1	Diligence .....	19-6
§ 19:3.2	Who Can Apply .....	19-6
§ 19:4	Contents of the Reissue Application .....	19-7
§ 19:4.1	Overview of the Contents .....	19-7
§ 19:4.2	Revised Specification and Drawings .....	19-7
§ 19:4.3	Reissue Claims .....	19-8
§ 19:4.4	Reissue Oath .....	19-9
§ 19:4.5	Claim for Priority .....	19-10
§ 19:4.6	Petition to Make Special .....	19-10
§ 19:4.7	Information Disclosure Statement .....	19-10
§ 19:4.8	Other Papers .....	19-10
§ 19:5	Tactical Considerations .....	19-10
Exhibit 19-1	Reissue Application Declaration .....	19EX-1
Exhibit 19-2	Contingent Request for Transfer of Drawings to Reissue File .....	19EX-3
Exhibit 19-3	Consent for Reissue .....	19EX-5

HOW TO WRITE A PATENT APPLICATION

<b>Table of Authorities .....</b>	T-1
<b>Index .....</b>	I-1