

Ten Tips on Preparing and Prosecuting Patent Applications

August 17, 2017

by David E. Rogers

1. Keep Your Eyes on the Prize.

A patent defines a piece of intellectual property. As with a parcel of land, the patent's owner can legally prevent any trespass (called an infringement) on the patent. Analogous to the size of a parcel of land, the size of a patent (usually referred to as its scope) is critical in determining its value. Mistakes can mean the difference between a patent worth millions and a worthless piece of paper. Patents prepared and/or prosecuted with little forethought about the end game, which is commercializing, selling or licensing the invention, often have little value.

Mistakes can mean the difference between a patent worth millions and a worthless piece of paper.

2. Obtaining a Patent Is Not the Goal; Obtaining Broad Claim Scope Is the Goal.

(a) Merely obtaining a patent is not the goal. The goal is to maximize the scope of meaningful patent protection to which your invention is entitled. Put yourself in a competitor's shoes - how would you design around the claims in your patent application? If you can conceive a practical design-around option, modify the claims and plug the gap if possible. By initially preparing narrow claims, or unnecessarily narrowing claims during prosecution, you create design-around opportunities competitors can use to circumvent the patent.

(b) To support broad claim scope, the written description of the invention and drawings should be detailed and thorough.

(c) Patent prosecution is not a "negotiation" with a USPTO Examiner, unless there is a misunderstanding or minor disagreement. The goal is to obtain broad, meaningful claim scope, and not to retreat to unnecessarily narrow claims to placate an Examiner.

3. The U.S. Patent System Grants Rights to the First to File, So File Early.

(a) File as soon as an invention is conceived in sufficient detail to teach others how to make and use it.

(b) Making a prototype of the invention before filing a patent application is unnecessary.

(c) If you develop improvements after filing a patent application, such as when developing a prototype, you can file another application if warranted. Or, the improvements could possibly be protected as trade secrets.

4. The First-Filed (Priority) Application Should Be Thorough and Include Multiple Claims or Examples of the Invention.

(a) Your priority application (even if a provisional) preferably should include a thorough, detailed description of the invention and all required drawing figures.

(b) The priority patent application should include numerous multiple-dependent examples in the specification to define numerous permutations of the invention for use in later-filed applications. This is true even if the earliest-filed application is a provisional. A provisional application with no or a few sketchy claims or examples probably would not support (if challenged) foreign applications claiming priority to it, and may not support a later-filed U.S. utility application.

5. File a Non-Publication Request if Appropriate.

A non-publication request can be filed with a U.S. utility application if the application will not be foreign filed. 37 C.F.R. § 1.213. Not publishing an application has several potential benefits: (a) competitors never see the application, (b) patent trolls never see the application, and one way in which patent trolls search for targets is by reviewing published patent applications, and (c) if a patent never issues from the application, you can potentially protect aspects of the invention as trade secrets.

6. The Patent *Miranda* Warning.

What you say can and will be used against you. This is true for statements in a patent application or in responses to office actions. Here are some general guidelines:

(a) Do not add unnecessary, narrowing limitations to claims. They reduce (or negate) patent scope and value.

(b) Try not to characterize prior art. Quote it and use its figures if appropriate. A mischaracterization could form the basis for an inequitable conduct allegation by a bitter or desperate litigation opponent. The allegation would likely fail, but no need to provide the opening.

(c) Do not use absolute terms, such as “necessary,” “required,” “essential,” or “mandatory” in your patent application or office action responses. Those can limit the scope of the claimed invention even if the “necessary,” “required,” “essential,” or “mandatory” structure or method step is not expressly recited in the claims.

7. Prepare for Appeal.

(a) There is little sense in refiling the same arguments over and over, or to unnecessarily narrow claims and lose valuable claim scope to push something through the USPTO. The response to the first office action should begin to place the application in condition for appeal.

(b) Your arguments and evidence in at least the office action response prior to appeal should argue patentability on a claim-by-claim basis. Add any evidence (such as a declaration under 37 CFR § 1.132) into a response prior to appeal. New evidence cannot be added on appeal unless the Examiner

determines (i) that the evidence overcomes all rejections under appeal, and (ii) there are good and sufficient reasons why the evidence is necessary and was not presented earlier. 37 C.F.R. §§ 1.116, 41.33.

(c) Place the claims in order under 35 U.S.C. § 112 even if the Examiner has not raised a 112 objection, so that on appeal you can (hopefully) focus only on prior-art objections.

(d) Claims cannot be amended on appeal, except to cancel one or more claims or to rewrite an existing dependent claim into an independent form. 37 C.F.R. §§ 41.33, 41.37. So, have necessary claim amendments entered before appeal

(e) Even if you lose on appeal, examination can continue afterwards, and the PTAB decision should provide valuable guidance as to how to amend claims and circumvent the prior art.

8. A Picture Says a Thousand Words.

Use drawings, which can be annotated, in responses to office actions and an appeal brief. The Examiner's time and PTAB's time are limited. Make it easy for them to understand the difference between your claimed invention and the prior art. Preferably identify drawings from your application as an "example" or "one preferred embodiment," and not as the entire invention itself.

9. Taking Multiple Bites at the Apple.

Sometimes maximum claim scope is best obtained in pieces, by taking claim scope allowed by the USPTO and then filing one or more continuation applications to obtain the remainder. If allowed claims have value, take them, obtain an issued patent for them, and file a continuation application(s) to go back for more if warranted.

10. Consider Placing All Allowed Permutations into a Single Application Rather than Filing Continuations.

If numerous claim permutations are allowed in a single application (for example, you have twenty pending claims and claims 2, 5, 9 and 15 are each found allowable) it may be best to pay excess claim fees and include all valuable, allowed claim permutations into that application. If you take only one permutation in the allowed application and file one or more continuation applications to capture the other allowed permutations, the Examiner who allowed the claims may leave the USPTO prior to examination of the continuation application(s). Then the continuation application(s) would be reviewed by another Examiner who could reject the previously-allowed claims.



David E. Rogers
602.382.6225
drogers@swlaw.com

Dave Rogers is a registered patent attorney with over 20 years of experience. He practices patent, trademark, trade secret and unfair competition law, including: litigation and arbitration; trademark oppositions, cancellations and domain name disputes; preparing manufacturing and technology contracts; and patent and trademark preparation and prosecution.