

# The Patent Drafting Process

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## I. The Patent Application Procedure

The procedure undertaken to obtain a utility patent can be readily summarized.

- a) Search Prior Art.
- a) Draft and File the Application.
- b) Prosecute the Patent Application in the PTO.

When the PTO issues a patent, the patent is presumed to be valid. This presumption can be overcome. In fact, a patent owner can bet on the fact that those accused of infringing the patent most often will take a second bite at challenging the patent's validity. Typically, these validity challenges allege:

- a) an insufficient disclosure by the patent;
- b) preclusion of the claims by the prior art; or
- c) some type of misconduct by the applicant during prosecution of the application before the PTO.

All of these potential validity challenges must be kept in mind when drafting a patent application.

## II. Parts of a Patent Application

To be recognized by the PTO, a patent application must contain the following three parts:

- a. a *specification* (again consisting of the written description and one or more claims);
- b. *drawings* necessary to understand the invention; and
- c. a *declaration* signed by each inventor.

## III. Drafting the Patent Application - General Disclosure Concerns

Drafting a patent application is a collaborative process between an attorney and the inventors. It is absolutely imperative that the attorney understand the essence of the invention and what distinguishes it from the prior art. If not, the application faces an increased chance of being rejected by the PTO. As an initial step, a patent attorney will have an inventor complete an invention disclosure form.

Once the initial information is provided to the attorney and the attorney has sufficient information to understand the invention, the attorney will typically begin drafting a patent application by drafting claims that set forth his or her understanding of the invention. Once the attorney feels that he or she has captured the essence of the invention with these draft claims, he or she will begin drafting the other parts of the application. Along the way, the inventor or a draftsman will begin preparing any needed drawings that help explain the claims. In some cases, the drawings may depict prior art items so that a proper distinction between those items and the invention can be made.

During the drafting of the application and the collaborative discussions with the inventors, the claims may change. This is typical and may be due to a desire to distinguish the invention over the prior art or because of a changed understanding of the invention. This thorough understanding is critical for several important reasons.

First, the written description and the drawings must appropriately disclose whatever is described in the claims. If not, the patent office will object to the claims and the written description will need to be revised. Revisions in a filed patent application, however, are a tricky business and no one can ever assume that he or she will have an unlimited right to revise a filed patent application. The Patent Office and counterpart patent offices around the world have very strict rules forbidding new matter from being added to an application. This rule can be summarized as follows: "No New Matter!" If new matter is needed to appropriately describe an invention, then an inventor will face having to file a new patent application to include the new matter. This may not be possible if the prior application has already published.

Secondly, for a patent to be valid it must teach (enable) others having reasonable skill in the relevant art how to make or use the invention. This is the quid pro quo for obtaining a patent. Over the past 20 years or so, several high profile cases have ended in rulings by courts declaring that certain patents did not provide a sufficient disclosure that would enable one skilled in the relevant art to make or use the patented invention and therefore the patents were invalid.

Thirdly, the patent application must disclose the best mode for making or using the invention. Failure to include such a disclosure can invalidate a patent resulting from such an application.

Lastly, as I discuss in more detail in other articles in this library, the patent application must describe an invention that meets the statutory subject matter of section 101 of the patent

law. This is more a problem for software enabled and cutting edge life science inventions. Nevertheless, how one describes the invention in an application can effectively determine whether the invention falls under the definition of statutory subject matter and is thus patentable.

#### **IV. Drafting the Patent Application- Prior Art Concerns**

In addition to the general disclosure concerns, a patent application should be drafted with an eye toward avoiding and distinguishing prior art. Anticipation and obviousness are the most common grounds for rejection of claims by the Patent Office. As pointed out above, later infringers can also challenge the validity of the patent on the basis of prior art.

Recall that a claim is anticipated if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. In deciding if a claim is obvious based upon prior art, a patent examiner must undertake an analysis of the following four factors:

1. the scope and content of the prior art;
2. differences between the claims and the prior art;
3. the level of ordinary skill in the pertinent art; and
4. secondary considerations of non-obviousness.<sup>1</sup>

If a patent drafter finds a possibly anticipating or obviousness reference, then the attorney drafting the application will need to make sure that the claim is drafted with those references in mind. In particular, the application, especially the claims, should distinguish the current invention from what is contained in prior art references. At the same time, the attorney should be trying to obtain for the client the broadest patent coverage available. One way to do this is to write the claims in "independent" and "dependent" format to see how much the patent examiner is willing to give an applicant by virtue of his or her review of those references. An independent claim is a claim that makes no reference to any other claim. A dependent claim is one that refers back to (also said, "depends from") another claim. Because a dependent claim refers back to another claim, a dependent claim contains all of the limitations of the claim(s) from which it depends.

The application is ready to file when:

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<sup>1</sup> Called the "Graham factors" by virtue of their announcement in the case *Graham v. John Deere Co.*, 383 U. S. 1 (1966).

1. the application is drafted so as to completely and accurately disclose the invention, whereby those skilled in the art can practice the invention;
2. the best mode for practicing the invention is fully described; and
3. known prior art considerations have been taken into account

Don V. Kelly  
Evans & Dixon, LLC  
Suite 2500  
211 North Broadway  
St. Louis, Missouri 63102  
dkelly@evans-dixon.com