How to Write a Patent Application

Second Edition

by Jeffrey G. Sheldon
(Sheldon Mak & Anderson, Pasadena)

This release expands and updates your treatise with practical information on the following topics and more:

**Priority based on foreign applications:** The usual time limits for claiming priority based on a foreign application may be extended by two months if the delay was unintentional. See § 2:8, at note 109.

**Mental processes as unpatentable:** According to the Federal Circuit, a patent for a computer program that helps doctors select treatments for patients was invalid because it claimed nothing more than a computerized version of routine mental processes used by doctors (*SmartGene, Inc. v. Advanced Biological Laboratories*). See § 6A:3.1, at note 12.1.

**Laws of nature and natural phenomena—PTO’s March 2014 guidelines:** The Patent Office issued guidelines for application of Supreme Court decisions dealing with the patentability of laws of nature and the like, including *Association for Molecular Pathology v. Myriad Genetics, Inc.* According to these guidelines, if a patent claim involves a law of nature, natural principles, natural phenomena, or natural products, the claim as a whole must recite something “significantly different” from those four concepts. In general, to be significantly different, a claim needs to add “significantly more” or include features or steps that demonstrate the claimed subject matter is “markedly differently” from what exists in nature. The guidelines identify six factors that weigh towards eligibility and six factors that weigh against eligibility. See § 6A:4.4.

**Method claims:** A disadvantage of method claims is that they are subject to patent exhaustion. As the Federal Circuit noted in *Keurig, Inc. v. Sturm Foods, Inc.*, method claims are exhausted by an authorized sale of an item that substantially embodies the patented method if the item (1) has no reasonable noninfringing use and (2) includes all inventive aspects of the claimed method. See § 7:5.4, at note 202.1.

**Using independent claims of intermediate scope:** The author explains why he believes that in addition to the broadest independent claim, it is desirable for the application to have additional independent claims of intermediate scope. Among other things, the U.S. filing fee pays for three independent claims, so it makes sense to include such independent claims because it is easier to assert an independent claim in litigation than a dependent claim. See new § 7:5.9.

(continued on reverse)
Use of “and” and “or”: The use of “and” and “or” can create problems, and thus must be used carefully. With regard to “or,” for example, a claim limitation requiring “search . . . for . . . magnitude or frequency” was not infringed where an accused device searched for both magnitude and frequency, the claim being interpreted as being limited to searching for one of the two parameters. And regarding “and,” does “at least one of A, B, and C,” where each of A, B, and C represents multiple possible compounds, mean that there has to be one composition from group A, one composition from group B, and one composition of group C, or just one composition from any of groups A, B, and C? Using “and/or” might be a way around some problems, but the Patent Office has not endorsed that expression. See new § 7:5.27.

Design patents: In High Point Design LLC v. Buyers Direct, Inc., the Federal Circuit identified various factors that help determine whether a claimed design is dictated by functional considerations, including whether the protected design represents the best design, and whether advertising touts particular features of the design as having specific utility. See § 10:1.2, at note 19.1.

Chemical patents—written description requirement: A disclosure that was too narrow in view of the breadth of the claim occurred where six specific alkaline salt cations were disclosed, and the applicant introduced a claim directed to all alkaline cations. This was held not to be supported by the specification (AstraZeneca AB v. Hanmi USA, Inc.). See § 15:3.1, at note 4.1; see also § 16:4.2, at note 48.1.

PCT searches: The choice of searching authority—PTO, EPO, or Korean, Australian, or Russian Patent Offices—is driven by such factors as the competence of a searching authority in a particular technology, whether the searching authority will actually search a particular technology, and cost. Russia tends to be the least expensive searching authority, but may produce references in Russian that need translating. See § 17:2.2[D].

Exhibits: Updated or new exhibits in this release include Exhibit 4-1 (Checklist for Patent Protection Evaluation).

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

How to Write a Patent Application
Second Edition

Release #9
April 2014

REMOVE OLD
PAGES:

☐ Title page to 2-40
☐ 4-1 to 4EX-8
☐ 6A-1 to 7-121
☐ 8-1 to 8-88
☐ 10-1 to 10-20
☐ 11-1 to 11-16
☐ 14-1 to 14-38
☐ 15-1 to 17-21
☐ T-1 to I-50

INSERT NEW
PAGES:

☐ Title page to 2-40
☐ 4-1 to 4EX-6
☐ 6A-1 to 7-124
☐ 8-1 to 8-88
☐ 10-1 to 10-21
☐ 11-1 to 11-16
☐ 14-1 to 14-38
☐ 15-1 to 17-21
☐ T-1 to I-50