How to Write a Patent Application
Second Edition

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

**Micro entity status:** A trap for the unwary is that an institute of higher learning, as the applicant, does not qualify for micro entity status. However, an applicant can qualify for micro entity status where the applicant has an obligation to assign the invention to an institute of higher learning, or actually makes such an assignment. See § 2:3.4, at note 41.

**Patentable subject matter:** The Patent Office issued its 2014 Interim Guidance on Patentable Subject Matter Eligibility, December 16, 2014. See new §§ 6A:4.4 and 6A:4.4[A]. Although the 2014 guidelines supersede 2009 guidelines on the same issue, there is much in the earlier guidelines that continues to be helpful in drafting claims that the Patent Office will likely consider as directed to patentable subject matter. See § 6A:4.4[B].

**Indefinite claims:** Applying the Supreme Court’s 2014 *Nautilus* decision, the Federal Circuit in *Interval Licensing LLC v. AOL, Inc.* held the term “unobtrusive manner that does not distract a user of the displayed device” to be indefinite because the “unobtrusive manner” phrase is highly subjective and, on its face, provides little guidance to one of skill in the art. See § 7:2.1, at note 2.

**Functional language in claims:** As illustrated in the Federal Circuit’s *In re Giannelli*, a particular advantage of using “adapted to” is that it can be construed to mean a particular structure is “designed or constructed” to be used a certain way. Thus, such a claim distinguishes prior art that has a mere capability of performing a specific function where it would be necessary to modify the prior art to perform the function. See § 7:3.5[A][4][b], at note 97.1.

(continued on reverse)
**Specification:** In writing the background section of the specification, do not be specific about problems solved by the invention. Among other things, identifying a specific problem in the background can result in a narrow claim construction, namely one limited to an invention solving the specific problem. For example, in a 2014 case in the Federal Circuit, the term “secure communication” was interpreted to require anonymity—discovering the identity of a participating terminal—due to statements made in the background (*Virnetx, Inc. v. Cisco Systems, Inc.*). See § 8:5.8[B], at note 164.1.

**Information disclosure statement:** As the Federal Circuit indicated in *American Calcar, Inc. v. American Honda Motor Co.*, the disclosure of the prior art in the information disclosure statement must be complete and must include the material portions. An incomplete disclosure can result in a finding of inequitable conduct. See § 9:4, at note 43.2.

**Biotechnology applications:** To avoid overly broad claims, be careful in using “comprising” as a transitional phrase, particularly in the body of a claim. Use of “comprising” can create enablement issues in that everything within the scope of the claim needs to be enabled. For example, a claim reading “comprising specific loci X, Y, and Z” was invalid because it included not only the specific loci recited in the claim but also all products that contain those specific loci, and failed to enable the scope of the claim (*Promega Corp. v. Life Technologies Corp.*). See § 16:5.1, at note 113.1.

**Reissue applications:** A reissue application has to be for “the invention disclosed in the original patent” as required by 35 U.S.C. § 251(a). It is not enough that the invention might have been claimed in the original patent because it was suggested or indicated in the specification. See § 18:2.2, at note 7.2.

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

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