PATENT PROSECUTION: ADVOCACY IN THE U.S. PATENT & TRADEMARK OFFICE

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PATENT PROSECUTION: ADVOCACY IN THE U.S. PATENT & TRADEMARK OFFICE

A CASEBOOK AND TRAINING MANUAL

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Chapter 1

PREFACE

This book focuses on advocacy. Parts of the book are similar to a traditional law school casebook. A study of patent prosecution that is not grounded in case law is too shallow. Other parts are hypothetical examples for illustrating principles, without which the study is too ethereal and abstract for the practical job of patenting an invention. Other parts are problems with suggested solutions, like in an engineering, science, or math textbook, to drive the principles home. Finally, some parts are about elevating the practice over rote, advanced technical writing style that is too common.

A few principles about this book and the field of patent prosecution will be helpful in digesting the contents of this book and understanding the corresponding course of study.

The concepts in this book constitute the basic tools of patent lawyers. For most students, studying with this book will be atypical, as the student is required not to merely understand some of the concepts in this course, but to master and internalize each of them.

This book is about advocacy in a specific way. Its target is to practice before the United States Patent and Trademark Office, but the book's real, and lofty, goal is to develop trusted advisors. Even though this book naturally focuses on the basic functions of a patent practitioner; mastering the technical skills for drafting and prosecuting patent applications, even though necessary, is insufficient for a practitioner to be more than a technical writer. There is no substitute for the probing and hard thinking required for effective advocacy.

To illustrate this point, consider the value to a client of the following work. A young lawyer receives information about a technical development from a company and is asked to prepare a patent application. The company is moderately sophisticated in patent matters and requests a prior art search. When the search uncovers a prior art reference that discloses all but one element (X) of the invention, the lawyer discusses the differences between the claimed invention and the prior art reference and then crafts a patent application to emphasize the undisclosed element X. After some prosecution, a patent is granted with claims of moderate scope.

Many patent practitioners would consider this to be excellent representation and a positive outcome, as the client received a patent that covers the product and is apparently of full scope. But consider these additional facts. The subject matter of the patent application is many times more important than any of the other client's products, but no one followed up with the inventors to capture improvements, broaden the initial claims, or investigate capturing related subject matter, such as tooling and methods of making, intermediates, etc. Further, the prior art reference

issued to a competitor of the client and had broad claims that arguably covered the client's product. The young lawyer did not know the client's business, so he didn't appreciate the commercial threat. He was not asked about freedom to operate, so he didn't look at the claims of the reference, nor did he search for additional patents assigned to the same competitor. The client would have preferred to pay more for the lawyer to perform more work on this subject matter, but the patent prosecutor's inattention prevented it, to the detriment of his client.

Before beginning, an explanation of the case excerpts in the book: cases have been heavily edited and citations in the case text have been nearly entirely eliminated for improving readability and brevity. Citations have been omitted even where the text of the case includes a quotation; the purpose of the cases in the book is to explain the rules and principles as efficiently as possible. String cites in quoted portions of the Manual of Patent Examining Procedure, however, have not been omitted because those cases are often cited by patent examiners.

Finally, patent lawyers and agents speak their own language. Jargon is so commonplace that practitioners forget that it is jargon. There are many adequate glossaries or Wikipedia entries that can help a student understand the jargon.