THE GACHE LAW FIRM

WHAT INFORMATION IS NECESSARY FOR THE PATENT ATTORNEY TO DRAFT A PATENT APPICATION?

Drafting a patent application is a complex process requiring the hired patent attorney to assimilate and comprehend an invention's overall workings in relation to prior similar inventions and to understand the operation and interaction of the invention's critical elements. The attorney then constructs a written specification of the invention of sufficient detail to satisfy the U.S. patent laws and adequately protect the applicant. The applicant, who is usually also the attorney's client, must work closely with the patent attorney to provide sufficient information to the attorney in order for him to successfully accomplish these tasks.

The basic components of a patent application are: (1) the specification, which concludes with one or more claims, (2) drawings, if necessary to understand the invention; and (3) an abstract. The specification must include a discussion of the field of the invention and of the pertinent background art. The discussion of the background art must be sufficiently detailed to demonstrate to the United States Patent and Trademark Office ("PTO") that the invention for which patent protection is sought is an advance over existing technology. If applicable, the problems involved in the prior art that are solved by applicant's invention should be discussed. Further, if particular prior art references such as publications or patents are particularly pertinent to the invention, or if they are helpful to providing the reader with an understanding of the background of the invention, they should be mentioned and discussed.

The specification further includes a detailed description of the invention. The invention must be described in sufficient detail to enable those skilled in the particular art to make and use the invention. Lack of a sufficiently detailed description may result in rejection of the application or invalidity of the patent later on, if one is issued. Further, the application must set forth the best mode contemplated by the inventor for carrying out the invention. Drawings are required if they are necessary to an understanding of the invention.

If a non-provisional patent application is being file, the specification concludes with one or more claims. A claim is a legal description of that which the applicant claims as his or her invention and is the cornerstone to the value of any issued patent. Patent attorneys work very hard to obtain the broadest possible protection for the invention through the claims submitted in the application. A claim will be allowed by the PTO only if it defines an invention that is: (1) new, (2) useful, and (3) not obvious to a person of ordinary skill in the pertinent art over that which already exists in the art.

In order to assist the patent attorney in preparing a patent application to describe and define your invention, you should provide him or her with copies of patents or any other

publications which describe the prior art in the field of the invention. If such publications are not available, you should draft a summary of the state of the prior art and provide an explanation of how your invention differs from the prior art, full discussing the aspects of the invention that you feel are novel. Illustrations or photographs clearly showing the invention are always helpful and often necessary. The illustrations may simply be hand-drawn sketches, but should be annotated appropriately to help the patent attorney understand the novel and critical features of the invention's operation. Since the PTO has very narrow guidelines on the of patent application drawings, drawings prepared by an applicant are rarely submitted in a non-provisional application, but nevertheless are still important as a learning aid for both the patent attorney and the patent attorney's draftsman. Marketing brochures of an invention such as information included in sales brochures are typically of limited value to the patent attorney because they focus on the saleable features of the invention and do not adequately explain the functional operation of the invention.

Finally, keep in mind that while patent attorneys are skilled in taking information from inventors and crafting an acceptable written application, they usually do not have much background understanding of the particular art in which the inventor may have spent his or her whole life. The inventor should never assume that the patent attorney knows as much or more about the invention than the inventor themselves. This is why the patent application drafting process is almost always a learning experience for both the inventor and the attorney.

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