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ARTICLE

TELLING A STORY: The What is It & Who Cares Approach to Drafting a Patent Application

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Writing a patent application has changed enormously since the early days when an inventor had to provide a working model of the invention he wanted to patent. As more applications were filed for methods of making new chemical formulations and then for processing materials for new uses, application drafting moved to a recitation of what patents others had, then a summary and references to figures of a device or process the inventor wanted to patent. These patents fortunately tended to be short.

Back in the 1980s, a trip to the US patent office was often for the purpose of scanning through stacks of patents categorized into “shoes” - boxes that could be removed from what looked like walls of small drawers. Enter the computer and the world - and the Patent Office - changed. It is still changing. Now everything is computerized, on the internet and in the cloud. The boundaries of what is patentable have also changed, and there are difficult questions asked when one tries to patent new technologies.

When scientists first started to genetically engineer organisms and create tissue constructs and stem cells from differentiated cells, a basic question was whether the resulting organisms (such as Dolly the sheep), tissue constructs (such as the famous ear on a mouse) or engineered cells constituted patentable subject matter. While there have been court decisions since in which judges have tried to determine what rises to patentable subject matter, and how such patents can be enforced, there are now questions about whether one can patent “artificial intelligence” (“AI”), computer programs that can function without human intervention, and their use to create art, to write stories, and even to make new inventions, and even if AI can infringe a patent.

For a patent attorney, the job is a lot simpler: what is the invention and who cares?

A patent is the right to exclude competition from making, using or selling an invention in a particular geographic jurisdiction. While it may seem obvious to a business person, it is easy for an inventor, and for the patent attorney, to lose sight of that critically important concept: competition. Without competition, a patent has no value. Without a product which has value in the marketplace, there is no competition.

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What is an invention? This is defined generally by 35 USC 101: Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title. (See https://www.uspto.gov/sites/default/files/101_step1_refresher.pdf for a more detailed explanation.)

What is a product? Note the distinction between an invention and a product. A product is something that has value in the marketplace - which may be very small or it may be significant. It may or may not be patented. A patented product has greater value because of the ability to exclude competitors from making, using, selling or importing the product for a period of years.

I recently had an interesting exchange with a medical doctor. Despite my repeated and increasingly creative requests for what his proposed product was, he could not answer my question - even though he had demonstrated the method and composition had astonishing efficacy clinically. When I finally asked him what he, as a surgeon, would ask the hospital pharmacy to send him, he immediately responded with a detailed description of the product - i.e., that which would be distributed and sold in the marketplace. One cannot enforce a patent against a doctor for treating a patient, nor against the patient for being treated. Therefore, when one is assessing value, one must determine what is to be sold, and how to increase the scope of the definition of that product so that the value can be increased. This may be by thinking ahead to improvements that may be made or by thinking of ways competitors may “design around” the invention.

As a patent attorney, my “product” is a patent application that one hopes will be issued with broad claims that exclude competitors from making, using, importing and selling that which my inventor has discovered. How do I create an application for a patent that will help to do this, understanding that my audience is not the inventor but initially the patent examiner and any potential optionee, licensee or buyer of the patent?

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First, tell the story: what is the problem to be solved? Why does anyone care (monetary, ease of manufacture, long standing need, failure of others)? What have others tried that failed?

Second, describe the invention. Not how great it is, not how it solves all of these problems, but what is it, how do you make it and how do you use it.

Third, provide an organized description - definitions, materials to make the invention and the invention itself, methods of making, and methods of using, and examples that demonstrate the foregoing and any benefits thereof.

A common and frustrating problem when reading patent applications is that it reads like a list of patents. This will NOT sell a reader on your invention. Indeed, most readers will stop early on and dismiss the application as a waste of time. Another common and equally frustrating problem is when one reads a patent application that repeatedly says how wonderful the invention is, while never telling you what it is. This too leads a reader to consider the application a waste of time.

In summary, be concise, organized, and detailed. Provide the problem to be solved and why a solution to the problem (i.e., the product, which may be a device, composition, method of making, method of using, or combination thereof) is valuable enough to invest in the technology. At the same time explain why it is different from what others have done so that it is patentable and adds value. In short, what is it, who cares, and why is it important and valuable.