

Model Patent Application Specification

Title

Relationship to Other Applications

[If any, for Example: (This application claims benefit of Provisional Patent Application Serial No. _____ filed _____.)]

Field of the Invention

[Here describe the general field of the invention. Usually broadly in one sentence and more specifically in a second sentence – e.g. This invention relates to the generation of electrical power by burning the products of coal gasification.]

Background of Invention

NOTE: Include a statement if invention results from government sponsored research

[Here describe the problem in both general and specific terms. Try for a lay explanation rather than a highly technical description – this is not a peer reviewed journal.]

Describe the current (prior art) solutions that are related to yours and why they are inadequate.

Describe why there is a need for a solution and how your invention solves that need.]

Summary of Invention

[You will see in many patents a listing of "objects" of the invention in the Summary. In my view this is antiquated and neither necessary nor useful. At one time that was thought to add scope to the patent, but with the state of the law today the claims are paramount and the "objects" recitation is not useful. I usually leave the Summary until I have written the broadest claims and use the broad claims as the summary after a brief introductory statement.]

Description of the Drawings (or Figures)

[Brief description, e.g. Figure 1 is a side view of an embodiment of the invention.]

Description of Preferred Embodiments

[This is where you describe the invention. I usually start with a broad scope description, much like the Summary. I then often find it useful to break the invention into parts and describe each part in detail. In this description you want to cover as many variations (embodiments) as you can

think of. It is not a requirement of patent law that you find an optimum solution or an economic one. It is only required that it is new and that it works. Do not neglect to describe all alternatives that you can imagine – however impractical and/or uneconomic they appear to you at the time. Also if you have a range of elements or conditions, describe the broadest range that will work and then narrow it in stages to the preferred range. This detailing of ranges and description of alternatives gives you a basis for modifying the claims during prosecution. You cannot know what the Patent Examiner will cite against patentability of your claims, but you can lay the basis for modifying the claims when you get the first Office Action. Consider the Office Action a guide to modify the claims to obtain allowance – it is not a personal rejection of your work!

Only the claims define your rights. It is only the claims for which you will contend with the patent Examiner.

Here is also the place to place your working examples together with an explanation of how the example proves some aspect of your claimed invention. In chemical and pharmaceutical patents working examples are often required to convince the Examiner that the invention really works. However, you may use hypothetical or prophetic examples – that are not the result of actual experiments but they must be identified as prophetic. The patent Examiner must consider them as if they were actually performed. For apparatus claims examples are not usually necessary – other than drawings illustrating embodiments of the invention. You will notice that the word embodiment is often used – this is "patent speak" for variations of the invention. You are not describing one invention but an inventive concept with many forms or variations – Embodiments!

Finally, it is an absolute requirement of patent law that you describe the "best mode of carrying out your invention." That means that you must describe in the above description the way that you think the invention is best practiced. This is subjective but if there is ever any evidence that you had held back a way to practice that you THOUGHT best, your patent is dead!]

Claims

[Claims are an art form. This is where the trained patent attorney earns his/her keep. (See [Claims1](#) and [Claims2](#)).

The claims define the invention for which you have rights. Generally there will be one to three broad self-contained claims and several dependent claims. Dependent claims refer back to a broad claim, e.g. "the process described in claim 1 wherein this additional limitation applies."

Claims are a word picture of the inventions embodiments (that word again). A claim must be contained in ONE sentence and each element of the invention must be described. There must be an independent antecedent in the claim language for each element.

There are also special "patent speak" words that you need to understand – e.g. "comprising" means that the claimed invention contains the elements described but may contain other elements. "consisting of" or "consisting" means the elements recited and no more.

You should always strive for the broadest claim language possible but have stepped back-ups in the dependent claims. Even if the Patent Office allows your broad claims they may be invalidated by a competitor who finds prior art that would be covered by the claim.]

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