THOMAS, THOMAS, AND THOMAS, PLLP

INFORMATION STATEMENT

NONPROVISIONAL UTILITY PATENT APPLICATION

(ANNOTATED VERSION WITH INSTRUCTIONS)

FROM: [Associate name]

TO: [Client name]

CC: [Senior partner name]

DATE: [Submission date]

RE: [Insert title of invention here]

Instructions from Professor to T-Cubed "Associates":

This is not the form you should draft with. This is your application form annotated with instructions and guidance.

This form is for relevant sections from a nonprovisional utility patent application.

A real patent application would contain additional forms and information, such as transmittal forms; application data sheet; and declaration of entity status. Do not include information for those forms. Instead, for this project, you should only provide the parts requested below. This document, filled out by you, *is* your draft patent application.

Significant guidance is contained in this form. Hyperlinks work. More guidance can be found in a "Checklist" from the USPTO at https://www.uspto.gov/sites/default/files/inventors/Checklist_for_Filing_a_Nonprovisional_Utility.pdf. Further links and tips can be found on the project page at http://www.nathenson.org/courses/innovations/projects/drafting/.

As you work through the sections below, it will be helpful if you compare the form below to an actual issued patent. You are already well familiar with patent no. 6,263,732 for the OXO cup, which can be found here. It's a well-drafted patent, and can give you ideas on how to fill out your application below.

You do not have to format this document in any special way. It is already formatted for you. You do not have to use dual columns or line numbering. Those are added by the USPTO. I suggest you print out this copy for reference, and download the clean copy for drafting.

Be sure to work with your client to make sure your draft accurately reflects their invention.

DECLARATION (See 37 CFR 1.56, 37 CFR 1.63)

[*From Professor:* This section must be filled out and signed by your client, the inventor. It must also be signed by you, the attorney. A declaration or oath is a normal and required part of a patent application, and a very serious one. For you to submit your client's application for credit, you must have your client review the application.]

As the below named inventor, I hereby declare that this declaration is directed to the attached application.

The above-identified application was made or authorized to be made by me.

I believe that I am the original inventor or an original joint inventor of a claimed invention in the application.

I hereby acknowledge that any willful false statement made in this declaration is punishable under 18 U.S.C. 1001 by fine or imprisonment of not more than five (5) years, or both.

Name of inventor (printed): _____

Signature of inventor (in ink): _____

Date signed: _____

SPECIFICATION (IN GENERAL)

[*From USPTO:* The specification is a collection of documents that describe the invention and how it is made or used. It must be written in full, clear, concise, and exact terms that any person knowledgeable in the same technology or science would understand the invention. The written description should not include information that is not related to applicant's invention. . . . The portions of the specification required for this project are listed in subheadings below].

[*From Professor:* You don't put anything under this heading. It is simply a main heading under which other things go, such as Title of the Invention, Background of the Invention, etc. As you work through the parts below, it will help your drafting if you review the cited sections of the **MPEP** and the **USPTO Checklist** and compare them to the **'732 OXO patent**. If you have a clear understanding of the *function* of each part of the application, then you'll be better able to draft the relevant sections of the application. You can also check some of the third-party resources I posted to the project page.].

SPECIFICATION: TITLE OF THE INVENTION

[*From USPTO:* The title should be descriptive of the invention. Don't use a name you would use to brand the invention, rather use one that describes the invention technically. Preferably, the title of the invention should be two to seven words and cannot contain more than 500 characters. . . . The Office will not enter certain words such as "new" or "improved" as part of the title of the invention. See MPEP 606.].

[*From Professor:* Keep it short, simple, and broadly descriptive. Don't use a brand name for your title. Not only is branding prohibited for the title, but it would be bad IP practice to do so, because new inventions for sale should have both a generic and a brand name. You want your invention to show up in the searches done by others so they know about your patent and steer clear. Length: no more than 500 characters, but I recommend it be much shorter than 500.].

SPECIFICATION: BACKGROUND OF THE INVENTION

[*From USPTO:* The Background of the Invention is a way to provide context for the invention. It may include a statement about the technology or subject matter to which the invention pertains and may paraphrase any related patent classification definitions. It should describe any information known to the applicant (including references to specific documents) that are related to the invention, and references to specific problems involved in the prior art or state of technology. See MPEP 608.01(c).].

[*From Professor:* Briefly provide the *field* of the invention (what your client's invention is about) and give a brief description of the *state of the prior art* (what is already out there). One or two sentences for each (field and state of prior art) would be sufficient but you can say a bit more.

You may also note deficiencies or problems of the prior art here. Length: no more than two paragraphs.].

SPECIFICATION: BRIEF SUMMARY OF THE INVENTION

[*From USPTO:* This section should summarize the substance or general idea of the claimed invention. The summary may point to advantages of the invention and how it solves previously existing problems described in the background of the invention. It may also include a statement of the purpose of the invention. See MPEP 608.01(d).].

[*From Professor:* Briefly and generally describe the *purpose(s)* of your client's invention as claimed and how it *solves* any existing problems you identify in the background section. Length: no more than two paragraphs.].

SPECIFICATION: BRIEF DESCRIPTION OF DRAWINGS

[*From USPTO:* [I]nclude a list of all figures by number (e.g., Figure 1, Figure 2) with corresponding statements explaining what each figure depicts. See MPEP 608.01(f).].

[*From Professor:* Brief here really means brief. Format and length: one sentence paragraph for each drawing, such as "FIG. 1 is ****." See the OXO patent for an example.].

SPECIFICATION: DETAILED DESCRIPTION OF THE INVENTION

[*From USPTO:* This part of the specification should explain the invention and the process of making and using it in full, clear, concise, and exact terms. Be sure to distinguish the invention from other inventions. In the case of an improvement, confine the description to the specific improvement and to the parts of it that are necessary to completely understand the invention. The description must be clear and complete enough that anyone working in that technology could make and use the invention without extensive experimentation. See MPEP 608.01(g).].

[*From Professor:* Provide enough detail that you are satisfying Section 112 of the Patent Act. Some patent descriptions are detailed and lengthy. However, for this assignment, keep things on the shorter side, somewhere in the five to fifteen paragraph range. Do not describe the prior art here. Instead, talk about the invention. Make reference in your description to *terms* you use in the claims. Also, make reference to your *drawings* (with **bold** references to the Figures and numbering from the drawings). See the '732 OXO patent for examples of this. The description, the drawings, and the claims all work together to give meaning to your client's patent application. You should also include at least one preferred embodiment (best mode, or best way of practicing the invention).].

ONE OR MORE CLAIMS

[*From USPTO:* Claims define the scope of the legal protection of a patent. Whether a patent is granted is determined, in large measure, by the scope of the claims. The claim(s) must point out and distinctly explain the subject matter that the inventor claims as the invention. A nonprovisional application for a utility patent must contain at least one claim. The claim section must begin on a separate sheet or electronic page and all claims should be numbered consecutively in Arabic numbers. Each claim should be written as a single sentence. Some claims may be dependent on, or limited by, other claims in the same application. All dependent claims should be grouped together with the claims they are related to. . . . See MPEP 608.01(i) through (n).].

[*From Professor:* This will be one of the shortest, but likely most challenging sections of your drafting. See MPEP 608.01(i) through (n) as well as the links I provide on the website with tips on claim drafting. Your claims should start on a fresh page, and each claim should be numbered using Arabic numerals (1, 2, 3, etc.). Remember that each claim is one sentence only, with a preamble, transition, and body. Provide between two and three claims using proper form, with the claims starting on a fresh page. At least one of the claims must be independent. At least one must be dependent on another claim. If you have a third claim, it may be either dependent or independent. Be sure that your description discusses the terms used in your claims. I would further recommend that you only draft product *or* process claims, and not both. If you want to draft both, go ahead, but then you must provide three claims: one an independent product claim, one an independent process claim, and the third would be dependent on one of the other two claims.].

ABSTRACT

[*From USPTO:* This abstract enables the USPTO and the public to determine quickly the nature of the technical disclosures of your invention. The abstract explains what is new about the invention. It should be in narrative form and be limited to a single paragraph. It must begin on a separate page and should be no longer than 150 words. See MPEP 608.01(b).].

[*From the Professor:* Remember when you searched patents? The USPTO suggests the first thing searchers look at on a patent is the abstract and the drawings. Thus, a good abstract provides the "nature and gist" of the invention. 37 CFR 1.72(b). A good starting point for your drafting of the abstract *might* be your client's initial idea this project, amended to more accurately reflect the nature of your invention as-applied and what is new about it. As stated above, one paragraph of no more than 150 words, starting on a fresh page. See MPEP 608.01(b), (I) Guidelines (A through E) give some very helpful tips.].

DRAWINGS

[*From USPTO:* Patent applications are required to contain drawings when they are necessary to understand the subject matter to be patented. Because of this, most patent applications contain drawings. The drawings must show every feature of the invention as specified in the claims. A drawing necessary to understand the invention cannot be introduced into an application after the filing date of the application because of the prohibition against new matter. See MPEP 608.02.].

[*From Professor:* Each drawing should be on a separate page. Do not submit photographs. Your drawings can either be figures or flowcharts. You must use black ink. You can hand-create the drawings, and they need not be done on a computer. I am not scoring you on artistic ability, but your drawings must be made and labeled/numbered neatly. Each drawing needs a label (e.g., FIG. 1, FIG. 2, etc.), and each feature within a drawing needs an Arabic-numeral number (e.g., 100, 102, 104, etc.). Arabic numbering of any feature should be consistent from drawing to drawing (e.g., a feature that appears in both FIG. 1 and FIG. 2 should use the same number.) I recommend that you start your Arabic numbering with 100, and move up in even increments (e.g., 100, 102 104, etc.) That way, if you have to add numbers later on, you have space to use odd numbers between the existing even numbers (e.g., add 115 in between 114 and 116). See the OXO '732 patent for examples. Provide at least one drawing, and no more than three.].

LISTING OF PRIOR ART

[*From Professor:* Starting on a fresh page, include a typed listing (numbered A, B, C, etc.) of all prior art the inventor (and you as their lawyer) is aware of that may impact on the patentability of the claimed invention. See 37 CFR 1.56.]

A. LIST HERE.
B. LIST HERE
C. LIST HERE
D. LIST HERE
E. LIST HERE
F. Etc.

[*From Professor:* On separate sheets following this page, attach printed documentation of the prior art, using tabs or labels (A, B, C, etc.) that correspond to the listing above.]