

Instructions for Reviewing Your Patent Applications

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This memorandum explains the steps you should take in reviewing a draft of your patent application, as well as your duties in regards to providing information that is material to the examination of your patent application by the United States Patent & Trademark Office. Please read these instructions carefully before you begin your review.

WHAT'S IN THE PATENT APPLICATION

The draft application contains the following sections: **Inventors**, **Cross-Reference to Related Applications** (**if any**) **Background of the Invention**, **Summary of the Invention**, **Brief Description of the Drawings**, **Detailed Description**, **Claims**, **Abstract**, and **Drawings**. These sections are briefly described below.

The **Inventors** lists the inventors that have been identified to us. It is essential that all and only those who contributed to the claimed invention be named as inventors. Knowingly leaving out an inventor, or including someone who is not an inventor can result in the patent being invalid. Accordingly, please review the list of inventors and ensure that all those who contributed to the conception of the invention are listed. Those who only implemented (e.g., coded, constructed, or others made) the invention using the conception and design information of others are not inventors. Similarly, supervisors, managers and others who only supervised the inventors are themselves not inventors.

The **Cross Reference to Related Applications** should list a) any other earlier patent application of which the present application should claim the filing date; b) any other patent application that contains subject matter necessary for practicing the invention described in this patent application. If you are aware of any such patent applications, please list them here with

whatever identification you have you, preferably title, serial number, and filing date.

The **Background of the Invention** identifies and describes some of the problems solved by the invention. This section may also describe conventional solutions to the problems and the shortcomings of such solutions. It is not necessary for this section to provide an extensive overview and analysis of technical literature.

The **Summary of the Invention** briefly describes the general concept of the invention in terms of its functions and structure. The Summary identifies the key features that are part of the invention. It does not list every feature or embodiment of the invention.

The **Detailed Description** describes in detail the structure and operation of one or more embodiments of the invention. From a legal perspective, it is essential that this section adequately describes the invention so as to enable a person skilled in the relevant art to make and use the claimed invention, and describes the best mode for carrying out the claimed invention.

The **Claims** identify the exact scope of protection provided by the patent. The claims of a patent are analogous to the legal description in a deed to real property and precisely set out the scope of the invention.

The **Abstract of the Disclosure** presents a one paragraph summary of the subject matter described in this application.

The **Drawings** illustrate the structure and operation of the invention.

HOW TO REVIEW THE PATENT APPLICATION

The patent application must contain sufficient information to: (1) enable one skilled in the art to practice the invention based on the description; and (2) describe the best known mode of practicing the claimed invention.

The requirements for the disclosure of a patent application are set forth at 35 U.S.C. §112 and 37 C.F.R. §1.71.

You must review entire application carefully for technical accuracy and completeness of description of the invention. The application must accurately describe how your invention operates. The application must **completely** describe all of the features of your invention, so that others of skill in the art can fully understand and practice your invention based on the description and the level of ordinary experience and education of workers in the field.

The best mode of practicing the invention is that mode which you, the inventors, presently believe to be ‘best’, given your intended or actual implementation, operational requirements, resources, and the like. It does not mean the objectively “best” implementation. This typically means, but is not limited to, the features of the current commercial implementation.

In order to minimize further preparation of this application, you should make any changes, additions, or corrections where necessary on or in the document itself, as well as to the drawings. If there are any questions included in the patent application, be sure to answer them as completely as possible.

Your input is important because once the patent application is filed in the U.S. Patent and Trademark Office (“USPTO”), we cannot make substantive changes to the application (except for the claims) without losing the benefit of the application’s filing date.

OTHER REQUIREMENTS

The patent application must be filed within one year of:

- the first public disclosure of the invention (*e.g.*, a presentation or publication);
- the first public use of the invention (*e.g.*, a product release, software release, demonstration)
- the first **offer** for sale or the first sale of a product or service incorporating the invention.

If you are aware that these events have already occurred more than one year ago, please let us know immediately. In addition, if these events have occurred within the last year, please provide us with that information (on a separate sheet of paper) when you provide your comments on the draft application.

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