

CHECKLIST FOR DRAFTING U.S. PATENT APPLICATIONS

Scoring: When reviewing others' work, use Grading System
Grading System. For self-review, check off items. 1 = less than adequate
2 = adequate
3 = more than adequate

Score

Title

1. The title is broad enough to embrace any conceivable presentation of invention, e.g., apparatus, composition, article of manufacture, and method claims, if appropriate. _____
2. If the application is a CIP or divisional, the title reflects the newly claimed invention. _____
3. The title is short, preferably seven words or less if filing in PCT. _____

Background of the Invention

1. The Background is concise, is free of extraneous matter, and has a coherent theme. _____
2. The Background is understandable by a judge, jury, or non-expert examiner. _____
3. The prior art is described dryly, factually, accurately, and conservatively, and refrains from characterizing it. _____
4. The Background discloses and discusses the closest prior art. _____
5. The Background is a logical lead-in to the Summary of the Invention and the Detailed Description of the Invention. _____
6. The Background does not describe the invention. _____
7. Continuation status, if applicable, is claimed in the specification. _____
8. Government rights, if any, are noted in the specification. _____

Summary of the Invention

1. The first paragraph(s) of the Summary paraphrases broadest apparatus and method claims only. _____

2. Subsequent paragraphs, if any, describe features covered in dependent claims or more narrow claims and clearly indicate that these features are embodiments of the broad invention, and/or describe advantages of the claimed invention.

Brief Description of Drawings

1. Every drawing is concisely and accurately referenced in the brief description.

Detailed Description of the Invention

1. The Detailed Description starts with the following, or similar form paragraph: In the following detailed description of the preferred embodiments, reference is made to the accompanying drawings which form a part hereof, and in which are shown by way of illustration specific embodiments in which the invention may be practiced. It is to be understood that other embodiments may be utilized and structural changes may be made without departing from the scope of the present invention.
2. If appropriate for understanding of the invention, the organization of the Detailed Description is laid out immediately after the form paragraph noted above.
3. The Detailed Description is coherently and understandably organized.
4. The Detailed Description starts with a generalized overview and proceeds downward through intermediate levels of detail to the greatest detail.
5. The Detailed Description refers to each embodiment as “one,” “example,” or “exemplary” embodiment of the invention.
6. The Detailed Description discloses all known unexpected results or properties, and such results or properties are conservatively characterized.
7. The Detailed Description discloses all known advantages, and such advantages are conservatively characterized.
8. For software cases, copyright notices and disclaimers pursuant to MPEP are included.
9. Prophetic examples are distinguished from actual examples.
10. The specification enables each claimed invention.
11. The best mode is disclosed for each claimed invention.
12. The specification concludes with a recap of the major features and advantages of the inventions disclosed.

Drawings

1. The drawings include copyright notices for software/data cases.
2. The drawings show all apparatus claimed.

Claims

1. For software inventions, there are: method claims; apparatus claims without means-plus-function; means-plus-function claims; program product claims; and data structure claims. If one or more types of claim are omitted, explain why here. _____

2. For electronic inventions, there are: method claims; apparatus claims without means-plus-function; means-plus-function claims; data structure claims; and program product claims. If one or more types of claims are omitted, explain why here. _____

3. Attach a copy of the claims, circle the key definitional terms, and note next thereto where these terms are defined in the specification. _____
4. The Detailed Description aptly and broadly defines all of the above-noted key terms unless the meaning of a term is fully self-evident. If a term is not defined in the specification, note in margin where definition of such term can be found in prior art. _____
5. Key terms are used consistently in the Detailed Description. _____
6. On the attached copy of the claims, note which claims represent the broadest concepts claimed. _____
7. Note here any broad concepts not claimed, and if any, why. _____

8. The claims with the broadest concepts do not include any unnecessary limitations. (Reviewer, please circle suspect unnecessary terms.) _____
9. With respect to each of the broad claims identified above, the Detailed Description discloses an alternate embodiment and/or a range of equivalents. _____
10. Identify on the attached claims a representative group of each type of claim included in the case (i.e., method, apparatus, means, article), with each group having an independent claim and claims dependent thereon. _____
11. For the groups of claims identified above, identify in the margins of the claims where each claim element is clearly supported in the Detailed Description (particularly for means-plus-function claims). Note where method claims are supported by express recitations of the methods in the specification. _____

12. Some of the key dependent claims identified above are used to broaden their respective base claims using the doctrine of claim differentiation. _____
13. For apparatus claims to software, the Detailed Description provides sub-definition of broad functional elements to provide "structure" to the claimed functional element. _____
14. No Jepson-style claims are included unless justified, and preamble material is unquestionably prior art. _____
15. Dependent claims refer to important distinguishing features/essences, and not to obvious matters of design choice unless presented for the purpose of claim differentiation. _____
16. There is at least one claim covering the commercial embodiment of the invention in the form in which it will be sold or used. _____
17. One or more claims are written not for breadth but to establish a broad royalty base on an assembly or system level. _____
18. Note here all inventions disclosed in the application that are not claimed, and the reason therefor. _____

19. Method claims include dependent claims making it clear that steps can be performed in an order different than that presented. _____

Overall

1. The application and drawings are free of typographical errors. _____
2. The application is uniformly formatted. _____

Any further comments: _____

Overall Grade: _____

Application drafted by: _____

Reviewed by: _____ Date: _____