



A GUIDE FOR REVIEWING YOUR DRAFT PATENT APPLICATION

This is a listing of issues you should consider before your patent application is filed. If you have any questions about these or any other issues that might affect your patent application, please contact our office.

1. **PRIOR DISCLOSURE**

Domestic Patent Applications ... The US patent laws allow a grace period of one year from the earliest (a) nonconfidential disclosure, (b) offer to sell, OR (c) actual sale for commercial purposes. If the invention claimed in your draft application or a previous version of the invention (even if you have improved it significantly) meets one of these conditions, please let our office know the details. We may still be able to draft the application and its claims in a manner that heightens your likelihood of a smooth examination.

Loss of Foreign Patent Rights ... Please note that most foreign countries do NOT allow a grace period for filing the application. A prior disclosure or nonconfidential delivery of a product within the invention may forfeit your right to pursue a patent outside the United States.

2. **ADEQUATE DISCLOSURE** ... The US patent laws have several requirements for the disclosure in a patent application. Two are critical to the validity of the patent grant. The first is that the invention must be disclosed in sufficient detail that those with an ordinary level of skill can make and use the invention after the patent grant expires. The second is that the best mode for practicing the invention must be disclosed within the entirety of the application, even if some of the key details are conventional practices. Please review the draft application to ensure that it has an adequate disclosure.

3. **ADEQUATE CLAIM SCOPE** ... The claims at the back of the application represent the elements of the invention that will be protected by the patent grant. Your review of the claims should consider the nature of the invention and the possible competitive threats it might encounter. Good claims recite the fewest elements that form the real "heart" of the invention but which do not encompass the prior embodiments. Often, the elements and advantages of the invention that will be argued for patentability are used in marketing the invention.

4. **PUBLICATION OF YOUR APPLICATION** ... For all regular utility applications filed after December 2000, the US Patent Office will publish the applications online 18 months from the earliest filing date in the priority chain, unless:

- 1) the application is no longer pending by then,
- 2) the application is classified as involving a matter of national security,
- 3) the application has already issued as a patent, or
- 4) the application was filed with a non-publication request.

Importantly, a request not to publish the application can be filed only (i) if the invention has not been or will not be the filed in another country that requires publication and (ii) when the application is filed at the USPTO. A published application can, however, serve as a very nice marketing tool to help you promote your invention. One way or the other, we need to know upon filing the application whether you want your application to be published.