

Introduction to Part I: Identifying the Invention

PART I—*Identifying the Invention*—takes as its central premise that an invention is not a thing, but a concept. We have to know what the inventive concept is to be able to reliably draft claims capturing the invention at its full breadth.

CHAPTER ONE introduces the notion of inventive concept, taking as its example the ballpoint pen, patented in 1888. Also introduced is the idea that the most effective route to the inventive concept is a process that moves forward from the problem the invention solves to identify the inventive solution, not backward from the inventor's specific embodiment(s).

CHAPTER TWO expands upon this concept. It uses the paper clip to illustrate how things can go quite wrong if the analysis of an invention is embodiment-based rather than problem-solution-based.

CHAPTER THREE focuses on the centerpiece of problem-solution invention analysis—the problem-solution statement. A problem-solution statement is a definition of the invention setting forth the problem the inventor sought to solve and the inventor's solution to that problem in terms that are as broad as the prior art will allow. The problem-solution statement provides a foundation for the patent application's broadest claims, as presented in Part II of the book.

CHAPTER FOUR offers ways of analyzing the invention to ensure that the problem-solution statement is not unduly narrow, while CHAPTER FIVE presents the opposite side of the coin. It discusses how we can determine when a problem-solution statement is too broad and how it can be narrowed without being made too narrow. The techniques discussed in these two chapters can also be used when drafting claims.

CHAPTER SIX introduces the concept of the Planned Retreat. The metaphor of the Planned Retreat is a strategy for identifying and prioritizing the invention's fallback features. These are aspects of the inventor's embodiment(s) that can serve as a basis for patentability if what we thought was the broad invention turns out to be in the prior art.