
CONTENTS

PART I IDENTIFYING THE INVENTION

Introduction		3
Chapter 1	Inventions Are Concepts	5
Chapter 2	Begin from the Problem (Not the Embodiment)	11
Chapter 3	The Problem-Solution Statement	19
Chapter 4	The Problem-Solution Statement—Reaching for Breadth	33
Chapter 5	The Problem-Solution Statement—Reining in Overbreadth	51
Chapter 6	Fallback Features and the Planned Retreat	61

PART II DRAFTING INDIVIDUAL CLAIMS

Introduction		81
Chapter 7	Problem-Solution-Based Independent Claims	83
Chapter 8	Inventive-Departure-Based Independent Claims	95
Chapter 9	Intermediate- and Narrow-Scope Claims	123
Chapter 10	Definition Claims	137
Chapter 11	Assembling the Dependent Claims	147
Chapter 12	Claims with Functional Language	163
Chapter 13	Means-Plus-Function	187

PART III
THE CLAIM SUITE AND THE ANTICIPATED
ENFORCEMENT SCENARIO

Introduction	209
Chapter 14	Invention Settings and Direct Infringers 211
Chapter 15	Statutory Claim Types 233
Chapter 16	Claim Diversity 243
Chapter 17	Claim Review with Enforcement in Mind 259

PART IV
PREPARING AND PROSECUTING THE PATENT APPLICATION

Introduction	267
Chapter 18	Writing the Background and Summary 269
Chapter 19	Writing the Detailed Description 285
Chapter 20	Claim Rejections—Amend or Argue? 297
Chapter 21	Claim Amendments 307
Chapter 22	Working with the Inventor 319
Appendix A	Inventive Concepts and Their Problem-Solution Statements 335
Appendix B	An Exercise for the Reader—and the Author 345
Appendix C	Sample Patent 351
Appendix D	Selected Sections of Title 35, United States Code, Effective as of March 16, 2013 355
Glossary	359
Index	363