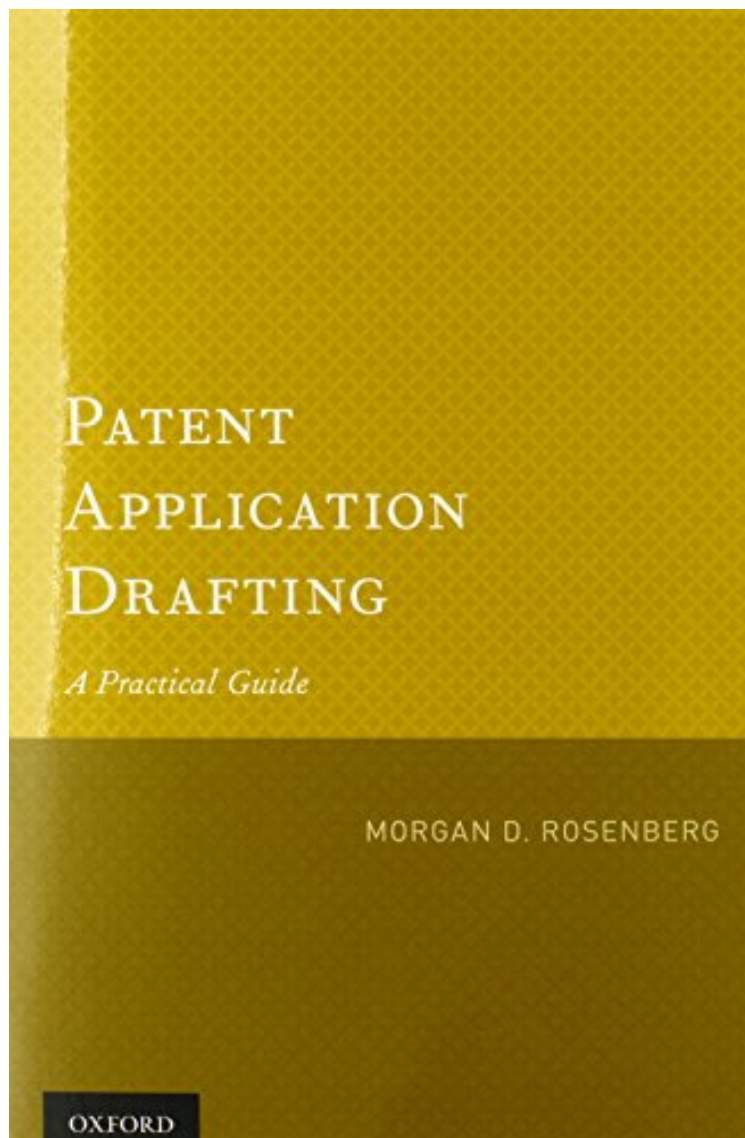


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Patent Application Drafting: A Practical Guide

Morgan D. Rosenberg

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Morgan D. Rosenberg : Patent Application Drafting: A Practical Guide before purchasing it in order to gage whether or not it would be worth my time, and all praised Patent Application Drafting: A Practical Guide:

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practitioner law publishing program from the Oxford University Press, this excellent guide is targeted to the professional needs, mainly of US-based lawyers. UK lawyers too, who advise or operate globally on patent applications, will find this book essential. Also check out the other seven or so titles on patents in this admirable OUP series, (which covers intellectual property, antitrust and media law), from Patent Appeals to Patent Ethics, as well as, for example, Patent Litigation in China. This particular work on patent application drafting is -- and does -- what it says on the cover. It is indeed a practical no-nonsense guide to the entire patent application process from start to finish, including many helpful illustrative examples -- complete with diagrams -- of the kind that the typical patent lawyer will usually encounter in practice. The claims of a patent application, says the author, Morgan D. Rosenberg, are the legal heart of the application and are the single most important part of the entire application both during prosecution and litigation. The book, as he points out in the introduction is full of information, strategy, and tricks (he) learned during what he terms a real-world educational program. Containing examples of virtually every type of patent application, the book delivers the kind of hands-on approach that the author considers to be something of a positive departure from the traditional texts on patent application drafting, which every law firm should have, but which he regards as much too case-heavy. The book is instead aimed at those who ask: how do I do this and I don't care about reasons or theory just yet. Here then is a how to book, ideal for novices and experienced practitioners alike, although those new to the patent application process should derive most benefit from it on either side of the Atlantic. Very useful too, are the research and practice tools; for example, the no less than eight appendices, including a glossary, bibliography, forms and checklists. As 90% of patent practice is drafting applications and responses to the consequent actions, it's a quite obvious conclusion that anyone involved in this complex area of law should acquire a copy. The publication date is cited as at 2012.

The proper drafting of a patent application takes into account technical breadth, legal strategy, conformance with a vast number of rules and regulations codified in U.S. statutory law, guidelines issued by the United States Patent and Trademark Office, and over a hundred years of constantly evolving case law. Present texts on the drafting of U.S. patent applications generally fall into two categories: First are the weighty legal treatises that focus on theory and case law to the detriment of practical information; second are the "patent it yourself" books, which are very basic and limited in scope, and thus not of much use to a practicing patent attorney or patent agent. Patent Application Drafting: A Practical Guide actually teaches the drafting of patent applications from a practical perspective. Intended as an introductory text, it covers the entire patent application and includes many helpful examples illustrating the process from start to finish. It is written for novice patent attorneys, agents, law students, and for those preparing for the patent bar exam.

"I can only hope that each and every novice practitioner and newly minted Patent Examiner is handed this book on their first day. I don't know if reading a book can be considered a form of 'mentorship,' but this book is certainly the best attempt at old-fashioned teaching methods (i.e., the ones that actually worked) I've ever come across." -- RICHARD J. APLEY Former Director of the Office of Independent Inventor Programs United States Patent and Trademark Office About the Author Morgan D. Rosenberg is presently the Director of Middle East Operations at Litman Law Offices in Manassas, VA. As a technical specialist, he writes and prosecutes patent applications. His specialties include claim drafting and analysis, PCT practice, right-to-use/infringement searches and analysis, validity/invalidity searches and analysis, and U.S. patent prosecution. He has written over 500 patent applications and over 500 patent amendments/responses to USPTO Office Actions. He is a regular contributor to Intellectual Property Today. He is also the author of The Essentials of Patent Claim Drafting (Oxford University Press, November 2011), and co-author with Richard J. Apley of Business Method and Software Patents (Oxford University Press, January 2012). Patent Application Drafting: A Practical Guide is the third and final of his practice-oriented guides to the patent application process.