**MEMORANDUM**

**THOMAS, THOMAS, AND THOMAS, PLLP**

FROM: [Associate name]

TO: [Client name]

CC: [Senior partner name]

DATE: [Submission date]

**RE: [Insert title of patent from application here]**

[*Instructions to T-Cubed “Associates”:* This is an annotated version of the memo template provided for guidance. There are no longer separate annotated/clean copies. Instead, use this document but remove or replace bracketed portions as context requires; do not leave my brackets in your final draft of this document that you turn in. Retain the headings provided in the order given; however, you may add subheadings if you believe them to be necessary. Regarding memo length, there is no minimum or maximum length. Be reasonable; I do not want a treatise, but I do expect that the tables added in the 2023 version of this template will lengthen your document by necessity and will likely, as it should, lead to deeper discussion of 102 and 103.]

**I. INTRODUCTION**

[What to do here: You should briefly explain your task and what you are recommending to your client. If you believe the USPTO is likely to allow the patent, say so. If you believe that only some claims will be allowed, say so. If you believe that it is unlikely that the invention can be claimed in a form that can be patented, say so. If you have any recommendation, briefly state it here. In the intro, I also want you to reproduce, in full, and with any typos or errors, the idea submission from the client I originally sent you.]

**II. SEARCHING AND PRIOR ART**

***Search strategy:***

[Explain the overall search strategy you used, including your initial CPC keywords, your main CPC classifications, and which CPC subclassifications you found to be most pertinent. Tell me why you found your strategy to be effective or ineffective and how you refined it to be more productive. Share the other techniques you used (such as internet searching, but do not use Google Patents.)]

***Most Pertinent USPTO/PPUBS Search # 1***

***Parameters: \_\_\_\_\_\_\_\_\_\_\_***

***# of hits: \_\_\_\_\_\_\_\_\_\_\_***

[This section (and the two that follow) is for the most *pertinent* searches (i.e., the one most useful in finding relevant hits) that you ran. (Do not bother giving me details of unsuccessful searches unless you do not have three pertinent searches; first attempts at searching, like initial bike-riding, tends to be less than successful.) For this search, cut and paste into this section the *actual search parameters* you used in PPUBS as shown in the input box. Do not include any individual application or registration records here; they will be attached in full to the appendix. Provide a brief discussion of why this search was effective.]

***Most Pertinent USPTO/PPUBS Search # 2***

[Do the same thing for the second most pertinent USPTO search.]

***Parameters: \_\_\_\_\_\_\_\_\_\_\_***

***# of hits: \_\_\_\_\_\_\_\_\_\_\_***

***Most Pertinent Non-PPUBS Search # 3***

[List your most pertinent non-USPTO searches, using for example, Google, eBay, Amazon, Etsy, etc. Add or delete lines as needed. Provide a brief discussion why these searches were effective.]

|  |  |  |
| --- | --- | --- |
| **Search tool** | **Parameters** | **# pertinent results** |
| [Ex., Google] | [actual parameters] |  |
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| [Add/delete lines as needed] |  |  |

***Most Pertinent USPTO Hit # 1***

Title: \_\_\_\_\_\_\_\_\_\_\_

Reg./app. # \_\_\_\_\_\_\_\_\_\_\_

Pertinent 102/103 date: \_\_\_\_\_\_\_\_\_\_\_

[Regardless of which USPTO/PPUBS search led you to find this hit, list your most pertinent hit here. Discuss why it is potentially pertinent to the validity of your client’s invention. Do not do 102 or 103 analysis here; instead give a brief discussion of why we may need to be concerned about this hit. Note that you may duplicate this subsection as needed; however, I seriously recommend you limit yourself to three pertinent hits max for purposes of this project, or your construction tables and 102/103 analysis will become unwieldy. If there are other pertinent hits you really want to discuss, drop a footnote or contact me.]

***Most Pertinent USPTO Hit # 2***

Title: \_\_\_\_\_\_\_\_\_\_\_

Reg./app. # \_\_\_\_\_\_\_\_\_\_\_

Pertinent 102/103 date: \_\_\_\_\_\_\_\_\_\_\_

[Do the same as above.]

***Most Pertinent non-USPTO Hit # 3***

Title: \_\_\_\_\_\_\_\_\_\_\_

Description \_\_\_\_\_\_\_\_\_\_\_

Pertinent 102/103 date: \_\_\_\_\_\_\_\_\_\_\_

[Same as above. Do not do 102 or 103 analysis here; instead give brief indication of why we may need to be concerned about this hit.]

**III. DISCUSSION OF PATENT APPLICATION**

[*What to do:* Discuss *why* you filled out each part of the application the way you did. If you chose from a number of options, explain why you chose *those* options as opposed to *others*.]

1. **Declaration**

[Discussion goes here. This will likely be a brief discussion unless you had concerns.]

1. **Specification: Title of the invention.**

[Discussion goes here. Explain why you chose the title.]

1. **Specification: Background of invention**

[Discussion goes here. Explain your choices.]

1. **Specification: Brief summary of the invention**

[Discussion goes here. Explain how you approached this.]

1. **Specification: Brief description of drawings**

[Discussion goes here. Explain how you approached this.]

1. **Specification: Detailed description of the invention**

[Discussion goes here. Explain how you approached this and any challenges or difficulties you faced. This is one of the more difficult parts of the application.]

1. **Claims**

[Discussion goes here. The claims are also one of the more challenging parts of patent drafting. Did you claim products, processes, or both? Why? Did you draft only independent claims? Are some dependent? Why? Do the claims do a good job of capturing most or all of the scope of the innovation detailed in the written description?]

1. **Abstract**

[Discussion goes here. Does your abstract accomplish the fundamental goal of informing the searching public of what your invention is about?]

1. **Drawings**

[Discussion goes here. Explain why you approached the drawings the way you did in terms of number, purpose, and perspective.]

**IV. SUBSTANTIVE ANALYSIS**

[*What to do:* In the sections below, provide analysis of the patentability of your client’s invention under each of the categories we have discussed this semester.]

1. **Subject matter (Section 101)**

[*What to do:* Is the claimed invention proper subject matter under section 101 and the cases? Is it a product (machine, manufacture, or composition of matter)? A process? If only some claims satisfy subject matter, explain why. Are any claims potentially barred by a judicial limitation on subject matter (law of nature, natural phenomena, or abstract idea)? For most of you, this requirement is likely met easily.]

1. **Utility (Section 101)**

[*What to do:* Does the claimed invention provide utility as contained in section 101 and the cases? If only some claims provide utility, explain why. For most of you, this requirement is likely met easily.]

1. **Written description, enablement, best mode Section 112**

[*What to do:* Have you provided an adequate written description that enables the PHOSITA to make and use the invention? Have you provided a best mode/preferred embodiment known to your inventor? Remember that a patent is not a detailed instruction manual, but rather should be sufficient to allow the PHOSITA to make and use the claimed invention.]

1. **Relevant Prior Art**
   1. **Claim construction table**

[Below is a template for a consolidated 102/103 claim construction table. I suggest you create a joint table to use for both 102 and 103 analysis and then refer to that table for both analyses below in subsections IV.4.a and IV.4.b. If you need additional tables for your claim # 2 or # 3, then copy, update, and paste the table. I suggest you only discuss the two or three most pertinent pieces of prior art to keep things manageable. I also suggest that here you use a smaller typeface (9 point) to give you more space.]

|  |  |  |  |
| --- | --- | --- | --- |
| **Client’s claim [#1, independent]** | **[Identify PA # 1]** | **[Identify PA # 2]** | **[Identify PA # 3]** |
| [List element by element] | [What is present, either expressly or inherently or by arguable equivalent] |  |  |
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| **Client’s claim [#2, dependent]** |  |  |  |
| **[All elements above +]** |  |  |  |
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| **Client’s claim [#3, independent or dependent]** |  |  |  |
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* 1. **Discussion of novelty (Section 102)**

[*What to do:* In light of the claims and the pertinent prior art you provided, do the claims satisfy post-AIA section 102 and the cases? If only some claims do, explain why. If you had to “design around” the prior art, explain how your claims avoid anticipation under section 102. Also keep in mind that you must attach the pertinent PDFs of the prior art, whether patents, apps, or other things, as exhibits to the memo.]

* 1. **Discussion of nonobviousness (Section 103)**

[*What to do:* In light of the claims and the pertinent prior art and claim construction table provided in the previous section, do your client’s claims satisfy post-AIA section 103? If only some claims do, explain why. If you had to “design around” the prior art, explain how your claims avoid obviousness under section 103. Keep in mind the *Graham* test and the secondary factors.]

**[V. OTHER COMMENTS & INFORMATION]**

[*Optional:* This section is optional. If there are other issues you deem worthy of discussion, include them here]

**CERTIFICATION OF ORIGINALITY & ATTRIBUTION**

*[Instructions: this certification should be the very last thing in your file. Fill it out completely and truthfully. Err on the side of disclosure. Add lines as needed. As noted below, you must attach to it any templates you used, along with annotation of language copied or adapted.]*

I, \_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_ [name printed or typed] certify the following

Subject to the information in the disclosures below, my submission for this project is *original* to me. I have also fully complied with any restrictions or prohibitions contained in the assignment instructions.

*Copies of templates*. **I have attached and marked up copies** of any and all materials I relied upon in the Project, such as applications, registrations, C&D letters, complaints, memos, or contracts. I have also disclosed, attached, and annotated copies of any ideas or materials deriving from use of any Artificial Intelligence. (FoxIt PDF reader is excellent for PDF annotation.) Those materials are also cited below. I have marked these documents up to indicate any language or materials that I used or otherwise relied upon. Below is a listing (*use actual descriptive citations; do not merely provide a URL*). At the end of this certification I have also attached these documents in the order provided below:

1. [Fill out, even if N/A]
2. [Fill out, even if N/A]
3. [Add lines if needed]

*No outside assistance.* I have not obtained any assistance with this Project from anyone who is not a currently enrolled member of this class from this semester.

*Inside assistance.* I disclose and certify that I received or provided assistance to or from the persons named below **[add lines as needed]**.

|  |  |
| --- | --- |
| Persons providing  **assistance to me**: | Nature of assistance, listed in detail |
| [Fill out, even if N/A] | [Fill out, even if N/A] |
| [Add lines if needed] | [Add lines if needed] |

|  |  |
| --- | --- |
| I provided **assistance to**: | Nature of assistance, listed in detail |
| [Fill out, even if N/A] | [Fill out, even if N/A] |
| [Add lines if needed] | [Add lines if needed] |

*No omissions or changes.* I have not knowingly omitted from this certification any source, person, or any type of assistance, whether given or received. Nor have I changed any of the language in this form with the exception of portions that I have been instructed to complete.

*Broad construction.* I recognize that this certification is to be interpreted broadly and includes without limitation: forms and preexisting materials used, as well as me or others reading drafts, suggesting edits, discussing issues, sharing sources, and getting tips.

*Consequences for violation.* I recognize that violation of this certification may lead, without limitation, to a reduced score, a lowered grade for this project or the course, and referral to the academic integrity committee.

Provide an actual signature or an E-signature (for e-sig, do/s firstname lastname/):

\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_

Date:

\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_

**APPENDIX LISTING**

[*Appendix:* This goes after the certification. You must include copies of any materials you used in drafting your application (such as examples of patent/application language taken from elsewhere. You should also include other materials if they are relevant to your memo and not already attached to your draft patent application. You need not attach copies of: 1) prior art, because it should instead be attached to your patent application; and 2) law or USPTO materials cited in your memo, so long as you provide citations.]

1. List item A here; give meaningful title; if patent or app, give title, #, and date of filing, issue, or publication, whichever is pertinent
2. List item B here
3. Etc.

**[EXHIBITS IN APPENDIX START HERE, with tabs or labels: A, B, C, etc.]**

[*Exhibits:* Attach any exhibits to the end of the document, after the listing of exhibits.]