



Podcast Transcript

Wait, what? Sweat the Small Stuff

Date: December 17, 2025

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Run Time: 13:48

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Kattman: Welcome to Wait, what? The podcast that explores the unexpected twists and turns of patent law, where even the most seasoned attorneys find themselves asking, wait, what? In each episode, we shine a light on the surprising, confusing, and sometimes downright frustrating moments that come with navigating the U.S. patent system. Whether you're a new associate, a seasoned practitioner, or just curious about how innovation gets protected, this show is for you.

Today's episode zeroes in on something that seems trivial but can disrupt your patent's prosecution, formatting. From font size pitfalls to the perils of grayscale, these tiny details can trigger rejections even after allowance. It is proof that in patent law, the devil really is in the details. To guide us through these formatting faux pas, we're joined by two attorneys who know the rules inside and out, Laura Gordon and Stephanie Lodise. They'll share real-world stories, practical tips, and

a checklist to keep your prosecution and your issuance schedule on track. So, grab your coffee, your templates, and maybe a ruler, because it is time to dive into Wait, what?

Gordon: Welcome back to Wait, what? The podcast where patent law's fine print meets real-life head scratchers. I'm Laura Gordon, a neuroscientist-turned-patent attorney, and I'm here with my partner in detail, the fabulous Stephanie Lodise. Hi, Stephanie.

Lodise: Hi, everyone. I'm Stephanie Lodise, organic chemist by training, patent attorney by trade, and apparently a connoisseur of formatting issues. Laura, what is on the docket today?

Gordon: Okay. Today we're diving into the kinds of rejections that make you say, wait, what? The ones that have nothing to do with the actual substance of your invention but everything to do with how your patent application is formatted.

Lodise: Laura, have you ever heard of substantial compliance?

Gordon: What is that?

Lodise: It is a contract law concept where a person doesn't fully perform, but they're close enough.

Gordon: Oh, I've never heard of that.

Lodise: You know what? That is okay, because neither has the PTO. The USPTO takes the formatting rules very seriously, and we have some tips to help you comply with the rules and to help you get back on track if your application gets bounced back for improper formatting.

Gordon: Okay, great. But before we get into the details, we're introducing a new segment, the IP IQ pop quiz challenge. And Stephanie, you are our very first contestant.

Lodise: It is so exciting.

Gordon: Since we just had Thanksgiving, I've prepared a few patent law questions with a festive Thanksgiving twist. This is how it works. I'll describe a Thanksgiving-themed invention, you tell me the right answer. Our listeners can play along and see how they match up.

Lodise: Okay, great. I'm ready.

Gordon: Okay, question one. Which patented invention helps hunters by mimicking the courtship ritual of turkeys? A, a turkey decoy with realistic feathers, B, a turkey call device, or C, a decoy designed to simulate mating behavior.

Lodise: Laura, I'm going to go with B, turkey call device.

Gordon: No, that would have been a good one. The answer is actually C. It is a decoy designed to mimic turkey courtship. I've got the drawings up for this patent in front of me. They're really something to look at.

Lodise: Oh, okay. Yeah.

Gordon: So, if our listeners want to take a look at this, it is entertaining. We'll provide a link to this patent in the show notes. Okay, question two. What patented game uses cards with themes like roasted turkey and cranberries to entertain guests while waiting for dinner? Answer, A, peeking turkey paddle game, B, scent-based board game, or C, Thanksgiving trivia card set.

Lodise: Laura, I'm going to say C, Thanksgiving trivia card set.

Gordon: Oh, no. Okay, you're 0 for 2. That is okay. The answer was B, a scent-based board game. You could have good scents, bad scents, mystery scents. I'll let the listener use their imagination what those could be. Sounds like a good time, though.

Okay, your last question. Which quirky patent describes a plate designed with condiment wells to keep your Thanksgiving meal organized? A, an adjustable warming plate, B, a plate having condiment wells, or C, a sectioned serving platter.

Lodise: Laura, I'm going to go out on a limb. Is it B, plate having condiment wells?

Gordon: Okay. Yes, you got it right. Fantastic. One out of three. Okay, it is plate having condiment wells. This is an interesting, it is a design patent. This would be good for kids or those young at heart who don't like to have their condiments mixing in with their main Thanksgiving dishes.

Lodise: Okay. Look, Laura, I have one for you. Bonus question.

Gordon: Oh, no.

Lodise: Are you ready?

Gordon: Yeah. Okay, go for it.

Lodise: What classic kitchen invention, patented in the mid-20th century, revolutionized turkey roasting by signaling when the bird is done?

Gordon: Oh, no. Okay, this would be my grandmother's era, I guess. I'm guessing some sort of thermometer built into the oven?

Lodise: Ah. So close. It is a pop-up turkey timer. It was patented as a thermally responsive signaling device in 1966. It is that little doohickey where you've seen it in the chickens or turkeys. It pops when it is done.

Gordon: Oh, that is great. I could have used that this year, actually. Fantastic. All right, great. Those were some fun Thanksgiving-themed patents, but now let's shift gears.

While those historic inventions were remarkable, today's applicants face a completely different challenge, formatting pitfalls in a patent application specification and figures. Let's talk about the surprising objections that have nothing to do with the invention and everything to do with how your application looks on screen.

Lodise: So, Laura, what are some examples of formatting issues that have made practitioners say, wait, what?

Gordon: In the United States, Section 35 U.S.C. 120 provides for the filing of continuing applications. A continuing application has the same specification as a parent or a grandparent application. So, what do practitioners usually do when filing a continuation application?

Lodise: They file the same exact specification that was filed in the parent, grandparent, or great-grandparent. The specification has already been accepted once, twice before. So how can anything go wrong? We are here to tell you that it can go wrong.

Gordon: Exactly. Rule 1.52(a)(1)(v) is relevant here. That section says the specification must be "presented in a form having sufficient clarity and contrast between the paper and the writing thereon to permit the direct reproduction of readily legible copies" by electronic capture, digital imaging, and optical character recognition. Each paper submitted has to comply with the rule at the time that it is filed. So, digital imaging and OCR technology changes over time at the PTO. So, what might have been accepted before might not be accepted today when you file.

Lodise: So, let's give an example. So, tables, shading in tables. So, maybe six years ago, you filed a specification that had a table with the header row in grayscale. We do that sometimes, right? Makes the table look pretty. The PTO does not recognize pretty. That grayscale shading creates an issue of clarity or contrast. So, that old specification with the shaded table header that might have been accepted previously is going to get bounced today.

Gordon: Oh. So, will the PTO let the applicant know when the specification is first filed whether or not it complies with Rule 52?

Lodise: Usually, Laura, but not always. The specification might get bounced at filing or later after allowance when it is being formatted for issuance.

Gordon: Oh, wow. So, what can the applicant do?

Lodise: If there is time, review every specification before filing it with the PTO. If there is not time and the specification gets bounced for being non-compliant, the PTO will typically give the applicant two months to file a substitute specification. I've seen applications where the applicant had to file a substitute specification after the

examiner flagged a shaded header row that hadn't been flagged in the parent. That same shaded table was in the parent, no rejection issued.

Gordon: So, it sounds like the Patent Office's reputation for nitpicking might be well-founded. Any other items our listeners should be on the lookout for?

Lodise: For sure. Text height in drawings. According to 37 CFR 1.840, all text must be at least 0.32 centimeters or one-eighth of an inch high.

Gordon: So, what does that even mean? Who is taking out a ruler to measure text height?

Lodise: The applicant better be because text that is too short will trigger an objection.

Gordon: So, do we need to find a ruler to guard against a rejection under 1.840?

Lodise: Try thinking in terms of font size rather than centimeters or inches. Point three two centimeters is about 10 points, depending on the font style. Having a 10-point font on all text in a drawing might be challenging if the drawing is a figure or a graph or some other type of data provided by an inventor. You might be pressed for time when filing an application, and you can't check on whether all the font sizes are compliant with the rules. But this is fixable. If your figures get bounced under 1.840, you can resubmit them, maybe just enlarging the originals. Or you might need a patent drawing vendor to assist.

Gordon: Got it. So, will the PTO let the applicant know when the drawings are first filed whether or not they comply with Rule 84?

Lodise: Just like with the specifications, usually, but not always. You might get an objection after allowance when the drawings are being formatted for issuance. I recently saw an application where a reference numeral was four millimeters too short. It measured just 0.28 centimeters. That figure was objected to, and this was after the notice of allowance issued. The applicant there got new drawings that were filed so the application could continue to grant. It is important to be quick in responding to these notices if the applicant does not want to delay issuance.

Gordon: Okay. So, why is the Patent Office so strict about these formatting details?

Lodise: Probably because the USPTO wrote the rules, and we have to fully comply with them. Almost complying just doesn't cut it.

Gordon: And the kicker, these objections can pop up in continuations or divisionals years later, even if the earlier filings were accepted without comment. So, what can practitioners do to guard against this?

Lodise: Here is a short checklist. If you have the time at filing, avoid shading, especially in tables. Stick to plain black and white text. Stick to plain table cells. Also confirm all drawing text is equal to or greater than 0.32 centimeters high.

Gordon: Fantastic. And if you do get a rejection, don't panic. Most fixes involve substitute specs or corrected drawings, and both can typically be put together rather swiftly.

Lodise: So, the moral, in patent law, it is not just what you say, it is how you format it.

Gordon: Thanks for joining us for another episode of Wait, what? If you've got your own out-nitpicking-the-nitpickers story, send it our way. We might feature it in a future episode.

Lodise: So, until next time, keep your specs clean, your tables unshaded, your figs in order, and your drawing text at least 0.32 centimeters high. Don't color outside the lines. Actually, don't color it all if you can help it. That is covered by Rule 84.

Kattman: Thank you, Stephanie and Laura. If you have any questions for Stephanie and Laura, their contact information is in the show notes. As always, thanks for listening to BakerHosts.

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