Comments On The Detailed Description (DD) Drafting Assignment

I.   General

     A.   Many people are really making the effort here and it shows. Thanks for all your hard work!

     B.   Writing the Detailed Description (DD) is not as purely creative as claim drafting, but it's long and grinding and you have to be precise and very , very thorough – remember that you will NEVER have a chance to supplement your disclosure. With the DD, you are aiming for completeness and stocking your arsenal with every potential claim limitation that you may need to fall back on.

     C.   The present invention disclosure is designed to have several issues that arise frequently in practice. There are gaps and there are aspects of the disclosure that are fine for the inventor's purposes, but not satisfactory for yours. It's not designed to be the easiest thing in the world to write. It is designed to try and get you to think and stretch. I think that a number of people are beginning to rise to the challenge and start recognizing and filling in gaps. This invention is about a 6-7 on a difficulty scale of 1-10 and should be pretty representative of what you might encounter in practice.

     D.   I did not mark every error every time – some repeated errors were numerous. Consequently, just because it's not marked doesn't mean its right.

     E.   Don't give me the originals of any of your materials. Assume that any materials that you give to me may get lost or damaged and I might need another copy from you.

     F.   AWK= Awkward

           H= How?

           AB = No antecedent basis

II.   Things to think about

    A.   It sure helps to have a plan of attack (ICOA), right?

    B.   Now that you have written the DD, you would probably have asked the inventor many additional questions during the inventor interview, right? It was only when you got really into writing the DD that you realized that you might not have some needed information. What questions would you ask? How can you be better prepared next time?

- Read the invention disclosure more thoroughly before the inventor interview and recognize the weak points of the disclosure so that you could question the inventor more specifically? More penetrating and exacting knowledge of innovation so that you can recognize what you don't know sooner?

- Mentally form an overall "outline" of how you think the application will go when you read through the invention disclosure the first time and then ask questions to flesh out the outline?

    C.   Recognize the importance of figures. You are really crafting your disclosure around the figures. Consequently, the first step is to try to figure out the point of novelty, then figure out what you have to show in order to enable it, then think about what figures you would like to use for that enabling disclosure. Also, the ORDER of the figures can make a big difference in making your explanation understandable to the Examiner or a jury.

    D.   Recognize that when you discuss a Figure, it can be overwhelming if you attempt to discuss every aspect of its functionality at once. However, you can walk through a simple embodiment or function and then come back to explain more complicated aspects. Possible with a series of flowcharts.

    E.   Now that you have written a complete DD:

        1.   What problems did you catch during your writing?

        2.   How would you have structured your DD differently?

            If you had to start over, what would you start with as first figure?

F. Would you have picked different claim terms after your wrote the DD? Did you then take the time to modify your claims and go with the new claim terms? Don't let your initial claims lock you into a bad disclosure.

G. Do you have a different idea about what "the invention" actually is?

III. Formalities

A. Increase readability by using concept joiners like "also", "additionally", "Thus" and "Consequently" to connect your concepts rather than just reciting bullet points. Also, link to earlier and later figures that describe the elements that you are referencing in more detail. "As described further below with regard to Figure X". "For example" is also effective

B. Recite embodiments using positive, but not limiting language.

No="The X needs …", "entire", "must be", "all X"

C. When drafting, ignore the number grammatically. This also means that you can't have "the transceiver 420" and "the transceiver 430" because they are indistinguishable. Instead include a differentiator in the term like "server transceiver" and "dispenser transceiver"

- Also can't write "device 420's memory". No apostrophes.

D. Try to keep sentences short with clear subject and predicate. Avoid pronouns – just repeat the noun.

E. Drawings

- Must be Dark

- All letters and numbers must be at least 1/8 inch

- Margins of at least 1 inch

- Do not give me any original drawings

- Flow charts must have boxes

- No numbers on top of another element.

F. "Inputted" – I looked it up and it is accepted by Miriam Webster. However, the traditional phrasing is "input" and an Examiner might object to "inputted", which would make you look bad. Also, it might look odd to a client. I recommend using "input" as in "the transmission data is input

by a user"

G. Term "Adspin" should not appear – pick descriptive term that you will also be using in your claim. For example, "start Adspin" could be something like "start image display process". In general, don't use trademarks – they are non-enabling.

IV. Not Getting Where You Want To Go

A. Not A Disclosure

-We need an affirmative, explicit disclosure if the Examiner is going to allow us to incorporate a term in the spec into the claim.

-BAD: "will" "would" "can" "could" "possibility" "should" "intended to" "One alternative embodiment could be …" (as opposed to IS)

- Not Affirmative. Does not illustrate that we had the necessary possession of the invention to meet the written description requirement.

- Also not disclosure – "any of a variety of ways", "May be any number" "could be greater or lesser" "this is just one example" – it is the only one that you disclose, so it is the only one that you can CLAIM! You can disclose other examples and ranges, though.

- Very questionable disclosure - "exists" or "creates" – unless you enable how the creation takes place

B. When you recite that something happens, you must recite HOW it happens, not just the end results. If data is displayed, where did that data come from? How did that data know to be transmitted? How was that data determined?

– What are the functional and structural aspects that ENABLE the thing?

- No - "At a predetermined time", "allows selections to be made", "it is processed", "the server implements", "is associated with" (at least without enablement of HOW)

4

- Warning Flag – watch out for the passive voice – it could be a
warning sign - "X allows selections to be made"

– May be OK for claims, not spec. <u>Spec must ENABLE.</u>

- Warning Flag -"fudge words" – if you see them, look closely to
see if you are really disclosing – Examples "based on",
"processes"

- Also any language that sounds like a human determination like

- need, adapt, collect, facilitated, subject to edit

"reads", "captures", "counts", "gives"

In general any human cognitive or emotional result is likely
not an enabling disclosure.

C.   Don't use legal or claim terms in the DD

-No "said" or "plurality"

May not actually be a disclosure in the DD

-NO "consist", "via"

- "the said" is not right either

D.   Watch the slang - "turns off", "runs" "on board", "filled out"

E.   Data representing vs. actual

- Can't transmit/store "location"– can transmit <u>data representing</u>

F.   Data structure.

- Many students did a great job in keeping track of the data elements and
combining them into data structures for ease of explanation. The figures
that they did were very helpful and added clarity. That was a great
example of developing a tool to make sure you have a complete
disclosure.

G.   Some students realized that they would need some sort of data storage
while the Adspinner was running so that they could track time, distance,
and adds displayed. It's not difficult, but if you just recited these elements
as being on the Adspinner app display without reciting a system that
enabled them to be there (storage, tracking, transmission to phone), then
the picture of the display alone is non-enabling.

H.   One good way to make sure that you have recited an enabled the process is to go through an actual hypothetical example – a sample person going on an Adspinn – or starting an ad campaign.

I.   Lots of people did not disclose all of the invention disclosure – I think this was a time issue more than anything. Take a shot at the network mobilization/push and route optimization in the full patent application.

However, it is getting kind of long, so skip the Divvy Bikes and Dynamic Population Mapping Using Cell Phone Data

(if you already wrote it or are in process, just include it as is)

J.   "known location" vs. "predetermined location data"
"Known" is human level/abstract. Computers do not "know". They retrieve data from a memory and compare the retrieved data to received data to determine if the received and retrieved data match.
- Similarly, a "variable" is an abstract concept – make it data.

K.   Generalized advice – when you feel that something is being fudged and it is uncomfortable/unclear, charge it head on and write something that seems to cover the ground. If nothing else, it makes the issue more apparent for the inventor to review so that they are likely to catch it before you file – you can also highlight it for their review. This is the opposite of the typical "school" instinct of attempting to hide it or gloss over it. Recognize that if you actually succeed in hiding it or glossing over it, you have probably shot yourself and your client in the foot.

L.   Claims – in several instances, students claims no longer agree with their DDs. I think that this is likely a time issue. Please fix it for the full patent application assignment.

M.   One good piece of advice is to think and write at the "data/data structure" level rather than the "conceptual" level. Or, alternatively, if you write first at the conceptual level, then go back and recite how a machine accomplishes each of the conceptual items that you have written.

N.   Several of the applications had some nice features:

- See the Sample DD Drawings

- Feel free to check the other DDs for more ideas – you can adopt strategies from other students, you just have to write/type your own

Next Assignment - Full Patent Application Ready to File! and completed Filing Paperwork

This is the full patent application, including all sections and complying with all PTO requirements

A.   Due date – March 30th

B.   Draft

    1.   Background

    2.   Summary

    3.   Brief Description of Drawings

    4.   Abstract

C.   Revise

    1.   Claims

        Know that when you turn in the full patent application at the next assignment, the claims will be your official claims just as if you had filed them at the PTO. If there is a problem with the claims, then expect a summary rejection from the PTO. We are going for realism and will be as picky as the average Examiner (which is very picky) and looking for an excuse to reject you without mercy.

    2.   Detailed Description (DD)

        All shortcomings in the DD are fair ground for rejection

    3.   Figures

        Must comply with PTO standards as discussed in class

D.   Grading

    1.   When grading the whole application, approximately 60% of the grade will be based on the new sections and 40% of the grade will be based on the DD and claims. Consequently, amend your DD and/or claims to improve them.

E.   Fair Warning!

You will be stuck with the patent application that you turn in for the remaining two office actions. Consequently, make sure that the DD includes everything that you think you might need.

F.   Completed filing paperwork

As a "class participation" assignment, complete the following filing documents for your patent application. The documents are available electronically at the PTO's website or may be printed out from the class materials and filled in by hand. The filing documents should conform to your actual patent application. For example, the fee calculation should reflect your actual number of claims and the attorney docket number should be your secret code

1.   ADS
2.   Fee transmittal
3.   Declaration
4.   Power of Attorney
5.   IDS