

# 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.
- C. The present invention disclosure is designed to have several issues that arise frequently in practice. 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.
- 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.

II. Things to think about

- A. It sure helps to have a plan of attack (ICOA), right?
- B. 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 and the second step is to think about what figures you would like to use to express it. It's a lot easier to use the block diagram rather than the picture drawing, isn't it? Functionality is clearer.
- C. Now that you have written the DD, you would probably have asked the inventor many additional questions during the inventor interview, right? 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?
- D. 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?

For example, some people did an overview figure, but in terms of real nuts and bolts disclosure, most people started with the Achiever, then went to the Redeemer and left the control for last. Some went Achiever-control-redeemer – If you had to start over, what would you start with? Would you start with setting up the control? If you did, then you could explain all of the user profile elements first before you incorporate them into your explanation of the Achiever or Redeemer. If you think about it, most of the system-wide functionality happens in the control. Where does the system really “start”?

Take away: Look for the functional component that underlie other components and discuss the basic components first. You can feel when this happens – You are writing and realize, “hmmm, I am referencing a new functional element that I have not described – it would make a clearer description if I had already discussed how it works”.

- E. Would you have picked different claim terms?
- F. 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. “For example” is also effective
- B. Watch out for statements of criticality – they may be limiting on your claim language. People are still using “must”
- C. Drawings
  - 1. Writing and numbers in the Figures must be large and legible per PTO rules.
  - 2. Do NOT double –side your paper – not acceptable to PTO

### **37 CFR§ 1.52 Language, paper, writing, margins, compact disc specification**

***(a) Papers that are to become a part of the permanent United States Patent and Trademark Office records in the file of a patent application or a reexamination proceeding.***

(1) All papers, other than drawings, that are submitted on paper or by facsimile transmission, and are to become a part of the permanent United States Patent and Trademark Office records in the file of a patent application or reexamination proceeding, must be on sheets of paper that are the same size, not permanently bound together, and:

(i) Flexible, strong, smooth, non-shiny, durable, and white;

(ii) Either 21.0 cm by 29.7 cm (DIN size A4) or 21.6 cm by 27.9 cm (8 1/2 by 11 inches), with each sheet including a top margin of at least 2.0 cm (3/4 inch), a left side margin of at least 2.5 cm (1 inch), a right side margin of at least 2.0 cm (3/4 inch), and a bottom margin of at least 2.0 cm (3/4 inch);

**(iii) Written on only one side in portrait orientation;**

D. No element numbers on top of other elements

E. Do not bold element numbers in text

#### 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.

##### 1. “may be calculated in a variety of ways”

This is not an affirmative disclosure. There is nothing in the statement that we can use as a claim limitation. It is not a disclosure of any specific way

##### 2. “it is possible” “on alternative could be” “will” “would” “can” “could” “possibility” “should” “intended to”

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

##### B. Operation

Don't mix your block diagram and your flow chart

##### C. “Stores the number of steps” – storing “steps”?

## V. Drafting Tips

### A. Strong Oops

Not including everything from the Inventor's disclosure

Strong negative grade factor - it's malpractice, remember?

1. Watch out when you re-draw a figure that you are not losing something or changing the inventor's invention. For example, some people turned the connections between elements in the Achiever and Redeemer into a bus.
2. If you have an alternative embodiment, that's perfectly fine, but disclose the inventor's embodiment too.

B. When choosing names for elements in the DD, remember that the standard that is used when interpreting the DD is the POS. Although you do need to make sure that the claim terms that you are going to use appear in the spec, try to make your primary description based on terms that would be understandable to the POS. For example "computer readable memory" v. "storage"

C. A "software program" is not a structural element. The program does not "receive data". Instead, the program operates the computer/CPU to control how it functions.

## 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 – April 3<sup>rd</sup> – two weeks

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. Spec

All shortcomings in the spec 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 an ungraded “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. Utility Patent Application Transmittal
2. Fee transmittal
3. Declaration
4. Power of Attorney
5. IDS 1449 Form

The inventor’s information is:

Spud Fries (U.S. Citizen)  
First Fitness Circle  
OreIda, ID 123456

Charge the fees to your firm’s deposit account:

Pat, Ent, & Win      10-0000  
The address of your firm is  
the law school’s address.