

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.
- 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. Also, the ORDER of the figures can make a big difference in making your explanation understandable to the Examiner or a jury.
- C. 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 data. 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? Form and 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?
- 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?

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

The structural figures are easier to write, but people then got into writing the QR/GPS functionality and ended up having to say something like "matching the QR code previously stored at the server" -how did that happen? where did that come from? Alternatively, at that point you would be writing "previously stored at the server as shown and described in Figure X, below."

Take away: Look for the functional components 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”.

Additionally, if you re-use portions of system, you can introduce the system preliminarily first and then describe specific uses using flowcharts. For example, introduce the central server and smartphone and mention that the smartphone has both camera and GPS system. Then a first flowchart with regard to the function of the QR process. Then a second flowchart with regard to the function of the GPS process.

- E. Would you have picked different claim terms after you 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.
- 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. “As described further below with regard to Figure X”. “For example” is also effective
- B. Drawings –
 - 1. Reference numbers can only be on top of a drawing element if they are underlined and indicate that element. If they use a lead line, they must NOT be on top of a drawing element. Reference numbers number be outside of any other structure in the drawing.
- C. Claims – skip lines between claims
Claims start on a new page
- D. Brief description of the drawings – just first sentence, not paragraph.

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 ...”

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

Also not disclosures – “any of a variety of colors”

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

No “by means of”, “equivalent”, “enable”, “said” “plurality”

May not actually be a disclosure in the DD

NO “consist”

D. Watch the slang – “captures” image, “turns on”

Is there a better way to say it?

V. Drafting Tips

- A. Learn to recognize when the DD is screaming for a flowchart. Actual quote from application – “X takes place in a series of steps. First, at step one....” Time to add a flowchart if it is complicated.
- B. Watch out for shortcuts. When you are writing and you can see two ways to disclose an element – 1) simply and at a high level or 2) thoroughly and rigorously – you may be thinking to yourself “option 2 is such a pain – do I really have to do it? I can’t see any reason for it.” Recognize that you are really saying that you can’t see any reason for it “right now”. Trust me – if you are suing on the reference and the other side is attacking it, you will probably see the reason at that time, but it will be too late. Why not put in the little extra effort now “just in case” and so that you can be confident in your product?

C. Reminders

Want to disclose everything from the Inventor’s Disclosure

1. Watch out when you re-draw a figure that you are not losing something or changing the inventor’s invention. It may be an alternative embodiment.
2. Put it in there even if it is tough for you to describe.
2. Clients rarely give us exactly what we need because they don’t think the same way and they are focused on different aspects. The best patent attorneys recognize the holes in their disclosure and help fill them in.

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 – 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