

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.
- F. AWK= Awkward

- 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?
 - E. 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.
 - 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. Recite embodiments using positive, but not limiting language.
 - No= “The server does not ...”
 - No= “The server must ...” “must be” “all X”
 - No= “The X is defined as” – very limiting
- C. When you recite that something happens, you must recite HOW it happens – what are the functional and structural aspects that ENABLE the thing?
 - No = “The server finds a match”
 - Use “fudge words” as flags – 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 “recognizes”
 - Passive voice is sometimes also a flag = “the selection is made”
- D. When drafting, ignore the number grammatically. For example: “The server 420” instead of “server 420” is correct. This also means that you can’t have “the picture 420” and “the picture 421” because they are indistinguishable. Instead recite “the first picture - the second picture” or use a more descriptive word “pre-exposure user photo” and “post-sun exposure user photo”

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 disclosures – “any of a variety of ways” “May be any number”

“this is just one example” – it is the only one that you disclose, so it is the only one that you can CLAIM!

Very questionable disclosure “exists” or “creates”

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

No “by means of”, “said” “plurality”

May not actually be a disclosure in the DD

NO “consist”, “via”

Use “for example” instead of e.g. – it is in English and makes it less likely that you will accidentally write i.e., which is to be avoided.

D. Watch the slang – “turns on”

“takes a picture” vs “actuates a camera to record an image”

“gives off” = slang, use “emits”

Also -“look up”, “based off”

E. No trademarks – no Helios – pick a descriptive/functional name for the innovation/component

F. Stop saying “match” – it literally means “is identical to”, which is rarely what you want to say.

V. Drafting Tips

- A. Reciting that “an altered version of the Fitzpatrick scale” is an admission of obviousness. The FS should not be mentioned as part of the invention. It may be differentiated as prior art.
- B. Spell out MED, UV – at least initially.
- C. “Size of one-a-day-vitamin” = no good – use dimensions
- D. Can’t transmit “intensity” – can transmit data representing an intensity
Similarly, “pictures include skin tones” – not quite right
- E. Defining a system that “includes” the sun and the internet
Use for “Fig 1 illustrates” instead of saying “the system includes”
- F. Must recite structural elements so that you can claim them.
Watch out for “application” – not structural - may want to use “processor” or “CPU”
Similarly non-structural - “sun protection model” – use system
- G. Go through examples of the process to clarify and as a check to confirm that you actually have an enabling embodiment. Actually determine the initial MED and total MED dose for an example person.
- H. Only two people used the claim snippet – take a second look
- I. Figures at the end, after claims
- J. “Then uses this information” vs “uses the average pixel color value”
Pronouns are less preferred because they may render the sentence unclear, especially for complicated sentences.
- K. “provides data to application” vs. “enters data using a user interface and the data is then transmitted to a processor in the smartphone”
- L. “illustrates a flowchart 100” - not “a method 100”
- M. Some flags that represent human or conceptual activity that let you know that you may be at the wrong level of disclosure: “device recognizes” “intent” “observable characteristics” “decides” in general any human cognitive or emotional result is likely not an enabling disclosure.

- N. Generalized advice – when you feel that something is being fudged, charge it head on. 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. 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.
- O. I got the feeling in several instances that people learned a lot about the system, but didn’t have time to go back and fix things.

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 3rd – 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. 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