

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
H= How?
AB = No antecedent basis

- 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 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?
 - 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 X needs ...”, “necessary”, “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. Specification-
 - Must number paragraphs in PTO format as in template
 - Do not bold numbers – even page numbers
- E. Drawings
 - Must be Dark
 - All letters and numbers must be 1/8 inch
 - Do not give me any original drawings
 - Must have names in the boxes, not just empty boxes
 - No numbers on top of another element.

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 increased or decreased” “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”

B. When you recite that something happens, you must recite HOW it happens

- What are the functional and structural aspects that ENABLE the thing?
 - No - “At a predetermined time”, “allows selections to be made”, “it is processed”, “adds an appropriate amount”
 - 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. Spec must ENABLE.
 - 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 “recognizes”, “identifies”, “creates”, “decides”, etc.
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 “by means of”, “said” “plurality”
May not actually be a disclosure in the DD

-NO “consist”, “via”

- D. Watch the slang - “turns off”, “runs”
- E. Application/Module/Software is not a structural element. Must recite structural elements so that you can claim them. May want to use “processor” or “CPU”. Just recite what the structural element would do under the control of the software.
 - Similarly non-structural - model, algorithm – use system
- F. Data representing vs. actual
 - Can’t transmit/store “user sensitivity” – can transmit data representing
- G. Data structure.
 - Dealing with each individual data element for substances to be added to the drink can be terrible. However, you can group them into something like “drink additive data structure” or “dispenser control data structure”
- H. Storing data structures in memory
 - Occasionally you have to determine whether the X data that is initially determined to be added to the current drink data structure would cause it to exceed a maximum threshold of X in the last 24 hours. In order to determine that, you would need to know what has been in the drink data structures for the last 24 hours. Consequently, all drink data structures need to be stored with a user ID indicator and a time stamp of dispensing. When you need to check the last 24 hours, you would just access the database of drink data structures dispensed by the dispenser, check the time indices, and sum the X amounts from the data structures in the last 24 hours.
- I. Don’t include the user as part of the system. If you define the invention as “a system for changing a user’s parameters”, you are claiming the user as part of the system. Our system ends at dispenser emission.
- J. 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 with sample readings which lead to a specific amount of additives being distributed.

- K. Lots of people did not disclose all of the invention disclosure – at least not in an enabling fashion. The mobile dispenser should be its own figure. The tDCS, too.
- L. “known quantity” vs. “predetermined stored quantity”
“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 match.
- M. 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.
- N. 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.
- O. 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.
- P. Several of the applications had some nice features:
- One person included mockups of all of the screens
 - One person identified each data element stored in memory at the server by number in the figure. That made it easy for him to discuss.
 - Check the other DDs for more ideas.

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 31st
- 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