

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 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 it's right. If one instance is marked, check your DD for others.
- 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. Possibly 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 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.
- 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"
More examples from this year - all, necessary, all the possible, every data, needed, any
- C. When drafting, ignore the number grammatically. That is, always include the "the" in "the transceiver 420"
- 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 "streetlight transceiver"
- Also can't write "server 420's memory". No apostrophes. Instead "the memory of the server 420"
- 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 flowchart boxes or structural elements
- Figures 1A, 1B – Examiners often don't like and will cause you to re-number

F. It seems like people really increased their understanding of the invention – and ability to track the controlling data – and thus the quality of their enablement – when they completed the flow charts.

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)
 Ex - Can't claim “can be any integer”
- 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 – also “based on” or “generates”
- Watch out for elements vulnerable to means+function determination
 - “unit”, “element”, “user variables”, “a module”

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 computer implements”, “is associated with” (at least without enablement of HOW)

- Ex - “Computer determines the correct intensity and duration”
- 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”, “a certain X”
- Avoid any language that sounds like a human determination.

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

- “queries” – transmits data? receives data? compares data?
- “elicits”

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 - “reckons on”

- No trademarks like “Happy Place”
- “user interface” vs. “app” – user interface is functional and can be claimed. App is non-functional and potentially copyrightable.

E. Data element vs. its contents

- “HRV data” stores an “HRV value”
- Ex “...Determines an HRV value and transmits said HRV value to said computer as current HRV data;”
- “wherein said previous HRV data represents a previously determined

V. Advice and Feedback

A. 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.

B. Use of Flowcharts- also seem to have really helped with understanding – when students were rigorous with reciting each step in a flowchart.

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.

C. 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 the initial intensity determination process – or a later duration determination process.

D. Lots of people did not disclose all of the invention disclosure – I think this was a time issue more than anything. Some items to remember:

- Non-linear duration
- 24 hour max stimulation time
- Non-responsive user
- How the psychological factors work with determining baseline HRV
- Continuous monitoring with the Oura

E. 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.

F. Link to other figures

- Figuring out where to “break out” different parts of the system into different figures can be challenging. One tip is when there are two or more ways/options to determining an element, have a first figure where the element is taken as already having been determined – and then two later figures, each reciting one option with regard to how to determine it.

G. Figuring out where to start –

Some people chose to start their Figure 1 with the psychological factor determination or physiological determination. However, it might be clearer and easier to follow if you recited the system as it was operating in steady state. For example, you can just recite that the system “receives and intensity from the server” – with the determination of the intensity or duration shown in later figures reciting several varying embodiments.

H. What is “intensity”? “Default intensity is 20” means what? Is it enabled?

Always get units. Here, the 40 settings are evenly spaced from 0-24V.

The nVNS device (provided by electroCore, LLC, Basking Ridge, NJ, USA) is a handheld, portable appliance that employs a constant voltage-driven signal consisting of a 1-millisecond burst of 5-kHz sine waves repeated at a frequency of 25 Hz, with stimulation intensity ranging from 0 to 24 V. The device is positioned against the side of the neck below the mandibular angle, medial to the sternocleidomastoid muscle and lateral to the larynx. Stimulations are delivered transcutaneously in the region of the cervical branch of the vagus nerve through 2 stainless steel disc electrodes that are manually coated with a conductive gel.

F. Claims – Claims seem to be considerably better than last time, but in many cases a little more work is needed.

H. Several of the applications had some nice features:

- See the Sample DD - 2228

Also nice -

- Feel free to review the DDs of other students– 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 – April 3rd, Start of class (3pm)

B. Draft

1. Background
2. Summary
3. Brief Description of Drawings
4. Abstract
5. Add Validation section to DD

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

Your attorney number is your secret code. Your correspondence address is the law school’s address and your firm name is Pat, Ent, & Win