

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 you have to be precise and thorough.
 - C. It sure helps to have a plan of attack (ICOA), right?
 - D. 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?
 - E. 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.
 - F. 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.
 - G. For some drawings I crossed out numbers – don't be alarmed, it's just me trying to make sure that the numbers in the drawing match the spec – just ignore my crossing out.
 - H. Double slash means “make it a new sentence” Double slash-P means make it a new paragraph.
 - I. 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. Formalities

- A. Increase readability by using concept joiners like “also”, “additionally”, “Thus” and “Consequently” to connect your concepts rather than just reciting bullet points
- B. Watch out for statements of criticality – they may be limiting on your claim language. People are still using “required”, “necessary”, “needs” “obviate” “eliminate”
- C. Drawings
 1. A small amount of text inside a block in a block diagram or inside a step in a flowchart is necessary - you can't just number an empty box
 2. Writing and numbers in the Figures must be large and legible per PTO rules.
 3. Only one drawing per figure.
 4. It's a lot easier to use the block diagram rather than the picture drawing, isn't it? Think about why. Then think about what you will be looking for for drawings in the future.
 5. “Means” and “consist” should not be recited in the DD
 6. Write the DD as if the numbers were not there
NOT “communication processor 260”, but
“THE communication processor 260”
 7. Don't number multiple elements with the same number in a single drawing. For example – don't number 5 things as “X 120”
 8. Trying to discuss multiple figures at the same time is often very unclear, especially if the figures have different content. Break them up.

III. 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 attached 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”

“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.

3. “the cell phone is bonded” – Elmers?

B. Operation

It may be helpful to break the operation into separate stages based on function rather than talking about a specific element’s multiple functions. For example, in the block diagram, trace once through all with way with power and then trace once through all the way with signal. Trying to talk about both at the same time can get confusing.

C. Not right

“The USB Port sends the information”

“The USB port powers”

D. Wikiwalker is not a functional description and consequently is not relevant for our patent disclosure. Mentioning it in the title, but never in the DD was also strange.

IV. Drafting Tips

A. Strong Oops

Not including everything from the Inventor's disclosure

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

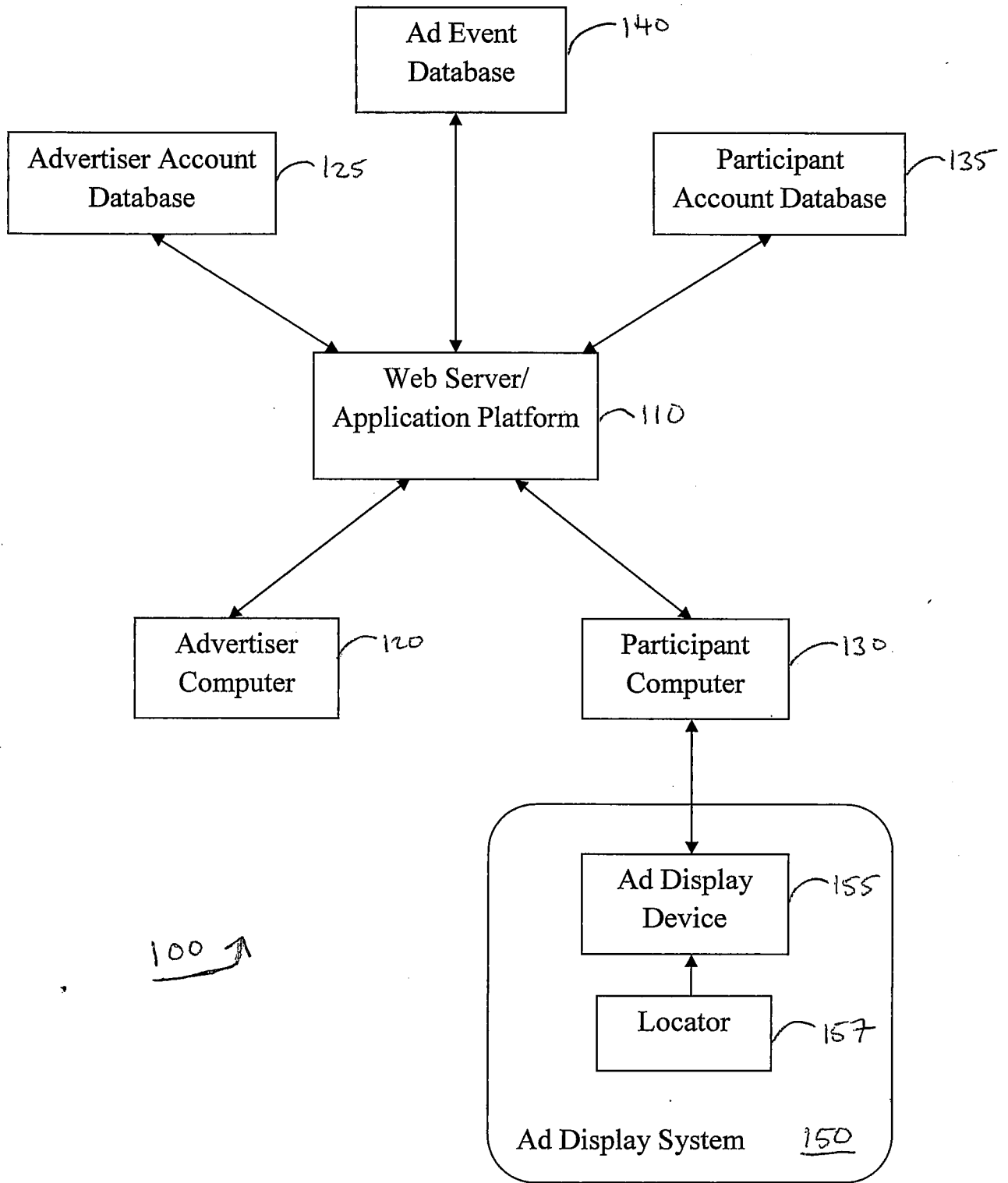
1. Watch out when you re-draw a figure that you are not losing something or changing the inventor's invention. Some people turned a transceiver (transmitter and receiver) into a receiver.
2. If you have an alternative embodiment, that's perfectly fine, but disclose the inventor's embodiment too.

B. Figures

The order of the figures makes a big difference in the clarity of your product. It's hard to talk about elements that you have not yet introduced.

1. Many people went with the inventor's "picture" drawing first. That's actually not a very good one to go with. Think about why you chose it. Were you thinking that my specification should disclose the invention, so here's a picture? What about describing function or giving a top-down description of the system as a whole? (See Example)
2. The best drawing to start with is one that gives an overall view of the system so that the reader can have a frame of reference of where the rest fits in. We then use later drawings to drill down.
3. I gave you last year's example which has a drawing of the overall system, but the inventor did not give you a drawing of the overall system this year. However, only a few people picked up on it. Now that you have written the DD, can you see how much easier it becomes to start at an overall system level?

Fig. 1



QUESTION: If you had it to do all over again what would you do differently?

A. Always reflect and think about what went well and what did not

B. Would You:

1. 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?
2. Probably have handled the figures a lot differently?
New figures? New order of figures?
3. Have chosen different terms for the claims? Have a different view about what "the invention" actual is?

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 28th – 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:

Leroy Jenkins (U.S. Citizen)
1337 Speak Dr.
Urbana, IL 61801

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.