

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?
 - 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=”In all embodiments of the invention, ...”
- 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 = “Light is emitted according to a profile”
 - Use “fudge words” as flags – if you see them, look closely to see if you are really disclosing – Examples “processes” “operates on”
 - Passive voice is sometimes also a flag = “the selection is made”
- D. A system does not “begin” – a process begins, but a system is structural
- E. “AB” = Antecedent Basis – if you just start talking about something without describing where it comes from, there is no antecedent basis
- F. When drafting, ignore the number grammatically. For example: “The server 420” instead of “server 420”

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 ways”

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 on”

E. “Application” and “Icon” are not structural

-However, “display” is structural and “processor” or “CPU” is structural.

V. Drafting Tips

A. Recognize that the signal that travels from the smartphone to the LED goes through many forms and includes different information depending on where in the chain it is. For example, at the “button press” all you have is an indication of the location on the screen that has been pressed – the CPU then correlates the location on the screen with a selection. The CPU then sends an indication of the selection to the router and from there to the server. The CPU receives the indication, compares it to several stored choices, identifies the choice indicated in the indication, retrieves the lighting information associated with the indication and sends the lighting information through the router to the bulb (I am writing this in an abbreviated fashion).

-Note that the information that passes between the smartphone and router has a very different informational content than the information passing between the server and the bulb. They should not be called the same thing. They have different functions and impacts. Some people still want to call them both “profile” and treat them the same – this is not correct.

B. 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.
3. Did you include the alternatives for depression and ultraviolet?
4. Alternatives of light profiles stored on phone vs. at server? If so, did you recite how the profiles got onto the phone in the first place? Download profiles to phone from server when application initiated?

5. Did you enable how the gradual change in light output is accomplished? Did you include a timer as an element at the server? It would likely be necessary to allow the server to send a command at a start and stop time as well as to keep a profile on for a specific time.
6. Some people still had trouble with “emitting a light profile” vs. “emitting light” or “A light profile is transmitted from the server to the LED bulb where it is emitted”

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. 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 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