

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.
- C. 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.
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.
- 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?
- 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?

The website setup?

High-level overview drawing – and wait with details?

Take away: Look for the functional components that underlie other components and discuss the basic components first. You can feel when this happens – You are writing and realize, “hmmm, I am referencing a new functional element that I have not described – it would make a clearer description if I had already discussed how it works”.

- E. Would you have picked different claim terms?
- 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. “For example” is also effective
- B. Drawings –
 - 1. Reference numbers can only be on top of a drawing element if they are underlined and indicate that element. If they use a lead line, they must NOT be on top of a drawing element.
 - 2. “Plan view” is only for physical objects, not website displays
- C. Claims – skip lines between claims

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”
Not Affirmative. Does not illustrate that we had the necessary possession of the invention to meet the written description requirement.

B. You need to disclose the preferred embodiment/best mode - in all of its highly-specific specific glory. It’s the exact opposite of what you do with the claims – and I could feel a conflict with some people. If you want support for a higher level of abstraction, you include a first drawing showing the preferred embodiment/best mode to satisfy that requirement, and then you include a second drawing showing a more abstract representation. You don’t neglect the best mode requirement or worry that your claim scope is going to be limited and just show the abstract representation. In the claims, we broaden scope by including less. In the DD, we “broaden” scope by including more – an additional example.

Example - “First data collection device” “Second data collection device”

What do these actually disclose of the preferred embodiment?

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

No “by means of”, “equivalent”, “enable”, “said” (OK in claims)

D. Watch the slang – computer program “runs”, “personal carbon output”

V. Drafting Tips

A. Strong Oops

Not including everything disclosed by the Inventor's

1. Watch out when you re-draw a figure that you are not losing something or changing the inventor's invention. For example, some people "fixed" the drawing that the inventor gave you during the interview – or else ignored it!
2. Sometimes the client gives you something and you don't think it's right for your purposes. That does not mean that you can ignore it or change it. Instead, disclose it as an alternative embodiment.
3. Further, recognize that if the inventor gives you something that does not seem to square with your understanding of the invention, you should question them on it – not modify it so that it fits with your thinking. It may be an entirely new aspect to the invention.

B. Don't call things "element" – like "weight measurement element"

As we will see, that leads to 112 rejections – use device, system = ok

C. "Offset" is a bad word. What does it really mean? What is being "offset"? A carbon amount? Carbon emission? Data? What is really happening when a user purchases an "offset?"

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 2nd – 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:

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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.