

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?

Door unit?

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 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.
- 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.

Also not disclosures – “not limited to VOIP”, “Other methods known to one of skill in the art”

B. You need to disclose the preferred embodiment/best mode - in all of its highly-specific specific glory. Also, it makes your patent application MUCH clearer if you discuss your best mode in the Figures as you introduce the system. For several people, when introducing the overall system drawing, just mentioned “signals are transmitted” from one element to another and did not mention what the system actually does – there was no mention of the system responding to someone at a door and providing communication between the person at the door and the remote user. Adding a high-level explanation (with appropriate “as further described below in Figure X) can really make your system clear to the Examiner.

C. Also, we want to be sure to disclose the low-level details in the DD. It’s the exact opposite of what you do with the claims – at least with your first explanation as shown in the Figures. However, 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 – or broaden it as an alternative. 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 or different alternative terminology

- C. Don't use legal or claim terms in the DD
 - No "by means of", "equivalent", "enable", "said" "plurality"
 - (OK in claims), but may not actually be a disclosure in the DD
- D. Watch the slang – computer program "runs", data "is buried in a signal", door is "locked", door is "closed" – is there a better way to say it?

V. Drafting Tips

- A. Don't call things "element" – like "weight measurement element"
As we will see, that leads to 112 rejections – use device, system = ok
- B. Watch out for shortcuts. When you are writing and you can see two ways to disclose an element – 1) simply and at a high level or 2) thoroughly and rigorously – you may be thinking to yourself "option 2 is such a pain – do I really have to do it? I can't see any reason for it." Recognize that you are really saying that you can't see any reason for it "right now". Trust me – if you are suing on the reference and the other side is attacking it, you will probably see the reason at that time, but it will be too late. Why not put in the little extra effort now "just in case" and so that you can be confident in your product?
- C. "the system is activated" – not a great disclosure
- D. Can't claim the trademark of "AlwaysHome". Why can I use the TM of Bluetooth?
- E. Reminders
 - Want to disclose everything from the Inventor's
 - 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. Clients rarely give us exactly what we need because they don't think the same way and they are focused on different aspects. The best patent attorneys recognize the holes in their disclosure and help fill them in.

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 1st – 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:

Dom Semper (U.S. Citizen)
1 Lares Pl
Oppido, IL 123456

Charge the fees to your firm’s deposit account:

Pat, Ent, & Win
The address of your firm is
the law school’s address.
Deposit account 00-1337