

INVENTION ANALYSIS AND CLAIMING: Writing the Detailed Description' PART I



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The Detailed Description should not be a flat, featureless field of undifferentiated details. It should be an attention-grabbing landscape with a central focus and clearly delineated features that stand out from the overall setting.

Unfortunately, however, that is often not the case.

Even if the Background and Summary do a good job of outlining the invention story, the invention disappears from view in many patents once the Detailed Description starts up. Readers are set loose to negotiate an expanse of details on their own without being shown how those details relate to the invention story.

A Detailed Description that does not continue to focus on the invention story misses an opportunity to help the reading audience better understand the invention. The fact that “it’s all in there” only satisfies the minimum legal requirements of §112. It does not guarantee that the reader will be able to align the broad statements that characterize the problem and the solution with the specifics that appear in the Detailed Description. Most of the details in the Detailed Description do not illustrate the invention *per se*; they are there to provide

an enabling disclosure and to satisfy best mode. Even a moderately simple Detailed Description may not make clear which aspects of the disclosed embodiment(s) correspond to the elements of the invention unless the correspondence is explicitly pointed out.

THE DETAILED DESCRIPTION AS EXPANSION OF THE BACKGROUND/SUMMARY

Most attorneys write the Detailed Description before the Background and Summary. There is much to be said, however, for writing the Background and Summary first. Indeed, that is my own preferred approach.

A Background and Summary written following the guidelines offered in previous columns² serve as a perfect outline for the Detailed Description. The Background and Summary guide the writer as to what should be introduced when when telling the expanded version of the invention story. In fact, my own Detailed Descriptions typically contain each sentence of the Summary or sometimes whole paragraphs augmented or expanded with the embodiment details. Key sentences from the Background are sometimes also included. A Detailed Description written in this way provides the reader with a clear picture of which aspects of the Detailed Description illustrate the broad statements made in the Background and Summary. It imbues the overall specification with a pedagogic unity and cohesiveness that is hard to achieve when the Detailed Description is written first.

Illustrating the Problem and the Solution

The Detailed Description’s telling of the problem can be at various levels of detail, depending on what seems useful. The problem story can be as limited as a sentence or two that refer the reader to the Background. Often, however, it is useful to illustrate the problem with reference to a block diagram of an illustrative system, or a flowchart of an illustrative prior art process, in which the problem arises. If the invention is a simple article of manufacture, such as a hand tool, a piece of sports equipment

or a gadget of some kind, it may be useful to show a prior art version of the article.

The stage is thus set for the problem to be shown in context and to be explained in greater depth than is typically desirable for the Background. Whole sentences appearing in the Background describing the problem may be re-presented at this point, and then amplified with reference to the system block diagram or process flowchart. The reader may have understood the problem in a general sense from the Background, but may not have understood specifically how the problem arises or why solving it is so important. The Detailed Description is a vehicle through which these things can be made clear.

The stage is now set for the Detailed Description to illustrate the solution to the problem. In particular, there will be points in the Detailed Description where the reader will encounter the structural element(s) or method step(s) that constitute the inventive departure. These should be explicitly pointed out by making specific reference to “the invention.” Such lead-in phrases as “In accordance with the invention...” serve well here.

Use the Inverted Pyramid Style to Get To the Invention Early

A way to keep up reader interest is to structure the Detailed Description using the inverted pyramid style, in which what’s essential to the inventive concept appears early on and less important details appear later.³

For example, the inventive concept may reside in a new functional relationship between the elements of a known type of system. In such a case, the Detailed Description can lead off with a description of a high-level block representation, or simplified mechanical drawing, illustrating that functional relationship. The details of the various components of the disclosed system can be introduced later on. An inverted pyramid style of Detailed Description will, in fact, evolve naturally if a Summary written in that style is used as a template.

Indeed, it is my own practice to push down to the end of the Detailed Description the descriptions of components or steps that are not involved in the inventive concept but are simply included to meet the requirements of enablement and/or best mode. Few readers will actually be interested in that material and it just gets in the

way of the story-telling, so for that kind of stuff, the later the better.

Next Month: Writing the Detailed Description—Part II.

ENDNOTES

1. Copyright © 2007, 2010 American Bar Association. Adapted with Permission. All Rights Reserved.
2. *Intellectual Property Today*, Nov. 2007, Apr. 2008, May 2009
3. The inverted pyramid style is discussed in detail in *Intellectual Property Today*, May 2009.