

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



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Last month’s column presented some ideas for structuring the Detailed Description in a way that highlights the invention. This month’s column continues that discussion.

USE THE WORD “INVENTION” CAREFULLY

The word “invention” should be used with great care. This is a point that cannot be emphasized often enough or strongly enough. The word “invention” should be used in an unqualified way only when referring to the broad inventive concept. We should not call something “the invention” unless we are willing to have the patent coverage limited to that.

If the specification says that something is “the invention,” the Opposing Team will argue to the Court that it *is* the invention, regardless of what the claims say, and various reported decisions² will back them up. Broad terms in the claims have been interpreted narrowly because the specification characterized something as being a part of “the invention.” Indeed, entire claim elements nowhere to be found in a claim have been imported into it based on such

a characterization of “the invention” in the specification.

Consider, for example, the seemingly innocuous statement

FIG. 1 is a circuit diagram of the invention.

This sentence implies that every component shown in the circuit diagram is required to implement the inventor’s contribution. It’s not likely that that’s what the patent drafter meant. Unless it was intended to have the patent’s coverage limited to the circuit exactly as shown, it would be better to write

FIG. 1 is a diagram of a circuit embodying the principles of the invention.

Or consider the statement

The invention employs a nickel oxide shell-type catalyst to speed up the reaction between X and Y.

This statement implies that the invention necessarily involves use of a nickel oxide shell-type catalyst. This is fine if reacting X and Y using a catalyst is known in the prior art and the inventive departure is that the catalyst is of the nickel oxide shell-type. But if the invention resides simply in reacting X with Y, it would be better to write

Particular embodiments of the invention may use a nickel oxide shell-type catalyst to speed up the reaction between X and Y.

The above considerations apply, of course, to the Summary as well. Indeed, it is even more important to observe the specialness of the word “invention” in the Summary since the Summary is supposed to be—and thus may well be interpreted as—a summary of the invention *per se*. See, for example, 37 CFR 1.73, which provides that

A brief summary of the invention indicating its nature and substance...should precede the detailed description. Such summary should, when set forth, be

commensurate with the invention as claimed....[emphasis added]

The point about the specialness of the word “invention” is brought up here—in connection with the Detailed Description—because we are already quite focused on stating what the invention is when we are writing the Summary and we are not as likely, therefore, to make a mistake. The Detailed Description is less formalized and more wide-ranging. We have a lot more to think about than just the invention *per se* when drafting the Detailed Description. It may thus be easier when writing the Detailed Description to slip up and refer to something as “the invention” when it is not.

When the claims in a litigated patent get interpreted more narrowly than they “should,” the specification is often the culprit.

HAVE THE INVENTION WELL IN HAND BEFORE STARTING THE DETAILED DESCRIPTION

The key to writing an effective Detailed Description is to have the invention well in hand *before* the writing begins. This is automatically accomplished if the Summary has already been written, as suggested in last month’s column. But even if the Detailed Description is written first, we still should know what the invention is before we start.

A contrary view holds that familiarity with the embodiment gained by writing the Detailed Description helps us isolate the inventive concept. We have seen, however, that analyzing the embodiment to identify the invention rather than carrying out a problem-solution analysis can easily result in the broad invention being missed.

Even if the invention does get properly identified at some point during or after the writing of the Detailed Description, the Detailed Description probably will not point out the invention in desirably broad, functional terms. Aspects of the embodiment that were thought to be central to the invention, and described as such, may prove to be only optional fallback features. Conversely, features that were thought to be optional might prove to be crucial to patentability once the invention has been fully thought through and vetted against the prior art. Terminology used in the Detailed Description may prove to be too narrow in light of what was later realized to be the invention. The overall structure of the Detailed Description may prove to be less

than optimally suited for telling and illustrating the invention story.

Revision is always an option, of course. But revising the Detailed Description could involve a lot of effort that would not have to have been expended if the invention had been identified at the outset.

Preparing the drawings is also more efficient if we know what the invention is. The drawings must show every feature recited in the claims.³ So we can be sure that the drawings are complete only once we know what the claims will say. This, in turn, requires knowing what the invention is, and what its fallback features are. Revising the drawings can be tedious and may entail further revision of the specification to make it consistent with the revised drawings.

There are other issues. Major revision of the Detailed Description is error-prone. The editing process may miss an unduly limiting statement about what “the invention” entails. Not all changes in terminology may be caught. The narrative is likely to read like the patch job that it was. As with any written composition, writing the Detailed Description without a clear goal can result in a tangle that is very hard to unravel.

ENDNOTES

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2. See, for example, *Curtiss-Wright Flow Control Corp. v. Velan, Inc.* 438 F.3rd 1374, 77 USPQ2d 1988 (Fed. Cir.2006)
3. 37 CFR 1.83.