

# INVENTION ANALYSIS AND CLAIMING: What Should I Write First?<sup>1</sup>



BY RONALD SLUSKY

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There are a number of advantages to writing the Detailed Description only after writing the Background and Summary.

A Background and Summary written following the guidelines offered in previous columns<sup>2</sup> serve as a perfect outline for the Detailed Description. A well-crafted Background and Summary guides the patent drafter as to what should be introduced, and when, in telling the expanded version of the invention story that is the Detailed Description. In my own practice, the Detailed Description often contains each sentence of the Summary, or something very close to it, expanded upon with embodiment details. Key sentences from the Background are sometimes also included.

A Detailed Description written in this way provides its reader with a clear picture of which aspects of the Detailed Description illustrate the broad, general 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.

As an example, here are excerpts from the Summary and Detailed Description of a patent application purporting to disclose the very first chair. Note how the Detailed Description repeats, and expands upon, each idea set forth in the Summary..

## SUMMARY

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In accordance with the invention, a seating device with reduced weight compared to the prior art comprises one or more elongated members as the seat support structure. An elongated support member can support a large load relative to its own weight when compressed along its longitudinal axis, thereby achieving a significant reduction in weight of the overall seating device. Such a seating device is referred to herein as a “chair” and the elongated support members as “legs.”

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## DETAILED DESCRIPTION

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FIG. 2 depicts a seating device, or “chair,” 10 embodying the principles of the invention. Chair 10 comprises a platform, or “seat,” 12 on which the sitter sits. Seat 12 is supported above a floor or the ground by a support structure indicated generally at 11.

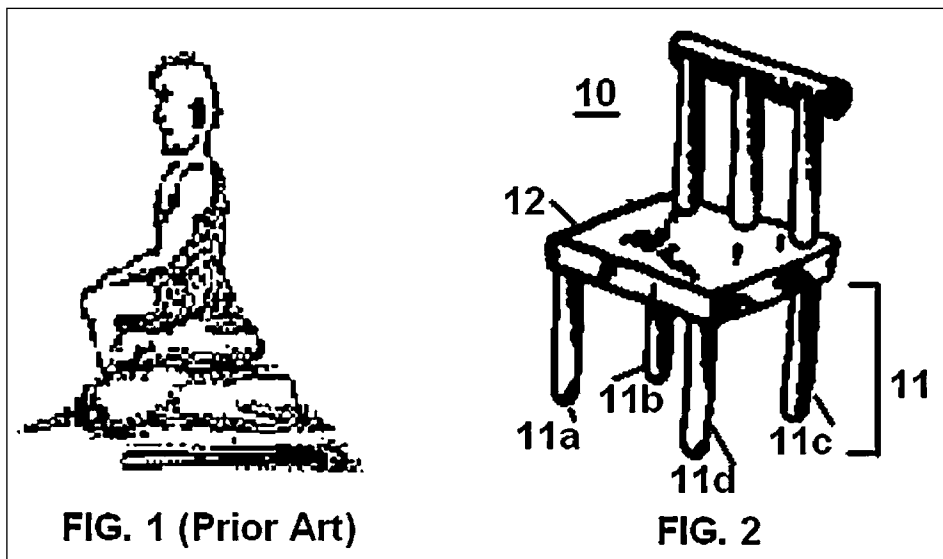
In accordance with the invention, chair 10 has reduced weight compared to prior art seating devices by virtue of support structure 11

comprising one or more elongated support members. In the illustrative embodiment, there are four such support members 11a through 11d. An elongated support member, such as the support members 11a through 11d, can support a large load relative to its own weight when compressed along its longitudinal axis, thereby achieving a significant reduction in weight of the overall seating device as compared prior art seating devices such as that shown in FIG. 1. I refer to the elongated support members 11a through 11d as “legs.”

There are other reasons for writing the Detailed Description only after writing the Background and Summary.

The process of writing the Background and Summary provides an opportunity to “tweak up” an overview of the invention within a compact lexical space. This includes refining our view of the broad invention, establishing terminology to describe the invention and an intended environment for its use, and establishing a logical flow of ideas from the problem to the solution to the fallback features. Crafting an accurate Background and Summary first can be a slow process. But it pays for itself many times over in the efficiency with which the Detailed Description can be thereafter prepared. It is more time-consuming to have to go back and make changes in an extensive Detailed Description that was written first.

I personally write the claims last. Insights of various kinds may evolve during the writing of the specification—particularly the Background and Summary. Claims written last benefit from all of that. This can



only work, however, if one has the invention and its fallback features fully in hand at the outset, which is to say that a nailed-down answer to the question *What is the Invention?* is absolutely required.

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“What should I write first?” is one of the classic questions of the just-starting-out patent practitioner.

Some mentors teach that the Detailed Description should be written first. The idea is that this is a good way to get the juices flowing and for the application drafter to “get a feel for” what has been invented. Others instruct that at least some of the claims be written first to ensure that the Detailed Description—in fact, the entire specification—will be drafted in a way that provides the claims with the necessary conceptual and terminological underpinning.

*Slusky’s* answer, however, is that “You shouldn’t write *anything* first.” First figure out what the inventive concept is, after which the order in which the parts of the application are drafted is of secondary importance.

A patent application written with the inventive concept fully in hand at the outset is one that will best serve the inventor, the patent owner and, indeed, the invention itself.

## ENDNOTES

1. Copyright © 2007, 2010 American Bar Association. Adapted with permission. All rights reserved.
2. *Intellectual Property Today*, Nov. 2007, Apr. 2008, May, 2009.