

# Patent-disclosure meetings: *A 'one and done'\* approach*

*\* Mostly*



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# The traditional approach



Inventor presentation



Attorney note-taking



Attorney drafting



Inventor review



Ready?

No



Yes



File pat app

# Three frequent dislikes:





# The time required ...





# the cost ...





# the inventor frustration



# What causes these dislikes?





# 1. The invention is a technical advance... *(presumably)*





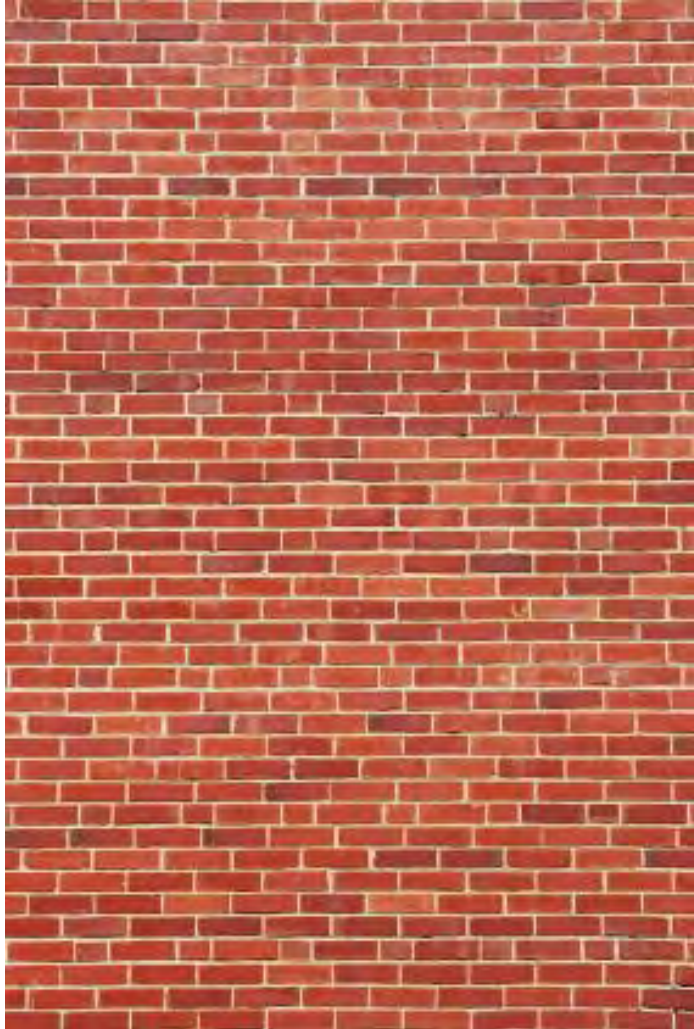
2. ...but the lawyer is a *lawyer*  
(and so must play 'catch-up')





### 3. And, everyone's busy





**Not much we can do  
about these issues.**

# Let's focus on three other causes





# 4. Inventors' presentations aren't always well-organized





# 5. Attorney's notes are likely to be incomplete ...





# ... prompting follow-up calls ...





**... and inventors aren't always thrilled to be interrupted**





# 6. Attorney doesn't want to risk leaving out anything important ...





**... so, drafts a 'dissertation' ...**





**... which needs more editing  
by the inventors ...**





**... increasing the  
time required ...**



# ... and the cost ...





# ... and the inventors' frustration

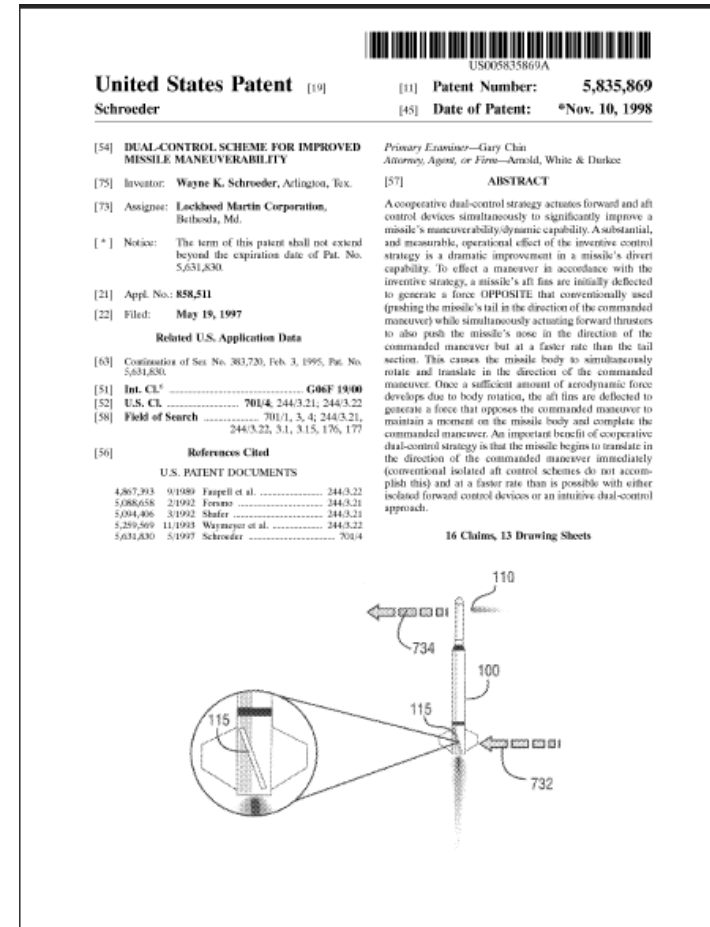


**There is a better way**

# 'Proof of concept' example

U.S. Patent No. 5,631,830:  
*Dual-control scheme  
for improved missile  
maneuverability*

Assignee:  
Lockheed Martin Corp.  
*(no endorsement implied)*





# How it's done

# No notes (!)



# Instead: Draft, with *the inventors*:

- starter claims,  
  
plus
- ‘footnotes’ ...



... in person, or ...

# ... via on-line screen sharing



skype™  
GoToMeeting®



# Three basic steps to walk the inventors through:





# 1. Ask: What would someone *pay for* ...





# ... and focus on *that*

*(to start with)*

## ***Technology focus:***

“We came up with a neat way of **inhibiting the activity of the Doo-Hickey enzyme** in the human body.”

**vs.**

## ***‘What would someone pay for’ focus:***

“We’ve come up with a way of making **a hay-fever medication that gives relief for up to 24 hours.**”



## 2. Outline a 'business plan' *as a method claim*

100. A method of relieving hay fever for an extended period of time, comprising:

- (a) manufacturing a new decongestant compound;
- (b) acquiring a spray bottle; *[etc., etc.]*



### 3. Expand the 'business plan' claim boundaries as much as the prior art will allow



100. A method of relieving ~~hay fever~~ nasal congestion [1] for an extended period of time, comprising:

[1] *Nasal congestion*: Nasal congestion could result from a variety of causes such as, for example, hay fever or a sinus infection.



# ... adding necessary details

(a) manufacturing a ~~new~~-decongestant compound comprising a mixture of powdered unicorn horn [2] and ground pepper; [3]

[2] *Unicorn horn*: A unicorn may be attracted by sprinkling chocolate chips on any convenient unicorn trail.

[3] *Ground pepper*: Cayenne pepper is preferred, but black pepper has also been found to work satisfactorily.



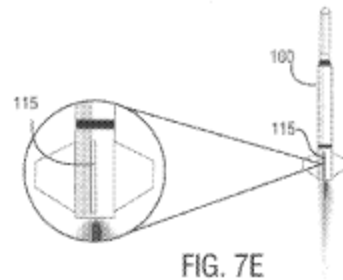
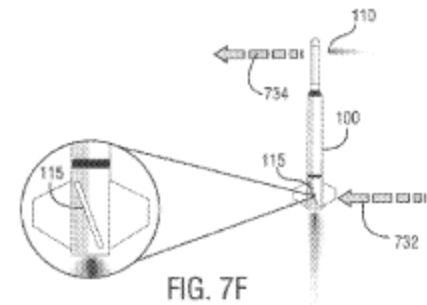
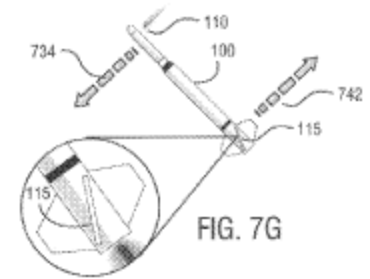
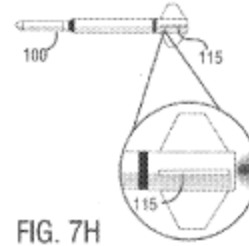
## *[Dependent claims can be useful]*

**110.** The method of claim 100, wherein the ratio of powdered unicorn horn to ground pepper is in the range of 1:1 to 1:5. **[4]**

**[4]** *Ratio:* Proportions from 1:2 to 1:4 have been experimentally verified; proportions ranging from 1:1 to 1:5 are expected to work satisfactorily.



Sketch rough  
drawings;  
number the  
components:





# Brainstorm w/ inventors:



- Do claims distinguish over prior art?
- Are claims targeted at what competitors will actually *do*?
- Any problems *proving* infringement?
- Future products / services? Licensing to other industries?



Repeat for other  
'business plan'  
claims





# Result:

A disciplined  
survey of  
'the invention' ...

... with  
immediate,  
on-the-fly  
inventor  
critique &  
feedback ...





... that can  
easily be edited  
into a patent  
application



US005917822A

United States Patent [19]

[11] Patent Number: 5,917,822

Lyles et al.

[45] Date of Patent: Jun. 29, 1999

*(Editing tip:  
Copy the ‘business  
plan’ and ‘footnotes’  
and tweak them into  
a prose narrative)*

Referring to the data flow diagram in FIG. 4, the method, executed by the head-end controller 105 (or other bandwidth allocation unit 305), comprises:

- (a) receiving a transmission authorization request 405 [4] from an identified terminal equipment 210 as illustrated in Lines 517 through 519 of Table 1 the transmission authorization request 405 being associated with a requested transmission;
- (b) generating a virtual scheduling time [5] for the requested transmission, based on (1) the time of arrival of the transmission authorization request 405 [6] (2) a

\* \* \*

#### 4.2. Notes to Illustrative Method Description

\* \* \*

[4] In an 802.14 type network, access to an upstream channel (e.g., from a terminal equipment 210 to the head-end controller 105) will either be granted on a specific station basis (directed grant), on a contention basis (request grant), or for station registration purposes (acquisition grant). The specific type of grant 410 and when these are scheduled are managed directly by the head-end controller

# Payoffs:





# Inventors prefer this approach, because...





**... an intense session now  
means less editing work later**





# Lawyers like the BIG head start on legal drafting





# Applications get filed faster

*(File a provisional application  
the same day, even)*





# Cost: Comparable, or better





# Good training vehicle for:



Junior attorneys,  
patent agents –  
'sit second-chair'

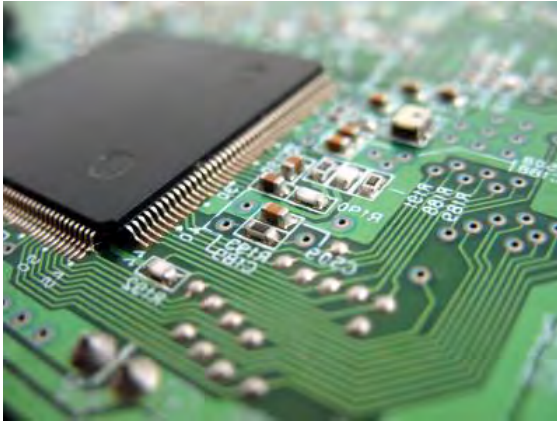
and



Invention-  
disclosure  
authors



# Adaptable to different fields



```
string="Database=DB home; User=...  
= " Database provider" DB,connect  
SelectSQL1 = " Select id, name, quantity from ...  
MySQL1 = " where id between decode(name ...  
MySQL2 = " group by id, name"  
SelectQuery = SelectSQL1 & QuerySQL1 & QuerySQL2  
Execute Query; Commit Transaction; Select new data  
Form Navigation  
If KeyAscii = 13 Then Execute Query  
If Not Chr(KeyAscii) Like "#" And KeyAscii ...
```

# Further reading

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## Reengineering the Inventor Interview

D.C. Toedt<sup>1</sup>

### INTRODUCTION

“Painful.” “Tedious.” “Frustrating.” These are the most common responses received in a highly unscientific survey, in which some of my colleagues and I asked a number of inventors to describe, in one word, their past experiences in the process of preparing a patent application. This paper describes some simple changes to that process that have significantly reduced the time and expense required to prepare most applications and which have received almost uniformly favorable reviews from inventors and in-house counsel.

During more than two years of experimentation, we tried a wide variety of interview techniques.<sup>2</sup> We tape-recorded entire interviews and had them transcribed. We had inventors tell us the story of the invention as though it were being presented at a conference, or being described in a children’s science book. We even tried having inventors collaborate in writing a draft specification with us during the interview. None of these approaches proved entirely satisfactory.

Almost by accident, we stumbled onto a very effective technique: *Ask the inventor to help draft actual patent claims to a saleable product or service, plus explanatory ‘footnotes,’ during the inventor interview.* We found that by drafting an organized set of claims with the inventor, a patent-attorney team can quickly record nearly all the information needed directly in the claims themselves—in such a way that the specification practically writes itself.

### BACKGROUND: DISORGANIZED ATTORNEY NOTETAKING

Many painful aspects of the conventional patent application process are well known. From the client’s point of view, it often is an

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<sup>1</sup> D. C. Toedt is a shareholder and chairman of the patent prosecution practice committee at Arnold, White & Durkee. The author acknowledges with appreciation the numerous contributions of Coe F. Miles, Ph.D., a patent agent at AW&D and second-year law student, in the development of the techniques described in this paper. Any views expressed are the present views of the author and not necessarily those of his firm or any of its clients. Copyright © 1995 D. C. Toedt.

<sup>2</sup> Cf. generally JAMES C. COLLINS AND JERRY I. PORRAS, BUILT TO LAST ch. 7 (1994) (arguing that an effective way of stimulating progress in a company is to “try a lot of stuff and keep what works”).

*Reengineering the Inventor Interview*, in *Journal of the Patent & Trademark Office Society*, vol. 78, p. 19, <http://goo.gl/WbHZ>

# For more information

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