

Use Of Technical Jargon – “How Do You Describe An Invention In A Manner That's Acceptable To The Inventor And Still Understandable By The Public?”

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Family Feud
Question # 3

Question Presented.

- 3) Use of technical jargon - How do you describe an invention in a manner that's acceptable to the inventor and still understandable by the public?
- a. You don't. There is no such thing.
 - b. You first write it in the inventor's techno speak and follow that with a primer the public can understand.
 - c. No need for a primer; just use “definition of terms” to explain the jargon.
 - d. Forget the inventor; it has to be understandable to anyone.

Nature of the question.

This question narrowly relates to one of the soft skills that patent prosecution attorneys should possess; namely, how to ensure that the language and/or vision of the inventor is honored within the context of preparing a patent application. Implicit in this question is a tension between the inventor and the public, between a desire to use specific technical language or jargon to describe the invention, and a need for subsequent readers (those skilled in the art, as well as judges, juries and/or the general public) to understand that description. To the extent such tension exists, a skilled patent attorney should be able to resolve the tension in a satisfactory manner.

Legal requirements related to the question and to technical jargon include...

35 U.S.C. 112 Specification (1st and 2nd paragraphs)

(1st paragraph) The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

(2nd paragraph) The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Practical requirements related to the question and to technical jargon include...

In addition to meeting the various legal requirements enabling a “person skilled in the art” to practice the invention, the written description may also be called upon to define the meaning and scope of the claims to important constituencies not skilled in the art; namely, judges and juries.

The desire of an inventor to use his or her technical jargon to explain the invention.

Inventors describe their innovations using technical jargon/vocabulary familiar to them. Inventors can become attached to technical jargon/vocabulary due to their familiarity and comfort with such jargon, and possibly due to the inventor having been the first to use such language. Hopefully the inventor is sufficiently reasonable and flexible to understand that the patent application has a broader audience and that effective communication of the invention to that audience, both legally and practically, may require some give-and-take in terms of technical jargon/vocabulary.

The field of endeavor within which an inventor works or “art to which [the invention] pertains” will have associated with it a particular vocabulary describing the relevant technologies, understandings and assumptions within the field, such as used by standards bodies and/or publications associated with the field. Use of this vocabulary will be important to the understanding of the invention by a "person skilled in the art."

If the technical jargon/vocabulary of the inventor is universal in nature, then there should be no problem in describing their innovations using such universally understood language. If the technical jargon/vocabulary is specific to the inventor, the inventor's company or some other less than universal group, then a disconnect between the inventor's technical jargon/vocabulary and that understood by a "person skilled in the art" and/or the public may exist.

Answers and Discussion

a. You don't. There is no such thing.

This answer presumes that the public is incapable of understanding the technical jargon/vocabulary within the context of a patent application or that such understanding is irrelevant given that the public is generally "not one skilled in the art" and therefore not the legally relevant target audience of the patent application.

For any given patent application it is certainly true that much of the public will not be able to understand some or all of the technical jargon used. However, while one purpose of the written description is to enable "those skilled in the art" to practice the claimed invention, it must also be said that another purpose of the written description is to enable those asserting/licensing a patent to explain to the satisfaction of a licensee, judge or jury the meaning of specific technical jargon/vocabulary and, importantly, the literal or equivalent application of the technical jargon/vocabulary as used in the claims to an allegedly infringing product, process and the like.

Answer "a" is not the best approach.

b. You first write it in the inventor's techno speak and follow that with a primer the public can understand.

This answer presumes that the inventor's language is appropriate to describe and claim all of the embodiments of the invention in a manner satisfying all of the legal requirements, with a primer to simplify/clarify this language for public consumption.

As discussed above, the purpose of the written description is to enable one skilled in the art to practice invention. However, even if the inventor's language is consistent with the language

used by those skilled in the art, the language may be overly restrictive within the context of describing the invention as a whole (e.g., may not be flexible enough to describe all embodiments). Some inventors are so narrowly focused on the particular embodiments associated with their innovation that they do not immediately recognize the broader applicability of that innovation and may not describe the innovation in sufficiently broad language.

Part of the inventor interview process must entail questioning the inventor about other useful embodiments, other areas of endeavor where the invention might be applicable, any broader applications of the invention and so on. During this interaction between patent attorney and inventor, it may become apparent that the technical jargon/vocabulary used for initially disclosed embodiments is not sufficiently flexible to describe and claim other embodiments, or claim the invention at an appropriately broad scope.

Given that the technical jargon/vocabulary will likely benefit from some amplification and/or clarification, a *concise* primer linking this amplification and/or clarification of the technical jargon/vocabulary to the various embodiments as well as the broader field of endeavor associated with the invention is useful and will likely find favor with the inventor as well. A primer should not be a treatise on the relevant field of endeavor, merely a “bigger picture” view of the relevant technology and the applicability of the invention to that technology. Such a primer may also encourage the inventor to broaden his or her perspective of the invention and its applicability.

Caveat: Care must be taken to insure that any primer restating, amplifying and/or clarifying the “techno speak” portion of the description does so in a consistent manner to avoid damaging the patent owner’s rights. An inconsistency interpretable as a mistake, mischaracterization or oversimplification in the primer may raise questions of operability, lack of enablement, claim scope and so on. Perhaps even questions of undue experimentation to resolve the inconsistency. Will a judge or jury (much less opposing counsel) latch onto an inconsistent, erroneous or oversimplified statement in the primer to avoid expending the time or energy necessary to fully understand an important definition in the specification?

Answer “b” is a reasonable approach with the above caveats.

c. No need for a primer; just use “definition of terms” to explain the jargon.

In recent guidance to patent examiners, the patent office has expressed a preference for the use of glossaries describing technical terms. The benefit of using a glossary from the patent office perspective and that of the courts is, obviously, a clear statement from the patent drafter as to his or her intended definition of a technical term. Since the parties to a litigation or licensing discussion often have divergent views regarding the definition of technical terms, a glossary or definition of terms might provide a mechanism to reduce ambiguity regarding such definitions.

Unfortunately, glossaries or definitions of terms do not readily support the contextual adaptations or additional meanings that may be associated with a technical term. The meaning of specific technical terms may be the plain meaning as defined by dictionaries or relevant reference materials, as understood by those skilled in the art, as defined by standards bodies and so on. Moreover, the *context* within which the technical term is used also supports the *specific* definition of that technical term as envisioned by the drafter.

Thus, some technical term may not be capable of being fully understood from a glossary alone. Moreover, if the glossary or definition of terms provides a definition that is in any way inconsistent with the use of the term in the patent application, an ambiguity is introduced that can impact the patent owner’s rights.

The use of a glossary may provide a false sense of certainty with respect to definitions. Terms requiring contextual analysis to be properly defined may instead be defined according to the glossary, even if such a definition is incomplete or lacking in some way. Therefore, it is very important for the definition of a technical term provided in a glossary to be consistent with the use of the term elsewhere in the patent application. This may result in the use of very complex definitions of terms (especially where the definition requires contextual analysis) such that the use of a glossary becomes pointless or the glossary expands and begins to look like a primer or other device.

Answer “c” is not a preferred approach.

d. Forget the inventor; it has to be understandable to anyone.

The use of technical jargon/vocabulary known to those skilled in the art may be crucial to enabling those skilled in the art to practice the invention. If so, then this language must be included within the patent application.

There is no point in describing an invention using overly simplified language. There is also no point in describing an invention using stilted or nonstandard language if more appropriate language exists. Either may prove damaging to the patent owner's rights.

Ultimately the claimed invention *must* be understandable to those skilled in the art and *should* be understandable to those ultimately deciding whether or not the claimed invention is infringed.

As previously noted, the inventor should be guided during the interview and drafting process to expand upon the technical jargon/vocabulary of an initial disclosure (as needed) to include language sufficiently flexible to support other embodiments, appropriately broad claims and the like.

As a practical matter, the views of the inventor cannot be ignored if the inventor is expected to favorably review the patent application to execute the necessary documents.

Answer "d" is not a preferred approach.