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Topic 9: Drafting Description in Relation to Claims

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Parts of the Application

- **Title of the Invention** - Should generally match your independent claim preamble(s)
- **Technical Field of the Invention** – Concise – may frame the search for the closest prior art, but be careful not to limit scope of invention
- **Background** – Concise and non-prejudicial; frames the invention in the best light – may introduce the "problem" for which the invention provides an inventive "solution"
- **Summary of the Invention** – Summarize the claims in more-readable language; can also explain advantages/solutions provided by the invention
- **Brief Description of the Figures** – FIG. 1 shows . . .
- **Detailed Description** – Bulk of description and main source of support for the claims
- **Claims**
- **Abstract** – Usually captures key features from claim 1
- **Figures** – FIG. 1, FIG. 2, FIG. 3, . . .

Claims ↔ Description/Specification

Claims

- Define the invention in clear and concise terms
- Dictate the content and focus of the description
- Can only be amended in a manner that is supported by the description

Description

- Must support the full scope of the claims
- Must enable a person of ordinary skill in the art to produce/practice the invention
- Should be consistent with claims in terms of content and terminology

Role of Detailed Description

- Provide support (**written description**) for all components, steps, characterizations, and the combination thereof, as defined by the claims;
- **Enable** person of ordinary skill in the art to practice and/or produce the invention without requiring undue burden, undue experimentation or inventive efforts;
- Establish industrial applicability;
- Provide various examples and embodiments to support a broad interpretation of the claims;
- Provide additional detail and explanation to support and facilitate an understanding of the claims;
- Reference the drawings;
- Provide fallback positions from which you can draw to amend the claims in response to rejections from the Examiner – ***cannot add new matter***.

Referencing the Drawings in the Description

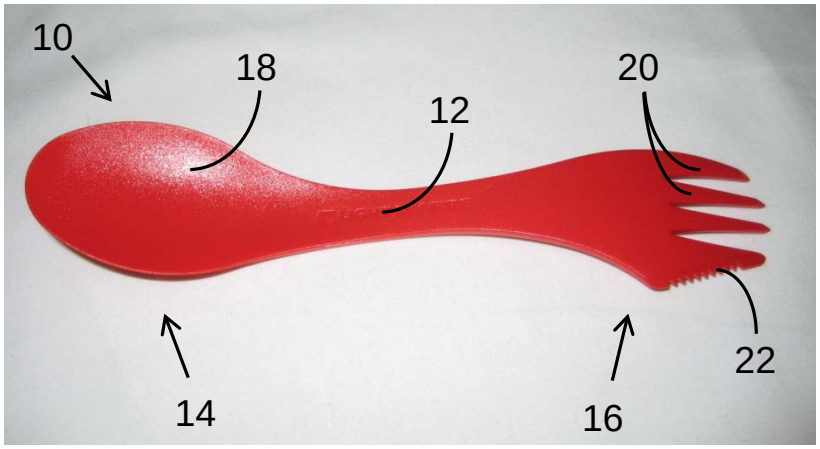


FIG. 1

Passages from description:

- "An exemplification of a multi-function feeding tool 10, including a handle 12 with a spoon end 14 and a fork end 16 is shown in FIG. 1. The spoon end 14 . . ."
- "The multi-function feeding tool 10 can be formed of a bio-based plastic formed, for example from sugarcane, wood fiber, or corn, or from conventional polymers, such as polypropylene, or from a ceramic, a metal, or wood."

Typical Structure of Detailed Description

- Boilerplate language to promote a favorable interpretation of the claims (may be at end and/or beginning of the description);
- Describe the composition/structure/product;
- Describe how to make the composition/structure/product;
- Describe potential uses/applications of the composition/structure/product.

Examples of boilerplate language (1)

- The foregoing and other features and advantages of various aspects of the invention(s) will be apparent from the following, more-particular description of various concepts and specific embodiments within the broader bounds of the invention(s). Various aspects of the subject matter introduced above and discussed in greater detail below may be implemented in any of numerous ways, as the subject matter is not limited to any particular manner of implementation. Examples of specific implementations and applications are provided primarily for illustrative purposes.

Examples of boilerplate language (2)

- Unless otherwise herein defined, used or characterized, terms that are used herein (including technical and scientific terms) are to be interpreted as having a meaning that is consistent with their accepted meaning in the context of the relevant art and are not to be interpreted in an idealized or overly formal sense unless expressly so defined herein. For example, if a particular composition is referenced, the composition may be substantially (though not perfectly) pure, as practical and imperfect realities may apply; *e.g.*, the potential presence of at least trace impurities (*e.g.*, at less than 1 or 2%) can be understood as being within the scope of the description. Likewise, if a particular shape is referenced, the shape is intended to include imperfect variations from ideal shapes, *e.g.*, due to manufacturing tolerances. . . .

Describe the composition/structure/product

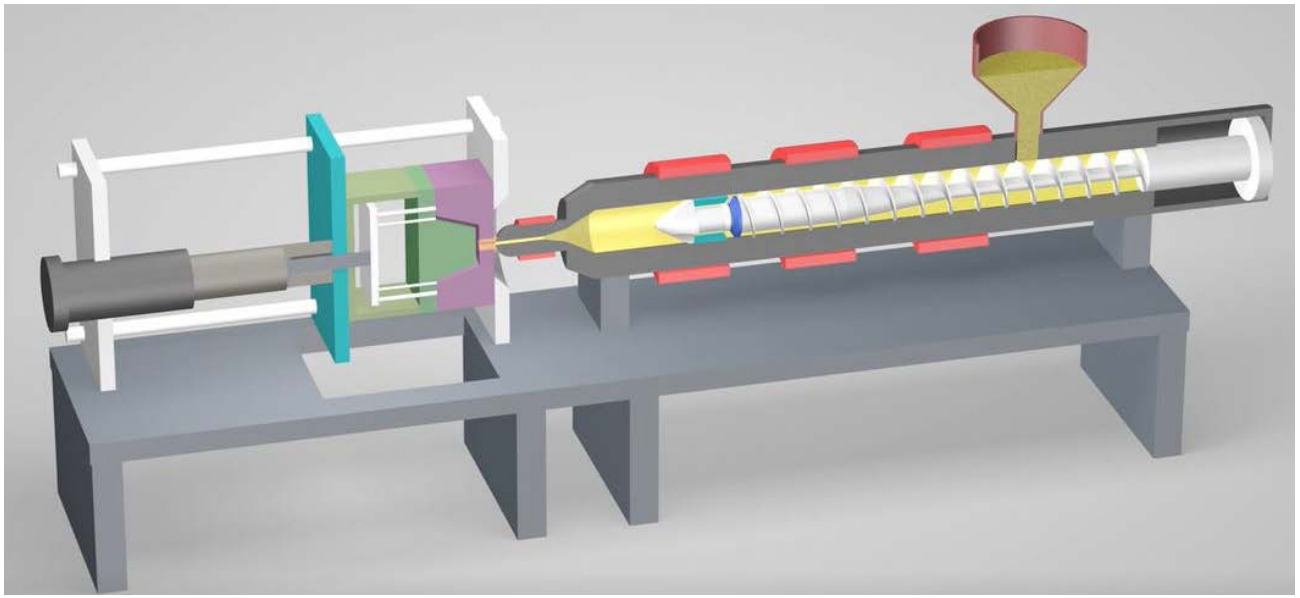
Example: Sporf

- What compositions might be suitable?
- What qualities must it have?
- How are the components connected?
- What dimensional ranges might be appropriate for tool overall and for particular components?
- What are the shapes of each component?

Describe how to make

Example: Sporf

- Preferred method of manufacture is via injection molding



- How else could it be formed?

Describe how to make (2)

Example: Sporf (continued)

- injection molding process

Engineerguy (Bill Hammack – www.engineerguy.com), Plastic Injection Molding < https://www.youtube.com/watch?v=RMjtmsr3CqA>

Describe potential uses/applications

Example: Sporf

- Personal feeding:
  - Explain how the user holds the tool and changes his/her hold on the handle and arm/hand movements to use each of the
    - (a) spoon,
    - (b) fork, and
    - (c) knife.
- Other uses?

Enablement: Biotechnology

- "Deposits" of biological material are made with a recognized international depository authority (IDA) to satisfy the enablement requirement with many biotechnology inventions per the Budapest Treaty on the International Recognition of the Deposit of Microorganisms for the Purposes of Patent Procedure – 47 recognized IDA's worldwide, as of July 2018
- Deposits should be made before filing and the description of the patent application should include its details (deposit number, depository, date of deposit)
- Sequence listings are also used to meet the enablement requirement in the case of nucleotide and/or amino acid sequences

Support & Enablement Requirements

- Claims should not be broader than the scope justified by the invention's technical contribution to the art.
- Claims should not extend to subject matter, which, after reading the description, would not be at the disposal of a person skilled in the art—for example:
  - if an essential feature is missing;
  - if there is a contradiction between the claims and description; or
  - if the scope of the claims covers an area which has not been invented (speculative) or not adequately described to enable others to practice the invention beyond the particular embodiment(s) discussed.

Support - Example

- Claim 1: A method of treating a disease using a *Bifidobacteria* strain. . .
- Description: All examples relate to methods of treating diabetes using *Bifidobacteria breve strain 174*

- Does Claim 1 meet the enablement requirement?

- In most jurisdicitions, **no**

(Bifidobacerium represent a genus of bacteria found in the human gastrointestinal tract, some of which are also included in probiotics)

Other application parts - Examples for Sporf

- **Title:** "Multi-Function Feeding Tool"
- **Technical Field of the Invention:** "The present invention relates to utensils used to feed people."
- **Background:** Discuss traditional single-function utensils (spoon, fork, and knife) and may briefly discuss what you think may be regarded as the "closest prior art" – but do not include inventor's contributions/insights that led to your invention
- **Summary:** "One aspect of the invention is a multi-function feeding tool. The tool can include . . ."
- **Brief Description of the Figures:** "FIG. 1 is a perspective view of an exemplification of a multi-function feeding tool 10 with a spoon 12, a fork 14, and a knife 16 combined with a handle 18 in a single tool." Drawings can include views from different angles, sectional views, schematics, flowcharts, graphs, and photographs (black and white - reproducible).
- **Abstract:** Typically recast claim 1 – limited to 150 words

Questions?