



Topic 8: Drafting Description, Drawings and Abstracts

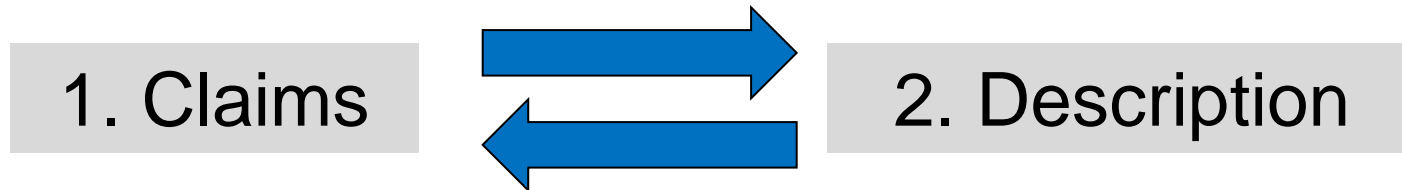
National Patent Drafting Course

Manila

November 23, 2016

Tomoko Miyamoto
Head, Patent Law Section, WIPO

Claims and Description



Claims

- Clear and concise
 - Supported by the **description**
- (IP Code, Sec. 36.1)



Description

- The **[claimed] invention** shall be disclosed in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art.
- (IP Code, Sec. 35.1)

No contradiction between the two parts

Avoid crying over spilt milk....

- No new matter can be added after the filing date
 - Description of the invention in the **sufficient depth** in the description **as of filing**
 - Allows necessary adjustment during the examination stage
 - Include various possibilities and examples

- **Unclaimed subject matter in the description** will be published and become prior art. □
 - No way to get a patent later.

- National laws and practices may be different.



Patent Applications

PCT, Art.3(2)

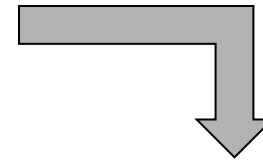
- ❖ Request
- ❖ Description
- ❖ Claim(s)
- ❖ Drawing(s)
- ❖ Abstract

IP Code, Sec. 32.1

- ❖ Request
- ❖ Description
- ❖ Claim(s)
- ❖ Drawing(s)
- ❖ Abstract

Description

- Format / Manner of the description
- Substantive content of the description



- **Enabling disclosure** requirement
- **Support** requirement /
written description requirement (US)

Ref. PCT Search and Examination Guidelines

Enabling disclosure requirement

- Enabling to a “person having ordinary skill in the art”.
- On the basis of the information disclosed in the description and the common general knowledge in the art.
- Ability to perform the claimed invention without undue burden / inventive efforts / undue experimentation.
- Various factors:
 - the breadth of the claims;
 - the nature of the invention (ex. the level of maturity of the tech.);
 - the level of predictability in the art, etc.
- Details of well-known ancillary features don't need to be disclosed.

Test for enabling disclosure – whether a person skilled in the art could, by following the directions in the description, put the invention into practice.

(Implementing Reg. Rule 406)

Enabling disclosure requirement

Ex.

- Claim: A new chemical compound X and its manufacturing process.
- Description: A detailed description of how to produce the compound X.
However, no indication of how to obtain the reagents used in the process.

The description does not contain enabling disclosure of the claimed invention, if a person skilled in the art cannot obtain these reagents based on his/her common general knowledge.

Deposit of microorganisms

- Application concerns a **microbiological process or product** and involves the use of a microorganism
 - The microorganism **cannot be sufficiently disclosed** in the enabling manner
 - Such material is **not available to the public**
- The application shall be supplemented by a **deposit** of the material with an international depositary authority.
(IP Code, 35.1)

- Deposit shall be made **before filing** the patent application.
- The identity of the depositary authority, the date of deposit and the depositary number should be in the application.

Support requirement/ Written description requirement

- Claims should not extend to subject matter which, after reading the description, would still not be at the disposal of a person skilled in the art.
 - An essential feature of the invention is missing.
 - Contradiction between the claims and the description.
 - The scope of the claims covers an area which has not been recognized by the inventor as of the filing date (ex. speculation).

Ex.

- Claim: A method of treating synthetic **resin moulding** comprising step 1, step 2, and step 3.
- Description: All the examples relate to **thermoplastic resin**, and the claimed method is inappropriate to thermosetting resin.
 - *The claim is not supported by the description.*
 - *The description does not contain enabling disclosure of the claimed invention.*

Format/Manner of the Description

Implementing Reg. Rule 407&410 (\approx PCT Rule 5.1)

- Title of the invention
- Technical field
- Background art
- Disclosure of the claimed invention
- Brief description of the figures
- Detailed description of at least one way of carrying out the invention

[PCT: the best mode contemplated by the applicant for carrying out the invention]

- Explicit indication of the industrial applicability, when it is not obvious

Title of Invention

- As short and as specific as possible.
- In technical terms particularly referring to technical feature(s) of the invention.
- Fancy names are not permissible.

[ref. Implementing Reg. Rule 410, PCT Rule 4.3]

Title - Examples

- *Apparatus and Methods for Timestamping Electrical Data in a Panel Meter*
- *Cheese product and process for production*
- *Balancing Unit and Laundry Treatment Apparatus*
- *Bispecific Antibody Substituting for Functional Proteins*
- *Semiconductor circuit*

Technical Field

- Specify the technical field which the invention relates.

Example

- *The present invention relates generally to electrical devices such as circuit breakers, and more particularly to limiting current in electrical contact assemblies for such electrical devices.*

Background Art

- Background art which, as far as known to the applicant, can be regarded as **useful for understanding, searching and examination** of the invention.
 - Preferably, cite the background art documents.
- [ref. Implementing Reg. Rule 407, PCT Rule 5.1]

Background Art - Examples

- *Conventionally, ...*
- *In general,*
- *WO 00/68407 describes*
- *To date, commercially available [things] are ...*

US: “admission” practice

- Minimum description
- Address the general area of the relevant technology

Disclosure of Invention (Summary of invention)

- In such terms that the **technical problem** (even if not expressly stated as such) and its **solution** can be understood
- State any **advantageous effects** of the invention with reference to the background art

[ref. Implementing Reg. Rule 407, PCT Rule 5.1]

Disclosure of Invention - Examples

Addressing technical problem and its solution

- *To solve the problem described above, ...*
- *To achieve these objects and other advantages and in accordance with the purpose of the invention...*
- *One effect of the present invention is ...*
- *An objective of the present invention is to provide ...*

More general style

- *In a first, broad aspect, the present invention provides ..*
- *In another aspect the present invention provides ..*
- *In a further aspect, the present invention provides ...*

Brief Description of Drawings

- Briefly describe the figures in the drawings.
[ref. Implementing Reg. Rule 407, PCT Rule 5.1]

Description of the Drawings - Examples

- *Figure 1 is a plan view of the transformer housing.
Figure 2 is a side elevation of the housing.
Figure 3 shows an end elevation looking in the direction of arrow “X” of Figure 2.
Figure 4 is a cross-section taken through AA of Figure 1.*
- *Figure 1 illustrates a block diagram of a timestamp generator.*
- *Figure 1 illustrates a flowchart of a method of timestamping electrical data.*

Mode(s) for Carrying out the Invention (Description of Embodiments)

- Describe in details at least one way of carrying out the claimed invention:
 - using examples,
 - referring to the drawings.

[ref. Implementing Reg. Rule 407]

- examples = “embodiments”; “an embodiment of the invention”
- Structure, function, steps etc.
- Use reference numerals in the drawings

Detailed Description - Examples

- *A first embodiment of electrical device contact assembly 100 is shown in Fig. 1, which includes a main line connector 102, a plurality of branch circuit connectors 104, a plurality of circuit breakers 106 ...*
- *In another embodiment shown in Fig. 2, the magnetic field generator 202 is positioned below the first electrical contact 204 ...*
- *In an embodiment, the amount of fat contained in the high protein component is from 8 to 12 grams per 100ml.*

Industrial Applicability

- The way in which the invention is capable of exploitation in the industry, **if it is not obvious from the description or nature of the invention.**

[ref. Implementing Reg. Rule 407, PCT Rule 5.1]

ex. intended **function**, specific **use** or special **purpose** (for example, specific DNA target for a polynucleotide invention)

Drawings

- Drawings , flow sheets, diagrams
- Photographs
 - black and white photographs may be allowed to illustrate the invention which are incapable of being accurately and adequately depicted by drawing drafting methods.

[ref. Implementing Reg. Rule 413&414
PCT Rule 7]

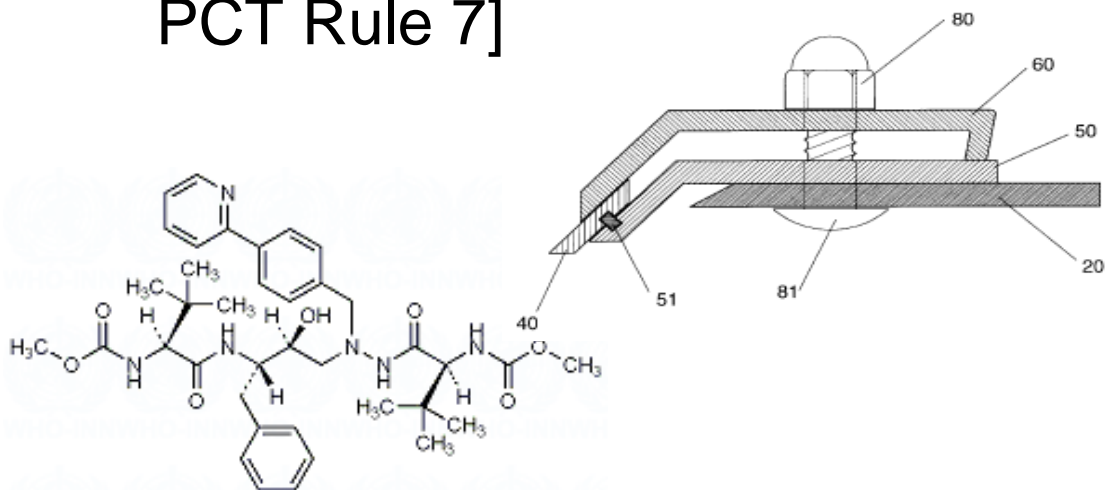
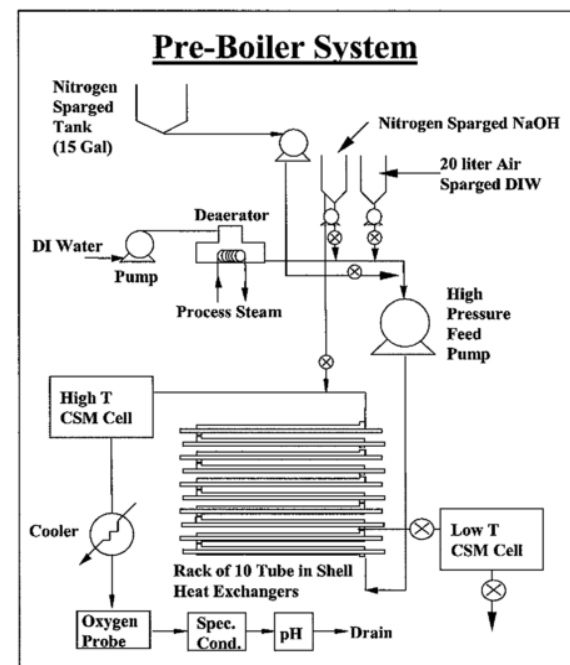


FIG. 2



Abstract

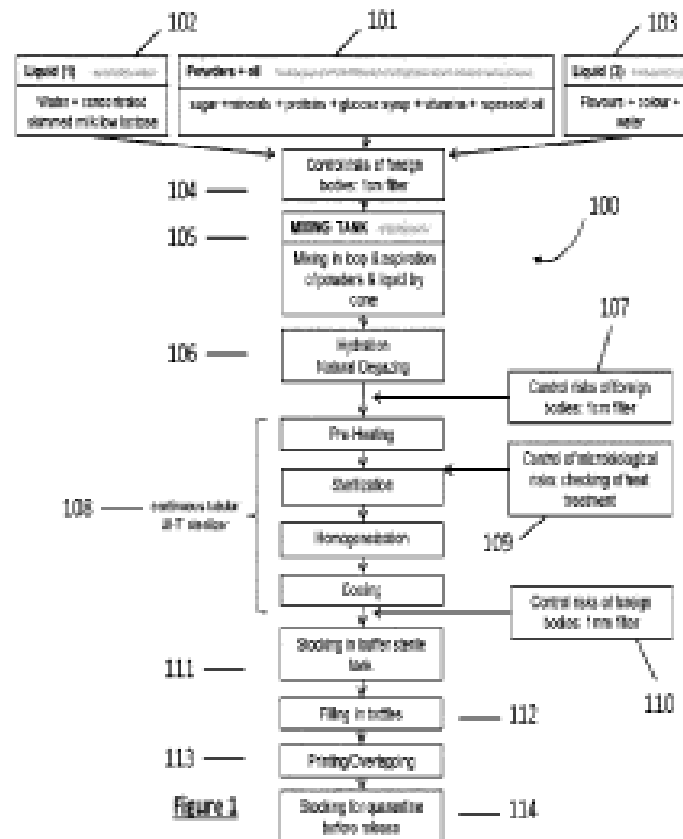
- Consists of a **concise summary** of the disclosure of the invention contained in the description, claims and drawings
- Allows the clear understanding of:
 - the **technical problem**,
 - the **gist of the solution** of that problem through the invention, and
 - the **principal use(s)** of the invention.
- Preferably, not more than 150 words.
- Abstract **merely serves for technical information.**

[ref. Implementing Reg. Rule 411, PCT Rule]

(54) **A HIGH PROTEIN NUTRITIONAL COMPOSITION**

(57) Provided herein are nutritional compositions that have a high content in proteins and a high caloric density. Also provided are related methods for formulating the nutritional compositions according to the invention. The present invention advantageously provides a heat-sterilized liquid nutritional composition with high energy content, designed to meet the nutritional needs of

persons in need thereof, in particular malnourished patients, elderly and patients with certain disease conditions. The composition provides an increased amount of energy per unit volume while providing a good palatable liquid to allow the composition to be easily consumed orally. In addition, the taste of the composition is not diminished.



Structure of the description

- Prior art
 - *Teapot with one spout*
- Drawback of prior art
 - *Time-consuming*
- Problem to solve
 - *Reduce filling time*
- Solution
 - *Provide a second spout*
- Advantage of the invention
 - *The time needed to fill multiple cups is reduced*



Fig. 1.

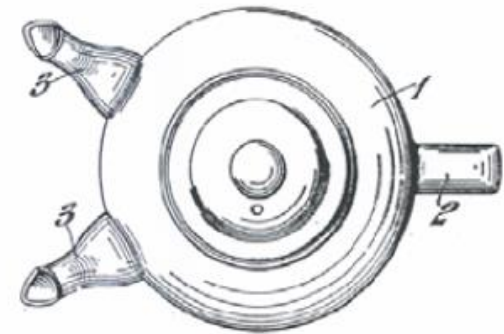


Fig. 2.

Thank you.

Tomoko.miyamoto@wipo.int