



Drafting Description in Relation to Claims

National Patent Drafting Course

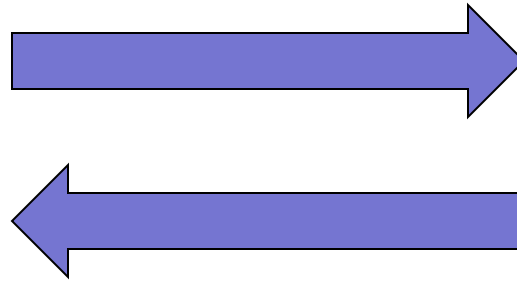
**Chiang Mai, Thailand
October 2 to 6, 2017**

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Claims and Description

Claims

Clear and concise
Fully supported by
the description



Description

Invention disclosed
in a sufficiently clear
and complete
manner so **a person
of ordinary skill** can
carry it out

No contradiction between the two parts

Legal Construct

- “A Person of Ordinary Skill in the Art”
 - The person of ordinary skill in the art is a hypothetical person who is presumed to have known the relevant art **at the time of the invention.**

Role of Description

- No new matter may be added after filing. Therefore...
- Description of the invention must be of sufficient depth **at the time of filing**:
 - Is used as a dictionary to interpret the claims
 - Can be used as support base for amendments
 - Must support the claims – verbatim in some jurisdictions
 - Includes various possibilities and examples

Requirements – In Every Major Patent Office

- Two key requirements of description:

- **Enabling disclosure (sufficiency)**

- **Support (written description)**

- *Both are separate and distinct requirements under U.S. Patent Law – 35 USC 112, first paragraph.*
- *Also required in European law - “Both requirements are designed to reflect the principle that the terms of a claim should be commensurate with, or be justified by, the invention's technical contribution to the art.”*

(EPO Guidelines for Examination, 6.4)

Requirements – In the US

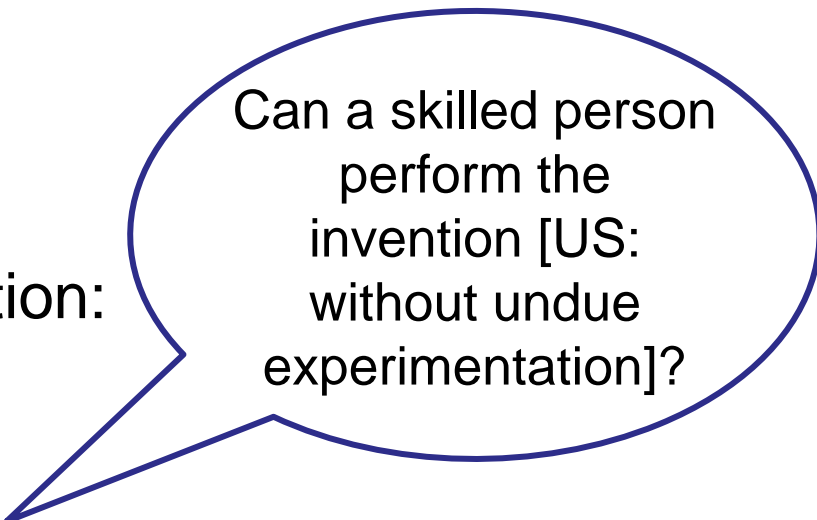
- Enabling disclosure (sufficiency) in the US
 - whether the specification provides sufficient information such that one skilled in the art can make and use the claimed invention with undue experimentation
- Support (Written Description) in the US
 - whether the specification reasonably would have conveyed to one with ordinary skill in the art that “the inventor possessed the invention at the time of that original disclosure.”

Role of Description

- Two key requirements of description:

- **Enabling disclosure (sufficiency)**

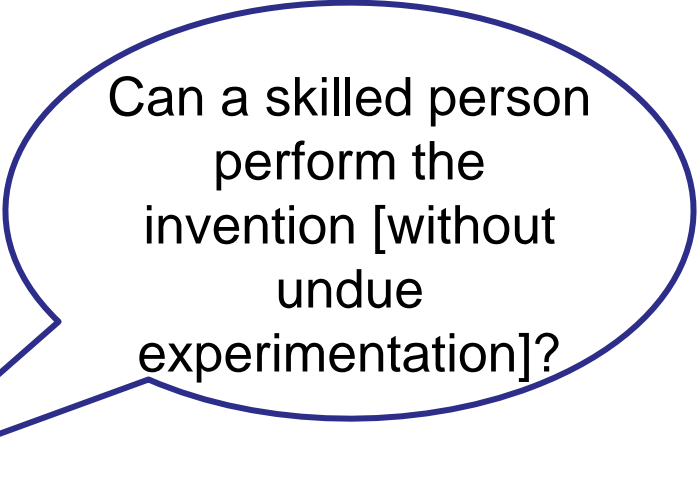
- **Support (written description)**



Can a skilled person perform the invention [US: without undue experimentation]?

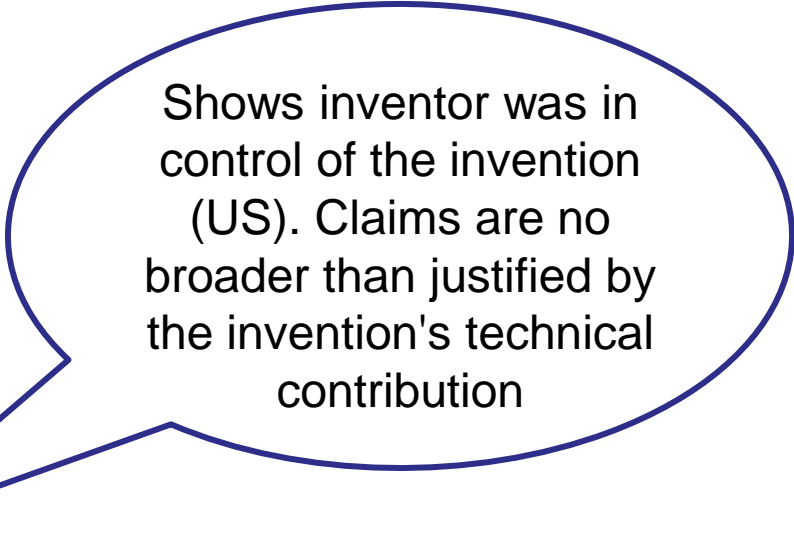
Role of description

- 2 key requirements of description:



Can a skilled person perform the invention [without undue experimentation]?

- **Enabling disclosure (sufficiency)**



Shows inventor was in control of the invention (US). Claims are no broader than justified by the invention's technical contribution

- **Support (written description)**

Enabling Disclosure Requirements – Sufficiency

- 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.
 - Enabling to “a person skilled in the art”
 - On the basis of the information **disclosed** and the common general knowledge
 - No undue burden / undue experimentation / inventive efforts required, *e.g., some experimentation is allowed and even expected.*

Enabling Disclosure – Example

- **Claim 1:** A process for making a chemical compound
- **Description:** A detailed description for how to carry out the process, but no description as to how to make the reagents used in the process.

Does it meet the requirement?



Enabling Disclosure – Example

- **Claim 1:** A process for making a chemical compound
- **Description:** A detailed description for how to carry out the process, but no description as to how to make the reagents used in the process.

Does it meet the requirement?

*If a person skilled in the art cannot produce these reagents based on their common general knowledge, then the description does **not** contain an enabling disclosure of the claimed invention.*

Support Requirements– Written Description

- 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.
 - An essential feature is missing
 - Contradiction between claims & description
 - The scope of the claim covers an area which has not been invented (speculative)

Support Requirements – 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 it meet the requirement?



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Does it meet the requirement?

In most jurisdictions, claim 1 is unlikely to be found to meet the support requirement:

** disease > should be narrowed*

** Bifidobacteria > should be narrowed*

Other Requirements of the Disclosure – Jurisdiction Based

- In the U.S., it's no longer a required element but the **best mode** of performing the invention **should** be included (known to the applicant at the time of filing)
- In the EP, explicit indication of the **industrial applicability** (where not immediately apparent)

Parts of Application – in order

- Title
- Field of the Invention
- Background
- Summary
- Brief Description of the Figures
- Detailed Description
- Examples
- Claims
- Abstract
- Sequence listing

Suggested Order of Drafting Application

- *Claims* – once these are drafted, the application is 60% finished
- *Summary* – the independent claims
- Brief Description of the Figures
- *Detailed Description* – the entire claim set
- Examples – *prophetic or working*
- Field of the Invention – *1-2 sentences*
- Background - *1-2 paragraphs*
- *Abstract* – a summary of the main independent claim
- Sequence listing

Title

- As short as possible, and precise
- Examples:
 - “Cheese product and process for production”
 - “Suitcase”
 - “Bispecific antibody substituting for functional proteins”
 - “Semiconductor unit”
 - “Phenyl-substituted amides”

Field of Invention

- Specify the technical field to which the invention relates
 - Place the invention in its proper setting
 - Do **not** include a proper description of the invention, its objects and advantages.
- Examples:
 - “The present invention relates to shoes especially adapted for high impact sports.”
 - “The present invention generally relates to improved methods of making sheet metal for heavy machinery and other uses.”

Background

- Sets the scene and provides motivation for the invention
- Can be useful for understanding, searching & examining the specification
- Some jurisdictions (e.g., Europe) request for the known closest prior art to be described
- US Examiners will use it to reject the claims as – AAPA – (Applicant Admitted Prior Art)
- Describe only the known art, not your invention

Background

- Be careful not to describe your invention as obvious
- **Examples:**
 - Invention: panadol for treating hair loss
 - *“Panadol can be used to treat virtually any disease or condition known to man”*
 - Invention: Process A + B
 - *“Prior art process A has a problem **clearly requiring** the addition of element B to work”*

Summary of Invention

- Some will start with a description of the technical problem in the art and the solution the invention provides
 - **Caution** – this can limit how the claims are read
- That is why I recommend keep it consistent with the independent claims
 - *“In one aspect, the present invention provides (independent claim 1)...”*
 - *“In another aspect, the present invention provides (independent claim 2)...”*
 - *“In a further aspect, the present invention provides (independent claim 3)...”*

Brief Description of the Drawings

- Briefly describe each of the Figures
- Examples:
 - *“Figure 1 is a plan view of the suitcase...”*
 - *“Figure 2 is a side elevation of the suitcase...”*
 - *“Figure 3 shows an end elevation looking at the direction of arrow “X” of Figure 2”*
 - *“Figure 4 shows a cross-section taken through AA of Figure 1”*
 - *view, blockview, plan, flowchart, process, graph...*

Detailed Description – Description of Embodiments

- Describes in detail the invention
 - As many permutations of each element of the invention, and the invention as a whole as envisaged (and feasible) to include
 - All essential features of the invention – **never use “essential” or other “patent profanity”**
 - All non-essential features (fall-back positions)
 - Should include best mode of performing the invention
 - Can refer to drawings and/or examples
- Use reference numbers based on those used in the drawings

Detailed Description –Examples

- *A first embodiment of the suitcase 10 is shown in Figure 1, whereby the handle 4 includes a main shaft 6, and...”*
- *“The fastening means as used in the present invention may comprise a screw, a bolt, a ...”*
- *“The sheet metal of the present invention may comprise any suitable sheet metal with a hardness of xxx. Suitable sheet metals include, but are not limited to, steel, iron, metal alloy x...”*
- *“The composition may comprise 40 - 60 mg/mL. Suitably, the composition comprises 45-55 mg/mL, more suitably the composition comprises 47-43 mg/mL. In an exemplary embodiment the composition comprises 50 mg/mL sodium.”*

Drawings

- Drawings
- Flow sheets
- Diagrams
- Results (e.g. graphs)
- Photographs
 - Black & white reproducible!



FIG. 1

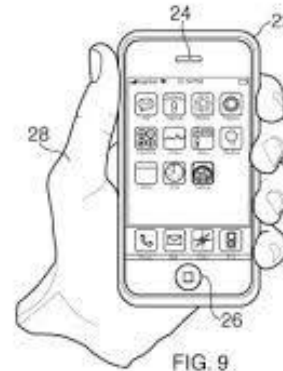
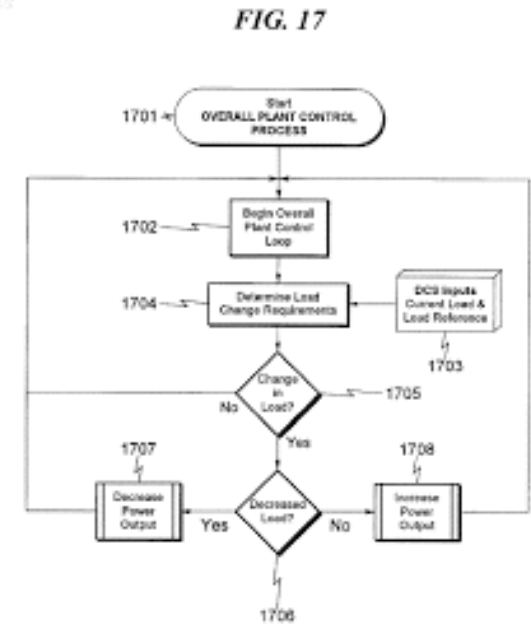


FIG. 9



Abstract

- A concise summary of the invention
- Often used for classification of the patent
- No more than 150 words generally

Quiz

- What are the two Requirements that the Disclosure must meet?
- From who's perspective are these requirements judged?
- T or F? You can change or supplement the disclosure after you file the application to include new data?
- T or F? The Background section should include a detailed discussion of your invention?
- T or F? The best mode of carrying out the invention should not be included in the disclosure because it will allow others to steal your invention?

Q & A?

Thank You!

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