



## **WIPO National Patent Drafting Course**

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### **Topic 8 Drafting Description, Drawing, and Abstract**

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# Outline of topic 8

- Reviewing the previous session
- Understanding configuration of description
- Reading some examples

Once a patent agent understands the invention he can begin preparing the patent application. The parts of the application are generally:

- claims
- detailed description (or specification)
- drawings
- background
- abstract
- summary

## 1. Claims

One of the first things to do is to prepare the claims for the invention.

In fact, the patent agent may even want to sketch out the claims in the disclosure meeting with the inventor. The patent agent may consider preparing a “picture” claim for an invention.

A picture claim is a claim that paints a word picture of the invention. The patent agent will rarely want to file a picture claim although such claims can be useful in helping to understand the invention and may also be helpful in determining all the points of novelty with the inventor

## 2. Detailed Description or Specification

The detailed description section, sometimes known as the “preferred embodiment of invention” section or the “disclosed embodiment of the invention” section breathes life into the claims and provides a sufficient explanation of the invention for an ordinary person skilled in the art to make and understand the invention.

The detailed description section must be closely tied to the drawings. This section cannot be substantively amended once the application has been filed.

The patent agent cannot amend his application to include new technical disclosure during prosecution.

Thus, a patent agent should take care that the patent application

- (1) reflects the disclosure material provided by the inventors,
- (2) provides sufficient information to enable an ordinary artisan to reproduce the invention and
- (3) provides sufficient depth so that the claims can be narrowed during patent prosecution to avoid close prior art.

The patent agent will also want to consider the “best mode” requirement that arises in jurisdictions such as the US and India. The patent application must disclose the best mode of carrying out the invention known to the inventors.

Basically, the patent application cannot conceal the optimum aspects of the invention from someone who tries to make and use the invention described in the patent. So, for example, if the inventors know that a precipitate is formed between 115 and 140 degrees, but also know that the greatest volumes of precipitate are formed at 120.5 degrees, they must disclose this information as well. Not all countries have a “best mode” requirement in patent applications.

Patent specifications filed with the EPO preferably follow a “problem-solution” approach. Thus, the story told by the application is one of outlining a problem first and then describing its solution. The discussion of the problem begins in the Background Section. (See Sec. 4.d below.) Some patent agents find the problem-solution approach easy to follow in crafting their applications and this technique should be suitable for applications filed in most jurisdictions. However, the patent agent should exercise caution as to how the problem is described. The critical aspect of some inventions is a recognition, characterization or re-characterization of a problem, *e.g.* once the inventor has uniquely formulated the problem, the solution follows fairly easily thereafter.

The patent agent must be very careful in his use of language in a patent application. The patent agent’s language choices will be important not only during patent prosecution but especially if/when the patent is litigated.

### 3. Drawings

The patent agent must prepare good visual supporting materials that describe the invention. In fact, many patent agents would argue that the drawings are the most important part of the patent application after the claims. Some patent laws require that every claimed element be shown in a drawing. Where possible, the drawings should explain the invention in sufficient detail that reading the detailed description section merely confirms in words the information provided in the drawings.

The drawing section should begin with a statement indicating that the drawings are illustrative of one or more embodiments of the invention (and not illustrative of THE invention), such as:



## **BRIEF DESCRIPTION OF THE DRAWINGS**

An exemplary embodiment of the present invention is illustrated by way of example in the accompanying drawings in which like reference numbers indicate the same or similar elements and in which:

**Figure 1** is a diagrammatic representation of an exemplary widget within which the present invention may be deployed;

**Figure 2** is...

The patent agent should make sure that his drawings are complete and omit no critical details.

## 4. Background

The use of background sections varies among the world's patent regimes. In some patent systems the background section serves to disclose to the public the closest prior art applied against the patent application during examination. This is the situation in most European systems.

In some countries such as the US, the prior art submitted by the patent applicant, as well as the prior art found by the examiner, is printed on the cover of the patent itself. Consequently, patent background sections in many countries suggest caution

[Patent Drafting Manual WIPO2016 \(Marker\).pdf](#)

The patent agent should always recognize that while his patent application has distinct parts with a precise order, he should not assume that the application will be read in that order by the patent examiner. In many of the world's patent offices the typical examiner simply has too heavy a workload to read the patent application from cover to cover. In understanding the invention well enough to prepare a first office action, many patent examiners simply review the claims and drawings and possibly a few selected parts of the application. Consequently, a verbose and detailed background section might never even be read by the patent examiner.

Don't spend too much time preparing the background. A good rule of thumb is no more than a maximum of two pages and/or no more than 10 percent of the total content of the application.

## 5. Abstract

The patent abstract should describe the invention very clearly in the fewest possible words. The patent agent could use a version of the first paragraph of the summary of the invention section as the abstract. In many of the world's patent systems, abstracts are reviewed only for their adherence to certain maximum length requirements and receive little/no substantive review. For the most part, courts will rarely look to the abstract for an explanation of the invention.

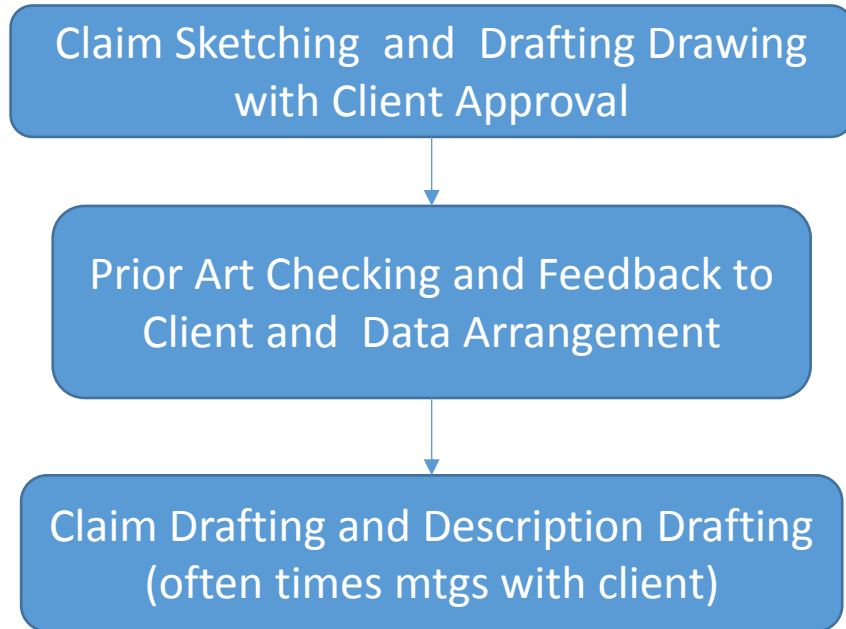
## 6. Summary

As noted earlier, not all jurisdictions require a summary of the invention section. However, such sections are customarily prepared in many jurisdictions even when not strictly required by national law.

Shall we have a look at real case?

[Apparatus for Cleaning Dies Case](#)

## Drafting Flow in this case



Thank you for your attention.

Q&A