



Topic 10: Drafting Description, Drawings and Abstracts

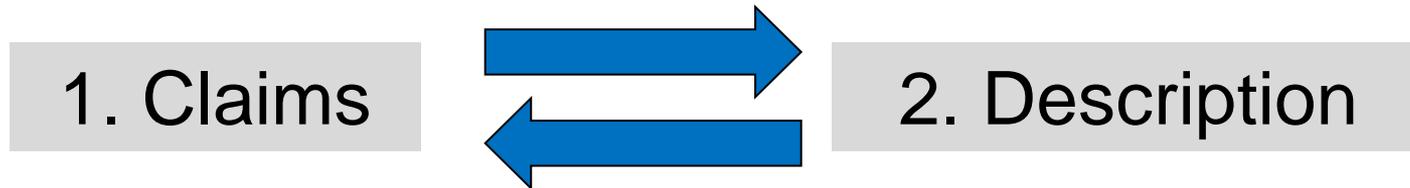
National Patent Drafting Course

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Tomoko Miyamoto
Head, Patent Law Section, WIPO

Claims and Description



Claims

- Clear and concise
- Fully supported by the **description**

(Pat. Reg. Rule 13(1))



Description

- The **[claimed] invention** shall be disclosed in a manner sufficiently clear and complete for it to be carried out by a person having ordinary skill in the art.

(Pat. Reg. Rule 12(1)(c))

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

- National laws and practices may be different.



Patent Applications

PCT, Art.3(2)

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

Pat. Reg. Rule 5

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

Description

- Substantive contents of the description shall meet:
 - Enabling disclosure requirement
 - Support requirement [Written description requirement (US)]

- Ref.
- PCT Search and Examination Guidelines
 - MyIPO Guidelines for Patent Examination

Enabling disclosure requirement

The [claimed] invention shall be disclosed in a manner sufficiently clear and complete for it to be carried out by a person having ordinary skill in the art.

- Enabling to a “**person having ordinary skill in the art**”.
- On the basis of the **information disclosed** in the description (with the aid of drawings) and the **common general knowledge** in the art.
- Ability to perform the claimed invention **without undue burden / inventive efforts / undue experimentation**.
- Details of well-known ancillary features don't need to be disclosed.

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.

Biotechnology

- Sufficient disclosure of **inventions relating to biological material**, or inventions using biological material, in writing may be difficult.
- The application shall be supplemented by a **deposit** of the biological material with a recognized collection center.

- 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.

MyIPO Guidelines for Patent Examination, 3.17

- Sequence listing of **nucleotide and/or amino acid sequence**

Support requirement

Claims shall be supported by the description.

- 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 invented by the inventor as of the filing date (ex. speculation).

Support requirement

Ex.

- Claim: A method of treating synthetic resin molding comprising step 1, step 2, and step 3.

- Description: All the examples relate to thermoplastic resin, and the claimed method is not workable with respect 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

Pat. Reg. Rule 12 (\approx PCT Rule 5.1)

- Title of the invention
- Technical field
- Background art
- Disclosure of the claimed invention
- Brief description of the figures
- [At least] the best mode contemplated by the applicant for carrying out the invention, using examples and referring to the drawings
- Explicit indication of the industrial applicability, when it is not obvious

A different manner or a different order is acceptable, if that would result in a better understanding of the invention.

Title

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

PCT Rule 4.3: short and precise (preferably from two to seven words (in English))

Title - Examples

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

Technical Field

- Specify the technical field to which the invention relates.
 - Place the invention in its proper setting.
 - Should not include the description of the invention, its objectives and advantages etc.

Example

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

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**.

Background Art - Examples

- *Conventionally, ...*
- *In general,*
- *To date, commercially available [things] are ...*
- *WO 00/68407 describes*
- *FIGS. 1 and 2 show a conventional xxx which*

- Describe only the known art.
- **Not to suggest your inventive solutions**
- US: “admission” practice
 - Minimum description of background art is preferred.
 - Technical problems not in the “Background Art” part

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
 - Broad summary: it should clearly state the technical features and solutions proposed by the invention.
 - Normally, the same scope as the independent claim(s)
 - Include the objectives of the invention and its advantageous effects

Disclosure of Invention - Examples

Addressing technical problem and its solution

- *The aforementioned xxx has major drawbacks, as ...*
- *To solve the problem described above, an objective of the present invention is to provide ...*
- *One effect of the present invention is ...*
- *To achieve these objects and other advantages and in accordance with the purpose of the invention, ...*

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.

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.*

Detailed Description (Description of Embodiments)

- Describe in details [at least] the best mode contemplated by the applicant for carrying out the claimed invention:
 - using examples,
 - referring to the drawings.
- examples = “embodiments”; “an embodiment of the invention”
- Explain embodiments of the invention by its structure, function, steps etc.
- Use reference numerals in the drawings
 - Not to explain 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.**

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. [PCT Rule 7]

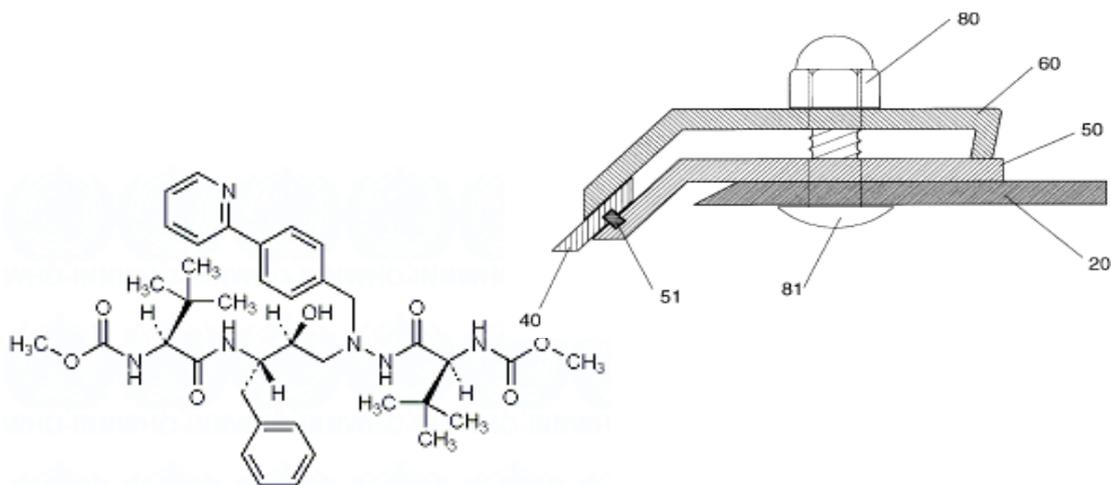
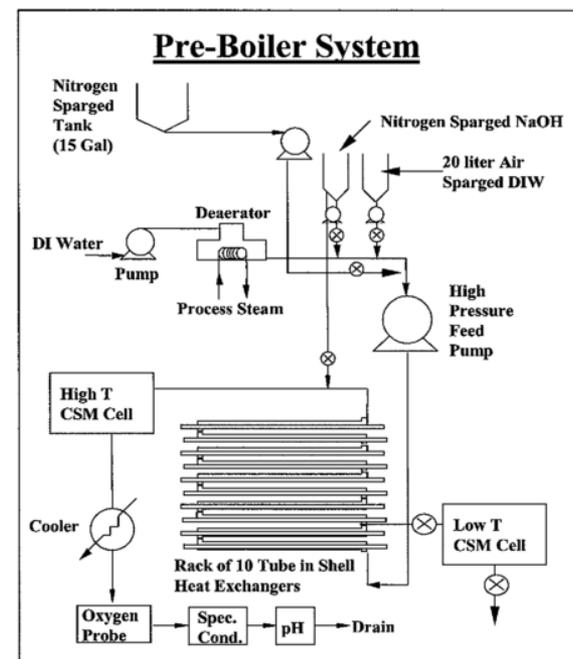


FIG. 2



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**.

Pat. Reg. Rule 16

- Commences with the title of the invention, and includes the indication of a representative drawing that accompanies the abstract
 - ex. “Most illustrative figure: Fig. 2”
- Main features in the abstract which are in the illustrative drawing shall be followed by the reference sign within parentheses.

Thank you.

Tomoko.miyamoto@wipo.int