



Drafting Description in Relation to Claims

JERRY C. SERAPION
OCTOBER 10, 2018



Drafting the description

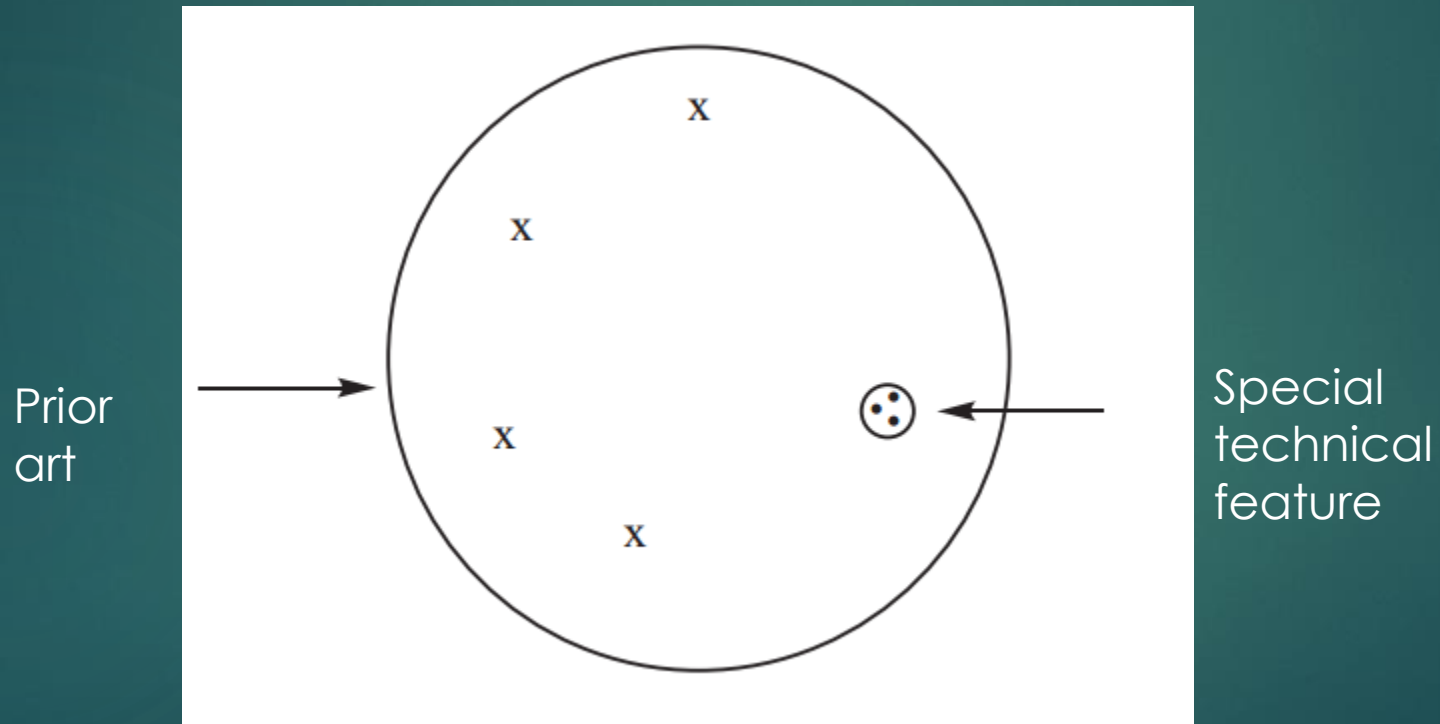
General structure: **Rule 407 IRR** on Inventions

- ▶ **Technical field of the invention**
- ▶ **Background art**
 - ▶ - **statement of prior art**
 - ▶ - **identification of the closest prior art**
 - ▶ - **drawbacks of the prior art**
- ▶ **Summary of the invention**
- ▶ **Detailed Description of the invention**
 - ▶ - **technical problem underlying the invention**
 - ▶ - **disclosure of the solution to this problem**
 - ▶ - **technical advantage(s) of the invention**

Suggested sequence after drafting the **claims**...

- ▶ 1. Drafting the detailed description (with reference numerals)
- ▶ 2. insert reference numerals in the claims
- ▶ 3. drafting the summary of the invention.
- ▶ 4. writing the abstract using reference numerals.
- ▶ Draft the Background of the invention

special technical features



special technical features

- ▶ technical features that define a **contribution which each of the claimed inventions**, considered as a whole, makes over the prior art.
- Rule 605 IRR Patents
- ▶ Since these are the focus of the claims, you expand on these on the detailed description of the invention.

Detailed Description of the Invention

- ▶ usually equivalent to *Materials and Methods* in scientific publication
- ▶ sets forth the best mode of carrying out your invention. You can go from general to specific. Please describe them in as much detail as possible – all the possible ways of embodying the invention i.e. the invention can also be built in this manner etc. That means that the more description is embodied here, the better our chances will be of getting the patent or UM, as the case may be.

Detailed Description of the Invention

- ▶ At the minimum, it must **contain those special technical features** or those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.

enabling disclosure - description

- ▶ The test is whether the persons to whom it is addressed could, by following the directions therein, put the invention into practice. (Rule 406, Revised IRR FOR PATENTS, UTILITY MODELS AND INDUSTRIAL DESIGNS (2011)). The sufficiency of the disclosure is to be assessed on the basis of the application as a whole, including the information given in the claims, description and drawings, if any.

Description...

- ▶ When it is necessary to refer in the description to elements of the drawings, the **name of the element** should be referred to as well as its **number**, i.e. the reference should not be in the form: "3 is connected to 5 via 4" but, "resistor 3 is connected to capacitor 5 via switch 4".
- ▶ The description and drawings should be consistent with one another, especially in the matter of reference numbers and other signs.

Disclosure and Description of the Invention

- ▶ Disclosure and Description of the Invention. — 35.1. Disclosure. — The application shall disclose the invention in a **manner sufficiently clear and complete for it to be carried out by a person skilled in the art.** Where the application concerns a microbiological process or the product thereof and involves the use of a **micro-organism** which cannot be sufficiently disclosed in the application in such a way as to enable the invention to be carried out by a person skilled in the art, and such material is not available to the public, the application shall be supplemented by a deposit of such material with an international **depository institution.** Sec. 35, IP Code

sufficiency of disclosure objection

- ▶ Ensure that the disclosure is enabling
- ▶ Objection can be overcome by a showing that **the missing step or element is already established in the art prior art** (including prior use - MSE); or
- ▶ The missing step could be easily figured out by a skilled person in the art **without undue experimentation**

Undue experimentation

- ▶ A person skilled in the art must do too much research and testing in order to make an invention work.

lack-of-antecedent-basis rejection

- ▶ Rejection of a patent application on the ground that a reference either in the specification or in the claim is missing. - Black's Law Dictionary, Standard Ninth Edition, 2009

Question of support

- ▶ Each claim shall be clear and concise, and shall be supported by the description. Sec. 36, IP Code
- ▶ The claims must conform to the invention as set forth in the description and the terms and phrases used in the claims must find **clear support** or **antecedent basis** in the said description so that the meaning of the terms may be ascertainable by reference to the description (Rule 415d, IRR IP Code)

Generalizing the embodiment of the invention

- ▶ generalize the important feature(s) and crystallize what we think the general idea underlying the invention is.
- ▶ This can be done once a narrow main claim has been drafted and is reviewed (several times). It is important to generalize the concept of the invention by concentrating on the essential features through using broad technical concepts, broad language and by avoiding unnecessary limitations.

Generalizing the embodiment of the invention

- ▶ The **generalized claim** should also **be reflected in the Description**. Otherwise, there will be lack of antecedent basis.

SUMMARY OF THE INVENTION

- ▶ a disclosure or general statement which the claimed invention is to solve or at least to alleviate in enough detail that the examiner and anyone searching for prior art can understand the unique character of the invention
- ▶ talks about the advantages of the current invention and how it is a cut above or different from prior art problems

BRIEF DESCRIPTION OF THE DRAWINGS

- ▶ when there are drawings, there shall be a brief description of the several views of the drawings and the detailed description of the invention shall refer to its different parts, as shown in the views, by use of **reference numerals**

Drawings...

- ▶ "Figure 1 is a plan view of the transformer housing;
- ▶ Figure 2 is a side elevation of the housing;
- ▶ Figure 3 is an end elevation looking in the direction of the arrow 'X' of Figure 2;
- ▶ Figure 4 is a cross-section taken through AA of Figure 1."

perspective view

- ▶ In drawing and graphics programs, a display method that shows a 3D image. These three dimensions, height, width, and depth, create an image on-screen that more closely resembles what the human eye actually sees.

cross-sectional view

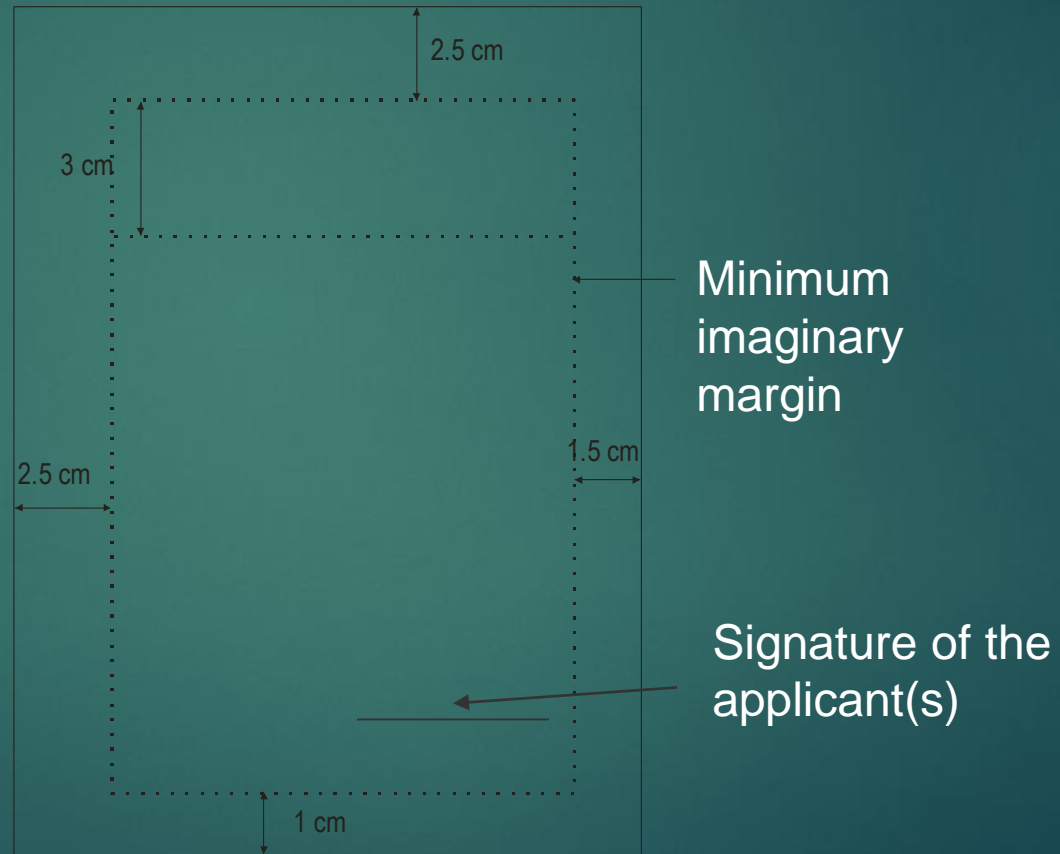
- ▶ Sliced view of a part or component in a drawing showing its internal make up. - <http://www.businessdictionary.com/definition/cross-sectional-view.html>

Drawings

- Must show every feature of the invention covered by the claims
- A4 size
- India ink, or its equivalent in quality, is preferred to secure perfectly black solid lines
- Signature of the applicant/agent should be placed at the lower right-hand corner within the imaginary margins (top 2.5 cm, left 2.5 cm, right 1.5 cm, bottom 1 cm)

Requirements for the drawings

A4 size
21cm x 29.7 cm



improvement of the prior art

- ▶ When the invention relates to an improvement of the prior art, the drawing must exhibit, in one or more views, the novel or inventive improvement in relation with the old structure presented **in dotted lines**. - Rule 413b of the THE REVISED IMPLEMENTING RULES AND REGULATIONS FOR PATENTS, UTILITY MODELS AND INDUSTRIAL DESIGNS (2011)

Reference numeral

- ▶ Reference numerals are used on the drawings and in the text of the specification to identify the elements (or steps) of the invention. In the disclosure of a complicated invention, it is helpful to provide **a listing of reference numerals and associated invention elements (or process steps)**

Flow Sheets and Diagrams

- ▶ Flow sheets and diagrams may be considered drawings provided they serve as an aid in the clear understanding of the invention. - Rule 414.10 of the revised IRR

Photographs

- ▶ Photographs are acceptable for purposes of obtaining a filing date
- ▶ The Office accepts black and white photographs or photomicrographs - must show the invention more clearly than they can be done by India ink drawings.
Rule 414.13 of the Revised IRR

Title of the Invention/ UM

1. should be as short and specific as possible
2. should appear as a heading on the first page of the specification
3. all **fancy** names are not permissible Examples of fancy names: "wonderful new product" or "improved machine"
4. acceptable **technical** terms should be used
5. serves as a finding aid (search purposes)
6. does not restrict the coverage of the invention/ utility model

Abstract

- ▶ It must be drafted in a way which allows the **clear understanding of the technical problem, the gist of the solution of that problem through the invention, and the principal use** of the invention.

abstract

- ▶ the abstract should (a) commence with the title of the invention, (b) indicate the technical field, (c) preferably not contain more than 150 words, (d) if necessary, contain the chemical formula which, among those contained in the application, (e) not contain statements on the value of the invention or on its speculative application, (f) be accompanied by a figure, if appropriate, and (g) comprise **reference signs** (number) between parenthesis following each main technical feature mentioned in the abstract and illustrated by a drawing. Rule 411, THE REVISED IMPLEMENTING RULES AND REGULATIONS FOR PATENTS, UTILITY MODELS AND INDUSTRIAL DESIGNS (2011)



Abstract

- a concise summary of the principal features of the disclosure
- its purpose is to facilitate search and retrieval
- does not limit the scope of the invention/utility model

BACKGROUND OF THE INVENTION/ UM

- ▶ usually equivalent to Review of Literature in scientific publications
- ▶ Composed of:
 - A. Field of the Invention
 - B. Description of the Related Art

Field of the Invention/ UM

- ▶ The area of technology to which the invention pertains.
- ▶ Usually starts with: “The invention relates to...”
- ▶ check closest prior art search – you can copy the technical field
- ▶ This and the title should be consistent with the preamble of the independent claim

Description of the Related Art

- ▶ Sets the backdrop of the invention. The closest prior art is mentioned at the end or close to the end to set the stage for the present invention. It is preferable to mention at least 3 prior art or literature. You can search prior art related to your invention here: <http://worldwide.espacenet.com/advancedSearch>, google patents, ncbi, google.com; www.ipophil.gov.ph

Description of the Related Art...

- ▶ The technical problem is usually formulated here. Technical problem refers to the task of modifying the closest prior art to provide the technical effect that the invention provides. Thus, a technical problem is usually a technical effect which the prior art does not achieve having regards to the present invention.

Precise use of words

- ▶ Examiner may object to a word/ phrase that appears to be vague
- ▶ Use dictionary or definitions from authorities

Exercise

- ▶ Draft a description for Velcro adhesive fastener



Credits and Recommended Readings:

- Intellectual Property Office Of the Philippines, Manual for Substantive Examination Procedure, 2002
- THE REVISED IMPLEMENTING RULES AND REGULATIONS FOR PATENTS, UTILITY MODELS AND INDUSTRIAL DESIGNS (2011)
 - WIPO Patent Drafting Manual



▶ Thank You!!!