

Patent Drafting for Beginners
Prof. Feroz Ali
Department of Humanities and Social Sciences
Indian Institute of Technology, Madras

Lecture – 48
Parts of the Specification

(Refer Slide Time: 00:18)

Parts of the Specification



Parts of the specification, what constitutes a specification?

(Refer Slide Time: 00:20)

What Constitutes a Patent Specification

Patent specification = **Description** + **Claims**



Now we had seen that the patent specification comprises of 2 things, 2 broad things and that is how we have structured this course we had looked at the problem solution statement helping us to create a claim. So, there is a claim which we have looking at. and in this set of lectures we were looking at everything else other than the claim. So, the patent specification includes the description and the claims.

So, the descriptive part along with the claims is what we call or refer to as the patent specification. now the description itself has many parts. It has a title, it has a background, summary, detailed description, abstract and drawings also become a part of the detailed description. So, this tells us that the description comprises of various parts. the title, there is a statutory requirement up on the title, background and summary are requirements which are regarded as a part of the descriptive part, to which we will now turn our attention to.

(Refer Slide Time: 01:39)

To Whom is the Patent Addressed to

- “Patent specifications are curious documents in that they are written by a group of experts (**patent agents**), embody the rights of a group of creative people (**inventors**), are addressed to a hypothetical group of skilled persons (**persons skilled in the art**), and may, if the case so demands, be interpreted and constructed by a legally trained group of persons (**examiners and judges**).”

— The Law of Patents, LexisNexis, 2007

- Person skilled in the art—hypothetical construct
- Section 10(1) “..shall describe the invention..”



To whom is the patent address to? the patent is addressed to a variety of people.

Now, I had mentioned this when I wrote my first book in 2007, a patent specifications are curious documents in that they are written by a group of experts, patent agents, embody the rights of a group of creative people inventors are addressed to a hypothetical group of skilled persons, whom we call the person skilled in the art. And may if the case so demands be interpreted and constructed by a legally trained group of persons examiners and judges.

Now, you can see that patent specifications are not addressed to one set of people, a. and you could add many more to this group, you can have angel investors who are interested in looking at a a a start up which has a patent. You could add consultants who would value intellectual property, a intellectual property valueverse you could have a financial people who want to gage a particular intellectual property before advancing a loan or before giving making some kind of an investment into the company.

So, you could have a whole lot of people who could be interested in a patent specification. But technically the patent specification is addressed to a person skilled in the art; whose which is a hypothetical construct, because a person skilled in the art at times could be a group of people. it could also be a group of people working in different parts. it could be a group of people who have different skills; which are brought together only for the purposes of interpreting a patent specification.

So, it is a hypothetical construct, because if the invention combines technology from 3 fields, then you will have to assemble hypothetically that is you do not actually do that, assemble a group of people who will have taken a skills from all the 3 fields of technology. So, it is from that perspective, that the patent is constructed. Now we have seen that the patent specification has to describe the invention. Now the description of the invention as we have said has different parts. we saw the requirements that there is a sufficiency requirement of which the enablement requirement is a part, then we saw the best mode requirement and the utility requirement.

Now, how these requirements translate into different parts of the specification is what we will now look at.

(Refer Slide Time: 04:30)

To Whom is the Patent Addressed to

- **Section 64(1)(h):**

that the complete specification does not sufficiently and fairly describe the invention and the method by which it is to be performed, that is to say, that the description of the method or the instructions for the working of the invention as contained in the complete specification are not by themselves sufficient to **enable a person in India possessing average skill in, and average knowledge of, the art** to which the invention relates, to work the invention, or that it does not disclose the best method of performing it which was known to the applicant for the patent and for which he was entitled to claim protection

- Draft with wider audience in mind



Now, we have already covered section 64 1 h. So, the person to whom it is addressed to is to is a person who has average skill in or average knowledge, this is the person to whom the invention is addressed to. And the enablement requirement tells us that the person should be able to come up with the invention. Though, it is addressed to a person skilled in the art, patents have to be drafted keeping a wider audience in mind.

Now let us quickly Run through the role of the description or the descriptive part of the pattern specification before we see what are the different parts and what are their function.

(Refer Slide Time: 05:05)

Role of description

- Explain what the invention is
- Convince that there is an inventive concept that can be claimed
- Supports and explains the claims
- Teaches the public
- The story of the invention



now it explains what the invention is. now in the descriptive part, you convince the examiner or the patent office, that there is an inventive concept that can be claimed. because the descriptive part comes before the claim, and what you do in the descriptive part is apart from supporting the claim, you convinced that there is something inventive.

It also supports and explains the claim; it teaches the public this is the teaching requirement in patent law; where it enables a person skilled in the art to perform the invention. in some, the descriptive part of the patent the description tells the story of the invention, and the story concludes with the claim. So, it is essentially narrating the life of an invention, or how the invention has come into being, what are the problems that were overcome, and what are the different parts and how the parts work.