

Patent Drafting for Beginners
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Lecture – 45
Introduction to Specification Drafting

Specification drafting; We have already seen the principles involved in claim drafting now our approach is to first create a problem solution statement from the disclosure, work on the problem solution statement to formulate claims and then we will work on the description. Description means the remaining part other than the claim. So, the claims and the description together form the specification.

Now, when we refer to specification drafting, in this context we are referring to the other parts of the specification that remains. Now, that we have drafted the claims.

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Statutory Requirements

• **Section 10(1):**

Every specification, whether provisional or complete, shall describe the invention and shall begin with a title sufficiently indicating the subject-matter to which the invention relates.



Now, let us look at the statutory requirements claims had very little statutory requirements which we had to cover, but when it comes to the specification their act and the rules do give quite a lot of detail on what should be the structure and the function of various parts of the specification. Let us looked at look at section 10 1 it says that every specification whether provisional or complete shall describe the invention.

So, the job of the specification is to describe the invention. So, that is where we get the requirement of description and a disclosure. The disclosure, there are certain requirements for the disclosure. So, you need to describe the invention in the specification and there are certain objectives for that description, there are certain requirements we will get to that and shall begin with the title.

So, we get two things there has to be a description, there has to be a title sufficiently indicating the subject matter to which the invention relates. So, the function of the title is also given, the title cannot be few words of your choice it has to do a particular function and the function is it should indicate the subject matter to which the invention relates.

So, from 10 1 we understand that every specification should describe the invention; you could say claims also describe the invention. So, claims can be regarded as a part of the description, but in patent parlance you use description to refer to the parts other than the claim. So, in this lecture will be covering those parts which require or which have certain functions, that form a part of the specification other than the claims. So, we know that there is a description and there has to be a title.

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Statutory Requirements

• Section 10(2):

Subject to any rules that may be made in this behalf under this Act, drawings may, and shall, if the Controller so requires, be supplied for the purposes of any specification, whether complete or provisional; and any drawings so supplied shall, unless the Controller otherwise directs, be deemed to form part of the specification, and references in this Act to a specification shall be construed accordingly



10 2 tells us that subject to any rules that may be made in this behalf under the under this act which is the patents act has corresponding patent rules, rules give the details at gives the broad principles. So, to speak drawings may and shall if the controller so, requires the controller is the person in charge of the patent office be supplied for the purposes of

any specification whether complete or provisional. So, we understand drawings can be a part of complete as well as provisional. So, we understand that drawings can be supplied both for complete as well as provisional and any drawings. So, supplied shall unless the controller otherwise directs be deemed to form part of the specification and reference to this act to a specification shall be construed accordingly.

So, we understand drawings are regarded as a part of the specification. So, if you give drawings along with your specification, it will be treated as a part of the specification, now what do we understand when something is referred as a part of a specification. When something is referred to as a part of a specification, it simply means that that part is integral and that part could be used to interpret and construct the claims.

So, if something is a part of a specification, it is a part of form two the specification is filed using form t2. So, you would we regard something as a part of a specification, then we had already seen this point then it becomes an intrinsic aid for construction we saw that they could be intrinsic aid, extrinsic aid as well as tertiary aims aids now intrinsic aid the description and the claims can throw light on interpreting the invention.

Extrinsic we had covered dictionary encyclopedias could be extrinsic aids for construction and the third thing that we covered was territory, which was expert evidence given by an expert. So, when you regard something as a part of a specification, it means that that part could be used as an intrinsic requirement for constructing that specification in case there is any ambiguity.

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Statutory Requirements

• Section 10(4):

Every complete specification shall-

- (a) fully and particularly describe the invention and its operation or use and the method by which it is to be performed;
- (b) disclose the best method of performing the invention which is known to the applicant and for which he is entitled to claim protection; and



Section 10 4 further says every complete specification shall fully and particularly describe the invention, you again see the words describe the invention being repeated here fully and particularly we need not get into that there is a certain style in which certain a provisions in law are written and this has been explained by the courts. So, we need not worry about it lets just look at describe the invention and its operation or use. So, you just do not describe the invention you also explain the operation of the invention or use of the invention and the method by which it is to be performed.

So, here you there are two things that we need to bear in mind. The description of the invention should also contain operation and its use that is the first point and it should also have method by which it is to be performed it should also state the method by which it is to be performed. So, the description should be a detailed description because if it is not a detailed description, you would not understand how it is operated or how it is how it is used. And the method by which it is performed also needs to be given in detail. Now we will see further layers coming up as we read the other provisions of the act for the levels of detail.

Now, there is also a requirement in 10 4 section 10 4 which states that the disclosure of the best method has to be done the complete specification should disclose the best method of performing the invention, which is known to the applicant and for which he is entitled to claim protection. So, there is a requirement called the best method

requirement. Now, what is the best method requirement? Ask an applicant to do it simply requires him to disclose the best method and the best method should be something that is known to the applicant what is known to her if the applicant does not know it then there cannot be a burden on the disclosure.

We will get to the details of what a best method is and what is the scope of the best method in subsequent lectures, for now we need to know that the applicant is required to disclose the best method for which he is entitled to claim protection, which means if there is a single claim which is the minimum number of claims that you can have the minimum or the single claim should correlate to a disclosure which you regard as the best method.

So, you cannot claim something without describing the best method of performing. It could be just one method, but there should be which means the claim should have the claim the single claim in case you have just made one claim that claim should have a corresponding disclosure of the method of performing it. So, the method of performing the invention should correspond to the independent claim or the main claim that you have made.

So, if there is a main claim and if there is a corresponding method of performing the invention which you have described in your descriptive part of the specification, then in principle you are you have satisfied the requirement of best method. So, it is an easy requirement to satisfy we find very few cases where the applicant has not disclosed the best method and the best method has become a reason for a revocation of a granted pattern.

There are very few case laws on that, but because this is an easy requirement to satisfy all you need to do is when the claims are drafted ensure that the method of performing the invention or explaining what has been covered in the main claim is also described in detail in your disclosure.

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Statutory Requirements

- **Section 10(4):**

Every complete specification shall-

- (c) end with a **claim or claims** defining the scope of the invention for which protection is claimed;
- (d) be **accompanied by an abstract** to provide technical information on the invention



Then for further continues and it says the complete specification shall end with claim or claims defining the scope of the invention for which protection is claimed, we had covered this in our earlier lectures be accompanied by an abstract to provide technical information on the invention. So, we saw many things propping up we saw the invention has to be described, we saw title requirement that the title has to be mentioned, now we see claims coming up and we saw the best method as a requirement and now we have abstract. So, there has to be an abstract.

So, we will collect all these things and we will show you from the statutory provisions, what are the requirements we also saw something on drawings. So, we will we will collect all these things and show to you what are the statutory requirements, that you need to satisfy when you draft a specification.

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Statutory Requirements

Rule 13(7):

(a) The **abstract** as specified under clause (d) of subsection (4) of section 10, accompanying the specification shall commence with the title of the invention. The **title** of the invention shall disclose the specific features of the invention normally in not more than fifteen words.



Rule 13 7 gives some detail about the abstract, it says that the abstract as specified under clause d of subsection 4 of 10 which is section 10, accompanying the specification shall commence with the title of the invention. So, the abstract should have a title this is the same as the title of the specification itself there is a separate specific title for the specification the title of the invention shall disclose the specific features of the inventions normally not more than 15 words. So, there is a word limit for the title which is 15 words.

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Statutory Requirements

Rule 13(7):

(b) The **abstract** shall contain a concise summary of the matter contained in the specification and the summary shall indicate clearly the technical field to which the invention belongs, technical advancement of the invention as compared to the existing knowledge and principal use of the invention excluding any speculative use and where necessary, the **abstract** shall contain the chemical formula, which characterises the invention.



The abstract clause b continuous the abstract shall contain a concise summary of the matter contained in the specification. So, the abstract is a summary and the summary shall indicate clearly the technical field to which the invention belongs. So, the field of invention has to be mentioned in the abstract, technical advancement of the invention as compared to the existing knowledge. So, some kind of an advancement has to be demonstrated and principal use of the invention excluding speculative use and where necessary the abstract shall contain chemical formula which characterizes the invention.

So, the abstract when you draft an abstract, you should ensure that the abstract satisfies the requirements in this rule 13 7 b clearly stipulates what are the things that your abstract should satisfy it should be a summary, it should clearly indicate the field to which the invention belongs, it should demonstrate technical advancement over existing knowledge and the principal use of the invention it should not contain speculative views and where it pertains to chemicals you can show the abstract shall contain a chemical formula.

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Statutory Requirements

Rule 13(7):

(c) The **abstract** may not contain more than one hundred and fifty words.

(d) If the specification contains any drawing, the applicant shall indicate on the **abstract** the figure, or exceptionally, the figures of the drawings which may accompany the **abstract** when published. Each main feature mentioned in the **abstract** and illustrated by a drawing shall be followed by the reference sign used in that drawing.



Now, the abstract has a word limit just how the title has a word limit it should not contain more than 150 words. So, 10 times the word limit of the title. If d continues if the specification contains any drawing the applicant shall indicate on the abstract the figure or exceptionally the figures of the drawings, which may accompany the abstract when

published each main feature mentioned in the abstract and illustrated by the drawing shall be followed by a reference sign used in that drawing.

So, drawings are would normally have references, the abstract should also indicate the references from the drawing.

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Statutory Requirements

Rule 13(7):

(e) The **abstract** shall be so drafted that it constitutes an efficient instrument for the purposes of searching in the particular technical field, in particular by making it possible to assess whether there is a need to consult the specification itself.



The abstract so, drafted that it constitutes an efficient instrument for the purposes of searching in the particular technical field, in particular by making it possible to access whether there is a need to consult the specification itself. So, here they describe the function of an abstract no it is used as a searching tool that is the role of an abstract. In fact, when a patent as application is published, it is published with the bibliographical details and the abstract.

So, the abstract is important as a tool for searching and the abstract should correspond to a technical field, because you have to disclose which technical field it pertains to. So, that it becomes easy to classify the invention and we have already seen the importance of the classification and the classification codes. So, once it is classified then you would know that the abstract can be searched in a particular field and in that field it will tell you the summary of an invention and the role of the abstract is to make it an efficient instrument for search.

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Statutory Requirements

Rule 15: Drawings

(1) **Drawings**, when furnished under section 10 by the applicants otherwise than on requisition made by the Controller, shall accompany the specifications to which they relate.

(2) No **drawings** or sketch, which would require a special illustration of the specification, shall appear in the specification itself.

(3) At least one copy of the **drawing** shall be prepared neatly and clearly on a durable paper sheet.



Drawings rule 15 gives the details on drawings, now drawings as you know are not mandatory, drawings are usually given when the patent office feels there is a requirement for drawing or in cases where mostly in mechanical inventions, where drawings actually add more clarity to the invention. For instance when it comes to a biotechnology or a chemical invention, drawings are not mandatory in the sense, they are required for a mechanical invention.

So, drawings when furnished under section 10 by the applicant otherwise than on requisition made by the controller; So, you know you know understand that drawings can either be given voluntarily or when there has been a request by the controller, shall accompany the specification to which they relate. So, if it is if your invention has drawings, then it has to accompany the specification while you are filing it. This is different when you file an application and the controller asks you to provide some drawings to explain your invention. So, it has to go along with the application no drawings or sketch would require a special illustration of the specification shall appear in the specification itself.

So, if you have seen all the specification that we have showed you so, far the drawings appear in a separate sheet that is the case of the American specifications it is also the case you saw that in the Bajaj patent the drawings appear in a separate sheet. At least one

copy of the drawing shall be prepared neatly and clearly on a durable paper sheet again it is a requirement.

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Statutory Requirements

Rule 15: Drawings

(4) Drawings shall be on standard A4 size sheets with a clear margin of at least 4cm on the top and left hand and 3cm at the bottom and right hand of every sheet.

(5) Drawings shall be on a scale sufficiently large to show the inventions clearly and dimensions shall not be marked on the drawings.



Now, it continues drawing shall be on standard a four size sheets, and with a clear margin of at least four centimeters on the top and left of left hand and three centimeters at the bottom again this is to bring in some uniformity to the filing process.

Now, drawings shall be on a scale sufficiently large to show the invention clearly and dimensions shall not be marked on the drawings. So, if there is something that you need to mark you will not mark it on the drawings rather you will just use an arrow and mark it with numbers reference numbers.

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Statutory Requirements

Rule 15: Drawings

(6) Drawing shall be sequentially or systematically numbered and shall bear –

- (i) in the left hand top corner, the name of the applicant;
- (ii) in the right hand top corner, the number of the sheets of drawings, and the consecutive number of each sheet; and
- (iii) in the right hand bottom corner, the signature of the applicant or his agent.

(7) No descriptive matter shall appear on the drawings except in the flow diagrams.



Drawing shall be sequentially or systematically numbered and shall bear now you had seen in some cases are the drawings are sequentially numbered. So, you will have figure 1 and figure followed by figure 2, figure 3 and so on and shall bear one in the left hand top corner the name of the applicant because it is filed in a separate sheet it has to have these details in the right hand top corner, the number of sheets of the drawing and the consecutive number of each sheet and on the right hand bottom corner the signature of the applicant or the agent.

No descriptive matter shall appear in the drawing except in flow diagram. This is important you cannot describe anything in words in the drawing you can only have reference number and the reference number because you have given a particular reference number to a particular part of the drawing has to be explained in writing.

So, there is a brief description of the drawings, in some specifications which has drawings and in the brief description of the drawings you have the figures explanation of the figures. And in the detail description wherever you describe the invention you give the corresponding part as a reference which you have illustrators and drawing.

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Requirements for the Specification

- Sufficiency
 - Enabling disclosure (enablement requirement)
 - Clear and intelligible disclosure (description requirement)
- Best method (Best mode requirement)
- Utility (Useful)



Now, the claim had certain requirements we had seen the requirements of the claim the claim has to be clear, it has to be fairly based on the matter that was disclosed, the claims cannot use ambiguous language, the claims cannot be omnibus statement we have we saw various requirements. The specification by which we mean the parts of patent specification other than the claims, has certain requirements too now the sufficiency is a requirement which the specification has to satisfy.

Now, sufficiency comprises of two parts one there has to be an enabling disclosure this is called the enablement requirement the disclosure or when you describe the invention it should enable a person skilled in the art the skilled person to whom the patent does address to it should be able to describe the invention in such a manner the skilled person can perform the invention. So, the enabling disclosure is a requirement which would make an addressee who reads the specification to perform the invention.

The second requirement is that the sufficiency it is a second part of the sufficiency requirement is that there has to be a clear and intelligible disclosure the earlier part enabling disclosure would mean that whatever you have said enables a person to do your invention to perform the invention it is more like teaching, the second part is whatever you have described about the invention is clear and intelligible.

So, if it is not clear you could say that it is not clear hence it is not a be enabling fine it is quite possible to say that. But clear and intelligible is a separate requirement because if

the claim even if it is if it enables a person skilled in the art to perform the invention, if it is clear unclear and it is not intelligible that itself can be a reason why a specification can come under scrutiny and challenge.

So, sufficiency is a requirement and sufficiency is a requirement tied to the disclosure. Now apart from sufficiency you have the best method requirement. The best method requirement was also called the best mode requirement in the United States. The best mode requirement requires the applicant to describe the best method that is known to him at the time of filing whatever is known to him or her at the time of filing has to be described this is the best method apart from the sufficiency and best method requirement you also have the utility requirement which means the fact that the invention is useful should come out in the description.

So, the descriptive part of the specification by which we means the parts other than the claims we have already covered the claims should satisfy broadly these three requirements sufficiency best method and utility and we had also covered the relevant provisions, which says that these are the three things, but we will cover in the next lectures we will cover these three things and see how these things can be achieved or can be incorporated while drafting it. Now, on utility it is not something that really affects most applications because in your application you will state the objectives of your invention for what the invention is to be put to use.

So, the usefulness of the invention normally comes in, because the invention always as we have already discussed targets a problem a problem that has not been solved. So, you because you have defined your invention as a solution to an existing problem it is very hard for us to miss out on the utility requirement, but nevertheless the utility requirement is manifested in terms of the objectives of the invention.

One objective of the invention is a further objective of the invention is another further objective of the invention is. So, you can have multiple objectives that your invention achieves in the descriptive part and that will be useful to satisfy the utility requirement.