

QUESTION 69

Sufficient description of the invention

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Q69

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Sufficient Description of the Invention

Resolution

The IAPIP,

adopting the principles laid down in the Summary Report, completed and amended by the Report of the Working Committee, and taking the remarks into account which were voiced by the Congress at its session of May 18, 1978,

adopts the following resolution:

1. The description shall disclose the invention in a manner sufficiently clear and complete for the invention to be carried out by a person skilled in the art.

1. The person skilled in the art is skilled in the art corresponding to the technology with which the invention is concerned.

Where the object of the invention consists in the application of a technique or means, and not in the technique or means itself, the art in question is the art in which the application is made and not the art of the applied technique or means in itself. However, the person skilled in the art of the technique or means may be consulted.

The person skilled in the art is one of average knowledge and average ability; his level will depend on the nature of the technology in question.

The person skilled in the art does not have the whole technology at his fingertips; he knows the state of the art which is part of the average knowledge required in his professional work; he knows also the state of the art revealed in the patent.

In the case of inventions involving several technologies, the person skilled in the art is a person having an average knowledge in all the relevant technologies.

2. The description must be clear and complete.

This is a qualitative assessment, the description having to be considered as a whole.

Consequently, the complete and clear character of the description shall not be considered as deficient for the sole reason that one of the formal indications required to constitute its content has been omitted.

In order to be complete, the description shall supply all which is necessary, not only to understand the invention, but also to carry it out or implement it.

It is not enough that the description be complete. It must also be clear, i.e. it should not include any obscurity or ambiguity.

Difficulty in carrying out the invention may not be confused with obscurity, and the capacity of the person skilled in the art must correspond to the nature and the degree of the invention.

3. The description is sufficiently complete and clear when a person skilled in the art can carry it out.

Thus, a description is sufficient when it discloses:

- the constituent elements of the invention

- and the instructions adequate to enable a person skilled in the art to put the invention into effect by the application of his skill and knowledge.

However, the patent needs only disclose the means making it possible to carry out the invention; it cannot be required that the patent should contain all indications for the practical realization of the invention, which constitutes the know-how for carrying it out.

The realm of the invention, which is a matter for patents, and the realm of implementation, which includes questions of know-how relating to the industrial exploitation of the invention, should not be confused.

It must be emphasized that an invention cannot be considered as inadequately described on the sole ground that it is difficult or imperfect.

4. The assessment of sufficiency must be made in the light of the knowledge and abilities of a person skilled in the art at the date of the patent application or at the date of the priority claim.

For supporting a priority claim, it is only necessary for the relevant claim to read on the priority document.

The local criteria applicable to the determination of sufficiency of description are relevant only to the patent description in that country, and not to the priority documents.

II. There is an interest that the description be presented in a fairly uniform manner.

For the presentation of the description, the following rules can be admitted:

1. It is necessary for the patent to site the invention in the state of the art.

To this effect, the description must indicate:

- the title of the invention, i.e. its technical designation;
- the technical field which it concerns;
- the state of the prior art, but only for the elements necessary for understanding the scope of the invention.

2. The description must then define the invention.

The invention is first of all defined in the form of a problem stated and of a solution proposed.

The essential means and the concrete modalities of its implementation must then be described.

In general, there is no reason to require that the description lists the advantages procured by the invention, unless this listing gives a sense to the solution brought about by the invention.

At least one example (detailed embodiment) should normally be given.

There is no reason to require that the description should supply the best mode of carrying out the invention. It is indeed often impossible to determine the best mode and in any case, it does not depend on the invention or the patent but on the industrial technology concerned with making use of the invention.

Furthermore, there is no reason to require that the description should contain indications concerning the possible detrimental effects of the invention on the environment. These

indications, whatever their merits in respect to the protection of the environment may be, are not in the realm of the patent; they are in the realm of the control of the exploitation of the invention.

3. It is desirable that drawings should be an integral part of the description. As such, they should be covered by the patent.

4. In addition to the correction of purely immaterial faults, the description of the invention may be amended in the course of the grant procedure, under the control of the examiner, and on the essential condition that this modification adds no new inventive matter to the description.

Consequently, modifications of the description are permissible, for example: to eliminate elements which have become irrelevant after the applicant has renounced certain claimed subject matter; to add indications relative to the prior public domain which the applicant may not have known about but which it would be desirable to add, or to introduce explanations or clarifications in the relevant documents.

It must be possible to furnish further examples of implementation within the scope of the claims, e.g. for support purposes, providing that the further examples are not actually included in the patent specification itself: these further examples could be published in an Appendix to the patent specification.

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