

Parts of a complete specification: what are they and why should you use them?

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**CHAMPIONS
OF INNOVATION.**

Every patent application is accompanied by a provisional or a complete specification. A complete specification can be filed within 12 months of a provisional specification or as the only specification in the first instance. The complete specification describes an invention and the best way of working that invention. This document is examined by the Intellectual Property Office of New Zealand (IPONZ) to determine if the patent application complies with the requirements of the Patents Act once examination has been requested.

The Patents Act lists a number of things a patent specification (including a complete specification) must contain. Patent specifications are drafted to fulfil those requirements. In a complete specification they will usually include the following sections:

Title

The specification must begin with a title to indicate the subject matter of the invention. The title is the only part of the specification that is published until acceptance of the complete specification at the end of the examination process.

Technical field

This section indicates the general and specific field of the subject matter of the invention. This may be used by an examiner to determine which search fields to look in when searching for similar published technology.

The examiner will conduct this search to determine whether the invention described in the complete specification is novel.

Background art

This section is used to describe prior art known to the applicant in the same technical field. This section provides a context for the invention; usually by describing the disadvantages of the prior art which the invention will attempt to address (and accordingly highlighting the advantages of the invention).

Disclosure of the invention

This section should describe the invention in a series of concise statements (known as "statement of invention") using clear terminology (which may require definition). Its purpose is to highlight the features of the invention which solve the problems described in section 3 above.

This is the area in the complete specification where alternative configurations of the invention can be covered. Therefore the section should also describe alternative embodiments of the invention.

The statements of invention are often used as a basis for claims (see below).

Brief description of the figures

This section describes the different views of the invention shown in the Figures (if any). The Figures themselves should be clear black and white line drawings which clearly illustrate

preferred embodiments of the invention and which do not include any unnecessary features or written descriptions.

Best modes for carrying out the invention (detailed description of the invention)

This section should describe in detail the preferred embodiment(s) of the invention and the best method of performing the invention known to the applicant at the filing date of the complete specification. The preferred embodiment is usually (but not always) the form of the invention that the applicant for the patent proposes to make or use.

This section is usually the longest part of the specification and should provide sufficient detail to enable a person skilled in the art to produce or perform the claimed invention without the need for undue experimentation or further invention. If the specification does not do this then it may not meet the statutory ground of sufficiency.

In addition if the invention as described in the specification does not do what it is intended to do and the end result is not useful then the complete specification may not meet the statutory ground of utility.

Accordingly considerable care needs to be taken with this part of the specification.

Claims

These are the numbered statements at the end of the complete specification which define the scope of monopoly sought by the applicant.

During examination, these statements are looked at critically by the examiner.

The claims should relate to a single invention, use wording which is clear and succinct and

claim subject matter which is based on the material in section 5 described above.

In addition, to be valid the subject matter of the claims must be new and inventive. 'New' is defined as not known (published) or used before the priority date of the claim in New Zealand. 'Published' means anything that is publically available and includes patents, internet website content, books and Journals. 'Inventive' means a non-obvious improvement over that which was already known or used before the priority date of the claim (as judged by a person skilled in the art).

Abstract

A complete specification must be filed with a short abstract which summarises the invention.

A word of caution

Drafting a complete specification to ensure broad protection for the invention (while at the same time distinguishing it from the prior art) is a highly skilled process. Therefore it is always important to discuss your specific requirements with your intellectual property advisor to ensure maximum protection can be derived from your intellectual property.

Disclaimer

The above is provided for general information purposes only and does not take the place of specific legal advice. For more specific advice on all aspects of intellectual property law please contact us.