

TOPIC 2: The Patent Specification

2.1 Description and Claims

- Application for a patent must be accompanied by a 'patent specification'
- **S 40 – a complete specification must, inter alia,**
 - Disclose the invention, and
 - Must end with a claim(s) defining the invention
- **Patent specification has 3 main components:**
 - i. Bibliographic information and abstract –
 - a. Summary data
 - b. When, where, whom, what, etc.
 - ii. Description –
 - a. Describes the invention in the context of prior art
 - b. For purpose of knowing how the invention works
 - iii. Claims –
 - a. Defines the invention
 - b. For the purpose of knowing what it is; the scope of the invention; the thing over which the applicant is seeking exclusive rights
 - c. Therefore determines what is protected by defining the thing over which the applicant is seeking exclusive rights
 - d. Determines the scope of the monopoly sought
 - e. Specification must end with these claim(s) – s 40

2.2 Principles of Construction – how are patent claims to be construed?

Décor Corporation Pty Ltd v Dart Industries Inc [1988] FCA 399, [14], Sheppard J – summary of relevant rules concerning construction of patent claims as derived from case law:

- (1) **The claims define the invention, which is the subject of the patent. Therefore must be scrutinized with care.**
- (2) **Objective approach – ordinary meaning, otherwise technical meaning if the skilled person would read it that way–**
 - a. What would the person skilled in the art of the invention in the position of the patentee have intended the word to mean?
 - b. Ordinary principles of construction apply
 - c. Give ordinary meaning (dictionary meaning) unless a special meaning applies
 - d. Special meaning applies if – 1) the patentee defines it to be so, or 2) if the hypothetical skilled person would interpret that word, in the context of the art of the invention, to have a special technical meaning different to the ordinary meaning
 - e. Any purely verbal or grammatical question that can be answered according to ordinary rules for the construction of written documents is to be resolved accordingly.
- (3) **Construe the specification as a whole**
- (4) **Can't add limitations to a claim from references in the body of the specification –**
 - a. It is not legitimate to confine the scope of the claims by reference to limitations that may be found in the body of the specification but are not expressly or by proper inference reproduced in the claims themselves.
 - b. [I.e.,] it is not legitimate to narrow or expand the boundaries of monopoly as fixed by the words of a claim by adding to those words glosses drawn from other parts of the specification.
- (5) **However, the body of the specification *can* define the meaning of terms in a claim**
 - a. In some cases the meaning of words used in the claims may be qualified or defined by what is said in the body of the specification.
- (6) **If claim term is clear, can't use body of specification to make it unclear... If claim term is unclear, can refer to body of specification to make that the claim term clear –**
 - a. If a claim is clear it is not to be made obscure because obscurities can be found in particular sentences in other parts of the document.
 - b. But if an expression is not clear or is ambiguous, it is permissible to resort to the body of the specification to define or clarify the meaning of words used in the claim.

(7) Give specification a purposive construction, rather than a purely literal one.

(8) Specification must be construed in the light of the common knowledge in the art before the priority date.

a. Note though –

i. It is permissible for an invention to be described in a way which involves matters of degree. Lack of precise definition in claims is not fatal to their validity, so long as they provide a workable standard suitable to the intended use – *Flexible Steel Lacing Co*, Hely J [81] (citing *Stanway Oyster Cylinders*)

ii.—

iii. Evidence can be given by experts on the meaning which those skilled in the art would give to technical or scientific terms and phrases and on unusual or special meanings given by such persons to words which might otherwise bear their ordinary meaning – *Flexible Steel Lacing Co*, Hely J [81] citing various authorities

iv.—

v. However, the construction of the specification is for the Court, not for the expert witness. Insofar as a view expressed by an expert depends upon a reading of the patent, it cannot carry the day unless the Court reads the patent in the same way: *Allsop Inc v Bintang Ltd*

(9) Construe specification as a public instrument defining a monopoly in a reasonably clear manner.

a. In construing the specification, the court is not construing a written instrument operating *inter partes*,

b. It is a public instrument which must define a monopoly in such a way that it is not reasonably capable of being misunderstood (see also *Flexible Steel Lacing Co v Beltreco*, Hely J [72])

c. If the specification could not be understood by a skilled reader, then it is invalid

(10) Specification must be comprehensible to the person skilled in the art, since it instructs the skilled reader –

a. The body, apart from the preamble, is there to instruct those skilled in the art concerned in the carrying out of the invention; provided it is comprehensible to, and does not mislead, a skilled reader, the language used is seldom of importance.

b. Note also –

i. ‘The hypothetical addressee of the patent specification is the non-inventive person skilled in the art before the priority date’ – [81] *Flexible Steel Lacing Co*

ii. The words used in a specification are to be given the meaning which the hypothetical addressee would attach to them, both in the light of his own general knowledge and in the light of what is disclosed in the body of the specification – *Décor* at 391, per Lockhart J

iii. However... ‘There is a fine line between, on the one hand, reading down the words of a patent claim to reflect how a person skilled in the art would understand it in a practical and common-sense way, and, on the other hand, impermissibly limiting the clear words of a claim because a reader skilled in the art would be likely to apply those wide words only in a limited range of all the situations they describe: *Stanway Oyster Cylinders* at 585 - per Drummond J.