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What Information Does an Applicant Have to Include When Filing A Patent Application?

You've decided that you want to file a patent application for your invention. What information about the invention do you have to disclose in your application?

The Canadian Patent Act states that an application must correctly and fully describe the invention and its operation or use as contemplated by the inventor. To meet this requirement, the application will include a written description of the invention, supported by drawings, where appropriate. The application will also include at least one claim which defines the scope of the applicant's invention. Care is usually taken when consulting with a patent professional to craft claims that best capture the invention by including components that define the invention while at the same time differentiate from what has come before. While the scope of the claims has traditionally been seen as the most important part of the application, courts in Canada and in the United States have recently been considering what constitutes an adequate description as well.

A patent is often thought of as a bargain between an applicant and the government granting the patent. In exchange for the applicant's disclosure of the invention in the application, the government grants a patent for an invention meeting criteria for patentability, the patent giving the patentee exclusivity in what it has claimed for the term of the patent. The application will be published eighteen months following filing, and the description must be sufficient to enable anyone to practice the invention once the period of exclusivity expires.

Therefore, what is set out in the description of an application is different than what would be found in an academic paper, something an inventor may have more familiarity with. In an academic paper, the section outlining the procedure followed is less important than the sections of the paper analyzing and discussing the results obtained, presenting conclusions drawn from the results and speculating about directions for further research. The researcher may not want to fully disclose the methods underlying the research presented in the paper. Anyone who is interested in what the researcher is doing may approach the paper's author seeking to collaborate in further research. However, a patent application must be complete in-of-itself. If specific starting materials are used, the nature of those materials and where they can be obtained must be disclosed. If specific techniques are used, the techniques must be described or, if already known, citation may be given instead to one or more published documents where the techniques are described.

If the known techniques have been modified, the modification must be described as a supplement to the citation of where the known techniques are described.

In certain circumstances, results of experiments must be included in the description which demonstrate that the invention described has the utility contemplated. In

circumstances where it may not be possible to design experiments that will demonstrate utility, results must be provided that a person skilled in the art would find to soundly predict the usefulness of the invention claimed. The experiments should be properly controlled, and the results of the controls given to show the involvement of the components of the claimed invention.

A patent may not be granted for a scientific principle or an abstract theorem. Similarly, in the United States, one cannot obtain a patent for a natural phenomenon, law of nature or abstract concept, and courts have recently been willing to characterize claims as being directed to abstract concepts where the invention has been too broadly claimed and inadequately described. While there is always some abstract concept behind an invention, it is important to describe specific embodiments of the invention – specific ways of implementing the abstract concept that the inventor has come up with.

Obviously, there is a great deal that needs to be discussed between an inventor and a patent professional. Any conversation that an inventor has with a patent professional about an invention needs to be confidential. Any public disclosure of the invention prior to filing will be fatal to the application in most jurisdictions throughout the world. Canada and the United States allow an inventor to file an application up to a year following the first public disclosure, but these are exceptions to the rule – almost all of the world's countries require absolute novelty for an invention to be patentable.

As there is more to discuss with your patent professional than ever before, it is important to make sure that adequate time is taken for consultation so that an application can be properly drafted before filing.

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