

Chapter 9

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Chapter 9 Description

9.01 The description

The description means the part of the specification other than the claims (see definition in section 2 of the *Patent Rules*).

The description must describe the invention and its operation or use as contemplated by the inventor (subsection 27(3) of the *Patent Act*). It must be in the same language as the claims, that is, wholly in English or wholly in French (subsection 71(3) of the *Patent Rules*). If an applicant wishes to change the language used in a specification, he may submit a new specification in the other official language provided that no new matter is added.

The description must be clear and accurate. It should be as simple, direct, and free from obscurity and ambiguity as possible. It is addressed to persons skilled in the art or science to which the invention pertains and must be so written that those persons would be able to put the invention to the same successful use as had the inventor.

The description must not contain erroneous or misleading statements likely to deceive or mislead persons to whom it is addressed. Nor should it be couched in such language as to render it difficult to comprehend the invention's mode of operation without trial or experimentation. Broad assumptions or unproved statements made in the description are objectionable and must be removed. If only one embodiment is operable, alternatives must not be suggested even if skilled persons would probably choose the operable embodiment (*Mineral Separation v. Noranda Mines* 1947 Ex. C.R.)

The actual inventive step need not appear in a single sentence or paragraph in the description. It is sufficient if it can be seen that the invention is described in the description as a whole.

For applications filed on or after October 1, 1996 the description must be presented in the manner set forth in sections 69(1),(3), (4), and (5), 70(1), 71, 72, 73, 74, 75, and 76 of the *Patent Rules*. These Rules require specified standards in regard to the paper

size and quality, margins, page numbering, line numbering, sequence listings, language of the description, etc..

As prescribed by paragraphs (a) to (g) of subsection 80(1) of the *Patent Rules* the description shall:

- (a) state the title of the invention, which shall be short and precise;
- (b) specify the technical field to which the invention relates;
- (c) describe the background art that, as far as known to the applicant, can be regarded as important for the understanding, searching and examination of the invention;
- (d) describe the invention in terms that allow the understanding, of the technical problem, even if not expressly stated as such, and its solution;
- (e) briefly describe the figures in the drawings, if any;
- (f) set forth at least one mode contemplated by the inventor for carrying out the invention in terms of examples, where appropriate, and with reference to the drawings, if any; and
- (g) contain a sequence listing where required by paragraph 111(a) of the *Patent Rules*.

The description must be presented in the manner and order specified in (a) to (g) above unless, because of the nature of the invention a different manner or a different order would afford a better understanding or a more economical presentation (subsection 80(2) of the *Patent Rules*). This would, for example, permit the applicant to refer to drawings of the background art prior to providing a brief description of the figures in all of the drawings.

For applications filed in the period beginning on October 1, 1989 and ending on the day before October 1, 1996, the description must conform to sections 133, 134, 135, 136, 137, 138, and 140 of the *Patent Rules*.

For applications filed before October 1, 1989, the description must conform to sections 169, 170, 171, 172, 173, and 176 of the *Patent Rules*.

A new product should be described in terms of its characteristics and for a compound its derived formula should be given.

Under Section 2 of the *Patent Act*, the invention must have utility. The description should explain at least one use of the invention in sufficient detail to enable a skilled person to use the invention for its intended purpose. If no use can be seen on the basis of the description, the application may be rejected for lack of utility.

Not only must the applicant give all information for putting the invention to use but he must also insert necessary warnings to avert failure.

9.02 Title of the invention

Each application for a patent must have a title. The title of the invention must appear on the first page of the description and should preferably also appear on the page containing the abstract. It must be short and precise (paragraph (a) of subsection 80(1) of the *Patent Rules*). It should be descriptive of the invention rather than broad, such as "CARBON TETRACHLORIDE" rather than "COMPOUNDS".

For applications filed in the period beginning October 1, 1989 and ending on the day before October 1, 1996, the title must conform to section 134 of the *Patent Rules*.

For applications filed before October 1, 1989, the title must conform to section 170 of the *Patent Rules*.

9.03 Reference to drawings

Drawings are not permitted in the description, abstract, claims, or the petition (subsection 74(1) of the *Patent Rules*). However, the description, abstract and claims may contain chemical or mathematical formulae or the like (subsection 74(2) of the

Patent Rules). All drawings provided with an application for a patent must be described in the description making reference to corresponding reference numbers shown on the drawings identifying the various elements being depicted. All reference numbers in the description must appear in the drawings (subsection 82(9) of the *Patent Rules*). The same reference number must describe the same feature throughout the application (subsection 82(10) of the *Patent Rules*).

9.04 Reference to other documents in the description

The description may not incorporate by reference another document (section 81(1) of the *Patent Rules*). The description may refer to a document that does not form part of the application, only if the document was available to the public on the filing date of the application (subsection 81(2) of the *Patent Rules*). Any such document cannot be relied upon for the support of a claim in an application (section 84 of the *Patent Rules*). If a document referred to is a patent or a patent application, it must be identified by the serial number and country or organization where filed. Any other document referred to must be sufficiently identified to enable the document to be located.

For applications filed in the period beginning on October 1, 1989 and ending on the day before October 1, 1996, refer to subsections 137(1), 137(2) and 137(3) of the *Patent Rules*.

For applications filed before October 1, 1989, refer to subsections 173(1), 173(2) and 173(3) of the *Patent Rules*.

9.05 Insufficient description

The description of an application must describe all of the subject matter that the applicant intends to claim as his invention. For example, if the applicant intends to claim a chemical compound the description must disclose how that compound is prepared and desirably it will characterize the compound by some of its physical constants.

When it is clear that the description of an application is not sufficient to support the claims without reference to a document referred to in the application being examined, it is objected to for insufficiency of description under section 84 of the *Patent Rules*. If the reference is to a document that was available to the public before the Canadian application date, the applicant is requisitioned to insert the pertinent disclosure of the document into the application. If the reference is to any document that was not available to the public before the filing date of the Canadian application, the applicant may not import any of the subject matter disclosed in that reference into the application. Further, the applicant will be requisitioned to delete the reference from the description (subsection 81(2) of the *Patent Rules*).

For applications filed in the period beginning on October 1, 1989 and ending on the day before October 1, 1996, see subsection 137(2) of the *Patent Rules*.

For applications filed before October 1, 1989, see subsection 173(2) of the *Patent Rules*.

9.06 Trade-marks in the description

A "trade-mark" is a mark that is used by a person for the purpose of distinguishing, or so as to distinguish, wares or services manufactured, sold, leased, hired or performed by that person from those sold, leased, hired or performed by others.

A "registered trade-mark" is a trade-mark that is on the register kept by the Registrar of Trade-marks.

In compliance with subsection 27(3) of the *Patent Act*, the applicant is required to give a full description of the invention being described. This description may include a trade-mark as long as it is identified as such in the description (see section 76 of the *Patent Rules*). The Commissioner may require a complete description of the wares that are the subject of the trade-mark if reference to the trade-mark per se does not satisfy subsection 27(3) of the *Patent Act*. The applicant is required to give as complete a description as possible. It is usually possible to describe, at least partly, a material or list some of its constituents or properties, if only in general terms. Once the material has been defined, subsequent references to it in the same description or in the claims

may be made by use of the trade-mark alone.

Whenever a trade-mark is used, it must be identified at the first appearance as a trade-mark. For the purpose of identification, the Patent Office will accept the symbol or a statement that it is a trade-mark. Whenever the trade-mark appears subsequently in the specification, it must be identified in a similar manner or by capitalizing all letters or by use of quotation marks.

9.07 Amendments to the description

The general rule governing the admissibility of amendments is that they must not have the effect of introducing new matter.

Under subsection 38.2(2) of the *Patent Act*, the description may not be amended to add subject matter not reasonably to be inferred from the drawings or the specification as originally filed. Therefore, subject matter shown in the drawings as originally filed or set forth in the original claims, may be added to the description. In addition, the applicant is permitted to add matter that describes the prior art with respect to the application (subsection 38.2 (2) of the *Patent Act*). The specification includes the description and claims (subsections 27(3) and (4) of the *Patent Act*). (Refer to Chapter 19.08.01 and 19.10.01)

Any amendment which is not acceptable under section 38 of the *Patent Act* because it contains new matter will be objected to in a subsequent examiner's action and cannot be used to establish a priority date or a claim date. (Refer to 19.08.01 and 19.10.01)

9.08 Jurisprudence

The following decisions of the courts are of importance in considering the subject matter of this chapter:

disclosure/description (directed to one of skill in the art)

O'Cedar v Mallory Hardware

ExCR

299

1956

Description

Metalliflex v Rodi	35 CPR	49	1961
	SCR	117	1961
American Cyanamid v Charles	47 CPR	215	1965
Gilbert (Gillcross) v Sandoz	64 CPR	14	1970
	1 SCR	336	1974
Leithiser v Pengo Hydra-Pull	12 CPR (2d)	117	1973
	2 FC	954	1974
Burton Parsons v Hewlet	17 CPR (2d)	97	1976
	1 SCR	555	1976
Monsanto v Comm of Pat	42 CPR (2d)	161	1979
	2 SCR	1108	1979
Consolboard v MacMillan	56 CPR (2d)	145	1981
Beecham v Procter & Gamble	61 CPR (2d)	1	1982
Windsurfing v Bic Sports	8 CPR (3d)	241	1985
Amfac v Irving	12 CPR (3d)	193	1986
Hy Kramer v Lindsay	9 CPR (3d)	297	1986
Reading & Bates v Baker	18 CPR (3d)	181	1987
Pioneer Hi-Bred v Com of Pat	25 CPR (3d)	257	1987
	14 CPR (3d)	491	1987
Tye-Sil v Diversified	16 CPR (3d)	207	1987
Eli Lilly v O'Hara	20 CPR (3d)	342	1988
AT&T Tech v Mitel	26 CPR (3d)	238	1989
Computalog v Comtech	32 CPR (3d)	289	1990
	35 CPR (3d)	350	1991
	44 CPR (3d)	77	1992
Lubrizol v Imperial Oil	33 CPR (3d)	1	1990
	45 CPR (3d)	449	1992
Welcome v Apotex	39 CPR (3d)	289	1991
TRW Inc v Walbar	39 CPR (3d)	176	1991
Allied v Du Pont	52 CPR (3d)	351	1993
	50 CPR (3d)	1	1993
Hi-Quail v Rea's Welding	55 CPR (3d)	224	1994
Mobil Oil v Hercules	57 CPR (3d)	488	1994
	63 CPR (3d)	473	1995

misleading statements

Lovell v Beatty	41 CPR	18	1962
Corning v Canada Wire & Cable	81 CPR (2d)	39	1984
Rothmans, Benson & Hedges	35 CPR (3d)	417	1991
TRW Inc v Walbar	39 CPR (3d)	176	1991
PLG Research v Jannock	35 CPR (3d)	346	1991
Nekoosa v AMCA	Int 56 CPR(3d)	470	1994

ambiguity

French's Complex v Electrolytic	ExCR	94	1927
	SCR	462	1930
Mineral Separation v Noranda	12 CPR	99	1947
	15 CPR	133	1952
Omark v Gouger Saw Chain	45 CPR	169	1964
Proctor & Gamble v Bristol	39 CPR (2d)	145	1978
	42 CPR (2d)	33	1979
Standal v Swecan	28 CPR (3d)	261	1989
Gorse v Upwardor	25 CPR (3d)	166	1989
	40 CPR (3d)	479	1992
Reliance v Northern Tel	28 CPR (3d)	397	1989
	44 CPR (3d)	161	1992
	47 CPR (3d)	55	1993
Risi Stone v Groupe Peracon	29 CPR (3d)	243	1990
	65 CPR (3d)	2	1995
PLG Research v Jannock	35 CPR (3d)	346	1991
Procter & Gamble v Kimberly	40 CPR (3d)	1	1991
Unilever v Procter & Gamble	47 CPR (3d)	479	1993
	61 CPR (3d)	499	1995
Allied v Du Pont	52 CPR (3d)	351	1993
	50 CPR (3d)	1	1993
Mobil Oil v Hercules	57 CPR (3d)	488	1994
	63 CPR (3d)	473	1995
Almecon v Nutron	65 CPR (3d)	417	1996

Description

description of product (characterization)

Scully Signal v York Machine	20 CPR	27	1954
Leithiser v Pengo Hydra-Pull	12 CPR (2d)	117	1973
	2 FC	954	1974
Monsanto v Comm of Pat	42 CPR (2d)	161	1979
	2 SCR	1108	1979
Re: Farbwerke Hoechst	13 CPR (3d)	212	1980
Ciba Geigy v Comm of Pat	65 CPR (3d)	73	1982
Martinray v Fabricants	41 CPR (3d)	1	1991
TRW Inc v Walbar	39 CPR (3d)	176	1991
Airseal v M&I Heat	53 CPR (3d)	259	1993
Allied v Du Pont	52 CPR (3d)	351	1993
	50 CPR (3d)	1	1993

need to avert failure

Wandscheer v Sicard	SCR	1	1948
Mineral Separation v Noranda	69 RPC	81	1952
	12 CPR	99	1950
TRW Inc v Walbar	39 CPR (3d)	176	1991
Airseal v M&I Heat	53 CPR (3d)	259	1993
Feherguard v Rocky's	53 CPR (3d)	417	1994
	60 CPR (3d)	512	1995

utility

Mailman v Gillet	SCR	724	1932
Northern Electric v Browns	ExCR	36	1940
	SCR	224	1941
Wandscheer v Sicard	SCR	1	1948
Metalliflex v Wienenberger	35 CPR	49	1961
	SCR	117	1961
Boehringer v Bell-Craig	39 CPR	201	1962
Comm of Pat v Farbweke	41 CPR	9	1963
	SCR	49	1964

Description

Rhone-Poulenc v Gilbert	55 CPR	207	1968
Burton Parsons v Hewlet	17 CPR (2d)	97	1976
	1 SCR	555	1976
Marzone v Eli Lilly	37 CPR (2d)	37	1978
Proctor & Gamble v Bristol	39 CPR (2d)	145	1978
	42 CPR (2d)	33	1979
Monsanto v Comm of Pat	42 CPR (2d)	161	1979
	2 SCR	1108	1979
Consolboard v MacMillan	56 CPR (2d)	145	1981
Radio Corp v Hazeltine	56 CPR (3d)	170	1981
Shell Oil v Comm of Pat	2 SCR	536	1982
	67 CPR (2d)	1	1982
Corning v Canada Wire & Cable	81 CPR (2d)	39	1984
Hy Kramer v Lindsay	9 CPR (3d)	297	1986
Lubrizol v Imperial Oil	33 CPR (3d)	11	1990
	45 CPR (3d)	449	1992
TRW Inc v Walbar	39 CPR (3d)	176	1991
Welcome v Apotex	39 CPR (3d)	289	1991
Haul-All v Shanahan	50 CPR (3d)	368	1993
Unilever v Procter & Gamble	47 CPR (3d)	479	1993
	61 CPR (3d)	499	1995
Feherguard v Rocky's	53 CPR (3d)	417	1994
	60 CPR (3d)	512	1995

novelty in utility

Wright v Brake Service	Ex CR	127	1925
Pope Appliance v Spanish River	Ex CR	28	1926
Candian Gypsum v Gypsum Lime	Ex CR	180	1931
Mailman v Gillet	SCR	724	1932
Lanlois v Roy	Ex CR	197	1941
Northern Electric v Browns	SCR	224	1941
Shell Oil v Comm of Pat	2 SCR	536	1982
	67 CPR (2d)	1	1982

best mode (undue experimentation)

TRW Inc v Walbar	39 CPR (3d)	176	1991
AT&T Tech v Mitel	26 CPR (3d)	238	1989
Mobil Oil v Hercules	3 CPR (3d)	473	1995
	57 CPR (3d)	488	1994

insufficiency of disclosure

French's Complex v Electrolytic	ExCR	94	1927
	SCR	462	1930
BVD Co V Canadian Celanese	ExCR	139	1936
Low v Hawley Products	1 DLR	15	1940
Mineral Separation v Noranda	12 CPR	99	1950
	69 RPC	81	1952
Di Fiore v Tardi	16 CPR	18	1952
Boehringer v Bell-Craig	39 CPR	201	1962
Rhone-Poulenc v Gilbert	55 CPR	207	1968
Gilbert (Gillcross) v Sandoz	64 CPR	14	1970
	SCR	1336	1974
Leithiser v Pengo Hydra-Pull	12 CPR (2d)	117	1973
	2 FC	954	1974
Xerox v IBM	33 CPR (2d)	24	1977
Re: Farbwerke Hoechst	13 CPR (3d)	212	1980
Ductmate v Exanno	2 CPR (3d)	289	1984
Corning v Canada Wire & Cable	81 CPR (2d)	39	1984
Pioneer Hi-Bred v Com of Pat	14 CPR (3d)	491	1987
	25 CPR (3d)	257	1987
Cabot Corp v 318602 Ont	20 CPR (3d)	132	1988
Reliance v Northern Tel	28 CPR (3d)	397	1989
	44 CPR (3d)	161	1992
	47 CPR (3d)	55	1993
Rothmans, Benson & Hedges	35 CPR (3d)	417	1991
TRW Inc v Walbar	39 CPR (3d)	176	1991
Computalog v Comtech	44 CPR (3d)	77	1992
Allied v Du Pont	52 CPR (3d)	351	1993

Description

	50 CPR (3d) 1	1993
Mobil Oil v Hercules	57 CPR (3d) 488	1994
	63 CPR (3d) 473	1995

consistency clause

Reliance Electric v Northern	47 CPR (3d) 55	1993
Re: Appln 122,906	52 CPR (2d) 135	1978

object statements

Amfac Foods v Irving Pulp	12 CPR (3d) 193	1986
	80 CPR (2d) 59	1984
Saunders v Airglide	50 CPR (2d) 6	1980
Johnston Controls v Varta	80 CPR (2d) 1	1984
Reliance v Northern Tel	28 CPR (3d) 397	1989
	44 CPR (3d) 161	1992
	47 CPR (3d) 55	1993

variance/omnibus clause

Mico Products v Acetol	ExCR	64	1930
Leithiser v Pengo Hydra-Pull	12 CPR (2d)	117	1973
	2 FC	954	1974
Amfac Foods v Irving Pulp	12 CPR (3d)	193	1986
	80 CPR (2d)	59	1984