



## AIPPI's Resolutions Relating to Sufficiency of Disclosure

*Prepared by Standing Committee on Patents*

### About AIPPI

The International Association for the Protection of Intellectual Property (Association Internationale Pour la Protection de la Propriété Intellectuelle ("AIPPI")), is an international organization, founded in 1897, dedicated to the development, improvement, and legal protection of intellectual property. AIPPI is a politically neutral, non-profit organization headquartered in Switzerland having over 9,000 members representing over 125 countries and operating mainly through National Groups in many of those countries and other regions.

The members of AIPPI include intellectual property lawyers, patent, copyright and trademark attorneys, and patent agents in corporate and private practice throughout the world, as well as academics and other persons interested in intellectual property, and including members from North America, South America, Europe, Asia, Australia and Africa. AIPPI is organized into 67 National and 2 Regional Groups, and its members participate by joining one of these groups.

AIPPI promotes the protection of intellectual property on a national and international basis by studying and comparing existing laws and proposing new laws and international and regional treaties and agreements relating to intellectual property. In its long history, AIPPI has adopted more than 700 Resolutions and Reports. AIPPI's Resolutions are published in English, French and German, and are provided to international and national intellectual property organizations around the world. The presentation of these Resolutions and Reports to international Governmental Organizations, such as the World Intellectual Property Organization ("WIPO"), has contributed considerably to the development, improvement and harmonization of the international protection of intellectual property.

## Sufficiency of disclosure

Most, if not all, patent systems around the world require that an invention is disclosed in such a way as to enable the skilled person to perform the invention. This is, inter alia, reflected in article 29.1 of the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS Agreement), which reads *“Members shall require that an applicant for a patent 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 [...]”*

The rationale for this requirement is that patent holders are given exclusive rights to prevent others from commercial exploitation of the patented invention in return for disclosing the invention to the public. This public disclosure function of the patent system is considered as one of the important rationales of the patent system itself and one of the pillars that justifies the system. It is through the disclosure requirement that the patent system facilitates the dissemination of information and access to technological knowledge contained in a patent application. This allows the public to benefit from the technological advance that the invention provides, to use it as a basis for further technological developments and to avoid duplicative research and development.

The manner and order of drafting a patent application to fulfill the requirement of sufficiency of disclosure differ from one country to another. AIPPI has studied this requirement on several occasions, both separately as the subject of a dedicated study question and as part of study questions devoted to other subjects.

## Resolutions of AIPPI

In reviewing the body of work of AIPPI, numerous Resolutions have discussed the requirement that an invention be sufficiently disclosed in a patent application, or have touched upon issues relating to the sufficiency of disclosure. These include:

- Resolution on Q69 - "Sufficient description of the invention" (Munich, 1978)
- Resolution on Q82 - "Patent protection for biotechnological inventions" (Rio de Janeiro, 1985)

- Resolution on Q142 - "Breadth of claims, support by disclosure and scope of protection of patents" (Rio de Janeiro, 1998)
- Resolution on Q150 - "Patentability requirements and scope of protection of expressed sequence tags (ESTs), Single Nucleotide Polymorphisms (SNPs) and Entire Genomes" (Sorrento, 2000)
- Resolution on Q213 - "The person skilled in the art in the context of the inventive step requirement in patent law" (Paris, 2010)

The following summarizes the Resolutions of AIPPI on the subject of sufficiency of disclosure.

Resolution Q69 addressed the issue of sufficient description of the invention. As a starting point and overarching principle, the Resolution states, "[t]he description (of the patent or patent application) 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." This general principle was reaffirmed in Resolution Q142 (1998).

Resolution Q69 then provides more specific commentary on the constituent elements of this principle.

#### Sufficiently clear and complete

The assessment of whether the description is clear and complete is to be qualitatively based on considering the description as a whole. 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.*" To be clear, "*it should not include any obscurity or ambiguity.*" The Resolution notes that, "*[d]ifficulty 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.*"

AIPPI's Resolution on Added Matter (2016) also touches upon sufficiency of disclosure. This Resolution highlights the importance of assessing the sufficiency of a disclosure from the viewpoint of a person skilled in the art. The content of the application as filed should be interpreted: a) to include what is explicitly disclosed in the application as filed; and b) to include what is implicit or inherent in the application as filed to a person skilled in the art, using their

common general knowledge as at the filing date. Also, a claim is supported by the disclosure if it may be understood by the person skilled in the art to be an embodiment of the invention as disclosed in the application as filed, notwithstanding that the claim may only include a subset of features disclosed as an embodiment or include features in addition to a disclosed embodiment.

This is consistent with Resolution Q69 which provides that a complete and clear description, *“shall not be considered deficient for the sole reason that one of the formal indications required to constitute its content has been omitted.”* From the viewpoint of the person skilled in the art, the *“formal indication”* that is omitted from a disclosure may be merely *“implicit or inherent in the application as filed to a person skilled in the art”*. It is also in this light that Resolution Q69 states that *“[t]here is no reason to require that the description should supply the best mode of carrying out the invention.”* See also below.

#### The person skilled in the art

With regard to the level of skill of the person skilled in the art, Resolution Q69 says, *“[t]he person skilled in the art is one of average knowledge and average ability”* and *“[t]he 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.”* With regard to the *“art”* at issue, the Resolution clarifies that, *“[w]here 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.”*

Resolution Q213 (2010), provides further comment on the characteristics of the person skilled in the art. This person is able to perform routine experimentation and research and can be expected to draw predictable solutions from the prior art. In certain technologies, the person skilled in the art may be a team comprising members from different disciplines.

### For the invention to be carried out

Resolution Q69 states that the description will be 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.*” This does not mean that it must contain all indications for the practical realization of the invention, *i.e.* the know-how. The latter is the realm of implementation and industrial exploitation, which should not be confused with the realm of the invention. The mere fact that a description is difficult to understand or imperfect should not solely be used as the basis for finding the description inadequate.

### Date of assessment

The assessment of sufficiency should be made in light of the knowledge and abilities of a person skilled in the art as at the filing date or the priority date.

### Structure of the description

Resolution Q69 suggests that there is an interest in presenting the description in a fairly uniform manner. To this end, it suggests that certain rules “*can be admitted*”:

1. The patent should situate the invention in the appropriate context of the state of the art. In this respect, the title should give its technical designation and the technical field should be indicated. The state of the art should be indicated, but only for the elements necessary to understand the invention.
2. The detailed description is then presented to define the invention. This is to be done first through defining a problem and proposing a solution<sup>1</sup>. The essential means and concrete modalities of its implementation are then to be described. There is no reason to present advantages. At least one detailed embodiment should be given. The best

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<sup>1</sup> While it is AIPPI’s position that setting out a problem and a solution in the description is to be recommended for the sake of sufficiency of disclosure, this does not imply that the so-called “problem-solution approach” as developed by the European Patent Office is to be followed for the assessment of inventive step. AIPPI considers the “problem-solution approach” as an effective approach, but not the only approach for the assessment of inventive step.

mode need not be described, since it may not be possible to determine and best mode typically relates to industrial implementation details, not the invention itself. The description also need not detail detrimental effects on the environment.

3. Drawings should be an integral part of the description if appropriate.

### Biotechnological inventions

Resolution Q82 (1985) states that biotechnological inventions should be protected by the application of the general principles of patent law and that the creation of a special body of law is not necessary. This means that the standard “sufficiency of disclosure” criteria of national laws should be applied to biotechnological inventions. Resolution Q150 (2000) confirms that AIPPI’s position as set out in Resolution Q82 applies to new kinds of the biotechnological inventions such as EST, SNPs, and entire genomes.

Resolution Q82 also states that if a written description is sufficient to make a living organism, or other biological material, available to a person skilled in the art, then a deposit of the organism/biological material should not be required, but nevertheless, a deposit should always be considered as completing the requirement of sufficient disclosure particularly in relation to the repeatability of the invention.

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