Claims Drafting :

Defining the Scope of Search and Examination

Kuala Lumpur, November 2011

Dr. Wolfgang Tauchert
Presiding Judge (German Fed. Patent Court) ret.

---

Claims Drafting – Claims Form and Function

1) Function

Art. 84 EPC:
“The claims shall define the matter for which protection is sought. They shall be
- clear,
- concise and
- supported by the description.”

Art. 69(1) EPC:
“The extent of the protection conferred by a European patent or a European patent application shall be determined by the terms of the claims. Nevertheless, the description and drawings shall be used to interpret the claims (see also Protocol to Art. 69).”

Tauchert/Kuala Lumpur 2011
Claims Function:
(“The Name of the Game is the Claim”)

Rule 29(1) (Guidelines C-III, 2.1)
„The claim shall define the matter for which protection is sought in terms of the technical features of the invention“;
(similar in other legislations).

1) Claims define the subject of protection therefore and corresponding (broad/narrow)

2) claims define equally the subject of search and examination,

Tauchert/Kuala Lumpur 2011

Claims shall define the invention by words.
i.e. by the technical (structural and/or functional) features of the invention
There is no invention outside the claims
(even if it were, it wouldn´t matter; this sounds natural, but is often overseen in the process of examination).

The skilled person (assessing patentability) has the same level of knowledge and experience in understanding and interpreting the claimed application and the state of the art

Tauchert/Kuala Lumpur 2011
Form of a Claim

Basic structure:

- Introducing part (Category, purpose..)
- body (specific legal description of the invention by structural and/or functional features)
- link (words/phrases like comprising, including, consisting of ....
- one part claim - ) or

characterized in (- two part claim)

Dependent - / independent claim

Formally: with / without reference to another claim within the same category
Substantive: Further specification of an independent claim.

Important: An independent claim has to present an independent solution of the underlying objective problem of the invention.
Otherwise: Lack of Unity!

Tauchert/Kuala Lumpur 2011
Form of a Claim

One part - / two part claim

Dependent - / independent claim

Basic types (categories) of claims:

1) Type entity: Product, apparatus, device.
2) Type activity: Process, method, use.

Further on: Special types, e.g.:
1st and 2nd medical use, product-by-process, Markush grouping, disclaimer

Tauchert/Kuala Lumpur 2011

---

Form of a Claim: One Part / Two Part
(Rule 21(1)b EPO Guidelines)

One part claim:

Presentation of the essential characteristics of the invention without structure as to state of the Art.
Example:
„Apparatus comprising features A, B, C, D ….“

Two part claim:
Presentation of the essential characteristics of the invention with a structure according to the state of the art (so far as known)
„Apparatus with features A, B, characterized by features C, D … characterized in that features C, D …are comprised.

Invention comprises all features of the claim!

Tauchert/Kuala Lumpur 2011
Form of a Claim: One Part / Two Part
- Handling

One part claim:

Each of the essential characteristics of the invention (= the claim!) has to be referred to in state of the Art, as far as known.
Example:
„Apparatus comprising features A, B, C, D .....“

Doc. 1) provides an apparatus showing feature A; Doc. 2) shows an apparatus with feature C) ....

General: If there is no clear single starting document in the state of the art giving the base fort the invention, then a one part claim can be useful and taken into consideration.

Invention comprises all features of the claim!

Tauchert/Kuala Lumpur2011

---

Form of a Claim: One Part / Two Part
- Example

One part claim:

From: Int. Application Nr. PCT/IB2003/005958
1) A Method of producing a soya bean product, the method including the step of exposing soya beans to an acidic aqueous solution.
2) A method as claimed in Claim 1, in which the acidic aqueous solution has a pH of between about 2.0 and 5.5.
3) A method as claimed in Claim 1 or Claim 2, in which the soya beans are whole beans
4) A method as claimed in any one of the preceding claims which includes the prior step of dissolving an organic acid in water to produce an aqueous acidic solution.
5) A method as claimed in Claim 4 in which the organic acid is citric acid.

Tauchert/Kuala Lumpur2011
Form of a Claim: One Part / Two Part
- Handling

Two part claim:

Introductory part – characterizing part
Category, purpose, general - specific features
Link: characterized in ... or characterized by....

The introductory features of the invention are generally supposed to be known to the applicant. (US: definitely state of the art; Europe: Closest st.o.a) the characterizing features form the body of the invention with the specific features to be protected, introduced by „characterized in ....(as far as known) „Apparatus with features A, B, characterized by features C, D ....

If there is a document in the state of the art giving the clear base for the invention, then a two part claim is to be considered and useful. It should be applied “whenever appropriate” (EPO-practice).

Tauchert/Kuala Lumpur 2011

Form of a Claim: One Part / Two Part
- Example

Two part claim:

1) A dining table having legs evenly distributed around the periphery of the table top, which legs do not protrude beyond said periphery, characterized in that the table has three legs.

2) A dining table according to Claim 1 characterized in that the legs are made of ply wood.

.../...

Invention comprises all and only the features of the claim!

Tauchert/Kuala Lumpur 2011
Independent Claims

- No substantial reference to any other claim/ independent solution of the underlying objective problem (unity!)

- Often: ONLY ONE PER CATEGORY (product, process, use, apparatus/device…
- except if
a) alternative independent solutions of the same (objective) problem are to be considered (e.g. several processes to obtain one and the same product or
b) with interrelated products (plug and socket, receiver/transmitter).

Dependent Claims

- Refer to one or more dependent and/or independent claim:
  Apparatus according to claim 1 / claim 1 – n / one of the claims 1 - n further comprising …
  characterized in that it further …

- give further limitations/specifications to the claims referred to;
- show preferred embodiments – „fall back positions“ if claim 1 fails;
- contains all the features of the claims referred to plus ist own features.
! Check initial file covering!
Basic Types of Claims - Categories

- Product (compound, material, fabric..)

- Apparatus/device

- Process (method for producing something, doing something .....); ! product obtained by the process is automatically protected with it!

- Use (of a product to obtain a specific result; use claim is a special type of process claims

Interpretation of Claims
- Rules for Practitioners -

(Non-)limitations:

- „Apparatus for ...“, „apparatus suitable for..“ (purpose): Not limiting (except purpose describes subjects constructive features – fishing hook/coat hook).

- Optional features, alternatives (especially, particularly): Not limiting the scope, neither in protection nor in search.

- S-M... comprising: open i.e. (a+b+others) S-M..consisting of: limiting i.e. (a+b only)
Interpretation of Claims – Specialities

- Process claim: Protection extends to the product directly obtained (Art. 64(2) EPC)
- Use claim = process claim!
- Product – by – process claim: only if no other definition possible!

Interpretation of Claims – Specialities
to obtain appropriate protection

- 1st and 2nd medical use claim:
  „Use of a known substance or composition for a new treatment“
  substance X as pesticide“

- „Use of substance X for producing a medicament for the treatment of C („Swiss type“)“

- Markush grouping (multiple references):
  „X selected from the group consisting of a, b, c, d, e, f and g and any combinations thereof.“
Final Highlighting in Claim Drafting

- Be clear (objective facts instead of subjective judgement).

- Be complete (covering all inventive features in a proper context).

- Be supported (all parts of the claims must (should) be fully explained in the description).

- Be -- literally, word-for-word -- covered by the initial disclosure.

Tauchert/Kuala Lumpur 2011

Thank You

? Questions?