

Topic 7: Specific Types of Claims

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September 4, 2018

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Main Category of Claim

- ✓ Product

Physical entity: device, apparatus, system, etc.

- ✓ Method

Activities: method of analysis, method of manufacture, etc.

Product Claim

Example:

An apparatus for supporting a camera, comprising:

a pivotal mounting configured to hold the camera;
and

a plurality of legs arranged to support the pivotal
mounting.

- ✓ List the essential elements of the invention

Method Claim

Example:

A method of making tea, the method comprising:

boiling water;

adding sugar to the boiling water;

adding tea leaves to the boiling water to form a mixture;

filtering the mixture; and

adding milk to the mixture.

- ✓ Steps may be recited in order of performance, but are usually interpreted as being performed in any order unless otherwise specified.

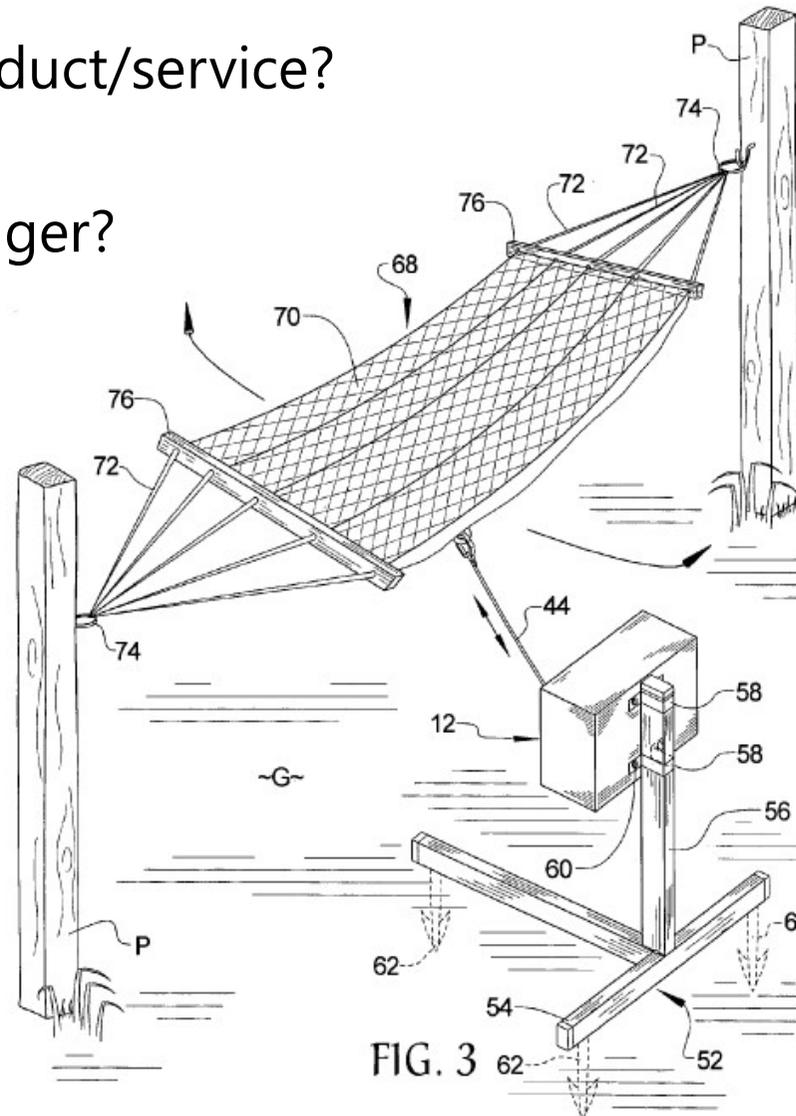
Product Claim vs Method Claim

- ✓ Product claim is easy to find/prove infringement, while method claim is not.
- ✓ For direct infringement of method claim, a single entity must perform all the steps of the method.
- ✓ Better not much rely on indirect infringement.
- ✓ Who will be an infringer?

Where is the place to sell/manufacture?

What is the product/service?

Who will be an infringer?



Who will manufacture? Who will be an user?

Claim 1:

A swinging assembly comprising:

a housing;

a motor disposed within the housing;

a source of electrical power for powering the motor;

a crankshaft disposed within the housing and operationally connected with the motor such that motor operation causes crankshaft rotation;

a cable having a first end attached to the crankshaft and a second end adapted to be secured to a **hammock**, the cable protruding through an opening on the housing; ...(omitted)

✓The hammock is not recited as an element

✓Can be written as method claim also

Component Claim vs Product Claim

- ✓ Should we claim a novel component or a product containing the component?
- ✓ If possible, try both!
 - The component may be applicable to more than a single product
 - An infringer might only produce the component, not the product
 - The product might be more valuable for licensing, as it gives argument for the bigger royalty base

Manufacturing Method Claim

- ✓ Example:

A method for producing a device, comprising:

preparing a substrate;

making a reflection layer on the substrate; and

cutting the substrate to obtain a device.

- ✓ Manufacturing method claim covers the product produced by the manufacturing method under Japanese patent law.

- ✓ Verify: Is it possible to determine whether the product was produced by the manufacturing method?

(Reverse Engineering)

Product-by-Process Claim

- ✓ Specify a product by the process of manufacture
 - Some jurisdictions treat as product claim
 - Other jurisdictions treat as method claim
- ✓ Example: A semiconductor device obtained by a process comprising the steps of ...
- ✓ What if a third party produces the product by other method?
- ✓ Verify: Is product-by-process claim the best approach for protecting the invention?

Chemical composition (Product)

Example :

A copper electroplating solution comprising:

an alkaline solution of copper sulfate, from 30-50 grams per liter;

sulphuric acid, from 2-4 times the copper acetate solution; and

an aqueous solution of a PH-modifying substrate in an amount sufficient to adjust the PH to a value of from 3.5-5.

Software Claim (Product)

- ✓ Program: not allowed in some jurisdictions
- ✓ Can be claimed as computer-readable storage medium

Example:

A computer-readable storage medium storing instructions that when executed by a computer cause the computer to perform a method for using a computer system to {function}, the method comprising:

Use Claim

- ✓ Similar to method claim
- ✓ Example 1: The use of substance X as an insecticide ...
- ✓ Example 2: The use of a transistor in an amplifying circuit ...

- ✓ May be interpreted as method claim
- ✓ Not allowed in all jurisdictions

Second Medical "Use" Claim

Suppose chemical compound XYZ is already known, and has been used to treat diabetes.

Assume that Inventor A discovers that compound XYZ is an effective medicament for the treatment of malaria.

Example: The use of compound XYZ in the manufacture of a treatment for malaria.

- ✓ Also known as Swiss-type claim
- ✓ Helpful when substance is already known in the art
- ✓ Not allowed in all jurisdictions

Two-part Form (Europe)



- ✓ A writing device comprising:
 - a pencil;
 - an eraser attached to one end of the pencil; and
 - a light attached to a middle part of the pencil.

- ✓ A writing device comprising:
 - Prior Art** (indicated by an arrow pointing to a red-bordered box):
 - a pencil; and
 - an eraser attached to one end of the pencil;
 - Novel Features** (indicated by an arrow pointing to a blue-bordered box):
 - characterized in that** the writing device further comprising a light attached to a middle part of the pencil.

Thank you for your kind attention!

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