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Intellectual Property Office
of the Philippines



■ Topic 6: Specific Types of Claims

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Roadmap

1. The Usual Categories
2. What infringes each?
3. When you can have each?
4. Claims for complex systems – i.e. telecoms, computing
5. Claims for life science inventions

Categories of claim

- The basic categories are:
 - Product claims – these recite a thing.
 - Process claims – these recite a method.

- These are often linked:
 - A new product may be made by a new process;
 - *To put it differently, a new process may result in a new product;*
 - A new process may be performed using a new apparatus;
 - *To put it differently, a new product may be put to a new use.*

Types of Product Claim

- The product which will be *sold*;
- The product *made* by a process;
- The product for *making* a product which will be sold;
- An *intermediate* product made during a process;
- A *component* sold separately;
- A *combination* of several products to make a larger product or a system;
- A *kit* to make up a product.

Types of Process Claim

- A method of *making X*
- A method of *using X*/Use of X to
- A method of *treating X*

- *Usually* reciting a series of steps
- *Usually* (but not necessarily always) in order performed
 - May be difficult if using the European “2 part” form

Crossover-type claims

- Sometimes, the new thing about a process claim is a product feature
 - *E.g. Use of X to cure the common cold*
- Likewise, sometimes, the new thing about a product claim is a process feature
 - *E.g. A digital filter which performs a Fourier transform*
- Usually no official objections issue about having both types of claim present in the same application
 - But depends on national law

PCT Administrative Instructions Ann. B

(e) Combinations of Different Categories of Claims. The method for determining unity of invention under Rule 13.2 shall be construed as permitting, in particular, the inclusion of any one of the following combinations of claims of different categories in the same international application:

(i) in addition to an independent claim for a given product, an independent claim for a process specially adapted for the manufacture of the said product, and an independent claim for a use of the said product, or

(ii) in addition to an independent claim for a given process, an independent claim for an apparatus or means specifically designed for carrying out the said process, or

(iii) in addition to an independent claim for a given product, an independent claim for a process specially adapted for the manufacture of the said product and an independent claim for an apparatus or means specifically designed for carrying out the said process,

Who infringes? TRIPS Art. 28

■ Product claim

- Anyone making, importing or supplying the product
- Anyone using the product – *except for private, non-commercial uses*

■ Process claim

- Anyone using the process – *except for private, non-commercial uses*
- Anyone importing or supplying at least the **direct product of the process**, or using it – *except for private, non-commercial uses*

Enforcement Issues

- Usually simple to detect infringement of a product claim
 - Buy the product, and
 - Look for the integers of the claim!
- May be harder to detect infringement of a method claim
 - Methods are usually carried out privately
 - Special burden of proof rule for process producing a new product - PCT Art 34
- For a telecoms or IT system, different players may operate different parts of the system – even in different countries – does anyone infringe?

When can't you have them all?

- Process is excluded from patentability: (e.g. a medical method in Europe), or
- Process is carried out privately and non-commercially (e.g. a method of contraception)
 - Can patent a new product for carrying out that process, but not the process itself
- Product is not new in itself
 - Can patent a new process for making the product, but not the product itself (special rule for medicines!)
 - Can patent a new use of the product.

Computer implemented inventions

- Different rules in different jurisdictions.
- Computing separates hardware from software
- So, a new computer-implemented invention may run on conventional hardware – only the software is new
- However, legally, a computer running a new program is effectively a “new computer” – it behaves in a new way.
- So in most countries it is possible to claim either:
 - A method of doing X using a computer, or
 - A computer programmed to do X
- Patentability depends on whether **doing X** is patentable

Excluded computer methods

- Purely mathematical methods – i.e. “doing X” is just performing a calculation
- Purely business methods – i.e. doing X” is just a financial process
- Beyond this, everything depends on which country you are talking about

Claiming computer-implemented inventions

- A computer programmed to ...
- A method of ... implemented on a computer
- A computer-readable storage medium containing ...
- A computer program product ...
- A computer program ...
 - A computer program for carrying out the steps of ...ing
- A signal (Europe only?) produced by encoding data by the steps of ... ()).

System and method example

1. A system for searching the Internet, said system comprising: a software module configured to perform a search; a database configured to store results produced by the search; and a user interface configured to present the search results to a user.
2. A method for performing an Internet search, the method comprising: transmitting a search request over the Internet from a software module; receiving search results over the Internet from the search request by the software module; storing the search results in a database; and presenting the search results to a user through a user interface.

Software Claims – referring back

- Example (assume claims 1 to 10 are method claims)

11. An apparatus/device/data-processing system comprising means for carrying out [each of the steps of] the method according to any one of claims 1 to 10.

11. An apparatus/device/data-processing system comprising a processor and a memory and being configured to perform [the steps of] the method according to any one of claims 1 to 10.

Software Claims – non-referring

- Alternative example, if referring back is not allowed:

11. *A data-processing system comprising:*

means for sending, from a client to the server, which is in a standby mode, an activation signal, wherein the activation signal is adapted to transfer the server from the standby mode to the fully activated mode;

means for receiving, by the server, the activation signal; and

means for transferring the server from the standby mode to the fully activated mode in response to the reception of the activation signal.

Software Claims - computer-readable medium

1. *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 {a specified function}, the method comprising:*

System Inventions

- “Client-server” type processes
 - Client side software accessible
 - Server-side software inaccessible – infringement?
 - Server may be located anywhere in the world - covered by filing program?
- Telecoms networks
 - Elements may be anywhere - including space!
 - Some processes performed “in the network” – anywhere in the world
 - Handset patents get higher royalties

Problems with this claim?

1. A method for dispensing candy, comprising: sending a request from a client computer to a server computer for candy located in a candy store; sending candy store video data from the server computer to the client computer; displaying the candy store video data on the client computer, wherein the displayed candy store video data provides a visual representation of the candy store to enable a user of the client computer to provide directions for a robotic arm located in the candy store; sending robotic arm direction instructions from the client computer to the server computer; converting the robotic arm direction instructions into native machine robotic arm direction instructions for the robotic arm at the candy store, wherein the native machine robotic arm direction instructions actuate the robotic arm to fill a candy bag with candy; sending a shipping instruction from the client computer to the server computer; and converting the shipping instruction into a native machine robotic arm shipping instruction for the robotic arm, wherein the native machine robotic arm shipping instruction actuates the robotic arm to place the candy bag in an open box and seal it for shipping.

Client side separated

2. A method for dispensing candy, comprising: receiving at a client computer candy store video data; displaying the candy store video data on the client computer, wherein the displayed candy store video data provides a visual representation of a candy store to enable a user of the client computer to provide directions for a robotic arm located in the candy store; sending robotic arm direction instructions from the client computer, wherein the robotic arm direction instructions cause the robotic arm at the candy store to fill a candy bag with candy; and sending a shipping instruction from the client computer, wherein the shipping instruction causes the robotic arm to place the candy bag in an open box and seal it for shipping.

Server side separated

3. A method for dispensing candy, comprising: sending candy store video data from a server computer to a client computer, wherein the candy store video data provides a visual representation of a candy store to enable a user of the client computer to provide directions for a robotic arm located in the candy store; receiving robotic arm direction instructions at the server computer from the client computer; converting the robotic arm direction instructions into native machine robotic arm direction instructions for the robotic arm at the candy store, wherein the native machine robotic arm direction instructions actuate the robotic arm to fill a candy bag with candy; receiving a shipping instruction at the server computer from the client computer; and converting the shipping instruction into a native machine robotic arm shipping instruction for the robotic arm, wherein the native machine robotic arm shipping instruction actuates the robotic arm to place the candy bag in an open box and seal it for shipping.

Telecoms claims

- “Mirror” claims are typical
 - Method of coding, method of decoding
 - Method of transmitting, method of receiving
 - Program for coding, program for decoding
 - Coder, decoder
 - Transmitter, receiver
- May also include
 - Claim to network node
 - Method performed at node
 - Claim to whole system
 - Claim to whole method
 - Claim to “signal”

Thank you very much!

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