Topic 9: Claim Drafting Techniques

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Patent Claim Design

The Claims --

- Represent the heart of the patent application
- Define the scope of protection given to an invention
- Are usually the first and sometimes the only parts of patent application actually reviewed by the patent examiner
Drafting Patent Applications

Once the patent agent understands the invention, then he can begin preparing the patent application.

Prepare draft claims for the invention as the first step.

The patent agent may want to sketch out draft claims in the disclosure meeting with the inventor.

This procedure will often confirm for the patent agent has understood the invention - immediate feedback from the inventor.
Drafting Patent Applications

■ In the initial draft claims, the patent agent may wish to use a “picture” claim
  ■ A picture claim essentially “draws a picture” of the invention in words
  ■ A picture claim is not typically the broadest claim & does not use highly abstract language
  ■ But a picture claim can be helpful in beginning the process of finding the broadest possible claim
Drafting Patent Applications

- A picture claim may be helpful in the initial meeting with the inventor since inventors are often unfamiliar with patent claim language.
  - The patent agent will likely develop the most abstract terms possible for the claims later after further consideration of the invention.
One part / two part form

CLAIMS in the TWO-PART FORM

Nr.  PREAMBLE,  CHARACTERISED BY IN THAT  CHARACTERISING PORTION
Patent Claim Design

- In summary: Prepare the claims first
  - Write draft claims before preparing the description, drawings, etc.
  - Discuss the draft claims with the inventor early in the application drafting process
  - Review/revise the claims again once the specification has been completed
Claims

- The claims are the legally operative part of a patent application.
- The majority of patent agents prepare several draft patent claims as their first step in drafting a patent application.
- When the claims are prepared before drafting the specification, then the patent agent knows precisely which terms need to be described clearly in the description.
Claims

- After the patent agent has finished his draft description, then he must reconsider the claims.
- It is possible that after preparing the description, the patent agent may see that the draft claims do not describe the invention as accurately as possible.
- Once the patent agent has completed the final claim set:
  - He must carefully check the **drawings & description**.
  - To verify that the claim terms have been appropriately described & defined.
Claims and the Description

- The “detailed description” section, should:
  - Breath life into the claims,
  - Provide a sufficient disclosure of the invention that a skilled person in the relevant field could make & understand the invention,
  - Claims must be supported by the description
  - If the patent agent uses a highly abstract term in the claims, then he should use this term in the detailed description
  - Offers sufficient depth so that the claims can be narrowed during patent prosecution to avoid close prior art.
Patent Claim Design

- Include both broad and narrow claims
  - Include claims of varying scope
  - Consider claim sets of varying scope
    - Not just an independent claim followed by narrower dependent claims
Patent Claim Design

- Gives the client a range of options
  - Broad claims will catch a wider group of infringers
  - Narrow claims will be more likely to be “valid” in light of prior art not known during prosecution
- These options are not mutually exclusive
  - Give you client both options
Patent Claim Design

- Often, the patent agent can prepare dependent claims from things he removed from draft claims while writing broad claims.

- As a patent agent, you must be creative in order to obtain the maximum possible protection.
Theory of the Patent Claim

- Patent Claims must:
  - Define the invention for which patent protection is being sought,
  - Be clear and concise, and
  - Be supported by the description and drawings
    - Drafted in terms of technical features of the invention
Patent Claim Design

- Choice of words in claim
  - Be cautious
  - Words should capture invention as well as variants
  - Word meanings must be appropriate
  - Words must convey meaning and cover invention
Patent Claim Design

Choice of words in claim
- Watch out for “relative” words like
  - Fast, slow, long, short, tall, wide, perfect, complete, thin, strong, flat, etc.
- Unless the relationship lies with another recited element in the claim
  - Ex: “wherein the first piece is shorter than the second piece”
Patent Claim Design

- Choice of words in the claims
  - If you use a word established in a given technical field, make sure that you understand what the word means and doesn’t mean
    - Explain the word’s meaning in the description if necessary
  - If you use a new word in the claims, then make sure that you clearly establish its meaning in the description.
Patent Claim Design

- Choice of words in the claims
  - Avoid negative limitations in claims
    - “a tire that is not solid”
  - State limitations in positive terms
    - “a hollow tire”
  - Unless the limitation cannot be phrased in any other manner
    - “a non-black color”
Patent Claim Design

- The description must support the claim language
- Make sure every claim has adequate support in the specification
- Words and terminology should be consistent
- You don’t need to define terms already known in the industry – if you’re using them consistent with industry practice
Patent Claim Design

- Claim variations/modifications of the invention
  - Think about variations or other embodiments of the invention
- Think like a potential competitor trying to avoid the patent
  - Assume that the competitor has a piece of prior art that can knock out your broadest claim
- Incorporate alternative embodiments into the description and claim them
- Alternative embodiments broaden protection
Patent Claim Design

- Avoid unnecessary limitations
  - Delete all unnecessary limitations before filing claims
  - File only the limitations or essential technical features necessary to recite the invention in its broadest patentable form in the broadest independent claim.
Patent Claim Design

- If possible your claims should cover competing products
- But your claims must overcome the prior art
  - Be aware of related prior art
  - Do not file claims that you know to be invalid
  - Ideal to draft a narrower claim than prior art but broader than competing (non-prior-art) products
Patent Claim Design

- Use Multiple Claim categories for the same Invention
  - Useful to get broadest possible protection
  - Some competitors will infringe device claims but not method claims and vice versa
- Don’t include every type of claim just for the sake of inclusiveness – use your judgment
Category of claims

**INVENTION**

**PHYSICAL ENTITY**
- **PRODUCT**
  - a chemical compound
  - compounds for use as a pharmaceutical
  - composition mixture
  - alloy
  - food
  - drink
- **APPARATUS**
  - instruments
  - machines
  - a system of cooperating apparatus

**ACTIVITY**
- **PROCESS**
  - methods of preparation
  - methods of analysis
  - treatment
- **USE**
  - use of products
  - application of a process
  - use to prepare a medicament for the treatment of
Always think about who is the infringer?

DON’T MAKE YOUR CUSTOMER THE ONLY POSSIBLE INFRINGER.
Patent Claim Design

- Narrowing a patent claim during prosecution
  - Add new elements to the claims and/or
  - Add new limitations to existing elements
  - All new additions must be supported by the description – as filed
- Consider all relevant options in amending a claim
  - Do the least harm possible
- The client should understand the implications of any claim amendments
Example

1. (Amended) An apparatus, comprising:
   a pencil;
   an eraser attached to one end of the pencil;
   a light attached to the center of the pencil;
   and
   a removable cap attached to one of end of the pencil.
Patent Claim Design

- Claims & Exclusions from Patentability
  - Most jurisdictions explicitly exclude certain types of inventions from patenting
  - The patent agent can sometimes simply re-word a claim to bring it from an unacceptable invention class to an acceptable one
  - TIP: Be prepared to fight for the patentability of certain types of inventions.
Patent Claim Design

Claims & Exclusions from Patentability

- Ex. Strict rules exist in the biotechnology practice area due to public concern about patenting life and due to various moral concerns.

- However, thousands of biotechnology patents exist because patent agents have drafted claims that avoid the exclusions to patentability.

- Ex: Methods of treating the human body are excluded from patentability in certain jurisdictions but not « Swiss Type of claims ».
Methods of treatment claims - EP

Aim: to alleviate the health of a patient.

EX:

A method of treating diabetes characterized in that insulin is sequentially injected to a patient in need thereof, and the blood glucose is controlled.
Medical use claim - EP

Aim: to circumvent the interdiction.

EX:

  (formerly the Swiss type of claim)

- Use of compound X in the manufacture of a medicament for the treatment of diabetes.
Patent Claim Design

- At least one claim in the application should read on what the client is actually doing

  - Defending the client’s products against infringement may be difficult otherwise

  - Patent marking is also difficult