



# **CLAIM FORMAT**

Topic 4

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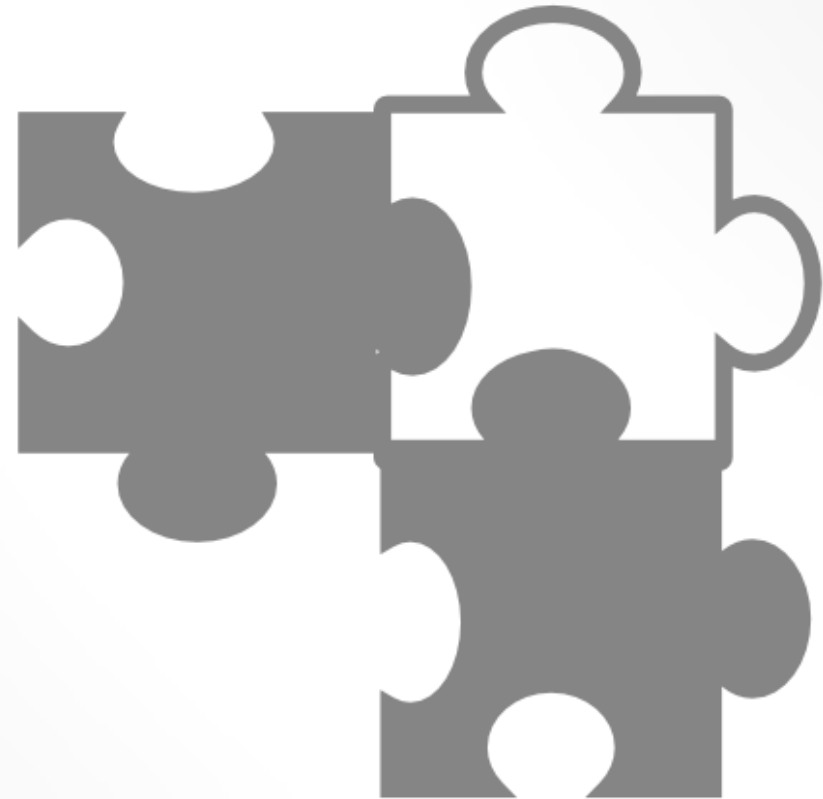
# PARTS OF A CLAIM

- Claims appear at the end of the written section of the specification
- Each claim is numbered
- Each claim is a single sentence
  - no full stops are used but paragraph numbers can be used:
  - eg, a light to illuminate a space comprising:
    - a transparent enclosure defining an airtight cavity;
    - a filament inside the cavity that has two terminals outside the cavity for engagement to a source of electricity to thereby be energised.
- Dependent and independent claims
  - independent claims are broadest
  - the claims that refer (directly or indirectly) back to the independent claims are narrower
  - why do dependent claims exist ?

# PARTS OF A CLAIM

Each claim has 3 parts:

1. Preamble
2. Transitional phrase
3. Body



# PREAMBLE

This is what the invention is about.

- The invention is about a rice cooker, then the preamble may read:
  1. *an apparatus for cooking rice...*
- The invention is about a method of making tea, then the preamble may read:
  1. *a method of making tea...*
- A patent can have multiple independent claims:
  1. *a method of making tea...*
  2. *an apparatus for making tea...*
- A patent can have independent claims and many dependent claims that directly or indirectly refer to the independent claims
  - the dependent claims use the same preamble language as their independent claim



# THE PREAMBLE AND PATENT SCOPE

- If the invention can be used for other purposes and not just the preferred purpose then think about broadening the preamble.
  1. an apparatus for cooking rice...
  2. an apparatus for cooking.....
- But be careful:
  - more prior art; and
  - support is needed in the detailed description, so don't go too broad.

# MULTIPLE INDEPENDENT CLAIMS

You can have multiple independent claims in a patent specification. The only limitation is:

- unity; and
- clarity.

# TRANSITIONAL PHRASE

Two types:

- Open = “comprising” – used 99% of the time.
- Closed = “consisting” – rarely used.

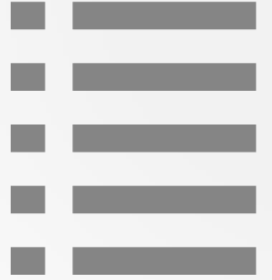
Relevant from an infringement point of view.

“

”

# BODY OF THE CLAIM

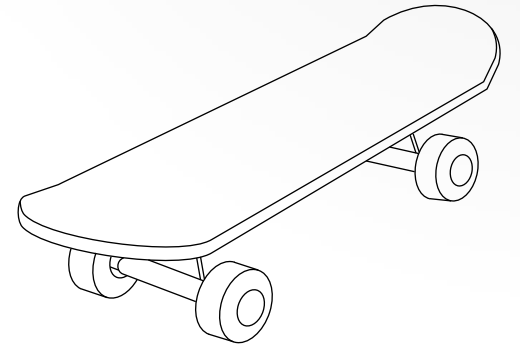
- The body follows the transitional phrase.
- It is usually a list of features of the invention glued together with words to make it one sentence.
  1. An apparatus for holding items, comprising:
    - at least one table leg; and
    - a top configured to support at least one leg.
- The body cannot be a list of parts. The relationship between parts must be explained.





# BODY OF THE CLAIM

- The structure of the body is dependent on the nature of the invention.
- Usually the first feature in the body is the core of the product that other components depend on.
  1. A vehicle comprising:
    - a deck;
    - a first pair of wheels coupled to the front of the deck; and
    - a second pair of wheels coupled to the back of the deck.
- To be valid, an independent claim must include at least one novel and inventive feature or combination of features.
  - usually much an independent claim is included in the prior art.
- The claim does not need to recite all features of the product, only enough features to ensure that the novel features are put in context.



# PARTS OF A CLAIM- TWO PART APPROACH

- The preamble of the claim sets out the most relevant known prior art and the body characterises the improvement of the invention.
- The preamble and body are connected by a specific transitional phrase that signals the claim is a two-part claim or Jepson claim.
- The preamble is the statement of the prior art, the transition is a phrase such as 'characterised by' and the body provides the novelty.

# EXAMPLE

1. A pencil having an eraser, characterised by a light attached to the pencil.



# MEANS-PLUS-FUNCTION CLAIMS

- Claims that recite elements that do not have specifically-defined structures but instead recite functions performed by structures disclosed in the specification.
- Interpretation varies from jurisdiction to jurisdiction and over time.

# MEANS-PLUS-FUNCTION CLAIMS

The format of a classic means-plus-function claim is the word “means” followed by a function.

1. An apparatus for cooking rice, comprising:
  - a means for holding rice; and
  - a heater configured to heat the rice-holding means.



# MEANS-PLUS-FUNCTION CLAIMS

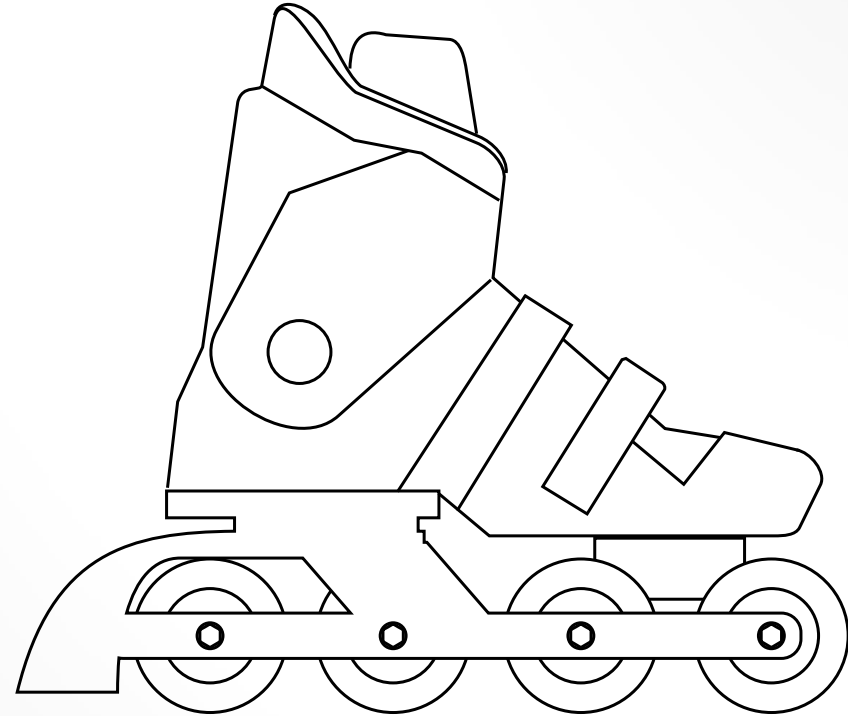
- Helpful in jurisdictions where such claims receive broader interpretation than claims that specifically recite a structural element.
- If you use means-plus-function clauses they must be accompanied by an adequate description in the specification that clearly defines a structure for carrying out the recited function.
- You should describe sufficient structure in the patent application regardless of the claim type being used.

# CLAIM PUNCTUATION

Seemingly arbitrary and antiquated rules around : ; and ,

## 1. Footwear comprising:

- a body into which a foot of a user can be contained;
- a sole secured to the base of the body;
- a plurality of in-line wheels secured to the sole and presented to be able to make rolling contact with the ground.



# ANTECEDENT

- The first time a feature is introduced in a claim, the word "a" or "an" is used.
- The next times the feature is referred to the word "the" is used.
  1. A device comprising:
    - a pencil; and
    - a light attached to the pencil.
- Terminology must be consistently used.
  1. A vehicle comprising:
    - a deck that is elongated and has a front and a back;
    - a first pair of wheels engaged to the front of the deck;
    - a second pair of wheels engaged to the rear of the deck.

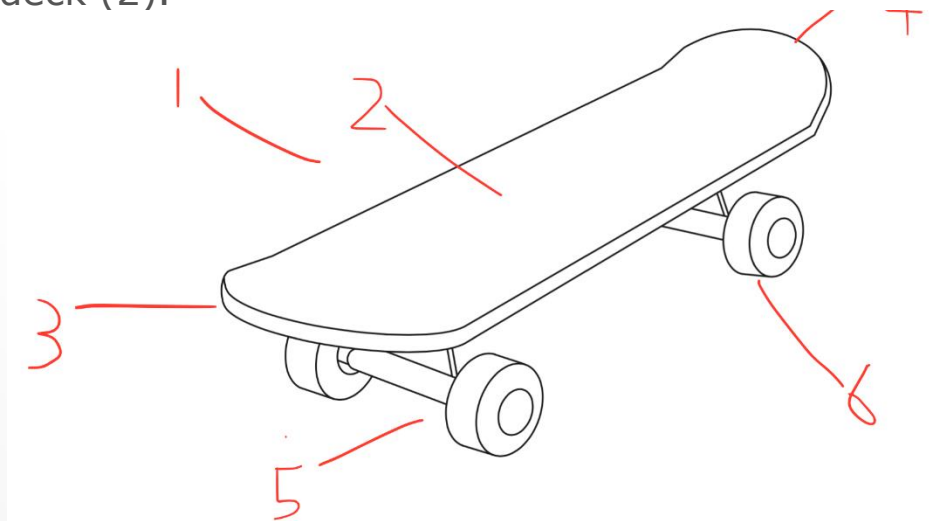


# REFERENCE NUMBERS

- In some countries reference numerals must be included in the body of the claim.
- Reference numerals relate to items shown in the drawings.
- The EPO usually requires this.

## 1. A vehicle (1) comprising:

- a deck (2) that is elongate and that has a front (3) and a back (4);
- a first pair of wheels (5) engaged to the front (3) of the deck (2);
- a second pair of wheels (6) engaged to the back (4) of the deck (2).



# OTHER POINTS

- Other glue words
  - whereby
  - wherein
    - ...a folder for keeping files, wherein the folder has multiple pockets.
- Don't use "or" to claim alternative elements.
  - Markush grouping approach.
- 1. Footwear comprising:
  - a body to receive and envelope a foot of a person;
  - a sole at the base of the body;
  - a plurality of wheels secured to the sole the plurality of wheels arranged in one of:
    - an inline arrangement, and
    - a side by side pairing.

