

■ Claim Format and Independent Claim

National Patent Drafting Course

**Chiang Mai, Thailand
October 2017**

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Independent claim

- Product claim
- Method claim
 - Are they different?
 - How?

Independent claim

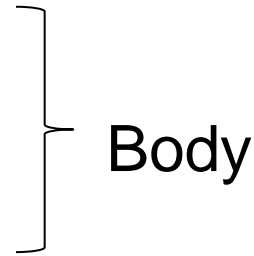
- Pure method
 - Method of testing / method of using a product
- Method/process for manufacturing a product
 - Use of compound A for producing a drug for a particular disease

- Product
 - Chemical compound or composition
 - Pharmaceutical composition
 - Pharmaceutical composition for treating a particular symptom

Form

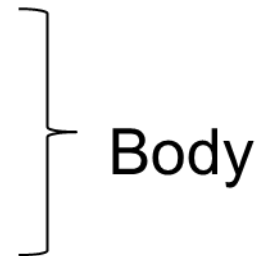
- A camera comprising:
- A,
- B,
- C, and
- D (plus tying features)

Preamble + Transition



- A method comprising the steps of:
- ...ing ...,
- ...ing ..., and
- ...ing

Preamble + Transition



What is claim drafting?

- It is an acquired skill
- No substitute for practice

Why wording of claim is important?...

- “Technical scope of invention” (Japan Patent Act Art. 70)
- Technical scope of invention shall be determined based on the terms in the claims
- Description and drawings shall be taken into consideration for interpreting each term in the claims

Why wording of claim is important?...

- The Supreme Court *Lipase Decision* (1991)
- “Unless special circumstances exist, the determination of the scope of invention has to be made based on the recitations in the claims. Only if special circumstances exist such as when the technical meaning of a recitation in the claim cannot be understood without ambiguities, or when it is apparently clear that such recitation is an error with reference to the detailed descriptions of the invention in the specification, it is permitted to refer to the detailed description of the invention in the specification. Description and drawings shall be taken into consideration for interpreting each term in the claims”

Why wording of claim is important?...

- The Supreme Court *Lipase Decision* (1991)
- The Supreme Court rejected the idea of reading a limitation from the specification into pending claims.
- The Tokyo High Court (now IP High Court) read "lipase" in the claim as the species "Ra lipase" because all examples in the specification in the context of the patent examination proceedings were for Ra lipase.

Why wording of claim is important?

- “All Elements Rule”
- All elements recited in a claim must be found in an accused product
- Otherwise, you will fail to prove the direct infringement

Rules

- Rule 1 - all rules have an exception
- Rule 2 - there is no single right answer
- Rule 3 - there are wrong answers

Two phases - First

- First, form a mental picture
- What is the point of the invention?
- What feature or combination of features allow this point to be achieved?

Two Phases - Second

- Form a mental picture and ask yourself more questions
- Understand the subject matter
- Turn-the-page technique
 - Close the PC or notes, try to explain the subject matter
- Ask questions
 - What does the invention do?
 - How does it do?

Caution!

- Statement of what you want to achieve is **not** a claim

The wine bottle problem

- simple corkscrew v. sommelier knife












What do you see?

- Remove cork from a bottle by screwing it into cork
- Rim of the bottle
- Four pics of a sommelier knife (plan, screwing, rim, pull)

- What does it do?
- How does it do?
- Sometimes the words say it all
 - A corkscrew
 - An apparatus for removing a cork from a wine bottle?
 - A bottle cork remover?
- Statement of what you want to achieve is **not** a claim

Functional analysis

- What the whole thing does?
 - Open the bottle
- What each required function is?
 - Something to hang on the rim of the bottle mouth
 - Something to engage with the cork in the bottle
 - Something to leverage
- Give a name to each “something”
 - “Means” may not be a good word to use
 - Expression to specify “structure” is required in many cases
- Does it work?  If not, use another approach

Balance is important – use broad v. narrow terms

- Mouse trap with clam-shell structure
- An apparatus for catching mice - rodent - animal (elephant? human?) - what?

Create a list

- Give it a name?
- What it does?
- How does it do?
 - Stationary v. what it does?

A helical element sharpened at one end to engage the cork by being rotationally embedded within

V

A cork engaging element

Bits?

- Three?

One

- What is it?
 - A handle v. a first member
- What does it do?
- How does it relate to other structures?
 - connected to the cork engaging element
- Should we specify how or where?

Two

- What is it?
 - An arm
 - A second member
- What does it do?
 - Bears against the bottle
 - connected to the handle
- Should we say?
 - pivotally
 - hingedly
 - movably

Three

- A cork engaging element
 - (Pivotally, or rotatably (which way?)) attached to the handle

Rough Claim

- A bottle cork remover comprising:
- a cork engaging element,
- a handle connected to the cork engaging element, and
- an arm pivotally connected with the handle to bear against the bottle and allow moving of the handle to exert a pulling force on the cork.

Check list!

- Are any of the terms **relative**?
- When is the claim infringed?
- Can we achieve the same result **without** one of the features?
- Have we claimed **prior art**?
- Are all elements connected or related with each other? - **no loose element**