

WIPO-MOST Intermediate Training Course on
Practical Intellectual Property Issues in Business
November 10 to 14, 2003

Patentability and Claim Interpretation

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Patent application

- n Request → Bibliographic data
- n Description → Full and detailed explanation
- n Drawings
- n Abstract → Information purpose only
- n Claims → Define the subject matter for which protection is sought
Once patented, define the scope of patent protection

Novelty, inventive step, industrial applicability, sufficiency of disclosure are examined vis-à-vis the claimed invention.

Functions of claims

- n Definitional function
- n Public notice function

Example

1. A process for treating textiles comprising spraying the material with a liquid coating under ultraviolet light irradiation.
2. A process according to claim 1 comprising the step of coating at 200-210°C.
3. A process according to claim 1 or 2 characterized by the coating composition X.

- product/ process claim
- 2-part/ single part claim
- independent/ dependent /multiple dependent claim

Requirements concerning claims

Definitional function

- n Broadest claim as possible

<--> prior art

Public notice function

- n Clear
- n Concise
- n Supported by the description (disclosure)

Claim interpretation (1)

- n The extent of the patent protection should be defined by the wording of the claims.
- n To what extent the description and drawings can be taken into account?
- n Central claiming theory/ Peripheral claiming theory
- n Legal certainty for third parties/
Fair protection for patentee

Claim interpretation (2)

“The extent of patent protection should be determined by the wording of the claims. The description and the drawings should be taken into account for the interpretation of the claims.”

- n The words used in the claims should be interpreted in accordance with the **ordinary meaning and scope**, unless the description provides a special meaning.
- n The claims should **not** be interpreted as being **necessarily confined to their strict literal wording**.
- n The claims should **not be limited to the examples expressly disclosed in the description**, unless the applicant made a “disclaimer”.

Equivalents

- n Reasonable degree of certainty for third parties
 - rely on the definitional/ public notice function of claims.
- n Fair protection for the patentee
 - minor variations to circumvent the claims.
- n Doctrine of Equivalents
 - The scope of a patent may embrace equivalent means to the claims described under certain circumstances.

Objective: Not to allow by-passing possible infringement

Doctrine of Equivalents (1)

- n Reasonable possibility of substituting the claimed element with the equivalent element
- n “Non substantial” difference
 - **substantially the same result or effect**
ex. Mere change of form, size, material etc.
 - **predictability of the substitution by a person skilled in the art**
 - **substantially the same function and/or the way the invention works**
- n Equivalents at the time of filing/ publication/ alleged infringement.

Doctrine of Equivalents (2)

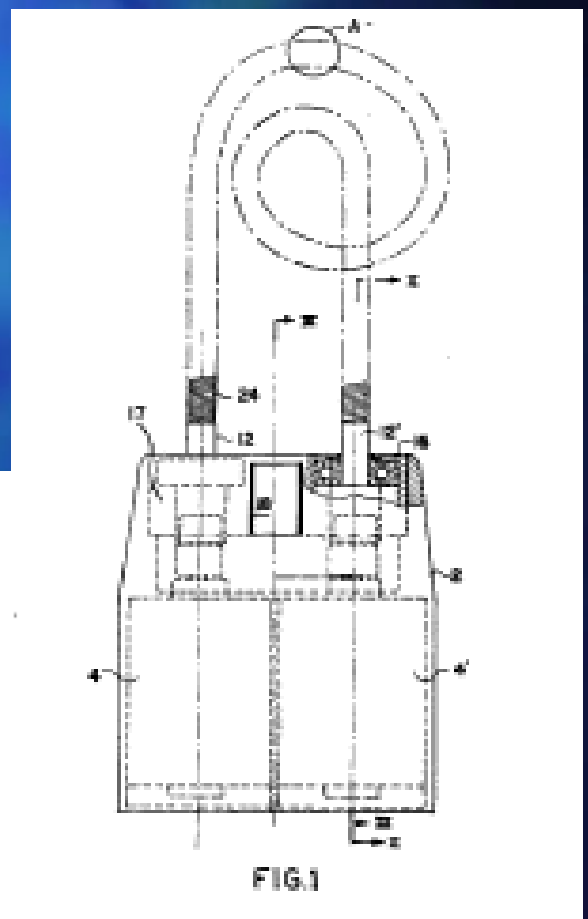
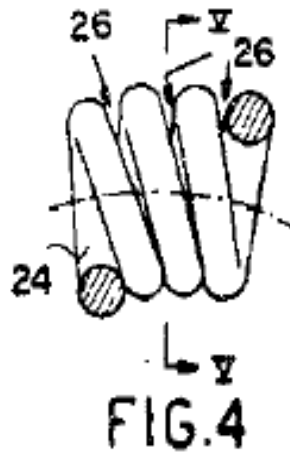
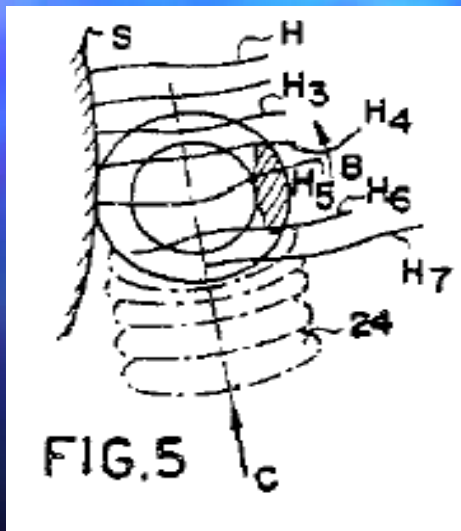
- n If a person skilled in the art has a reason to assume that an element had been excluded from the scope of the claims, that element is not an equivalent element.
 - Elements fallen under, and are obvious from, the prior art.
 - Prosecution history.
 - ex. Amendments and statements made before the Office.

Many different practices among the States ...

Doctrine of Equivalents - Epilady case

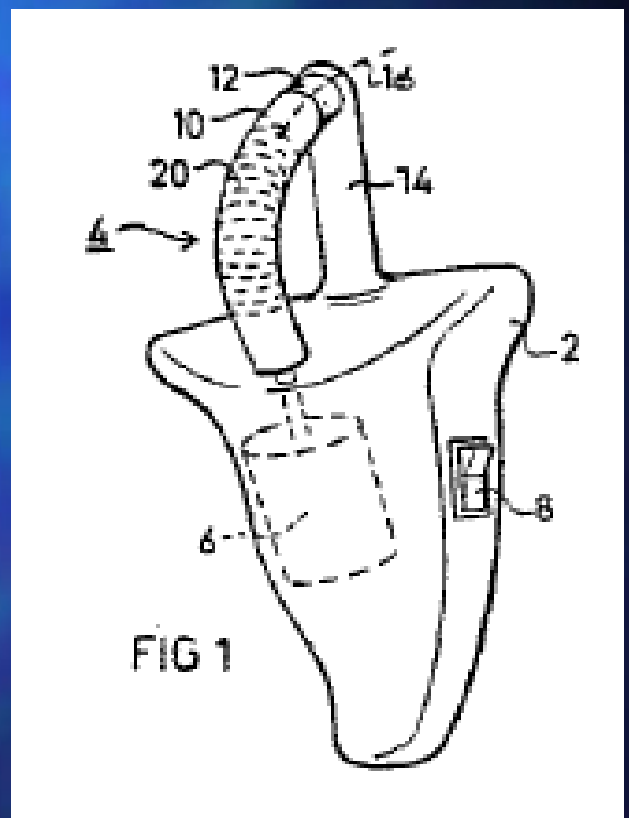
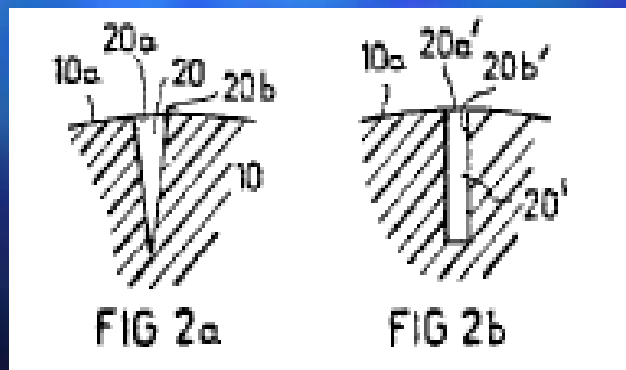
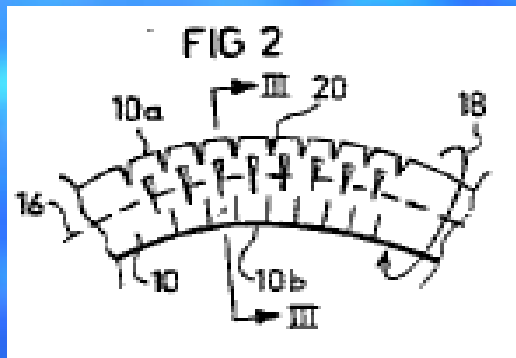
Epilady patent

Helical spring

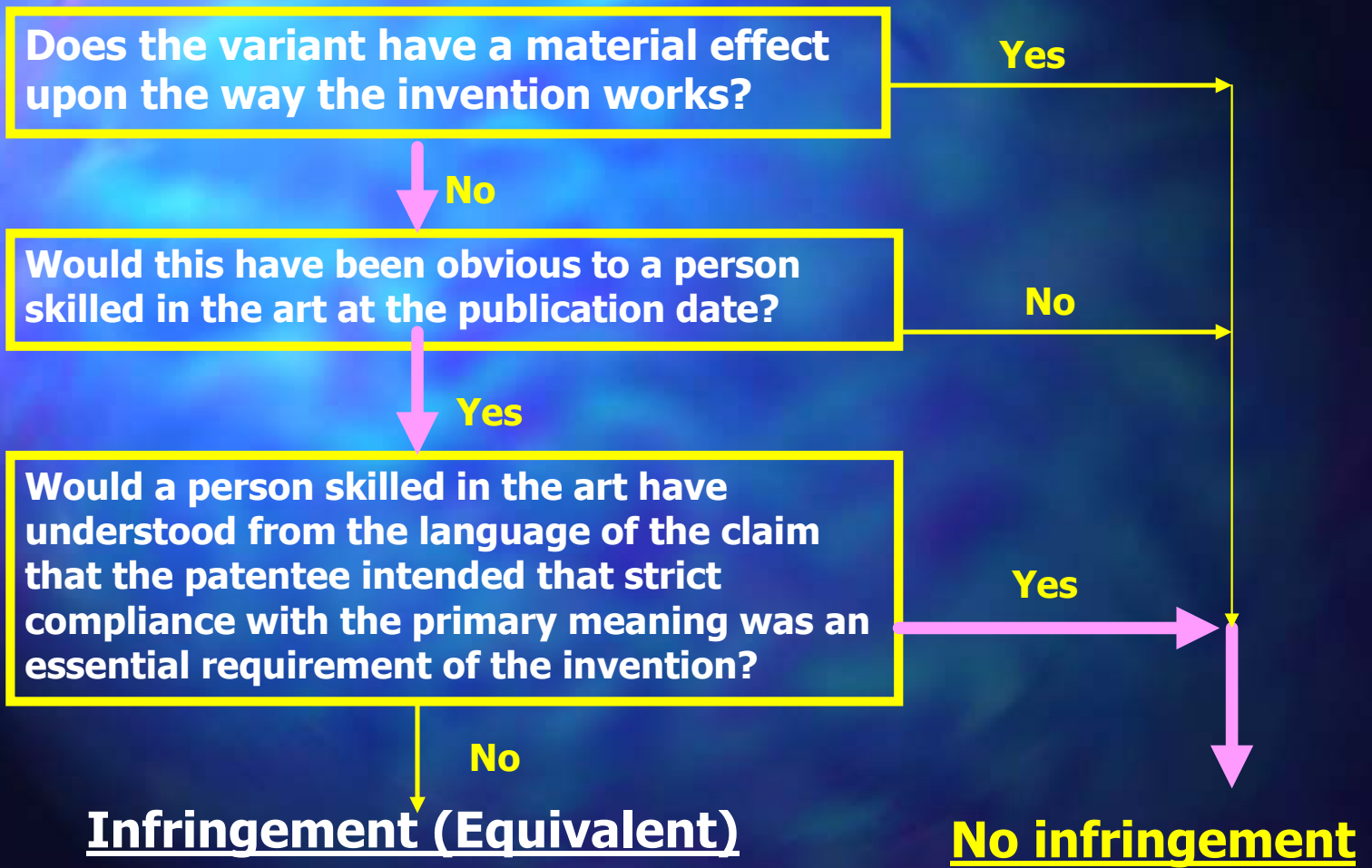


"Smooth & Silky"

Rubber rod with slits



UK (Catnic Test)



Germany

It is **obvious to a person skilled in the art** using his knowledge at the priority date that the **equivalent solution** can be provided by **equally functioning means**.

---> Infringement

Need for international harmonization? (1)

Example 1: Product-by-process claim

“Protein Z which is obtained by process P comprising steps P1, P2, P3... and Pn.”

- n Protein Z *per se* that possesses the characteristics derived from process P?
- n Protein Z that actually obtained by process P?

Need for international harmonization? (2)

Example 2: Use claim

“Substance X for a use as an insecticide.”

“Use of substance X as an insecticide.”

- n Product claim (substance X as an insecticide)?
- n Process claim (a process of killing insects using substance X)?
- n Lacking clarity?

Need for international harmonization? (3)

n Limitation of the PCT

Customize the application at the national phase.

<--- different claim interpretation, equivalents

n Draft Substantive Patent Law Treaty (SPLT)

- Applicants: Prepare one set of claims
- Offices: Enhanced utility of search/examination report obtained from other Offices



Thank you!

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