

# TOPIC 4



## Introduction and Theory of Patent Claims – Protection of Inventive Concepts

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# THEORY OF A PATENT CLAIM

The Claims:

- The most important part of any patent application.
- Define the scope of protection given to an invention.
- Give the patentee the right to exclude others from using/making/selling what is claimed.
- (But don't give the patentee the right to make/use/sell what is claimed).

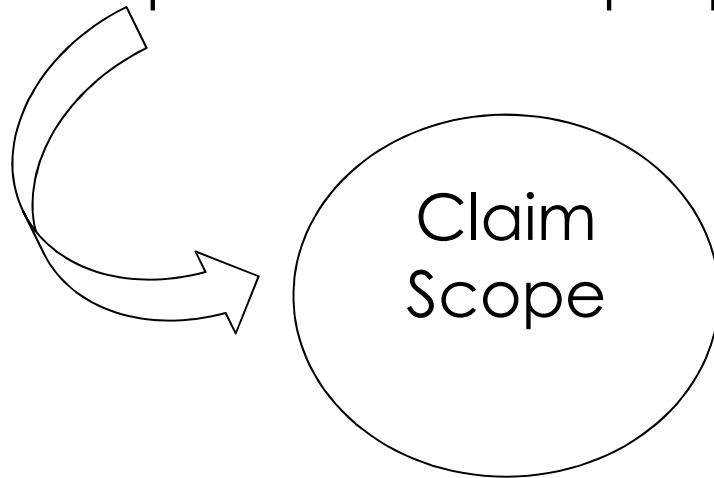
# THREE LEGAL CONSTRUCTS



- The “invention” is a mental concept inside the mind of the inventor, with no physical substance.
- An “embodiment” of the invention is a version of the invention, with substance.
- The “claims” protect at least one embodiment, but the best patent claims protect the invention (i.e. the inventor’s embodiment and all other possible embodiments of the invention).

# PATENT CLAIMS DEFINE SCOPE OF PROTECTION

Claims are like a fence post around a property



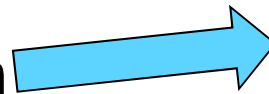
Exclusionary right!



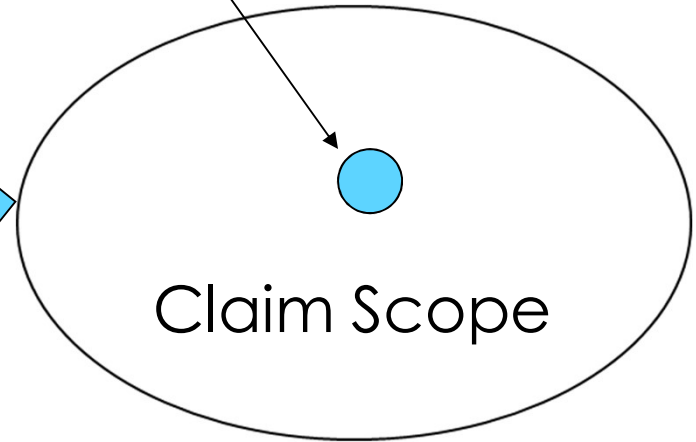
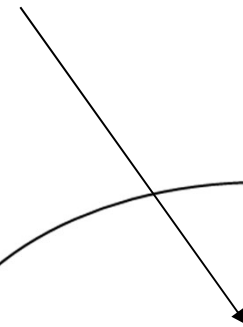
# PROTECT THE ENTIRE INVENTION (NOT JUST A SINGLE EMBODIMENT)



Conception of Invention



Single embodiment



Claim Scope

# EXAMPLE – MANDY’S MUG



An inventor, Mandy, develops a red clay mug with a handle. Existing mugs don't have a handle, and are made from clear glass.

- Should Mandy's patent agent claim the physical embodiment of "a red clay mug with a handle"?

**No!**

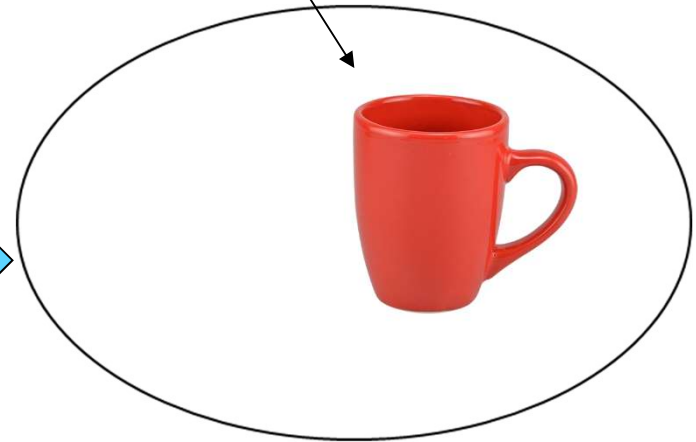
- This would allow non-infringing plastic cups with handles.
- The would allow non-infringing blue clay cups, too.
- If the patent agent understands the invention, then he/she will claim a "cup with a handle" (the invention)
- "Red cups" and "clay cups" may appear in narrower claims.

# CLAIM OBJECTIVE TO PROTECT ENTIRE INVENTION (NOT JUST A SINGLE EMBODIMENT)



Embodiment of  
invention: red clay  
cup with a handle

Conceived first  
cup with a handle  
(the invention)



# NEED TO PROTECT ALL EMBODIMENTS



Claim 1. A cup comprising a handle.

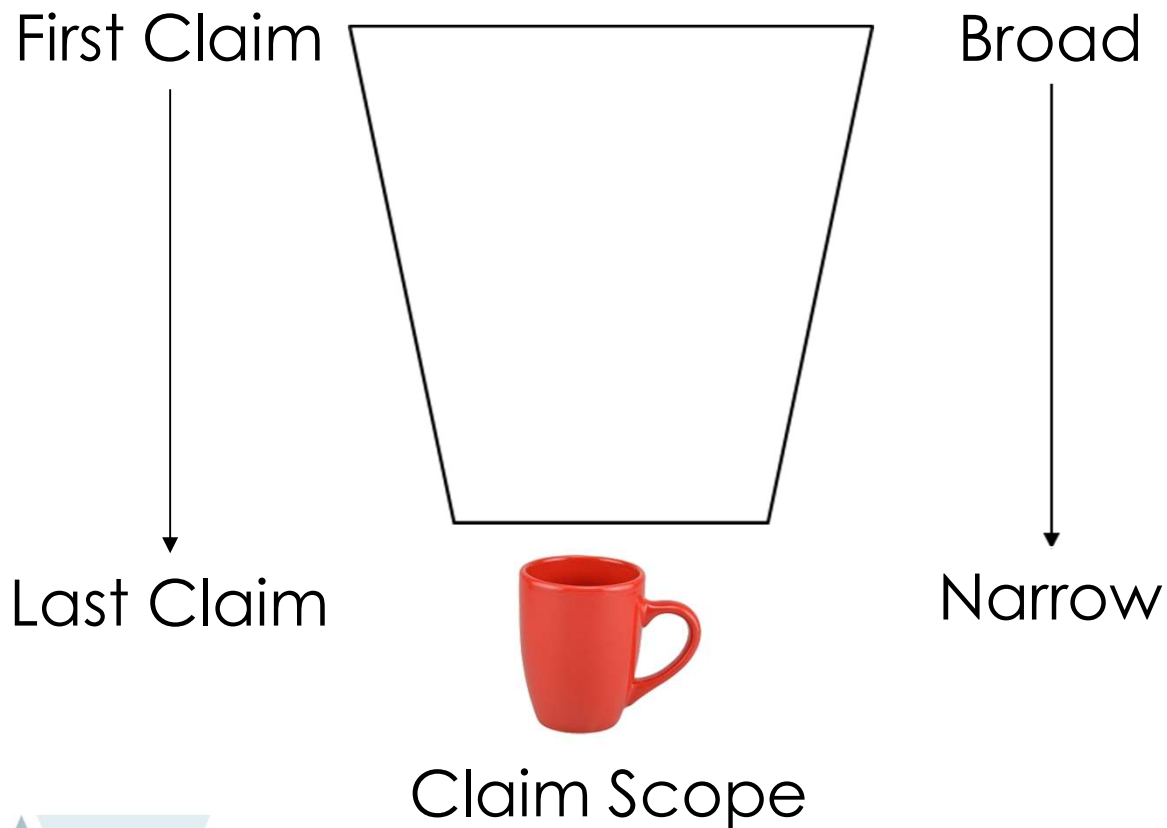


# CLAIM SET



- The claims begin with at least one independent claim, setting forth all of the boundaries essential to be **novel** and **inventive** over the state of the art (in a **clear** and **enabled** way when combined with the description).
- Usually, also a number of “dependent” claims, which include all features of the independent claim (from which they depend), and add one or more further features, or expand on previous features.

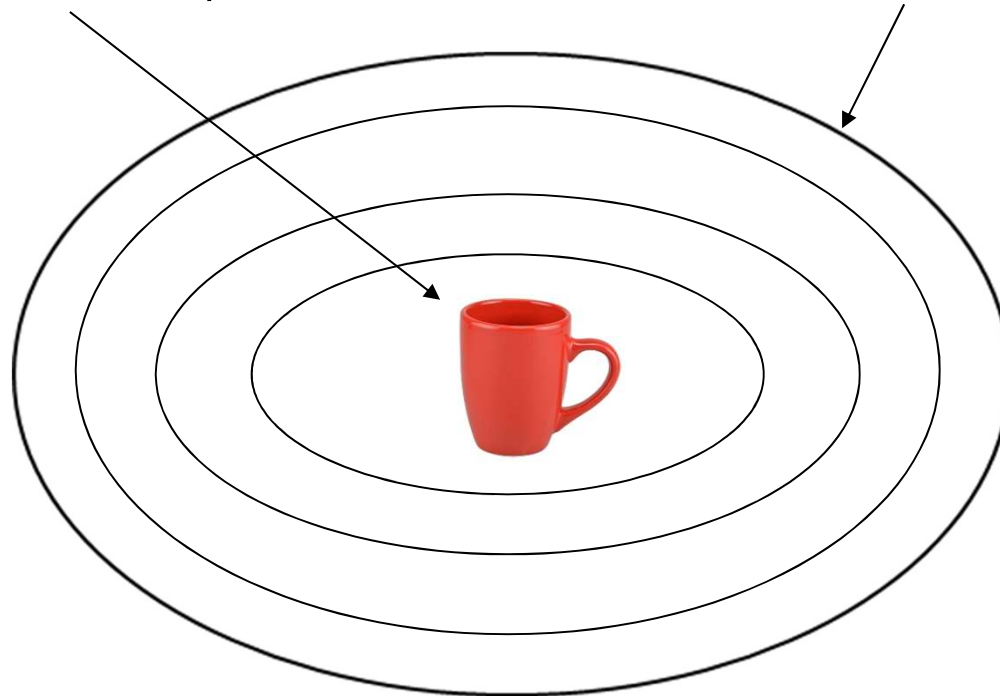
# SCOPE OF CLAIM SET SHOULD LOOK LIKE AN INVERSE PYRAMID



# BROAD VS. NARROW COVERAGE

Narrow scope = greater chance of validity

Broad scope = more commercially valuable



Claim Scope

# PATENT CLAIMS: THE OBJECTIVE?

- A claim must:
  - Define the scope of protection
  - Represent an advantage or solution to a problem
  - Avoid the “prior art”
- ...in a way that is clear, concise and self-contained
- ...in a single sentence!



So, how do we draft a claim in practice?

# UNDERSTAND THE INVENTION

You (the patent agent) must decide:

- What has been invented?
  - Does the inventor know what he/she wants to protect?
- What is commercially important about the invention?
- Who are the competitors in this field?
- Is there any prior art that would prevent a patent?
  - What is the difference between the prior art and claimed invention?
- What types of claims can be drafted to this invention?

# PATENT CLAIM FORMAT



Now break the novel and inventive concept into different parts:

- Preamble (introduction)
- Transition
- Body of the claim (features of the invention)

# PREAMBLE - IS THE INVENTION:



- A product – physical entity?
  - Such as a device, article, system, chemical compound, composition...
  - (A cup is an example of a product.)
- A method – activity?
  - Method of making a product or of performing a task...
- A method of use – activity with a product?
  - Method of treating a disease using a pharmaceutical compound...



# PATENT CLAIM FORMAT - THE TRANSITION

## Transition

- Word or phrase which follows the preamble, indicating whether the invention is limited to the features which are set out below
  - “Open transition” – opens the claims to anything in addition to what is recited.
  - “Closed transition” – limits the claims to only what’s recited.

# PATENT CLAIM FORMAT - THE TRANSITION

## Transition Examples:

- (Open) A cup **comprising / including** a handle ...
  - The cup can include anything else, e.g., a lid
- (Closed) A cup **consisting of** a handle ...
  - The cup cannot include anything else but a handle
  - This is very limiting – try to avoid its use



A cup **comprising**...



# PATENT CLAIM FORMAT - THE BODY

The Body of the claim:

- follows the transitional phrase
- recites the limitations of the claim
- explains how different limitations exist in relationship to one another

A cup comprising **a handle**.

# STUCK? TRY THE FOLLOWING...

Here is one way of drafting a claim:

- Start off by listing all of the features of the invention
- Look at each feature - is it essential to the invention (and to the novelty and inventiveness of the invention)
  - Delete all those features that are not essential
- Look at the remaining features -
  - can broader terminology be used?
  - are the correct words used for each feature (make sure you understand the meaning of each word)?

## E.G. MANDY'S MUG

- V1: A mug with one handle ~~made from clay which is red~~
- V2: A ~~mug~~ cup with ~~one~~ handle
- V3: A cup comprising a handle.



# Q&A?



Thank you for your attention!

James Davies