

Claims Drafting :

Defining the Scope of Search and Examination

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Presiding Judge (German Fed. Patent Court) ret.

1

Claims Drafting – Claims Form and Function

1) Function

Art. 84 EPC:

“The claims shall define the matter for which protection is sought. They shall be

- **clear,**
- **concise** and
- **supported by the description.”**

Art. 69(1) EPC:

“The extent of the protection conferred by a European patent or a European patent application shall be **determined by the terms of the claims.** Nevertheless, the description and drawings shall be used to interpret the claims (see also Protocol to Art. 69)”.

Claims Function : ("The Name of the Game is the Claim")

Rule 29(1) (Guidelines C-III, 2.1)
„The claim shall define the matter for which protection is sought in terms of the technical features of the invention“;
(similar in other legislations).

- 1) Claims define the **subject of protection** therefore and corresponding (broad/narrow)
- 2) claims define equally the **subject of search and examination**,

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3

Claims Function : ("The Name of the Game is the Claim")

Claims shall define the invention by words.
i.e. by the technical (structural and/or functional) features of the invention
There is **no invention outside the claims**
(even if it were, it wouldn't matter; this sounds natural, but is often overseen in the process of examination).

The **skilled person** (assessing patentability) has the **same level of knowledge and experience in understanding and interpreting** the claimed application and the state of the art

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4

Form of a Claim

Basic structure:

- **Introducing part (Category, purpose..)**
- **body (specific legal description of the invention by structural and/or functional features)**
- **link (words/phrases like comprising, including, consisting of**
 - **one part claim -) or**
 - characterized in (- two part claim)**

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5

Form of a Claim

Dependent - / independent claim

Formally: with / without reference to another claim within the same category

Substantive: Further specification of an independent claim.

Important: An independent claim has to present an independent solution of the underlying objective problem of the invention.

Otherwise: Lack of Unity!

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6

Form of a Claim

One part - / two part claim

Dependent - / independent claim

Basic types (categories) of claims:

- 1) Type entity: Product, apparatus, device.**
- 2) Type activity: Process, method, use.**

**Further on: Special types, e.g.:
1st and 2nd medical use, product-by-process, Markush grouping, disclaimer**

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7

Form of a Claim: One Part / Two Part (Rule 21(1)b EPO Guidelines)

One part claim:

Presentation of the essential characteristics of the invention without structure as to state of the Art.

Example:

„Apparatus comprising features A, B, C, D“

Two part claim:

Presentation of the essential characteristics of the invention with a structure according to the state of the art (so far as known)

**„Apparatus with features A , B,
characterized by features C, D**

characterized in that features C, D ...are comprised.

Invention comprises all features of the claim !

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8

Form of a Claim: One Part / Two Part - Handling

One part claim:

Each of the essential characteristics of the invention (= the claim !) has to be referred to in state of the Art, as far as known.

Example:

„Apparatus comprising features A, B, C, D“

Doc. 1) provides an apparatus showing showing feature A; Doc. 2) shows an apparatus with feature C)

General: If there is no clear single starting document in the state of the art giving the base for the invention, then a one part claim can be useful and taken into consideration.

Invention comprises all features of the claim !

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9

Form of a Claim: One Part / Two Part - Example

One part claim:

From: Int. Application Nr. PCT/IB2003/005958

- 1) A Method of producing a soya bean product, the method including the step of exposing soya beans to an acidic aqueous solution.
- 2) A method as claimed in Claim 1, in which the acidic aqueous solution has a pH of between about 2.0 and 5.5.
- 3) A method as claimed in Claim 1 or Claim 2, in which the soya beans are whole beans
- 4) A method as claimed in any one of the preceding claims which includes the prior step of dissolving an organic acid in water to produce an aqueous acidic solution.
- 5) A method as claimed in Claim 4 in which the organic acid is citric acid.

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10

Form of a Claim: One Part / Two Part - Handling

Two part claim:

Introductory part – characterizing part

Category, purpose, general - specific features

Link: characterized in ... or characterized by....

The introductory features of the invention are generally supposed to be known to the applicant.
(US: definitely state of the art; Europe: Closest st.o.a)
the characterizing features form the body of the invention with the specific features to be protected , introduced by „characterized in(as far as known)
„Apparatus with features A , B,
characterized by features C, D

If there is a document in the state of the art giving the clear base for the invention, then a two part claim is to be considered and useful. It should be applied “whenever appropriate” (EPO-practice).

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11

Form of a Claim: One Part / Two Part - Example

Two part claim:

1) A dining table having legs evenly distributed around the periphery of the table top, which legs do not protrude beyond said periphery, characterized in that the table has three legs.

2) A dining table according to Claim 1 characterized in that the legs are made of ply wood.

.../...

Invention comprises all and only the features of the claim!

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12

Independent Claims

- No substantial reference to any other claim/ independent solution of the underlying objective problem (unity!)
- Often: **ONLY ONE PER CATEGORY** (product, process, use, apparatus/device...)
- except if
 - a) alternative independent solutions of the same (objective) problem are to be considered (e.g. several processes to obtain one and the same product or
 - b) with interrelated products (plug and socket, receiver/transmitter).

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13

Dependent Claims

- Refer to one or more dependent and/or independent claim:
Apparatus according to claim 1 /
claim 1 – n / one of the claims 1 - n
further comprising ...
characterized in that it further ...
- give further limitations/specifications to the claims referred to;
- show preferred embodiments – „fall back positions“ if claim 1 fails;
- contains all the features of the claims referred to plus its own features.
! Check initial file covering !

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14

Basic Types of Claims - Categories

- Product (compound, material, fabric..)
- Apparatus/device
- Process (method for producing something, doing something);
! product obtained by the process is automatically protected with it!
- Use (of a product to obtain a specific result; use claim is a special type of process claims)

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15

Interpretation of Claims - Rules for Practitioners -

(Non-)limitations:

- „Apparatus for ...“,
„apparatus suitable for..“ (purpose):
Not limiting (except purpose describes subjects constructive features – fishing hook/coat hook).
- Optional features, alternatives (especially, particularly): Not limiting the scope, neither in protection nor in search.
- S-M... comprising: open i.e. (a+b+others)
S-M..consisting of: limiting i.e. (a+b only)

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16

Interpretation of Claims – Specialities

- **Process claim: Protection extends to the product directly obtained (Art. 64(2) EPC)**
- **Use claim = process claim !**
- **Product – by – process claim: only if no other definition possible!**

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17

Interpretation of Claims – Specialities to obtain appropriate protection

- **1st and 2nd medical use claim:**
 - „Use of a known substance or composition for a new treatment“
substance X as pesticide“
- **„Use of substance X for producing a medicament for the treatment of C („Swiss type“)**
- **Markush grouping (multiple references):**
„X selected from the group consisting of a,b,c,d, e, f and g and any combinations thereof.“

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18

Final Highlighting in Claim Drafting

- **Be clear (objective facts instead of subjective judgement).**
- **Be complete (covering all inventive features in a proper context).**
- **Be supported (all parts of the claims must (should) be fully explained in the description .**
- **Be -- literally, word-for-word -- covered by the initial disclosure.**

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19

Thank You

? Questions ?

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20