

Topic 8:

**Claim Drafting - Methodologies and
Techniques**

Multiple approaches

- There is no “right way”
- Overall objective is to spot the invention(s)
- Relative to the “state of the art”
- Many devices and methods include many “inventions”

Recap

T. A. EDISON.
Electric-Lamp.

No. 223,898.

Patented Jan. 27, 1880.

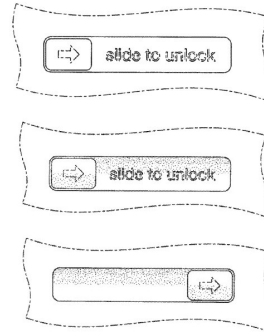


Fig. 1.

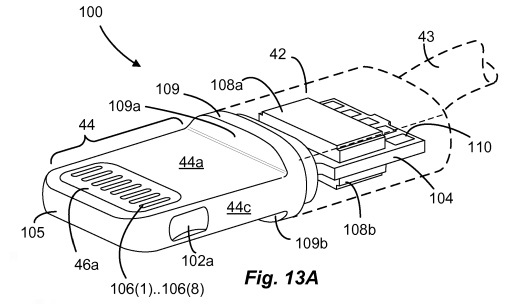


Fig. 13A

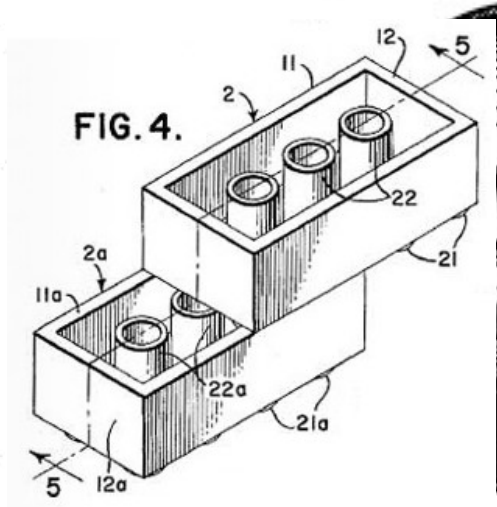
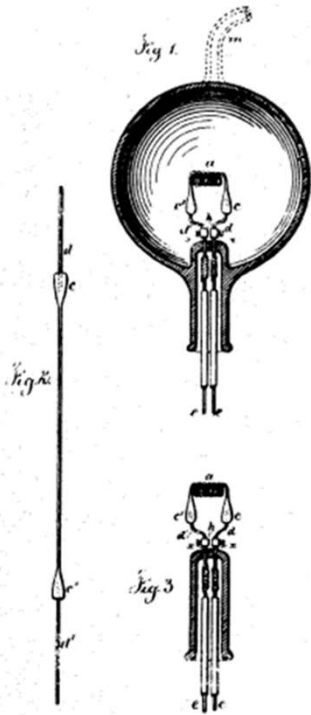


FIG. 4.

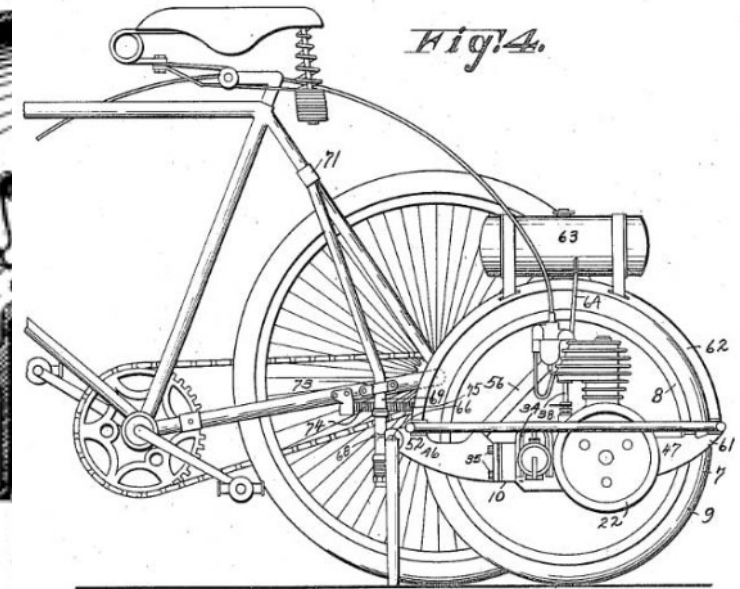


Fig. 4.

Witnesses
 Charles Smith
 Geo. H. Mackay

Inventor
 Thomas A. Edison

for Lemuel W. Perrell

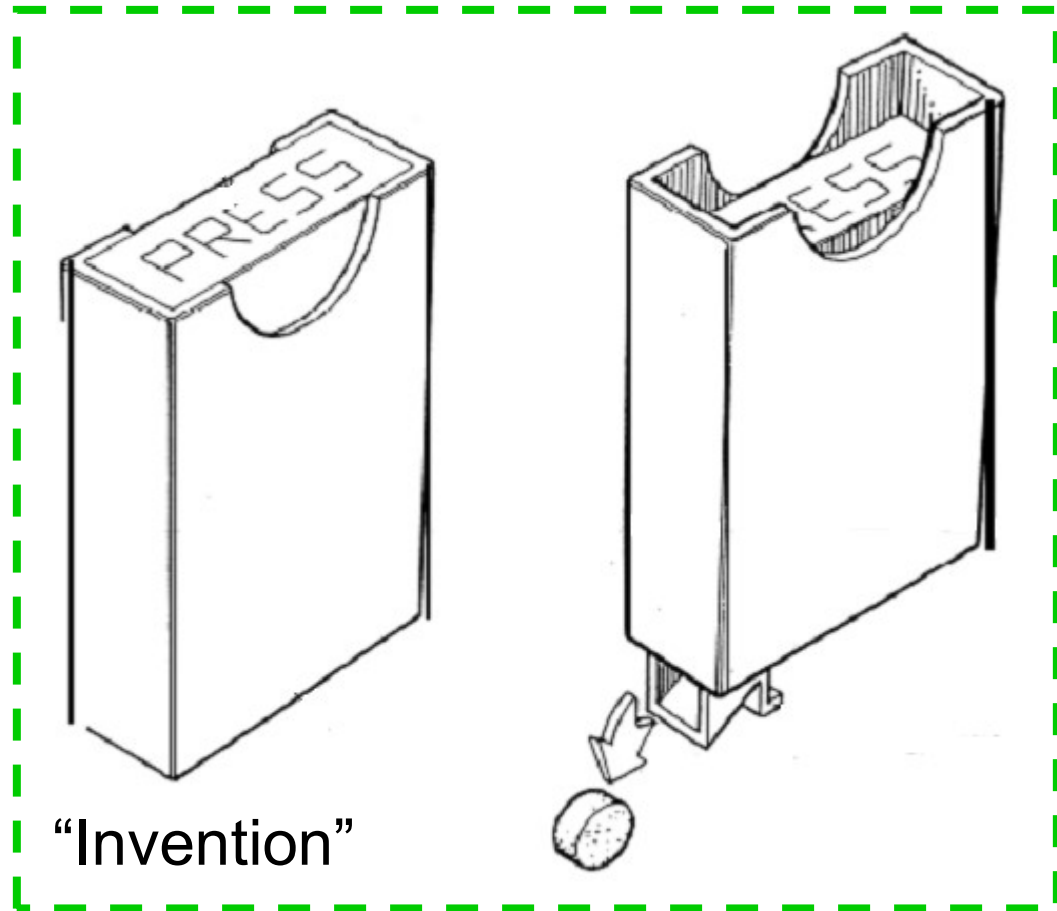
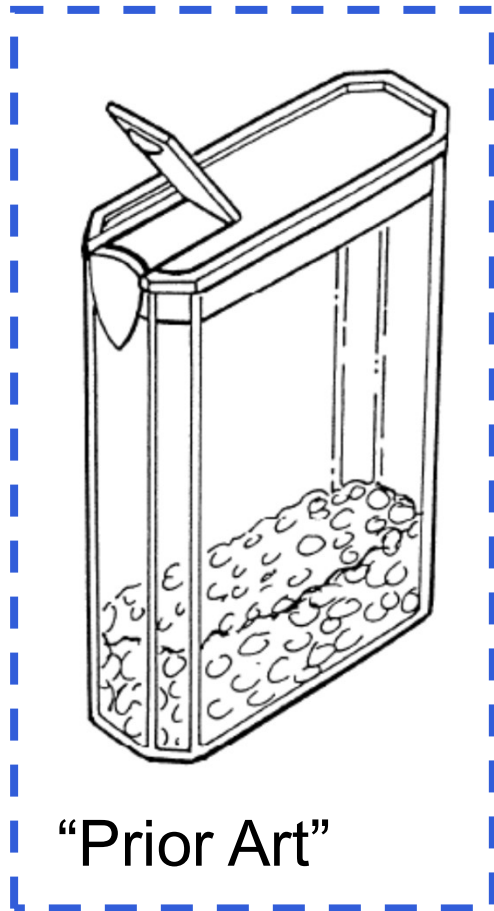
att'y.



3G

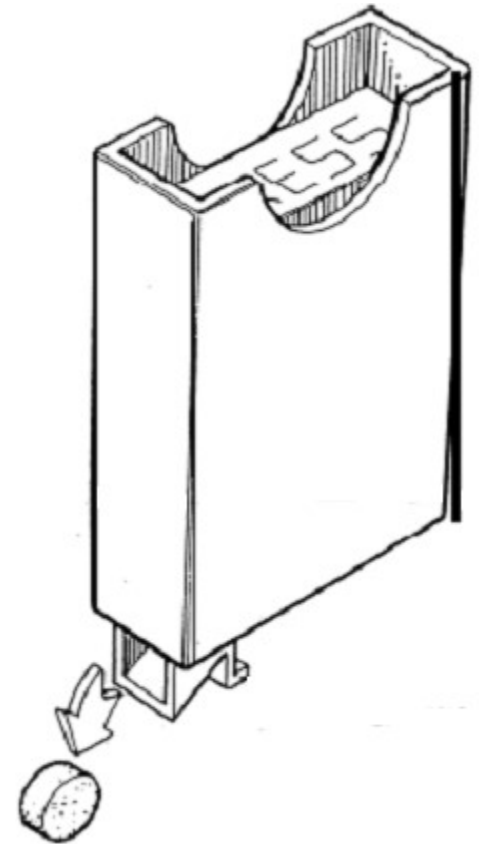
WIPO
 WORLD
 INTELLECTUAL PROPERTY
 ORGANIZATION

Recap – Yesterday’s puzzle



Recap – Our independent claim

- TO ADD – our agreed-upon claim 1 from Tuesday's session



What is an invention – legal requirements recap

- Novelty – something that's “new”
- Inventive step – “advantages, solutions to problems, alternatives”
- Industrial applicability – “does something”
- ~~Sufficiency/enablement~~

Make a list

- Everything about its structure, movement and function that's "new"
- Any "advantages, solutions to problems, alternatives" you can see
- Essentially any features/anything you notice about the device

Make a list – anything you notice

Hopper

Housing

Opening

Ramp

Button

Spring

Sliding movement

Single item dispensing

Automatic closure

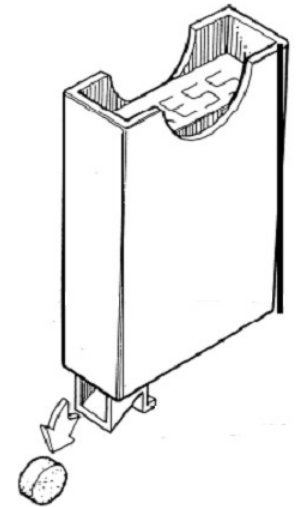
Hygienic

“Press”

Blue and white colouring

Plastic

Contains mints



Categorise the list

Structure and movement

Hopper	“Press”
Housing	Blue and white colouring
Opening	Plastic
Shaped ramp	
Button	
Spring	
Sliding movement	

Advantages, solutions and alternatives

Single mint dispensing
Automatic closure
Hygienic
Contains mints

Eliminate, attribute and prioritise

- Eliminate features which achieve nothing
- Attribute features to the things they achieve
- Prioritise and decide what is most important

Categorise the list

Structure and movement

Hopper	“Press”
Housing	Blue and white colouring
Opening	Plastic
Shaped ramp	
Button	
Spring	
Sliding movement	

Advantages, solutions and alternatives

Single mint dispensing

Automatic closure

Hygienic

Contains mints

Categorise – eliminate non-essential features

Structure and movement

Hopper	“Press”
Housing	Blue and white
Opening	colouring
Shaped ramp	Plastic
Button	
Spring	
Sliding movement	

Advantages, solutions and alternatives

Single ~~mint~~ dispensing

Automatic closure

Hygienic

Contains ~~mints~~

Categorise – What achieves what?

Structure and movement

Hopper

Housing

Opening

Shaped ramp

Button

Spring

Sliding movement

Advantages, solutions and alternatives

Single item dispensing

Automatic closure

Hygienic

Contains items

Core or common features
and/or advantages

Build a claim – First draft

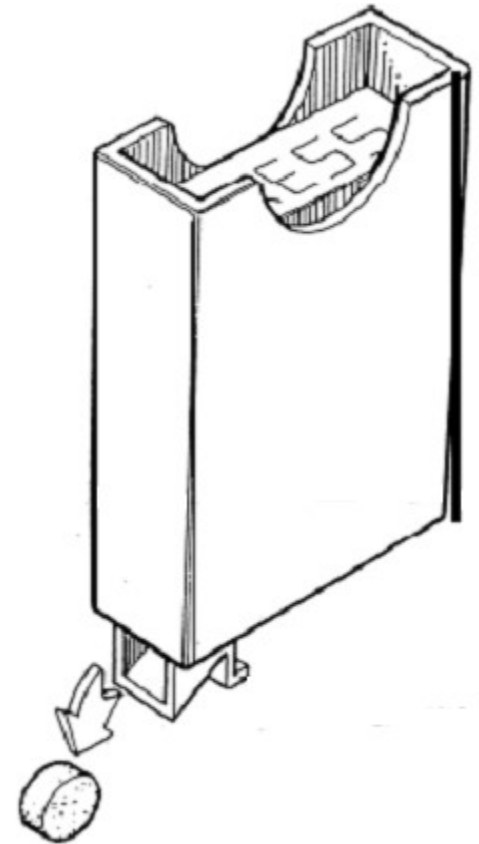
- Claim: a clear, concise and self-contained single sentence
- Assemble the “structural” and “movement” features
- Encapsulate the invention

Build a claim – Stress test the first draft

- Are all features necessary to achieve your effect (“minimum essential features”)?
- Do all features interact (floating features)?
- Can a broader/more general feature be employed instead?

Recap – independent claim pitfalls

- TO ADD – pitfalls encountered during the exercises on Tuesday (e.g. unnecessary features, floating features, etc.)



Useful techniques

- Table of features and advantages
- Starting with a “picture claim”
- Problem and solution-approach
- (...all variations on the same theme)

Table of features and advantages

Prior art

Hopper

Opening

Hinged lid

Catch

Multiple item dispensing

Invention

Hopper

Opening

Automatic closure

Hygienic

Sliding movement

Single item dispensing

Housing

Button

Spring

Table of features and advantages

Prior art

Hopper

Opening

Hinged lid

Catch

Multiple item dispensing

Invention

Hopper

Opening

Housing

Button

Spring

Sliding movement

Automatic closure

Single item dispensing

Hygienic

Starting with a “picture claim”

A ~~plastic mint~~ dispenser, comprising:

a ~~white~~ hopper contained within a ~~blue~~ housing, ~~said hopper having the word “PRESS” written thereon,~~ said hopper comprising an aperture for dispensing hopper contents;

said hopper being slidable within the housing between a first position in which the aperture is open and a second position in which the aperture is closed,

~~said hopper being biased towards the second position for reliable and hygienic dispensing of mints,~~

~~and said dispenser being configured for single item dispensing.~~

Starting with a “picture claim”

A item dispenser, comprising:

a hopper contained within a housing, said hopper comprising an aperture for dispensing hopper contents;

said hopper being slidable within the housing between a first position in which the aperture is open and a second position in which the aperture is closed.

Problem and solution-approach

Single item dispensing

Automatic closure

Hygienic

Contains items

**Core or common
advantages**

Problem/solution 1?

Problem/solution 2?

Problem and solution-approach

Structure and movement

Hopper

Housing

Opening

Shaped ramp

Button

Spring

Sliding movement

Advantages, solutions and alternatives

Single item dispensing

Automatic closure

Hygienic

Contains items

Core or common features
and/or advantages

Recap – multiple approaches

- There is no “right way”
- Overall objective is to spot the invention(s)
- Relative to the “state of the art”
- Many devices and methods include many “inventions”

Recap – Make a list

- Everything about its structure, movement and function that's “new”
- Any “advantages, solutions to problems, alternatives” you can see
- Essentially any features of the device
- Keep refining

Reap – Useful techniques

- Table of features and advantages
- Starting with a “picture claim”
- Problem and solution-approach
- (...all variations on the same theme)



WIPO

WORLD
INTELLECTUAL PROPERTY
ORGANIZATION

Q & A

Thank you

James Snaith
Associate
(Chartered and European Patent Attorney)
jsnaith@kilburnstrode.com

Kilburn & Strode LLP
Lacon London, 84 Theobalds Road,
London, WC1X 8NL
T +44 (0) 20 7539 4200
F +44 (0) 20 7539 4299
www.kilburnstrode.com

Patent and Trade Mark Attorneys

Kilburn & Strode