



Topic 10: Introduction and Theory of the Patent Claim

WIPO Patent Drafting Course for Patent Agents from the ARIPO Member States and Observer States

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September 9, 2015

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Theory of the Patent Claim

- Patent Claims
 - Define the patent's scope of protection
 - Represent the written approximation of the abstract inventive concept created by the inventor
 - Set the boundaries of the invention
 - Tell the world what has been invented

Introduction

- When an inventor is ready to file a patent application, the patent agent must ask --
 - What has been invented?
 - What are the claims to this invention?
 - Does the inventor know what he wants to protect?
 - How should we claim this invention?

Theory of the Patent Claim

- The patent agent must understand the differences between inventions, embodiments, & claims.
 - An “invention” is a mental construct inside the inventor’s mind & has no physical reality.
 - An “embodiment” of an invention is a specific physical form of the invention in the real world.
 - The “claims” must protect at least an “embodiment” of the invention – but the best claims protect the “invention” – such that all physical embodiments infringe the claims.

Theory of the Patent Claim

- **Example.** Inventor A develops the first cup to have a handle. A's physical embodiment is a red clay cup with a handle.
- Does A's patent agent claim the physical embodiment of "a red clay cup with a handle"? **No!**
- This would allow non-infringing plastic cups with handles.
- It would allow non-infringing blue clay cups, too.
- **If the patent agent understands the invention, then he will claim a "cup with a handle" (the invention)**
- "Red cups" and "clay cups" may appear in narrower claims.

Theory of the Patent Claim

■ If the patent examiner prevents claims from exceeding the scope of the invention, then whose role is to push the claims up to their maximum breadth?

■ Answer -- The Patent Agent!!

Theory of the Patent Claim

- The patent agent will usually not want all of the claims at the apparent upper limit of protection
 - Because there may be unknown prior art &
 - Claims can be invalidated during litigation
- The patent agent will want to develop a mix of broad, medium, & narrow claims
 - This provides the client with protection in depth

Theory of the Patent Claim

- Patent Claims must:
 - Define the thing (invention) for which patent protection is being sought,
 - Be clear and concise, and
 - Be supported by the specification and drawings
 - Drafted in terms of technical features of the invention

Theory of the Patent Claim

- **The patent specification must support the claims.**
 - A claim that is not supported by the specification is invalid.
- **Before filing the application, the patent agent must review the specification & claims to verify that every claim has support in the specification.**
- **The patent agent should trace the terms used in claims back to the specification to verify that consistent terminology has been used throughout.**

Theory of the Patent Claim

■ Example. If Claim 1 recites a glass table with four legs, then the patent agent must verify that the specification supports glass tables having four legs.

Theory of the Patent Claim

- **Example.** If Claim 1 recites a “red” component, but the specification describes a “scarlet” component, then the patent agent should either:
- use 1 term throughout or
 - amend the specification to state that “scarlet” is a subset of “red” and that any “red” component could be used (assuming this is correct).

Q & A