



WIPO National Patent Drafting Course

organized by the World Intellectual Property Organization (WIPO)

in cooperation with

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and with the assistance of the Japan Patent Office (JPO)

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August 29 to October 30, 2016 (follow-up session)

Topic 5 Claim Drafting-Claim Sets

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Outline of this part

- Reviewing the previous session
- What is patent document?
- How to organize in the Gazette?
- Claim sets
 - Independent Claims
 - Dependent Claims
 - Multiple Claims

Reminding the previous session

Thai Patent Law

Section 17 The application for the patent shall comply with the rules and procedures as prescribe in the Ministerial Regulations.

The application for a patent shall contain:

- (1) the title of the invention;
- (2) brief statement of its nature and purposes;
- (3) a detailed description of the invention in such full, concise and clear and exact terms as to enable any person ordinarily skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention and setting forth the best mode contemplated by the inventor to carry out his invention;
- (4) one or more clear and concise claims;
- (5) other items prescribed in the Ministerial Regulations

Section 36 bis The scope of the rights of the patentee under Section 36 in respect of a patented invention shall be determined by the claims. In determining the scope of the claimed invention, the characteristics of the invention as indicated in the description and the drawings shall be taken into account.

The scope of protection for a patented invention shall extend to the characteristics of the invention which, although not specifically stated in the claims, in the view of a person of ordinary skill in the pertinent art, have substantially the same properties, functions and effects as those stated in the claims.

Section 20 The applicant may amend his application for a patent in accordance with the rules and procedures prescribed in the Ministerial Regulations, provided that such amendment does not enlarge the scope of the invention.

Section 53⁽¹⁾ Any patentee may surrender his patent or any claim or claims there of in accordance with the rules and procedures prescribed in the Ministerial Regulations.

In order to surrender a patent or any claims under the preceding paragraph, if the patent is jointly owned by two or more persons, the surrender shall be made with the consent of all patentees. If licenses have been granted under Section 38, 45, 46, 47 or 47 bis such surrender shall be made with the consent of all licensees.

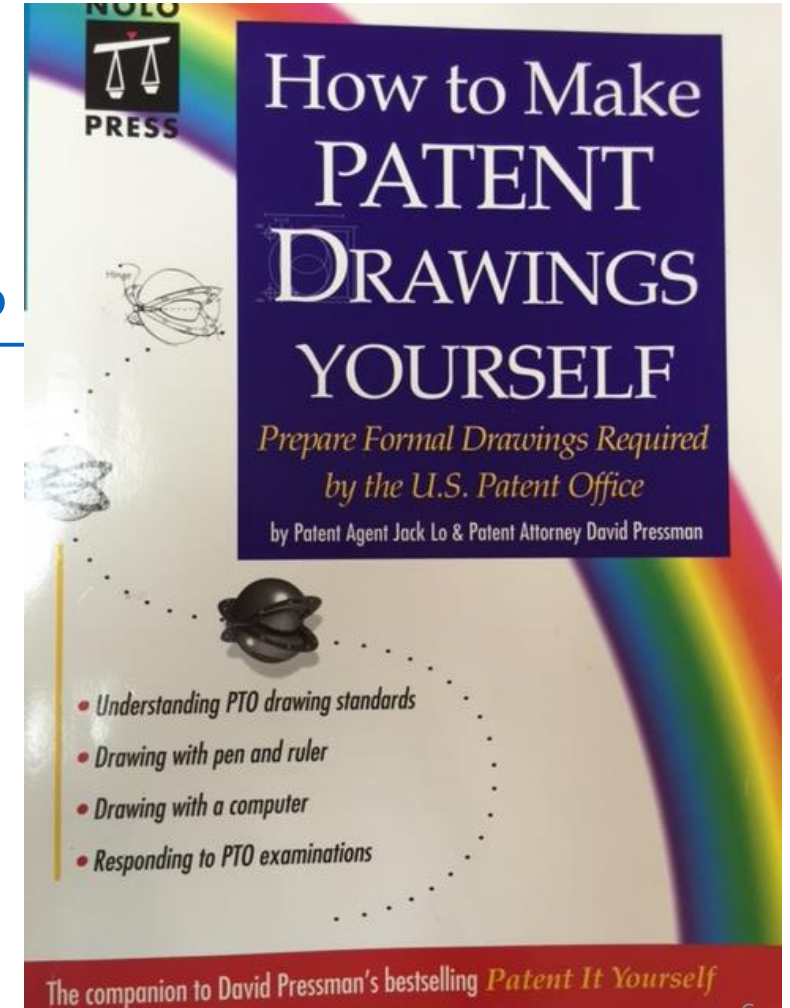
Section 54 Any patent granted not in compliance with the provisions of Section 5, 9, 10, 11 or Section 14 shall be invalid.

The invalidity of a patent may be challenged by any person. A petition to cancel an invalid patent may be submitted to the Court by any interested person or the public prosecutor.

Any other useful reference for drafting

- Patent & Petty Patent Manual ([2011](#), [2012](#))
- [Regulation of Ministry](#)
- [Notification of DIP](#)
- [Petty Patent Claim Drafting Instruction by DIP](#)

Drawing:

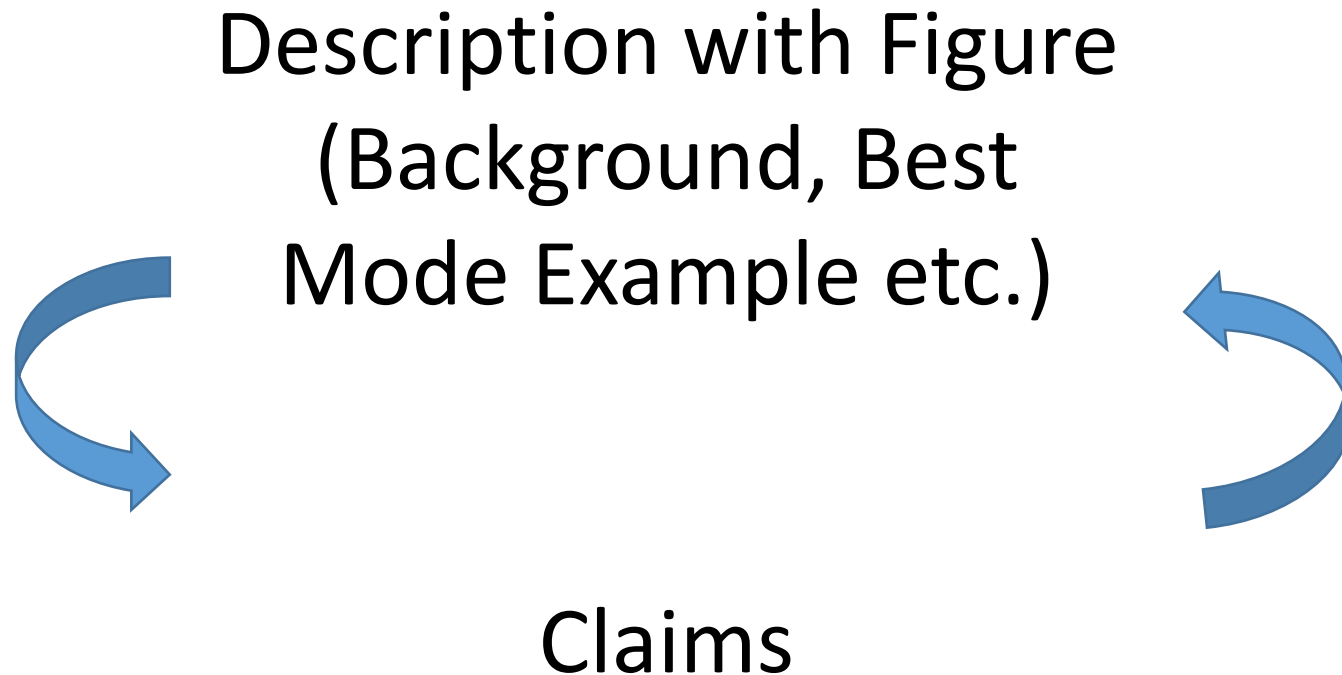


What is Patent Document?

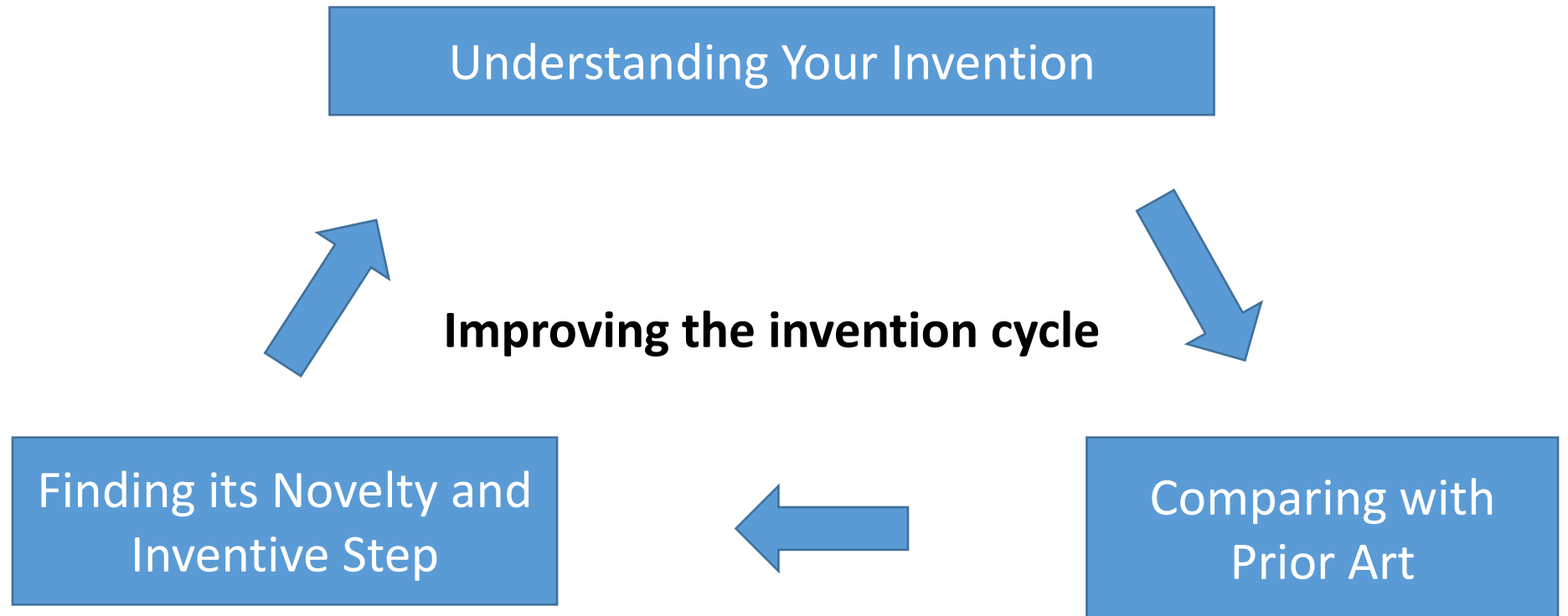
- Distinguish A document and B document(Look at its number)
- Thai Patent Document is A document only and not including claims
- If you want to see full document(specification), go to DIP for request of open filing wrapper
- Find out its claim part, its layout is different in country by country.

Tips : How to Read Patent Document

2 step approach



Tips : How to process in your mind during reading and making draft patent invention



Tips : How to train your staff for drafting job

Searching Job Experience

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graph TD; A[Searching Job Experience] --> B[Drafting Job]
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Drafting Job

How to organize it in the Gazette?

Bibliographic Data (Right Concerning)

Abstract

Drawing

Description

Technical Field

Background Art

Disclosure of the Invention

Brief Description of the Drawings

Best Mode for Carrying out the

Invention

Claim

C. CLAIM SETS

A set of claims in a patent specification include

- One or more independent (or main) claims
- A number of dependent or subsidiary claims (or sub claims)
 - Depend on one or more preceding independent claim(s).

Must contain at least one “independent” claim

- directed to the essential features of the invention
- i.e. those features necessary to satisfy the legal requirements of novelty and inventive step.

Dependent claims = Claims containing references to other claims

1. Independent Claims

A patent application may have more than one independent claim.

Sometimes a single invention might encompass several different inventive concepts, in which case it may not be possible to have one broad claim that covers all the different inventive concepts.

In general, it is wise to have several independent claims, each of which separately covers a different inventive concept.

EPO prefer the number of independent claims be limited to one independent claim in each category.

They can accept as following situation;

(i) examples of a plurality of inter-related products:

- (a) plug and socket;
- (b) transmitter – receiver;
- (c) intermediate(s) and final chemical product;
- (d) gene – gene construct – host – protein – medicament.

(ii) examples of a plurality of different inventive uses of a product or device:

- (a) second or further medical uses in the claim format of a “second medical use”-type claim.

(iii) examples of alternative solutions to a particular problem

- (a) a group of chemical compounds;
- (b) two or more processes for the manufacture of such compounds.

Please consider: unity of invention, cost, and the practice of each jurisdiction.

Varying claim breadth provides strong support against arguments that all the claims in a patent are invalid over the prior art.

Even after a patent examiner approves an application for grant as a patent, a third party may attempt to invalidate the patent later.

Thus, having claims of varying scope provides insurance against the possibility of invalidity arguments arising from prior art not known to the inventor, the patent agent or the patent examiner during patent prosecution.

In fact, it is not uncommon for the best prior art to be found by the defendant during patent infringement litigation.

2. Dependent Claims

A dependent claim is one that depends from another claim -Either an independent claim or another dependent claim.

- Such dependencies are signaled by the identification of parent claim.
- For example:
 - “2. The apparatus of Claim 1, further comprising...” indicates that Claim 2 is dependent from Claim 1.

Assume an independent claim reads:

1. An apparatus, comprising:
 - a pencil; and
 - an eraser attached to the pencil.

Assume a dependent Claim 2 reads:

2. The apparatus of Claim 1, further comprising:
 - a light attached to the pencil.

Assume a dependent Claim 3 reads:

3. The apparatus of Claim 2, further comprising:
 - a pencil lead release button attached to the pencil.

The entirety of Claim 2 includes all the text affirmatively recited in Claim 2 plus all the text of Claim 1. Thus, Claim 2 actually reads:

2. An apparatus, comprising:
 - a pencil;
 - an eraser attached to the pencil; and
 - a light attached to the pencil.

Similarly, Claim 3, which depends from both Claim 1 and Claim 2, actually reads:

3. An apparatus, comprising:
 - a pencil;
 - an eraser attached to the pencil;
 - a light attached to the pencil; and
 - a pencil lead release button attached to the pencil.

A patent examiner will sometimes allow a dependent claim over the prior art and merely object that the claim depends from a rejected independent claim.

This means that the patent applicant can obtain a patent by simply canceling the rejected independent claim and add the cancelled limitations to the allowable dependent claim.

The patent agent can also amend the other claims in the application

- Amend to depend from the newly independent (formerly dependent) claim.
- Or may decide not to accept the allowance of the dependent claim and continue to fight for the patentability of the parent claim.

Example: Amendment of independent claim during patent prosecution

A dependent claim can only add elements or limitations to the claim to which it refers.

It cannot subtract any elements or limitations from the same.

In other words, a dependent claim may only narrow the scope of the claim to which it refers, not broaden it.

- For example, dependent Claim 4 cannot read as follows:
 4. The apparatus in Claim 2 wherein the light is not attached to the pencil.

3. Multiple Dependent Claims

Like dependent claims, the body of a multiple dependent claim must narrow the claim from which it depends. In some jurisdictions multiple dependent claims may not depend on another multiple dependent claim. Different jurisdictions may have different formatting requirements for multiple dependent claims. The patent agent must make his claims conform to the precise requirements for the jurisdictions of interest to his client.

Recall the pencil example from above:

1. An apparatus, comprising: a pencil and a light attached to the pencil.
2. The apparatus of Claim 1, wherein the light is detachably attached to the pencil.

Here, a multiple dependent claim may be recited as follows:

3. A pencil as recited in Claims 1 or 2, further comprising an eraser.

This multiple dependent claim covers a pencil comprising either:

- a. a light attached to the pencil and an eraser; or
- b. a light detachably attached to the pencil and an eraser.

Thank you for your attention.

Q&A