



WIPO National Patent Drafting Course

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Specific Types of Claims

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Claim History and Omnibus Claims

- Patents originally didn't have claims
- The first claims followed a “central” claiming doctrine where the claims identified “the center of the invention”
 - Omnibus claims are a legacy of central claiming
- Modern claims typically follow the “peripheral” claiming doctrine where the claims set the outer boundaries for the scope of protection
 - Most jurisdictions follow the peripheral claiming doctrine

Omnibus Claims

- Refer to the description or the drawings without providing any specific limitations or technical features.
- Simple to write:
 1. *An apparatus for harvesting corn as described in the description.*
 2. *A juice machine as shown in Figure 4.*

Most patent offices don't allow omnibus claims.

- Include an omnibus claim where possible
- But pin your strategy on other claim types!

Apparatus Claims

- Protect an apparatus or a device
- Recite at the beginning what the apparatus “is” and/or “does”
 - *“A radio, comprising...”*
 - *“A device for hearing music ...”*
- Recite in the claim’s body the combination of essential features defining the invention.
 - In a two-part claim the features different from closest prior art are preceded by e.g. “characterized in that”

Apparatus Claim Example

1. *An apparatus for supporting a camera, comprising:*

a pivotal mounting configured to hold the camera; and

a set of legs arranged to support the pivotal mounting.

Means-Plus-Function Claim

- Includes a technical feature expressed in functional terms.

1. *A radio comprising:*

...means for converting a digital electric signal into an analog electric signal...

Jepson Claim

In the US practice a method or product claim where one or more limitations are specifically identified as a point of novelty, distinguishable over at least the contents of the preamble. Useful in calling examiner's attention to a point of novelty.

1. A system for storing information having (...) wherein the improvement comprises:

(Similar to “two-part form” of claim in European practice)

Component or Product?

- Should you claim a novel component or a product containing the component?
 - The component should generally be claimed
 - Because the component may be applicable to more than a single product
 - The product should also be claimed if possible
 - Because it may be easier to license/exploit

Component or Product?

Example. A invents novel Component X which will replace Component Y in Product Z

1. A component X, comprising:

...

&

2. A product Z, comprising:

a component X, and ...

Method Claims

- Recite a sequence of steps that complete a task or accomplish a result
- Steps may be recited in order of performance, but are usually interpreted as being performed in any order unless otherwise specified

Method Claim Example

1. *A method of making tea, the method comprising:*
 - *boiling water;*
 - *adding sugar to the boiling water;*
 - *adding tea leaves to the boiling water to form a mixture;*
 - *filtering the mixture; and*
 - *adding milk to the mixture.*

Which of these steps could be performed in any order – as set forth in the claim?

Use Claims

- Similar to method claims
 1. *The use of substance X as an insecticide ...*
 2. *The use of a transistor in an amplifying circuit ...*
- May be interpreted as method claims
- Not allowed in all jurisdictions

Second Medical “Use” Claims

- Suppose chemical compound xyz is already known, and has been used to treat diabetes. Assume that inventor A discovers that compound XYZ is an effective medicament for the treatment of malaria:
 1. *The use of substance X in the manufacture of a medicament for the treatment of condition Y.*
- Use claims - also known as Swiss-type claims – are helpful when the substance is already known in the art
- Not all jurisdictions permit such types of claims

Composition Claim

- Used where a claimed invention pertains to the chemical nature of the materials or components used
- Claims a “thing” like a device claim

Composition Claim Example

- 1. A copper electroplating solution comprising:
an alkaline solution of copper sulfate, from 30-50
grams per liter;
sulfuric acid, from 2-4 times the copper acetate
solution; and
an aqueous solution of a pH-modifying substrate
in an amount sufficient to adjust the pH to a
value of from 3.5-5.*

Product-by-Process Claims

- Claims a product defined in terms of a process of manufacture
- Some jurisdictions treat as product claims
- Other jurisdictions treat as method claims
- Verify that a product-by-process claim is the best approach for protecting an invention before employing this type of claim

Product-by-Process Claim Example

1. A metallic salt obtained by a process comprising the steps of ...

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- Mainly used in chemistry
- Has multiple functionally equivalent chemical entities allowed in one or more parts of the compound.
- *.....selected from the group consisting of A, B and C...*

Biotechnology Claim

- relates to all practical uses of living organisms
- either commercial or therapeutic uses
- may include c DNA, recombinant DNA, DNA fragments, protein, monoclonal antibodies, anti sense DNA and RNA, recombinant vectors and expression vectors

Claim for an invention related to nucleic acids and encoded proteins might be

- *1. An isolated polynucleotide comprising a member selected from the group consisting of:
 - (a) a polynucleotide encoding a polypeptide comprising amino acid 1 to amino acid 255 as set forth in SEQ ID NO: 2; and
 - (b) A polynucleotide which hybridizes to and which is at least 95% complementary to the polynucleotide of (a).*
- *2. The polynucleotide of claim 1 comprising the polynucleotide of (a).*
- *3. The polynucleotide of claim 2 comprising nucleotide 1 to nucleotide 1080 of SEQ ID NO:1.*

Example for Claim for Deposited Biological Material

1. *A seed of cotton cultivar designated PHY 78 Acala, wherein a representative sample of seed of said cultivar was deposited under ATCC Accession No. PTA-5666.*

The Budapest Treaty requires signatory countries to recognize a deposit with an depository which has been approved by WIPO.

Software Claims

- Used where the claimed invention pertains to computer software and/or hardware
- Can use device and method claims to cover software inventions
- Can also use specialized claim formats to provide an additional scope of protection

Example Software Claim

Type "Computer-Readable Media" Format (commonly referred to as Beauregard Claim)

1. *A computer-readable storage medium storing instructions that when executed by a computer cause the computer to perform a method for using a computer system to {a specified function}, the method comprising:
{list the inventive method steps}.*

Computer Program (EPO)

1. *A computer program for instructing a computer to perform the method of
...{allowable method claim}....*

Example Software Claim Type "Data Structure" Format

1. A memory for storing data for access by an application program being executed on a data processing system, comprising:

a data structure stored in the memory, the data structure including information resident in a database used by the application program and including:

a first data object configured to ...

a second data object configured to ...; and

a third data object configured to

Design Claim

Only one claim is typically permitted

Design Claim Example

*The ornamental design
for an umbrella, as shown
and described.*



Plant Patent Claim

New Variety of the Plant Chrysanthemum

Only one claim is generally permissible

A new and distinct cultivar of Chrysanthemum plant named 'White Norwoodstock', as illustrated and described.

Thank you for your attention!

What are your questions?