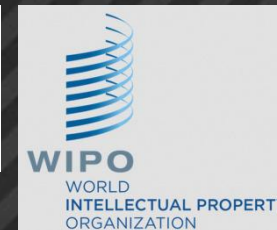


# NATIONAL PATENT DRAFTING COURSE

16 February 2017



PREPARATION AND FILING OF PATENT  
APPLICATIONS IN AND FROM  
MALAYSIA



**Dave A Wyatt**

Henry Goh & Co Sdn Bhd

Executive Director and Head of Patent and Industrial Design

# CONTENTS

- Claim Drafting
- Description Drafting
- Restrictions on foreign filing by Malaysian residents
- Dos and Don'ts of Patent Drafting

# CLAIM DRAFTING

- Spotting the invention, and
- Identifying target infringers
- Knowing the patent owner's business, and
- Naming the invention

# CLAIM DRAFTING

A patent claim must meet a few diverse needs

- protect an invention
- in the patent owner's field of interest
- be capable of infringement by a party you would want to stop or make pay
- be valid

# HOUSEHOLD COFFEE-MAKING MACHINE

- patent owner makes and sells the machine
- also sells the replaceable cartridges
- money is made from selling the cartridges
- cartridges are easier to make than the machine
- patent claims covering the machine are useful
- patent claims covering the cartridge may be even more valuable
- patent claims covering a method of making coffee are not helpful

# SPOTTING THE INVENTION

## Example

- invention is a mug that can hold a spoon
- the commercial product looks like this:



# SPOTTING THE INVENTION

- the closest prior art looks like this:



# SPOTTING THE INVENTION

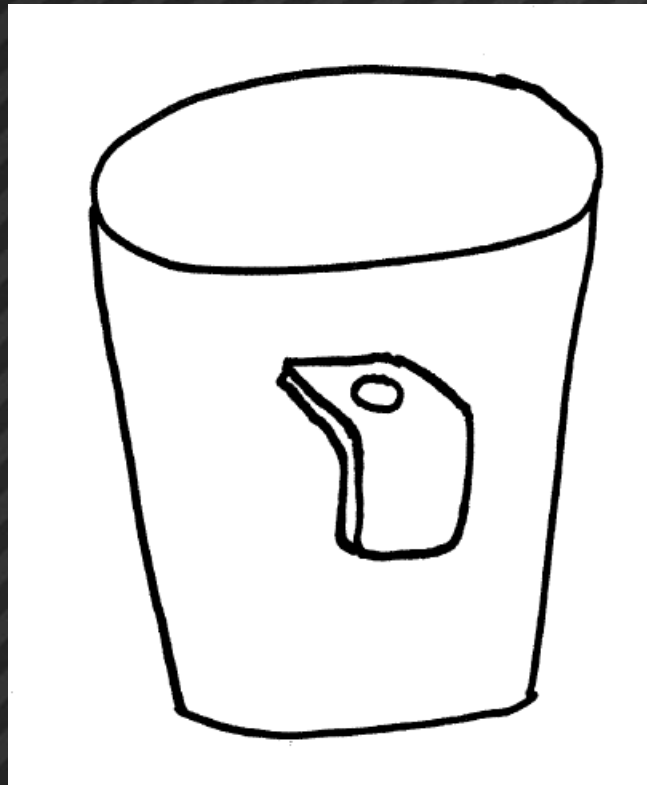
## Patent Claim Version 1

- A mug having a handle, wherein the handle includes two holes for receiving a teaspoon.



# SPOTTING THE INVENTION

## Infringement 1



# SPOTTING THE INVENTION

## Patent Claim Version 1 vs Infringement 1



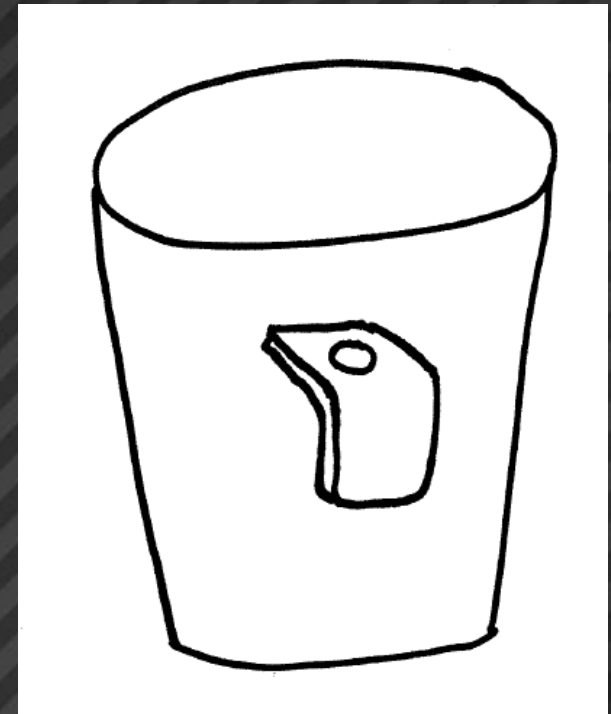
mug



handle



two holes in the handle  
for receiving a teaspoon



**No Infringement**

# SPOTTING THE INVENTION

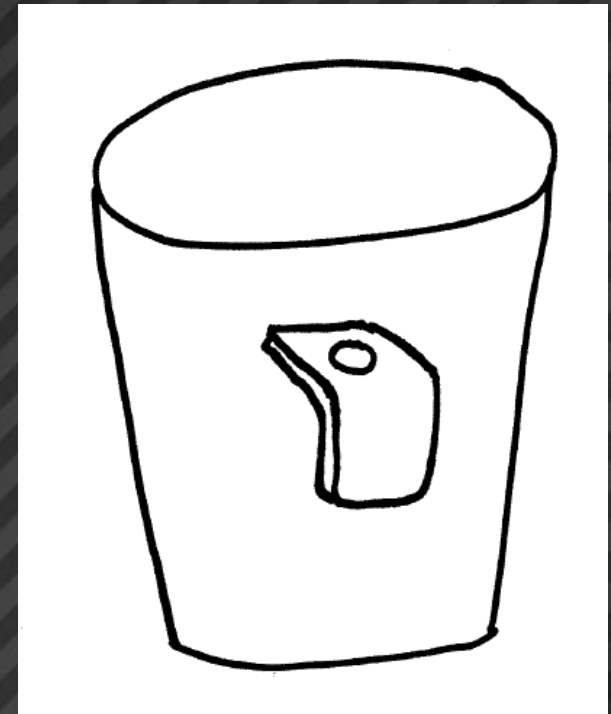
## Patent Claim Version 2

- A drinking vessel having a handle, wherein the handle is adapted for stowing a spoon.

# SPOTTING THE INVENTION

## Patent Claim Version 2 vs Infringement 1

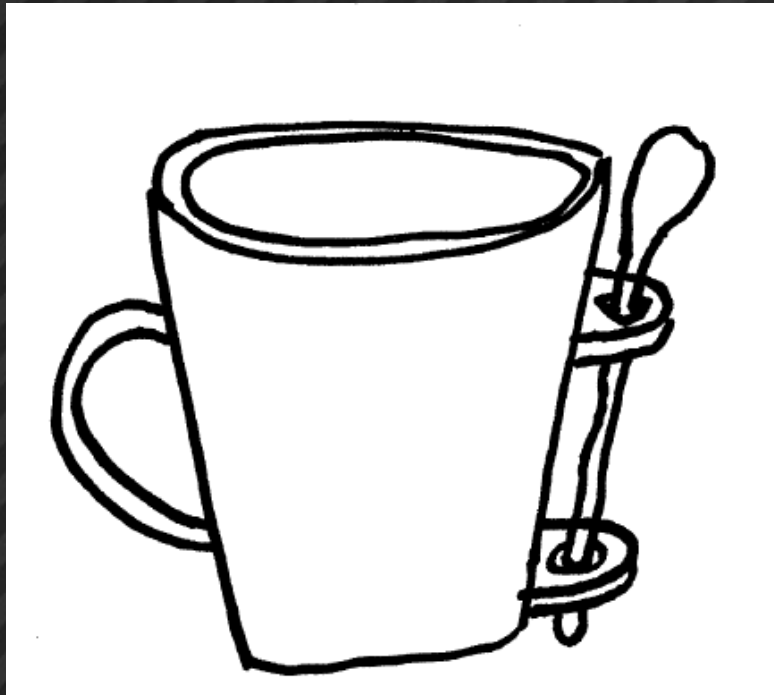
- ✓ drinking vessel
- ✓ handle
- ✓ handle is adapted for stowing spoon



**Infringement**

# SPOTTING THE INVENTION

## Infringement 2



# SPOTTING THE INVENTION

## Patent Claim Version 1 vs Infringement 2



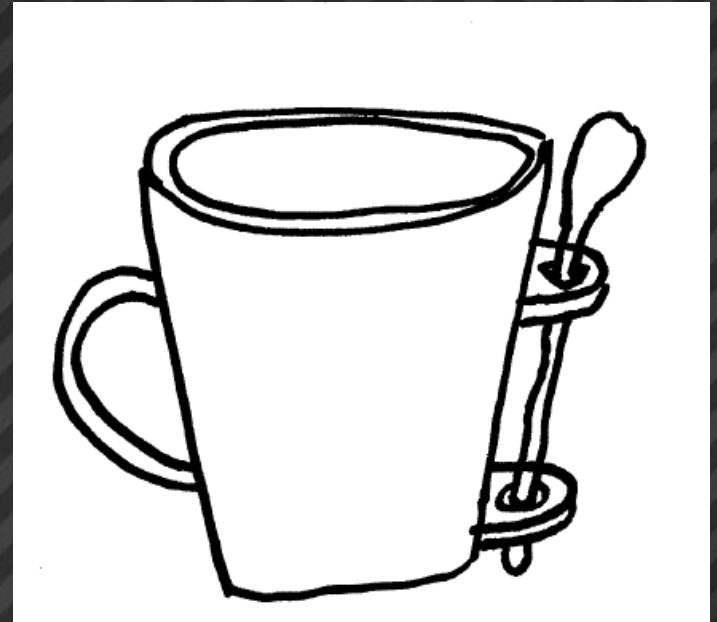
mug



handle



two holes in the handle  
for receiving a teaspoon



**No Infringement**

# SPOTTING THE INVENTION

## Patent Claim Version 2 vs Infringement 2



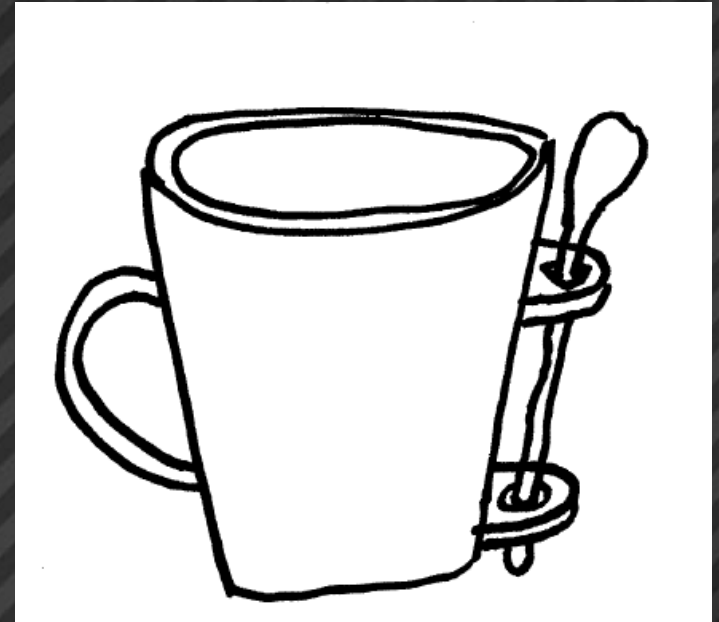
drinking vessel



handle



handle is adapted for  
stowing spoon



**No Infringement**

# SPOTTING THE INVENTION

## Patent Claim Version 3

- A drinking vessel characterised in having an integral utensil holder.



# SPOTTING THE INVENTION

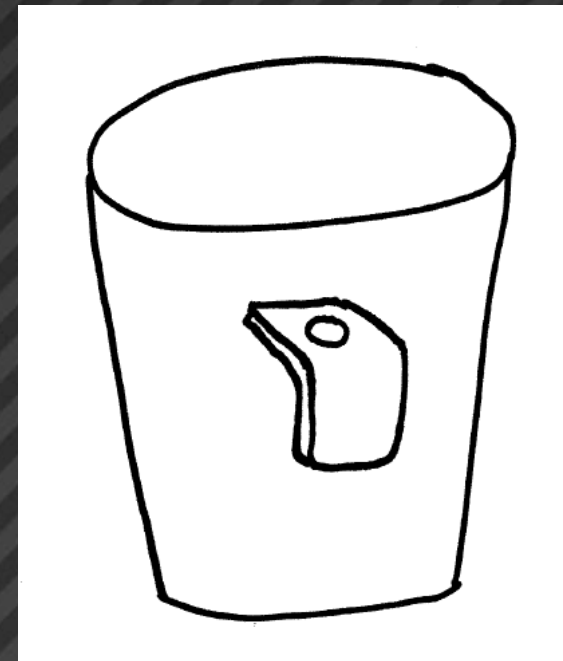
## Patent Claim Version 3 vs Infringement 1



drinking vessel



integral utensil holder



**Infringement**

# SPOTTING THE INVENTION

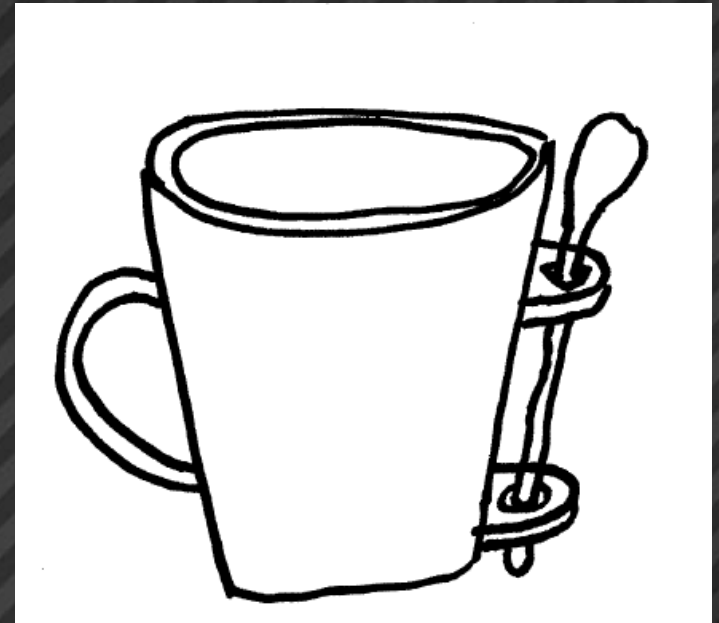
## Patent Claim Version 3 vs Infringement 2



drinking vessel



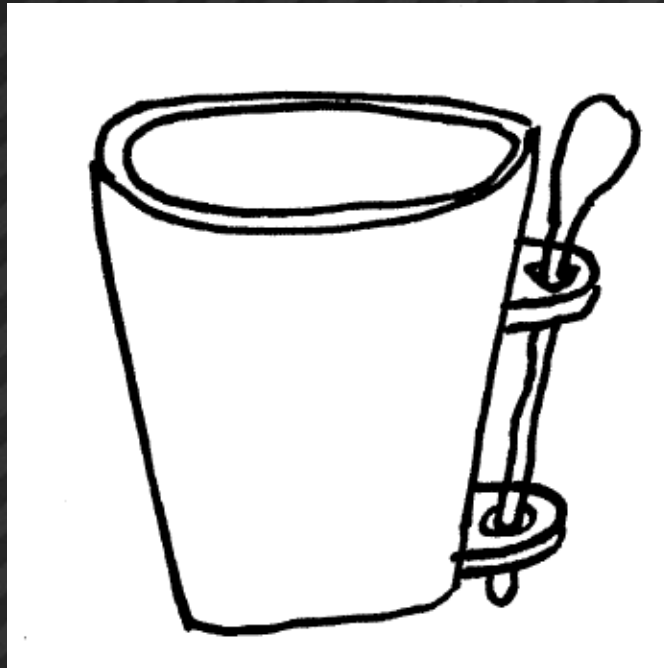
integral utensil holder



**Infringement**

# SPOTTING THE INFRINGEMENT

Here is one more infringement

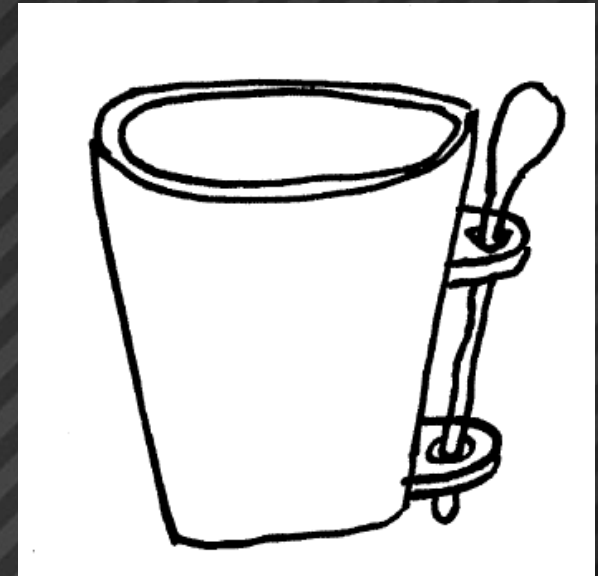


# SPOTTING THE INVENTION

## Infringement 3

### Patent Claim Version 1

- A mug having a handle, wherein the handle includes two holes for receiving a teaspoon.



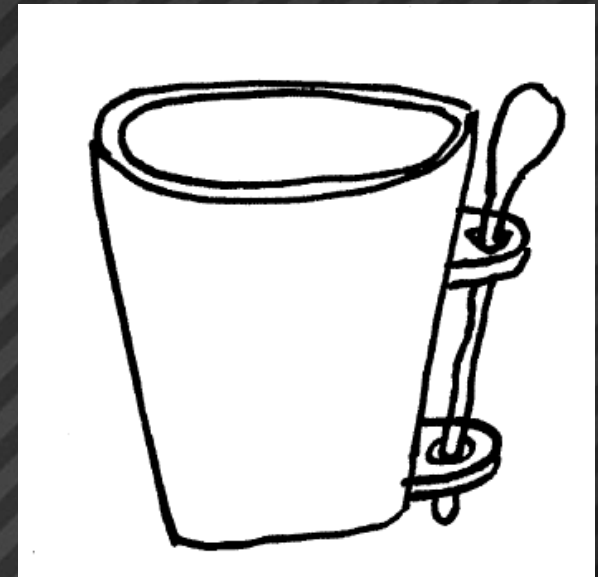
**No Infringement**

# SPOTTING THE INVENTION

## Infringement 3

### Patent Claim Version 2

- A drinking vessel having a handle, wherein the handle is adapted for stowing a spoon.



**No Infringement**

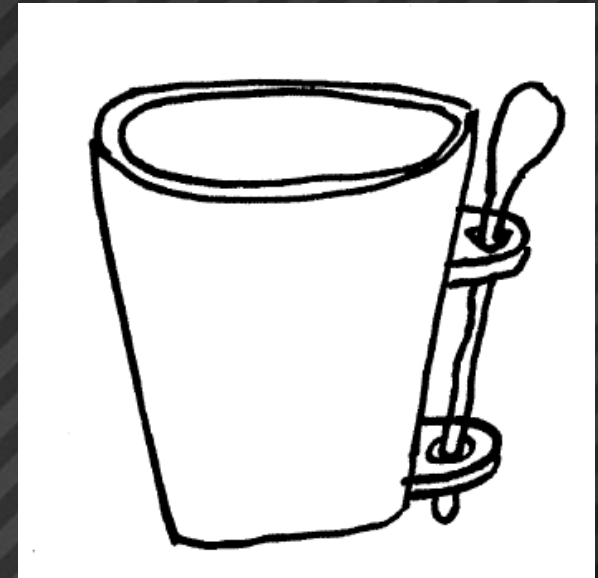
# SPOTTING THE INVENTION

## Infringement 3

### Patent Claim Version 3

- A drinking vessel characterized in having an integral utensil holder.

## Infringement

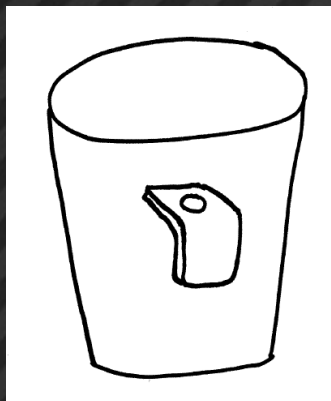


# SPOTTING THE INVENTION

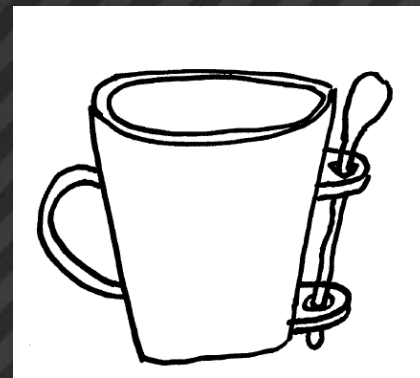
## Patent Owner's Product vs Alleged Infringements



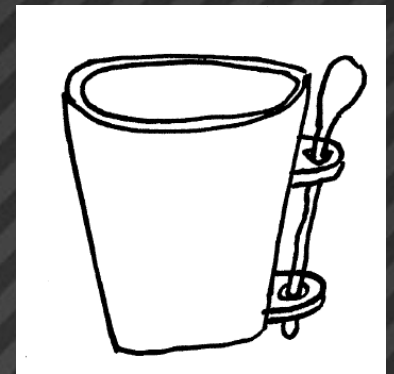
Patent Owner's  
Product



Infringement 1



Infringement 2



Infringement 3

# SPOTTING THE INVENTION

## What went wrong with drafting of Claims Version 1 and Version 2?

- drafter did not distinguish between the inventor's prototype and the invention behind it
- he claimed what he saw



# SPOTTING THE INVENTION

## How was Claim Version 3 different?

- drafter identified with his mind rather than his eyes what the inventor had done
- he distinguished between the underlying idea and the specific implementation of it

# SPOTTING THE INVENTION

## Narrow Claims

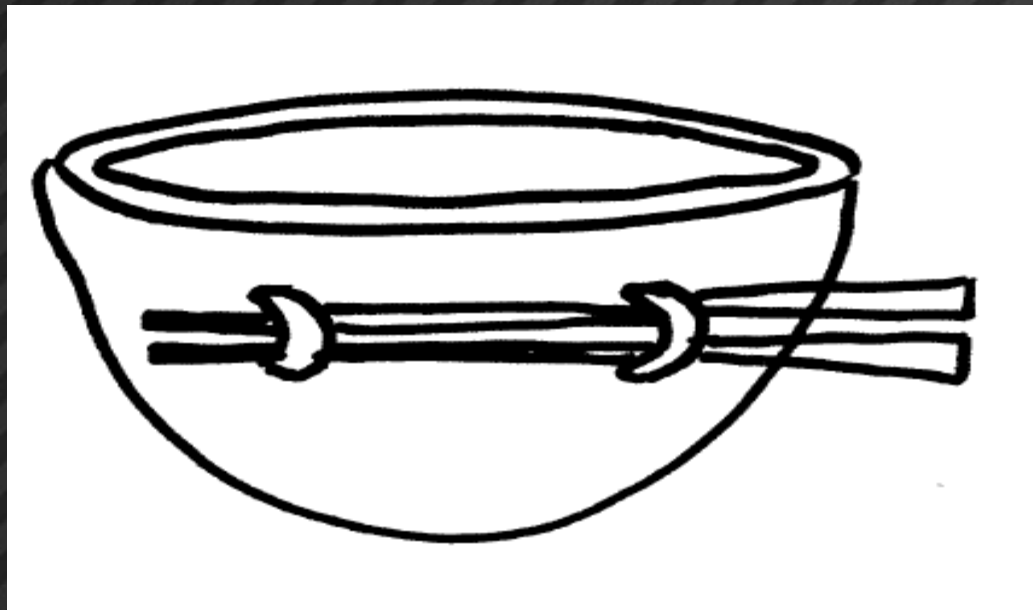
- too focused on the patent owner's specific product
- easy to work around
- only infringed by copy cats

## Broad Claims

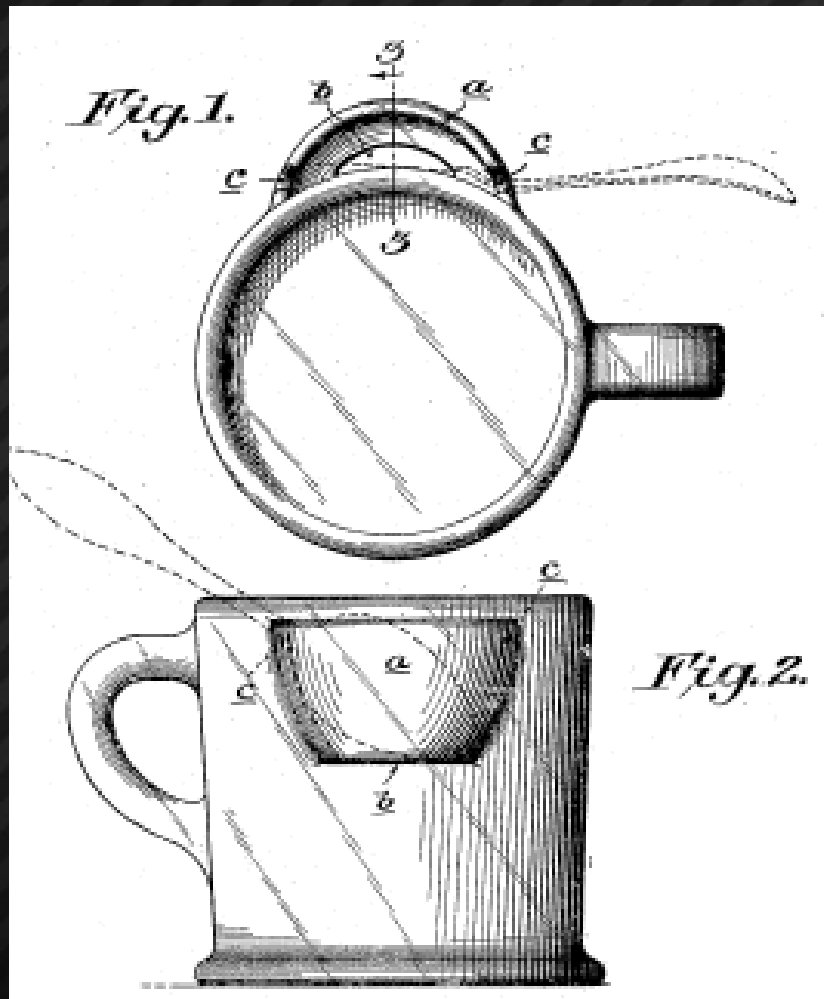
- covers the underlying inventive idea
- not easily worked around
- infringed even by smarter copy cats

# SPOTTING THE INVENTION

## Infringement 4



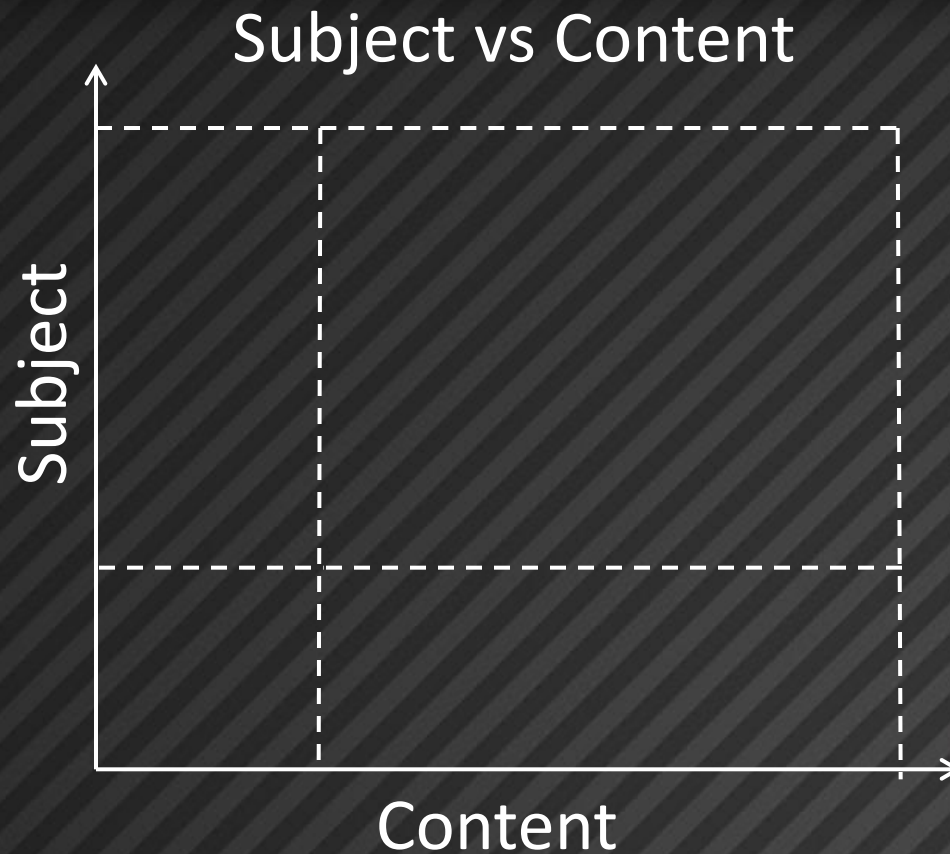
# US PRIOR ART – US 1,276,018



# NAMING THE INVENTION

- Scope of patent claim = Subject x Content
- Subject = what you call the invention and its field of application
- Content = how you define the invention beyond that

# NAMING THE INVENTION



Scope = area of the chosen rectangle

# NAMING THE INVENTION

## Example – Water Supply System



Bottle of Water



Water Cooler

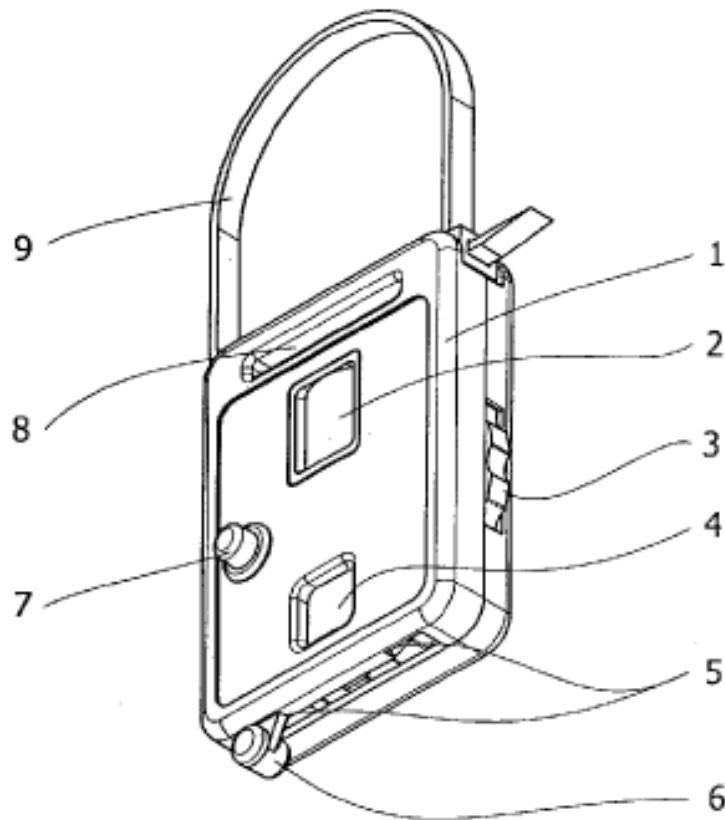


Sewage Treatment Plant

# NAMING THE INVENTION

## Example – Invention

**Title:** FUEL CONTAINER STATUS INDICATOR TAG



**(57) Abstract:** A fuel container status indicator tag for signaling the status of the contents of a fuel container, for example whether gasoline has been mixed with two-stroke oil, or is not yet mixed. The tag includes a casing (1), an actuator (14) mounted for rotation within the casing, and a window (4) for showing the status. The actuator includes a disc-shaped plate (14) and a radial tab (20) that protrudes through a slot at one end of the casing and is movable between the ends of the slot to reveal different status signs, such as red and green, through the window. A double-locking system (5, 7) prevents accidental switching. In one embodiment, an integral calculator (2, 3, 10) is provided for determining the volumes of gasoline and oil needed for specified mix ratios.



# NAMING THE INVENTION

## Example – Claim

### Claim 1

A fuel container status indicator tag for signaling the status of the contents of a fuel container, the tag comprising:

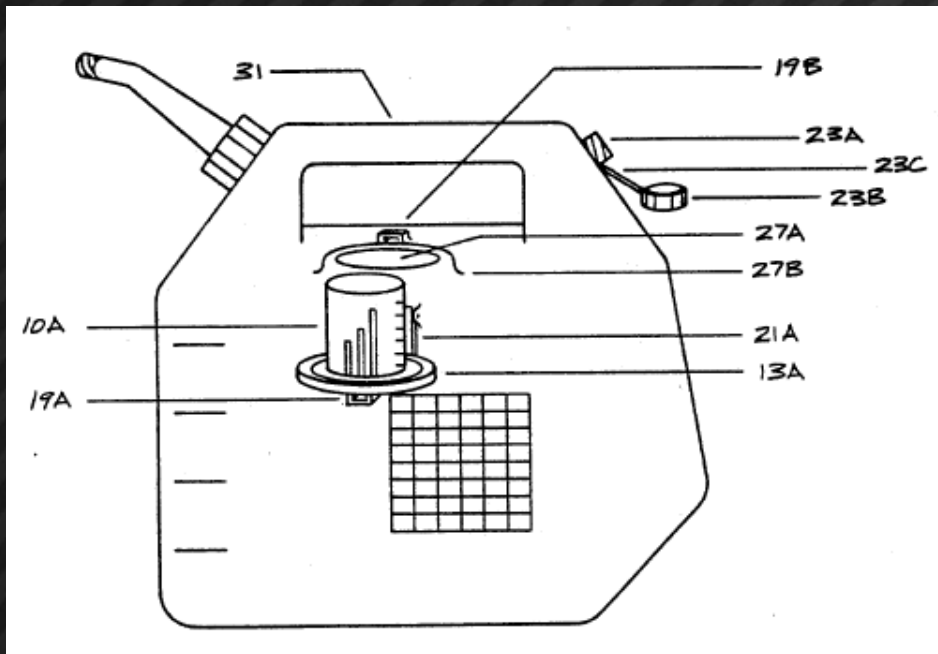
a casing adapted to be secured to the container; and  
an actuator mounted within the casing and movable by hand between a first locked position and a second locked position;  
wherein the tag displays a first status when the actuator is in the first locked position and a second status when the actuator is in the second locked position.

Subject

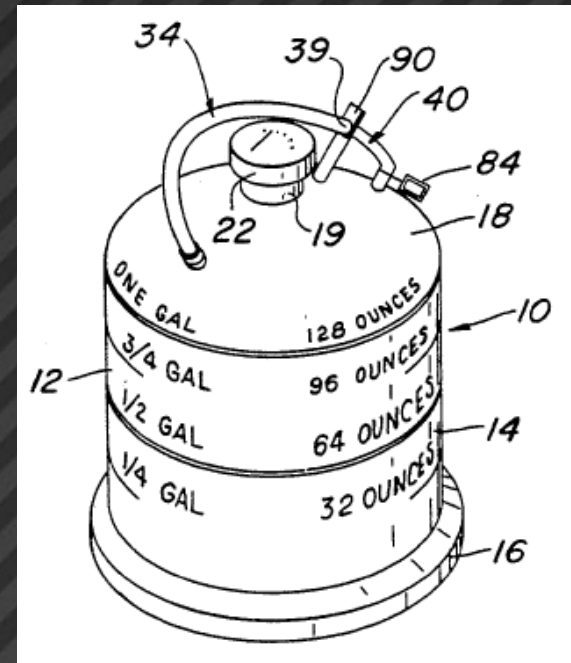
Content

# NAMING THE INVENTION

## Example – Prior Art



US 5,295,610 A



US 5,108,016 A

# NAMING THE INVENTION

- importance of appropriate naming is underestimated
- goes back to patent owner's business interest
- has enormous impact on prosecution
  - removes extraneous prior art
  - gives better search quality
  - serves to focus prosecution and reduce cost
  - strengthens patent validity

# CLAIM DRAFTING – INITIAL STEPS

## Invention Spotting

- if that is too difficult, start with feature analysis

## Features Analysis

- list every conceivable feature
- group and filter features for independent claims
- filter and prioritize features for dependent claims

## Invention Naming

- decide on the field of interest
- choose an apt name

# CLAIM DRAFTING – ACTUAL WRITING

- use simple language and terminology – less ambiguous and better for future translation
- positive recitation of features
- avoid action-oriented language in product claims – define in terms of capability
- limited if any explanation
- do not state advantages in the claim

# CLAIM DRAFTING – ACTUAL WRITING

- use two-part form for independent claims
- reasonable number of dependent claims directed to features of value
- maximize use of multiple claim dependencies
- avoid optional features

# CLAIM DRAFTING – QUALITY CHECK

## Stand outside the claims

- test the independent claims by thinking like an infringer – what would a determined infringer do to escape the claim wording?
- check against the prior art
- test extreme interpretations
- peer review – ask a colleague to review and feedback

# DESCRIPTION DRAFTING

## Title

- keep it short
- does not need to recite claim categories
- meaningful as to field but no hint of invention

## Introduction

- keep the introduction short and concise
- selective citation of prior art
- no hinting at the invention



# DESCRIPTION DRAFTING

## Summary of invention

- use statement of invention for each claim
- add a statement of advantage for each claim

# DESCRIPTION DRAFTING

## Detailed description

- detailed, self-contained written description
- drawings are required if necessary or useful for understanding
- however, do not rely on drawings as a substitute for the written description
- organized structure – for example: product make-up, followed by explanation of how it works

# DESCRIPTION DRAFTING

## Detailed description

- describe the embodiments in specific, non-optional terms – deal with variants separately
- use metric / SI units
- best mode must be included and cannot be suppressed
- keep an eye on the claims – each claimed feature must be supported in the detailed description

# DESCRIPTION DRAFTING

## Drawings

- have formal drawings professionally prepared
- add reference signs for all features
- ensure consistent use of reference signs throughout the specification

# DESCRIPTION DRAFTING

## Abstract

- has no effect on scope of protection
- can use an independent claim except written in natural language
- may include reference to one or more features from dependent claims
- state main advantage and problem solved
- observe the maximum 150 word count

# RESTRICTIONS ON FOREIGN FILING BY MALAYSIAN RESIDENTS

Matter	Comment
<b>Restrictions on First Filing</b>	No person resident in Malaysia shall file or cause to be filed an application for a patent outside Malaysia
<b>Exception 1</b>	A first patent application has been filed in Malaysia and a period of 2 months has lapsed without any prohibition on publication
<b>Exception 2</b>	Written permission to file overseas has been obtained in advance from the Registrar of Patents – so-called Foreign Filing Licence
<b>Qualifying person - interpretation of who is covered</b>	Natural or legal person, based on residence not nationality On a cautious interpretation, this provision extends to an inventor and not merely an applicant resident in Malaysia
<b>Application for Foreign Filing Licence</b>	Straightforward process, takes about 1~2 weeks Requirements: Name and address of applicant Name and address of inventor Country of proposed filing Title of invention Specification
<b>First Application via PCT</b>	May be filed with MyIPO as Receiving Office together with a request for written permission filing Filing via ePCT is not possible
<b>Non-Compliance</b>	Criminal offence, punishable by fine and/or jail sentence upon conviction

# DOS AND DON'TS OF PATENT DRAFTING

Dos	Don'ts
<ul style="list-style-type: none"><li>• Invest in thinking time before claim drafting</li></ul>	<ul style="list-style-type: none"><li>• Claim only the embodiment instead of the invention</li></ul>
<ul style="list-style-type: none"><li>• Include dependent claims that add value</li></ul>	<ul style="list-style-type: none"><li>• Draft only trivial dependent claims</li></ul>
<ul style="list-style-type: none"><li>• Write a detailed and concrete description</li></ul>	<ul style="list-style-type: none"><li>• Make the description vague and woolly</li></ul>
<ul style="list-style-type: none"><li>• Include the best mode</li></ul>	<ul style="list-style-type: none"><li>• Leave out the inventor's preferred implementation</li></ul>
<ul style="list-style-type: none"><li>• Get draft claims peer reviewed</li></ul>	<ul style="list-style-type: none"><li>• Underestimate the value of another's opinion</li></ul>
<ul style="list-style-type: none"><li>• Seek professional assistance</li></ul>	<ul style="list-style-type: none"><li>• Do it yourself without professional review</li></ul>
<ul style="list-style-type: none"><li>• Request written permission if first filing is overseas</li></ul>	<ul style="list-style-type: none"><li>• File a first application via ePCT</li></ul>

**TERIMA KASIH**  
**Thank You**

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