

V. Patent Claim Drafting

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A. Theory of the Patent Claim

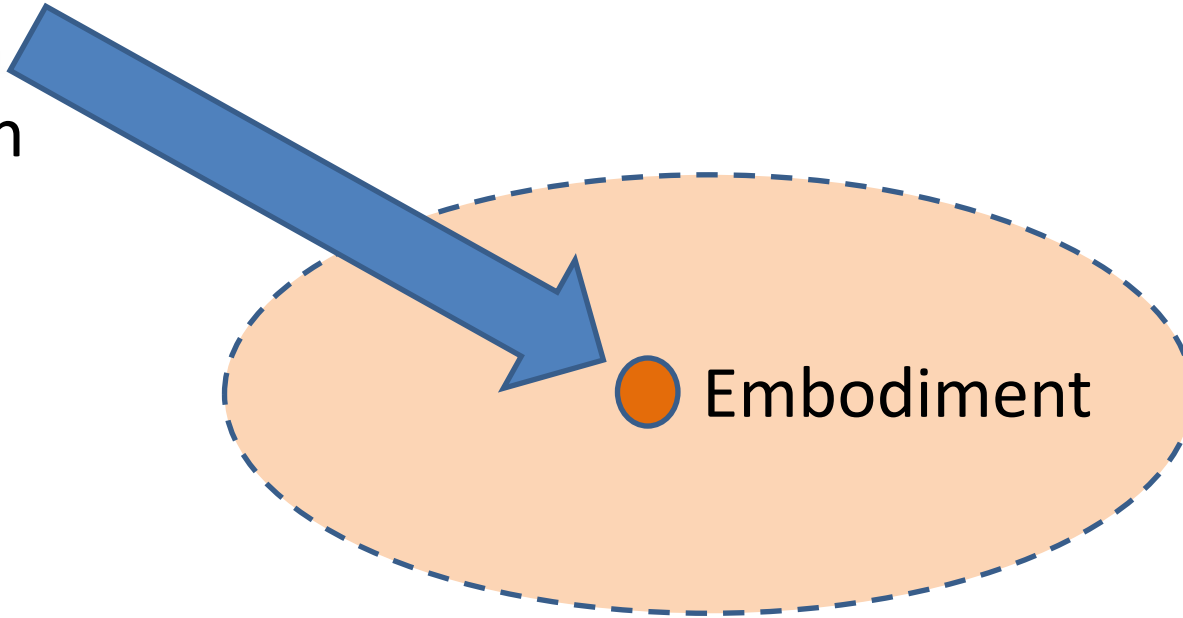


Three legal constructs

- “Invention” = mental construct inside the mind of the inventor, with no physical substance.
- An “embodiment” of the invention is a physical form of the invention.
- The “claims” protect at least one embodiment, but **the best patent claims protect the invention** (i.e. the inventor’s embodiment and all other possible embodiments of the invention).



Invention

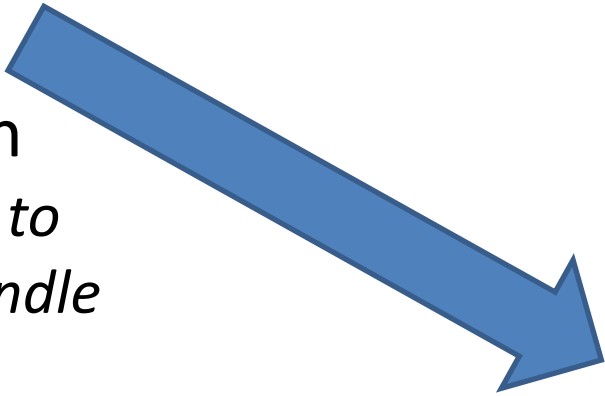


Claim scope



Invention

*= first cup to
have a handle*



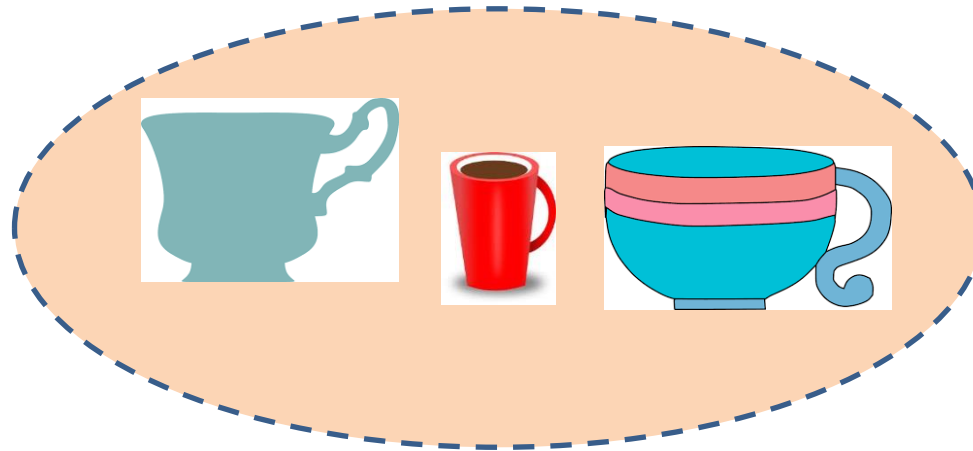
Embodiment

= red clay cup with handle



Invention

*= first cup to
have a handle*

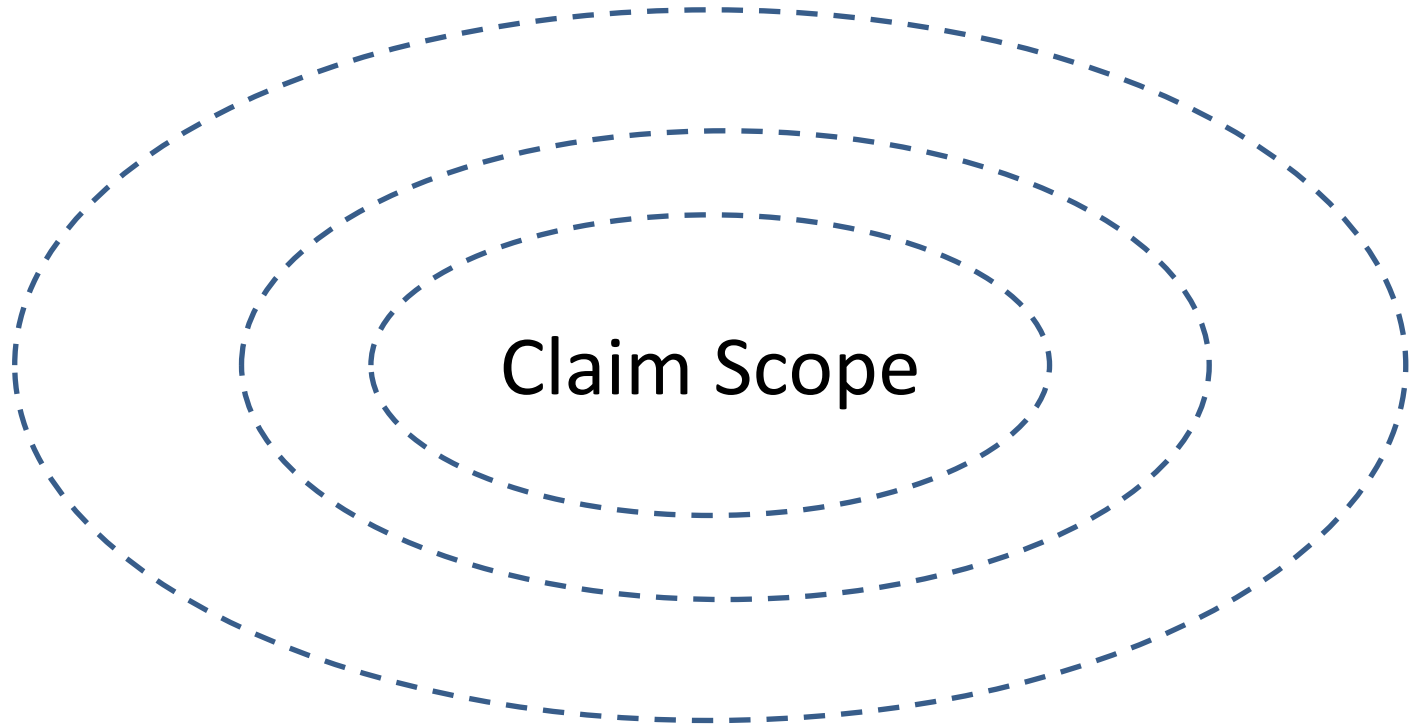


Claim 1. A cup with a handle

Narrowest scope
= validity



Broadest scope
= commercially
useful protection



Claim Scope

Some key requirements

- Scope of protection must be clear and concise
- The specification must support the claims
 - Consistent terminology must be used throughout
- Claims may be amended during prosecution with some limitations. Amendments must also be supported.

Part A - Quick Quiz

- Distinguish between an invention and an embodiment (of an invention)
- Which part of a patent defines the scope of protection that the patent provides?
- Why should a patent agent include both broad and narrow claims in a patent?

B. Patent Claim Format

- Single sentence, with punctuation

Claim Parts:

Preamble, Transitional Phrase: Body

Preamble

Identifies the category of claim

- Apparatus
- Article
- Composition
- Method
- Process
- ...

See page 69 for examples

Note: It is not necessary to use the “for” statement as in the examples. Some jurisdictions will not give any weight to the preamble, while others look at whether it “breathes life” into the claim as a whole.

Transitional Phrase

- Open-ended
 - **comprising**
 - [Also can consider: including, containing, characterised by...]
- Midway?
 - **consisting essentially of**
- Closed
 - **consisting of**

See page 70

It can be a good idea to define the transitional phrases you select to use in the specification

Body

- Recites the elements / limitations of the claim
- Recites the relationship of the claim features (if needed)

Preamble? Transitional Phrase? Body?

1. An apparatus, comprising:

a pencil;

an eraser attached to one end of the pencil; and

a light attached to the centre of the pencil.

Preamble? Transitional Phrase? Body?

1. An apparatus, comprising:
 - a pencil;
 - an eraser attached to one end of the pencil; and
 - a light attached to the centre of the pencil.
-

Punctuation and Antecedent Basis

Reference numbers

- Refer to features shown in the figures
- Not typically treated as limiting the claims, but rather to make the claims easier to understand.
 - Include a statement to this effect in specification

1. A pencil having an eraser (10), wherein the improvement comprises a light (12) attached to the pencil (3).

Improvement claims

- Preamble = prior art
- Body = invention
- Transitional phrases such as:
 - “...characterised in that...”
 - “...wherein the improvement comprises...” [Jepson]

1. A pencil having an eraser, *wherein the improvement comprises a light attached to the pencil.*

Means-plus-function claims

- Claims recite the function of a structure
 - Instead of specific definition of structure

1. An apparatus for cooking rice, comprising:
a means for holding rice; and
a heater configured to heat the rice-holding means.

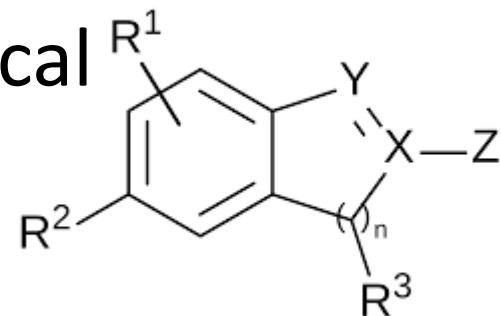
- Be very careful to provide adequate support of such phrases in the specification

Markush claims

- “... selected from the group consisting of...”
- Typically the group is related but cannot be defined in one term
 - Avoids the need for multiple independent claims

“... an alkali metal selected from the group consisting of lithium, sodium, and potassium.”

- Most often seen in biotech & chemical inventions.



Part B - Quick Quiz

- Name the three parts of a claim and explain each
- What is the difference between an open-ended and a close-ended transitional phrase?
- What is correct antecedent basis in a claim?
- True or false: a patent claim may simply list the parts of the invention with no apparent relationship to each other described?

C. Claim Sets

- Each patent application must contain at least one independent claim
 - Multiple independent claims are ok (provided unity of invention requirement is met)
- **Dependent** claims by definition include all the features of the claim from which they depend and something further
 - Narrower in scope than the claim they depend from
 - Multiple dependencies can be considered
- Limit on claim numbering (and multiple dependency) is almost always for cost reasons

INDEPENDENT CLAIMS

DEPENDENT CLAIMS

Capable of standing alone

Refers to an earlier claim (independent or dependent)

Starting claim for its group

Follows (depends from) another claim

Broadest claim of its group

“Fall-back” protection

Specifies all essential features of the invention

Not necessary as this is done in the independent claim

1. An apparatus, comprising:
a pencil;
an eraser attached to one end of the pencil.
2. The apparatus of claim 1, further comprising a light attached to the centre of the pencil.

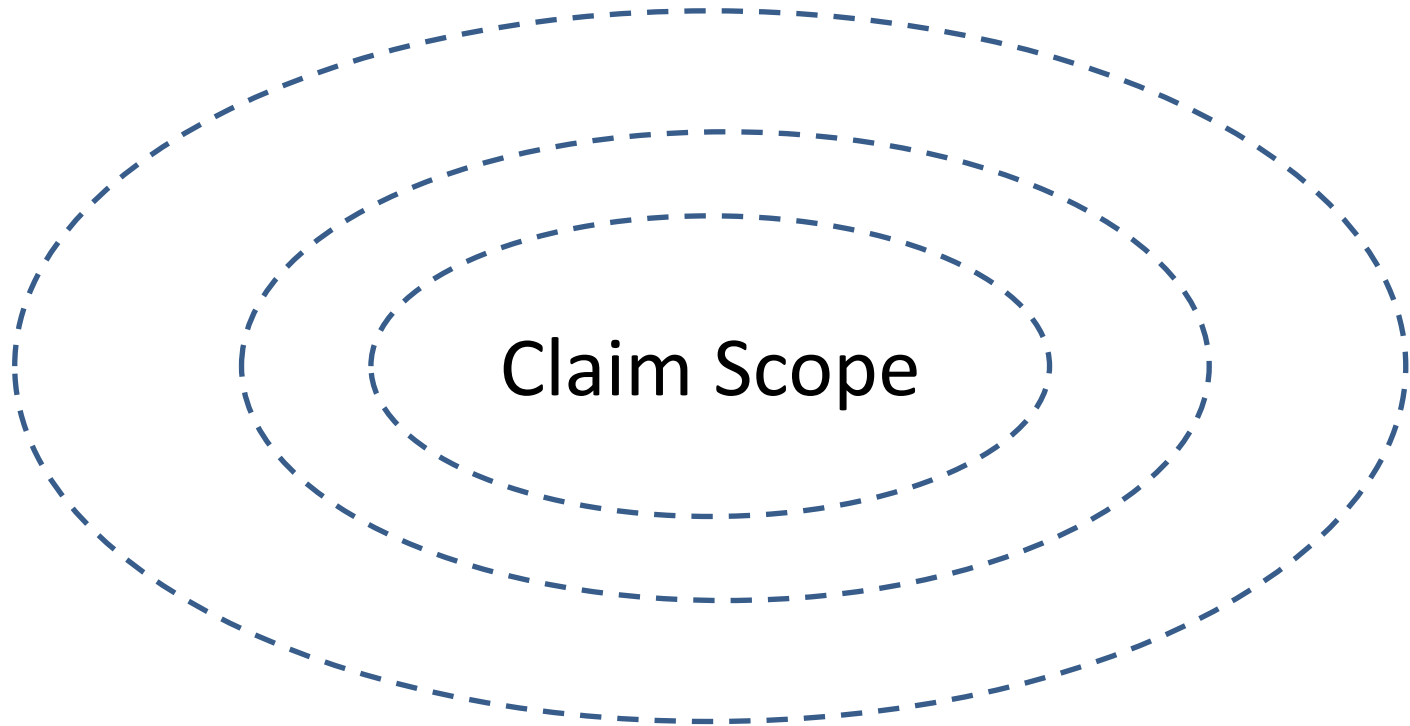
How do you re-write claim 2 as an independent claim?

1. An [~~The~~] apparatus [~~of claim 1~~], [~~further~~] comprising:
a pencil;
an eraser attached to one end of the pencil; and
a light attached to the centre of the pencil.

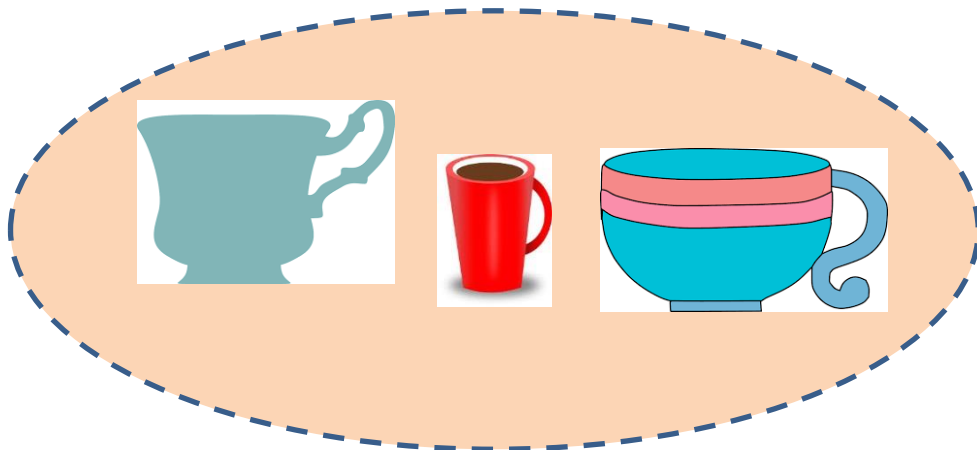
Narrowest scope
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Claim Scope



Claim 1. A cup with a handle



?



Part C - Quick Quiz

- A dependent claim may depend from any other claim (independent or dependent) – true or false?
- What is a multiple-dependent claim?
- Why should a patent agent include both broad and narrow claims in a patent?