

# Identifying the invention and preparing claim 1

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# Invention disclosures

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At the end of this first session you will be able to:

- Explain to your client/inventor what you need to know and why, to prepare a patent specification.
- Ask questions of the inventor to get the information needed to prepare a patent specification.

# Invention disclosures

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To draft a patent specification, you need to know a lot about the product invented, in order to ID the invention and draft a broad claim for it.

Before the meeting - try to read up about the field of technology and come prepared with technical questions to ask the inventor. **What else can you do?**

Introduce yourself and explain your background to give you credibility.

Explain

- Confidential relationship.
- Administration requirements.
- Timing and costs. Draw timeline.
- Check no prior publication has occurred.

Always keep an open mind to other or additional forms of IP that may be appropriate.

# Invention disclosures

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Inventors attitudes:

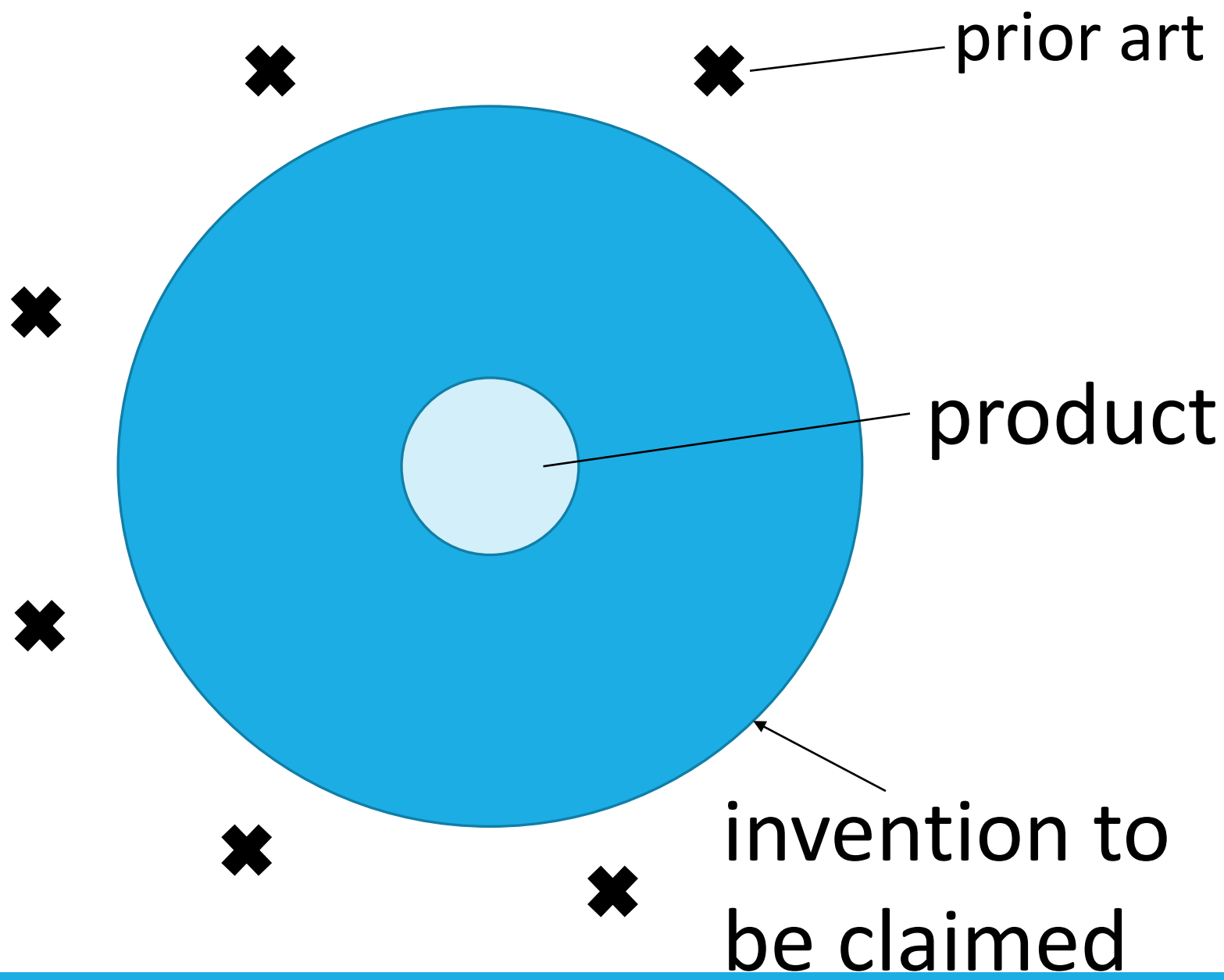
Cooperative, Disinterested, Anti IP, Engaging, Suspicious, Busy and more..

Explain expectations and what you and your inventor need to achieve.

Discuss timing and availability of the inventor and information.

Your client is the technical expert and you are the legal expert.

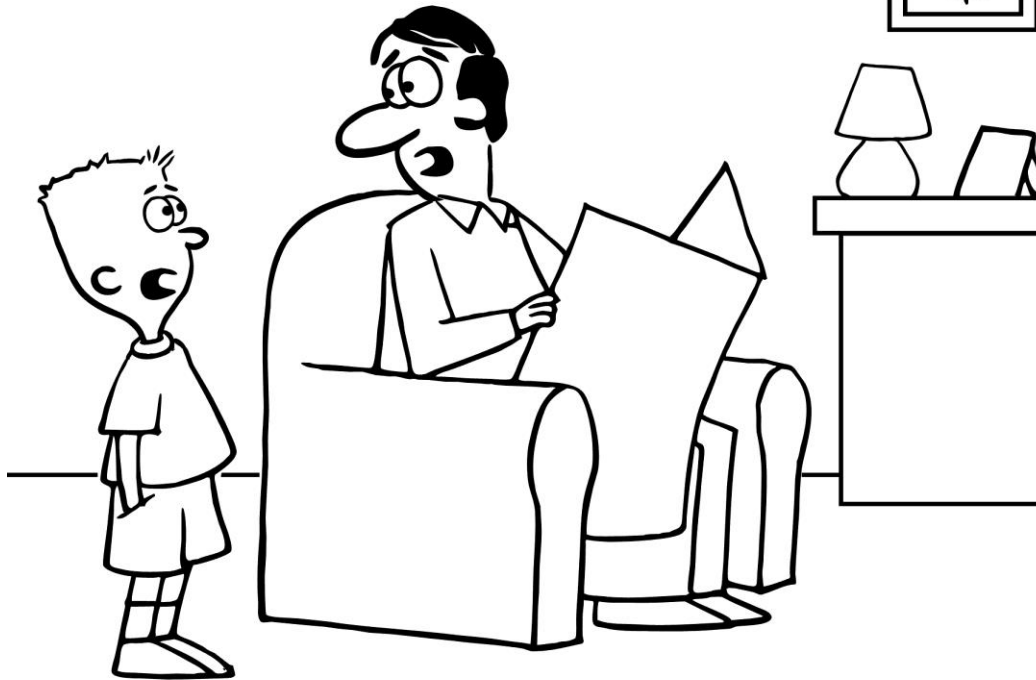
- Client has invented a product. You must conceptualise this. With the help of the inventor.
- Iterative process.





Daddy,  
what's  
"prior  
art"?

Depends  
on how good  
the patent  
attorney is.



# Invention disclosures

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Explain to your client what you understand about the technology and the prior art.

Let your client know what you understand and what you don't understand.

Be proactive with your questions. Don't think that you'll understand the feature later because it may be an important part.

- I didn't understand...
- It isn't clear to me why...

If something seems technically incorrect to you, it may be because:

- the inventor may be mistaken
- you haven't understood clearly
- it may be a breakthrough in technology

Confirm your understanding of the product.

# Why do you need all this info

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- To draft the claims to the concept. Not purely the product.
- For providing Support to the claims
- Best method disclosure requirements (in some countries)



# Questions to ask your client

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What has been done before?

- By you.
- By your competitors.

How did you come up with the idea?

What are the significant features?

What are the advantages of each feature?

What are alternatives you have thought about?

Is there any publication of this idea?

- Where, when, what, who?

Have you told anyone about this idea?

- Where, when, what, who?

Were non-disclosure agreements used?

# Questions to ask your client

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Who is/are the inventor(s)?

Who will the applicant be?

Which countries/jurisdictions do you want protection in?

What are the expectations or requirements about the cost?

When does the application need to be filed?

Prior art searching !!

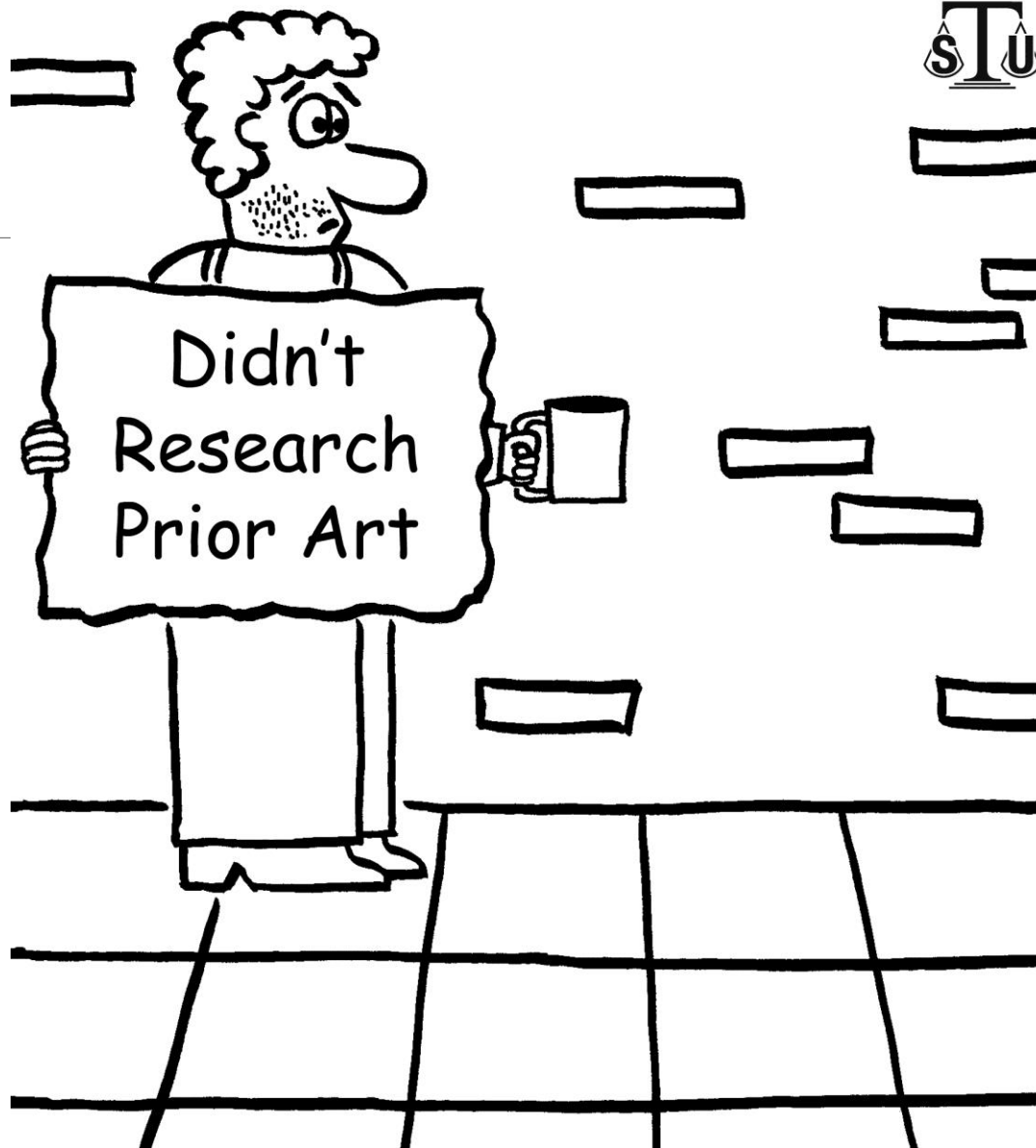
Explain about other types of intellectual property.

- Registered designs, trade marks, trade secrets.

How will the new idea be commercialized?

- Product, process, machine for manufacturing.
- IP Strategy should be 1<sup>st</sup> discussion before going down patent path

FTO. Don't forget this discussion



# Be curious about the invention

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Look at each feature and think about why it is like it is:

- Material
- Shape
- Interaction with other features
- Is the feature essential or optional?
- What are alternative features that might achieve the same purpose?

Ask lots of questions. Some features may look minor but may play a big role

Play devil's advocate

What if 3 wheels?



# Be curious about the invention

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Do prior art searching. You may discover other options, other applications or better ways

Question the commercial value if you do find a better way of achieving the same results, in the prior art.

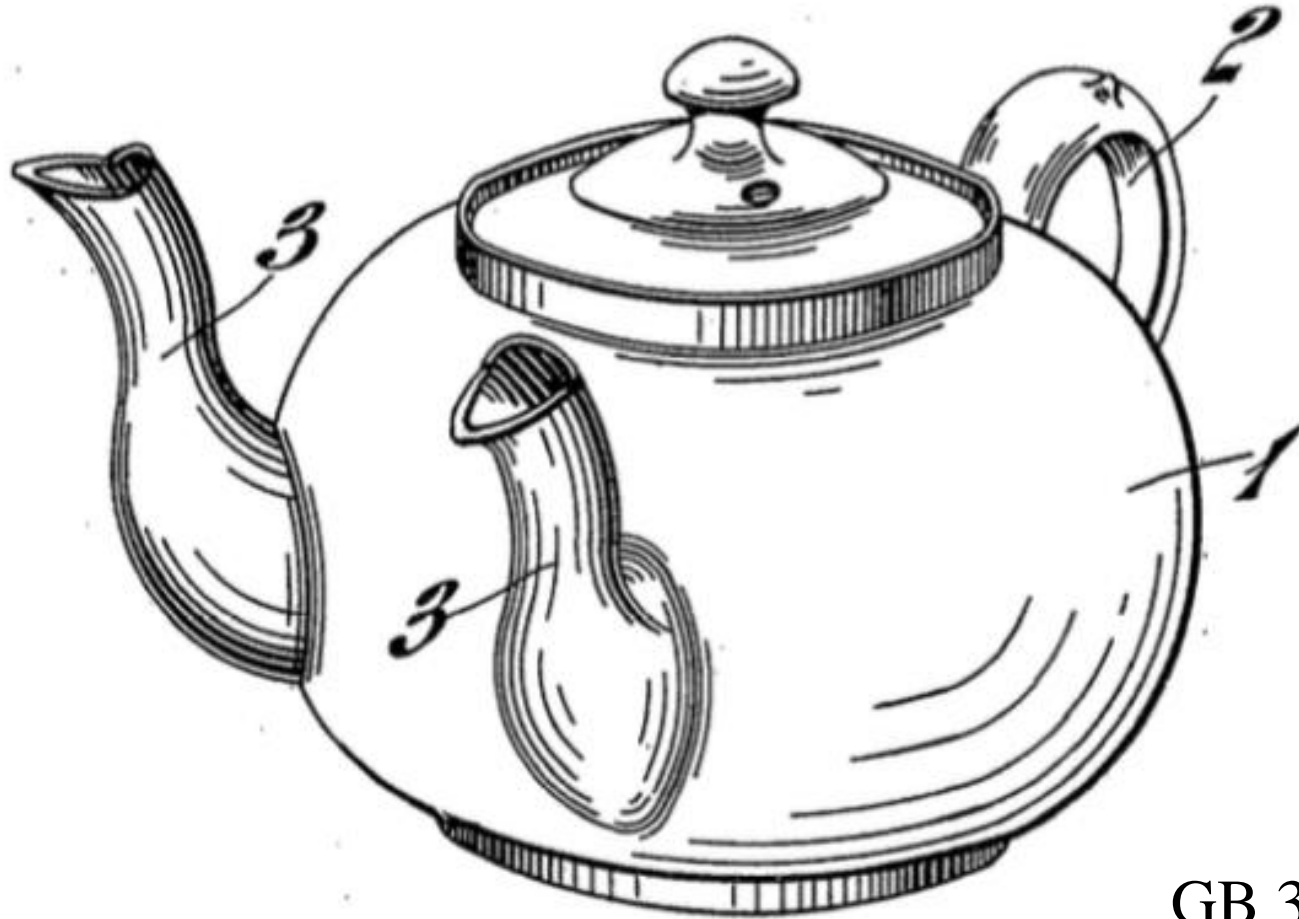


# Tea pot example

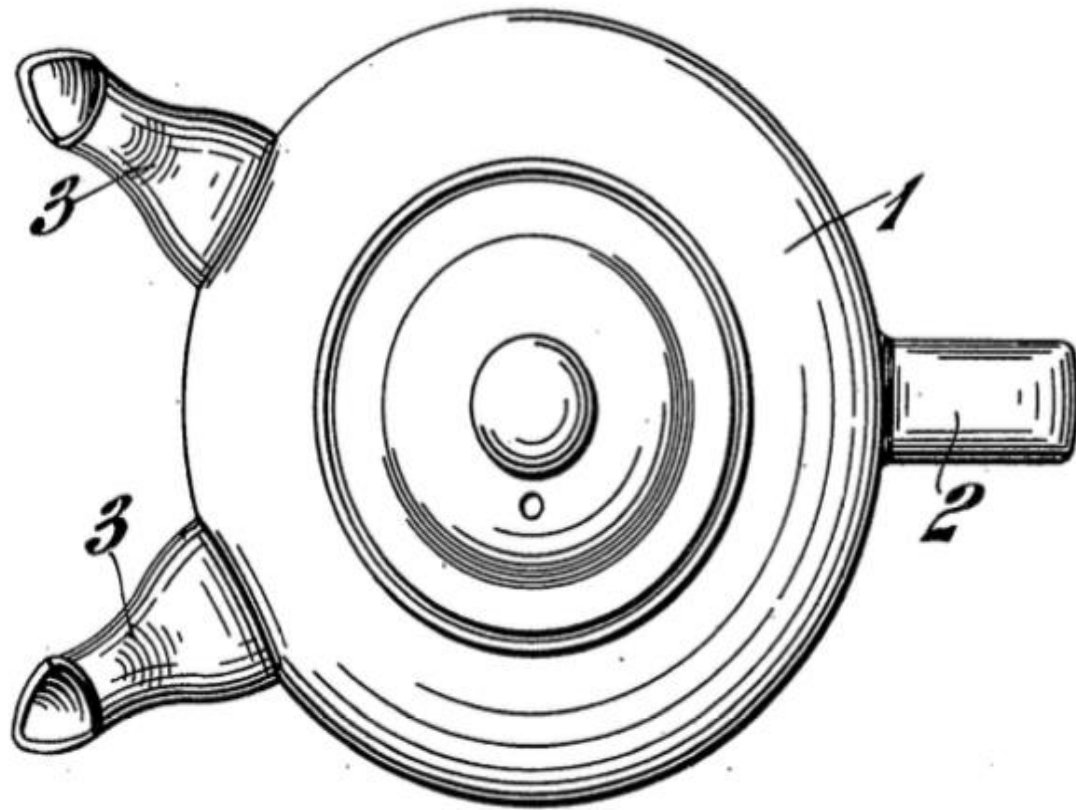
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Inventor says: I have invented a  
tea pot with two spouts



GB 360,253





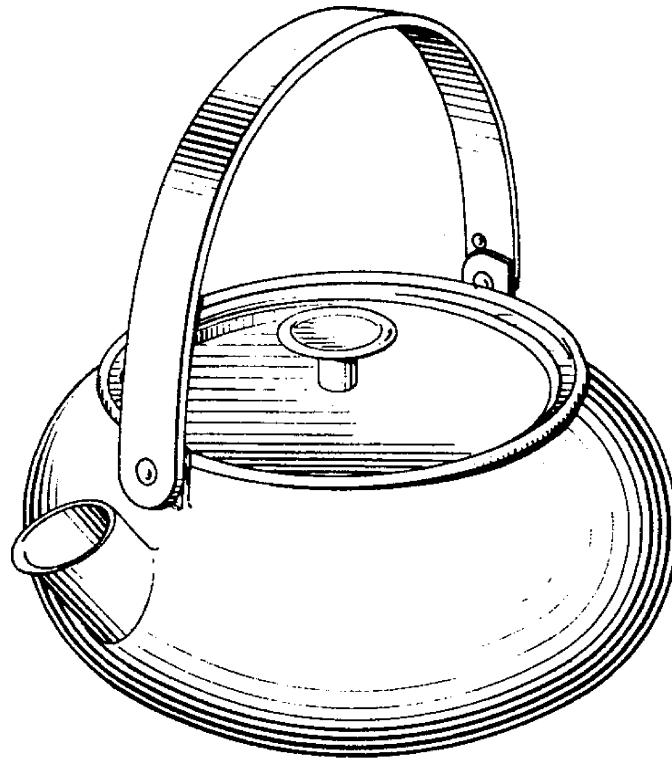
# Questions to the inventor to help ID the invention

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What prior art exists?

# Tea pot 1

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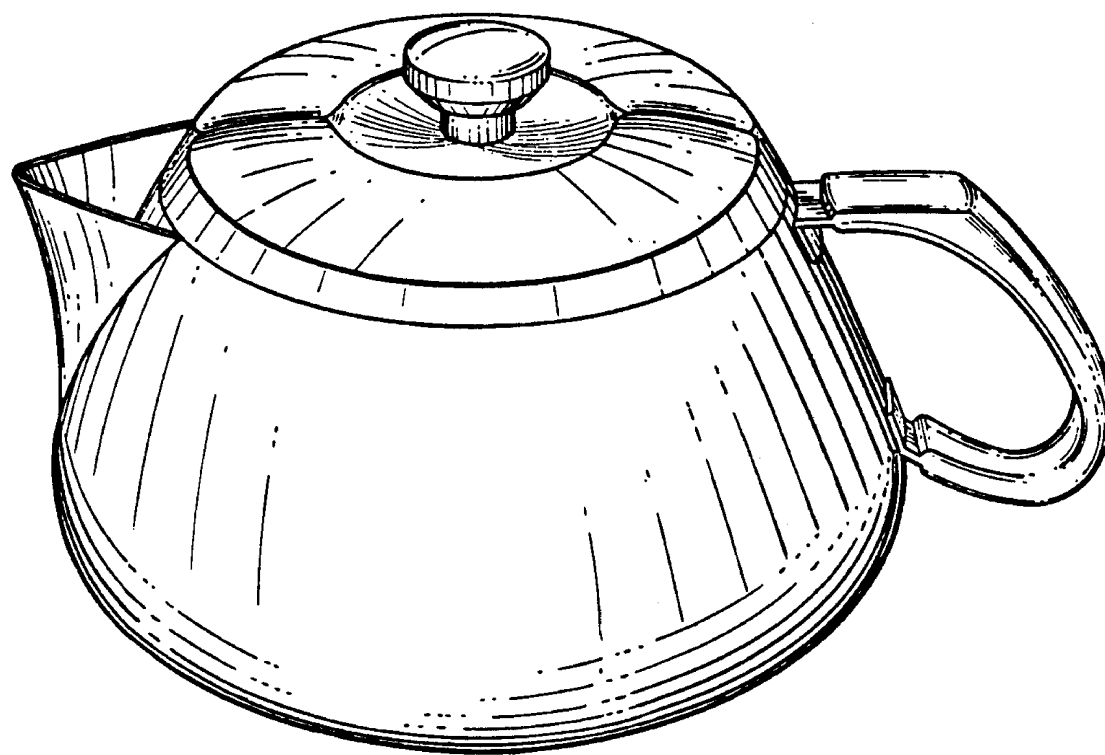
# Tea pot 2

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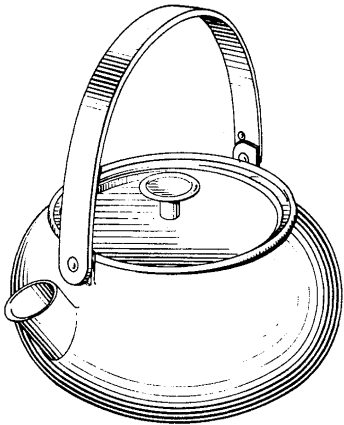


# Tea pot 3

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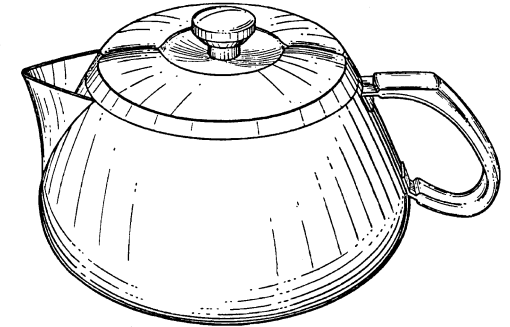


# Closest prior art?

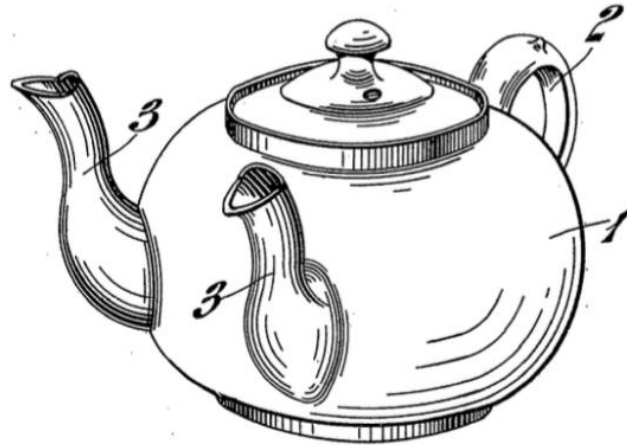


Tea pot 1

Tea pot 2



Tea pot 3



Tea pot of the inventor

# Questions to the inventor- Identifying the invention

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What is the difference between the closest prior art and the invention? (**Novelty**?) – Identifying the Invention

Could you explain your invention?

How is it constructed?

How does it function? How is it used?

# Questions to the inventor

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What arguments do we have in favour of **inventive step**?

Are there any other applications of the invention?

What is the aim / advantage of the invention?

What technical problem was solved by the invention?

# Questions to the inventor

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How does the invention solve that problem?

Due to what technical feature the problem underlying the invention is solved?

What are the technical effects caused by the invention?



# Questions to the inventor

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Is there another way to arrive at the technical effect caused by the invention?

What are the advantages of the invention in comparison to the prior art?

What are the important and/or critical features of the invention?

# Questions to the inventor

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How was the problem solved in the past?

What is it that you want your competitors not to be allowed to do? (Strategic defense)

How could a competitor design around the contemplated patent claim? (Strategic defense)

# Questions to the Inventor

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Do you intend to use the invention in your own business?  
(Revenue generation)

Are you planning to sell or license your invention?  
(Revenue generation)

Where do you want to get a patent? (Filing)

# Drafting Claims

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Patent claims explained

# Body of the claim

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The body follows the transitional phrase.

It is usually a list of features of the invention glued together with words to make it one sentence.

1. An apparatus for holding items, comprising:
  - at least one table leg; and
  - a top configured to support at least one leg.

The body cannot be a list of parts. The relationship between parts must be explained.

But when drafting a claim, one valid approach is to first create a full list of parts.

# Body of the claim

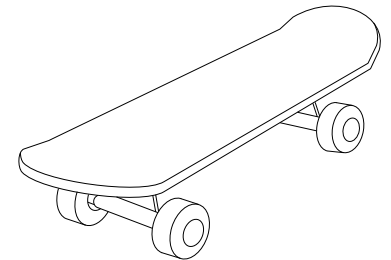
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The structure of the body is dependent on the nature of the invention.

Usually the first feature in the body is the core of the product that other components depend on.

1. A vehicle comprising:

- a deck;
- a first pair of wheels coupled to the front of the deck; and
- a second pair of wheels coupled to the back of the deck.



To be valid, an independent claim must include at least one novel and inventive feature or combination of features.

- usually many features of an independent claim are included in the prior art.

The claim does not need to recite all features of the product, only enough features to ensure that the novel features are put in context.

How do we come up with the words?

# Terminology

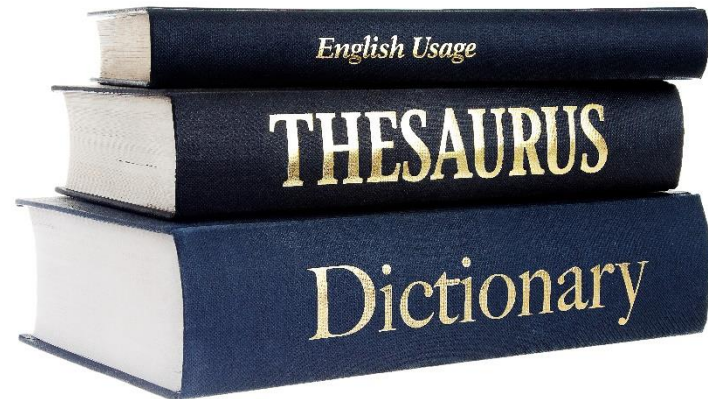
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Use words you understand and words your audience will understand too.

Use a dictionary:

- Check you understand the word you are using
- It may trigger your mind to think about other words that may be better

Read patents in the field

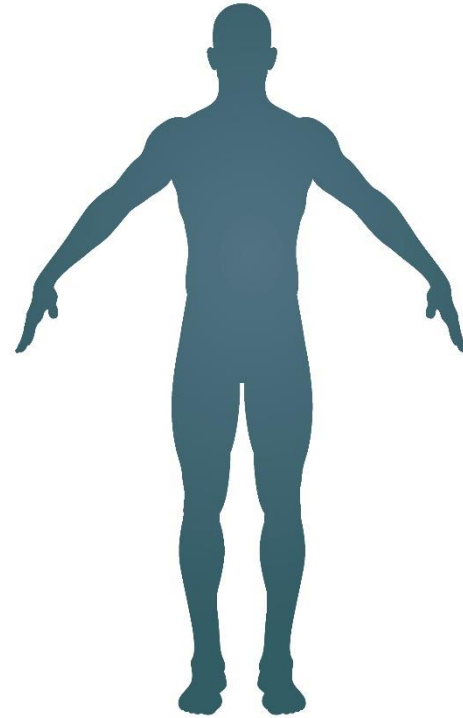


# Terminology

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Body parts can be useful terminology :

Neck  
Shoulder  
Arm  
Elbow  
Finger  
Foot  
Ear  
Eye





# Claim 1

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# Claim 1. Example exercise

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Tea Pot claim:

- List all the salient features of the product.
- Find the novelty creating parts and make that sacred
- Broaden (or delete) the non-sacred parts.
  - These are in the prior art anyway
- Glue the remaining features together
- Broaden the sacred parts.

# Test claim

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- Do elements relate to each other
- Does it cover product
- Does it avoid prior art
- Does it have unnecessary limitations

# Reference numbers

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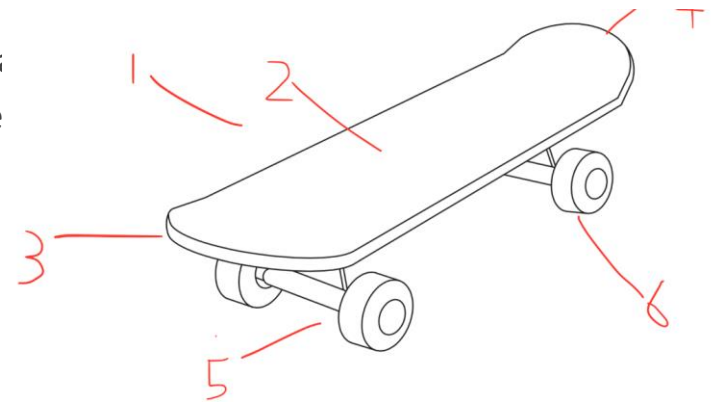
In some countries reference numerals must be included in the body of the claim.

Reference numerals relate to items shown in the drawings.

The EPO usually requires this.

## 1. A vehicle (1) comprising:

- a deck (2) that is elongate and that has a front (3) and a back (4)
- a first pair of wheels (5) engaged to the front (3) of the deck
- a second pair of wheels (6) engaged to the back (4) of the deck



# Antecedent

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The first time a feature is introduced in a claim, the word "a" or "an" is used.  
The next times the feature is referred to the word "the" is used.

1. A device comprising:

- a pencil; and
- a light attached to the pencil.

- Terminology must be consistently used.
- Example of lack of antecedent

1. A vehicle comprising:

- a deck that is elongated and has a front and a back;
- a first pair of wheels engaged to the front of the deck;
- a second pair of wheels engaged to the rear of the deck.