



# **Topic 9: Claim Drafting Techniques**

**Emmanuel E. Jelsch**  
**European Patent Attorney**

# Patent Claim Design

## ■ The Claims --

- Represent the heart of the patent application
- Define the scope of protection given to an invention
- Are usually the first and sometimes the only parts of patent application actually reviewed by the patent examiner

## Drafting Patent Applications

- Once the patent agent understands the invention, then he can begin preparing the patent application.
  - Prepare draft claims for the invention as the **first** step.
    - The patent agent may want to sketch out draft claims in the disclosure meeting with the inventor
    - This procedure will often confirm for the patent agent has understood the invention - immediate feedback from the inventor



# Drafting Patent Applications

- In the initial draft claims, the patent agent may wish to use a “picture” claim
  - A picture claim essentially “draws a picture” of the invention in words
  - A picture claim is not typically the broadest claim & does not use highly abstract language
  - But a picture claim can be helpful in beginning the process of finding the broadest possible claim

## Drafting Patent Applications

- A picture claim may be helpful in the initial meeting with the inventor since inventors are often unfamiliar with patent claim language
  - The patent agent will likely develop the most abstract terms possible for the claims later after further consideration of the invention



One part / two part form

## CLAIMS in the TWO-PART FORM



# Patent Claim Design

- In summary: Prepare the claims first
  - Write draft claims before preparing the description, drawings, etc.
  - Discuss the draft claims with the inventor early in the application drafting process
  - Review/revise the claims again once the specification has been completed

# Claims

- The claims are the legally operative part of a patent application
- The majority of patent agents prepare several draft patent claims as their first step in drafting a patent application
- When the claims are prepared before drafting the specification, then the patent agent knows precisely which terms need to be described clearly in the description.



## Claims



- After the patent agent has finished his draft description, then he must reconsider the claims
- It is possible that after preparing the description, the patent agent may see that the draft claims do not describe the invention as accurately as possible
- Once the patent agent has completed the final claim set
  - He must carefully check the drawings & description
  - To verify that the claim terms have been appropriately described & defined.

# Claims and the Description

- The “detailed description” section, should:
  - Breathe life into the claims,
  - Provide a sufficient disclosure of the invention that a skilled person in the relevant field could make & understand the invention,
  - Claims must be supported by the description
  - If the patent agent uses a highly abstract term in the claims, then he should use this term in the detailed description
  - Offers sufficient depth so that the claims can be narrowed during patent prosecution to avoid close prior art.



# Patent Claim Design

- **Include both broad and narrow claims**

- Include claims of varying scope

- Consider claim sets of varying scope

- Not just an independent claim followed by narrower dependent claims

# Patent Claim Design

- Gives the client a range of options
  - Broad claims will catch a wider group of infringers
  - Narrow claims will be more likely to be “valid” in light of prior art not known during prosecution
  - These options are not mutually exclusive
    - Give you client both options

## Patent Claim Design

- Often, the patent agent can prepare dependent claims from things he removed from draft claims while writing broad claims.
- As a patent agent, you must be creative in order to obtain the maximum possible protection.

# Theory of the Patent Claim

- Patent Claims must:
  - Define the invention for which patent protection is being sought,
  - Be clear and concise, and
  - Be supported by the description and drawings
    - Drafted in terms of technical features of the invention

# Patent Claim Design

- Choice of words in claim
  - Be cautious
  - Words should capture invention as well as variants
  - Word meanings must be appropriate
  - Words must convey meaning and cover invention

# Patent Claim Design

- Choice of words in claim
  - Watch out for “**relative**” words like
    - Fast, slow, long, short, tall, wide, perfect, complete, thin, strong, flat, etc.
    - Unless the relationship lies with another recited element in the claim
      - Ex: “wherein the first piece is shorter than the second piece”



# Patent Claim Design

- Choice of words in the claims
  - If you use a word established in a given technical field, make sure that you understand what the word means and doesn't mean
    - Explain the word's meaning in the description if necessary
  - If you use a new word in the claims, then make sure that you clearly establish its meaning in the description.

# Patent Claim Design

- Choice of words in the claims
  - Avoid negative limitations in claims
    - “a tire that is not solid”
  - State limitations in positive terms
    - “a hollow tire”
- Unless the limitation cannot be phrased in any other manner
  - “a non-black color”

# Patent Claim Design

- The description must support the claim language
  - Make sure every claim has adequate support in the specification
  - Words and terminology should be consistent
  - You don't need to define terms already known in the industry – if you're using them consistent with industry practice

# Patent Claim Design

- Claim variations/modifications of the invention
  - Think about variations or other *embodiments* of the invention
  - Think like a potential competitor trying to avoid the patent
    - Assume that the competitor has a piece of prior art that can knock out your broadest claim
  - Incorporate alternative embodiments into the description and claim them
  - Alternative embodiments broaden protection

# Patent Claim Design

- Avoid unnecessary limitations
  - Delete all unnecessary limitations before filing claims
  - File only the limitations or essential technical features necessary to recite the invention in its broadest patentable form in the broadest independent claim.

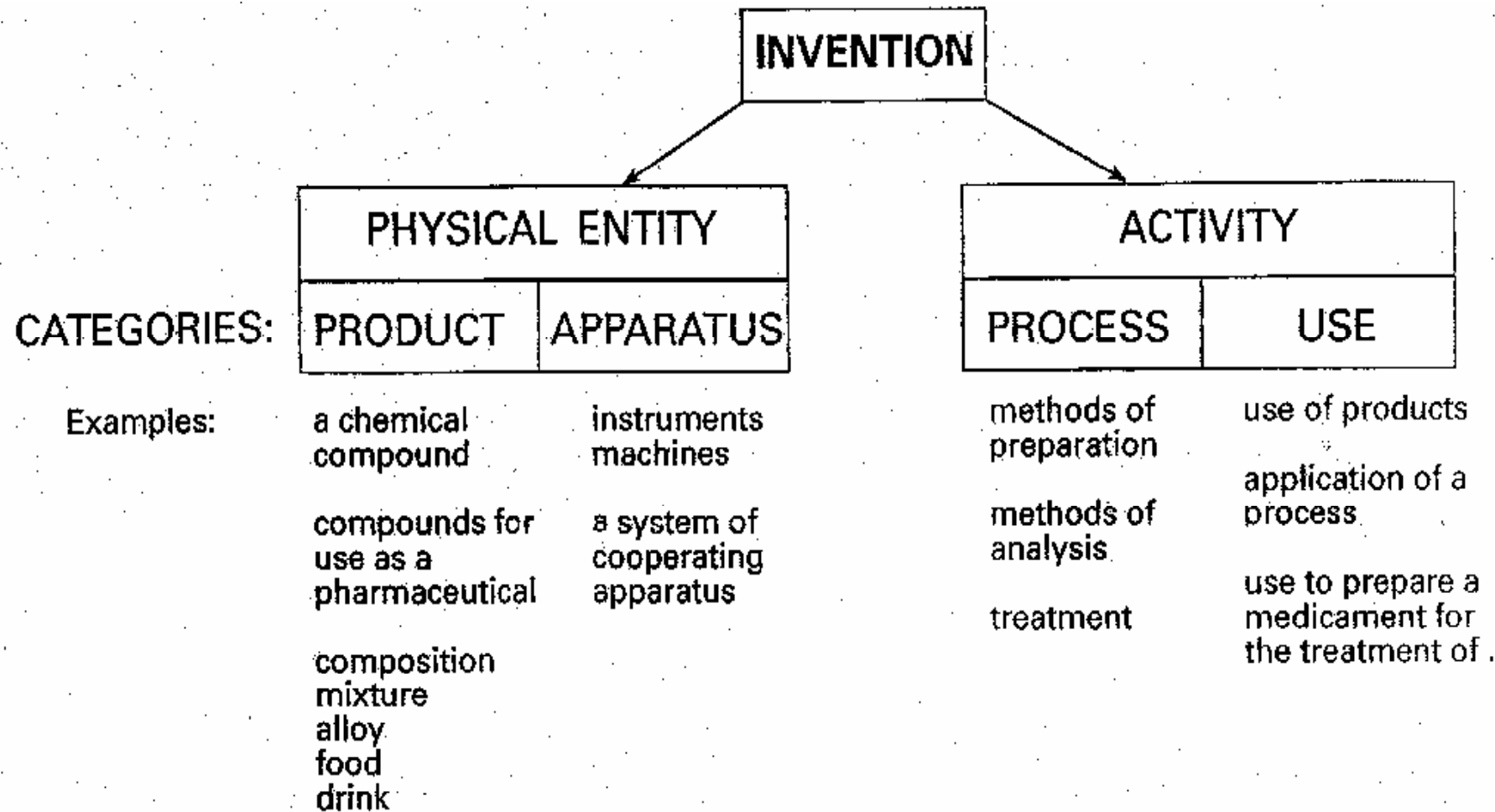
# Patent Claim Design

- If possible your claims should cover competing products
- But your claims must overcome the prior art
  - Be aware of related prior art
  - Do not file claims that you know to be invalid
  - Ideal to draft a narrower claim than prior art but broader than competing (non-prior-art) products

# Patent Claim Design

- Use Multiple Claim categories for the same Invention
  - Useful to get broadest possible protection
    - Some competitors will infringe device claims but not method claims and vice versa
  - Don't include every type of claim just for the sake of inclusiveness – use your judgment

# Category of claims





## Theory of the Patent Claim

**Always think about who is the infringer?**

**DON'T MAKE YOUR CUSTOMER THE ONLY POSSIBLE INFRINGER.**

# Patent Claim Design

- Narrowing a patent claim during prosecution
  - Add new elements to the claims and/or
  - Add new limitations to existing elements
  - All new additions must be supported by the description – as filed
  - Consider all relevant options in amending a claim
    - Do the least harm possible
  - The client should understand the implications of any claim amendments

# Patent Claim Design

## ■ Example

1. (Amended) An apparatus, comprising:
  - a pencil;
  - an eraser attached to one end of the pencil;
  - [[and]]
  - a light attached to the center of the pencil;
  - and
  - a removable cap attached to one of end of the pencil.

# Patent Claim Design

- Claims & Exclusions from Patentability
  - Most jurisdictions explicitly exclude certain types of inventions from patenting
  - The patent agent can sometimes simply re-word a claim to bring it from an unacceptable invention class to an acceptable one
    - TIP: Be prepared to fight for the patentability of certain types of inventions.

# Patent Claim Design

## ■ Claims & Exclusions from Patentability

- Ex. Strict rules exist in the biotechnology practice area due to public concern about patenting life and due to various moral concerns.
- However, thousands of biotechnology patents exist because patent agents have drafted claims that avoid the exclusions to patentability.
- Ex: Methods of treating the human body are excluded from patentability in certain jurisdictions but not « Swiss Type of claims ».

## Methods of treatment claims - EP

Aim: to alleviate the health of a patient.

EX:

A method of treating diabetes characterized in that insulin is sequentially injected to a patient in need thereof, and the blood glucose is controlled.



## Medical use claim - EP

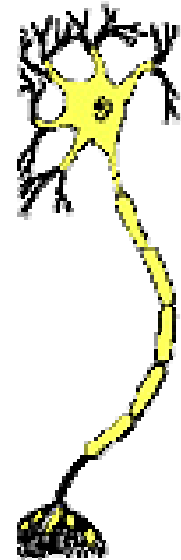
Aim: to circumvent the interdiction.

EX:

- Compound X for use in a method for treating diabetes in a patient in need thereof.

(formerly the Swiss type of claim)

- Use of compound X in the manufacture of a medicament for the treatment of diabetes.



## Patent Claim Design

- At least one claim in the application should read on what the client is actually doing
  - Defending the client's products against infringement may be difficult otherwise
  - Patent marking is also difficult



## Q & A