



Topic 4: **Claims, Priority Claims, and Prior Art**

Lutz Mailänder
Head, Patent Information Section
Global IP Infrastructure Sector

Manila
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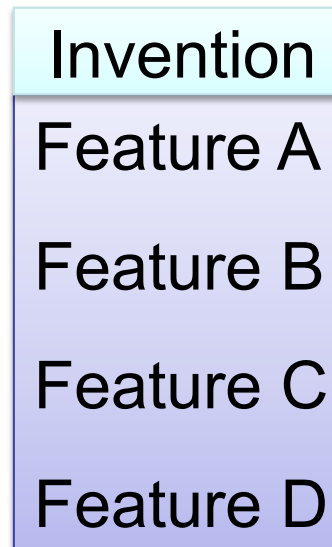
Agenda

- Claims and the scope of protection and search
 - Unity of patents
- Prior art in the presence of priorities
- Validity of priorities

What is a patent ?

- A patent is an exclusive right granted for an **invention**, i.e. the invention cannot be used by others for **commercial** purposes without permission of the owner
- An invention offers a **technical solution** to a **problem**

- Each invention can be defined by the **features** that are **essential** to solve the problem



Sample: Main claim & dependent claims

1. A method of producing a soya bean product, the method including the step of **exposing soya beans to an acidic aqueous solution.**

one single feature

2. A method **as claimed in Claim 1**, in which the acidic aqueous solution has a pH of between about 2,0 and 5,5.
3. A method **as claimed in Claim 1 or Claim 2**, in which the soya beans are whole beans.
4. A method **as claimed in any one of the preceding claims**, which includes the prior step of dissolving an organic acid in water to produce the aqueous acidic solution.

Claims 2-4 are dependent claims since they refer to claim 1.

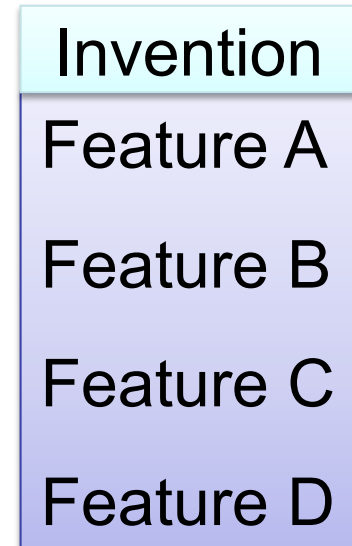
WO2005055733

Types of claims

- **Main claim (1st independent claim):**

Includes **all** the features/elements of the invention which are **essential** to solve the problem, and **only** those features!

“1. Apparatus/process with {feature A}, {feature B}, {feature C}, {feature D}.”



- **Dependent claims:**

additional, e.g. advantageous features

- **Further independent claims:**

alternative similar solutions for **same problem** (**unity of invention!**)

Rule 415 (b)

Claim sample – two part claim

Introducing part (category, purpose)

1. A method of determining the torque induced in a rotating shaft (51),
 - A the shaft (51) having a torsional oscillation frequency that is dependent on the stiffness of the shaft (51),
 - B where the torsional oscillation frequency and the stiffness are dependent upon the operating conditions of the shaft (51),

characterized in that

generic expression

- C the torsional oscillation frequency of the rotating shaft (51) is measured (35);
- D the twist induced in the rotating shaft (51) by the torque is measured (39); and
- E the measured value of the torsional oscillation frequency and the measured value of the induced twist are used (41) to determine the torque induced in the shaft (51).

Sequence of 5 features A – E (added)

EP 2006651 A2

Types of claims

- One part claim:

includes just list of essential features

“1. Apparatus {with,where} A,B,C,D”

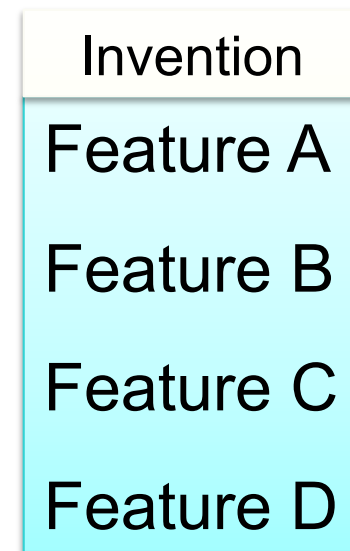
- Two part claim:

“1. Apparatus with A and B,
characterized in that C and D”

> first part (preamble) describes closest prior art

> second part describes difference(s) between invention and closest prior art:

special technical features



Rule 415 (e); Rule 416 (a),(b)

Unity of patents

Rule 604 (a)

- Unity of patents: Claiming of several distinct inventions in one application is not admissible, i.e. solutions to distinct problems
- Applicants should not get protection for 2 inventions while paying only one fee!
- However, several independent claims may define related inventive subject matter, e.g.
 - a product if 1st claim is process, or vice versa
 - a specially adapted apparatus to carry out the process
- Unity is given as long as inventive subject matters are linked to **same inventive concept**, i.e. variations of solution of same problem

Rule 605 (c), (d)

Unity of patents

Rule 604. *Unity of Invention.* –

PCT

- (a) The application shall relate to one invention only or to a group of inventions forming a single general inventive concept (Sec. 38.1, IP Code).
- (b) If **several independent inventions** which do not form a single general inventive concept **are claimed** in one application, the Director may require that the application be **restricted** to a single invention. (by election of claims, or mandatory division)
- Unity is usually **checked only with respect to claimed subject matter**, i.e. either several independent claims, or
- If independent (main) claim includes two distinct claimed subject matters, e.g. when certain features are presented as alternatives, i.e. 'A' or 'B'

Rule 605 (b)

PCT Rule 13.3; EPC Rule 42(2)

Unity of patents

- Lack of unity may
 - be directly evident '**a priori**' (obvious lack of unity, prior to search; formality examination)
 - Become apparent only in comparisons to prior art '**a posteriori**' (i.e. after search, during substantive examination)
- Unity is given 'when there is a technical relationship among the claimed inventions involving one or more of the same or corresponding special technical features'

Rule 605 (a)

PCT Rule 13.2; EPC Rule 44(1)

- Lack of unity: solvable by divisional application, or withdrawal of claims (election of claims to be examined)
- Disclosure as such may (intentionally) comprise several inventions

Unity of patents – generic example

(Academic) Example from PCT Examination Guidelines 10.03

- Three independent claims:
 - Claim 1: A + X
 - Claim 2: A + Y
 - Claim 3: X + Y
- 'A priori' lack of unity because claim 3 has nothing in common with claims 1 and 2
- 'A posteriori' lack of unity if search reveals that feature A which is common to Claims 1 and 2 is known; then X and Y would be special technical features describing the difference to the known prior art A, however they are distinct and have nothing in common
- See further examples and discussion in the PCT Examination Guidelines

Admissible claim amendments

Applicant may usually amend claims anytime during examination, e.g. if originally filed claims are not patentable:

- Inclusion of additional features taken from description or other claims
- Replacement of features
- Completely reworded claims

Section 49; Rule 916, 920

- All features have to be **supported by the original description**
- Features from drawings not supported by the description are not permitted, i.e. they have to be mentioned explicitly in description
- Examiner to check whether amended claims are within initial disclosure

Evolution of claims

- Claims related to a patent application are usually different at different publication and prosecution stages
- Independent claims in applications before examination have a broader scope because applicants seek to get as much protection as possible.
- Claims of granted patents are, in comparison to the initially filed claims,
 - Usually narrower, i.e. include additional features
 - May be totally different
- Claims after opposition have often narrower scope than claims after grant

Claim sample – as filed

Introducing part (category, purpose)

1. A method of determining the torque induced in a rotating shaft (51),
 - A the shaft (51) having a torsional oscillation frequency that is dependent on the stiffness of the shaft (51),
 - B where the torsional oscillation frequency and the stiffness are dependent upon the operating conditions of the shaft (51),

characterized in that

generic expression

- C the torsional oscillation frequency of the rotating shaft (51) is measured (35);
- D the twist induced in the rotating shaft (51) by the torque is measured (39); and
- E the measured value of the torsional oscillation frequency and the measured value of the induced twist are used (41) to determine the torque induced in the shaft (51).

Sequence of 5 features A – E (added)

EP 2006651 A2

Claim sample – as granted

1. A method of determining the torque induced in a rotating shaft (51),
A the shaft (51) having a torsional oscillation frequency that is dependent on the stiffness of the shaft (51),
B where the torsional oscillation frequency and the stiffness are dependent upon the operating conditions of the shaft (51),

the method comprising:

- C** measuring (35) the torsional oscillation frequency of the rotating shaft (51);
- D** measuring (39) the twist induced in the rotating shaft (51) by the torque; and
- E** using (41) the measured value of the torsional oscillation frequency and the measured value of the induced twist to determine the torque induced in the shaft (51);

F the torsional oscillation frequency of the shaft (51) and the induced twist are measured (35) at the second set of operating conditions;

the method is **characterized by**

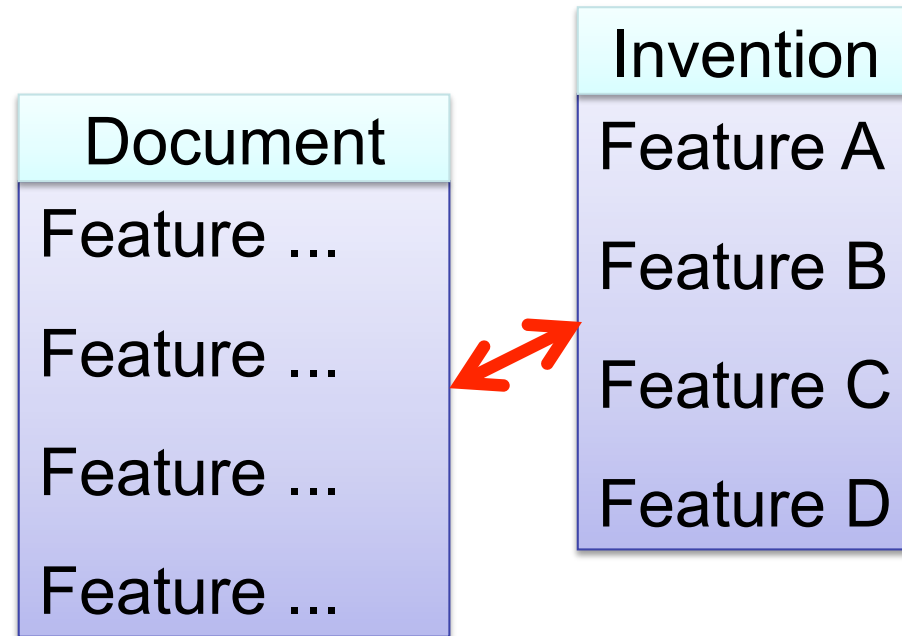
- G** determining the torsional oscillation frequency of the shaft (51) at a second set of operating conditions at which the stiffness of the shaft (51) can be determined (33) and
- H** determining the stiffness of the shaft (51) at the second set of operating conditions;
- I** the torque induced in the shaft (51) at the first set of operating conditions is determined (41) using the measured torsional oscillation frequency and the induced twist at the first set of operating conditions, and the measured torsional oscillation frequency and the stiffness at the second set of operating conditions

Added during examination

Deconstruction of claim wording

- Deconstruction of claim wording, i.e. structuring/sorting the subject matter of a claim into distinct features/elements facilitates:
 - Understanding of the subject matter
 - Checking the clarity of the claim wording
 - Searching of prior art
 - Assessing of novelty by comparing the distinct features with the prior art
 - Determination of the closest prior art
 - (Determination of the difference to the closest prior art)
 - Comparison of claims subject to examination at different IPOs (claims of different members of the patent family)

Novelty



- Subject matter described in a claim is not novel if

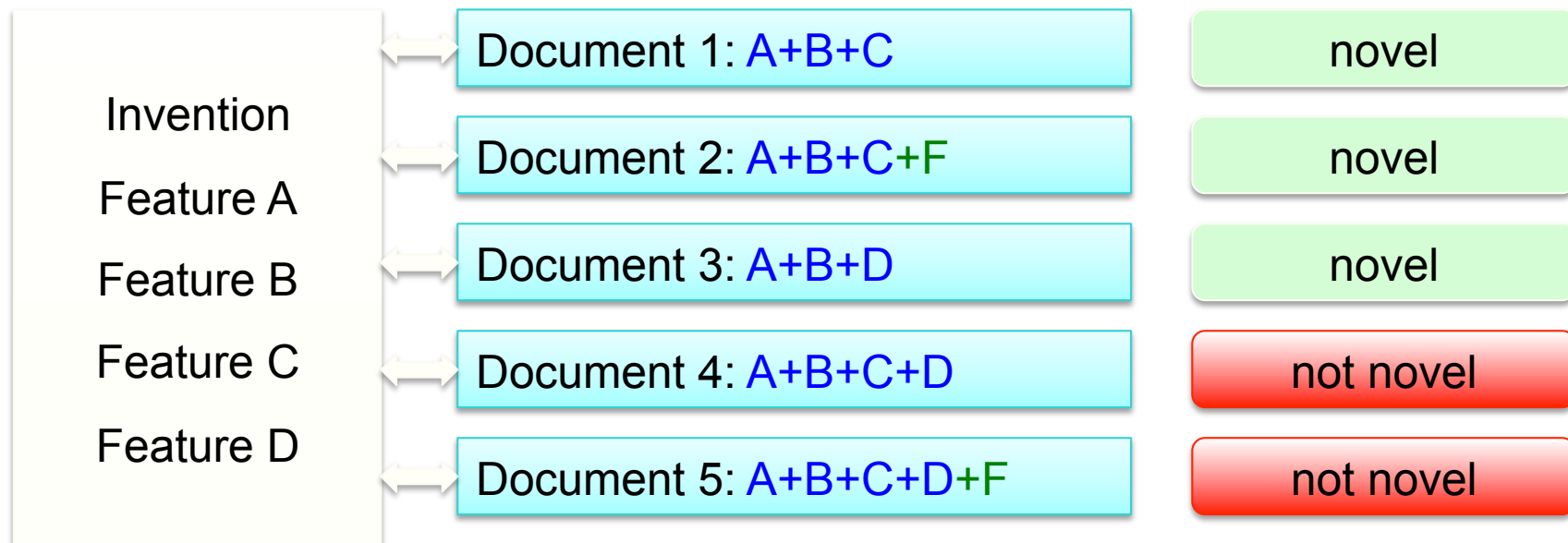
all features are known

from a **single** piece of **prior art**, e.g. another patent

Rule 204.1

Checking novelty

- ▶ Compare claimed inventive subject matter (e.g. claim 1) **individually** with all researched prior art



Prior Art

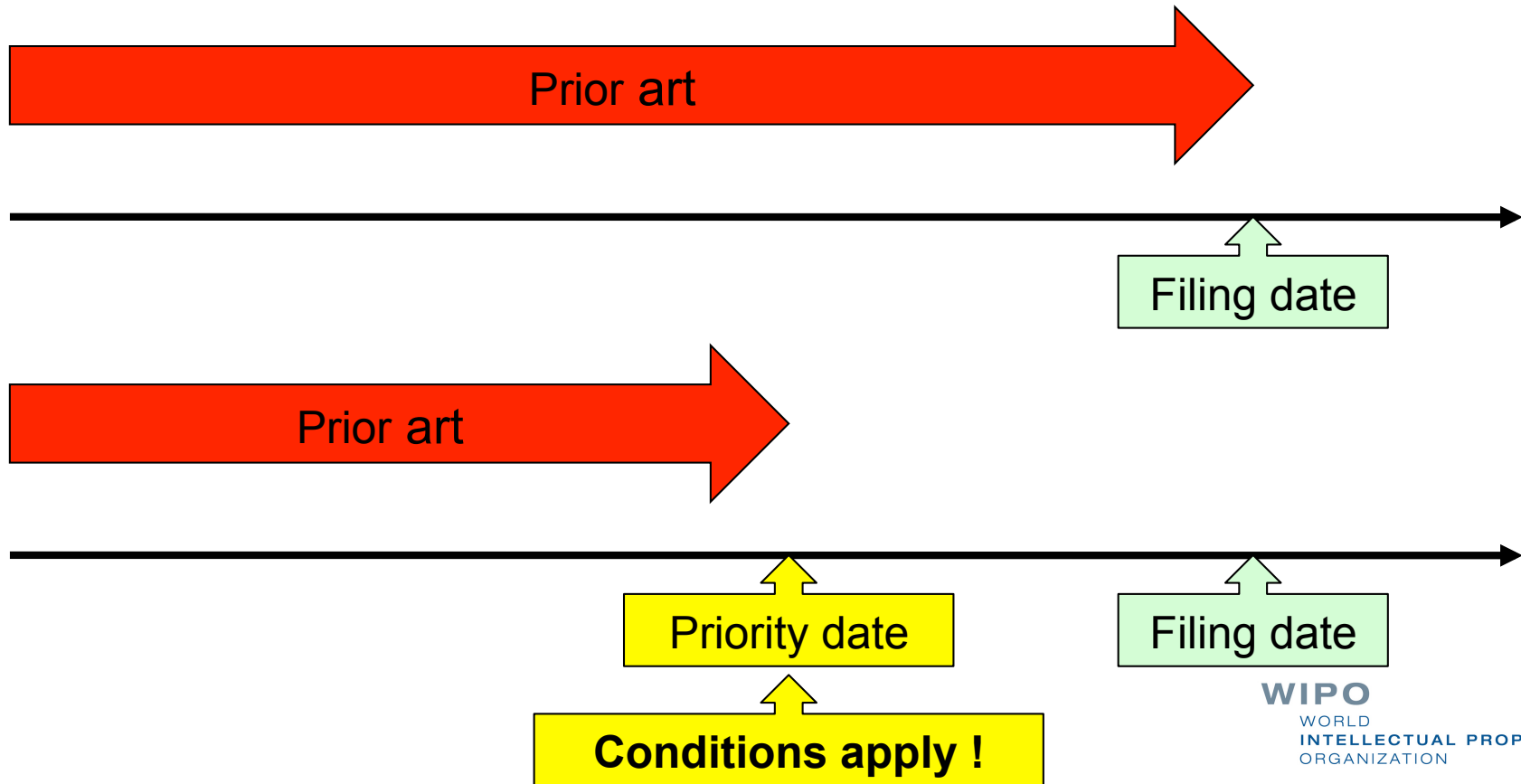
Rule 204. *Prior Art.* – Prior art shall consist of:

(a) Everything made available to the public anywhere in the world by means of a written or oral disclosure, by use, or in any other way, **before the filing date or the priority date** of the application claiming the invention. Information is deemed available to the public when it is not confidential or restricted to the use by a selective group. ..

Prior art

Rule 204 (a)

- Any information that is made **available to the public** until the application date or the priority date (provided priority is acknowledged)



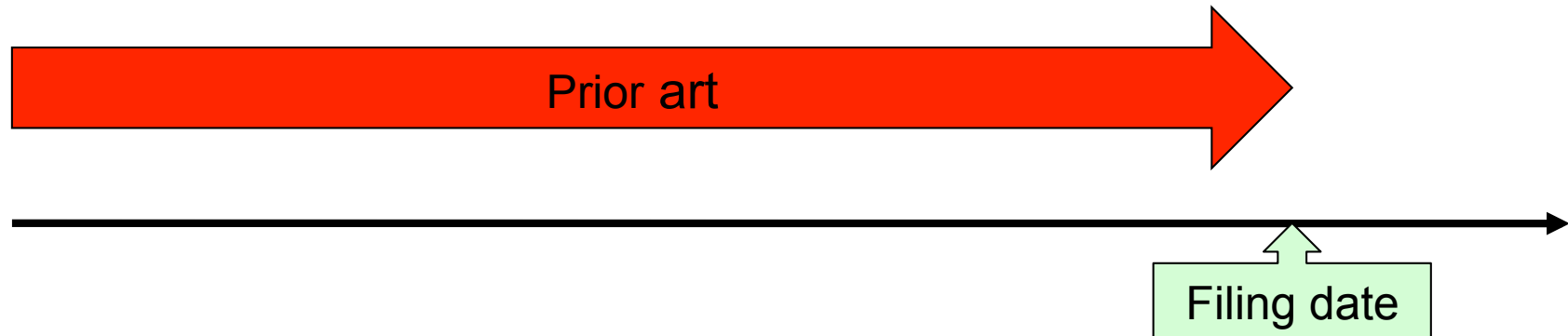
Prior art – grace period

- Many legislations grant to the inventor and applicant a grace period of, e.g., 12 months prior to filing/priority date for disclosures of her/his invention, e.g. scientific publications, presentations at conferences, fairs,
- I.e. after the disclosure, she/he has 12 months time to file for a patent
- Does not apply to publications of earlier filed applications of same invention, e.g. by Office of First Filing

Section 25; Rule 205

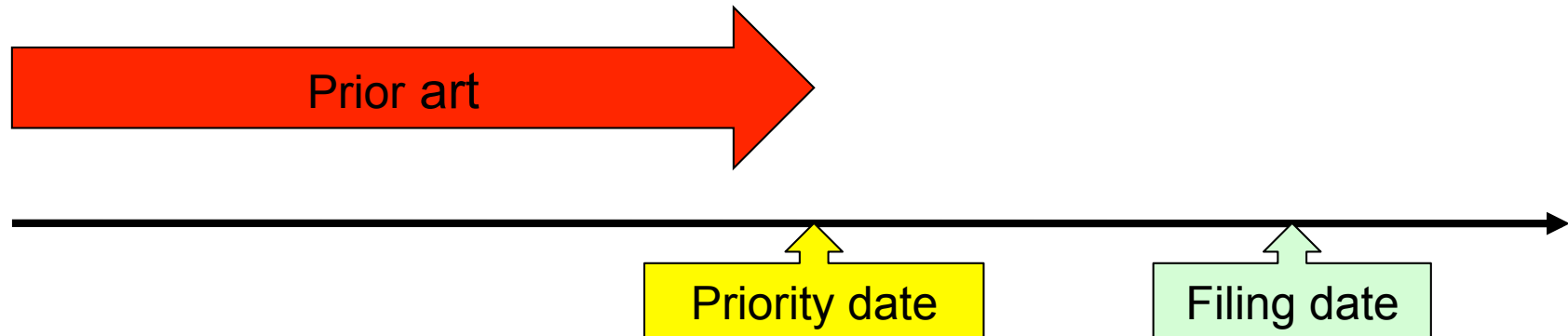
Example: difficulty with multiple priorities

- No priority, OFF



Example: difficulty with multiple priorities

- Single priority



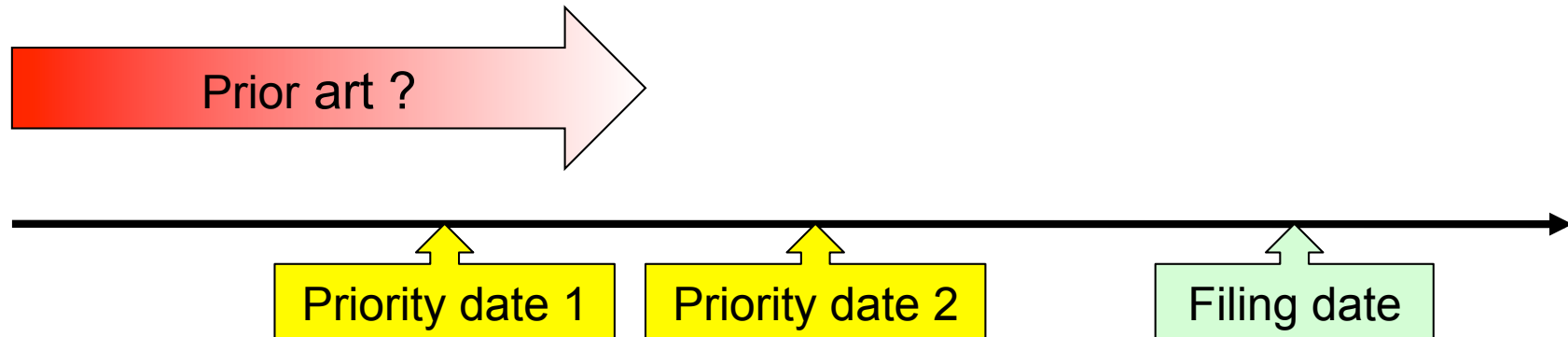
Example: difficulty with multiple priorities

Rule 306. Multiple Priorities. – An application can claim **more than one priority even from different countries**. If more than one (1) priority is claimed, time limits computed from the priority date will be based upon the earliest priority date; Provided, that the local application and the priority applications have common inventor(s) or applicant(s).

<> Art. 4 F Paris Convention

Example: difficulty with multiple priorities

- Different priority dates > different prior art



Conditions

Conditions for claiming priority date

Section 31

- Application filed within 12 months after **first** filing (Art. 4 C (1))
 - Explicit statement for claiming priority of earlier filing
 - Time limits for claiming priority
 - Usually to be claimed with filing
 - Sometimes grace period
- Rule 306.3: 2 months
- **Certified copy of first filing** (+ translation)
 - Paris Convention: no explicit conditions apply for
 - Inventor and applicant names
 - **Additions of subject matter (are permitted)**

Conditions

- **Why certified copy? What if additions of subject matter?**
 - Some priority applications are never published, e.g. withdrawn before they are published
 - May be needed to confirm that claimed priority is indeed the first filing
 - Needed for comparison of disclosure of priority application and of application claiming the priority
- There are further **conditions for acknowledging validity of priority date for examination**, i.e. whether priority date determines relevant prior art:
 - All technical features of a claimed subject matter need to be disclosed in priority document

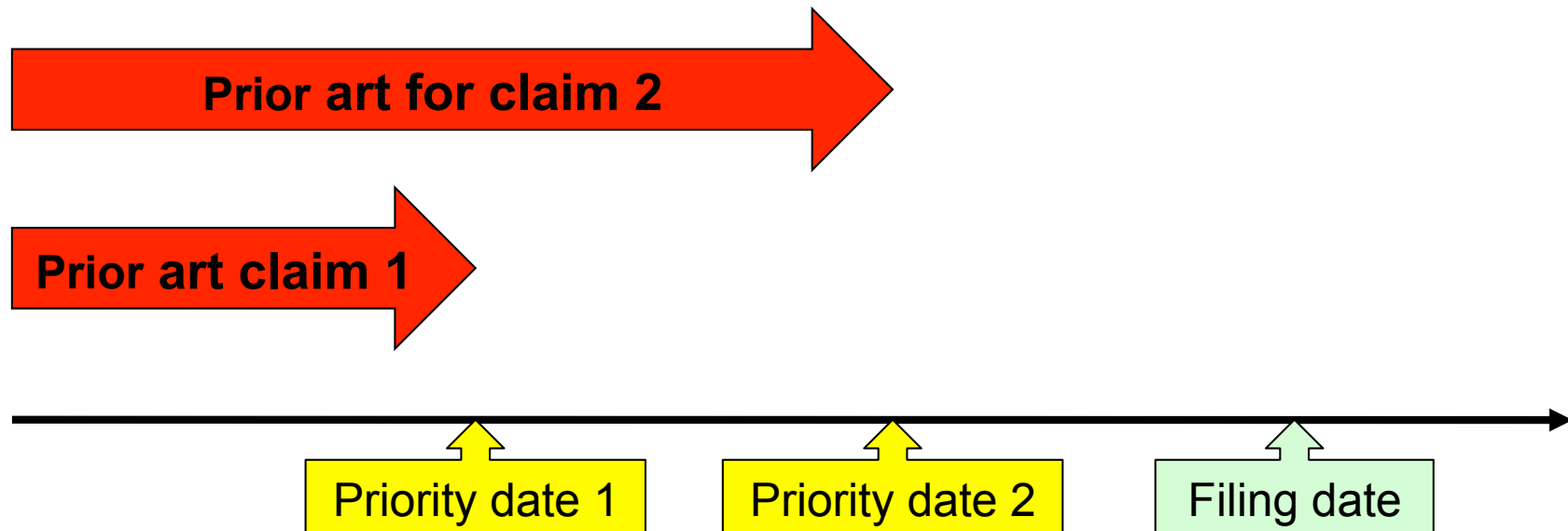
Conditions for claiming priorities

Rule 306.1. If one or more priorities are claimed, the **right of priority shall cover only those technical feature or features of the invention which are included in the application or applications whose priority is claimed.**

Rule 306.2. If the technical feature or features of the invention for which priority is claimed does not appear among the claims formulated in the previous application, priority may nonetheless be granted; provided, that the previous **application as a whole specifically discloses such technical feature or features.**

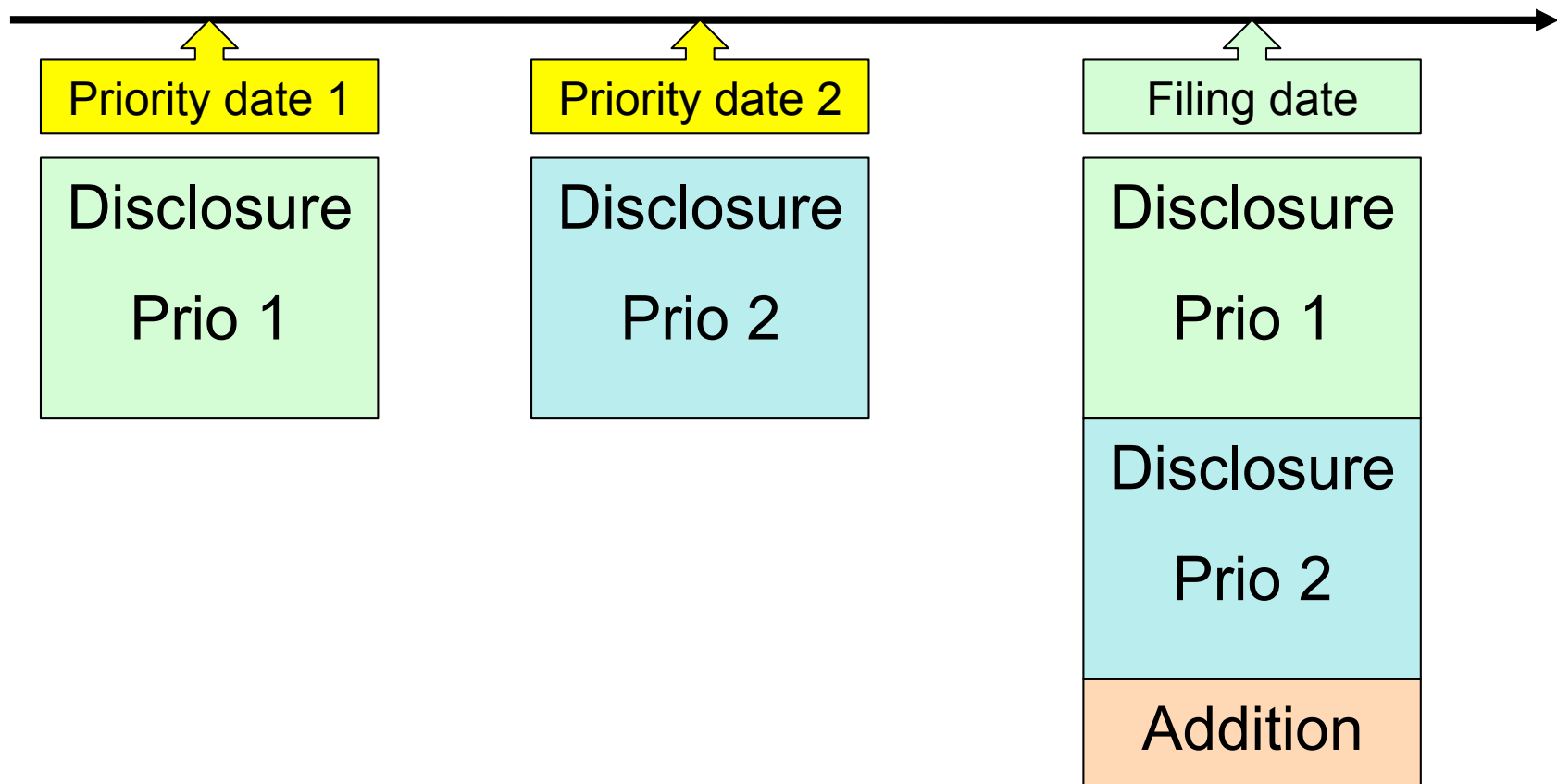
Difficulties with multiple priorities

- For each claim check which claimed subject matter is disclosed in which priority
- If claimed matter derives from different priority documents, different respective priority dates apply for determination of prior art



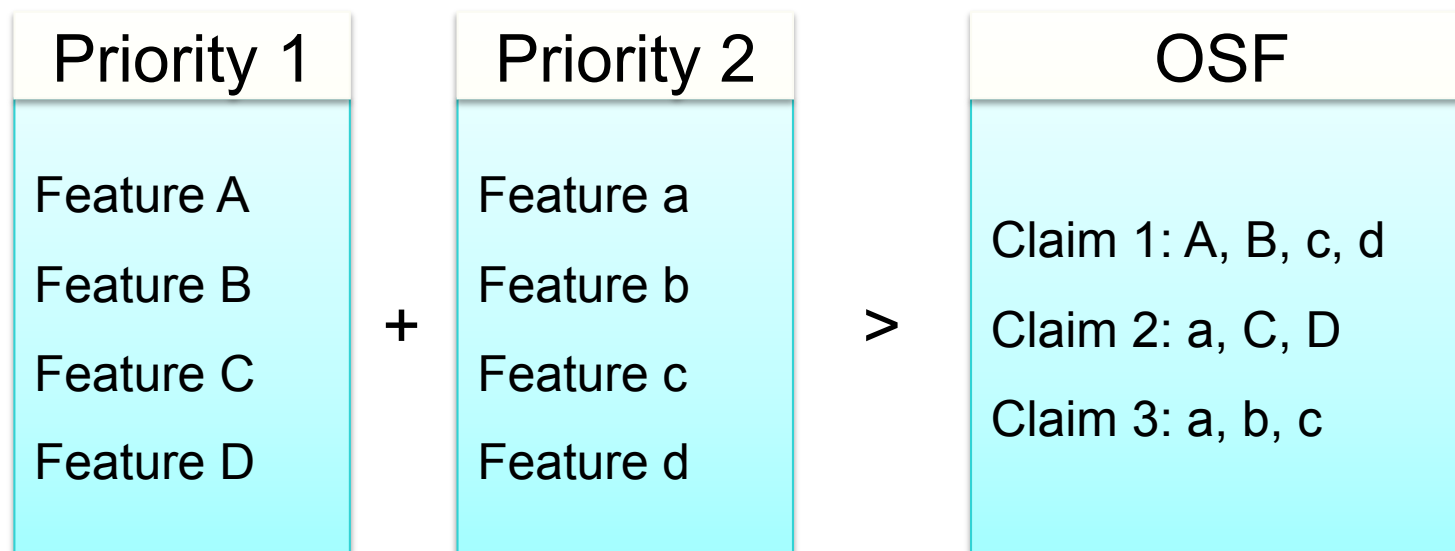
Multiple priorities

- Application claiming two different priorities



Difficulties with multiple priorities

- Combining different priority documents implies combination of different technical features



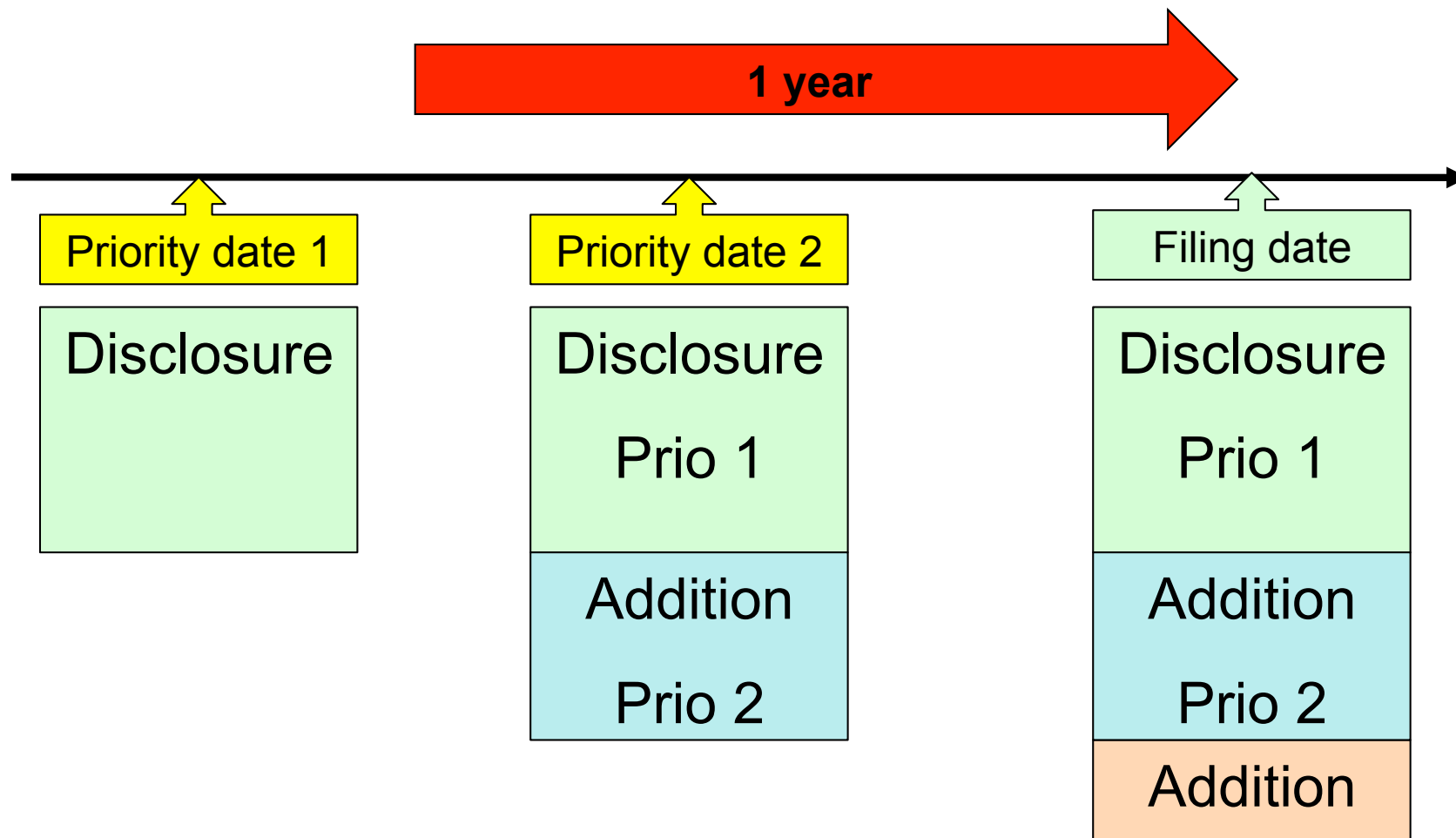
Rule of thumb

- If the claimed subject matter is **fully disclosed in the priority document**, then the priority date determines the relevant prior art,
 - Provided the claimed priority document is indeed the first filing of the claimed subject matter.
- If the claimed subject matter is **not** fully disclosed in the priority document, the filing date determines the relevant prior art
- This rule is applied claim by claim

Checking if claimed priority is first filing

- If claimed priority itself claimed a priority:
 - Priority is valid if the still earlier priority was never published, is withdrawn, abandoned, refused, and no rights are alive anymore,
 - Else, priority is valid for additions of art in priority document, i.e. only for features not yet disclosed in the priority of the priority (Paris Convention Art. 4 F)
- EPO does not acknowledge US continuations and continuations in part (except for additions) as first filings (EPC Examination Guidelines F VI 1.4)

Priorities and additions of subject matter

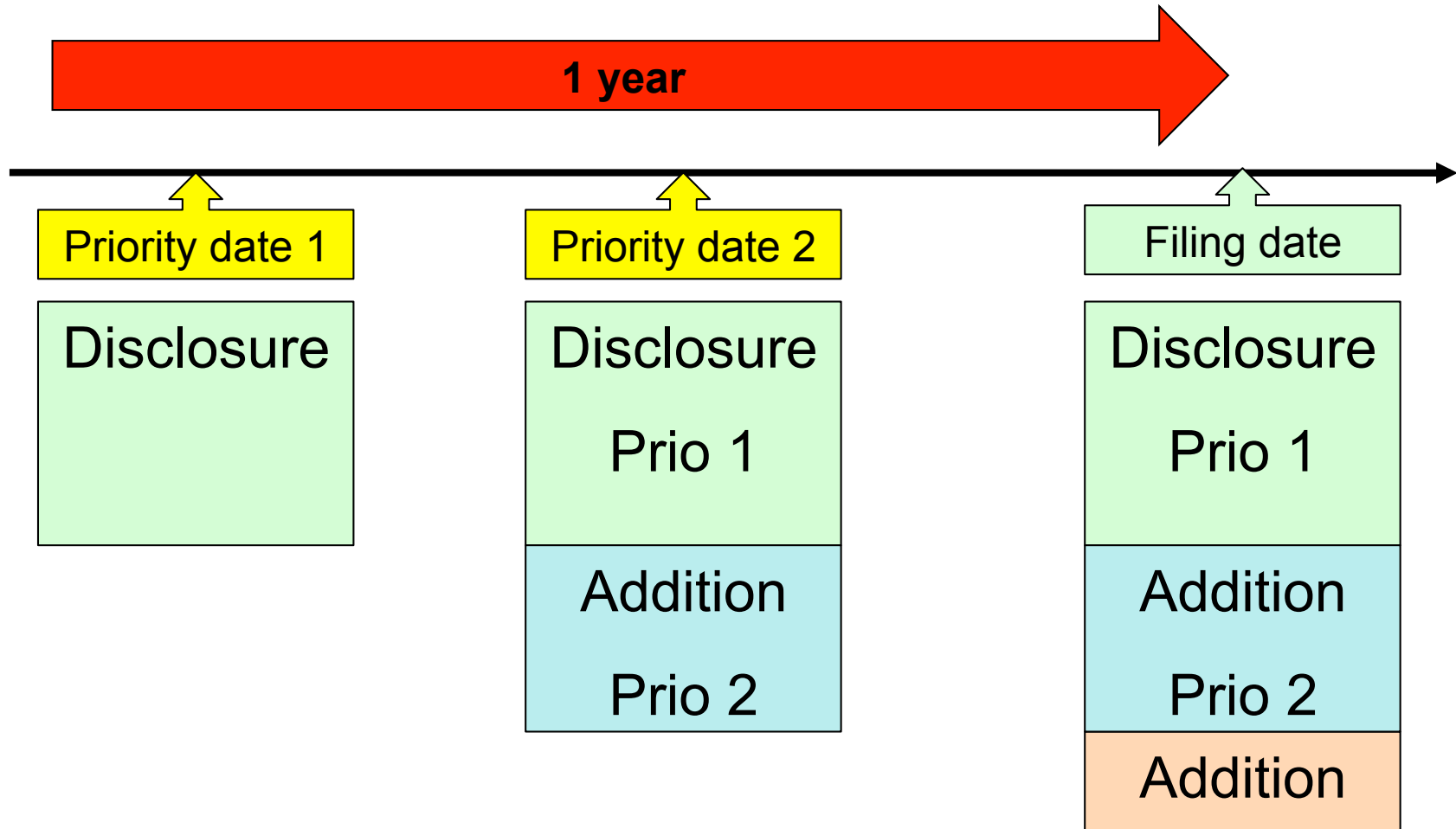


Exercise

What are the relevant dates for the determination of prior art if

- the application claims priority 1 and 2, or
- the application claims priority 2 which claims priority 1

Priorities and additions of subject matter



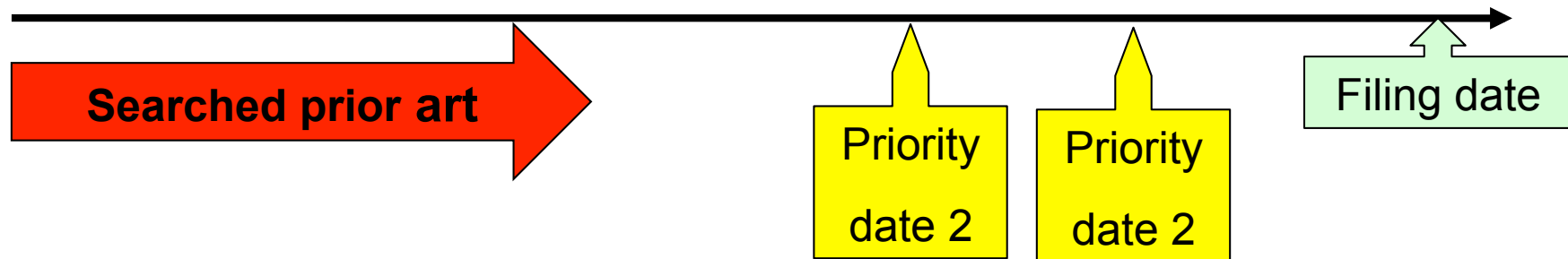
Exercise

What are the relevant dates for the determination of prior art if

- (i) the application claims priority 1 and 2, or
- (ii) the application claims only priority 2 which claims priority 1

Prior art and priorities

- When all relevant prior art documents are before the earliest priority date one need not worry about priorities even if there are several



Thank you

lutz.mailander@wipo.int