



Claim Drafting Seminar

Claim Function and Form

Karin Pramberger

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Claim Function And Form

1. Function

2. Form

- one part/two part
- dependent and independent claims
- types of claims
- first and second medical use
- disclaimer
- Interpretation of claims
 - Rule 29 and Guidelines : C-III



Function of a Claim

Art. 84 EPC

"The claims shall define the matter for which protection is sought. They shall be clear, concise and be supported by the description."

Art. 69(1) EPC

"The extent of the protection conferred by a European patent or a European patent application shall be determined by the terms of the claims. Nevertheless, the description and drawings shall be used to interpret the claims." (see also Protocol to Art. 69)"

3



Form of a Claim

Rule 29(1)

"The claims shall define the matter for which protection is sought in terms of the technical features of the invention."

- Guidelines: C-III, 2.1.

4



One part / two part form - Rule 29(1)b

- **One part** : "Mixture comprising A and B."
- **Two part** : "Pharmaceutical formulation comprising A as active ingredient, characterized in that it further comprises B."
 - prior art features - "characterized in that" - features defining the invention.

In both cases: Claimed invention comprises all features of the claim!

- Guidelines : C-III, 2.2.

5



Independent Claims

- Does not refer to any other claim
- One per category (product, process, use, etc.)
- More than one per category if a)
 - a) interrelated products (e.g. transmitter - receiver)
 - b) different uses of a product
 - c) alternative solutions to a problem (e.g. group of chemical compounds, alternative processes to produce such compounds)

6



Dependent Claim

Claim 4 : "Mixture according to any one of claims 1 to 3, further comprising"

- can refer to one or more dependent and/or independent claims
- further limitations compared to above claim(s)
- preferred embodiments - "fall-back positions"
- ALL features of claims 1 or 2 or 3 are included into claims 4

- Rule, 29(4), Guidelines : C-III, 3

7



Types of claims - categories

- **Product** (compound, combination, pharmaceutical formulation, gene, protein, etc.)
- **Apparatus**
- **Process** (method for producing sth, for identifying sth, etc.)
- **Use** (of a product for carrying out sth) - equivalent to a process claim

8



First medical use claim I

- Art. 52(4) EPC excludes methods for treatment (surgery, therapy, diagnostic method) of the human or animal body.



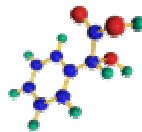
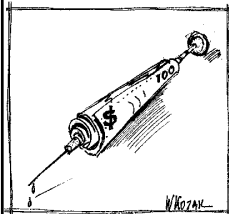
9



First medical use claim II

BUT: not excluded are : products, in particular substances or compositions for use in these methods (Art. 52(4) EPC)

Art. 54(5) EPC states that a known substance or composition for use in a new method of treatment is patentable.



10



First medical use claim III

- "Treatment of X by administering substance Y"
(not allowable under Art. 52(4))
- "Substance Y for use as a medicament" or
■ "Substance Y for curing disease X"
(allowable under Art. 54(5))
 - This is an exception to the rule that product claim can only be obtained for new products
 - Protection is restricted to the product when presented or packaged for that use
 - kit-of-parts (T9/81)
 - Guidelines: C-IV, 4.2.

11



Second medical use or "Swiss-type" claim

Substance is known as medicament, but use in new treatment is invented

- "Use of substance X for producing a medicament for the treatment of C." or
- "Method for manufacturing a medicament intended for therapeutic application C, characterized in that the substance X is used."

■ Guidelines: C-IV, 4.2., G1/83, G5/83, G6/83

12



Disclaimer = negative feature C-III, 4.12

Claim: "Lamp, selected from the group consisting of desk lamp, floor lamp, ceiling lamp, reading lamp, fog lamp, gas lamp, control lamp, blue lamp, characterized in that..."

or

Claim : "Lamp, with the exception of a street lamp, characterized in that....."

A disclaimer expressly states that particular features are absent.

Disclaimers may only be used if adding positive features to the claim would either not define more clearly and concisely the subject matter protectable or would unduly limit the scope of the claim

13



Disclaimer II, G 1/03, G 2/03

- The disclaimer should not remove more than necessary
- If the disclaimer is or becomes relevant for the assessment of inventive step or sufficiency of disclosure, it adds subject matter contrary to Art. 123(2)
- A claim containing the disclaimer must meet the requirements of clarity and conciseness of Art. 84 EPC.

- Guidelines: C-III, 4.12
- Decisions: T 4/80, T 1050/93

14



Interpretation of Claims



15



Specific types/phrasings of Claims I

- "Apparatus for...." = "Apparatus suitable for" (not limiting)
- optional features, alternatives : not limiting!
- Markush grouping : "X selected from the group consisting of a, b, c, d, e, f, and g and any combinations thereof."
- Product-by-process claim: only if no other definition

16



Specific types/phrasings of Claims II

- Process claim: protection extends to the directly obtained product (Art. 64(2))
- use claim = process claim
- 2nd non medical use claim "Use of substance X as pesticide"
- Comprising (open) - Consisting of (limiting): "comprising A + B" = can contain A + B + C but "consisting of A + B" = contains only A + B, not C!

17



remember

- define your invention clearly and completely
- know and apply the rules of the EPO
- you will get a monopoly only for the objects you have disclosed



18