Patent Drafting Strategy

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• What is a patent?.
• How Good Must Your Invention Be.
• The Basic Patent Right
• Precautions to be taken before drafting a specification
  • Contents (kind) of patent specifications
  • Drafting the patent (description and claims).
  • Claims and their interpretation
What is an invention and what is a patent?

**Invention:** means a new product or process involving an inventive step and capable of industrial application.

- Fundamental research
- Improvement on existing art
- Solving unsolved problems of art/unaddressed issues
- Different approach

**Patent:** is a limited monopoly right conferred by the State in consideration of disclosure of the invention.

**Means:**

*Is the right to exclude others from exploiting or using the particular invention*
How Good Must Your Invention Be.

Useful

Solution/Invention

Application

Satisfaction of condition

PATENTABLE

Novel

Inventive (Surprising)
The Basic Patent Right

• Stop others from
  – Making
  – Using
  – Selling
• your invention
Exploiting Patent Rights

Exercise

License

Sell

Trade

pledge

promote
BEFORE DRAFTING

• What is the invention?
• Is invention patentable?
• Is invention novel, inventive?
• Prior art/prior disclosure?
  – Oral disclosure? Did I tell anybody about it?
  – Prior printed publication available to the public?
  – Prior public use?
  – Application entitlement: **Conflicting interests**! Employee Invention Act? Employment Contract?
BEFORE DRAFTING

VERIFY THE FOLLOWING:
Conduct search
Enlist problems in prior art
What is the problem sought to be solved by the invention?
What is the novelty?
Is the solution obvious?
Has publication ensued?
Ascertain the type of application - whether complete or provisional is to be filed
Decide the area and nature of protection - Paris convention, PCT, ordinary application.
Your patent will be Read by:

- Patent Office
- Licensee/Assignee
- Court
- Technical peers/skilled persons
- Competitors
- Commercial players
- General public
KINDS OF PATENT SPECIFICATIONS

- PROVISIONAL
- COMPLETE
A PROVISIONAL SPECIFICATION

- when there is an Urgency
- commercial disclosure
- Submission of thesis
- Inventors/Seniors leaving the company
- Accidental disclosure
- Many competitors

Provisional application: Is a document describing the invention and need not contain claims.
Disclose as much as possible.
Decides the date of the application.
Patent Specification

- Description
- Claims

- Description discusses the invention
- Claims define boundary of monopoly
What should be mentioned:

✓ Title
✓ Abstract
✓ Technical field of the invention
✓ State of the art (prior art)
✓ Disadvantages of prior art
✓ Objects of Invention (purpose)
✓ Statement of Invention
✓ Detailed description of Invention
✓ Claims
TITLE

• A concise statement providing the crux of the invention

• Care should be taken to incorporate all major aspects claimed

• Product-Process-Apparatus

Technical field of the invention

• More details than the title

• Provides utility

• Sometimes used as a tool for search in the absence of abstract
DRAFTING THE ABSTRACT

(*purpose*: the technical information presented by briefly mentioning everything analyzed in the description, the claims and the drawings. It doesn’t affect the extent of protection.)

What should be mentioned:

- The title of the invention
- The technical field to which the invention pertains
- A reference to the manner of solving the technical problem the invention deals with
- The main use or uses
- The basic chemical formula (if there is any)
State of the art (prior art)

Is a brief write-up of what is known before the invention associated with each of the known art; and describes the problem proposed to be solved by the invention; sets out the problems:

- Un-solved problems
- Prior art solution not working
- Describe new solution adequately
OBJECTS OF THE INVENTION

• Provides purpose of the invention

• Main object(s) and Ancillary object(s)

• Essential aspects and preferred/optional aspects.
DETAILED DESCRIPTION OF INVENTION

• Sets out best mode of performing the invention

• Describes the invention in greater detail with examples/illustration/tables/graphs/diagrams, etc

• Description sufficient to enable a skilled person to put the invention into practice
(purpose: they define the extent and the content of the protection on the basis of the technical features of the invention)

Is the operative part of the specification. Defines the monopoly to be conferred by the patent. Define the metes and bounds of the invention: at the time of infringement proceedings, only claims will be interpreted. If you do not claim, you disclaim.
EXAMPLE: DRAFTING THE DESCRIPTION OF INDUSTRIAL DESIGNS OR MODELS

• Describing the elements that are characteristic of the design
• It should not exceed 100 words
• Technical details relating to
  
  the operation of the object

  Or its possible uses

  or the material of its making
PRESENTATION OF GRAPHIC OR PHOTOGRAPHIC REPRESENTATIONS OF INDUSTRIAL DESIGNS OR MODELS

- Color or black and white photos or graphic representations

  ✓ should present clearly the object only, without shadings
  ✓ other objects, persons or animals are not allowed to be depicted next to the object
  ✓ the object should be depicted at least once in a position of usual use
  ✓ the dimensions of the photographs or the graphic representations should not exceed 16 x 16 cm
It is not allowed:

✓ To use words or texts or typical phrases or company names or marks on the object

✓ Photographs are not accepted when:
  - they are instant film
  - they are photocopies
Somebody invented a pencil with an eraser and a light attached to it. A claim may read as follows:

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

Closed phrases, such as “consisting of,” limit the claim to nothing more than the specifically-recited elements. The claim covers only the elements named and nothing more.

A pencil having an eraser, wherein the improvement comprises a light attached to the pencil.
Example 2. A patent applicant has invented a rice cooker. Since an object of this invention is to cook rice, the preamble and title might reads as follows: 

*An apparatus for cooking rice.*

But suppose that the patent applicant knows his invention could be used for cooking all kinds of grains, a broader preamble might read: 

*An apparatus for cooking grains.*

Suppose further that the patent applicant knows his invention could be used for cooking vegetables, or even melting cheese for fondue, an even broader preamble might simply read: 

*An apparatus for cooking.*
Example 3. An apparatus for turning lead into gold, comprising:
an electric motor;
a bowl for retaining scrap lead; and
a lead-gold zapper element operably coupled to the bowl and configured to receive electric power from the electric motor

Should still try to make it as broad as possible in order to fully capture the invention.

An apparatus for turning lead into gold, comprising:
a power source;
a bowl for retaining scrap lead; and
a lead-gold zapper element operably coupled to the bowl and configured to receive power from the power source.
The provability test

✓ Check for every claim feature:
✓ Can realization of feature be proven (easily)?
✓ Can the feature be replaced by another one with easier provability (e.g. indication of the structure instead of the generating method)?

✓ Check meaning of apparently clear words (e.g. „solvent“ or „attachment“)
✓ If required, define term yourself (German Federal Supreme Court: every patent application is its own dictionary)
✓ Beware of finite definitions such as „consisting of“. Better use open wording such as „comprising“ or „including“

✓ In case of basic inventions, indication of function may be the only possibility to lead to appropriate scope of protection.
✓ If the claim only indicates the targeted aim, the claim becomes unclear
✓ and may be far too broad;
✓ Choose the middle: Combination of structural and functional features
Title: Soap -dispenser with authentification check of the refill

Dettol patent.doc
Thank you for your attention