

QUESTION 89 B

Drafting of patent claims

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Report of the Working Committee of AIPPI

The Committee first considered whether harmonization was desirable. It agreed that it was; there would be advantage both to the applicant/patentee and to third parties if there was greater uniformity in this respect. There would be particular advantages to PCT applicants, whose international application would have easier transition into and more equal effect in national or regional phases.

The Committee felt, however, that harmonization in the manner of drafting claims is only a minor step if there is not harmonization of interpretation of the claims once drafted (see the Resolution of AIPPI on Question 60 - Annuaire 1981, page 144).

Another precondition is that harmonization shall mean acceptance of agreed standards or rules; it is not merely a liberalization, which accepts a greater variety of different manners of proceeding.

The Committee noted that it was not studying some of the questions which are considered as a rule by any draftsman before he starts to draft claims; notably

- a) the effect of legal provisions on amendments on what is the permissible or desirable manner of drafting claims
- b) what would constitute a "claim" for purely formal purposes and
- c) the relationship between claims and description (see the Resolution of AIPPI on Question 69 - Annuaire 1978/II, page 158).

The Committee considered therefore that it was dealing with the manner of claiming which should be allowed by Patent Offices and recognised by the Courts. It noted, in this

latter respect, that a problem might arise in countries where no examination occurs and an applicant (who may not have been professionally assisted) may have obtained claims not in proper form.

The Committee firmly enunciated the following principles:

A) Subject to the requirements of substantive law, the applicant should be free to claim what he wishes to claim. In particular, it is not the function of a Patent Office to dictate the form or wording of a claim.

B) The object of the manner of drafting of claims shall be claims of the maximum clarity and conciseness.

Bearing these things in mind, the Committee studied the "Principles of a Solution" outlined in the WIPO Paper HL/CE/II/3, Paragraph 143. It comments on the subparagraphs in turn as follows:

Subparagraph (1)(a)

i. There is no justification to require the presence of claim(s) as a minimum requirement for receiving a filing date. It would be acceptable to say:

"A patent application shall, for the purposes of examination, contain one or more claims."

(The Committee noted that the question of presence of claims for establishing a filing date was within the ambit of the Working Committee on Question 89A.)

ii. The Committee took the opportunity of emphasising that "description" in the last line of (1)(a) comprises "everything in the original documents of that application".

Subparagraph (1)(c)

The concept of unity should be defined, and for this purpose the Committee suggested adoption of the wording of Rule 13 PCT. This subparagraph would be clearer if the last line reads: "claim. Additionally, it may contain two or more independent claims of different categories."

Subparagraph (1)(e)

The Committee was worried that "technical features" might be considered as excluding the possibility of functionality in claiming. Phrasing such as "technical, including functional features" might be preferable. The guidelines to PCT at III (2.1) were considered as an acceptable explanation on the wording by the Committee.

Subparagraph (2)(a)

i. The Committee considered that in some cases the divided claim tends to be artificial and even misleading even though in respect of some inventions the divided form may be entirely appropriate and desirable.

ii. The Committee resolved that there should be no bias in favour of any particular format of claim.

iii. In particular, there need not be a distinction within a claim between new and known features unless such a distinction would be appropriate for the purpose of making the claim more easily understood. The burden of proof should be on the Patent Office.

iv. The Committee therefore felt that paragraph 2 needs to contain only the specific prohibitions of subparagraph (b).

Subparagraph(2)(c)

The Committee noted that reference to drawings was permitted in exceptional cases by subparagraph (2)(b). It felt that subparagraph (2)(c) was redundant and should be removed.

Subparagraph (2)(d)

The Committee felt, following its principle "A", that this subparagraph should read: "If reference signs are included in the claims, following the feature to which they relate, they should not be construed as limiting the claim".

Subparagraph (3)(b)

There seems to be no reason why claims should not be dependent on more than one independent claim, even of different categories. Accordingly, "either" should be replaced with the words "one or more".

Subparagraph (3)(c)

The Committee noted that "refers" should be taken to be an intention to incorporate appropriate features: a claim of the form "Apparatus for performing a method as claimed in claim X..." is not a dependent claim: the apparatus is not referred to the previous claim.

Subparagraph (3)(e)

The Committee felt this was unclearly expressed; this should state that a dependent claim is not objectionable merely because it does or does not claim subject matter which might have been an independent invention. This is subject always to the requirement for conciseness in the claims, which will prevent trivial dependent claims.

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