

P O N S

PATENTES  
Y MARCAS

# Patents

## PONS Patentes y Marcas



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## *Drafting the scope:*

- The first step towards drafting a patent specification is defining the scope of the invention
  - We must first consider what is it that we desired to get a patent for on the basis of that already made and tested.
  - We must check for the closeness of the prior art, good patentability studies are crucial in defining the scope of an invention.
- The scope of protection varies from one field to another (pharmaceutical products versus dyestuff)
- It is important to define a scope which has a certain distance from the prior art and which will be much more defensible against obviousness attacks.

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## *The structure of the Patent Specification:*

- Background of the Invention: Particularly relevant if the essence of the invention is the solution of an existing problem
- Brief Description of the Invention
- Description of the figures
- Description of the invention: Examples
- Claims
- Drawings
- Sequence Listing

I personally prefer to draft the full set of claims first and then the rest of the patent specification.

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## *Background of the Invention and Prior Art :*

A discussion of the prior art in the specification is considered desirable by the US Patent Office and by the EPO, however:

At the time of filing, the closest prior art is not always known, and an elaborate discussion of less relevant prior art serves no useful purpose.

The emphasis of the invention may change or it may be realized only some years after filing what the invention really is.

An extensive discussion of the prior art significantly adds to the length of the text and thus to the translation and other costs on foreign filing.

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## *Support in description under EPC*

General remarks:

The claims must be supported by the description. There must be basis in the description for the subject matter of every claim and that the scope of the claims must not be broader than is justified by the extend of the description and drawings and also the contribution to the art.

Extend of generalisation

Most claims are generalizations from one or more particular examples. A fair statement of claim is one which is not so broad that it goes beyond the invention nor yet so narrow as to deprive the applicant of a just reward for the disclosure of the invention.

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## *Support in description under EPC*

### Objection of lack of support

A claim should be regarded as supported by the description unless there are well founded reasons for believing that the skilled person would be enable, on the basis of the information given in application as filed, to extend the particular teaching of the description to the whole of the field claimed, support must be of a technical character.

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## *US sufficiency requirements*

Sufficient disclosure is particularly strict in the USA

The US requirements regarding what constitutes a sufficient disclosure can be considered separately as:

1. Description: Each claim should be fairly based on the disclosure. In the USA the original disclosure must contain a full disclosure of preferred subscopes to which it may be necessary to limit. The word preferably tends to become rather overworked in US chemical patent specifications.
2. How to make: The specification must enable the skilled reader to make the invention which is claimed.
3. How to use: Utility can never be inferred for a pharmaceutical product and must always be stated.
4. Best mode

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## *Special requirements for biotech inventions*

### Biological material

Under EPC, if an invention involves the use of or concerns biological material which is not available to the public and which cannot be described in the European application in such a manner as to enable the invention to be carried out by a person skilled in the art then the conditions set out in Rule 28(1) must be met.

Public availability of biological material is key in these cases

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## *Special requirements for biotech inventions*

1. Microbiological inventions: A sample of the micro-organism must be deposited, normally according to the provisions of the Budapest Treaty. Mention must be put in the specification itself referring to the deposition and giving the accession number. The deposit in the EPO must be made at the time of filing and the information about the deposit, with accession number, must be given to the EPO before preparations for publications are complete.
2. Inventions involving DNA sequences: A listing of these sequences in standard format must be supply. These sequence identifiers are printed separately at the end of the application. Standard sequence identifiers must be given whether the sequences are actually claimed or are merely mention in the description. The industrial application of a sequence or a partial sequence of a gene must be disclosed in the patent application.

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## *Drafting the claims :*

The application must contain one or more claims which must:

Define the matter for which protection is sought

Be clear and concise

Be supported by the description

Since the extend of the protection conferred by a European patent or application is determined by the terms of the claims, clarity of claim is of the utmost importance.

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## *Drafting the claims :*

The claims must be drafted in terms of the technical features of the invention. This means that claims should not contain any statements relating to non-technical matters, however statements of purpose should be allowed if they assist in defining the invention.

## *Kinds of claims*

In fact there are only two basic kinds of claims

Claims to a physical entity (product, apparatus)

Claims to an activity (process, use)

## *Drafting the claims :*

- Number of independent claims: According to Rule 29(2) EPC, the number of independent claims is limited to one independent claim in each category (product, process, use)
- However there are exceptions to this rule if:
  - It involves a plurality of inter-related products (Gene – gene construct – host – protein – medicament)
  - Different uses of a product or apparatus (second medical use claims)
  - Alternative solutions to a particular problem, where it is not appropriate to cover these alternatives by a single claim

## *Drafting the claims :*

Independent and dependent claims:

- All applications shall contain one or more independent claims directed to the essential features of the invention
- Any such independent claim may be followed by one or more claims concerning particular embodiments of that invention.
- Any claim relating to a particular embodiment must effectively include also the essential features of the invention, and hence must include all the features of at least one independent claim.
- Any claim which includes all the features of any other claim is termed a dependent claim. Such claim must contain a reference to the other claim.
- A dependent claim may refer back to one or more independent claims, to one or more dependent claims or to both.

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## *Drafting the claims :*

### Arrangement of claims:

All dependent claims referring back to a single previous claim and those referring back to several previous claims must be grouped together.

The arrangement must be one which enables the association of related claims to be readily determined and their meaning in association to be readily construed.

### Alternatives in a claim:

A claim may refer to alternatives, provided that the number and presentation of alternatives in a single claim does not make the claim obscure or difficult to construe and provided that the claim meets the requirements of unity.

## *Drafting the claims :*

### Clarity and interpretation of claims

The requirement that the claims must be clear applies to individual claims and also to the claims as a whole.

### Interpretation

Each claim should be read giving the words the meaning and scope which they normally have in the relevant art, unless in particular cases the description gives the words a special meaning, by explicit definition or otherwise. If such special meaning applies, the examiner shall require the claim to be amended whereby the meaning is clear from the wording of the claim alone.

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## *Drafting the claims :*

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## *Drafting the claims :*

### Inconsistencies

- Any inconsistency between the description and the claims should be avoided, such inconsistency can be of the following kinds:
  - Single verbal inconsistency
  - Inconsistency regarding apparently essential features
  - Part of the subject-matter of the description and/or drawings is not covered by the claims

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## *Drafting the claims :*

### Essential features

An independent claim should specify explicitly all of the essential features needed to define the invention.

### Relative terms

Do not use a relative or similar term as thin, wide or strong unless the term has a well-recognised meaning in the particular field.

Where there is no basis in the disclosure for a clear definition and the term is essential having regard to the invention, it cannot be allowed in the claim.

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## *Drafting the claims :*

Terms like about and approximately

Such words may be applied, for example, to a particular value or to a range. In each case the examiner should use his judgment as to whether the meaning is sufficiently clear in the context of the application read as a whole and the invention can unambiguously distinguished from the prior art with respect to novelty and inventive step.

Other expressions such as preferably, for example, such as or more particularly can only be allow if they do not introduce ambiguity.

Trademarks

They may only be allowed exceptionally if their use is unavoidable and they are generally recognised as having a precise meaning. Remember that a product or a feature referred to by a trademark can be modified during the patent term.

## *Drafting the claims :*

### Parameters

Where the invention relates to a product it may be define in a claim in various ways. Characterisation of a product mainly by its parameters should only be allowed in those cases where the invention cannot be adequately defined in any other way.

### Product by process claim

Claims for products defined in terms of a process of manufacture are allowable only if the products as such fulfil the requirements for patentability (new and inventive). And should be written as “Product X obtainable by process Y”, other terms such as obtained or directly obtained are also allow.

## *Drafting the claims :*

### References to the description or drawings

The claims must not, in respect of the technical features of the invention, rely on references to the description or drawings except where absolutely necessary. An example of an allowable exception would be that in which the invention involves some peculiar shape. Another example relates to chemical products some of whose features can be defined only by means of graphs or diagrams.

### Negative limitations

A claim's subject matter is normally defined in terms of positive features, however, the subject matter may be restricted using a negative limitation expressly stating that particular features are absent. Disclaimers may be used only if adding positive features to the claim either would not define more clearly and concisely the subject matter still protectable or would unduly limit the scope of the claim.

## *Drafting the claims :*

Definition of comprising vs consisting

Functional definition of pathological condition

When a claim is directed to a any condition of being improved or prevented by selective occupation of “a specific receptor”, the claim can be regarded clear only if instructions, in the form of experimental tests or testable criteria, are available from the patent documents or from the common general knowledge allowing the skilled person to recognise which conditions fall within the functional definition and accordingly within the scope of the claim.

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## *Length of Text*

A general rule about the drafting of patent specifications is that they should be kept as short as possible, consistent with a sufficient disclosure of the invention. It saves costs plus a description which is concise is forced to be clear, and a clearly written specification is more likely to give an enforceable patent.

## *Unity of invention*

An application must relate to one invention only or to a group of inventions so linked as to form a single general inventive concept.

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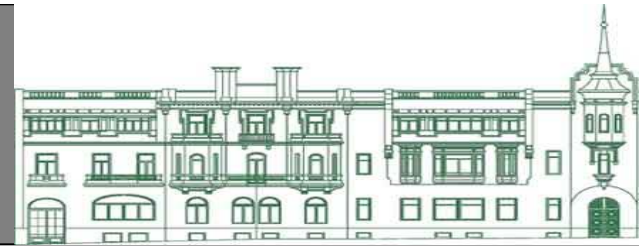
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**Muchas gracias por vuestra atención**



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Fundamentals of Global Law, Practice and Strategy.  
Fourth edition. Philip W. Grubb.
2. EPO Guidelines for Examination part C.



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## US PATENT LAW 2005

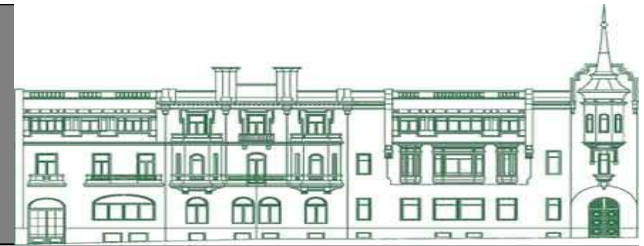
35 U.S.C. 102(a) – What constitutes prior art

A. 35 U.S.C 102 (a): Acts or Works of those other than the Applicant.

Section 102 contains seven specific events that will defeat novelty.

**“A person shall be entitle to a patent unless:”**

Section 102(a) describes events that will defeat novelty if they occurred before the applicant **invented** the claimed invention, not merely if they occurred before the applicant **filed** a patent application.

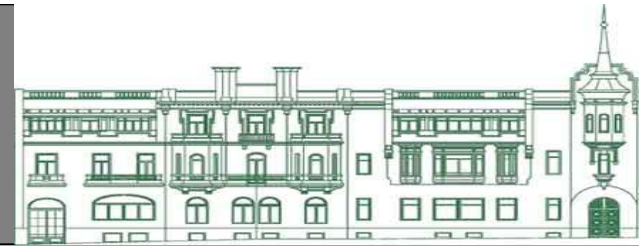


## US PATENT LAW 2005

Knowledge or use by others in the United States of the claimed invention or a patent or printed publication of another, from anywhere in the world, that describes that invention by a date prior to the earliest date of invention will disentitle an applicant to a patent under 102(a).

Because the USPTO does not typically have information concerning an applicant's date of invention, it will initially treat the application's filing date as the invention date.

An inventor can antedate the prior art by providing an evidentiary showing that he was the first to invent.



## US PATENT LAW 2005

Section 102(a) applies only to the work of others. An applicant's own work, whether in the form of a patent, publication, or public knowledge or use, **does not** represent prior art under subparagraph (a) but it can become prior art under Art. 102(b).

### **35 U.S.C 102(b): The statutory bar provision**

102 precludes patenting an invention previously patented or described in a printed publication anywhere in the world, or in public use or on sale in the United States, more than one year before the date the applicant applied for a patent in the United States



## US PATENT LAW 2005

102(b) applies to acts of the applicant as well as to the acts of others.

Essentially, 102(b) allows an inventor a one-year grace period to file a patent application following one of these mentioned events.

### **1. Patents and printed publications**

The publication must have been disseminated or otherwise made available to extent that persons interested and ordinarily skilled in the art can locate it.



## US PATENT LAW 2005

The effective date of a printed publication is the date it first becomes accessible to the public.

### 2. Public use

Determining whether a use is an anticipating “public use” requires consideration of (1) the extent of the use, and (2) the extent of publicity of the use.

When the invention is sold or put on display and used in its natural and intended way, a public use occurs.

Even if the invention is arguably concealed as part of a larger product, using the invention in its intended environment and in a nonprivate manner may give rise to public use.



## US PATENT LAW 2005

### 3. On sale-activity

Statutory “on sale” activity arises when a definite sale or offer for sale of the claimed invention, or an obvious variant thereof, has occurred more than one year before the filing date of the application in the United states

#### **35 U.S.C. 102(c) abandonment**

This article prohibits the granting of a patent if the applicant has abandoned the invention. Abandonment under this paragraph requires a deliberate surrender of rights. In other words, the inventor must intent to dedicate the subject matter to the public.



## US PATENT LAW 2005

### **35 U.S.C. 102 (d) foreign patenting**

This section prevents an applicant from patenting an invention in the United States if the applicant received a patent on the invention in a foreign country before his U.S. filing date on an application filed more than 12 months before the U.S. filing date. Four conditions must be satisfied:

- a. The foreign application must have been filed more 12 months before the U.S. Application was filed
- b. The foreign application must have been filed by the same applicant as the US application.



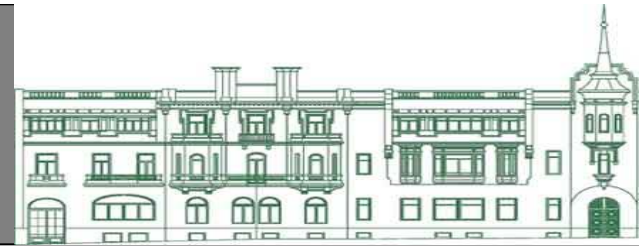
## US PATENT LAW 2005

- c. The foreign application must have matured into a patent before the filing date of the U.S application.
- d. The same invention must be involved in both the foreign and U.S. Applications.

### **35 U.S.C. 102 (e) prior art of another**

A person shall be entitle to a patent unless:

The invention was described in an application for patent by another filed in the United States before the invention by the applicant for patent or a patent granted on an application for patent by another filed in the US before the invention by the applicant for patent.



## US PATENT LAW 2005

Except that a pct application filed under the treaty shall have the effects for the purposes of this subsection of an application filed in the US only if the international application designated the US and was published under Article 21(2) of such treaty in the english language.





## US PATENT LAW 2005

Beyond the question of novelty, the claimed invention must also be nonobvious over the prior art. This is the case where the differences between the invention and the prior art are such that the invention as a whole would have been obvious to the person of ordinary skill in the pertinent art. The relevant time period for evaluating what the person skilled in the pertinent art would have considered obvious is just prior to when the invention was made.