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Advanced Claim Drafting with emphasis on the allowability of, and the protection obtainable by,
product-by-process claims, purpose-directed product claims and functional claims

<u>Product-by-Process Claims</u>	<u>Process X for producing product Y</u>	<u>Product Y obtained by process X</u>	<u>Product Y obtainable by process X</u>
<u>Purpose-Directed Product Claims</u>	<u>Product A for therapeutic use</u>	<u>2nd therapeutic use of product A</u>	<u>Use of product A for non-therapeutic use</u>
	<u>Use of Product A for therapy</u>	<u>Product A for 2nd therapeutic use</u>	<u>Product A used for non-therapeutic purpose</u>
	<u>Product A used for therapy</u>	<u>Product A for non-therapeutic use</u>	<u>(Functional name) comprising product A</u>
<u>Purpose-Directed Device/Apparatus and Means + Function Claims</u>	<u>Device for specified purpose</u>	<u>Device including means for performing a given function</u>	<u>Device including a structural functional element</u>
	<u>Device used for specified purpose or effect</u>	<u>Means for performing a given function</u>	<u>Device including several means for function</u>
	<u>Device «When in operation»</u>	<u>Device comprising «Function» means</u>	

CLAIM	Subject Matter	Extent of Protection	Comments - Secondary Infringement/protection
Process X for producing product Y.	The production of Y by process X.	Carrying out the process in the patented territory. Sale/use in the patent territory of product Y as direct product of the process (wherever the process is carried out)	«for□producing» means the actual production of Y, not the intended production, because the end product Y is a technical feature of the process.
Product Y produced/obtained by process X.	Product Y with implied product features resulting from the claimed process No distinction if the same product Y with any implied technical features is known from a prior process. The EPO applies a «□claim category theory□ assuming absolute protection for a claimed product, and makes no distinction between «□obtained□ and «□obtainable□.	Sale/use in the patent territory of product Y when actually produced/obtained by the claimed process (wherever the process is carried out). Performance of the actual manufacturing process is outside the protection but possession of the product (by the manufacturer) would be included.	Exceptionally equivalent or indirect infringement if the product Y is produced by a modified process. In the UK the subject matter and the protection are defined by the plain words□ Product Y obtained by process X (hybrid claim) whereby a known product acquires patentability from a novel and inventive process of production.

CLAIM	Subject Matter	Extent of Protection	Comments - Secondary Infringement/protection
Product Y produceable/obtainable by process X.	<p>Product Y with implied product features derived from the claimed process, even if the product Y is produced by another process.</p> <p>There is also no novelty-creating distinction if the same product Y with any implied technical features is known from a prior process.</p>	<p>Sale/use in the patent territory of product Y produced by any process (wherever the process is carried out), provided the product can be manufactured by process X.</p> <p>Performance of the actual manufacturing process is outside the protection but possession of the product by the manufacturer would be included.</p>	<p>There should be no substantial difference in applying EPO and UK principles of interpretation.</p> <p>However, the EPO theory to equate «obtained» and «obtainable» is not applicable in determining the extent of protection.</p>

CLAIM	Subject Matter	Extent of Protection	Comments - Secondary Infringement/protection
Product A for therapeutic use.	Product A for its intended therapeutic use (actual use is not covered).	Manufacture and sale of product A for the therapeutic use.	1st medical use claim – Art 54(5)EPC.
Use of Product A for therapy.	Carrying out an excluded therapeutic method using product A.	None. Excluded.	
Product A used for therapy.	Product A when used for therapy.	None. Excluded.	The claim is unconventional and may be considered unclear under EP «claim category» theory.
Use of product A in the manufacture of a medicament for a given therapeutic use.	Manufacturing activities to produce product A for the intended therapeutic use.	Manufacturing activities + probably extends to all commercial dealings (sale etc) of the product for the intended therapeutic use (indirect infringement)	Questions could arise relating to dealings in the same product A for other uses (potential use for the new therapeutic application).

CLAIM	Subject Matter	Extent of Protection	Comments - Secondary Infringement/protection
Product A used in the manufacture of a medicament for a given therapeutic use.	Product A when used in manufacturing a product A for the intended therapeutic use.	<p>Manufacture and sale of a medicament with product A for the intended therapeutic use.</p> <p>Sale of the product should be covered under direct infringement.</p>	<p>The claim is unconventional and may be considered unclear under EP «claim category» theory.</p> <p>Product protection should in principle be «stronger» than use protection.</p>
Product A for non-therapeutic use. (cosmetic, herbicidal, fungicidal any purpose-directed use)	<p>The subject matter is equated with product A.</p> <p>Covers the actual use and the intended use of product A—the intended use is deemed to embrace product A for any use.</p>	The manufacture and sale of product A.	If product A is known, the claim lacks novelty.
Use of product A for non-therapeutic purpose. (cosmetic, herbicidal, fungicidal any purpose-directed use)	<p>Use of product A for the new purpose.</p> <p>Achieving the new purpose is deemed to be a technical feature of the claim.</p>	Actual use of the product A for the new purpose.	Manufacture and commercial dealings in product A related to the new use should be covered under contributory or indirect infringement.

CLAIM	Subject Matter	Extent of Protection	Comments - Secondary Infringement/protection
Product A used for non-therapeutic purpose. (cosmetic, herbicidal, fungicidal any purpose-directed use)	Product A used for the new purpose. (same as use of product A for the new purpose, but different category).	The use of product A for the new purpose and the manufacture and sale of product A for the new purpose.	The claim is unconventional and may be considered unclear under EP «claim category» theory.
(Functional name) comprising product A. The designation of the subject matter can be any functional or purposive name□Herbicide, Fungicide, Lipstick ... etc	Product A. Covers product A for the intended purpose (= product A) and product A actually used for the new purpose.	Manufacture and sale of product A for the new purpose.	The new name is not deemed to impart a novel technical feature. If product A is known, novelty may be achieved by claiming a composition containing product A with (functional) additives for the new purpose.

CLAIM	Subject Matter	Extent of Protection	Comments - Secondary Infringement/protection
<p>Device for specified purpose.</p> <p>Also applies to apparatus, system, installation, thing for a specified purpose.</p>	<p>Device suitable for performing the intended purpose, as defined by the constitutive technical features of the device (excluding recitations of external features with which the device cooperates).</p>	<p>Manufacture, sale and use of a device intended for the intended purpose□also includes use of the device when operating to achieve the specified purpose.</p>	<p>The claim is anticipated by a device having the same structural features <u>and suitable for carrying out the intended purpose</u>, even if it was known only for different purposes.</p> <p>Not anticipated if the prior device having the same structural features <u>cannot</u> carry out the intended purpose.</p>
<p>Device used for specified purpose or effect.</p> <p>(Device, apparatus, system, installation, thing in use)</p>	<p>The device characterised by the sum total of its structural and operational features.</p>	<p>Use of the device (in the patented territory).</p>	<p>Supply of the device may be contributory infringement.</p> <p>Unnecessary use restrictions are considered to constitute a serious handicap in enforcement.</p> <p>Any use restriction for one element can restrict to the entire device being in use.</p>

CLAIM	Subject Matter	Extent of Protection	Comments - Secondary Infringement/protection
Device, apparatus, system, installation, thing with «When in operation» clause	Device, apparatus, system, installation, thing out of operation but capable of operating, or actually in operation	Manufacture or sale of the Device, apparatus, system, installation, thing in its passive state, and its use in the operative state.	The «When in operation» clause embodies an inventive effect. Claiming in the passive mode is necessary for enforcement.
Device etc. comprising, as one of its technical features, means for performing a given function.	The device with the means capable of performing or actually performing the given function.	Manufacture, sale or use of the device. For manufacture and sale, the means can be in the passive state. In use the means will normally be functioning.	«Means» is broadly interpreted, but the skilled person must have no difficulty in identifying and implementing alternative means.
Means for performing a given function, comprising ...	--	--	Single means is regarded as indefinite. No clear indication of the designation/category.
Device etc. comprising, as one or more of its technical features, «Label» means. Amplifier means, heating means etc.	It is necessary to ascertain if the «Label» qualifies or defines the function or merely identifies previously-identified means for performing a function.	Manufacture, sale or use of the device. For manufacture and sale, the «Function» means can be in the passive state. In use the means will normally be functioning.	Generally, its preferable to use structural functional terms like «Amplifier» rather than «Amplifier means».

CLAIM	Subject Matter	Extent of Protection	Comments - Secondary Infringement/protection
Device etc. comprising, as one of its technical features, a structural functional element, like amplifier.	The device comprising the structural functional element in its passive or active state.	Manufacture/sale/use of the device. For manufacture/sale the functional element can be passive. In use, the element is normally functioning.	Structural functional language should be given preference over « means for function » language.
Device etc. comprising several technical features, each defined as a means for performing a given function.	The device with the several means capable of or actually performing the given functions.	Manufacture, sale or use of the device. For manufacture and sale, the means can be in the passive state. In use the means will normally be functioning.	Several different « means + function » statements can be included in one claim, if they are clearly distinguished and identified e.g. using labels such as « first means » or « amplifier means » or « said means for performing specified function ».