
Claim Interpretation and Established Case-Laws

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Abstract

This article covers some established Case-Laws in respect of patent claim interpretation. Generally a claim is drafted as a single sentence with three parts, a preamble, main body of the claim and a link connecting both. Wordings chosen for each part of claim has implications on interpretation thereof. Preamble may restrict the scope of claim. Claim(s) of a patent must not be self-contradictory or creating confusion. Claim must be clear and concise. Use of a trademark should be avoided in drafting claim as it does not provide information in technical terms. Moreover, a disclosure involving trademark cannot be said to be enabling disclosure. Further, there is no guarantee that the meaning of a trademark will remain same throughout the patent term. A claim may be in an independent, dependent or multiple-dependent form. Dependent or multiple-dependent claims specify limitations of base

claim. However, a multiple dependent claim cannot serve as a base for another multiple-dependent claim. Omnibus claims are not allowable as per Rule 43(6) EPC, unless in case if the nature of an invention is such that the claim cannot be expressed without reference to description. As per the opinion of Federal Circuit, under the doctrine of claim differentiation, each claim in a patent is presumptively different in scope. Product-by-process claims are allowed where structure or other characteristics of a product are not completely known and hence the description of product is not possible without referring to the process by which it is made. When a product is defined by its parameters, it is necessary to give method of measurement of those parameters, unless the method of such measurement is well known in the art. Alternative generic expressions are permitted in Markush type claims if they present no uncertainty or ambiguity with respect to the scope or clarity of the claims. It was held in a case that two methods without any technical bearing on each other cannot be considered as a technical whole and hence it cannot be allowed in form of a single multi-step process claim. The terms used in claims should be generally interpreted to give a meaning conventionally used in the relevant art, unless any special meaning is defined in the specification. For interpretation of claims, how much weight should be given to each available source of evidence differs from case to case.

Keywords

claim interpretation; patent claims; claim interpretation and case laws;
claim interpretation and judicial precedents

INTRODUCTION

This article covers some established Case-Laws in respect of patent claim interpretation. Whenever a statutory provision is available, it has to be considered first. However, in absence of a statutory provision, one has to look at established case-law. A case-law is jurisprudence based on judicial precedents.

Among various case-laws on a particular aspect, one has to consider case-law of appropriate territory, and in absence of which, foreign case-law, if applicable, may be considered. However, while quoting foreign case-law, care has to be taken as the law differs from country to country. If something is expressly prohibited under law of a particular country, it is meaningless to quote foreign case-law in that matter.

Established case-laws can also be considered at the time of amendment of a statute, as they can provide clues to include new grounds for opposition or revocation of patents, and the same can also be used for analyzing infringement cases.

1. Three parts of claims and established jurisprudence:

Claims are the part of a patent specification which determines the boundaries of protection conferred to a patentee. Generally, a claim is drafted as a single sentence which may be made up of three parts viz., an introductory context or preamble, main body of the claim and a link connecting both.

1.1 Introductory Context or Preamble:

Claim 1 of US patent 7,589,225 reads as *A method for the preparation of a platinum(II) complex containing a neutral bidentate ligand, the method including the step of reacting a halogenoplatinum complex containing a neutral bidentate ligand with an oxalate salt in a solvent, wherein more than 1 g/L of the oxalate salt is soluble in the solvent and the solvent is a non-aqueous solvent or a mixed solvent system.*

In this case, the sentence *a method for the preparation of a platinum(II) complex containing a neutral bidentate ligand,* is the **preamble**. It provides a **context** to which the invention relates.

The inventive step is then described following the preamble as *the method including the step of reacting a halogenoplatinum complex containing a neutral bidentate ligand with an oxalate salt in a solvent*, it further limits the scope of the claim by imposing a condition *wherein more than 1 g/L of the oxalate salt is soluble in the solvent and the solvent is a non-aqueous solvent or a mixed solvent system.*

Preamble may restrict the scope of the claim. In case of GE Vs Nintendo Co.¹⁾ for infringement of US patent 4,270,125, it was concluded that the preamble of claim 1 imposed a limitation as the inventors were working on a specific problem of binary data display on a specific display device, not improvements to all display systems in general. Thus, while drafting even preamble to the claim, broadest possible coverage should be kept in mind.

1.2 Link connecting preamble and main body of claim:

1) <<http://www.ll.georgetown.edu/federal/judicial/fed/opinions/98opinions/98-1089.pdf>>

Whether the claimed invention is a product or a process, when the link or the transition phrase comprising is used, it implies that the claim includes products or processes with additional features or elements not necessarily mentioned in the claim. However, when the term comprising of is used, it excludes elements not mentioned in the claim. This is inferred from the view taken by patent examiners, particularly from US Patent Office.

2. Minute details of technical features or steps:

Art.84 EPC²⁾ requires that claim should define the matter for which protection is sought. It further specifies that the claim should be clear and concise and be supported by description. Whether the matter claimed is a physical entity (e.g., product, apparatus) or physical activity (e.g., a process), the wordings of a claim should enable one to determine the scope and extent of protection granted by a patent. However, as held in case T 1055/92³⁾, it is not always necessary to give minute details of technical features or steps in the claim. It is sufficient if a specification as a whole describes/discloses essential features of an invention in a manner to enable a skilled person in the art to reproduce results.

3. Independent, Dependent or Multiple-dependent claims:

Under 35 USC 112, the patent specification shall conclude with one or more claims distinctly identifying the subject matter which the applicant claims as his invention. A claim maybe in an independent, dependent or multiple-

2) Article 84 The claims:

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

3) <<http://legal.european-patent-office.org/dg3/biblio/t921055ep1.htm>>

dependent form. Dependent or multiple-dependent claims specify limitations of base claim. However, a multiple dependent claim cannot serve as a base for another multiple-dependent claim.

4. Claims must not be self-contradictory

Bayer AG filed an application EP0005150 in respect of Flame resistant polyamide molding compositions and their use in preparing shaped articles. The examining division of European Patent Office refused to grant patent on the ground that there was lack of clarity of claim. In the claimed composition, the sum total of individual components of composition exceeded 100%. The applicant lodged an appeal requesting that the patent be granted on the basis of the refused version of the claims. In response to a communication from the Board of Appeal, the applicant filed a new version of claims, complying with the requirement. Thus, it can be concluded that **claims must not be self-contradictory** (T 2/80⁴).

5. Use of a Trademark in claims:

In the case T 762/90⁵, it was held that the use of trademark Imprafix 43 035 liquid was considered to be unclear as it failed to indicate chemical composition.

In another case T 0480/98⁶, the application EP0564764 was refused by the examining division of European Patent Office. The claim 1 of the original application read as An article for animals entertainment, in particular pets, of

4) <<http://legal.european-patent-office.org/dg3/biblio/t800002ep1.htm>>

5) <<http://legal.european-patent-office.org/dg3/biblio/t900762du1.htm>>

6) <<http://legal.european-patent-office.org/dg3/biblio/t980480eu1.htm>>

the type provided with a familiar appealing shape for the animal to whom it is aimed, characterized in that it is basically composed of a plastics material obtained from natural polymers. The applicant submitted for amendment of description and claim 1 before receipt of first communication from the examining division under Rule 86(2) EPC. The amended claim specified that the article for animals entertainment basically composed of a bioderivative plastics material comprising natural polymers of vegetable origin, plasticizers of natural origin and hydrophilic and biodegradable synthetic polymers. According to the applicant, the amendment introduced in the main claim was supported by description as filed, wherein the plastics material used for the article of invention was indicated as MATER-BI of Novamont.

The amendment to claim 1 was not considered as a technical disclosure by the examining division. Moreover, the examining division said that claim 1 failed to satisfy the requirement of Article 84 in respect of clarity as the word bioderivative did not appear to have a clear meaning in the art. Further, as it assumed to mean derived from living organisms, it appeared to contradict the feature of synthetic polymers. In response, the applicant amended claims so as to define plastics materials as MATER-BI (registered trademark) in claim 1. The applicant filed five auxiliary request amending claim 1. On further examination, the amended claim still did not satisfy requirements of EPC and patent was refused by the examination division.

The applicant filed an appeal against the decision of examination division to refuse the application. The appellant provided evidence to identify the materials sold under the trademark MATTER-BI by Novamont. The appellate board found that the claim 1 of all 5 auxiliary requests were unallowable under Article 123(2) EPC and/or Article 84 EPC as the meaning of trademark MATER-BI was unclear and moreover, it might not remainsame throughout the term of patent.

Thus, it can be concluded that use of a trademark should be avoided in patent specifications as it does not provide a clear technical meaning and it may change during the term of a patent. It is a requirement that a disclosure should be enabling disclosure in the sense that a skilled person in the art should be able to reproduce the results of a disclosed invention without undue experimentation. Since the use of a trademark does not indicate certainty of its technical meaning, its use in the description or claims cannot be considered as enabling .

6. Reference to another patent specification in claims:

If a reference to another patent specification is made in a claim, it is not possible to determine the scope of claim without referring to the reference (T 363/99⁷⁾). Hence it cannot be said to be fulfilling the requirement of Art 84 EPC. Claim must be complete in itself in the sense that its interpretation should be possible without referring to any other document.

7. Omnibus Claims

Claims relying on reference to description in the specification i.e., omnibus claims are not allowable as per Rule 43(6) EPC⁸⁾, unless such reference is absolutely necessary. This was also decided in the case T 150/82⁹⁾. It is permissible only in case if the nature of an invention is such that it cannot be expressed without drawings.

7) <<http://legal.european-patent-office.org/dg3/biblio/t990363du1.htm>>

8) 43(6) EPC: Except where absolutely necessary, claims shall not rely on references to the description or drawings in specifying the technical features of the invention. In particular, they shall not contain such expressions as "as described in part... of the description", or "as illustrated in figure... of the drawings".

<<http://www.epo.org/patents/law/legal-texts/html/epc/2000/e/r43.html>>

9) <<http://legal.european-patent-office.org/dg3/biblio/t820150ep1.htm>>

Under US law, 35 U.S.C. 112¹⁰⁾ specifies that the subject matter which the applicant regards as his invention must be distinctly claimed.

8. Doctrine of Claim differentiation:

It is to be presumed that each claim of a patent conveys a different meaning and scope in the sense that there cannot be any repetition claims. Ecolab Inc. Vs Paraclipse Inc¹¹⁾ is an interesting case. Ecolab Inc. was granted a US patent 5,365,690 in respect of a flying insect trap using reflected and radiated light. Ecolab sued Paraclipse and one of the grounds was infringement of claim 16 of the '690 patent.

Claim 16 of 690 patent read as *A flying insect trap using reflected and radiated light as an insect attractant, which trap comprises a vertical, planar surface, a housing containing a means to mount the housing on the vertical, planar surface, an insect immobilization surface and a source of insect attractant light wherein the housing is configured such that when mounted on the vertical, planar surface, the source cannot be directly viewed and the housing contains a surface at an angle to the horizontal, planar surface of less than 80.degree. which reflects light from the source onto the vertical, planar surface, and the trap has an upwardly facing opening.*

Claim 17 of the patent then specified that the trap of claim 16 wherein the insect attractant light comprises a source of ultraviolet light.

10) 35 U.S.C. 112 Specification: The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11) (<http://www.ll.georgetown.edu/federal/judicial/fed/opinions/01opinions/01-1204.pdf> page 18 of 23)

In the opinion of Federal Circuit, the only meaningful difference between claim 16 and claim 17 was the limitation of ultraviolet light. Federal Circuit applied doctrine of claim differentiation and held that claim 16 did not restrict scope only to ultraviolet light. Further it is mentioned in the opinion of Federal Circuit that under the doctrine of claim differentiation, each claim in a patent is presumptively different in scope. This presumption is especially strong where there is a dispute over whether a limitation found in a dependent claim should be read into an independent claim, and that limitation is the only meaningful difference between the two claims.

9. Product-by-Process Claims

Claims for products defined in terms of processes for their preparation (i.e., product defined as that obtained by invented process) are admissible only if the products themselves fulfill the requirements for patentability and there is no other information available in the application which could enable the applicant to define the product satisfactorily by reference to its composition, structure or some other measurable parameter. In other words, such claims are permissible when the product per se cannot be defined without reference to its process of manufacture. As per Article 64(2) EPC¹²⁾, protection conferred by a process claim is extended to the products directly obtained by that process.

US patent 6063927 is an example wherein a product-by-process has been claimed. First claim of 927 patent reads as Paroxetine methanesulfonate in crystalline form having following characteristic IR peaks: 1603, 1194, 1045, 946, 830, 601, 554, and $539 \pm 4 \text{ cm}^{-1}$. Thus, the product is defined by its

12) 64(2) EPC: If the subject-matter of the European patent is a process, the protection conferred by the patent shall extend to the products directly obtained by such process.
(<http://www.epo.org/patents/law/legal-texts/html/epc/2000/e/ar64.html>)

parameters viz., crystalline form with characteristic IR peaks. Second claim reads as Paroxatine hydrochloride formed by conversion of paroxatine methanesulfonate as described in claim 1, by contacting said paroxatine methanesulfonate with hydrochloric acid. Second claim is a product-by-process type claim wherein the product is defined by method described therein. It should be noted that second claim does not cover paroxatine hydrochloride in general, but it covers paroxatine hydrochloride which is prepared by the method claimed.

Product-by-process claims are allowed where structure or other characteristics of a product are not completely known and hence the description of product is not possible without referring to the process by which it is made.

10. Definition of product by its parameters:

When the product is defined by its parameters, it is necessary to give method of measurement of those parameters, unless the method of such measurement is well known in the art.

It was ruled in case T 1156/01¹³⁾ that if the invention is characterized by parameters, the method of and means for measurement of such parameters should appear completely in the claim itself, whenever this is reasonable, or by reference to the description in accordance with Rule 29(6) EPC, if the method is so long that it would impair the conciseness of the claim. However, it is not necessary to mention the method of determination if the method is so well known that a skilled person in the art would know the method and its application.

13) <http://legal.european-patent-office.org/dg3/pdf/t011156eu1.pdf>

11. Process claim including use of a device:

In case T 0453/90¹⁴⁾, it was held that a process claim with device characteristics included therein should be allowed when the device characteristics are necessary for the full and clear definition of the procedure. In US law, under 37 CFR 1.475(b)¹⁵⁾, claims related to a process and an apparatus or means specifically designed for carrying out the said process is considered to be fulfilling the requirement of unity of invention. However, it is not mandatory that a claim for an apparatus must contain information about method of operating it. It was held in T 435/89¹⁶⁾ that a claim for an apparatus per se need not contain information about the process of operating it. An apparatus and process of using it can be separately claimed.

As per 37 CFR 1.475¹⁷⁾ claims to different categories of invention will be considered to fulfill the requirement of unity of invention if the claims are drawn only to following combinations of categories:

1. A product and a process for manufacturing the same.
2. A product and a process for using the same.
3. A product and a process for manufacturing the same and use of said product.
4. A process and an apparatus or means specifically designed for carrying out the said process.
5. A product and a process for manufacturing the same and an apparatus or means specifically designed for carrying out the said process.

14) <<http://legal.european-patent-office.org/dg3/biblio/t900453du1.htm>>

15) <http://www.uspto.gov/web/offices/pac/mpep/documents/appxr_1_475.htm>

16) <<http://legal.european-patent-office.org/dg3/biblio/t890435du1.htm>>

17) <http://www.uspto.gov/web/offices/pac/mpep/consolidated_rules.pdf>

12. Number of claims should be reasonable

It was held in the case T 246/91¹⁸⁾ that although there cannot be a hard and fast rule regarding number of claims for a given invention, it does not mean that the criteria is devoid of any legal effect. Interest of relevant people has to be kept in mind while drafting the claims. Claims must be clear and concise so as to enable a skilled person to judge legal boundaries of a patent. Unnecessary large number of claims put undue burden on the potential users of the art. Originally there were 191 claims in the patent reviewed under case T 246/91, which were reduced to 157 during appeal proceedings.

13. Two part claims differentiating prior-art

A claim may be drafted in two parts to differentiate prior art from the invention. Such two-part claims consist of a preamble or context including prior art followed by a phrase such as *wherein*, which separates prior art from the invention. However, it is not mandatory to draft such claim in two parts. In case T 170/84¹⁹⁾, it was held that a two part claim is not appropriate where it will lead to complex formulation. The remarks read as Rule 29(1) EPC stipulates that claims should normally be formulated in two parts. According to Rule 29(1) EPC, second sentence, a two-part claim should be chosen wherever it is appropriate. But Article 84 EPC reads as follows: The claims shall define the matter for which protection is sought. They shall be clear and concise and be supported by the description. Where therefore a two-part claim would lead to a complex formulation it is no longer appropriate.

18) <<http://legal.european-patent-office.org/dg3/biblio/t910246eu1.htm>>

19) <<http://legal.european-patent-office.org/dg3/biblio/t840170ep1.htm>>

Claim has to be read in its entirety. Whenever a two-part claim is not appropriate, one part claim should be drafted which has to be read in its entirety in the sense that infringement takes place if all essential elements of a claim are copied by alleged infringer.

Consider an example of a formulation claim. If four components A, B, C & D of a formulation useful for cosmetic purpose are included in a claim in the prior art, and a subsequent inventor finds that addition of component E & F has special benefits of synergistic effect, he may draft his claim either as a single part or a two-part claim as follows:

Single-part claim:

A cosmetic composition comprising A, B, C, D, E & F.

This claim has to be read in its entirety and the claim will be infringed if all components are used by infringer.

Two-part claim:

A cosmetic composition comprising A, B, C & D, wherein the components E & F are included.

14. Markush Claims

Eugene Markush invented and claimed a process for manufacturing dyes comprising coupling of a halogen substituted pyrazolone with a diazotized unsulfonated material selected from the **group** consisting of aniline, homologues of aniline and halogen substitution products of aniline.

This was a broad generic type of claim including a “group” of compounds. However, his claim was rejected by US Patent Office. Markush appealed and

the Commissioner issued a decision²⁰⁾ overruling the examiner and approving the generic claim format. US Patent 1,506,316 was granted to Markush. The format of generic claim is known as Markush Format.

Alternative generic expressions are permitted if they present no uncertainty or ambiguity with respect to the scope or clarity of the claims. The use of Markush claims is not rejected unless it renders the claims indefinite or if it results in undue multiplicity, it may be rejected.²¹⁾

When the prior art only teaches a concept but it is not possible to obtain the benefits of the invention without undue experimentation, it implies that there is a scope for another invention which can help bringing the concept to practice. What is meant is that, the prior art disclosure may be conceptually correct, but the enabling solution is still patentable.

When a chemical substance is described or claimed by generic formula, anything which can be described by that formula loses novelty. However, under certain circumstances, even if a generic formula is described or claimed in the prior art, a future inventor can still be granted a “selection patent” if he meets certain requirements.

A selection invention is an invention, the subject of which is contained in the prior art by a more general teaching, for example, a generic structural formula of a chemical compound or a broad range of parameters, but which has not been specifically described in the prior art so as to enable a skilled person to practice the invention without undue experimentation.

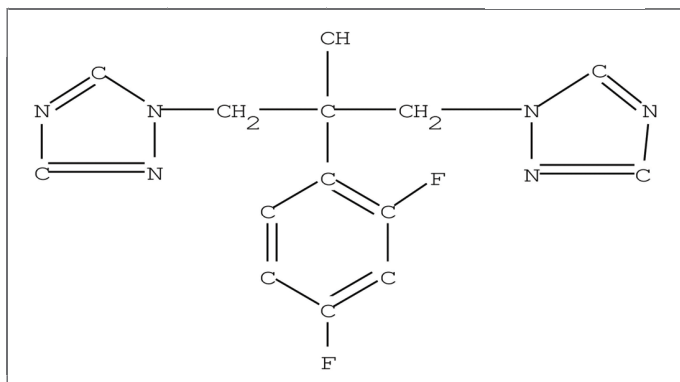
20) Ex Parte Markush, 340 OG 839 (1924)

21) <http://www.uspto.gov/web/offices/pac/mpep/documents/2100_2173_05_h.htm#sect2173.05h>

Selected sub-range should not be arbitrarily chosen sub-range from the broad range claimed in the prior art.

Pfizer filed a Canadian patent 1,181,076. The main claim of this patent read as under:

1. A process for preparing a compound of the formula [Diagram 1]

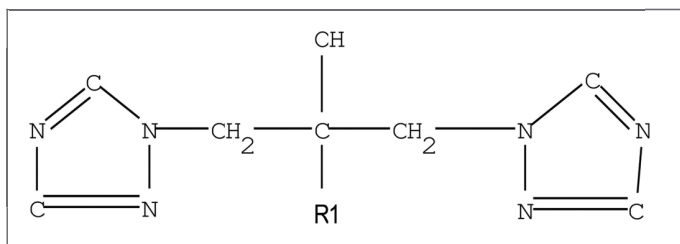


[Diagram 1]

or a pharmaceutically acceptable salt thereof, which comprises.....

Apotex raised an issue²²⁾ that Pfizer patent is invalid on the ground that what is claimed in Pfizer patent is not new and/or is obvious in the light of the disclosure in ICI Canadian patent 1,170,263, which has earlier priority.

ICI '263 patent included fungicidal compounds with formula [Diagram 2]



[Diagram 2]

22) Pfizer Vs Apotex T-2389-94

Wherein R1 is a variable, but it did not specifically include 2,4-difluorophenyl derivative(i.e., fluconazole compound). The ICIpatent was an originating patent, and it claimed genus whereas the Pfizer patent was a selection patent and it claimed species.

Fluconazole has unexpected therapeutic advantages over its closest structurally similar compounds disclosed in ICI patent. It is not only a potent anti-fungal agent, but also not causing teratogenic effects. Compounds specifically exemplified in ICI patent are teratogenic, i.e., they cause congenital deformities. Fluconazole as specifically disclosed in Pfizer patent, is the only specific compound within generalized class of compounds set out in ICI patent, which is not teratogenic.

Moreover, Fluconazole is soluble in water as compared to the teratogenic 2,4-dichloro derivative, which isinsoluble in water. This is an advantage with respect to administration of the pharmaceutical compound. It may be desirous or even inevitable to inject the drug intravenously, intramuscularly or subcutaneously, and the compound must be soluble in order to do so. Fluconazole possesses all these desirable properties.These advantageous properties are not exhibited by closest structurally similar compounds specifically exemplified or disclosed in ICI patent. These properties make fluconazole suitable for treatment of human fungal infections and it is the only compound in the general class, which has received marketing approval to be used for treatment of human fungal infections. None of the specific compounds disclosed in ICI patent is found suitable for commercial development.

In the opinion of Honorable Judge John D. Richard, the subject matter of the Pfizer patent has unexpected and valuable properties which are not possessed by the structurally closest compounds disclosed in ICI patent including the fact

that fluconazole is not teratogenic. The respondents' allegation of invalidity because of anticipation and obviousness fails.

Thus, an invention is not anticipated, if the information taught in the prior art document appears to be speculative, not entirely accessible or hidden, i.e. making it difficult or impossible to carry out the teaching. Selection of a specific compound or a group of specific compounds from a broad class of compounds described by a generic formula in the prior art is considered novel if following conditions are fulfilled: (1) selection should result in securing an advantage or avoiding a disadvantage of prior art. (2) advantage which can be secured by the use of selected member(s) must be unobtainable by using other members of the broad class. (3) useful and special property or characteristics of the selected member(s) should be adequately defined in the selection patent. (4) selection must be non-obvious to a person ordinarily skilled in the art. (5) selection must not be an exact repetition of the same method coupled with a statement of properties of the selected members. (6) process for obtaining selected member must not have been specifically described in the prior art, or in other words, the selected member must not be an outcome of a specific process already disclosed in the prior art.

From the decision of EPO Boards of Appeal in the case T 0198/84²³, it can be learnt that a selection of a narrow sub-range within a broad range claimed in the prior art can be considered to involve an inventive step if such selected narrow range is sufficiently far away from the known range illustrated by means of specific examples in the original patent. This was also confirmed in T 0279/89²⁴.

23) <<http://legal.european-patent-office.org/dg3/biblio/t840198ep1.htm>>

24) <<http://legal.european-patent-office.org/dg3/biblio/t890279eu1.htm>>

15. Single multi-step process claims:

There are instances where a process involves multi-steps, for example, a process to prepare a final chemical compound meant for some end-use, such multi-step process claim can include steps related to the preparation of its intermediate. However, in such multi-step process claims, there has to be a technical relationship between various steps of the process. In case T 380/01²⁵⁾, it was held that two methods without any technical bearing on each other cannot be considered as a technical whole and hence it cannot be allowed in form of a single multi-step process claim.

16. Definition of terms:

Litigants have used various sources for interpretation of terms used in claims. These include intrinsic and extrinsic evidences. Intrinsic evidence include definitions given in description part of patent specification and prosecution history. Extrinsic evidence include dictionary meanings, prior art documents, treatises, testimony of inventors & technical/legal experts. As these sources may provide different meanings, courts have selectively allowed appropriate source to be used, depending on the facts of a case.

The terms used in claims should be generally interpreted to give a meaning conventionally used in the relevant art, unless any special meaning is defined in the specification. It was held in T 0523/00²⁶⁾ that a patent document may be its own dictionary. The documents of a patent are to be considered as a self-contained whole, giving the words used their normal meaning in the art, unless in particular cases the description gives the words a special meaning. There is

25) <<http://legal.european-patent-office.org/dg3/biblio/t010380eu1.htm>>

26) <<http://legal.european-patent-office.org/dg3/pdf/t000523eu1.pdf>>

nothing in the EPC, which requires that terms used in different patents should have the same meaning. According to Article 69 EPC, the description and drawings of the patent, and not of other patents, shall be used to interpret the claims, that is to say the patent itself is its own dictionary. In the present case, the meaning of the term fiber is given in the description of the patent in suit, page 2, lines 55 and 56, together with the passage on page 3, lines 42 to 45, when yarns are implied. It follows that a fibre in the meaning of the patent in suit is the individual smallest element.

As per the opinion of the Federal Circuit in *Markman Vs Westview Instruments, Inc.*²⁷⁾, it was held that the construction of a patent, including terms of art within its claim, is exclusively within the province of the court. Courts were required to consider intrinsic evidence first. Extrinsic evidence cannot be considered when intrinsic evidence provide proper interpretation of claim. It means that the Judge could use discretion to consider extrinsic evidence in absence of proper intrinsic evidence.

In *Vitronics Corp Vs Conceptiontronic, Inc.*²⁸⁾, according to the Federal Circuit, if patent specification and prosecution history are unambiguous, expert testimony cannot be considered for interpretation of claim. Even the inventor testimony cannot be considered as it was most often found self-serving.

District Courts however did not appreciate the decision taken in *Vitronics* case. According to District Courts, claim interpretation should be left to a person skilled in the art. Trial Courts continued to accept expert testimony for interpretation of claims.

27) *Markman Et al. Vs. Westview Instruments, Inc., Et al.* certiorari to the united states court of appeals for the federal circuit, 517 U.S. 370 (1996).

28) *Vitronics Corp. Vs. Conceptiontronic Inc.,* 90 F.3d 1576, 1583, 39 USPQ2d 1573, 1577 (Fed. Cir. 1996)

Pitney Bows sued HP for infringement of its USpatent 4,386,272. The opinion of Court in Pitney Case recognized the fact that trial courts continued to accept expert testimony for interpretation of claims. Confusion still remained as there was inconsistency among various sources of evidence, so which source to be considered was a question, which was answered by decision of the Court in the case of K-2 Corp. From the opinion of Federal Circuit in the case of K-2 Corp Vs Salomon²⁹⁾, it can be concluded that for interpretation of claims, how much weight should be given to each available source of evidence differs from case to case.

29) K-2 Vs. Salomon 98-1552, 09/13/1999

청구의 해석과 확립된 판례법

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국문초록

본문은 특허 청구항의 해석과 관련된 확립된 판례법을 설명한다.

일반적으로 청구는 도입부와 청구항 본문, 연결부의 세 부분으로 구성된다. 청구항의 각 부분에 선택된 단어는 청구에 대한 해석의 의미를 가지고 있다. 도입부는 청구의 범위를 제한할 수 있다. 특허의 청구는 모순이나 혼란을 유발해서는 안 된다. 청구는 분명하고 간결해야 한다. 청구항 작성 시 기술적 정보를 제공하지 않는 상표의 이용은 피해야 한다. 또한 상표를 포함한 개시는 권한을 부여하는 개시로 볼 수 없으며 상표의 의미가 특허 기간 동안 계속 유지된다는 보장을 할 수 없다. 청구항은 독립항, 종속항, 다중종속항의 형태로 작성될 수 있다. 종속항이나 다중종속항은 기초 청구항의 한계를 지정한다. 단 다중종속항은 다른 다중종속항의 근거 역할을 할 수 없다. 유니버스 청구항은 발명의 성격 상 43(6) EPC에 따라 설명을 참조하지 않고 표시가 불가능한 경우를 제외하고는 허용되지 않는다.

연방순회항소법원의 판결에 따르면 청구항 구분의 원칙에 따라 각 청구항이 서로 다른 범위를 가진 것으로 간주한다. 방법적 물건청구항은 제품의 구성이나 다른 성격이 완전히 알려지지 않아 제조 방법을 참조하지 않고서는 제품의 설명이 불가능한 경우에 허용된다. 제품이 파라미터에 의해 정의된 경우에는 파라미터 측정이 잘 알려져 있지 않은 한 파라미터의 측정 방식을 제공해야 한다. 포괄적인 대체 표현은 청구의 범위나 명료성에 관련하여 불확실성이나 모호성이 없는 경우 마쿠시형 청구항으로 허용된다. 기술적 관계가 없는 두 가지 방법은 단일 다단계 방법 청구항을 구성할 수 없는 것으로 판결되었다.

청구항에 이용된 용어는 명세서에서 특별히 정의되지 않은 한 해당 기술분야에서 관습적으로 이용되는 의미를 가진 것으로 해석된다.

청구의 해석을 위해 각각의 증거 출처에 얼마나 높은 가중치를 둘 것인가는
사안마다 다르다

주제어

청구 해석, 특허 청구, 청구 해석과 판례법, 청구 해석과 판례