



Claim Interpretation: Pre-Lecture (Examples)

Patent Training Academy
Entry Level

UNITED STATES
PATENT AND TRADEMARK OFFICE





Objectives

You will become more familiar with the following:

- Why claims are important
- The types of claims
- The parts of a claim



What Is a Claim and Why Do You Care?

- A **claim** is one of the most important parts of the application because
 - It defines the scope of the protection that the applicant is granted
- Every word in the claim **MUST** be considered, and no limitation, functional or otherwise, can be ignored
- All limitations should be specifically addressed in the examination



Types of Claims

Claims come in different forms:

- Process or method claims, including methods of making or methods of using
- Machine or apparatus claims
- Manufacture or product claims, and
- Composition of matter claims



Apparatus Claims

- Patentability depends upon the parts or pieces (structure) of the apparatus, not on the way it is used or the material worked upon

See MPEP § 2114

Method or Process Claims

- Includes methods of making and methods of using
- Patentability depends on the specific steps listed as well as the materials used in the method or process
- If the steps are not ***directly linked*** to the previous step, then the order of steps doesn't matter (MPEP § 2111.01 II)

Example, Directly Linked:

A method of mixing comprising:

- Adding A
- Mixing B directly into A
- Mixing C directly into the A-B mixture

Example, Not Directly Linked:

A method of mixing comprising:

- Adding A
- Mixing B
- Mixing C



Product Claims

- Patentability depends upon the components of the product, not the method or process of making or using the product



Composition Claims

- Patentability depends upon the materials of the composition, not the method or process of making or using the product

See MPEP § 2112.01



Knowledge Check A

Patentability of a method claim depends only on the materials used in the method or process.

- A. True
- B. False

Knowledge Check B

The patentability of an apparatus claim depends on the structural limitations of the apparatus and on the way the apparatus is used or the material that the apparatus works upon.

- A. True
- B. False



Parts of a Claim

A claim has three (3) main parts:

- A **preamble** or introduction
- A **transitional phrase** of:
 - comprising (open); or
 - consisting of (closed); or
 - consisting essentially of (open, but excludes materials or steps that materially affect the basic and novel characteristics of the invention)
- A **body** reciting the elements of the invention

See MPEP §§ 608.01(m) and 2111.03



Example 1: Apparatus Claim

Claim 1:

A chair comprising:

- a flat top; and*
- a plurality of legs attached to one side of the top.*

- **Preamble:** "A chair"
- **Transitional phrase:** "comprising"
- **Body:** "a flat top; and a plurality of legs attached to one side of the top"



Example 1: Apparatus Claim (*cont.*)

Claim 1:

A chair comprising:

- a flat top; and

- a plurality of legs

attached to one side of the top.

- Does the preamble of the claim -- "a chair"-- give any structure to the claim, or is it understandable without the preamble?
 - **No**, it does not give any structure in this instance. The breadth of the claim is broad enough to encompass many things including a chair (MPEP § 2111.02)



Example 1: Apparatus Claim (*cont.*)

Claim 1:

A chair comprising:

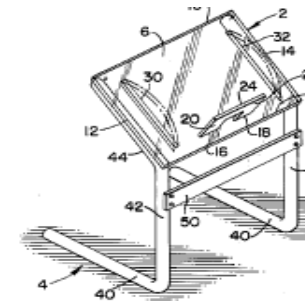
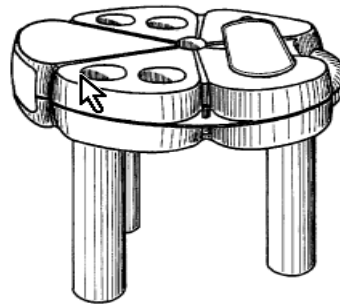
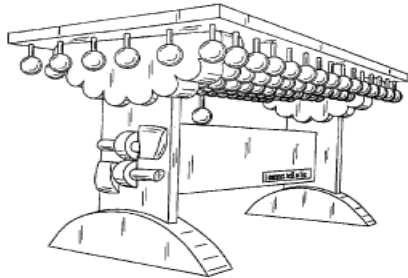
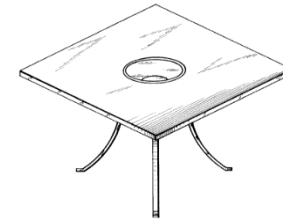
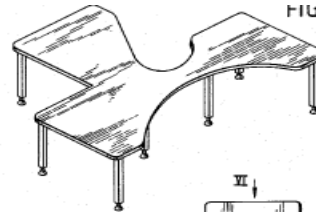
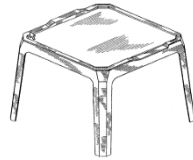
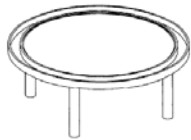
- a flat top; and*
- a plurality of legs attached to one side of the top.*

- What features of the claim are given patentable weight?
- Diagram the claim
 - The article **must** have: a flat top and a plurality of legs attached to one side of the top

Example 1: Apparatus Claim (*cont.*)

This is a very broad claim with many possibilities.

Would the claim read on any of the following examples?





Example 2: Product Claim

Claim 1. A multilayer product capable of conducting electricity consisting essentially of:

- a) a first skin layer of polycarbonate,*
- b) an intermediate layer of polypropylene doped with metal particles adjacent the first skin layer, and*
- c) a second skin layer on the opposite side of the intermediate layer from the first skin layer.*



Example 2: Product Claim (cont.)

What are the parts of the claim?

- **Preamble:** "A multilayer product capable of conducting electricity"
- **Transitional phrase:** "consisting essentially of"
- **Body:** "a) a first skin layer of polycarbonate, b) an intermediate layer of polypropylene doped with metal particles adjacent the first skin layer, and c) a second skin layer on the opposite side of the intermediate layer from the first skin layer"

Example 2: Product Claim (*cont.*)

Claim 1. A multilayer product capable of conducting electricity consisting essentially of:

- a) a first skin layer of polycarbonate,*
- b) an intermediate layer of polypropylene doped with metal particles adjacent the first skin layer, and*
- c) a second skin layer on the opposite side of the intermediate layer from the first skin layer.*

- Does the preamble of the claim "***a multilayer product capable of conducting electricity***" provide structural limitations to the claimed product?
- Or does the body of the claim recite a structurally complete invention?



Example 2: Product Claim (*cont.*)

Claim 1. A multilayer product capable of conducting electricity consisting essentially of:

- a) a first skin layer of polycarbonate,*
- b) an intermediate layer of polypropylene doped with metal particles adjacent the first skin layer, and*
- c) a second skin layer on the opposite side of the intermediate layer from the first skin layer.*

- In this instance, the phrase “a multilayer product” does not structurally limit the claimed product
- The claim could have recited “**An article**” instead of “A multilayer product” as we can tell that the product is multilayered by the language of the body of the claim

Example 2: Product Claim (*cont.*)

Claim 1. A multilayer product capable of conducting electricity consisting essentially of:

- a) a first skin layer of polycarbonate,*
- b) an intermediate layer of polypropylene doped with metal particles adjacent the first skin layer, and*
- c) a second skin layer on the opposite side of the intermediate layer from the first skin layer.*

- With regard to the second part of the preamble, does “**capable of**” in the phrase “**capable of conducting electricity**” provide a positive limitation to the claim?



Example 2: Product Claim (*cont.*)

Claim 1. A multilayer product capable of conducting electricity consisting essentially of:

- a) a first skin layer of polycarbonate,*
- b) an intermediate layer of polypropylene doped with metal particles adjacent the first skin layer, and*
- c) a second skin layer on the opposite side of the intermediate layer from the first skin layer.*

- **No**, this statement of intended use does not result in a structural limitation
- We can tell that the product is capable of conducting electricity by the language of “**doped with metal particles**” in the body of the claim



Example 2: Product Claim (*cont.*)

- What features of the claim are given patentable weight, or what must the claim have?
- The claim **must** have:
 - a first skin layer of polycarbonate,
 - an intermediate layer of polypropylene doped with metal particles adjacent and attached to the first skin layer, and
 - a second skin layer on the opposite side of the intermediate layer from the first skin layer and attached to the intermediate layer



Example 3: Method Claim

Claim 1. A method of repairing at least one defective area in at least one stoving lacquer coating consisting of the steps of:

- (a) applying a powder coating composition directly to at least one defective area, wherein said powder coating composition has a mean particle size ranging from about 1 to about 90 micrometers; and*
- (b) melting and curing the powder coating composition by irradiation.*



Example 3: Method Claim (cont.)

What are the parts of the claim?

- **Preamble:** "A method of repairing at least one defective area in at least one stoving lacquer coating"
- **Transitional phrase:** "consisting of the steps of"
- **Body:** "(a) applying a powder coating composition directly to at least one defective area, wherein said powder coating composition has a mean particle size ranging from about 1 to about 90 micrometers; and (b) melting and curing the powder coating composition by irradiation"

Example 3: Method Claim (*cont.*)

Claim 1. A method of repairing at least one defective area in at least one stoving lacquer coating consisting of the steps of:

(a) applying a powder coating composition directly to at least one defective area, wherein said powder coating composition has a mean particle size ranging from about 1 to about 90 micrometers; and

(b) melting and curing the powder coating composition by irradiation.

- Does the preamble of the claim give any life or characteristics to the method claim?
- Or can the method claim be understood just by the language of the body of the claim?



Example 3: Method Claim (*cont.*)

Claim 1. A method of repairing at least one defective area in at least one stoving lacquer coating consisting of the steps of:

(a) applying a powder coating composition directly to at least one defective area, wherein said powder coating composition has a mean particle size ranging from about 1 to about 90 micrometers; and

(b) melting and curing the powder coating composition by irradiation.

- **Yes**, it does make a difference this time
- We cannot tell from the body of the claim that the method is to repair at least one defective area **in a stoving lacquer coating**



Example 3: Method Claim (*cont.*)

- What features of the claim are given patentable weight, or what must the claim have?
- The claim **must** have the steps of:
 - applying a powder coating composition directly to at least one defective area, wherein said powder coating composition has a mean particle size ranging from about 1 to about 90 micrometers;
 - and melting and curing the powder coating composition by irradiation ***to repair a stoving lacquer coating***



Knowledge Check C

Which of the following are accurate?

- A. The transitional term “consisting of” does not exclude additional, unrecited elements or method steps
- B. The transitional phrase “consisting essentially of” limits the scope of a claim to the specified materials or steps “and those that do not materially affect the basic and novel characteristics” of the claimed invention
- C. The transitional phrase “comprising” excludes any element, step, or ingredient not specified in the claim
- D. All of the above



Summary

You should now be more familiar with the following:

- Why claims are important
- The types of claims
- The parts of a claim



Questions?

Thank you!

**Please remember to complete your course
evaluation survey**