



# FICPI 22nd Open Forum

Madrid

25-28 September 2024



# DRAFTING WITHOUT BORDERS HIGH TECH

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**FICPI 22nd  
Open Forum**  
Madrid  
25-28 September 2024



# Introduction

Johan Örtenblad  
Noréns Patentbyrå AB, Sweden



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# Drafting without borders

- The international patent space is growing more complex and complicated - despite international harmonization efforts
- Globalized markets
  - Strong local/global patent protection more important
  - Many different local peculiarities to take into account!
- My own personal experience: Drafting across the Atlantic
- Random data point from recent discussions:
  - Australian case *Jusand v Rattlejack* (mining drills falling down)
  - UK principle of “relevant range” applied for support/sufficiency



**Johan Örtenblad**

Sweden



**Patricia Koch**

Spain



**Dima Litvak**

Israel



**Pete Sadler**

United Kingdom



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# Drafting without borders

Dima Litvak  
Reinhold Cohn Group, Israel



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# Drafting without Borders

**A GLOBALLY ORIENTED FLEXIBLY  
DRAFTED PATENT APPLICATION**

**Dima Litvak**

Partner, Patent Attorney

Head of the Technology, Mechanics & Designs Practice



# Flexibility = Support at Different Stages

**Towards  
prosecution**

**1**

**During  
prosecution**

**2**

**Prior to  
grant**

**3**

**During  
post grant  
proceedings**

**4**

# Different types of support



**US-LIKE  
APPROACH**

**Scope of broadest claims**  
**Future narrowing amendments**  
**Future divisionals / continuations**  
**Broad interpretation of a feature**  
**Clarifying technical effects**

**EP-LIKE  
APPROACH**

**GLOBALLY ORIENTED FLEXIBLY  
DRAFTED PATENT APPLICATION**

# 1. Support for scope of broadest claims



## THE PRODUCT

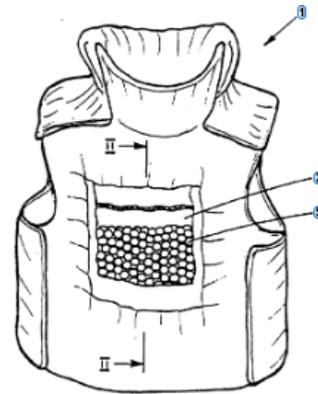


FIG. 1

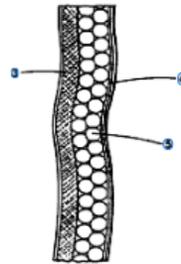


FIG. 2

## THE BROADEST SCOPE OF THE INVENTION

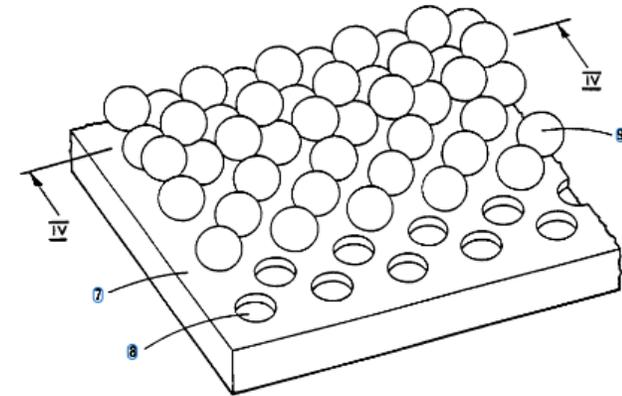


FIG. 3

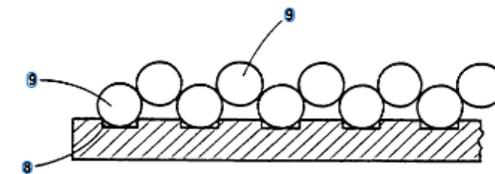


FIG. 4



2A.

Support for possible future narrowing amendments based on features originally claimed **in dependent claims**

**DRAFT THE CLAIMS IN MULTIPLE DEPENDENCY**

**DON'T COMBINE A NUMBER OF FEATURES IN A SINGLE DEPENDENT CLAIM**

## 2B.



Support for possible future narrowing amendments based on features from **the detailed description** (not claimed originally)

While drafting the **detailed description** and describing drawings:

1. Describe non-claimed features in a **language suitable for a claim** in a maximally isolated manner, to provide literal support for the EP-like approach
2. Describe specific examples in a **very detailed manner** and make sure that each claimed feature is shown in the drawings and described accordingly, to provide support for the US-like approach

# 2B.

Support for possible future narrowing amendments based on features from the detailed description (not claimed originally)



These engaging means will hereinafter be referred to as bracket engaging elements and corresponding canopy cover engaging elements. **In general**, the bracket engaging elements and the corresponding canopy engaging elements can be configured so as to provide a bayonet-type coupling of the canopy cover with the mounting bracket ...

**In the present example**, the bracket engaging elements of the mounting bracket 20 are in the form of outwardly extending protrusions 25 of the side wall 28 of the base 20a of the mounting bracket, spaced along its circumference by gaps 23 and each having a bracket engaging surface 27 oriented transversely to the axis X' of the mounting bracket. In Fig. 2A, the bracket engaging surfaces are shown as being oriented generally perpendicularly to the axis X' of the mounting bracket.

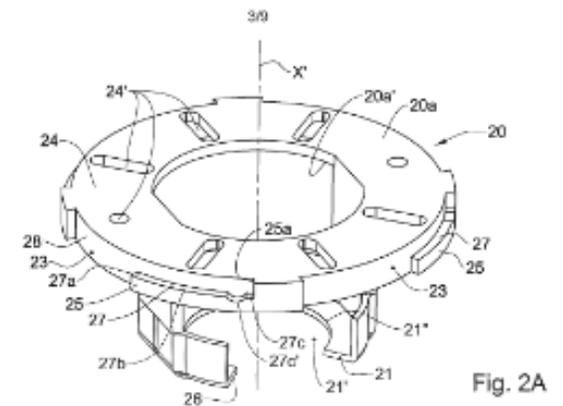


Fig. 2A

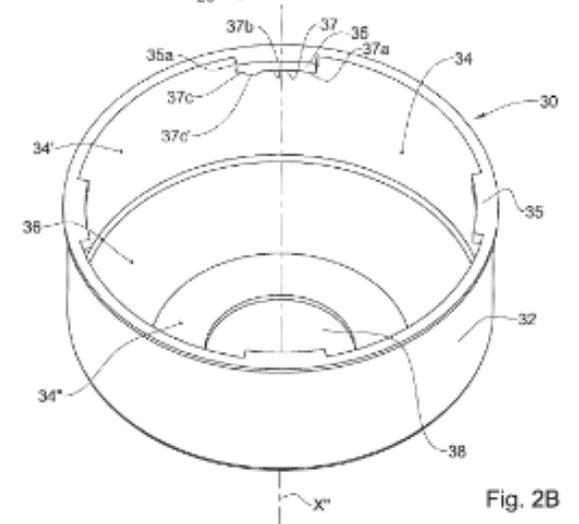


Fig. 2B



### 3 A.

Support for  
Divisionals and  
Continuations  
when the future  
is unknown and  
unpredictable

~~“SUMMARY OF THE INVENTION”~~



“GENERAL DESCRIPTION”  
(with two parts)

The **first part** of the general description is a **broader** version of the claims set. This provides literal support for all the combinations of the features to meet the requirements of the EP-like approach.



3 A.

Support for  
Divisionals and  
Continuations  
when the future  
is unknown and  
unpredictable

## Example:

Claim 1 is a combination of features A, B, C and D.

D is **the** distinguishing feature.

D' is an alternative wording for feature D.

E is a dependent claim and is also a feature that can be distinguishing without D, but we are not sure about it at the drafting stage.



# 3 A. Support for Divisionals and Continuations when the future is unknown and unpredictable

## GENERAL DESCRIPTION

*According to the presently disclosed subject matter, there is provided a system for ....., which can have **features A, B** and **C**. Such features will further be referred to as a **basic structure** of a system according to the presently disclosed subject matter.*

*According to one aspect of the presently disclosed subject matter, a system having the above basic structure can further have a **feature D**. Feature D can be constituted by .....*

*In other words, the system of the basic structure can further comprise a **feature D' (alternative wording for feature D)**, possibly for providing an alternative scope for the invention of D)....*

*According to a further aspect of the presently disclosed subject matter, which can be used in a system having the above basic structure or in a system according to the above aspect of the presently disclosed subject matter, the system can further comprise a **feature E**.*



# 3B. Support for Divisionals and Continuations planned in advance

The second part of the general description should include all the claims directed to all possible concepts which are included and not included in the final set of claims.

**This can serve two purposes:**

- To provides support in the future for **dependent claims** that have been cancelled at some stage
- In case of several inventions in the full claim set, the ready to be used claims are included in the application as filed



# 4. Support for broad interpretation of a claimed feature

Define claimed features as broad as possible to cover multiple design-around variations of your specific examples

**BUT**

Ensure they have **sufficient structural elaboration** in the description, for the features to be interpreted broadly

All possible structures, variations, and alternatives of this feature you can think of, should be clearly described in the specification



# 4. Support for broad interpretation of features

Prompt to ChatGTP:

**“A patent claim defines the feature “a mechanism for moving...”. Let me know what should I write in the specification for this term to be interpreted as broadly as possible.”**

Output:

*The term “a mechanism for moving” as used herein refers to any system, device, or structure capable of causing or enabling movement of [component] from one position to another. The mechanism is not limited to a specific form or type and may include any technology or system that achieves the desired movement, either directly or indirectly. In one embodiment, the mechanism may include mechanical systems **such as gears, pulleys, levers, or springs**. In another embodiment, it may include fluid-based systems such as **hydraulic or pneumatic actuators**. Electrical systems, including but not limited to motors, solenoids, or electromagnets, may also serve as the moving mechanism.*

*The specific nature, structure, or configuration of the moving mechanism is not critical to the present invention and may be adapted based on the requirements of the particular application. **The mechanism may involve various types of actuating forces, such as mechanical, electrical, hydraulic, or pneumatic forces, either independently or in combination**. For example, in certain embodiments, a motor-driven gear system may serve as the mechanism, while in other embodiments, a pneumatic piston system may perform the same function.*

*It is understood that the mechanism may take many different forms and is not limited to the specific examples provided herein. The examples are provided for illustrative purposes only and are not intended to limit the scope of the invention. Any mechanism capable of providing the required movement falls within the scope of this description. The term “mechanism for moving...” should be broadly construed to include any device or combination of devices that accomplish the intended movement, regardless of the specific components or technology employed.*



# 5. Support for clarifying technical effects

If a feature is related to any specific technical effect, that might have patentable weight, this technical effect should be elaborated, linked to the feature, and written in a language suitable to be claimed. It is correct for technical effects of both, claimed and non-claimed features.

# Thank you!

## Dima Litvak

Partner, Patent Attorney  
Head of the Technology, Mechanics  
& Designs Practice

[dilitvak@rcip.co.il](mailto:dilitvak@rcip.co.il)



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# Global Patent Drafting

Pete Sadler  
Reddie & Grose, United Kingdom



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# What I'll talk about...

Generally I'll be considering these from a computer implemented inventions/hi-tech point of view and also the use of AI tools to help us:

I'll look at:

- Considering language that you use
- Means plus Function language
- Claim formulations
- Some practical tips





# Be Bold!

- Use plain language.
- Use short sentences
- Avoid “clever”/obscure words





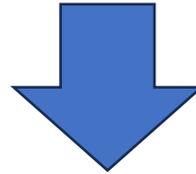




# Be Bold!

How about we rewrite this sentence?

*“The received inputs, or indicators, are assigned values of confidence; these values may be weighted according to how conclusive the indicator is that a programme was actually watched.”*



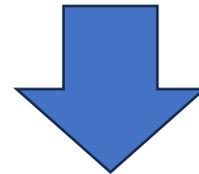
*“The received inputs are indicators. Each indicator is assigned a confidence value. These values are weighted. The weighting indicates how likely it is that a programme was actually watched by the user.”*



# Be Bold!

How about we see what an AI drafting tool makes of it?

*“The received inputs, or indicators, are assigned values of confidence; these values may be weighted according to how conclusive the indicator is that a programme was actually watched.”*



“Rewrite the highlighted sentence to make it clearer”

*“The system assigns confidence values to received inputs or indicators. These values represent how likely it is that a programme was watched. Some indicators may be given more weight than others. The weighting depends on how strongly the indicator suggests actual viewing occurred.”*



# Be Repetitive. Be Repetitive.

- Avoid relative reference to features like “which” or “thereof”, instead repeat the feature.

From claim 1 of the example - EP 2362644

*“receiving, at one or more inputs, transmitted data items and ID data identifying the transmitted data items and the series to which a transmitted data item belongs;”*

Perhaps better written as:

*“receiving, at one or more inputs, transmitted data items and ID data, **the ID data** identifying the transmitted data items and **the ID data** identifying the series that a transmitted data item belongs to;”*

Avoids potential mishaps during translation, avoids undesired interpretations.



# Be Mean?

What about “Means plus Function” language?

E.g. - “means for filtering a signal [according to a certain method]”  
- “means for sending data” and so on.

- EPO and JAPAN
  - broad interpretation generally applied.
- US
  - narrow interpretation generally applied based on patent description and equivalents.
  - Functional features should be named more appropriately and/or the structure of the means should be explicitly included in the claims.
- CHINA
  - Worst of both worlds! Broad interpretation by CNIPA, narrow interpretation by the Courts.
  - The CNIPA, looking at validity, can interpret “means plus function” style claims broadly, in line with the EPO approach. Courts looking at infringement can interpret closer to the US approach.



# Be Mean?

## Solution?

- Incorporate “means plus function” claim language into patent specifications at the drafting stage and make use of it in those jurisdictions where it is appropriate.
- The language can be included as numbered examples or clauses.
- At the same time fall back claims that include more specific features and accompanying structural limitations should also be included for those jurisdictions where “means plus function” language is not appropriate.



# BeWare (Software)...

Patentability and formal matters – what you can claim.





# Software Claim Formations

EPO – pretty permissive over what you can claim, e.g.:

## **(i) Method claim (claim 1)**

- A computer-implemented method comprising steps A, B, ...
- A method carried out by a computer comprising steps A, B, ...

## **(ii) Apparatus/device/system claim (claim 2)**

- A data processing apparatus/device/system comprising means for carrying out [the steps of] the method of claim 1.

## **(iii) Computer program [product] claim (claim 3)**

- A computer program [product] comprising instructions which, when the program is executed by a computer, cause the computer to carry out [the steps of] the method of claim 1.
- A computer program [product] comprising instructions which, when the program is executed by a computer, cause the computer to carry out steps A, B, ....

## **(iv) Computer-readable [storage] medium/data carrier claim (claim 4)**

- A computer-readable [storage] medium comprising instructions which, when executed by a computer, cause the computer to carry out [the steps of] the method of claim 1.
- A computer-readable [storage] medium comprising instructions which, when executed by a computer, cause the computer to carry out steps A, B, ...
- A computer-readable data carrier having stored thereon the computer program [product] of claim 3.
- A data carrier signal carrying the computer program [product] of claim 3.



# Software Claim Formations

Consider also the following for the EPO:

**v) Signals** – “A colour television signal adapted to generate a picture with an aspect ratio of greater than 4:3, and in which the active-video portion of a line constitutes at least 85% and preferably 90% of the line period.”

**vi) Data Structures or message structures** – “An electronic message comprising: a plurality of messaging elements, at least one of the messaging elements being associated with at least a portion of the content of the message and at least one of the messaging elements comprising instructions that define a structure of the message; etc etc.”



# Software Claim Formations

## FROM THE EXAMPLE EPO APPLICATION



1. A method of recording transmitted data items comprising the steps of:

.....

9. Apparatus for recording transmitted data items comprising:

.....

19. A computer readable medium having computer code stored therein, wherein the computer code when executed on an apparatus according to claims 9-18 causes the apparatus to carry out the method of any of claims 1-8.

**What else could have been claimed?**



# Software Claim Formations

## FROM THE CORRESPONDING US PATENT

1. A method of recording transmitted data items comprising:

.....

9. An apparatus for recording transmitted programmes comprising:

.....

15. An apparatus for recording transmitted programmes comprising:

And from a continuation:

20. A **non-transitory** computer-readable medium that includes code that is configured, when executed by a processor, to cause the processor to provide access to transmitted programmes by performing a method comprising:



# Software Claim Formations



## WHAT ABOUT OTHER JURISDICTIONS?

- **China** – adopt a similar approach to the EPO and now (since Jan 2024) specifically permit claims to:
  - a computer-readable storage media
  - a computer program productBut not to
  - A “data structure” or “signal”.
  
- **Japan** – also similar to EPO – you can generally get claims to
  - A program for causing a computer to execute certain steps
  - A computer readable recording medium
  - A data structure



## Lots of different claim formulations – can we make things easier?

FROM THE EXAMPLE EPO PATENT

1. A method of recording transmitted data items comprising the steps of:
  - receiving, at one or more inputs, transmitted data items and ID data identifying the transmitted data items and the series to which a transmitted data item belongs;
  - receiving, at an input interface, input indicating whether one or more received transmitted data items have been viewed or recorded by a user;
  - generating values for ranking the series to which each of the received data items belong based upon the received input;
  - storing subsequently received transmitted data items in a storage device based on the generated values, the stored data items belonging to a series for which a value has been generated.

- I asked the AI *“Take the highlighted claim and draft an independent apparatus claim and a software claim”*



# AI use:

Result:

An apparatus for recording transmitted data items, comprising:

- a receiver configured to receive transmitted data items and ID data identifying the transmitted data items and the series to which a transmitted data item belongs;
- an input interface configured to receive input indicating whether one or more received transmitted data items have been viewed or recorded by a user;
- a processor configured to generate values for ranking the series to which each of the received data items belong based upon the received input; and
- a storage device configured to store subsequently received transmitted data items based on the generated values, the stored data items belonging to a series for which a value has been generated.



# AI use:

Result:

A non-transitory computer-readable storage medium storing instructions that, when executed by a processor, cause the processor to perform a method for recording transmitted data items, the method comprising:

- receiving transmitted data items and ID data identifying the transmitted data items and the series to which a transmitted data item belongs;

- receiving input indicating whether one or more received transmitted data items have been viewed or recorded by a user;

- generating values for ranking the series to which each of the received data items belong based upon the received input; and

- storing subsequently received transmitted data items in a storage device based on the generated values, the stored data items belonging to a series for which a value has been generated.



# Be Independent (but not too independent)

Multiple independent claims in the same category as in the US?

- **EPO** – only when the invention meets certain criteria. You can't have multiple independent claims to the same entity with slightly different/overlapping scopes.
  - if the subject-matter of the application involves one of the following (a) a plurality of interrelated products; (b) different uses of a product or apparatus or (c) alternative solutions to a particular problem, where it is inappropriate to cover these alternatives by a simple claim
- **China** – similar to the EPO – one independent claim per category (unless the usual exceptions apply).
- **JPO** – doesn't seem to have a problem with multiple independent claims.
- **Korea** - also don't seem to have a problem with multiple independent claims.



# Some General Tips...

## Technical Field:

- Keep it brief and no more limited than the preamble of claim 1.

## Background:

- Keep it brief and generic for the technical field.
- Do not identify any specific documents.
- Do not use the background to frame a technical problem – if necessary or helpful for jurisdictions other than the US, use the detailed description.



# Some General Tips...

## Advantages/Technical Effect:

- Avoid putting advantages and effects in the summary. It opens up arguments for third parties that the claims are so limited.
- Advantages/effects can go into the detailed description, but should not be identified as, e.g., “preferable”. Use “may” and/or put them at the end of the description.

## Basis & Support

- Use multiple dependencies! If not in the claims, then as numbered clauses in the Summary or at the end of the description.
- Ideally, the Summary should be omitted or nothing more than a copy and paste of the claims! If you want to add, e.g., explainers/clarifications to the Summary, put “optionally” [or similar] beforehand.



# Some General Tips...

## MISC

- Two-part form – avoid it. Add if you really have to. But be prepared to do so - anticipate that you will have to include it in some jurisdictions, such that the claim can be rewritten without major amendments.
- Reference numerals in claims? Leave them out initially – add later in jurisdictions where you have to (EPO)
- Include support for multiple independent claims? Ideally yes, but consider budget and complexity.
- Avoid “patent profanity” (“the invention”, “essential”, “preferred”, “convenient” etc.)
- When referring to figures, use “FIG.” or “FIGS.” throughout. Most jurisdictions don’t care but I’m told the USPTO will only publish “FIG.” – avoids formal objections/additional costs from US attorneys.
- In the “Brief Description of the Drawings”, don’t group any figures together – avoids formal objections/additional costs from US attorneys.



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- **Stanford, Andrew John**  
**Baildon**  
**West Yorkshire BD17 6AP (GB)**
- **Hey, Andrew**  
**Steeton, Keighley**  
**West Yorkshire BD20 6SZ (GB)**

(71) Applicant: **Eldon Technology Limited**  
**Steeton, Keighley BD20 6QW (GB)**

(74) Representative: **Sadler, Peter Frederick**  
**Reddie & Grose**  
**16 Theobalds Road**  
**London WC1X 8PL (GB)**



(72) Inventors:  
• **Thompson, Geoff**  
**Steeton, Keighley**  
**West Yorkshire BD20 6SU (GB)**

(54) **Recording system**



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Dima Litvak

Reinhold Cohn Group, Israel



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# Drafting without borders



Questions?



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## Patents that work everywhere: Litigation

Patricia Koch  
Balder IP, Spain



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# Patents that work everywhere Litigation

FICPI 22nd Open Forum

**BALDER**

## The patent was drafted and granted – What now?

The drafting work has finished.

With my co-panelists' tips we have a patent useful throughout the world.

If there was a problem with the drafting the Patent Office should have solved it.

So everything is in place for using the patent?

# Harmonization

*Are we advancing?*

- *Paris Convention*
- *TRIPS Agreement*
- *Patent Law Treaty*
- *Failed attempt at Substantive Patent Law Treaty*

*No Patent Directive in the EU (though we do have them for biotechnological inventions)*

*Directive for computer implemented inventions rejected*

*Patent Regulation led to Enhanced Cooperation*

*European Patent Judges' Symposiums (biennial)*

## Description / Drawings

Always helpful?

How far do they influence the interpretation of claims?

Language issues (translations, same word for same feature)

Problem to be solved

# Equivalence

Results vary greatly from one jurisdiction to another

What about file wrapper estoppel

# International Litigation

Will there be an impact of the arguments made in one country in another jurisdiction.

Timings.

Cross impact of Court decisions.

Timing.

Damages.



# BALDER

**Patricia Koch**

[pkoch@balderip.com](mailto:pkoch@balderip.com)

T: +34 911 336 803

Paseo de la Castellana 93  
28046 Madrid | Spain

[www.balderip.com](http://www.balderip.com)



# FICPI // Events 2025



FICPI Korean Symposium  
2-5 April 2025  
Jeju Island, Republic of Korea



FICPI World Congress & ExCo Meeting  
12-18 October 2025  
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