



# Patent Drafting and the Litigator's Approach

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# Topics for Today

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- The litigator's v draughtsman's focus
- Maximising acts of infringement
  - exploiting 3 aspects infringement law when drafting
- Real-world examples of claiming issues
- Selecting the Technical Field



# Draughtsman's Initial Focus

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- What's the invention?
- What's the point of novelty
- What's the inventive step
- What can I claim?
- What's the broadest claim I can get



# Litigator's Initial Focus

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- What act is the potential defendant performing?
- In what jurisdiction?
- Is it prohibited by the laws of infringement?
- Is it in relation to a product or process within the scope of the claim?



# The Bifurcated European Patent System

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- EPC does not contain infringement law
- Infringing acts defined in national laws
  - Based upon the Community Patent Convention of 1975
    - CPC Article 25 - “direct” infringement
    - CPC Article 26 - “indirect” infringement
    - CPC Articles 27 & 28 - non-infringing acts
  - Similar in all EPC contracting states



# Direct Infringement of Product Claim

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- The acts, within the country of the patent, of
  - making, offering, putting on the market, using, importing or stocking **claimed product** for these purposes



# Direct Infringement of Process claim

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- The acts, within the country of the patent, of:
  - using the process
  - offering process if known or obvious that use would be infringement
  - offering, putting on market, using, importing or stocking direct product of claimed process



# Indirect Infringement

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- Supplying or offering to supply
  - “means relating to an essential element” of the claimed invention
  - for the purpose of putting invention into effect within the country covered by the patent
- The act of “supplying” or “offering” must be within the country of patent





# Examples

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- Claiming the wrong product
  - Windsurfer
  - RDS radio
  - Network inventions
- Claiming the wrong process
  - CD manufacturing invention
  - (and how to claim the right process)
- Exploiting indirect infringement



# The Windsurfer Problem

## The licensing position

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- The windsurfer company had numerous licensing agreements in which, amongst other things,
  - They claimed royalties on surfboards sold alone for use with rigs
  - They attempted to control where surfboards could be manufactured
- Complaint to EU that these (amongst other things) were anti-competitive practices



# The Windsurfer Problem

## The patent position

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- The UK patent only claimed complete product comprising board plus rig
  - At the time no indirect infringement law in UK
- The German patent only claimed the rig for use with a sailboard
  - Although German law included indirect infringement, German court had held that supply of sailboards for use in combination with rig was not indirect infringement because no claim to the rig/sailboard combination.
- Surfboard was novel
  - Included socket for universal joint
  - Could have been claimed



# The Windsurfer Problem

## The Commission's Decision (11 July 83)

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- Since surfboard was not protected by the patent, it was an anti-competitive practice
  - to claim royalties on sales of it, and
  - to try to control where it could be manufactured
- Windsurfer were required to change their licences and pay a substantial fine

# Avoiding These Problems

Complementary licensing/patenting/product design strategies

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- Draft patent to support licensing strategy
- If different components marketed or licensed separately,
  - Design product so that substantial novelty in high-volume/value components
    - e.g. attach universal joint to windsurfer board
  - Independently claim high-volume/value components



# The RDS Radio Problem

(German Supreme Court, March 24, 1987)

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- German patent
  - Claim to “Transmission system . . . . .
  - No claim to radio receiver
  - No claim to network of transmitter and receivers
- Infringement action against importer and seller of receivers having RDS decoders
  - Failed
  - No direct or indirect infringement
- No protection for most important commercial product: receivers

# Network inventions

## Example 1

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- Online gambling system
  - *Menashe-v-William Hill [2003] RPC 31*
- Only network claims
  - Defendant's server in Caribbean
  - Supplying software to UK gamblers enabling PCs to interact with server
- Indirect infringement
  - because network "used" in jurisdiction

# Network inventions

## Example 2

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- Mobile telecoms
  - *Rim-v-Motorola [2010] EWHC 1294 (Pat)*
- Only server claims
  - Defendant's server in Canada
  - Mobile phones in UK interact with server
- No infringement
  - because **no part of claim in jurisdiction**





# Protecting Product of Process

UK Case Law 1995 RPC 487

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- Pioneer brought UK infringement action against importer of CDs made from master made by patented process
  - Only claims to process of making master
  - No claims to making CD from master
- Action struck out
  - CD not **direct** product of claimed process
- To avoid problem
  - disclose and claim complete process

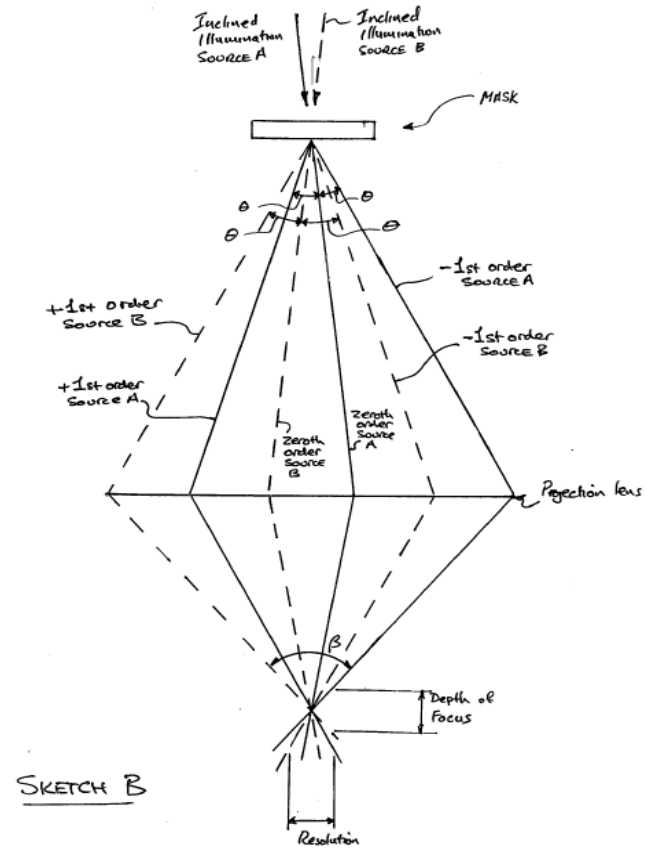
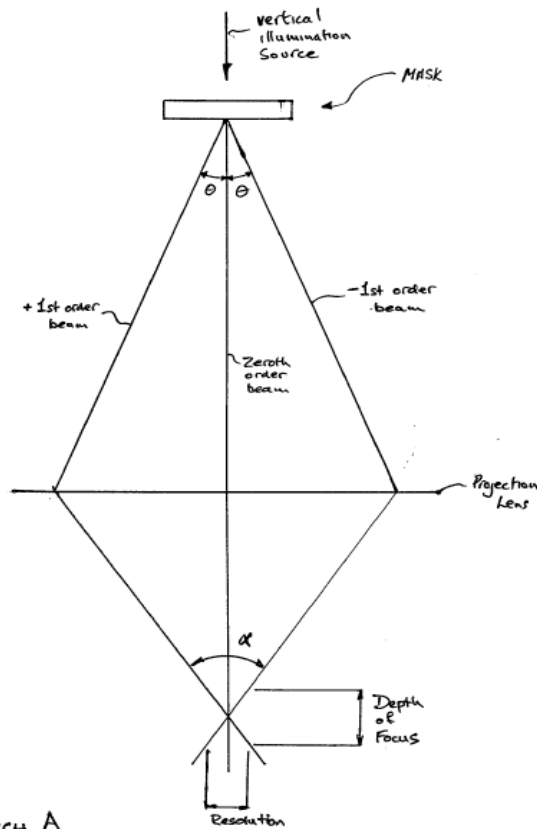
# Inventions in Apparatus for IC Manufacture



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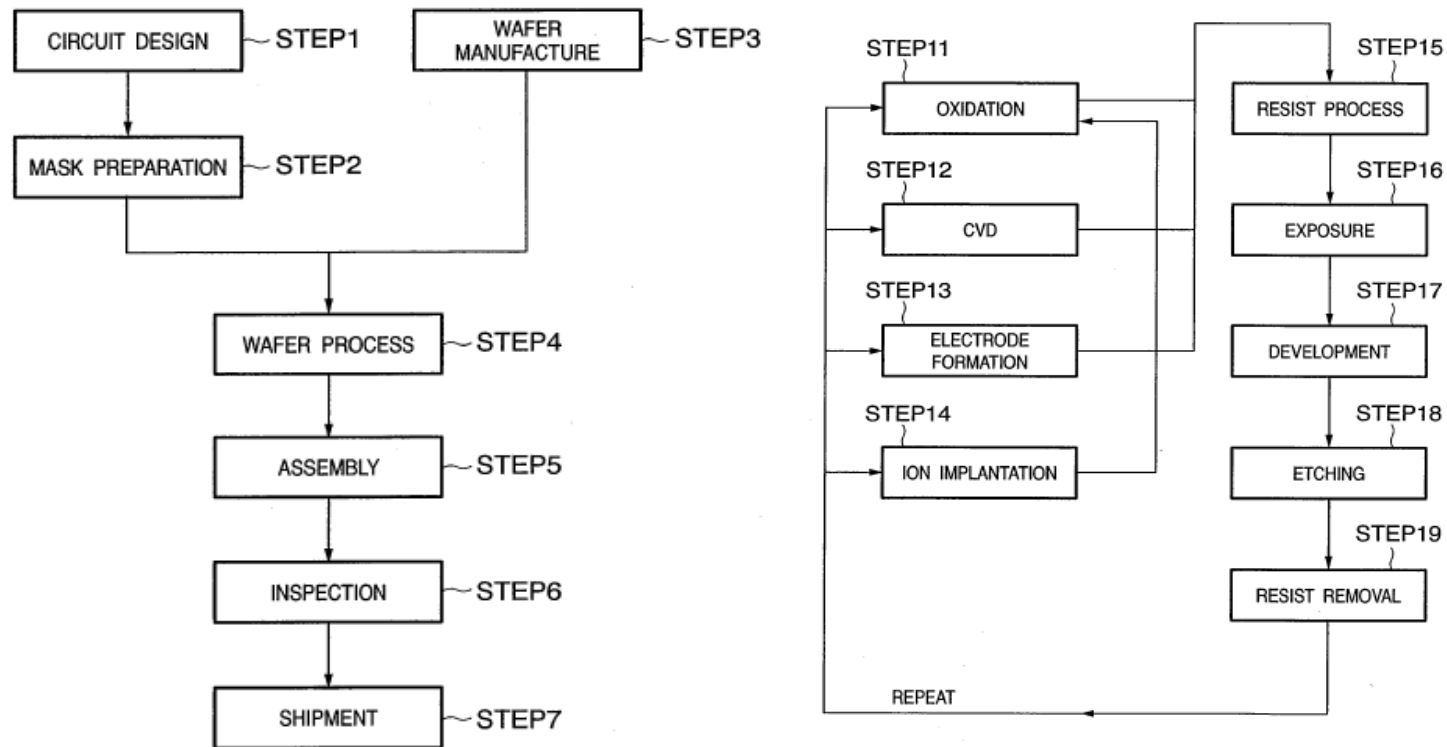
- Many inventions in exposure apparatus
  - Direct product of exposure step is exposed photoresist layer
  - Claim to exposure process would not protect IC
- For maximum value, need claims to
  - Exposure apparatus
  - Exposure method
  - Method of making IC utilising exposure method
    - Protects IC
    - But needs supporting description

# IC Manufacture Example Exposure Process Diagram



# ... (Example Continued)

## Flow Chart of Complete Process





# . . . (Example Continued)

## Claim to exposure process

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1. A method of forming an image of a fine pattern having linear features extending in orthogonal first and second directions, ... wherein... **the intensity distribution of the light source, the fine pattern and the optical system ... arranged so that said linear features produce diffracted light ... of which only light of zero order and of one of the first orders passes through the pupil for the formation of said image of said fine pattern.**



## . . . (Example Continued)

Claim to process of making IC

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2. **A microdevice manufacturing method**, including a step of printing a device pattern on a workpiece using a method of forming an image as defined in claim 1, and **processing said workpiece in at least one further step to produce a microdevice from the printed workpiece.**



# Bioprocessing Plant Design

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## Claim 1

A method for **deriving values defining design and/or operating parameters** for at least one stage of a multiple stage. . . . bioprocess for obtaining a product from a biomaterial, comprising the steps of . . . . .(design process steps specified).



# . . . . . Bioprocessing Example Continued

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## Claim 15

A method of producing a product comprising the steps of  
generating operating parameters according to the method of any one of the preceding claims and operating a multiple stage industrial scale bioprocess in accordance with the operating parameters thus obtained to produce said product.





# Exploiting the law of indirect infringement

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- Claim to A + B + C
  - Three potential acts of indirect infringement
- Claim to A + B + C + D
  - Four potential acts of indirect infringement
- Supplying component not recited in claim cannot be indirect infringement
- If component staple commercial product, supply must be for inducing infringement



# Analysis Process

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- What is the inventive concept
  - **What technical field**
- What products/processes will embody it
- What claims are needed *under the law of infringement*
- What description is needed to support those claims



# Importance of selecting technical field

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- Determines field within which inventive step is to be judged
- Technical field is defined by the first few words of the claim
- Also determines qualifications and experience of suitable expert witness



# Example of selecting technical field

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- Invention:
  - Anglepoise lamp in which balance improved by spring of novel structure
- Claim 1 directed to spring
  - Field of claimed invention is springs
  - In litigation, expert witness is spring expert
- Claim 1 directed to Anglepoise lamp
  - Field of claimed invention is Anglepoise lamps
  - Expert witness is expert in Anglepoise lamps



# THAT'S IT

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