

EGY RENDHAGYÓ IGÉNYPONT ÉS GYAKORLATI VESZÉLYEI (OMNIBUS CLAIM)



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magyar és európai szabadalmi ügyvivő

Jedlik Ányos-díjas

Iroda: 1014 BP., Móra F. u. 1.

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WHERE TO USE?

- UK *****
- EPO *
- US *
- JP *
- NZ *****
- AU *****
- SA *****

EPO



Art. 84 EP C: 'The claims shall define the matter for which protection is sought. They shall be clear and concise and be supported by the description.'

Rule 43 (6): '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".'

The onus is upon the applicant to show that it is "absolutely necessary" in appropriate cases (see T 150/82).

Exceptions:

Example 1: the invention involves some peculiar shape, illustrated in the drawings, but which cannot be readily defined either in words or by a simple mathematical formula.

Example 2: the invention relates to chemical products some of whose features can be defined only by means of graphs or diagrams.

Example of claim 1 of a current (pending) application:

- "1. A process for the production of the respective fine chemical, which comprises
- (a) increasing or generating the activity of a protein as indicated in Table II, columns 5 or 7, or a functional equivalent thereof in a non-human organism, or in one or more parts thereof; and
 - (b) growing the organism under conditions which permit the production of the respective fine chemical in said organism."

NOTE: Table II lists 641 protein SEQ ID's (and homologs) and extends over 580 pages of specification!

USA



35 USC 112 (2):

- “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.”
- Omnibus claims are considered indefinite as they rely on external material. Moreover, the claims and description are separate statutory requirements, and claims must be self-contained.
- MPEP 1302.04(b); 2173.05(r)
- see *Ex parte Fressola*, 27 USPQ2d 1608 (Bd. App. & Inter. 1993)

USA

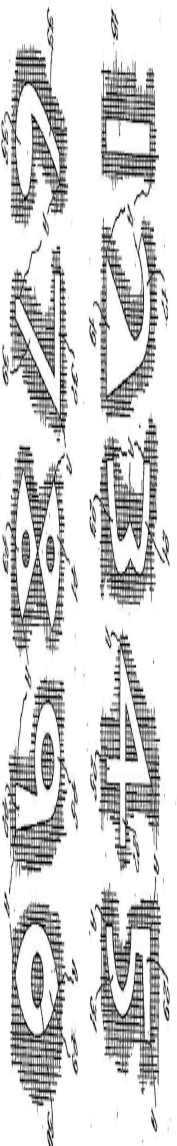


Exceptional Case: Ex parte Squires 133 USPQ 598 (1961)

A találmány úgy tökéletesítette a digitális kijelzések olvashatóságát, hogy azok jól felismerhetők voltak vörös fényben, rossz látási viszonyoknál, pl. tengeralattjárók periszkópjában

1 claim:

1. A font of numerals as shown in FIG. 1.
2. In an environment of low brightness of red light, a font of numerals as shown in FIG. 1.



OLTALMI KÖRRE?



[Raleigh-case] Lord Morton (UK):

- “.....surely more likely that the last claim, referring to the drawings, is intended to be a narrow claim, incorporating the drawings as part of the description, if all wider claims are to be held bad”
 - “substantially as described herein” insufficient by themselves to limit a claim to the embodiment described, and the scope will be construed to be as wide as the statement of invention”
 - “omnibus claims can be broader than the main claim 1 providing they are independent”
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QUESTION?



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