Teaching Patent Drafting: A practitioner’s perspective

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Introduction

• Personal experience and background
• What we do
• How we learn
• Exams
Formalising the teaching

• Teaching the unteachable
  – How do I do it?
  – I can do it – don’t know how.
  – Why can’t you do it?

• Can drafting be taught?

• To geeks?
Three step approach

1. Demystify
   Who do we have to please
   Legal background simpler than it looks
   Few constraints, really

2. Create framework
   Simple set of rules and tests

3. Apply practically
   The cheesegrater
Demystify

Who might look at the patent?
- The Patent Office (validity)
- The Judge (validity and/or infringement)
- The infringer (infringement)
- The researcher (information)
- The investor (pretty pictures)

The balance
- Validity - legal; infringement - commercial

The Patent Office
- Not patentable
- Insufficient
- Claims not clear/concise...
- Lack of unity
- Claims not supported
- Added matter...
- Formal matters

The infringer
- Scope of monopoly - s60
  - Infringing acts
    - What acts might your competitor do?
  - Contributory infringement
    - In relation to what products?
- Extent of protection - s125
  - Claims
  - Construction...
- Remedies
- Territorial
Create Framework - Description

- **Structure** – Suff, a/m
- **Operation** – Suff, a/m
- **Fabrication** - Suff
- **Advantages** – Claim check
- **Variants** – Claim check, support
Create Framework - Claims

• Spot invention
  Pub test

• Identify novel feature (validity)

• Choose main category (infringement)

• Name claim (infringement)

• Add other features/interaction (validity)
  Pass pub test

• Never lose sight of advantage
Create Framework - Crosscheck

• Infringement check
  – limiting words or features
  – claim what is made/sold
  – claim on the shelf (clarity, scope)

• Validity check
  – novel – prior art/everything
  – check Inventive Step argument
  – check free beer (clarity)
Apply Practically
Apply Practically

• Not novel over known prior art
  – A cheese grater comprising a grating portion and means for moving the grating portion relative to cheese.

• Reads onto something ridiculous
  – Food manipulation means comprising first and second elements movable relative to one another to manipulate food.
  – Knife and fork

• Inventive step argument doesn’t work
  – A cheesegrater including first and second portions movable relative to one another
Success?

• Cannot confer intuition
• Can provide confidence
• And boundaries
• Maybe their trainees will benefit