

Section 39: Contents of complete specification

(1) Every complete specification must—

- (a) disclose the invention in a manner that is clear enough and complete enough for the invention to be performed by a person skilled in the art; and
- (b) disclose the best method of performing the invention that is known to the applicant and for which there is an entitlement to claim protection; and
- (c) end with a claim or claims defining the scope of the invention claimed; and
- (d) include any other prescribed information.

(2) The claim or claims must—

- (a) relate to one invention only; and
- (b) be clear and concise; and
- (c) be supported by the matter disclosed in the complete specification.

(3) A complete specification filed after a provisional specification, or filed with a convention application, may include claims concerning developments of, or additions to, the invention that was described in the provisional specification or the basic application (as the case may be) if those developments or additions are developments or additions for which the nominated person would be entitled to the grant of a separate patent under this Act.

(4) If a complete specification claims a new substance, the claim must not be construed as extending to that substance when found in nature

The complete specification - general

1. For an invention to be patentable it must be novel over what is already known from the prior art base. Assessment of novelty of a claimed invention is based on whether all of the features of that claim are known from a single prior art document, see for example *Ammonia's Application*, 49 RPC 409. A mosaic of more than one document to find lack of novelty is not permissible, see for example *British Ore Concentration Syndicate v Mineral Separation Ltd*, 26 RPC 124 at page 147, and *Lowndes' Patent* 45 RPC 48 at page 57. Where it appears that a combination of more than one document would anticipate a claimed invention, then it is possible that these documents could be combined to find a lack of inventiveness i.e. the invention is obvious.

2. The complete specification should be the applicant's most complete attempt at describing and defining the invention to allow the grant of a patent, as adding missing materials after the filing date may lead to a loss of priority date of the amended specification. The complete specification should generally be a self-contained document with respect to the invention. The specification must include a title of the invention, followed by a description of the invention. The complete specification should include a description of the invention, contain at least one claim and any drawings required to illustrate the invention or other related matters.

3. The claims form part of the specification when filed with the specification at the same time as the application filing date. The subject matter found in the claims but not the description may be used to support the invention. Typically the subject matter which is found only in the claims will be required to be moved into the description to provide support for the claimed subject matter.

4. The purpose of the description is to disclose the invention clearly and completely enough to allow it to be performed by a person skilled in the art, and to provide support for the claimed invention. Where the description includes a consistency clause or other statement (of invention), then the clause or statement should be consistent with the claimed invention. The specification should not be excessively long or contain material which is not required in aiding understanding of the invention (*Francis' Application*, 27 RPC 87).

Clear enough and complete enough disclosure

5. The complete specification must disclose the invention so that a person skilled in the art would be able to work the invention.

6. The disclosure of the specification must be clear enough and complete enough to enable the person skilled in the art to perform the invention across the entire width of the claimed invention. The disclosure must be an enabling disclosure as in *Asahi's Application* [1991] RPC 485 HL and *Biogen v Medeva* [1997] RPC 1 HL.

7. The test for clear enough and complete enough disclosure was set out in *Kirin-Amgen v Hoechst Marion Roussel Ltd* [2005] RPC 9 as 'first identify the invention and decide what it claims to enable the person skilled in the art to do. Then one can ask whether the specification enables them to do it.'.

8. Claims may be directed to a single product or method, or encompass many separate methods or products. The disclosure should be sufficiently clear enough and complete enough for the person skilled in the art to perform the invention across the entire width of the claimed invention.

9. The specification should normally contain at least one example or method of performing the invention. Enabling disclosure is assessed during examination and is based on the specification at the filing date of the specification (*Biogen*) and not at a later date.

10. A single example may not be enough to provide an enabling disclosure across the entire width of the claimed invention. A single example of a method of producing a single product may be sufficient only to enable the person skilled in the art to work the invention for that product only. In *Generics (UK) Limited and others v H Lundbeck A/S* [2009] UKHL 12, [2009] RPC 13, a single product produced by a single method was sufficient to enable the full width of the invention with respect to that product. The specification in other cases may be required to disclose further examples or methods to support the invention across the entire width of the claimed invention.

11. It was noted in *Novartis AG v Johnson & Johnson* [2010] EWCA Civ 1039 that some non-inventive trial and error by a person skilled in the art is acceptable to determine what would or would not succeed for the invention to be performed as claimed. However, the specification must disclose all

of the essential features of the invention and in enough detail for the person skilled in the art to put the invention into effect. In *Edison and Swan Electric Light Co v Holland*, 6 RPC at page 282 it was noted that if to work the invention that something new must be added by the person of reasonably competent skill, then the specification was not sufficient (not enabling).

Best method

12. The complete specification must include the best method of performing the invention known by the applicant at the time of filing of the application. The assessment of whether or not the applicant has included the best method in the specification can usually only be based upon facts known to the applicant, which are not generally available to the examiner at the time of examination.

13. There is no requirement for the specification to include the words 'best method' or any other such phrase. It is sufficient that the applicant has included a method of working the invention in the specification.

End with a claim or claims

14. Claims form part of the specification and must define the monopoly sought, *AMP v Utilux* (1974) 48 ALJR 17. The claims should be read with the specification as a whole and there should be consistency between the claimed invention and the description.

Relate to one invention only

~~15. The Act does not set out any test for determining whether or not the claims recite one or more inventions. Unity should be assessed using the disclosure of the specification to set the context of the claimed subject matter.~~

~~16. Typically, claims are unified where they share common novel subject matter or share special technical features as per PCT rule 13.2. Special technical features are those features in claims which define a contribution over the prior art. A lack of unity may be found within the claim set as a whole, or within individual claims which for example recite alternatives not sharing common novel subject matter.~~

15. The Act does not set out any test for determining whether the claims relate to one or more inventions. In general, the approach followed to determine whether there is more than one invention claimed is the same as for 'Unity of Invention' under Rule 13 of the PCT Regulations.

Rule 13, Regulations under the PCT – World Intellectual Property Organization

16. The examiners should assess unity according to the PCT International Search and Preliminary Examination Guidelines [Part III] Chapter 10 and the PCT Administrative Instructions Annex B.

Chapter 10, PCT International Search and Preliminary Examination Guidelines [Part III] – World Intellectual Property Organization

Annex B, Administrative Instructions under the PCT – World Intellectual Property Organization

17. When raising a non-unity objection, the examiner should clearly identify all separate inventions with corresponding claim numbers and provide a brief summary of each invention in the examination report. If it is impractical to list all different inventions, the examiner should advise the applicant accordingly.

Special technical features

18. For there to be unity of invention, claimed inventions need to be linked by a single general inventive concept. Claims are unified when there is a technical relationship among those claimed inventions involving the same or corresponding special technical feature as per PCT Rule 13.2. Special technical features are those features in claims which define a contribution over the prior art.

19. Unity exists between claims of different categories when a special technical feature is shared among the claims. The allowable combinations of claims of different categories are listed in paragraph 10.12 of PCT International Search and Preliminary Examination Guidelines.

20. Unity also exists between claims of related articles in the same category when the special technical features of the claims correspond to each other, such as a transmitter and a receiver in a communication system.

Paragraph 10.12, PCT International Search and Preliminary Examination Guidelines [Part III] – World Intellectual Property Organization

Unity “a priori” or “a posteriori”

21. Unity of invention is assessed “a priori” or “a posteriori”.

22. Lack of unity a priori, before the prior art has been examined, can be determined if the subject matter of the claims in question is completely different with no common features. Alternatively, a priori lack of unity can be determined if the common subject matter of the claims in question is clearly known, i.e. common general knowledge.

23. Examples of lack of unity a priori:

Claim 1: Features A+B

Claim 2: Features C+D

Claims 1 and 2 lack unity a priori because they have no common features.

OR

Claim 1: Features A+B

Claim 2: Features A+C

If feature A is common general knowledge, then claims 1 and 2 lack unity a priori.

24. A posteriori lack of unity assessment requires a prior art document (not necessarily the closest prior art document).

25. If every common feature to all claims is known or obvious from the prior art document, then the claims lack unity a posteriori. A common feature which is not known and not obvious makes a contribution over the prior art, and therefore constitutes a special technical feature for uniting the claims.

26. Example of lack of unity a posteriori in independent claims:

Claim 1: Features A + B

Claim 2: Features A + C

If feature A is known or obvious from a prior art document, then claims 1 and 2 may lack unity a posteriori.

27. If all the features of an independent claim are known or obvious, then lack of unity a posteriori may exist between the dependent claims if there is no same or corresponding special technical feature among them.

28. Example of lack of unity a posteriori in dependent claims:

Claim 1: Feature A

Claim 2: dependant on claim 1 with additional Feature B

Claim 3: dependant on claim 1 with additional Feature C

If the feature A of independent claim 1 is known or obvious from a prior art document, then claims 2 and 3 may lack of unity a posteriori.

29. Although lack of unity of invention should certainly be raised in clear cases, it should neither be raised nor persisted in on the basis of a narrow, literal or academic approach. The examiner should decide the unity of the claims on the balance of probability.

Markush practice

30. A Markush claim is a single claim defining alternatives, which may be chemical or non-chemical.

31. Markush alternatives meet the requirement of a shared special technical feature when the alternatives are "of a similar nature".

32. When the Markush claim is to chemical compounds, the alternatives are of a similar nature when they all have a common property or activity, and either share a significant structural element or belong to a recognized class of compound.

33. A “significant structural element” is either a large portion of the structure, or a smaller but structurally distinct portion, essential for the common property. If the significant structural element is a large portion of the structure, it does not necessarily have to be novel.

34. A “recognized class of compound” means that each member of the class is expected to behave in the same way in the context of the claimed invention. Each member could be substituted for the other(s) and achieve the same intended result.

35. The criteria that alternatives be “of a similar nature” (have a common property or activity, and a shared significant structural element) may also be applied to claims to nucleotides, peptides, and proteins. See the discussion under examples 30 and 35-39 of the PCT Guidelines – Part III Ch 10.

Examples 30 and 35-39, Chapter 10, PCT International Search and Preliminary Examination Guidelines [Part III] – World Intellectual Property Organization

36. For Markush claims to chemical compounds, the existence of a compound or compounds falling within the scope of a claim will not necessarily result in a unity objection. The Markush alternatives may well still fulfil the requirements for “similar nature” noted above. In such cases, the anticipatory compound(s) may be addressed under novelty.

International reports

37. The examiner should review the international reports when examining a PCT application which has entered national phase in New Zealand. These reports are the International Search Report (ISR) and International Preliminary Report on Patentability (IPRP) Chapter I and/or II. Because IPONZ follows the PCT Guidelines on unity, the examiner will tend to take the same position on unity as the international authority.

38. However, the examiner may raise a unity objection, despite no objection by the international authority, if the claims clearly lack unity in view of the documents available. For example: if there are independent claims to A+B, B+C, and A+C.

39. Similarly, the examiner may not object to unity, despite a unity objection by the international authority, if it is considered that an error has been made and the claims clearly relate to a single invention. For example: if the independent claims are to A+B and A+C, and feature A is novel and inventive over the cited art.

Assessing prior art

40. Unity is assessed in view of the prior art base as defined in section 8(1) only: art published or made available before the priority date of the claims.

Section 8(1) of the Patents Act 2013 – New Zealand Legislation

Restricting examination

41. Where lack of unity has been identified, the examiner will only search the first numbered invention, unless it is possible to search the other inventions without substantial additional time or effort.

42. The examiner should appropriately advise the extent of searching and examination conducted in the examination report.

Clear and concise Clear and concise

1743. Section 39(2)(b) requires that the claim or claims must be clear and concise (compare with UK 1977 Act section 14(5)(b)). The claims should be written in such a way that a person skilled in the relevant art would know clearly and unambiguously what the scope of the monopoly is and what to avoid.

General clarity General clarity

1844. The scope of a claim should be clear when looking at each claim separately and when looking at the claim set as a whole. There should not be any contradictions within a claim or between claims. If a feature is set at a specific value then later on it cannot be said to be a different value.

1945. Sufficiency of the disclosure (section 39(2)(c)) relates to the scope of the disclosure and whether it supports the scope of the claimed invention. This has been referred to as 'Biogen insufficiency', after the case noted above. Whereas enabling disclosure relates to whether or not the disclosure would enable the person skilled in the art to perform the invention.

2046. Terms of a vague, relative or subjective nature should not be used if they create doubt as to the scope of the claim. For example "high", "small", "hot", "pure" can in some cases be unclear. A "high" temperature can vary greatly even within the same art. In these cases, it is better for the applicant to be clear in what they mean by adding measurable features. The term is allowable without further clarification if it has a distinct and accepted meaning in the art such as "high-frequency amplifier". The exact frequency range would not need to be stated in this instance.

2147. Terms that deal with the position of features such as "inside", "end", "above", "upwardly" should be considered as to whether they are clear. Relative terms are allowable if the point of reference is implicitly or explicitly clear and if the scope of the claim is measurable.

2248. The question as to whether such terms as "back", "front", "above", "upwardly", are allowable or whether they introduce uncertainty into the claim, must be decided upon the facts of the case. Particular care is needed when for example the location of a feature of the invention is defined by reference to apparatus not forming part of the invention claimed or even by reference to a person using the invention.

2349. The scope of a claim should not be variable over time. It needs to represent a set monopoly that is being claimed that a reader will be able to ascertain. Claims referring to documents, especially to a claim of another patent document are generally not allowed, as it may be altered, and would not stake out an immovable boundary. Industry standards may also change over time and the scope of a claim should not depend on a standard that has the potential to alter. Similarly, claims to a particular technical standard will be allowed where the substance of that standard is included within the specification.

2450. Claims directed to "any invention as disclosed herein" or similar variations do not clearly define the scope of the invention and should be objected to for lack of clarity.

2551. The term "homology" refers to whether two structures share a common origin, that is they either are homologous or they are not. It is therefore regarded as incorrect to say a polypeptide or nucleic acid sequence has a certain percent homology to another. The more appropriate term "sequence identity" should be used to clarify the scope of the claim.

2652. Where percentages are listed the unit base should be stated where ~~is it~~ is appropriate to do so. For example, percent weight, percent volume.

2753. Names that are used exclusively by the applicant and represent a private or internal name given to a material or compound should not be used in the claims. The term should be replaced by an expression known to all skilled persons who may need to determine the monopoly defined by these claims.

2854. Terms such as "metabolite", "prodrug" and "derivative" do have a variety of working definitions, for example a metabolite is considered to be a product derived from the metabolic transformation of another compound. However, this definition does not identify what the actual chemical compounds would be in a specific instance. The same point applies to the term 'prodrug'. Unless the specification gives direction to a person skilled in the art what the metabolites and prodrugs are, then these terms will generally be considered to be unclear.

2955. With the term "derivative", the allowability may depend on the context it is used. An example of an unallowable use of the term derivative would be "a compound of formula (I) or a derivative thereof" where formula (I) is a Markush structure. In this context the "derivative" would not necessarily fall within the scope of the Markush structure, the Markush structure is a starting point from which the compound is derived. An example of a possibly allowable use of the term "derivative" would be "a compound of formula (I) or an alkyl ester derivative thereof" where formula (I) is a Markush structure with a carboxylic acid group.

Conciseness

3056. The claims are required to be concise. The requirement is for each individual claim as well as the claim set as a whole. Each claim should clearly express the intended content without wordiness or undue repetition.

3157. The presentation of plural independent claims, each one of which defines a different category of the invention, such as: a product, method of making the product, use (or method) of using the product, and apparatus for making the product, will not in itself draw an objection that the claims are not concise.

3258. When plural independent claims of the same category are presented one independent claim should not fall wholly within the scope of another independent claim. A claim that falls wholly within the scope of another claim should not be presented as an independent claim, but instead should be made dependent on a broader claim. This may require re-arranging of claims as claim should not

depend on claim later in the claim set. This requirement is based on *Bancroft's application* 23 RPC 89 which at page 94, lines 23 to 26 states that there may be more than one independent claims "separate in their nature". A claim that falls wholly within the scope of another claim is not considered to be "separate in nature" and so should not be an independent claim.

3359. Even where independent claims of the same category and having different and substantial mutually exclusive features, so that one does not fall wholly within the scope of another, are presented, objection that the claims are not concise will be taken if repetition of subject matter from claim to claim is considered excessive.

3460. If there is deemed to be such an excessive number of independent claims with excessive repetition, objection will be taken that such a plurality of independent claims makes it difficult, if not impossible, to determine the common novel inventive concept, that is, the claims taken as a whole do not clearly define the invention.

3561. The purpose of the claims is to map out the scope of the monopoly sought by the applicant. Each claim should have a different scope. If two claims have the exact same scope then one of them is unnecessary and should be deleted in order to fulfil the requirement of conciseness.

Form of the claim

3662. There is no set structure for the claims. Providing a claim meets the requirements of the Act and Regulations, the applicant may choose the structure of the claim.

3763. The scope of the claim should be defined by technical features of the invention. The claims should not include statements of advantage, or non-technical matters. The technical features should not define the invention by using unusual and non-standard or unreasonable parameters that are unable to be compared with the prior art. Claiming by a result to be achieved should only be used when no other way to define the invention is possible and will need to fulfil the requirements of support over the whole scope of the claim.

3864. A claim should consist of a single sentence with a single full stop at the end of the claim. Claims should be numbered consecutively. As the claims are required to be numbered consecutively, this implies an order to the claims. For this reason claims should not be dependent on claims later in the claim set. When amendments to the claim set ~~has~~ have taken place, deleted claims should be removed and the remaining claims renumbered. The claims should not include the markings of the amendments such as strikethrough lettering.

Meaning of terms used in the claims

3965. In the reading of a claim, the plain dictionary meaning of the terms are used in most cases. If they are terms known to have a particular meaning to a person skilled in the relevant art then that definition is the one that applies. See *Kirin-Amgen Inc v Hoechst Marion Roussel Ltd* [2005] RPC 9. The technical meaning may have to be verified by a regulating body (such as IUPAC for chemistry terms) or those in common use in trade journals.

4066. *Peterson Portable Sawing Systems v Lucas* [2006] NZSC 20 discusses at paragraphs [25] to [28] construing of claims. A specification must be read as a whole with a mind to the function of each part. The purpose of the claims are to confer the monopoly of the patent. The description can help define the claims but it cannot be used to alter the monopoly which is set out in the claims.

4167. The specification can be used as a dictionary but cannot be used to change the meaning of what is in the claim. For example, if a claim is directed to a chemical structure and the variable R1 is said to be "lower alkyl", the definition of the specification can be used to define the number of carbons and whether it includes both branched and straight chain alkyls. However, if the specification defines "alkyl" as including cyclic groups, aromatic groups, amines, carboxylic acids ...etc, as this is contrary to what a person skilled in the art would considered be an "alkyl" the definition of "alkyl" may need to be further clarified in the claim.

4268. *Electrical and Musical Industries Ltd v Lissen Ltd*, 56 RPC 23 dealt with a case there where the meanings of the claims was-were trying to be altered by what was in the specification rather than what was in the claim itself. The case made it clear that the forbidden field for a third party must be clear from the language of the claim and not found elsewhere in the specification.

4369. Objection should be made where the scope of the claims is ambiguous or where the claim is unclear. Terms that in themselves are clear, but their use makes the claims unclear should also be objected to. There are terms that may make the claim unclear in some cases but not in others. Examples of some of these terms are "about", "substantially", "such as", "for example", "approximately", "essentially", "especially", "for instance" and words that appear in brackets. An example of a possible unallowable use would be "wherein the second temperature is substantially higher". If the second temperature being a certain amount higher is an important feature then how much higher should be stated in clearer terms. Another example of an unallowable use would be where there is a contradiction: "a composition that includes an organic acid such as hydrochloric acid" (hydrochloric acid being a mineral acid rather than an organic acid).

4470. A claim may include numbers or letters in brackets that reference certain embodiments in the drawings. For example "a rotation means (4)", or "distillation column (7)". These should not be considered as limiting in the construing of the scope of the claims. However, the scope of the claim should be construed as to include the specific embodiment that is being referred to. They should be considered as helping the clarity and there should be no objection to the reference being in the claim except if the reference introduces ambiguity. Examples where a drawing reference may introduce ambiguity is if the same reference number is used for different features, or there is a contradiction between what the claim and the description say the feature is.

4571. Terms that give the claim an indeterminate scope such as "likely", "improved", "possibly", "and the like", "not limited to" and "etc." and an objection should be raised to these terms.

4672. The terms "novel", "new" and the phrase "the invention" should not be used in the claims. These terms place the onus on the reader to determine what is the novel/new part or what is "the invention" that is being claimed.

4773. If a claim recites the invention or features of the invention in broad terms, and then also lists more narrower, more specific terms preceded by "preferably", "with preference", "most preferred",

or similar wording, then the claim should be construed in the context of the broader terms. If the claim were granted, the patentee would not have any special protection to the limited options unless they are also the subject of a dependent claim. It may be appropriate to raise to a lack of clarity if the intended scope of the claim is unclear. This may also be the case where the claim is defined by "optional" features. If the intended scope is vague, an objection should be raised.

Open and closed claims

4874. Open claims are not restricted to the features that are listed in the claims. The claim has those features and optionally others that may be identified in later dependent claims. Closed claims are ones where the features of the claims are restricted to those that are listed in the claims. The terms used in the claims determines whether it is open or closed. For example "comprising", "including" and "contains" are open terms that mean that the claim includes the following features but do not exclude features that are not listed. The term "consisting" is a closed term which means that the claim includes the following features and does not include any other features. A Markush structure claim is a closed claim.

4975. Refer to [Section 40: Amendment of complete specification](#) [Section 40: Amendment of complete specification](#) for introduction of a definition of 'comprising' or 'consisting'.

[Section 40: Amendment of complete specification](#)

Purposive construction

5076. In construing the claims, the claims should be read with the purpose of the claims in mind. *Catnic Components Limited and another v Hill and Smith Limited* [1982] RPC 183 said that when reading a claim the purpose of the claim should be taken into consideration. The case was about a window lintel and what the scope of "vertical" was. With a strict definition "vertical" would mean that it is 90 degrees. It was decided that although the vertical portion in the infringers item was a few degrees offset from 90 degrees and so not strictly vertical, the small difference in angle made no practical difference to the invention.

5177. The departure of a range could not be considered as variant like in the Catnic case. The reason behind this is that if a patentee uses a descriptive word he may not mean it in a strict literal sense and may have been speaking figuratively. However a specified number does not leave room for interpretation.

Types of claims

5278. In general, claims may be directed to either to a physical entity such as a compound, apparatus or a composition; or to an activity such as a method, a use or a process. It should be clear whether the claim is directed to an object or an activity, as it can have some bearing on the interpretation of the language. For example if the claim is directed to an object "for" a particular use

then the claim is construed as the object "suitable" for that use and is not considered a restrictive use (*L'Air Liquide Societe's Application*, 49 RPC 428).

5379. However, if the claim was to a method "for" a particular outcome then the method is restricted to that outcome.

5480. A claim to an object may be restricted to specific use by using a phrase such as "when used". Where the object is an apparatus which is used for a method, the technical features of the apparatus must be clear from the claim. In cases where the apparatus and the method are both novel then they can usually be claimed independently. Where only one aspect of the claimed subject matter is novel e.g. either the object or the process; then the claim may be required to be limited. For example 'a method... when performed on the apparatus of claim X' or 'an apparatus... when used in the method of claim X. See below for the special case of a product made by a process.

5581. A method claim should detail what is expected as the outcome of the method also known as "the promise of the claim". The steps listed should then ultimately result in what the method said would be the outcome of the claim, or fulfil the promise of the claim.

5682. For a process claim to be clear, the starting material, the end product and the means for adopting one to the other should be in the claim. *British Celanese Ltd., George Holland Ellis and Frank Brown* 51 RPC 192 decided that without identifying the means of converting one to the other, no process has been defined.

5783. Claims directed to more than one category "compound, method, process or use according to claims 1-5..." may be of ambiguous scope and therefore unclear.

Product-by-process

5884. One of the differences in claim construction from the 1953 Act is the construing of claims to a product made by a process or "product-by-process" claims. Examples of forms of a product-by-process claim are "a product obtained by the process of claim x", "a product obtainable by the method of claim x", or "product made by the steps of...". Under the 1953 Act if a claim to product was restricted to be "obtained" by a novel process then regardless of whether the product was known or not, the claim was considered to be novel. Under the 2013 Act, a claim to the product of a process will only be considered to be novel if there are material differences between the product claimed and what is known in the prior art base, even if it is claimed by being made by a novel process. See *Kirin-Amgen Inc v Hoechst Marion Roussel Ltd* [2005] RPC 9.

5985. If the product is novel, and a claim is merely to "a product made by process Y" this form would only be allowable if the product could not be described in any other way, such as by its composition, structure or other testable parameters.

Trade marks in claims

6086. Trade marks merely indicate the origin of the substance or material. They do not guarantee what the composition or construction of it is. For example, if a food company changed the recipe they would not then have to market the product under a different name, they could continue using the original name. For this reason, technical features should not be defined by a trade mark alone. The features should be defined with the generic version of the trade mark. The trade mark could clarify what is meant by the generic name by being in brackets beside, for example "carbonated beverage (Coca Cola)".

Claim by results

6187. Claims that are defined by a result to be achieved were considered in *No-Fume Ltd v Frank Pitchford Co Ltd*, 52 RPC 231. In general, claims that define the invention by a result that they wish to achieve should only be allowable in cases where the invention cannot be defined in another way. In the No-Fume case the patent was to an ashtray. The invention was that if you had certain relative sizes of the components then the ashtray would be able to prevent the smoke from coming out of the ashtray. In that patent the claim was formulated so that ~~they~~ the physical dimensions of an ashtray were chosen in order to produce the result of collecting the smoke coming off an object. It was decided that claiming by a result was allowable in this case because the area of scope was difficult to define in another way and the specification provided the means for achieving the results. Also a person skilled in the art would not have to perform undue experimentation in order to determine if he infringes the claims or not.

6288. To allow a claim by result the feature that is defined by the result to be achieved should not be able to be defined in any other, more concrete way. Also, a person skilled in the art, reading the specification should not have to perform undue experiments in order to determine the scope of the claim. The person skilled in the art having to do simple trial and error tests that are laid out in the specification to tell whether the result has been achieved is acceptable. However, if the person would have to perform experiments not laid out in the specification and requiring initiative or inventive ability to determine whether something does or does not fall within the claim then it is not clearly defined.

6389. As with all claims, claims by result must be enabled and supported by the disclosure over the entire scope of the claim. If the scope of the claim extends beyond what a person skilled in the art would know to be obvious alternatives of what is explicitly disclosed, then the claim would not be supported or enabled by the disclosure.

6490. An example of an objectionable claim by result was discussed in *H. Lundbeck A/S V Generics (UK) Ltd* [2008] RPC 19 at [60] where it was said that if a man found a new way to make a new substance which is 10 times harder than diamond, he would be able to claim the new method and the new substance but would not be allowed to claim "a substance which is 10 times harder than diamond".

Functional definitions

6591. Where an integer of the claim is defined by what it does rather than what it consists of, then this is considered to be a functional definition. For a functional definition to be allowable, a person skilled in the art should either know from the common general knowledge of that art what would or would not be included in the scope, or the specification should contain instructions in the form of testable criteria or experimental tests which would allow a skilled worker to recognize which objects or materials fall within the functional definition and accordingly within the scope of the claimed integer. The skilled worker should not be required to perform inventive measures in order to determine what would fall within the scope of the claims, however, simple trial and error tests to confirm that are laid out in the specification to tell whether the result has been achieved is acceptable, see for example *Corvas International Inc* [2001] NZIPOPAT 8 (27 March 2001).

Markush claims

6692. Markush claims are a special type of claim where a feature is defined by a number of alternatives. The most common form of a Markush claim is a chemical structure claim where variables are indicated on a chemical structure and then they are defined as alternate moieties. Markush claims are closed groups and care should be taken that dependent claims do not introduce new features.

6793. Each variable of the Markush claim should be defined in the claim, or in a claim to which the claim depends. Also there should not be any additional and unnecessary definitions where variables are defined but are not used elsewhere within the claim.

6894. The scope of a Markush structure under the 1953 Patents Act was construed to every compound that was within the structure. From *Dr Reddy's Laboratories (UK) Ltd v Eli Lilly & Co Ltd* [2010] RPC 9 which was decided under the 1977 UK ~~patents~~ Patents Act, this idea was replaced with the construing of the Markush structure with reference to what the disclosure enabled and supported.

Omnibus claims

6995. An omnibus claim is a claim that claims a scope based on a reference to the description, examples or drawings and not on technical features provided in the claim. For example "An apparatus substantially as herein described with reference to the figures and/or examples".

7096. Omnibus claims are not prohibited by either the Act or Regulations. It is likely that an omnibus claim would be upheld by a court in keeping with earlier decisions such as *Raleigh v Miller* (1948) 65 RPC 141 HL and *Rotocrop v Genbourne* [1982] FSR 241.

7197. When examining omnibus claims care should be taken to ensure that prior art examples disclosed in the description, examples or drawings are not also being claimed. Also when other claims are required to be restricted to overcome objections, such as lack of support, anticipation and lack of inventive step, omnibus claims may likewise require restriction.

7298. Where the omnibus claim refers to "substantially as herein described" or similar wording where there is no further restriction, there is no restriction to an embodiment and it will be construed as wide as the disclosure of the specification and would include an prior art mentioned in the specification relating to that claim type.

7399. Claims that depend on an earlier claim that has features listed are not strictly an omnibus claim as the scope of the claim includes and is limited to the technical features of the claim to which it depends. For example "An apparatus of claim 1 substantially as herein described with reference to the figures and/or examples".

74100. Omnibus claims should be carefully worded to ensure that they are clear and not ambiguous.

Reach through claims

75101. Reach through claims are generally claims to an object that the invention is worked upon and may be objectionable due to lack of clarity as well as a lack of support. Common forms of reach through claims are where the invention is to a new method of identifying a substance (e.g. compound, antibody, protein) and then claiming the substance identified (e.g. "Antibody X when identified by method Y").

76102. Where a method of identifying a substance is novel and inventive the claims to the method are allowable per se. However a known substance is not made new merely due to a new way to identify it. The reach through claims have been likened to an invention of a new pair of binoculars, and then claiming both known and unknown objects that can be seen through the binoculars e.g. an existing house when seen through the binoculars of claim 1.

77. [Paragraph removed.]

Suitability for use

78103. A claim to an apparatus or object "for" a particular purpose is considered to be "suitable for use" for that purpose (*L'Air Liquide Societe's Application*, 49 RPC 428). For an apparatus or object to be restricted to a particular use then the claim must specify that it is "when used" or similar wording. Subject matter that is claimed as 'suitable for' a purpose is limited in the sense that subject matter found in the prior art base which is not suitable for that purpose would not be considered as prior art with regard to novelty at least. Additionally, apparatus being suitable for purpose implies certain features of the apparatus for example relating to materials from which it can be made, the size of the apparatus and other features which would be apparent to the person skilled in the art. For example, 'a hook for a crane' or 'crane hook' would necessarily need to be relatively robust and strong and of a size which would allow it to be suitable for the purpose of lifting and moving materials. A 'hook for fishing' or 'fish hook' would not be suitable for the same purpose as a crane hook.-

79104. In *Hickman v Andrews*, [1983] RPC it was decided that although a workbench and a previously known bookbinders press had all the same technical features, the book press did not

anticipate the workbench because the dimensions of the book press meant that it was not suitable for the purpose of use as a workbench. Suitability for use is discussed in *Adhesive Dry Mounting Co Ltd v Trapp and Co*, 27 RPC 341 and *G.E.C's Application*, 60 RPC 1.

SUPERSEDED