Presentation at
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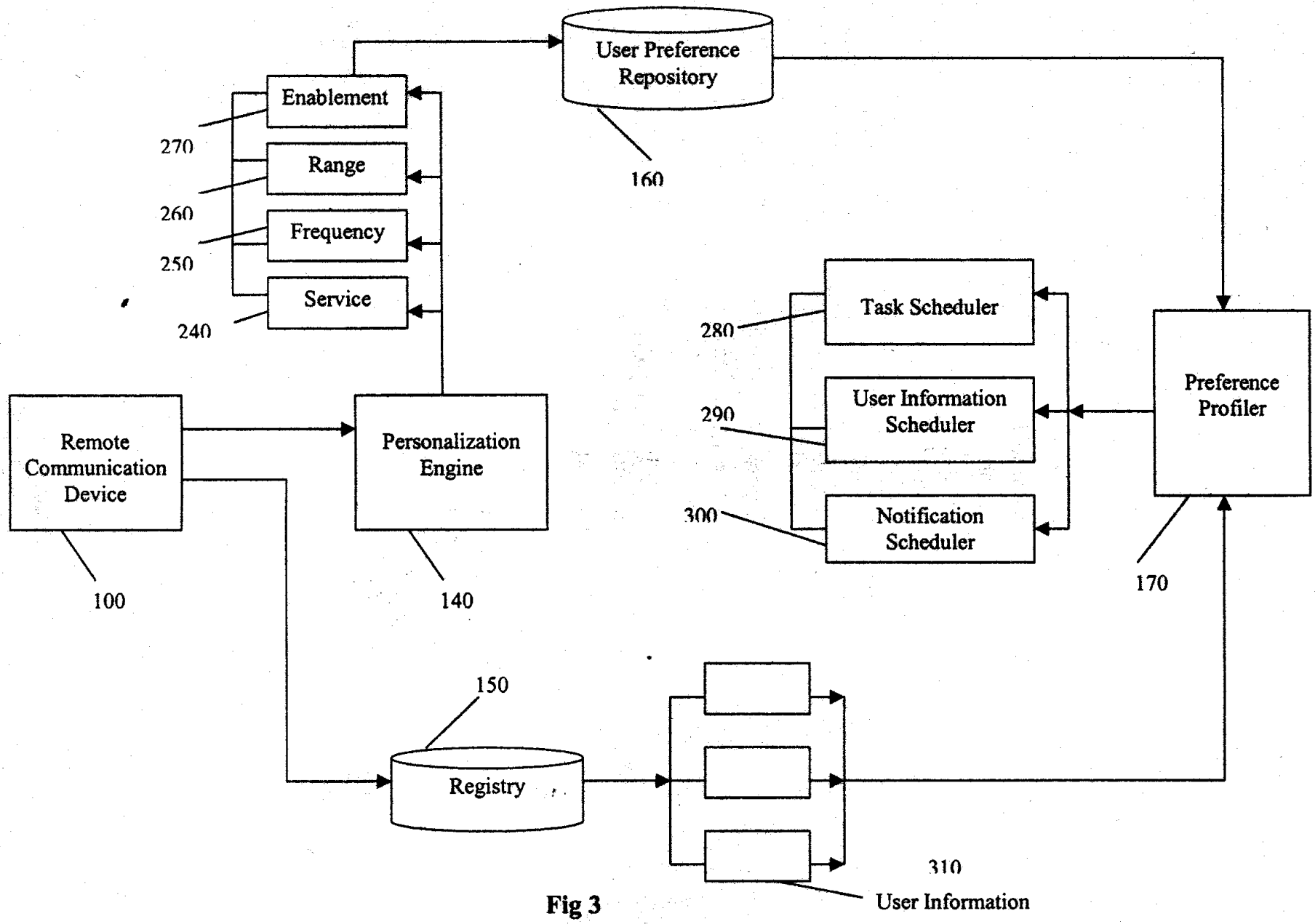
User Preference Repository
160
Enablement
Range
Frequency
Service
270
260
250
240
Task Scheduler
User Information Scheduler
Notification Scheduler
280
290
300
Preference Profiler
170
Remote Communication Device
100
Personalization Engine
140
150
Registry
310
User Information

Fig 3

lbns

- This system contains a plurality of computer programs, configured to achieve the objective of notifying a mobile telephone subscriber of locations of his/her liking when he/she passes by such locations
- It employs a known cellular telephone architecture
- These computer programs are implemented in a base station which is part of a digital cellular telephony network
- These programs work in conjunction with known digital cellular technology like GSM (Global System for Mobile Communications)

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example of an independent claim directed at lbns

We claim or I claim:

1. A communication system comprising:

a remote communications device configurable to communicate through a telecommunications network;

a base station in communication with the remote communications device, the base station having a notification system interfacing with the remote communications device, wherein the base station is configured to provide location based notification to the remote communications device employing the notification system.

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We claim:

1. A communication system comprising:

a remote communications device configured to communicate through a telecommunication network;

a base station in communication with the remote communications device, the base station having a notification system interfacing with the remote communications device, wherein the base station is configured to provide location based notifications to the remote communication device using the notification system.

2. The system according to claim 1 wherein the remote communications device comprise a mobile phone.

3. The system according to claim 1 wherein the remote communications device comprise any device capable of communicating through a telecommunications device.

4. The system according to claim 1 wherein the base station is configured to provide location based notifications to the remote communications device.

5. A system for providing location based notifications, the system comprising:

a remote communications device configured to communicate through a telecommunications network; and

a base station in communication with the remote communications device, the base station having:

a personalization engine configured to interface with the remote communications device and receive personal preferences from the remote communications device;

a user preference repository configured to store user preferences obtained by the personalization engine from the remote communications device upon termination of the interface between the remote communications device and the personalization engine;

a registry configured to receive and store predefined user information;

a preference profiler configured to receive user preferences from the user preference repository and user information from the registry and to create notifications;

patent specification

- Title
- Technical Field
- Reference to Cross-related applications
- Background of the Invention
- Summary of the Invention
- Brief Description of the Drawing Figures
- Detailed Description of the preferred embodiments
- Claims
- Abstract
- Drawing Figures (if any)

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claims – the most critical integer of a patent specification

- The scope of a patent is defined by one or more ‘numbered’, ‘single’ sentences given at the end of a patent specification which are called ‘claims’ [Sec.10(4)(c)] or 35USC §112
- Claims determines the *metes and bounds* of the invention
- Typically claims must be single sentences (MPEP 608.1(i)) and numbered (no specific provision in the Indian law). If there is only a single claim in an application the claim is not numbered (MPEP608.01(j))

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structure of a claim

Let us look at a claim directed at a method for unlocking a door - the claim is as follows:

1. A method for unlocking a door" the method comprising:
   removing a key chain with one or more keys from a pocket or a bag;
   selecting the proper key to unlock a door based upon a color - coded system; and
   unlocking the door employing the key.

The preamble may not usually limit the scope of the claim

In Corning Glass Works v. Sumitomo Elec. USA, Inc, Court held that the question whether a preamble would limit the scope of the claim can be decided only on the basis of a complete reading of the claim in light of the specification.

In Catalina Marketing Intl. Inc v. coolsavings.com Inc, the court held the preamble will not limit the claim when it merely serves to define the environment in which the invention is to be used or operated.

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multiple independent claims

- Multiple Independent Claims refer to the inclusion of more than one independent claim in a single patent application
- In some countries multiple independent claims are permissible, provided the claims fall under a “single inventive concept”
- In India, so far, multiple independent claims were not allowable

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multiple dependent claims

- Multiple Dependent Claims refer to claims wherein a subsequent claim derives antecedence basis from more than one previous claims refers to more than one In some countries certain types of multiple. As for example:

10. The communications system according to any of claims 2 through to 9, wherein…

31. The method according to claim 29 and 30, further comprising…

40. The method according to claims 36, 37, 38, and 39 in which…

60. The communications system according to any of the preceding claims, the method further comprising…

transitional phrase

- The phrase used to connect the preamble and the body of a claim is known as 'transitional phrase' or link
- Commonly used transitional phrases include "comprising", "consisting essentially of", "consisting of", "including", or "containing"
- "Comprising" is an open-ended phrase. It means including but not excluding
- In Ex parte Davis the Court held that "consisting of" would mean restricted to those elements, steps or ingredients recited in the claim.
- "Consisting essentially of" is a transitional phrase that is less limiting than "consisting of".
  - As for example, in "a method for unlocking door comprising step A, Step B and Step C", adding an additional Step D would avoid infringement if the transitional element used is "consisting of".
  - If the transitional element used is "consisting essentially of" adding additional Step D would only avoid infringement if Step D was material in view of Steps A, B and C. Otherwise A, B, C and D would infringe. (AFG Indus)

body of a claim

- Body of a claim typically contains elements set off as paragraphs. This serves in framing the infringement enquiry
- Each claim element ordinarily will comprise of a given structural component or a particular step
- As for example the structural element of a claim can be “a lock” whereas the functional claim element may be “unlocking a lock”
- It is often possible to recite a claim element without in fact reciting a structure. As for example a claim reciting a door-lock can be recited as “a means for releasably securing a door”.

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functional language

"Whereby" or "wherein" are often used as language functionally limiting the claimed invention. One will find this at the end of a claim or group of elements.

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how to read claims?

- To effectively work around patents, one must have the ability to find gaps in patent claims

- How do you find gaps in a patent disclosure?
  - Read claims
  - Read limitations into claims

- How do you read limitations into claims?
  - Read limitation into claims from the detailed description of the invention
  - Read limitations into claims from prosecution history
  - Prosecution history estoppel is a bar on the flexibility of doctrine of equivalents.
  - Read Prior art into the claims – invalidate the claim
  - Find absence of 'Enablement Requirement' in the specification
  - Find absence of the disclosure of best mode in the specification

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claim construction

- Can you read into the claims limitations based on written description provided in the specification?

  Yes, If you do not recite alternatives properly.

- In O.I Corporation v. Tekmar Company (Fed. Cir. 1997) the invention was concerning a

- *device for removing water vapor from a stream of gas, contaminant and water that flows through a temperature controlled "passage". The written description covered only non-smooth geometries for the passage.*

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O.I Corporation v. Tekmar Company

- The Court was called upon to construct the scope of "passage". Even though the claims did not refer to any geometry of passage, the Court held that "passage" means "non-smooth passage".

- This is a typical case of reading limitation into claims by constructing the claim language based on written description.

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the Markman rule?

- Who has the right to interpret claims in the context of a potential infringement - the answer is simple – the court.
- In *Markman v. Westview Instruments,* the CAFC decided that claim construction is a question of law. The US Supreme Court concurred with this decision.
- The dispute in Markman focused on the meaning of the term "inventory" in a patent claim. The claim covered a 'system for monitoring "inventory" for a dry-cleaning establishment.
- Markman's patented system permitted the user to input information in respect of articles to be cleaned and generate bar-coded tags to attach to the articles. The employees of the cleaning company can then use the bar-codes to the status of the articles being cleaned.

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Markman v. Westview Instruments

- On the other hand Westview employed a product which was capable of tracking invoices or cash totals during the cleaning process.
- Westview's contention was that its product did not track articles of clothing and did not monitor "inventory" as required in the Markman claim.
- Markman, however, contended that "inventory" was not limited to articles of clothing but could also include 'cash' or 'invoices'.

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reading limitations into the Claims

- The Federal Court rejected Markman's contention and held that "inventory" referred to 'articles of clothing'.
- To arrive at this, the Court considered the construction of the meaning of "inventory" as a matter of law and relied on for that purpose the Specification and the Prosecution History.
- That means in Markman the Court used the specification and the prosecution history to read limitations into the claims.

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prior art

Can you preempt possible attacks on your claims based on prior art while drafting and prosecuting patent applications?

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using prosecution history to limit claims

- Question is this – can you regain something which you stopped from claiming during prosecution?.
- If you amend your claim during prosecution you would presumptively create an estoppel – as there is a rebuttable presumption that the amendment relates to patentability, the patentee is estopped from recapturing the subject matter relinquished.
- Tampering with your claims in insubstantial details to avoid infringement is what is prevented by doctrine of equivalents. You read the claims element by element. Each element contained in a patent claim is material to defining the scope of the claim.
- File wrapper estoppels limit you from applying equivalents in constructing claims and from recapturing what you relinquished.

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you may keep this in mind when you look at a claim

- Review the claims to ensure that the examining attorney will not raise substantive objections.
- What an examining attorney will identify and evaluate each claim limitation
  - you limit your claim language by excluding subject matters other than what is recited in the claim 'controlled release pharmaceutical formulation comprising clarithromycin citrate salt" or a 'clear suspension formulation of dexibuprofen'
- The examining attorney will read each claim limitation based on the written description. [(The Markman rule) Markman v. Westview Instruments 31USPQ2d.]
- In interpreting a specific term the examining attorney will look for explanations provided in the text description. What is the limiting effect of the language in a claim – intended use – adapted to use – wherein – whereby –

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In India – no precedents

- There is no precedent – decisions by the Supreme Court or the High Courts explaining the intricate rules behind patent disclosure or claim construction
- We do not have a manual of patent examination procedure that explains these principles
- The IP Appellate Board may pass orders while hearing appeals (and soon revocation petitions) that lead to the development of clear rules concerning patent prosecution, disclosure standards and even claim construction

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Thank You

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