



INTELLECTUAL PROPERTY
OFFICE OF THE PHILIPPINES

CLARITY GUIDELINES (2022)

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INTRODUCTION

This Clarity Guideline complements the practices set out in the Bureau of Patents' Manual for Patent Examination Procedure (MPEP). It aims to assist BOP Examiners in assessing the clarity of claims as required under Section 36.1 of the IP Code, as amended.

Apart from the patentability requirements on eligibility, novelty, inventive step, and industrial applicability, patent applications filed in the Philippines must likewise comply with a number of other requirements; and among which is the requirement on clarity.

Patent claims are an essential requirement for an invention application. As set forth under Section 36.1 of the IP Code, as amended, a patent application shall contain one or more claims that should define the subject matter for which protection is sought. Furthermore, each claim shall be clear and concise and be supported in the description.

In formulating an opinion on the patentability of an invention application, clarity of the claims is of the utmost importance. Given their function in defining the matter for which protection is sought, proper clarity assessment of patent claims ensures that the scope of an invention application is clearly delineated over any of the existing relevant art.

The Guideline provides a non-exhaustive list of common issues and examples where the lack of clarity in the claims could arise. All discussions and illustrative examples described herein are sourced from the BOP MPEP, the BOP Training Materials, other Patent Offices, and actual invention applications.

I. CLAIMS

Section 36.1 of the IP Code, as amended, requires that a patent application must conclude with one (1) or more claims defining the subject matter for which protection is sought. Moreover, the claims must be clear and concise, are enabled, and be supported by the description.

Claims must be drafted in terms of the technical features of the invention, e.g., in terms of the structure of a chemical product or parts of an apparatus. Other means of defining the invention may also be recited in the claims, such as statements of function or purpose or use; provided that the other requirements under Section 36.1 are complied with.

A. Categories of Claims [7]

The claims of an invention may be classified into two (2) general categories, i.e., "physical entity" and "activity".

It can sometimes be worded differently; however, the interpretation of which would fall into either of the said categories. Inventions may also be claimed by more than one category to ensure full protection.

The two (2) general categories of claims cover the following:

- "Physical entity" - claims that pertain to a substance or compositions (e.g., chemical compound or a mixture of compounds) as well as any physical entity (e.g., object, article, apparatus, machine, or system of co-operating apparatus), which is produced by a person's technical skill.

Examples:

- (1) "A composition comprising A, B, C, and D."
- (2) "A product obtainable by reacting NaOH with HCl."
- (3) "A means for broadcasting information, comprising A, B, and C."
- (4) "An apparatus for communication, the apparatus comprising A, B, and C."

- "Activity" - claims that pertain to the use of some material product for effecting a process; such may be exercised upon material products, upon energy, upon other processes (as in control processes) or upon living things.

Examples:

- (1) "A process for the preparation of a compound of the Formula, comprising step A, step B, step C, and step D..."
- (2) "Use of a compound of the Formula...in the manufacture of a medicament for treating or preventing disease..."
- (3) "A method for broadcasting information, comprising step A, step B, and step C."

- (4) “A method for communication, the method comprising the steps of: step A, step B, step C, and step D.”
- (5) “An in vitro method of assessing liver fibrosis in a subject comprising: quantitatively measuring...”

A claim in one category may, to some extent, define certain features in terms of another category; however, the clear differentiation between claims to a physical entity (product or apparatus) on the one hand, and claims to an activity (process or use) on the other hand must be maintained.

Example of a claim to a “physical entity” but with features that is defined or characterized in terms of “activities”:

- (1) “Tape recorder apparatus comprising a measurement device and a computation device, characterized in:
 - that the computation device assesses, in a first computation step... the overall length,
 - that the computation device assesses, in a second computation step... a corrected tape thickness, and
 - that the computation device assesses the run time...” [1]

B. TYPES OF CLAIMS [7]

A patent application contains one (1) or more independent and dependent claims.

A correct identification of independent and dependent claims is important in conducting patent examination, particularly on clarity, novelty, inventive step, or unity of invention.

● INDEPENDENT CLAIM:

An independent claim is a standalone claim directed to the essential features of the invention. It serves as the bedrock of all other claims that refer to it.

Any feature which is consistently described as or demonstrated to be essential to the invention must be incorporated in an independent claim.

● DEPENDENT CLAIM:

A dependent claim is a claim of the same category that includes all the features of any other previously cited independent or dependent claim. A dependent claim is normally, but not always, preceded by the phrase “according to”.

To achieve the effect of having a specific scope than that of the previously cited claim, a dependent claim will include:

- one or more features of the parent claim defined in greater detail,
- one or more features in addition to those of the parent claim, or
- one or more features that limits the parent claim.

For conciseness, a dependent claim should contain a reference to the previously cited claim instead of reiterating all the features of that claim.

● **REFERENCE TO ANOTHER CLAIM/OTHER CLAIMS:**

A claim may contain a reference to another claim or other claims even if it is not a dependent claim (i.e., reference is only to a certain feature/s of the other claim/s).

The reference to another claim or other claims is for conciseness and would normally be preceded by the phrase “as defined in” or “according to”.

It should be noted though, that for claims which refer to another claim or other claims, the Examiner should carefully consider the extent to which the claim containing the reference necessarily involves the features of the claim referred to and the extent to which it does not.

In addition, for such claims, the requirements under Rule 415(c) would also apply, i.e., reference to more than one (1) other claim shall be in the alternative and shall not serve as basis for any other multiple dependent claims.

Examples (REFERENCE TO ANOTHER CLAIM):

<p>Example 1</p>	<p>Claim 1: <i>“A gearbox characterized by features A and B”</i>. [1]</p> <p>Claim 2: <i>“A tractor comprising a gearbox according to claim 1”</i>. [1]</p> <p>In this example, claim 2 relates to subject matter (a “tractor”), which is different from that of claim 1 (a “gearbox”); however, the said claim makes reference to claim 1 as far as the features of the “gearbox” are concerned.</p> <p>Claim 2 is therefore acceptable in terms of its format.</p>
<p>Example 2</p>	<p>Claim 1: <i>“A door with locking system, the system comprising of: a rectangular body; a door lock..., a...”</i></p> <p>Claim 2: <i>“The door lock according to claim 1...”</i> [1]</p> <p>In this example, claim 2 made reference to claim 1, but does not contain all the features of claim 1; instead, the subject matter of Claim 2 constitutes only part of the system of Claim 1, thereby making claim 2 unclear.</p> <p>Claim 2 is an example of a claim referring to another claim where an examiner should consider the extent to which the claim containing the reference necessarily involves the features of the claim referred to and the extent to which it does not.</p> <p>In this case, claim 2 is broader than claim 1; hence, claim 2 may be re-drafted either as an independent claim with the features of claim 1 appended to thereto or as a claim dependent on claim 1 (e.g., “The door with locking system</p>

	according to claim 1, wherein the door lock comprises...”).
Other Examples:	<p>Claim (a): “A <i>method of producing a polypeptide according to any one of claims 1 to 10 comprising obtaining a cell according to claim 33 and expressing...</i>”</p> <p>Claim (b): “A <i>compound according to any of claims 1 to 26 obtainable according to a process of claim 27.</i>”</p> <p>Claim (c): “A <i>process to prepare a compound according to any one of claims 1 to 26...in the presence of the compound of formula III wherein R, m, n, p, and q are as defined in any one of claims 1 to 26...</i>”</p> <p>Claim (d): “<i>The use according to claim 1 wherein the mixture is a liquid composition as defined in any of claims 1 to 15 and a solvent.</i>”</p> <p>In each of the above Examples, the claims which are drafted with reference/s to a previously cited claim/s may be considered acceptable. However, consideration as to the extent to which the claim containing the reference necessarily involves the features of the claim referred to and the extent to which it does not should be properly assessed.</p> <p>In addition, claims with reference/s to another claim or other claims must comply with all the requirements as per Rule 415, Revised IRR for Patents, UM, & ID.</p>

II. CLARITY & INTERPRETATION OF THE CLAIMS [7]

In assessing the claims of a patent application, clarity is of the utmost importance since the claims define the subject matter for which protection is sought (Section 36.1 of the IP Code, as amended) and determine the extent of protection afforded by a patent (Section 75 of the IP Code, as amended).

Patent examination procedures provide an opportunity to improve the clarity of the claims and thereby reduce the effort required to construe such, which could be ultimately granted. Thus, although it may be possible to ascribe a meaning to a claim despite the presence of ambiguities and other minor defects, it is often desirable, in the interests of customer service, to identify such deficiencies during patent examination to permit their rectification before grant. [8]

Points to Consider in Assessing Clarity of the Claims

The requirement on clarity under Section 36.1 of the IP Code, as amended, applies to individual claims as well as to the claims as a whole.

Generally, raising a clarity issue should only be done in cases where it could affect the overall scope of the patent, i.e., instances where the claim/s *per se* do not comply with

Section 36.1 of the IP Code, as amended or where the presence of imprecise claim terms or definitions that relate to the scope and/or patentability of the invention would not be understood by a person skilled in the art.

The mere presence of what may seem as unclear term/s in a claim does not automatically render a rejection for that claim, i.e., in some cases, the nature of the invention justifies a broader scope that can be validly expressed despite the presence of such terms. In such cases, the meaning of a specific technical term or feature may be, for example, broad or may encompass a range of embodiments; however, the overall scope of the claim remains well defined and can be readily determined by the reader. [8]

Examiners may provide suggestions to overcome any clarity issue when necessary; however, Examiners need not be overly concerned with trivialities merely because it would improve the wordings in the claims.

Examiners should take into account that the Applicants and/or Inventors are responsible for drafting the whole specification (including the claims) of their invention application. Applicants can describe in whatever terms or definitions what they regard as their invention so long as any special meaning (if any) given to a term or definition is properly set forth in the description. Furthermore, that all the other necessary requirements (patentability, sufficiency of disclosure, support in the description, etc.) are complied with.

Support in the Description

Prior to assessing the clarity of the claims at the examination stage (formality or substantive), the Examiner must verify and confirm whether the claims satisfy the support in the description requirement under Section 36.1 of the IP Code, as amended.

If the Examiner has well-founded reasons to reject a claim (or claims) for lack of proper support in the description, this may lead to insufficiency of the disclosure as required under Section 35 of the IP Code, as amended (see MPEP, Chapter III, pp. 100 to 103 for proper guidance on this requirement).

Conciseness

Claims, individually or as a whole, must also comply with the conciseness requirement under Section 36.1 of the IP Code, as amended. The requirement that “each claim shall be concise” refers to both independent and dependent claims in that their number must be considered in relation to the nature of the invention the applicant seeks to protect.

Undue repetition of wordings, e.g., between one claim and another, should be avoided by the use of the dependent form. Further, the presentation of the claims must not invite undue burden for both the reader and the Examiner to determine the subject matter for which protection is sought.

Regarding independent claims, generally, an invention is allowed one (1) independent claim per category; however, in certain cases, a plurality of such claims per category may be acceptable, provided that the requirement on unity of invention (Section 38.1, R.A. 8293, as amended) is met.

As for dependent claims, while there are no objections as to a reasonable number of such claims directed to particular preferred features of the invention, the Examiner should object to a multiplicity of claims of a trivial nature.

Broadest Reasonable Interpretation

In assessing the clarity of the claims, the Examiner typically interprets each claim as broadly as their terms reasonably allow, i.e., the claims' wordings would normally be treated as to their ordinary and customary meaning and scope, which they normally have in the relevant art.

In particular cases, the Examiner checks whether certain claim terms may seem unclear but are provided with a special meaning in the description, by explicit definition or otherwise; thus, such terms should be read taking into consideration those special meanings in the description.

Assessing the clarity of the claims is to be treated on a case-by-case basis, i.e., certain terms may vary from one art to the other depending on the context of the invention despite the broadest reasonable interpretation. Thus, it is important to carefully analyze the claim terms in light of the description (and/or the drawings, if any) and/or the general knowledge or prior art so as not to cast doubt on the scope of protection that is being sought for the claimed invention.

Claims Consistency

Part of assessing the clarity of the claims includes ensuring that the claims are consistent, including all terminologies, with respect to the description (and/or the drawings, if any).

Lack of clarity may result from any form of inconsistency within the claims and between one or more claims and the description and/or drawings, which could potentially affect the scope of the claimed invention. In such cases, proper amendments are necessary; however, the amendments should comply with the proviso under Section 49 of the IP Code, as amended.

Forms of inconsistencies, which may result in ambiguity in the claims, include:

- simple obvious inconsistency, e.g., using wrong technical terms;
- inconsistency regarding apparently essential features; or
- part of the subject matter of the description and/or drawings not covered by the claims.

Examples of inconsistencies, which may lead to ambiguity or the lack of clarity in the claims:

Example 1	<p>Claim: <i>“Arrangement comprising injection nozzles and a flame injector nozzle characterized in that the <u>injection nozzles are opposed in their direction to the direction of the flame injector nozzle.</u>” [1]</i></p> <p>Description: <i>An arrangement is described and is shown in the drawings as comprising <u>injection nozzles pointing in the same direction as the flame injection nozzle.</u></i></p>
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	<p>Lack of clarity should be raised since the recited feature (“opposed in their direction”) is inconsistent with that in the description (“same direction”). The claim should be amended, consistent with the description and drawings.</p>
<p>Example 2</p>	<p>Claim: <i>“An electronic apparatus for transmitting on a single link line codified control signals comprising a <u>codified control signal generating unit and a plurality of decode units</u>, characterized in that said line is an existing line of either the active or the passive type, such as a power supply line, a telephone line or an electric cable system line.” [1]</i></p> <p>Description: <i>The essential features of the invention are described herein: an electronic apparatus for transmitting on a single link line codified control signals comprising a <u>codified control signal generating unit...</u>; a <u>signal generator...</u>; and a <u>plurality of decode units</u>, characterized in that said line is an existing line of either the active or the passive type, such as a power supply line, a telephone line or an electric cable system line.</i></p> <p>The claim is unclear since the essential features needed to define the apparatus are inconsistent with the features recited in the description.</p> <p>Claims (in light of the description) should be consistent and complete in terms of the essential features that are indispensable for providing the effect of the invention and for solving the technical problem. An incomplete claim does not particularly point out and distinctly claim the part, improvement, or combination which the applicant regards as his invention.</p>
<p>Example 3</p>	<p>Claim: <i>“A continuous screw-type fine material washer comprising of:</i></p> <ul style="list-style-type: none"> - <i>a feeding mechanism through a hopper for receiving and loading of unwashed fine material which include but is not limited to salt, sand, gravel or coal;</i> - <i>a discharge mechanism through an outlet chute for collection of washed material; and</i> - <i>a washing mechanism through an inclined screw conveyor for thorough mixing of fine material and washing medium.”</i> <p>Description: <i>The invention is described herein relates to a continuous screw-type fine material washer comprising of: a feeding mechanism through a hopper attached on the top portion of the screw-type conveyor for receiving and loading of unwashed fine material which include but is not limited to salt, sand, gravel or coal; a discharge mechanism through an outlet chute provided on the rear section of said feeding mechanism for collection of washed material; and a washing mechanism through an inclined screw conveyor provided on the bottom portion of said feeding mechanism for thorough mixing of fine material and washing medium.</i></p> <p>The claim is unclear since the structural interrelationship of the features is not defined.</p>

	<p>The description disclosed that each feature in the claim is structurally connected; thus, the claim should be redrafted to make the claim consistent with the description.</p>
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A. COMMON CLARITY ISSUES IN CLAIMS

As to the presence of imprecise terms or definitions in the claims, lack of clarity should be raised if they cause the scope of the claim to become uncertain, i.e., an unclear claim term or definition cannot be allowed, especially if combined with a feature that is considered essential having regard to the invention. Further, an unclear claim term or definition cannot be used to distinguish the invention from any relevant prior art.

When rejecting a claim for lack of clarity, Examiners must provide sufficient reasoning to substantiate the rejection in order for the Applicant to clearly understand the alleged non-compliance with the clarity requirement as per Sec. 36.1 of the IP Code, as amended.

The items below, which are not intended to be an exhaustive list, discuss and illustrate commonly encountered issues where the clarity of a claim term/s or definition/s may be put into question. Note that assessing the clarity of a claim should be fact specific; thus, the illustrative examples below only serve as guide and should not be applied as *per se* rules.

i. TERMS & EXPRESSIONS

a. RELATIVE TERMS

<p>Definition</p>	<p>Relative terms in a claim may render the scope of the claim vague and uncertain and should not in general be permitted.</p> <p>Unclear relative terms cannot be allowed in a claim, especially if such terms are essential, having regard to the invention. Equally, an unclear relative term cannot be used to distinguish a claimed invention from the prior art.</p> <p>Relative terms such as “thick”, “thin”, “wide”, “strong”, “light”, “heavy”, “large”, “small”, or “low” when used in the context where they have no well-recognized and precise meaning in the pertinent art, should be rejected for lacking clarity. Other examples are: “long bridge”, “thin plate”, “large rod”, “lower alkyl”. [2]</p> <p>Where the term has no well-recognized meaning, it should be replaced by a more precise wording found elsewhere in the original disclosure. However, where there is no basis in the disclosure for a clear definition, and the term is not essential having regard to the invention, <i>it should normally be retained in the claim, because to excise it would generally lead to an extension of the subject-matter beyond the content of the application, as filed</i> - in contravention of the proviso in Section 49 of the IP Code, as amended.</p>
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	<p>On the other hand, a relative term with a well-recognized meaning in a particular art is permissible, e.g., "high-frequency", provided that its use or meaning in the application is in relation to an amplifier.</p> <p>Other examples of relative terms with well-recognized meanings include:</p> <ul style="list-style-type: none"> ● "High", "low", "short", "long", when used to refer to frequencies or wave bands refer to precisely defined ranges, such as the short-wave band, the long-wave band, the very-high frequency (vhf) band, very large-scale integration (VLSI).[1] ● "Thin-film technology" is a well-known expression identifying a particular branch of industrial techniques relevant to manufacturing integrated circuits.[1] ● "Ambient temperature" is a generally acceptable expression which relates to the current air temperature or the average air temperature at any one location.
Example 1	<p>Claim: <i>"A compound of the Formula...wherein A is selected from lower alkyl, amino..."</i></p> <p>Description: <i>The term "lower alkyl" relates to an alkyl group having no more than six carbon atoms"</i></p> <p>Claims of a Markush-type, wherein some variables are defined in terms of certain chemical groups (e.g., "lower alkyl", "lower alkenyl" or "lower aryl", etc.), are a common occurrence in the chemical field. This is an acceptable specific product claim type. However, clarity issues may arise when relative terms are recited in the claim.</p> <p>In this example, the term "lower" in reference to an "alkyl" in the claim implies a maximum number of carbon atoms, which may be present in the group, but does not say what this maximum is; thus, the said claim term "lower" lacks clarity.</p> <p>Although claims are read in light of the description, any skilled person should still be able to understand the claim terms without referring to the description. In this case, the definition in the description for the term "lower" should be introduced in the claim where the term appears, i.e., "wherein A is selected from lower alkyl having no more than six carbon atoms" or "wherein A is selected from C₁-C₆ alkyl".</p> <p>Note that any amendment/s in the claims (e.g., to overcome the lack of clarity), which finds no basis in the description as filed, cannot be accepted since it will be considered as "new matter" as per Section 49 of the IP Code, as amended.</p>
Example 2	<p>Claim: <i>"An alarm clock comprising an alarm unit, wherein the alarm generates a</i></p>

	<p><i>sound at a relatively large volume at a time set by a user.”</i></p> <p>The claim is unclear since there is no basis of comparison recited in the claim for the term “relatively large” when pertaining to the alarm clock volume. Any skilled person would not be able to determine the range of volume stipulated by the said relative term in the claim, making the scope of the claim unclear.</p>
<p>Example 3</p>	<p>Claim: <i>“An alarm clock comprising an alarm, wherein the alarm generates a safe sound at a larger volume than 50dB.”</i></p> <p>As far as the relative term “larger” is concerned, it would be considered clear since it can be measured to the given sound value of “50 dB”. In addition, it is known from common general knowledge that the acceptable or safe sound value would be at or below 70 dB; thus, the claim could be interpreted as an ‘alarm clock with an alarm that generates a sound of between ‘50 dB to 70 dB’.</p>

b. APPROXIMATE TERMS

<p>Definition</p>	<p>A term which may introduce inexactness or indefiniteness into quantities or expressions and which may leave the reader in doubt as to the precise meaning of the features qualified by such term.</p> <p>Typical terms include “about”, “essentially”, “approximately”, “substantially”, “at least about”, “similar”, “type”, or the like.</p> <p>In certain cases, approximate terms may be considered clear depending on the disclosure of the case being examined, the general knowledge, and the prior art.</p> <p>Therefore, in each case, the Examiner should appropriately judge as to whether the meaning of an approximate term is sufficiently clear in the context of the application and general knowledge, including the prior art, when read as a whole.</p> <ul style="list-style-type: none"> ● In terms of the <u>disclosure and general knowledge</u>, an approximate term would be considered clear when a certain effect or result can be obtained within a certain tolerance and the skilled person knows how to obtain the tolerance (e.g., “a substantially circular wheel”). ● In terms of the <u>prior art</u>, an approximate term would be considered clear when its presence does not prevent the invention from being unambiguously distinguished from the prior art with respect to novelty and inventive step. <p>Otherwise, such terms should be rejected as unclear and should not be allowed in the claims.</p>
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	<p>For approximate terms used in a structural unit of an apparatus (such as "substantially" or "approximately"), such terms are to be interpreted as being produced within the technical tolerance of the method used to manufacture it. For example, "a tray plate with a substantially circular circumference" is to be interpreted as claiming the same technical feature as "a tray plate with a circular circumference"; both are considered as claiming any tray whose base the skilled person in the manufacturing field would consider as being circular. [4]</p> <p>For approximate terms in numerical values and/or ranges, particular attention is required whenever the word "about" or similar terms such as "approximately", etc. are used. Such a word may be applied, for example, to a particular value (e.g., "about 200°C") or to a range (e.g., "about x to about y") [7].</p> <p>Where the terms such as "about" or "approximately" are applied to a particular value or to a range of a claimed invention, the value or range are to be interpreted as being as accurate as the method used to measure it.</p> <p>If the description does not provide a definition for an approximate term (i.e., margin of error), the general knowledge in scientific and technical literature is applied, i.e., the <u>last decimal place of the numerical value indicates its degree of accuracy</u>. [4]</p> <p>On the other hand, if the description provides a definition for an approximate term, the claim containing such a term should be read or interpreted in light of the described definition.</p> <p>Moreover, the defined margin of error may be recited in the claims in place of the expression containing the term "about" or any similar approximate term. [4]</p> <p>Lack of clarity should be raised when a claim feature having an approximate term, interpreted in terms of the general knowledge (or in terms of the prior art), overlaps with range/s or value/s in any prior art with respect to novelty and inventive step. Furthermore, when such a claim feature with the approximate term extends either beyond the interval claimed by a value and/or range or extends the structural unit beyond the manufacturing tolerances as suggested in the application. [4]</p>
Example 1	<p>Claim: <i>"An...object X... having a substantially flat surface"</i>. [1]</p> <p>If, on the basis of the description and general knowledge, the claim implies that the surface of the claimed object is considered to be flat within the limits of measurement usually employed in the relevant technical field, then the term is acceptable and the claim is clear.</p>
Example 2	<p>Claim: <i>"A process for...characterized in that the reaction mixture is heated to a temperature up to at least 80°C"</i>. [1]</p>

	<p>The approximate term “up to at least 80⁰C” would be interpreted (based on plain meaning) as a temperature of “<i>up to 80⁰C but not at exactly 80⁰C</i>”, i.e., the “up to” part implying a ceiling of 80⁰C while the “at least” part implying some flexibility in the claimed temperature value, which may go beyond the minimum of 80⁰C.</p> <p>The claim therefore would be considered unclear since the use of the term “up to at least” does not exactly define whether the temperature is at a maximum of 80⁰C or could go beyond 80⁰C.</p>
Example 3	<p>Claim (A): “A process for...characterized in that the reaction mixture is heated to a temperature of about 80⁰C.”</p> <p>Claim (B): “A process for...characterized in that the reaction mixture is heated to a temperature of approximately 80⁰C.”</p> <p>Claim (C): “An alarm clock comprising an alarm, wherein the alarm generates a sound at approximately 50 dB.”</p> <p>In the Examples, the terms “<i>about 80⁰C</i>”, “<i>approximately 80⁰C</i>”, and “<i>approximately 50 dB</i>” are to be interpreted as “80⁰C” and “50 dB”, respectively (i.e., the <u>last decimal place of the numerical value indicates its degree of accuracy</u>, if the description does not provide a definition for the approximate terms) or are to be interpreted in light of the definition provided in the description.</p> <p>If the claimed invention is clearly distinguishable from any prior art with respect to novelty and inventive step, the presence of the approximate terms (as interpreted) would be clear and acceptable. Otherwise, a lack of clarity should be raised.</p>

c. UNUSUAL PARAMETERS

Definition	<p>Parameters not commonly used in the field of invention. [4]</p> <p>An exception in defining product claims, parameters can be used if no other adequate means of defining a product is possible. However, the use of parameters in product claims should be known as “usual” in the pertinent art, which can be clearly and reliably determined either in the description or by objective procedures known to a skilled person.</p> <p>Parameters may be:</p> <ul style="list-style-type: none"> ● values of directly measurable properties (e.g., the melting point of a substance); or ● defined as mathematical combinations of varieties in the form of
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	<p>formulae.</p> <p>Obscure or unusual parameters may “hide” the fact that the claimed subject-matter is not novel; as such, lack of clarity should be raised. The method and/or means or measurements of the parameter values are, in principle, necessary for a clear definition of the parameter.</p> <p>However, this need not be included in the claim if:</p> <ol style="list-style-type: none"> i. a person skilled in the art would know which method to employ, ii. all known methods would yield the same result within the limits of accuracy, or iii. the description of the method is so long that its inclusion would render the claim lacking clarity and conciseness. <p>In the case of item (iii), the claim may include a reference to the description, but only when absolutely necessary. Otherwise, the method of measuring a parameter and/or a description of the parameter itself must appear completely in the claim.</p>
Example 1	<p>Claim: <i>“A structure comprising.... said structure further characterized by comprising an amorphous or near-amorphous film... comprising ZrO₂.”</i> [1]</p> <p>The term <i>“near-amorphous”</i> in the claim is an unusual parameter for the claimed film having ZrO₂, i.e., the said parameter does not have a precise or well-recognized meaning, thereby making the claim unclear.</p> <p>In this case, it may be possible to include in the claim what the parameter <i>“near-amorphous”</i> is (if defined in the description) to render clarity in the claim.</p>
Example 2	<p>Claim: <i>“Whiskey characterized in that the bouquet index B has a value between 12 and 20”.</i> [1]</p> <p>Lack of clarity should be raised if the parameter <i>“bouquet index B”</i> is not known or <i>“usual”</i> to a skilled person (i.e., measurable by means of known procedures).</p> <p>If defined in the description, the claim may include a reference to the description, but only when absolutely necessary (i.e., when the definition is lengthy that it would violate the conciseness requirement); or the method of measuring the parameter <i>“bouquet index B”</i> and/or a description of the parameter should appear completely in the claim.</p>
Example 3	<p>Claim: <i>“A compound consisting of A, 2-10 weight % B, and 10-12 weight units C per volume units of the end product”.</i> [1]</p> <p>The unit used to express the amount of component C (in <i>“weight units”</i>) does not have any acceptable meaning (an unusual parameter), which renders the said claim unclear.</p>

d. OPTIONAL FEATURES

<p>Definition</p>	<p>A term that purports to add a meaningful restriction to the claim but which in fact adds uncertainty. [4]</p> <p>Terms where optionally additional matters or selective matters are stated result in making the scope of the invention unclear. Examples of which are: “<i>when desired</i>”, “<i>if necessary</i>”, “<i>preferably</i>”, “<i>for example</i>” or “<i>e.g.</i>”, “<i>such as</i>”, “<i>more particularly</i>”, “<i>or the like</i>”, “<i>in particular</i>” or any similar expressions. [5]</p> <p>Although terms of this kind have no limiting effect on the scope of a claim, i.e., claim feature/s that are preceded by such terms should be regarded as entirely optional, discretionary or non-compulsory; they still lead to confusion over the intended scope of the claim.</p> <p>As such, <u>these terms should be deleted, regardless whether the said term is attached to an essential or non-essential feature</u> of the claimed invention (<i>description of “examples” or “preferences” should be properly set forth in the specification rather than the claims</i>).</p> <p>Furthermore, a <u>single claim that recites multiple “preferences” (or “preferred embodiments”)</u> renders the claim indefinite since the boundaries of the said single claim are not discernible. As such, regardless whether the features are essential or not, each “preferred” embodiment or feature should be set forth in succeeding dependent claims.</p>
<p>Example 1</p>	<p>Claim: “<i>Pharmaceutical composition...wherein said concentrated aqueous solution is diluted for intravenous administration with an isotonic aqueous solution, preferably 5% dextrose, and wherein the concentration of bimagrumab in the diluted solution is from 0.2 to 10 mg/ml.</i>” [3]</p> <p>In this example, the feature “preferably 5% dextrose” is considered unclear in that it would be interpreted as simply a ‘preferred option’ among other disclosed isotonic aqueous solutions, thereby introducing inaccuracy to the claim.</p> <p>The feature “preferably 5% dextrose” may be recited in a succeeding dependent claim to further define the claimed ‘isotonic aqueous solution’ (with the optional term “<i>preferably</i>” deleted).</p>
<p>Example 2</p>	<p>Claim: “<i>A compound according to Formula 1... wherein: R is halogen, for example, chlorine; X is...or a pharmaceutically acceptable salt thereof.</i>” [6]</p> <p>In this example, the optional term “for example” is unclear since the scope of the claim may be interpreted to include other halogens, aside from “<i>chlorine</i>”.</p> <p>Thus, “R” may be defined as “<i>halogen</i>” in the said claim and “<i>chlorine</i>” may be</p>

	<p>recited in a succeeding dependent claim (with the term “<i>for example</i>” deleted) or “R” may be directly defined as “<i>chlorine</i>”.</p>
Example 3	<p>Claim: “A <i>compound of Formula I...wherein R1, R2, and R3 are each independently hydrogen...optionally substituted (C1-C6)alkyl, optionally substituted (C1-C6)alkenyl...</i>”</p> <p>Markush-type claims recite a list of specific alternatively usable members or Markush groups. In some cases, Markush claims employ the use of optional terms, which may be considered unclear.</p> <p>In this Example, the term “optionally substituted” would mean that the group or variable referred to is either ‘unsubstituted’ or ‘can be substituted’ by any one or any combination of the radicals listed; thus, the use of such term would be considered clear.</p> <p>However, proper patentability assessment should be conducted to ensure that the scope of a Markush-type claim does not overlap with any relevant prior art.</p>
Example 4	<p>Claim: “A <i>method of making gourmet salt comprising the steps of: a) collecting sea water and brine solution, b) purchasing organic material such as seaweeds, black tiger shrimp heads, or dried shiitake mushrooms from...</i>” [6]</p> <p>The use of the term “<i>such as</i>” is unclear since it renders the claim indefinite as to whether the feature introduced by such language is a) merely exemplary of the remainder of the claim, and therefore not required, or b) a required feature of the claim.</p> <p>In the present instance, the claim recites the broad recitation, “organic material” and the claim also recites the narrower statement “seaweeds, black tiger shrimp heads, etc.”.</p> <p>The narrower types of “organic material” may be recited in a succeeding dependent claim (with the term “<i>such as</i>” deleted) or the optional term “<i>such as</i>” may be replaced with the term “<i>selected from</i>” in the same claim.</p>
Example 5	<p>Claim 1: “An <i>apparatus...wherein each container displays a unique machine-readable identifying reference, such as a bar-code.</i>”</p> <p>In this example, the bounds of the subject matter as claimed are not distinct, because the expression “such as a barcode” makes it unclear as to whether the claim covers (i) all “unique machine-readable identifying reference[s]”, (ii) only such references that are in some way similar to a bar code, or (iii) only a bar code.</p> <p>The feature “a bar-code” may be recited in a separate dependent claim to further define the generic term “unique machine-readable identifying reference”</p>

	(with the term “ <i>such as</i> ” deleted).
Example 6	<p>Claim: “A process for the production of a gasoline product from a light hydrocarbon feed comprising catalytically aromatizing a light hydrocarbon such, for example, light paraffins, olefins or naphthenes in an aromatization zone and producing effluent containing...” [6]</p> <p>In this example, the claim recites the broader “light hydrocarbon” and the narrower limitation “light paraffins, olefins or naphthenes”. The term “<i>such, for example</i>” makes it unclear in what condition on which the optionally added or selective matters are chosen, and thus, lack of clarity should be raised since the matters stated in the claim would be interpreted in many ways.</p> <p>The narrower limitations “light paraffins, olefins or naphthenes” may be indicated in a succeeding dependent claim (with the term “<i>such, for example</i>” deleted) or the optional term “<i>such, for example</i>” may be replaced with the term “<i>selected from</i>” in the same claim.</p>
Example 7	<p>Claim 9: “A myostatin or activin antagonist according to...wherein the human patients are men or post-menopausal women aged 50 years or older, preferably 60 years or older, more preferably 65 years or older, even more preferably 70 years or older.” [3]</p> <p>In this case, the “preferred” age groups of patients in a single claim are unclear as the boundaries that should be set forth in the claim are indefinite.</p> <p>Each of the “<i>preferred</i>” patient groups should be recited in succeeding dependent claims (with the optional terms deleted) as:</p> <p>Claim 9: “A myostatin or activin antagonist according to...wherein the human patients are men or post-menopausal women aged 50 years or older.”</p> <p>Claim 9(a): “A myostatin or activin antagonist according to...wherein the human patients are men or post-menopausal women aged 60 years or older.”</p> <p>Claim 9(b): “A myostatin or activin antagonist according to...wherein the human patients are men or post-menopausal women aged 65 years or older.”</p> <p>Claim 9(c): “A myostatin or activin antagonist according to...wherein the human patients are men or post-menopausal women aged 70 years or older.”</p>
Example 8	<p>Claim 1: “A method of using a communications and display device...wherein the display device is a touch screen device, preferably light-emitting diode (LED) display, more preferably organic light-emitting diode (OLED) display, and most preferably an active-matrix organic light-emitting diode (AMOLED) display.”</p> <p>Similar with Example 7, the “preferred” types of display device in a single claim</p>

	<p>are unclear as the boundaries that should be set forth in the claim are indefinite. Thus, the claim should be rejected for reciting preferred embodiments in a single claim.</p> <p>Each of the “<i>preferred</i>” types of display device should be recited in succeeding dependent claims (with the optional terms deleted) as:</p> <p>Claim 1: “<i>A method of using a communications and display device...wherein the display device is a touch screen device.</i>”</p> <p>Claim 2: “<i>The method of using a communications and display device of claim 1...wherein the touch screen device is a light-emitting diode (LED) display.</i>”</p> <p>Claim 3: “<i>The method of using a communications and display device of claim 2...wherein the light-emitting diode (LED) display is an organic light-emitting diode (OLED).</i>”</p> <p>Claim 4: “<i>The method of using a communications and display device of claim 2...wherein the organic light-emitting diode (OLED) is an active-matrix organic light-emitting diode (AMOLED).</i>”</p>
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e. ALTERNATIVE EXPRESSIONS

<p>Definition</p>	<p>A term or expression offering or expressing a choice.</p> <p>Where the matters defining the claimed invention are expressed as alternatives (“or”), and the alternatives have no similar characteristics or functions with each other, lack of clarity should be raised. [5]</p> <p>In some cases, where the matters defining the claimed invention are expressed using the term “and/or”, such would be considered clear, i.e., as per its plain meaning, “and/or” is interpreted either as a combination (e.g., “A and B”) or as alternatives (e.g., “A or B”); taking into consideration that the alternatives (“or”) should share similar characteristics or functions as stated above.</p> <p>Moreover, sufficient disclosure should be provided for both the combination and the alternative subject matters as per Section 35 of the IP Code, as amended. Otherwise, the necessary rejection should be raised if only one of the two interpretations is disclosed.</p>
<p>Example 1</p>	<p>Claim 1(A): “<i>A transmitter or a receiver which has a specific power supply...</i>” [5]</p> <p>Claim 1(B): “<i>One of a brake or a locking system...</i>” [6]</p>

	<p>In both Claims 1(A) and 1(B) above, there exist two (2) alternatives related to matters specifying the claimed invention; those alternatives, “transmitter or receiver” and “brake or locking system, do not have similar characteristics or function, thus making said claims unclear.</p> <p>In Claim 1(A), “transmitters” and “receivers” are totally different devices performing different functions; while in Claim 1(B), “brakes” and “locking systems” are not equivalent objects, and thus, do not share similar characteristics or functions.</p> <p>Claim 1(C): “...one of a rod or a bar...”</p> <p>In this example, the use of the alternative term “or” is clear as “rods” and “bars” are nearly similar objects having similar functions.</p>
Example 2	<p>Claim: “<i>The method of claim 1, comprising receiving, by the treatment chamber, transduction media wherein the transduction media comprises:</i> <i>(i) a base medium;</i> <i>(ii) cyto- and/or chemokines comprising recombinant human granulocyte colony stimulating factor (G-CSF), stem cell factor (SCF), thrombopoietin (TPO), fms-related tyrosine kinase 3 ligand (flt3 or flt3L), or interleukins selected from interleukin 3 (IL-3) or interleukin 6 (IL-6); and...</i>”</p> <p>In this Example, the claim relates to “(ii) a cytokine and a chemokine” (in combination) and to “(ii) a cytokine or a chemokine” (individually as alternatives).</p> <p>The use of the term “and/or” would be considered clear, given its plain meaning. However, other requirements such as sufficiency of disclosure must be satisfied for both the combination and the alternative subject matters.</p> <p>As for the term “or” used to enumerate the different types or categories of “cytokines and/or chemokines”, such would be considered clear since the enumerated types or categories share similar functions or characteristics.</p>

f. TRANSITIONAL TERMS (“Consisting” vs “Comprising”)

Definition	<p>Transitional terms define the scope of a claim with respect to what additional components or steps, if any, are included or excluded from the scope of the claim. The determination of what is included or excluded by a transitional phrase must be made on a case-by-case basis. [6]</p> <p>In drafting patent claims, the words “comprise” or “comprising” is to be interpreted by the broader meaning "include", "contain", or “characterized by”.</p> <p>The term “comprises” or “comprising” is an open-type transitional term and the</p>
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	<p>claim is construed as including all the technical features mentioned in a claim including other unnamed features that render the claim workable.</p> <p>On the other hand, the phrase “consists” or “consisting” is interpreted as a closed-type transitional term, which means that all the technical features mentioned in a claim are limited to those specifically enumerated and therefore would exclude other features that also form part of the invention.</p> <p>The transitional phrase "consisting essentially of" or "comprising substantially of" can be construed as including specific materials or steps, and those not materially affecting the essential characteristics of the claimed invention. This is particularly used in the case of chemical compounds or compositions. [4], [6]</p> <p>Other transitional phrases such as "having" or “which is” must be interpreted in light of the description (and/or the drawings) to determine whether open or closed claim language is intended. [6]</p> <p>The transitional phrase "composed of" or “composing of” has been interpreted in the same manner as either "consisting of" or "consisting essentially of". [6]</p> <p>It is important that the Examiner considers which type of transitional phrase is used in the claims for proper interpretation and evaluation of novelty and inventive step. Additionally, the type of subject matter to be searched depends on the type of transitional phrase.</p>
Example 1	<p>Claim: “An <i>expression vector</i> comprising a polynucleotide having the sequence of SEQ ID NO: 1.”</p> <p>The elements claimed in the example will not be limited to a polynucleotide having the SEQ ID NO: 1.</p> <p>Other elements not specifically recited may also be included, and the only restriction is that it contains, at least, SEQ ID NO: 1.</p>
Example 2	<p>Claim: “A <i>therapeutic composition</i> consisting of a protein having the sequence of SEQ ID NO: 2 and a suitable buffer.”</p> <p>The claim is to be interpreted as a composition limited to the components SEQ ID NO: 2 and a suitable buffer.</p> <p>Lack of clarity would result if any additional component of the composition (e.g., components of the suitable buffer) is recited in any succeeding claim. A closed-type transitional term excludes, from the scope of the claim, any additional component to the mixture, which are described in the specification.</p>
Example 3	<p>Claim: “A <i>composition</i> consisting of 50% by weight of A, 30% by weight of B, and 20% by weight of C...”</p>

	<p>In this example, the closed transitional phrase “consisting of” covers only components A, B, and C in the composition. Thus, the presence of any additional component would be considered unclear.</p> <p>Further, as the said components are defined by their proportions expressed in percentages, the total amount of each of the components in percentages should add up to 100%.</p>
Example 4	<p>Claim: “<i>An internal combustion engine apparatus having a controlled amount control device...</i>” [1]</p> <p>As defined above, the transitional term “having” must be interpreted in light of the description to determine whether an “open” or “closed” claim language is intended. Thus, a closer inspection and understanding of the description is necessary to determine the clarity and extent of the claim.</p>

ii. TYPE OF DEFINITION

g. SUBJECT-MATTER (TO BE PROTECTED)

Definition	<p>The object of the definition in the claim, the entity or activity that is being claimed.</p> <p>Sometimes, although the wording of the claim makes sense technically, it is legally uncertain as to what or would not fall within the protection sought, i.e., the subject-matter to be protected is not clear.</p>
Example 1	<p>Claim 1: “<i>A telephone communication system with a plurality of multiparty lines and a method for implementing a reverting call, characterized by...</i>”</p> <p>In the present claim, a rejection of lack of clarity should be raised, i.e., it is not clear whether the subject matter to be protected is directed to a “telephone communication system” (an entity), or to “a method for implementing a reverting call” (an activity).</p> <p>Consequently, the claim should be re-drafted wherein the subject matter in each claim should be limited to one (1) category only, either as an entity (“telephone communication system”) or as an activity (“method for implementing a reverting call”).</p>
Example 2	<p>Claim 1: “<i>In a telephone station set including an automatic dialer, and a dial tone detector, comprising...</i>”</p> <p>In the present claim’s preamble, the use of the term “<i>In a...</i>” does not provide a</p>

	<p>clear indication as to whether the subject matter of the claim is referring to a “telephone station”, an “automatic dialer”, or a “dial tone detector”.</p> <p>Moreover, the use of the term “...including” between the “telephone station set” and “an automatic dialer” as a transitional phrase in the preamble still does not provide a clear indication that the features “automatic dialer”, and “dial tone detector” are merely part of the features of the telephone station set.</p> <p>The term “including” can be construed as one of the possible constructions of the claim and may also be construed that the features “telephone station set”, “automatic dialer” and “dial tone detector” are independent of each other.</p> <p>The claim must only be directed to a single subject matter and since there are multiple instances where clarity issues are found to be present in the claim, the claim should then be rejected.</p>
Example 3	<p>Claim: “A telephone station set, an automatic dialer, and a dial tone detector, comprising...”</p> <p>Similar to Example 2, the claim should be rejected for lacking clarity for indicating not one, but multiple subject matters in the preamble (a “telephone station”, an “automatic dialer” and a “dial tone detector”) by mere use of a “comma”.</p>

h. PRODUCT-BY-PROCESS CLAIM

Definition	<p>A claim defining a product in terms of the process by which it is manufactured. A product-by-process claim should include all the necessary process parameters such as the starting materials, process conditions, etc.</p> <p>A product-by-process claim is construed as a claim to the product as such; thus, such claims are only admissible if the products <i>per se</i> fulfil the requirements for patentability, i.e., inter alia that they are new and inventive (a product cannot be rendered novel merely by the fact that it is produced by means of a new process).</p> <p>A product-by-process claim preferably takes the form "Product X obtainable by process Y"; however, since such claims are directed to the product <i>per se</i>, any wording equivalent thereto may also be acceptable, such as, “according to the process of”, “obtained by”, “produced by”, “purified from”, “the product of the process comprising the steps of”, “prepared in accordance with the method of”, or “by a process which comprises the steps of”. [4]</p> <p>Furthermore, a product-by-process claim is only admissible, as an <u>exception</u>, when there is no information available in the application that would enable to claim and define the product satisfactorily by reference to its</p>
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	composition, structure or some other testable parameter.
Example 1	<p>Claim 1: <i>“Process for preparing a product X characterized by steps A, B, C”</i>. [1] Claim 2: <i>“Product X when obtained by process of Claim 1”</i>. Claim 3: <i>“Product X as obtainable by process of Claim 1”</i>.</p> <p>The wordings of claims 2 and 3 as product-by-process claims are acceptable.</p> <p>However, claims 2 and 3 would lack clarity (and conciseness) since there is no patentable difference between the said claims (undue repetition of claims having similar scope).</p>
Example 2	<p>Claim 1: <i>“A compound of the Formula...”</i> [3] Claim 27: <i>“A process of preparing the compound of the Formula...”</i> Claim 33: <i>“A compound according to claim 1 obtainable by the process of claim 27...”</i></p> <p>In this case, the product-by-process claim 33 is considered to lack clarity (and conciseness), i.e., since the compound <i>per se</i> has already been defined in terms of its chemical formula, it need not be further defined in terms of its process of preparation, especially if the compound in claim 1 is found to have met the novelty and inventive step criteria. Thus, the said claim 33 should be deleted.</p>
Example 3	<p>Claim: <i>“Wash-free rice manufactured by a wash-free rice manufacturing method comprising steps of...”</i></p> <p>The claimed product-by-process is clear and acceptable.</p>

i. FEATURE DEFINED IN RELATION TO A FURTHER UNCLAIMED APPARATUS OR DEVICE

Definition	<p>A feature that serves to describe a claimed apparatus or device but is specified by reference to a feature of another apparatus or device that is not part of the claimed subject matter.</p> <p>Such references to an unclaimed apparatus or devices are acceptable if, for example, the feature concerned is standardized and the relationship is clear, so that the reference does not introduce obscurity in respect of the subject matter defined in the claim.</p>
Example 1	<p>Claim: <i>“A metal plate having a depression, the depression being the size and shape of a credit card...”</i>. [1]</p> <p>In this example of a claim directed to a <i>“metal plate”</i>, reference is made to the size and shape of a <i>“credit card”</i> to define the metal plate <i>“depression”</i>.</p>

	Since credit cards are of a standard size and shape, the use of such standard to refer to or describe the claimed metal plate's " <i>depression</i> " would be acceptable to render the said claim as clear.
Example 2	<p>Claim: "A <u><i>cylinder head</i></u> for an engine characterized in that it is <u><i>connected to the engine by...</i></u>" [1]</p> <p>The cylinder head is defined in relation to an engine ("...connected to the engine...") but that engine is probably not meant to be included in the claimed subject matter.</p> <p>The above claim is acceptable since the phrase "...connected to the engine by..." merely describes the function/application of the cylinder head to the engine but is interpreted as not part of the scope of the claim.</p>

j. FUNCTIONAL FEATURE

Definition	<p>A claim that is defined in terms of function, rather than in:</p> <ul style="list-style-type: none"> ● structural terms (when defining an entity), or ● process steps (when defining an activity). <p>For claims to a physical entity (product, apparatus, etc.) that seeks to define the invention by reference to features relating to the entity's function, such are to be construed as claims to the physical entity per se, but which are "suitable" for the stated function (<i>the "suitability" part is considered as a non-limiting feature for the claimed product or apparatus</i>).</p> <p>Claims that seek to define the invention in terms of a function would normally be preceded by the expressions "...for...", "...as..." or "...suitable for...".</p> <p>On the other hand, a product or apparatus claim that recites a functional feature preceded by the expression "<i>when used</i>" or "<i>use of</i>" is interpreted as a product or apparatus limited by the recited function in a particular field. Clarity may be present; however, the patentability of the said product or apparatus should be appropriately determined.</p> <p>In the pharmaceutical and medical science fields, claims defined in terms of a function may be considered unclear and may require redrafting in its proper medical use format. Some examples of claims defined by a function include:</p> <ul style="list-style-type: none"> ● "A compound <i>for inhibiting</i> D-2-hydroxyglutarate production"; ● "A D-2-hydroxyglutarate <i>inhibitor</i>..."; ● "A compound as <i>inhibitor of</i>..."; ● "A compound <i>for treating</i> a tumor..."; ● "A compound as an <i>antitumor agent</i>", etc. <p>In these Examples, the "suitability" interpretation for the functional terms or</p>
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	<p>definitions is also applied.</p> <p>Lack of clarity may be raised in case the said terms or definitions cannot be distinguished from any relevant prior art with respect to novelty and inventive step. Also, re-drafting the claims into its proper medical use format may be necessary.</p> <p>For additional guidance on how to interpret functional features in the pharmaceutical and medical science fields, refer to the MPEP, pages 124 to 125, para. 4.2.</p>
Example 1	<p>Claim 1: <i>“A mould for molten steel... having a particular form”</i>. [1]</p> <p>Prior Art: <i>“A mould for making ice cubes in a domestic refrigerator... having the same form”</i>.</p> <p>In this example, the limitation that the mould must be suitable for (i.e., having the technical characteristics that enable it to be used for receiving molten steel), would exclude the types of plastic and light alloy moulds used in domestic refrigerators.</p> <p>The claim is considered clear and acceptable since it implies certain limitations for the mould.</p>
Example 2	<p>Claim 1: <i>“A process characterized by steps A, B, C.”</i> [1]</p> <p>Claim 2: <i>“Apparatus when used for carrying out the process of Claim 1, characterized by A, B and C.”</i> [1]</p> <p>Claim 3: <i>“Apparatus for carrying out the process of Claim 1, characterized by A, B, C”</i>. [1]</p> <p>In this example, claim 2 is considered clear. A claim to an apparatus “when used” for a particular process is construed as a claim confined to the use of the apparatus in such a process. <i>(However, in terms of novelty, any prior art that discloses the same apparatus and use would be considered novelty destroying).</i></p> <p>Claim 3 is construed as an “apparatus suitable for carrying out the process and comprising the features A, B, and C”. Clarity may be present; however, the claim should be subject to the assessment of novelty and inventive step.</p>
Example 3	<p>Claim: <i>“An apparatus for shaking articles, comprising: a base, a container, legs and means for oscillating the container on the legs”</i>. [1]</p> <p>Description: <i>An apparatus for shaking articles comprising...means for oscillating the container on the legs, wherein the said means for oscillating is a vibratory motor.</i></p>

	<p>In this example, the claim feature “means for oscillating...” is <i>broadly</i> defined by the function rather than its structural arrangement or by the actual means in achieving the desired function; thus, the said claim feature is unclear and should be rejected.</p> <p>Amendment may be necessary, e.g., by replacing the broad claim feature “means for oscillating” by the specific “vibratory motor for oscillating” as recited in the description.</p>
<p>Example 4</p>	<p>Claim: “A <u><i>D-2-hydroxyglutarate production inhibitor</i></u> comprising a compound according to...wherein...”.</p> <p>Claim: “An <u><i>antitumor agent</i></u> having an <i>isocitrate dehydrogenase 1 gene mutation</i>, comprising a compound...wherein...”</p> <p>In the above claims, the features “D-2-hydroxyglutarate production inhibitor” and “antitumor agent” pertain to the functions of the claimed compounds.</p> <p>If a claim having a functional feature is drafted in a “two-part form” (Jepson-type), the presence of such functional features in the preamble may imply that such features are already known properties or functions of the claimed compound (which should be confirmed by the background art in the description or the prior art). If such functions are known, lack of clarity need not be raised.</p> <p>However, if neither the description nor any prior art mentions such functions as known properties for the claimed compound, lack of clarity should be raised and the proper format for such should be required (either in a first medical use or second or further medical use format, whichever is applicable).</p>
<p>Example 5</p>	<p>Claim: “A <i>service method for offering service points depending on an amount of commodity purchased at a shop on the Internet, comprising the steps of:</i></p> <ul style="list-style-type: none"> • <i>receiving by a server, an amount of service points offered and a name of the person to whom the said service points are offered via the Internet;</i> • <i>acquiring by the said server, the e-mail address of the said person from a customer list storage means based on the name of the said person;</i> • <i>adding by the said server, the said service points to the accumulated points of the said person stored in the said customer list storage means;</i> <i>and</i> • <i>notifying by the said server, to the said person that the said service points have been given by e-mail using the said e-mail address of the said person.”</i> <p>In this example, the claim is directed to an ICT/CII invention. For claims related specifically to “information processing”, they are normally described by the functional means of a computer (i.e., server, client, terminal, etc.).</p>

	<p>In this method claim, information processing is tangibly accomplished with the aid of a server under instruction from a computer software and is concretely realized by using hardware resources.</p> <p>The method claim is considered clear and acceptable even if the features as described in the body of the claims are broadly defined by just a computer plus its functional features expressed as instruction from a computer software.</p>
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k. MECHANISM OF ACTION [8]

Definition	<p>In the pharmaceutical and medical science fields, a medical use claim may be defined in terms of a specific biochemical interaction through which a drug substance produces its pharmacological effect or on how a drug or a biological substance produces an effect in the body.</p> <p>Medical use claims are drafted either as a “product for use in therapy” (first medical use) or as “use of a (known) product in the manufacture of a medicament for therapy of a specific pathological condition/s” (second or further medical use).</p> <p>For purpose-limited product (first-medical-use) claims, i.e., for compounds (<i>subject matter of the invention, as claimed</i>) and <u>medical use/s that are subsidiary to the main compound claim, mechanisms of action may be clear</u> if the said product can only be defined either in such terms or cannot otherwise be defined more precisely without unduly restricting the scope of the claims; provided, that the said product is truly novel and inventive over any prior art.</p> <p>For purpose-limited process claims (second or further medical use) claims, i.e., for claims directed to a second or further medical use of known compounds or substances (<i>subject matter of the invention, as claimed</i>), <u>mechanisms of action cannot be accepted as a means of defining the invention and are thus unclear</u> - for such medical use claims that involve a known compound or substance, the clear and distinguishing (patentable) features should lie in the particular pathological condition/s that are meant to be treated instead of the pharmacological effect exhibited by the said compound or substance.</p>
Example 1	<p>Claim 1: “Use of compound X in the manufacture of a medicament for treating a patient by influencing the binding of growth factor to tumor cells.” [8]</p> <p>Claim 1: “Use of compound X in the manufacture of a medicament for the normalization of the abnormal activity of the glycine site of the NMDA receptor in neurons.” [8]</p> <p>In each of the above main claims, compound X is already known or not novel; thus, the said claims (second or further medical use claims) should be rejected</p>

	<p>for lack of clarity for reciting mechanisms of action (the pharmacological effect of the claimed compound X) instead of a defined treatment of a disease or a pathological condition.</p> <p>The said features are considered to cover a number of undefined diseases that may be related to the claimed pharmacological effects of the compound X.</p> <p>Further, cases involving known compounds or substances may raise patent eligibility issues within the meaning of Section 22.1 of the IP Code, as amended (for details on patent eligibility issues involving known compounds or substances, refer to the applicable QUAMA Guidelines).</p>
<p>Example 2</p>	<p>Claim 1: <i>“Use of compound X for the manufacture of a medicament for the treatment of neurological disorders via normalization of the abnormal activity of the glycine site of the NMDA receptor in neurons.”</i> [9]</p> <p>Prior Art: <i>Compound X for treating neurological disorders.</i></p> <p>In this case, although a specified disease is recited, the claim is still unclear since the mechanism of action does not provide any new or improved technical effect on the use of the same compound X in the treatment of the same disease (the discovery of a mechanism of action or an alternative mechanism of action does not alter the technical effect exhibited by the known substance for the same pathological condition).</p> <p>Further, cases involving known compounds or substances may raise patent eligibility issues within the meaning of Section 22.1 of the IP Code, as amended (for details on patent eligibility issues involving known compounds or substances, refer to the applicable QUAMA Guidelines).</p>

I. RESULT TO BE ACHIEVED

<p>Definition</p>	<p>A claim that is described in terms of a desired result or effect rather than in structural terms or by process parameters.</p> <p>As a general rule, claims which attempt to define the invention or a feature thereof by a result to be achieved should not be allowed, in particular if they only amount to claiming the underlying technical problem.</p> <p>However, they may be allowed if the invention can only be defined in such terms or cannot otherwise be defined more precisely without unduly restricting the scope of the claims.</p> <p>Provided that the “result to be achieved” can be directly and positively verified by tests or procedures and is adequately specified in the description.</p>
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	By "tests or procedures" would mean involving nothing more than trial and error, or are known to the person skilled in the art, and which do not require undue experimentation.
Example 1	<p>Claim: <i>"A pill characterized in that it cures baldness."</i> [1]</p> <p>In this example, the feature "characterized in that it cures baldness" is merely a statement of a problem to be solved, i.e., the claim recites a desired result, directly or indirectly, rather than the manner of achieving the result, which is what the invention should normally correspond to.</p> <p>The scope of protection for the claim with regards to the essential features of the invention is unclear and should be rejected.</p>
Example 2	<p>Claim: <i>"An audio encoder for improving quality and coding efficiency."</i></p> <p>In this example, the claim is a mere statement of achieving the desired result of the invention rather than the manner or means of achieving the desired result; thus, the claim is unclear and should be rejected.</p> <p>For the above claim to be considered clear, the structurally-related means of achieving the desired result (parts or components of the claimed "audio encoder") should be recited in the claim.</p>

m. NEGATIVE LIMITATION (DISCLAIMER)

Definition	<p>A statement in a claim identifying certain technical features as being expressly excluded from the protection claimed.</p> <p>Generally, the subject matter of a claim is defined by means of positive features, indicating the presence of certain technical elements or features. <u>However, as an exception, it may also be defined by means of a negative limitation or a disclaimer</u>, expressly stating the absence of particular elements or features. [4], [7]</p> <p>Negative limitations or disclaimers may relate to structural or functional features and may relate to either a physical entity or an activity. [4]</p> <p>A disclaimer restricts the scope of protection without contributing to the invention; <u>it may be used only when the claim's remaining subject matter cannot be defined more clearly and concisely by means of positive features.</u></p> <p>Further, a disclaimer may be used to negate the lack of novelty of a claimed invention. A specific subject matter or features of a prior art may be excluded by a disclaimer even in the absence of support for the said exclusions in the originally filed description. [7]</p>
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	<p>In case a disclaimer is inevitable in a claim, it should be properly worded in order to satisfy the requirement for clarity, e.g., in terms of a prior art, a disclaimer should clearly point out the technical feature/s of the said prior document that is/are to be excluded from the scope of a claim. A mere reference to the prior document would not be considered an acceptable form of a disclaimer.</p>
Example 1	<p>Claim: “A compound with the general formula (X, Y, Z) with the exception of the derivatives, disclosed in the patent specification EP...” [1]</p> <p>In the Example, it is not clear which particular derivatives in the document referred to are to be excluded from the scope of the present claim; hence, lack of clarity should be raised.</p>
Example 2	<p>Claim: “Products obtained via the formula (1) except those for which R1= H, X= Br and Z= Na.” [1]</p> <p>The claim is clear and acceptable since the exceptions that are disclaimed are identified unambiguously.</p>
Example 3	<p>Claim: “...is a non-magnetic material...”</p> <p>Description: “...all the materials are made of non-magnetic, magnetic, etc.”</p> <p>The negative limitation appears acceptable since it clearly covers all materials except those that are magnetic.</p>

n. TRADE NAME

Definition	<p>An arbitrarily adopted name given to an article by a manufacturer or retailer to identify it as being produced or sold by him.</p> <p>The use of trade names in a claim should not be allowed unless it is unavoidable. They may be allowed exceptionally if they are generally recognized as having a precise meaning.</p>
Example 1	<p>Claim: “A composition comprising Persil™.” [1]</p> <p>“Persil” is a trade name for a well-known brand of detergent, but it does not have a precise meaning in patent terms as its composition changes with time.</p> <p>Therefore, in this case, even if the composition of “Persil” is clearly identified in the description, its use in the claim is unclear and should not be allowed. Instead, the actual components should be listed in the claim.</p> <p>The use of trade names in a claim should not be allowed unless it is unavoidable.</p>

	They may be allowed exceptionally if they are generally recognized as having a precise meaning.
Example 2	<p>Claim: <i>“Housing for shielding from electromagnetic interference, comprising a first housing component with a first Velcro-type fastening element and a second housing component with a second Velcro-type fastening element...”</i></p> <p>In this example, the use of the trade name “Velcro” is clear. Velcro has a fixed and definite meaning: having complementary parts that adhere to each other when pressed together and adapted for use as a closure fastener.</p> <p>Further, the term “Velcro” has become internationally accepted as a standard descriptive term and has acquired a precise meaning. Additionally, it should be noted that the use of trade name can be used in a claim only if its meaning has been adequately defined in the specifications, whereby it imparts specific limitations to the claim.</p>

o. REFERENCE TO THE DESCRIPTION (OMNIBUS CLAIM)

Definition	<p>A statement in the claim that refers the reader to the description to find the definition of claimed subject matter, or elements of it.</p> <p>A claim that includes a reference to the description is normally not allowable. The onus is on the Applicant to demonstrate that this is an exceptional case, in which it is absolutely necessary to rely on the reference to the description or drawings to define the subject matter to be protected.</p> <p>An example of an allowable exception would be that in which the invention involved some peculiar shape, illustrated in the drawings, but which could not be readily defined either in words or by a simple mathematical formula. Another special case is that in which the invention relates to chemical products some of whose features can be defined only by means of graphs or diagrams.[7]</p>
Example 1	<p>Claim: <i>“A cabinet substantially as hereinbefore described with reference to any one of the accompanying Figures 1 to 5.” [1]</i></p> <p>The claim is unclear for referring to the “accompanying Figures 1 to 5”, i.e., it is unclear which features in Figures 1 to 5 are to form part of the scope for the claimed “cabinet”.</p>
Example 2	<p>Claim: <i>“The isolated crystalline form...characterized by an X-ray powder diffraction pattern substantially similar to Figure 5.”</i></p> <p>For inventions involving polymorphs, claims would normally contain references to its powder diffraction pattern as obtained by X-ray Powder Diffraction (XRPD) technique. An XRPD pattern contains a number of peaks at specific 2-theta</p>

	<p>values, which provides the unique and distinguishing features of a specific polymorph.</p> <p>In some cases, the claims recite the specific highest intensity peak values in the XRPD pattern for the claimed polymorph; while in others, references are made to the Figure/s in the drawings (an omnibus claim), which shows a graphical representation of the claimed polymorph's XRPD pattern.</p> <p>In the above Example, the omnibus claim made a direct reference to Figure 5 instead of reciting the specific peak values for the claimed crystalline form; thus, the claim is unclear, i.e., the reference to "Figure 5" would not be considered as an exception since it is possible to recite in the claim the unique peak values for the claimed crystalline form.</p>
Example 3	<p>Claim: "<i>An apparatus as substantially shown and described in the description comprising a base or platform, upright stops for the side and end of the leaves and a stop adjacent to said first stop, for the ends of the boards.</i>"</p> <p>In this example, the claim includes the phrase "...as <i>substantially shown and described in the description</i>...", which is unnecessary and therefore unclear.</p> <p>Although the structural features are recited for the claimed apparatus, lack of clarity should still be raised for referring to the description.</p>

p. REFERENCE SIGN/S; TEXT IN BRACKETS OR PARENTHESES

Definition	<p>A reference sign, usually a numeral or letter, is used in a drawing to identify a particular feature.</p> <p>In a claim, a reference sign may be in brackets or parentheses after the corresponding feature to increase the intelligibility of a claim, without limiting the scope.</p> <p>Texts in brackets or parentheses are not considered to fall within the expression "reference signs" and usually not allowed.</p>
Example 1	<p>Claim: "<i>A (concrete) moulded brick characterized by...</i>" [1]</p> <p>The term in brackets ("concrete") is not a reference sign and is not clear whether this feature is intended to limit the claim.</p>
Example 2	<p>Claim: "<i>Valve arrangement (valve seat 12, valve element 27, valve seat 28) ... pressure (high pressure) ...</i>" [1]</p> <p>For the same reasons as indicated in Example 1, it is not clear whether the features added to reference signs are intended to limit the claim, e.g. by</p>

	specifying the composition of the and by limiting the pressure to high pressure.
Example 3	<p>Claim: "... screw (13-Figure 3), ... nail (14-Figure 4) ..." [1] Claim: "... screw (13), ... nail (14) ..." [1]</p> <p>Additional reference to the figures (Figure 3, Figure 4) in which particular reference signs (13, 14) are to be found merely helps the reader to identify more quickly where the reference signs appear in the drawings, and so are considered clear.</p>
Example 4	<p>Claim: "... (meth)acrylate..." [1]</p> <p>Features in parentheses (or brackets) in chemical applications are often admissible; provided, that such features have a generally accepted meaning.</p> <p>In the present example, the term (meth)acrylate is known as an abbreviation for acrylate or methacrylate."</p>
Example 5	<p>Claim: "... (wherein... is not a trifluoromethyl group) ..." [3]</p> <p>The use of parentheses makes the claim unclear whether the feature is intended to limit the claim.</p>

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