

ASPEK HUKUM PENYUSUNAN DESKRIPSI DAN KLAIM PATEN

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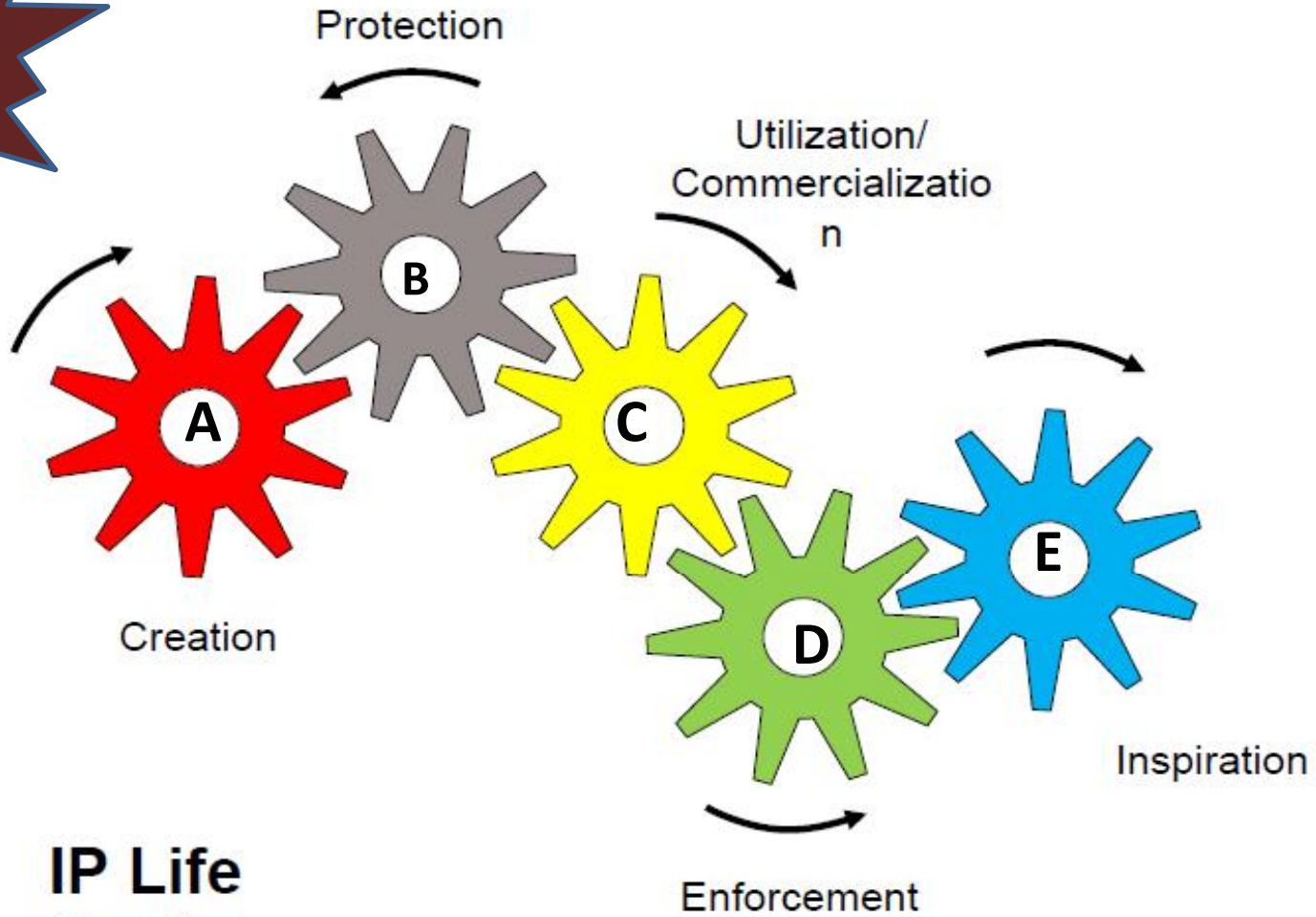
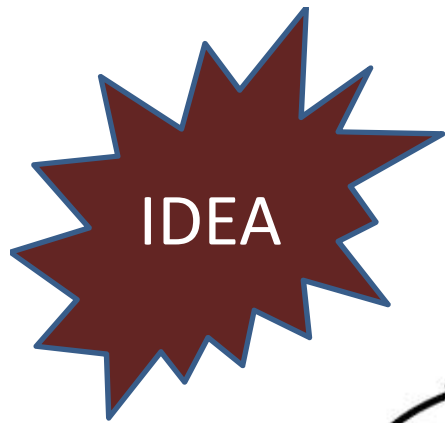
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**IP Life
Cycle**

❖ Apakah paten itu?

- ✓ Paten adalah **hak eksklusif** yang diberikan oleh Negara kepada inventor atas hasil invensinya di bidang teknologi **untuk jangka waktu tertentu melaksanakan sendiri invensi** tersebut atau memberikan persetujuan kepada pihak lain untuk melaksanakannya.

❖ Apa yang dapat dipatenkan?

- ✓ Yang dapat dipatenkan adalah **invensi**, yakni **ide inventor** yang dituangkan kedalam suatu **kegiatan pemecahan masalah** yang **spesifik di bidang teknologi** dapat berupa :
 - **produk** atau **proses** atau
 - **penyempurnaan dan pengembangan produk atau proses.**

❖ Apa syarat suatu invensi dapat diberi paten?

1. BARU / NOVEL

- Invensi tsb tidak sama dengan teknologi yang diungkapkan sebelumnya (ps. 3 ay.1)

2. MENGANDUNG LANGKAH INVENTIF

- Jika invensi tersebut bagi seseorang yang mempunyai keahlian tertentu di bidang teknik (terkait) merupakan hal yang tidak dapat diduga sebelumnya (ps.2 ay.2)

3. DAPAT DITERAPKAN DALAM INDUSTRI

- Jika invensi tersebut dapat dilaksanakan dalam industri sebagaimana yg diuraikan dalam permohonan (ps.5)

❖ Invensi apa yg tidak dapat diberi paten?

- | | |
|----|---|
| a. | Proses atau produk yang pengumuman dan penggunaan atau pelaksanaannya bertentangan dengan peraturan perundang-undangan yang berlaku, moralitas agama, ketertiban umum, atau kesusilaan; |
| b. | Metode pemeriksaan, perawatan, pengobatan dan/ atau pembedahan yang diterapkan terhadap manusia dan/atau hewan |
| c. | Teori dan metode di bidang ilmu pengetahuan dan matematika; |
| d. | <ul style="list-style-type: none">i. semua makhluk hidup, kecuali jasad renikii. Proses biologis yang esensial untuk memproduksi tanaman atau hewan, kecuali proses non-biologis atau proses mikrobiologis |

❖ Apa syarat suatu invensi dapat diberikan PATEN SEDERHANA?

1. BARU
2. MEMPUNYAI NILAI KEGUNAAN PRAKTIS DISEBABKAN OLEH BENTUK, KONFIGURASI, KONSTRUKSI, ATAU KOMPONENNYA
3. DAPAT DITERAPKAN DALAM INDUSTRI YANG BERUPA PRODUK.

❖ Bagaimana membuktikan adanya **invensi** tersebut?

- ✓ dengan TULISAN, yang disebut **SPESIFIKASI PATEN**, yg terdiri dari:
 - Judul invensi;
 - Deskripsi tentang invensi;
 - Klaim atau beberapa klaim invensi;
 - Abstrak invensi;
 - Gambar (jika diperlukan)

❖ Bagaimana membuktikan bahwa invensi tersebut adalah **BARU**?

- ✓ Menguraikan bahwa invensi tsb. berbeda dengan teknologi yang diungkap sebelumnya (**PRIOR ART**) baik untuk :
 - Teknologi yang telah diberikan (granted) maupun sedang di mohonkan (pending) di Indonesia atau di luar Indonesia
 - Teknologi yang diungkap di Indonesia maupun di luar Indonesia.
 - Teknologi yang telah diungkap dg lesan, tulisan, peragaan, penggunaan, atau cara lain yang memungkinkan seorang ahli untuk melaksanakan invensi tersebut.

❖ Bagaimana menuangkan Prior Art Paten (granted/pending) dalam Deskripsi?

1. Tuangkan data informasi paten yang relevan seperti nomor paten, judul, penemu, invensi terkait dan klaim invensi
2. Buktikan bahwa klaim invensi yang kita ajukan adalah berbeda dengan PRIOR ART

❖ Bagaimana membuktikan invensi tsb. mengandung langkah inventif?

- ✓ Tuangkan dalam deskripsi bahwa invensi tersebut bagi seseorang yang mempunyai keahlian tertentu di bidang teknik (yang relevan) merupakan hal yang tidak dapat diduga sebelumnya
- ✓ Tidak dapat diduga invensi tersebut di dasarkan pada keahlian orang yang ada sebelumnya.

❖ Bagaimana membuktikan bahwa invensi tsb. dapat diterapkan dalam industri?

✓ Ungkapkan secara jelas dan lengkap tentang bagaimana invensi tersebut dapat dilaksanakan oleh orang yang ahli di bidangnya.

❖ Bagaimana membuktikan nilai kegunaan praktis? (paten sederhana)

- ✓ Buktikan dalam deskripsi bahwa disebabkan oleh bentuk, konfigurasi, konstruksi, atau komponennya menyebabkan adanya NILAI KEGUNAAN PRAKTIS
- ✓ Juga membuktikan adanya kebaruan dan dapat diterapkan dalam industri

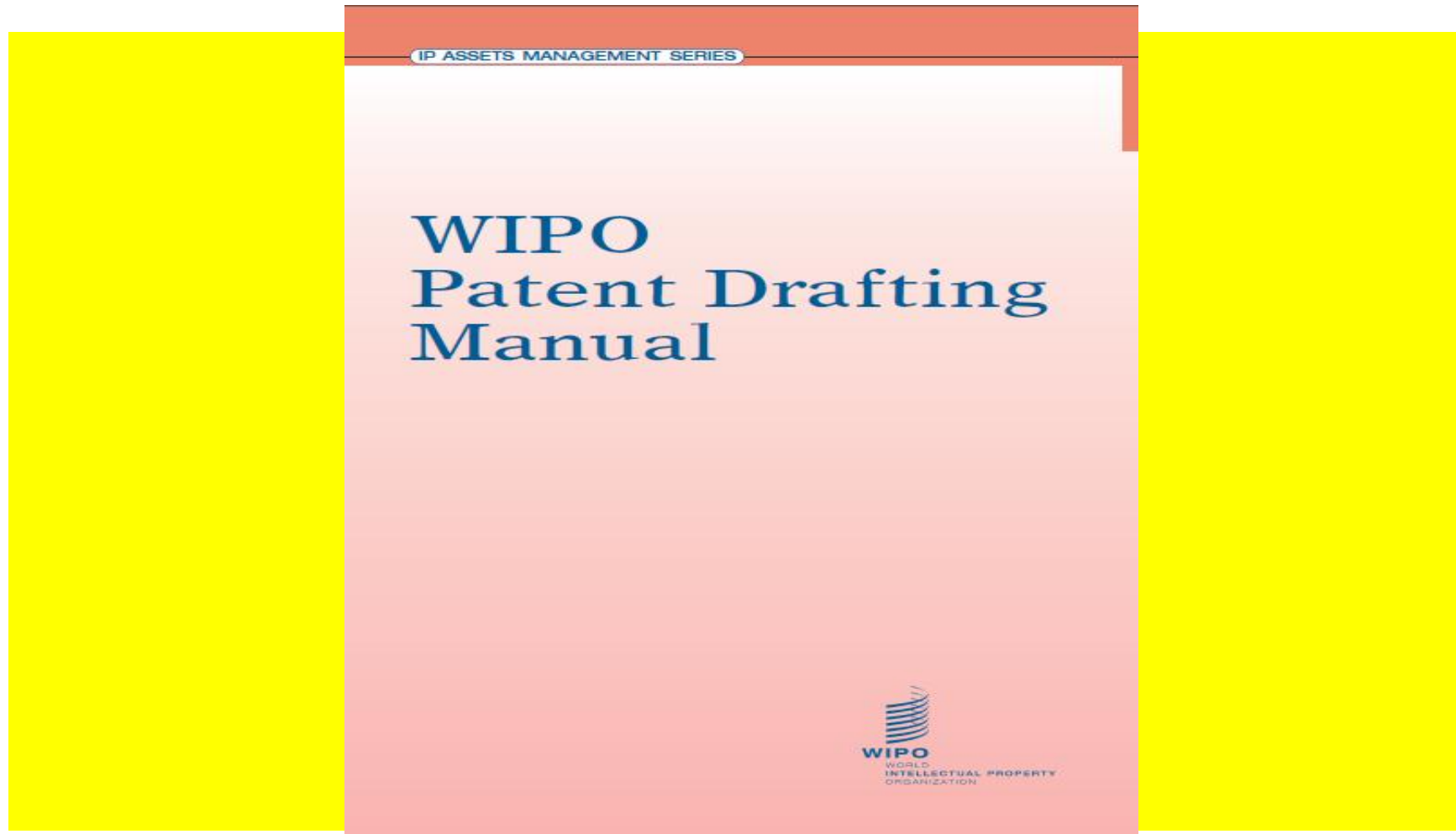
❖ Bagaimana jika pemohon tidak membuktikan adanya kebaruan, langkah inventif dan dapatnya diterapkan dalam industri?

- ✓ Permohonan tersebut tidak jelas dan tidak lengkap
- ✓ Permohonan tersebut kabur (obscuur)
- ✓ Pemeriksa paten sulit menyelesaikan pemeriksaan untuk mendapatkan alasan dapat diterima atau ditolakinya paten atas invensi yang bersangkutan
- ✓ Pemohon wajib membuktikan. Jika pemohon telah memberikan pembuktian, maka beban pembuktian beralih kepada Pemeriksa Paten untuk membuktikan sebaliknya (bahwa apa yang didalilkan oleh pemohon adalah tidak benar).
- ✓ Jika Pemeriksa tidak menemukan bukti sebaliknya tersebut maka Paten harus diberikan.

❖ Bagaimana jika pemohon telah membuktikan kebaruan, langkah inventif dan dapat diterapkan dalam industri namun Pemeriksa Paten tidak dapat membuktikan hal sebaliknya?

- ✓ Pemeriksa paten harus memberikan persetujuan invensi dapat diberi paten
- ✓ Jika waktu 36 bulan habis dan pemeriksa tidak menemukan bukti sebaliknya, bagaimana ? (UU belum mengatur)
- ✓ Apakah Pemohon punya hak menuntut? Ya, tuntutan sebaiknya diajukan (utamanya jika invensi tersebut bernilai tinggi bagi pemohon).

❖ Bagaimana menulis KLAIM sebagai inti atau ruang lingkup invensi

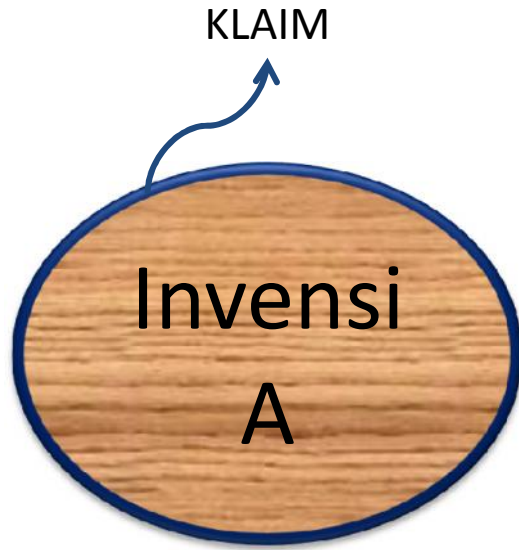


Catatan pengantar:

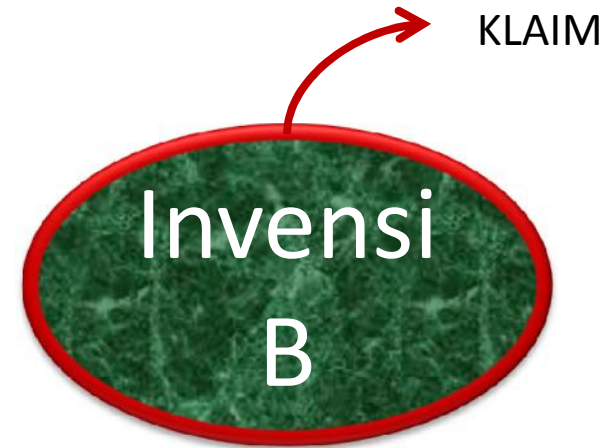
Inventor	orang yang menemukan invensi (penemuan)
Patent Agent	orang yang membantu membuat drafting spesifikasi paten. Paten agent bisa seorang lawyer (disebut <i>patent lawyer</i> atau <i>attorney</i>) dapat juga seorang engineer (disebut juga <i>Patent Enggineer</i>)
Examiner	pemeriksa paten pada kantor paten negara yang menentukan kelayakan untuk diberi paten
Patent Holder	Pemegang paten, bisa inventor maupun orang lain yang mendapatkan dari inventor
Infringer	Pihak yang melanggar paten

**teori
klaim paten**

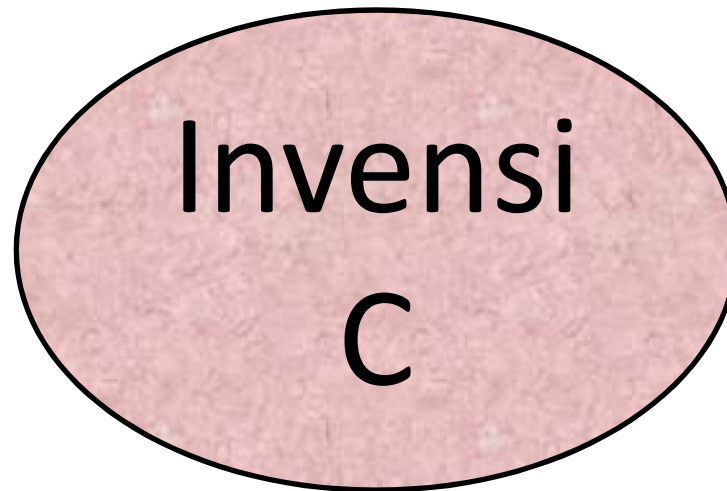
- + Suatu klaim membuat tanda batas dari perlindungan yang diberikan oleh
- + Suatu klaim menentukan luasan (scope) proteksi yang diberikan oleh paten
- + Suatu klaim memberikan batas terluar dari suatu proteksi paten
- + Suatu klaim memberitahukan dengan jelas dan tegas tentang apa yang diklaim oleh pemohon untuk menjadi invensi miliknya.



PUBLIC
DOMAIN



PUBLIC
DOMAIN



PUBLIC
DOMAIN

- + Suatu invensi adalah suatu konstruksi mental dalam pikiran inventor yang belum punya bentuk fisik.
- + Suatu perwujudan dari invensi adalah bentuk fisik dari invensi di alam nyata.



- Suatu klaim harus melindungi setidaknya satu perwujudan dari invensi
- Namun klaim paten yang paling baik adalah yang memberikan perlindungan sedemikian rupa sehingga tidak ada perwujudan lain dari invensi yang bersangkutan yang dapat dibuat, digunakan atau dijual oleh orang lain tanpa adanya pelanggaran terhadap klaim yang bersangkutan

Contoh

- Assume that an inventor invents the first cup to have a handle
- He makes a physical embodiment of his invention in the form of a red claycup with a handle
 - narrow claim : *the red clay cup with a handle*
 - Broader claim: *the cup with a handle*

contoh

- Asumsikan bahwa seorang inventor menemukan (invent) untuk pertama kalinya suatu cangkir yang memiliki pegangan
- Dia membuat perwujudan fisik dari invensiya tersebut dalam bentuk cangkir keramik merah dengan suatu pegangan.
 - Klaim sempit: *suatu cangkir merah dengan satu pegangan*
 - Klaim luas: *suatu cangkir dengan pegangan*

- Peran Inventor:
 - Menemukan (*invent*) sesuatu (produk atau proses)
- Peran Konsultan Paten:
 - Memastikan bahwa klaim paten telah mendekati ruang lingkup maksimalnya.
- Peran Pemeriksa Paten:
 - Mencegah suatu klaim paten agar tidak keluar dari ruang lingkup (*scope*) invensinya (Teori maksimum)

Hubungan antara Specification ↔ claim

- The specification must support the claim
- Every single claim has adequate support in the specification
- The choice of words and terminology used in claims should be traced back to the specification to ensure that the specification and claims are consistent and that the same terminology is used throughout.

The Application Must Contain:
“One Or More Claims”.
These Claims must:

- i. “define the matter for which protection is sought”
- ii. “be clear and concise”
- iii. “be supported by the description”

- Since the extent of the protection conferred by a patent is determined by the terms recited in the claims – clarity of the claims is of the utmost importance
- The claims interpreted with the help of the description and the drawings

- The EPO recommends that claims be drafted in terms of the “technical features of the invention”
- The claims should not contain statement relating, non-technical matters.

B.

FORMAT

CLAIM PATENT

A patent claim has three parts:

- ❖ The preamble:
- ❖ The transitional phrase
- ❖ The body

The preamble

The transitional phrase

The body

Example 1.

A Patent Applicant has invented a rice cooker

An apparatus for cooking rice

An apparatus for cooking grains

An apparatus for cooking

Example 2:

A Patent applicant wants to claim a unique method of making tea.

A method for making tea

A method for making a plant-based beverage

A method for making a warm beverage

Example 3:

A Patent applicant has invented a compound to treat malaria

A Composition for treating malaria

A method for

A device for

Transitional Phrase (open ended)

An apparatus, comprising:

a pencil;

an eraser attached to one end of the pencil; and

a light attached to the center of the pencil.

Transitional Phrase (Closed phrases)

An apparatus, consisting of:

a pencil;

an eraser attached to one end of the pencil; and

a light attached to the center of the pencil

The Body of Claim

An apparatus for holding items, comprising:
at least one leg; and
a top configured to support at least one leg

The Body of Claim

An apparatus for holding items, comprising:

four legs;

16 screws; and

a top

Two-Part Claims/
Improvement Claims/
Jepson claim

- the preamble of the claim sets out the most relevant known prior art, and the body characterizes the improvement of the invention.
- The preamble and body are connected by a specific transitional phrase.
- Thus, the preamble is the statement of the prior art, the transition is a phrase such as “characterized by,” and the body provides the novelty

- In Europe, for example, the preamble is followed by the transition “characterized in that” or “characterized by.”
- In the US the preamble is typically followed by the transition “wherein the improvement comprises...”
- The preamble should typically reference only a single piece of prior art since the preamble is considered an implied admission that it is prior art.

Example:

*A pencil having an eraser,
wherein the improvement comprises
a light attached to the pencil.*

- Thus, in this claim a pencil having an eraser is the relevant known prior art and the claimed improvement is the attached light.

- The EPO recommends that the first part of such claims contain a statement indicating “the designation of the subject matter of the invention,” *i.e.* the general technical class of apparatus, process, etc. to which the invention relates followed by a statement of “those technical features which are necessary for the definition of the claimed subject matter but which, in combination, are part of the prior art.”
- This statement of prior art features applies only to independent claims and not to dependent claims. Thus, such statements are necessary only to refer to those prior art features which are relevant to the invention.

- For example, if the invention relates to a photographic camera but the inventive step relates entirely to the shutter, it would be sufficient for the first part of the claim to read:

“A photographic camera including a focal plane shutter”

and there is no need to refer also to the other known features of a camera such as the lens and view-finder.

- The second part or “characterizing portion” should state the features that the invention adds to the prior art, *i.e.* the technical features for which, in combination with the features stated in the first part, protection is sought.

Means-Plus-Function Claims

- Means-plus-function claims recite elements that do not have specifically-defined structures but instead recite functions performed by structures disclosed in the specification.
- The interpretation of means-plus-function claims varies from jurisdiction to jurisdiction and even varies within jurisdictions over time. For example, a given jurisdiction may interpret a means-plus-function claim as the means disclosed in the patent's specification for performing the recited function plus the reasonable equivalents of those means.
- Means-plus-function claims could receive either a broad or narrow interpretation in a given jurisdiction since the claims do not specifically define the structure. Litigants in patent infringement cases sometimes expend considerable energy arguing over whether or not an asserted claim even is a means-plus-function claim.

- The format of a classic means-plus-function claim is the word “means” followed by a function. For instance, if the invention is a rice cooker, a claim in the means-plus-function format might read as follows:

An apparatus for cooking rice,

comprising:

a means for holding rice;

and a heater configured to heat the rice-holding means.

- In this example, notice that instead of reciting a rice-holding structure by name (*e.g.* a bowl), we have referenced a device that performs the function of holding rice. By doing so, we have avoided using a specific name and have instead recited the function that it performs.

Claim

Punctuation

- A comma typically separates the preamble from the transitional phrase and a colon typically separates the transition from the body.
- The body itself is typically broken into small paragraphs that define the logical elements of the claim. Many jurisdictions do not have specific laws requiring such punctuation but the patent agent should strive to make sure that the claim will be interpreted as he intends.
- Similarly, in many jurisdictions a claim “element” might not have a precise and/or legal meaning, with all the words of a claim simply being “limitations” to the claim.
- That said, the patent agent must write the claim in a manner that does not complicate claim interpretation by the patent examiner and later by courts and potential licensees.
- Thus, the “elements” of a claim are typically separated by semi-colons and the penultimate element ends with “; and.”

- Example 1.

Preamble, transition:

Element (#1);

Element (#2); and

Element (#3).

- Example 2.

An apparatus, comprising:

a plurality of printed pages;

a binding configured to hold the printed pages together; and

a cover attached to the binding.

Proper
Antecedent
Basis

- The elements in a patent claim must have the correct antecedent basis. This means that the first time an element is introduced, the indefinite article “a” or “an” should be used. Later when referring back to previously
- introduced elements, the definite article “the” or “said” should be used. Proper antecedent basis is not just
- a good idea; like gravity, it is the law. The following set of claims will help explain proper antecedent basis:

1. *A device, comprising:
a pencil; and
a light attached to the pencil.*
2. *The device recited in claim 1 wherein the
light is detachably attached to the pencil.*
3. *The device recited in claim 2 where in the
pencil is red in color.*

- Notice that in Claim 1, we introduced the “pencil” for the first time by referring to it as “a pencil.”
- In the same claim, we also introduced the light for the first time as “a light.”
- However, when we wanted to specify that the light was attached to the pencil, we referred to the pencil as “the pencil.” The use of the word “the” signaled that the pencil was the one we had previously defined in the claim.
- Otherwise, there would be ambiguity as to whether it was the same pencil or another pencil. The words “the” and “said” are interchangeable in claims drafting. (“Said” is old-fashioned legalese for the most part, while “the” is an attempt to make language more accessible to non-lawyers.)

Reference Numerals and Bracketed Expressions

- In some jurisdictions, claims are encouraged and/or required to recite the reference numerals associated with particular elements in the patent application's drawings. Thus, if Figure 1 of the patent shows a computer memory and this computer memory is labeled "123," for example, if the claims recite this particular computer memory, the computer memory element will be followed by the reference number "123."

An apparatus, comprising:

A plurality of printed pages (11);

A binding (14) configured to hold the printed pages (11) together; and

A cover (21) attached to the binding (14).

The numbers in parenthesis are the reference numbers from the patent application's drawings.

Claim Phrases

- For example, a “wherein clause” is generally used to describe either a function, operation or result that flows from the previously-recited structure or function of the claim. Thus, “wherein clauses” should be used where the result necessarily follows the recited structure or function. For instance, if we want to claim a folder for keeping files, the claim in a wherein format might read as follows:

A folder for keeping files, wherein the folder is configured to receive the files...

Multiple Elements:

- Many patent offices require claims to recite at least two elements. A patent claim without many limitations can be impossibly broad. One can readily see the necessity for this rule by comparing the following two claims:

Example 1.

A computer, comprising:
a processor.

Example 2.

A computer, comprising:
a processor;
a memory; and
a bus configured to transmit data between the memory and the processor

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