

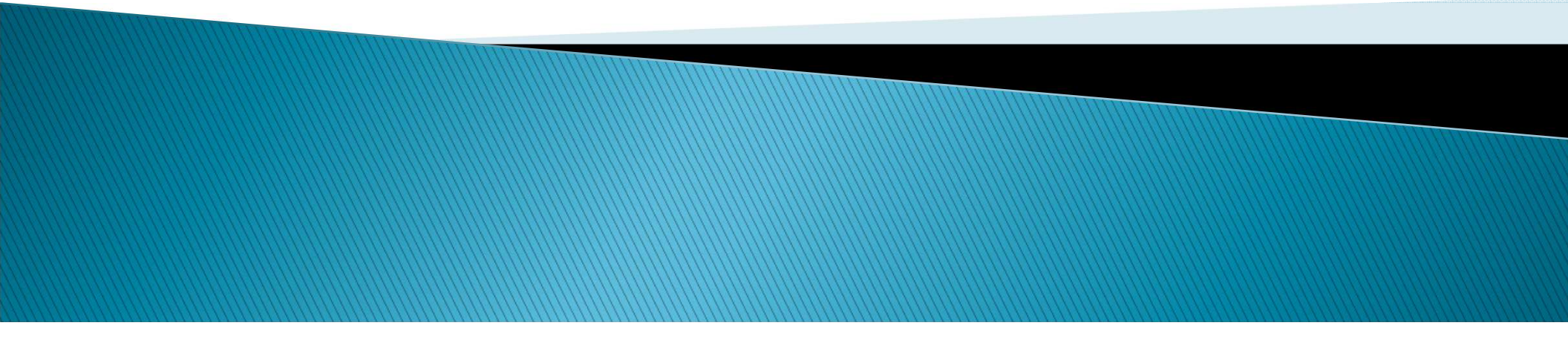
ON PATENT CLAIMS

and how to write them

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Nothing presented here is legal advice.



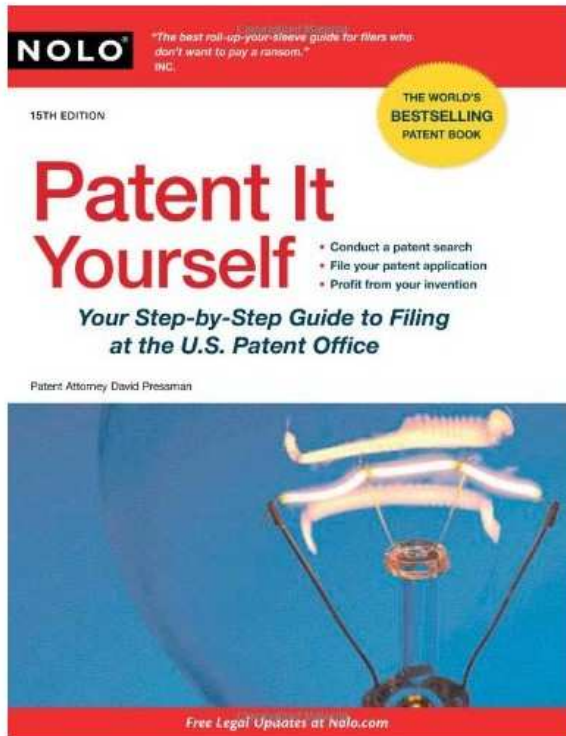
WORD GAME

Patents are a word game with high stakes.

Don't play alone.

Seek review by an experienced practitioner before filing.

A GREAT REFERENCE



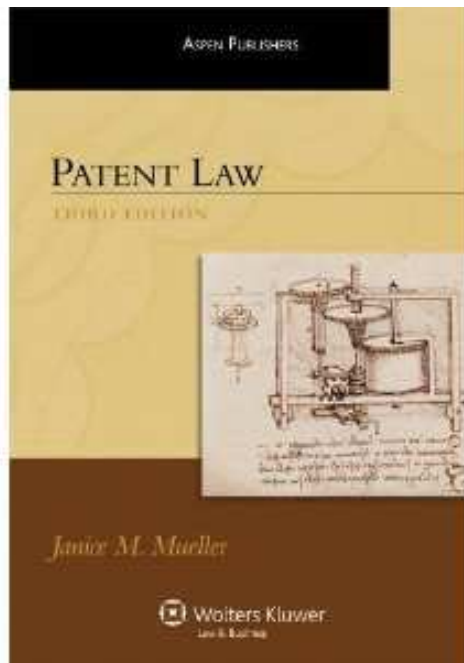
Patent It Yourself
by David Pressman

This book is famous.

Everybody should have a copy.

\$35

A DEEPER DIVE



Patent Law
by Janice M. Mueller

Get this if you plan to
do a lot of patenting.

\$67

THREE MAIN ELEMENTS OF A PATENT

Specification

A detailed description of the invention in technical language

Drawings

As needed to make the specification clear

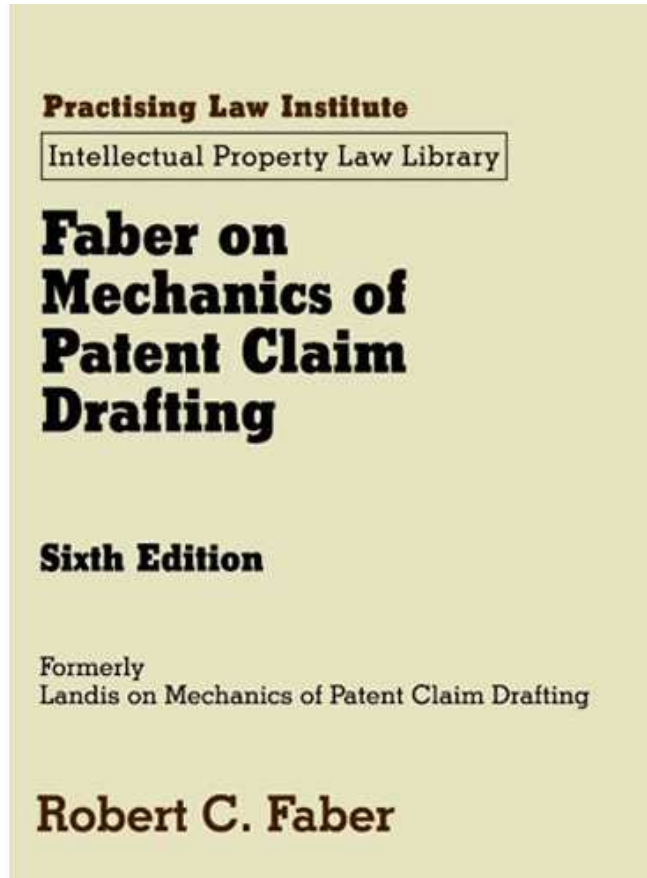
Claims

Precisely what you want to block others from doing

Claims are short, but the most difficult and important part.

“The name of the game is the claim”

THE BIBLE OF CLAIMS



Faber on Mechanics of
Patent Claim Drafting
by Robert C. Faber

900 pages

\$400



PROSECUTION

Note: Prosecution (the application process) is not Litigation (suing in court).

It is normal to argue with the examiner.

Prosecution is a negotiation:
rejection, followed by argument and/or claims amendment,
followed by reconsideration.

If your claims are allowed on the first try then they probably could have been broader.

BREADTH

Claims are both vague and precise at the same time.

“The strongest claims are the weakest and the weakest claims are the strongest.”

A broad claim will more thoroughly block a competitor but is harder to get and easier to invalidate in a lawsuit.

A narrow claim will be more easily granted, but less likely to block a competitor.

Every word makes your claim narrower.

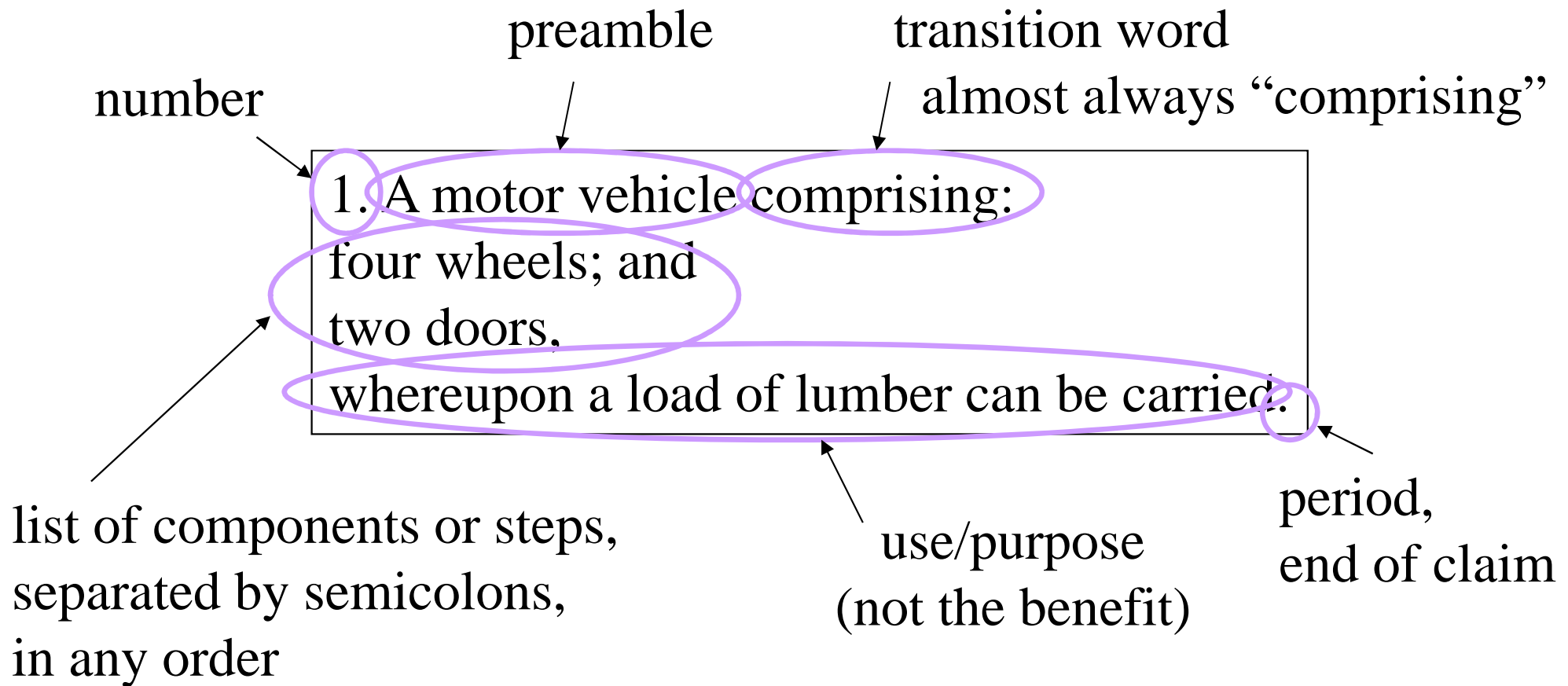
EXAMPLE

1. A motor vehicle.

2. A motor vehicle comprising:
four wheels; and
two doors.

3. A motor vehicle comprising:
four wheels; and
two doors,
whereupon a load of lumber can be carried.

THE PARTS OF A CLAIM



study examples in your field

DEPENDENT CLAIMS

Claim 2 contains every component of claim 1, plus something

2. The motor vehicle of claim 1 further comprising a polka-dotted cloth seat.

In case claim 1 is rejected or invalidated, claim 2 is more likely to be granted

There is less prior art blocking claim 2, but competitors can more easily design around it.

Any number and any depth of dependent claims are okay.

ANTECEDENT BASIS

The first reference to a component or step must use “a” or “an”.
All following references to the same component or step must use “the”.

wrong

1. A method operating a computer comprising:
engaging the power switch; and
disengaging the power switch.

right

1. A method of operating a computer comprising:
engaging a power switch; and
disengaging the power switch.

Indefinite article

Definite article

“said” == “the”

NUMBERS AND RANGES

Claimed

A glove with five fingers

A chair with at least four legs

A clock with a plurality of hands

A mat with a multiplicity of bumps

A tire holding 30 to 50 PSI of pressure

Approximately 37 degrees Celsius

Infringed by

exactly five

four or more

two or more

a large number

at or between 30 and 50

a bit more or less

BE YOUR OWN LEXICOGRAPHER

Industry jargon is okay
as long as others in your field would understand.

Your own personal terminology is ok,
as long as the meaning is clear from the spec.

If your company calls it an accelerator but
the rest of the industry calls it a co-processor,
your claim can refer to it as an accelerator
as long as your spec describes it.

Stick to the same term throughout spec and claims.

MATCHING THE SPECIFICATION

Claims must be enabled (supported) by the specification.

Claims should mirror the description of different embodiments described in the spec.

First write claims, second drawings, third spec.
Print the claims and check them off as you describe them in the spec.

That ensures support and avoids unnecessary disclosure.

Have a little bit more in the spec than you claim for continuation practice later.

PATENT PROFANITY

Avoid these words

means

prior art

requires / must

important / critical / essential / preferable / advantageous

needed / necessary / desired / significant

always / never / generally / usually / frequently / rarely

every / only / all / none / few

difficult / easy / simple / complex

correct

STRATEGY

Claims are not about your invention.

Claims define what your competitors cannot do.

Never mind what your product does.

What will your competitors want to do in the future?

What might potential customers try to do without you?

What will be valuable to potential acquirers?

CLAIM TYPES

Claim how you do it and how others would.

Claim your invention and a system that includes your invention.

Consider alternate uses and keep the preamble broad (short).

Carrying rocks does not infringe
“an automobile for carrying lumber”

Be creative.

Thoughtful claim writing can lead to improving your invention.

CLAIMS CLASSES

Only four kinds of inventions can be patented in the US:

machines

methods

articles of manufacture

compositions of matter

Consider claiming two classes:

1. An automobile...whereupon a load of lumber can be carried
2. A method of carrying lumber comprising:...

Patenting software?

A data storage device for storing computer program code is an article of manufacture.

INTERRELATE ELEMENTS

An automobile comprising:
four wheels upon which the automobile is suspended; and
two doors mounted on the automobile by hinges.

NEGATIVE LIMITATIONS

Claiming the absence of something.

Ok, when necessary, but no preferred.

An truck for carrying lumber comprising:
a bed mounted on the back; and
no tailgate,
whereby long lumber can stick out the back.

REJECTION VS OBJECTION

Rejections are for claims:

- not to an allowed class
- covered by prior art references
- covered by a combination of multiple prior art references
- not enabled by the specification

Objections are for formatting mistake: (examples)

- incorrectly written preamble or transition
 - antecedent basis (a/an vs the)
 - incorrect reference to a claim depending claim
 - typos, spelling, grammar
-

THANK YOU