

Comments On The Claim Drafting Assignment Spring 2007

Abbreviations used in grading

PA Prior Art
PON Point Of Novelty
BM Business Method
CM CouponMaster
'173 pub U.S. Pat. App. Pub. No. 2006/0080173
AB Antecedent Basis
CS CoolSavings

I. General

- A. Too much reliance on shortcut words and not enough clear, solid recitation in the claims. Clarity first! Short is good, but it must be clear. This extends to your choice of terms as well.
- B. What is our standard of clarity? So clear that the claim can't be broken by the other side no matter how hard they try.
- C. Format - double space and space between claims
We want it to be easy for the Examiner to read and understand (and easy for me to make comments!)
Skip a line between claims
New independents start on a new page
- D. Grades – Don't Panic. Grades get better during the semester and final grades are typically quite good if you work at improving your product.
 1. I am more than happy to discuss your claims with you to help you improve – just be sure to remove your identifying code before you show me the claims.
 2. If you got less than a B, then there will be extra credit opportunities to help you raise your grade.

II. Failure to identify and/or express the PON

Let's review the PA

'173 pub – coupons are downloaded to memory in display device
has user interface for displaying and selecting coupons
includes USB port
at the "point of purchase"
tracks use
displays advertising

NOTE: As mentioned in class, the '173 pub has really bad claims.

U.S. Pat. No. 6,668,599 Portable structure including bar codes for multiple coupons
Bar codes are scanned at checkout

CoolSavings or other widely-known internet sites that allow you to download coupons
Many websites allow you to download coupons
Coupons are printed, but you can store them on your PC
Sites have memory/database storing plurality of coupons

OK, now that we have examined our PA, let's take a look at some potential PONs.
(plain English, not claim language)

Web Application Based

1. Associating a coupon with a search term?
2. Auctioning linkage with a search term?
3. Display of coupon based on association of coupon w/ entered search term?
4. Coupon data units – not just coupons – create, store, download, store

Portable Device Based

1. Site supports interaction with removable device
2. Portable electronic display (but "portable" is tough to claim)
3. Attached Printer

Big Question – what aspect of the invention is of the more important to CM?

Answer – the aspect that they make money with. Do they make money
with the CM device or the website?

Probably Not an independent claim

1. Uploading coupon data to a website – CS does it
2. Verifying the identity of a poster - CS
3. Tracking number of downloads of coupons – 173, CS
4. Tracking demographics of coupon downloader – CS, Maybe
5. Users - Open access to unregistered users – CS, 173
6. Additional features provided for registered users – CS, Maybe
7. Downloading from website – CS, 173
8. Auctioning advertising space – 173, Probably Not
9. Power management – In every laptop
10. Specific data structure for storing bar codes - easily alterable (as opposed to concept of coupon data units)
11. Integration with BlackBerry – maybe dependent

A. Many people simply recited the structure of the CM device without attempting to establish a point of novelty.

Q - Is the structure of the CM new by itself?

A – Are you aware of another device that includes a data port, a processor, a battery, a memory, and an LCD screen? Cell phone? BlackBerry? 173?

Some Options

- limit data port to USB port? – nope, 173
- housing is adapted to provide a mechanical attachment for a printer?
Maybe
- removable?
Maybe if we can find a way to claim it

People got stuck on “portable” and “handheld” and “point of sale”, etc.

Recite structural limitations instead

“portable” – maybe concentrate on “removable”?

the device that stores the coupon is removable from the computer that downloads the coupon

coupon display occurs when the storage device is not connected to the download device

“handheld” – maybe concentrate on separate housing/power?

the device that stores the coupon is in a separate housing from the device that downloads the coupon

“displays” instead of “stores”

includes a battery that is adapted to provide power to the display device

battery is adapted to provide power to the display device when the device is not connected to the downloading device

“point of sale” – maybe concentrate on different locations of download and display?

the device displays the coupon at a location remote from where the coupon was downloaded

display device adapted to be removed from the downloading device when displaying

III. Unclear Claim Language
Standard of clarity for claims – that the claim can't be twisted by a smart, motivated opposing party.
(i.e., *really* clear!)

- A. Improper clause construction
1. Indefinite clauses and structures

MUST SAY EXACTLY WHAT YOU MEAN!

“Ohh, you know what I mean.” Is not a defense at trial – lock it up!

Example - not what the drafter wanted to recite

“a method of collecting customer information including:”

The claim is actually defining the information, not the method

Should be:

“a method of collecting customer information, said method including”

“the interface stores” or “the interface searches”

Or does the interface just display and something else stores (like memory) and searches (like the search engine)? Maybe the interface allows a user to enter a search term?

Example - drafter has mentally assigned a novel meaning to a blank variable

“a data port”

In reality, the Examiner could construe this limitation to be anything through which data passes

“a display screen that cooperates with a processing unit”

What is cooperation? This is pretty unclear.

3. No pronouns - no “which” no “that”
“a device which” should be “a device, wherein said device”
4. No slang
“on a website”
“posting”
“logging in to”
5. Defining the users as claim elements of the structure
The seller/offeror/downloader is NOT part of the system
6. Reciting non-limiting statements of use
“a memory for storing a coupon” becomes
“a memory adapted to store a coupon” or
“a memory storing a coupon”

- B. Getting hung up on the specification.
The Inventor uses a term and the term is a bad one, but the term gets lodged in your memory and your basic understanding of the invention and keeps popping into your claim. This is where “web presence” and “portable” come from.
- C. Preamble
1. Can’t use the preamble to establish antecedent basis
 2. Preamble is not a claim limitation – language should not appear only in the preamble and not in the claim limitations
 3. Improper preamble for business methods
“A business method including”
Method must have a firm concrete result that should be reflected in the preamble.
- U.S. Pat. No. 5,333,814 - AT&T vs. Excel
1. A method for use in a telecommunications system in which interexchange calls initiated by each subscriber are automatically routed over the facilities of a particular one of a plurality of interexchange carriers associated with that subscriber, said method comprising the steps of:
 - generating a message record for an interexchange call between an originating subscriber and a terminating subscriber, and
 - including, in said message record, a primary interexchange carrier (PIC) indicator having a value which is a function of whether or not the interexchange carrier associated with said terminating subscriber is a predetermined one of said interexchange carriers.
- D. Us of “or”
1. “or other device” is not a positive recitation
 2. “device is one of A or B” – do I need to recite both to get over PA?
- E. No connection of claim elements
Unclaimed essential subject matter - p13 , class 3
- F. Indefinite or Undefined Language
Need to affirmatively recite limitations in your claim that cause your claim to be clearly differentiable from the prior art.
1. Offeror/Offeree
 2. “Auctioning” “a winner of said auction”
 3. “A verified offeror”
 4. “post”
 5. “to sell” – advertise for sale? complete transaction?
 6. “a web presence”

What is a “coupon?”

Webster’s II New College Dictionary, 1995

1. A negotiable certificate attached to a bond that represents a sum of interest due.
- 2.a. A detachable part, as of a ticket or advertisement, entitling the bearer to specific benefits, as a gift or cash refund.
- b. A printed form, as in an advertisement, used for ordering merchandise or requesting information.
3. A detachable slip calling for periodic payments, as for merchandise bought on an installment plan.

Is the bar code a coupon? Is the text display on the LCD screen the coupon? Is what is stored in memory the coupon?

Maybe we just have some data with two parts – a bar code and some text.
Let’s put that in a package and let’s pick a name for it like “a coupon data unit.”
How can we refer to the data now?
“data representative of a coupon?”
“data representative of a discount offered on the purchase of a specific good?”

Let's consider some claims and their problems. These are representative of the graded claims.

1. A coupon system including:
 - a memory storing at least one coupon data entity, wherein said at least one coupon data entity represents a coupon and includes a bar code; and
 - a display device including a memory adapted to store said coupon data entity and an electronic display, wherein said at least one coupon data entity is downloaded from said memory to said display device,
 - wherein said display device is controlled to display the bar code associated with said coupon data entity on said display,
 - wherein said bar code is readable by a bar code reader.

2. A system for distribution of retail incentives including:
 - an interface for offerors to provide retail incentives;
 - a portable user device to utilize retail incentives; and
 - communication of retail incentives between said offeror interface and said user device.

3. A system for transmitting transaction discounts. Said system comprising:
 - a. Server capable of storing transaction discount data
 - b. Network in electrical communication with said server, a user personal computer, and a user processor
 - c. User CPU terminal
 - d. User processor for receiving and displaying transaction discount data.

AUCTION CLAIM

A method for associating a coupon data unit with a search term, said method comprising:

establishing a first coupon data unit including a first coupon bar code, wherein said first coupon data unit is associated with a first commercial entity;

establishing a second coupon data unit including a second coupon bar code, wherein said second coupon data unit is associated with a second commercial entity;

identifying a search term, wherein said search term is adapted to be used to search a database of a plurality of coupon data units, wherein said search term is adapted to be associated with an associated coupon data unit so that said associated coupon data unit is displayed when said search term is used to search said database;

allowing said first commercial entity to establish a first financial offer representing compensation for associating said first coupon data unit with said search term;

allowing said second commercial entity to establish a second financial offer representing compensation for associating said second coupon data unit with said search term; and

associating said search term with one of said first coupon data unit and said second coupon data unit based on the greater of said first financial offer and said second financial offer.

ALTERNATIVELY

associating said search term with said first coupon data unit when said first financial offer is greater than said second financial offer.

ALTERNATIVELY – COULD INSERT

determining the greater of said first financial offer and said second financial offer; and

Also:

wherein said database includes at least one of said first coupon data unit and said second coupon data unit



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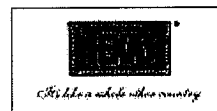
yes no

Pampers - Get valuable coupons and enter for a chance to win diapers for a year at Pampers.com!



yes no

MyPoints - Earn FREE gift cards for clothes, meals, DVDs and more—Join MyPoints!



yes no

Texas Tourism - Get your FREE Texas State Travel Guide now!

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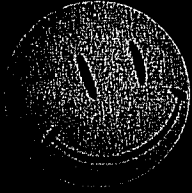


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SAVE TIME AND MONEY WITH COUPONS by Stephanie Nelson
Most strategic shoppers rely on grocery coupons to help save on groceries. However, industry statistics show that a very small percentage of shoppers are heavy grocery coupon users. (Continue reading [Save Time and Money with Coupons...](#))

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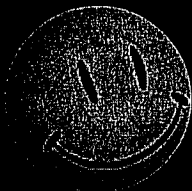
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