

Comments On The Claim Drafting Assignment Spring 2012

I. General

- A. In many cases, the claims need some work, but if you keep trying, I will be happy to help you get better.
- B. 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 specific claims with you to help you improve – just be sure to remove your identifying code before you show me the claims. However, please read Patent It Yourself and the MPEP sections first.
 - 2. If you got less than a B+, then there will be extra credit opportunities to help you raise your grade – if they are even needed. (They usually are not.)
- C. Claim drafting is very mentally challenging. It often takes a lot of practice to be able to see things from a patent attorney point of view, but I think that just about everyone can do it with practice and hard work.. Thus, use your grade as an indication of how far along you are in attaining the skill. If your grade is low, it's not that you are "bad" or that you won't get there, it's just that you have more work to do and more distance to travel. An "A" claim is one that I would be happy to approve sending out the door for client work.
- D. Visit JoeBarich.com!
The comments on the graded assignments are available going back to 2005. If you compare the mistakes that are being made this year with last year and the year before, there is an overlap of about 80%. Why not review last year's mistakes so that you don't make them?
- E. Formatting – claims should be double-spaced, indent elements, don't leave large sections of the page blank
- F. Remove PON statement for future assignments.

II. Identifying the Point Of Novelty

- A. The majority of people seem to be having a vagueness problem – more like the class of 2010 – as well as difficulty distinguishing a technological event from an abstract notion of what a technological process represents. For example “transmitting data” vs. “completing a quest” Really need to think specific “hardware” and functional elements rather than “experience” and how users perceive/interpret the technological function
- B. What exactly does the prior art teach?
‘825 publication discussion
‘731 publication discussion
- C. Vague words that seem helpful, but are really indefinite or undefined
Every year these happen. It’s part of the growth process, but a tough thing to avoid. In regular communication, we have a great deal of imprecision and that is understood and accepted – when someone says that their burger is “good”, we don’t need to know exactly how good. However, when it comes to claims, we need our language to be so clear that an Examiner or an opposing party can not attack it.

Examples

interfacing, integrates, quest, “turn on”, incorporating, sharing, aesthetic appearance, task, scan

- D. Become more “solid” and “hardware” rather than “experience”
“changing an aesthetic appearance”
“triggering an aesthetic transformation”
“initiating a display system providing a visual display”
- E. Too much abstraction.
“processing data”
“matching locations”
“storing a location”
“performing a task” “completing a task” “storing a task”
“initiation of the registration process”

E. Novelty Vectors

1. QR code triggers video to smartphone
2. GPS location triggers video to smartphone
3. GPS location of smartphone causes quest object to glow

How do we dig down and get to the technological aspects of these experiences? Can we work backward?

Also, you can train yourself to feel when something is not “solid” or not “locked down” – if things are just “appearing” in your claim, there is likely a problem.

Let’s look at #1 above and think about it:

1. Where is the video, how does it get triggered? It’s on a server, it gets triggered in response to a signal from the smartphone
2. How is the QR code detected? Camera takes a picture of the data, data is passed to the server and server sees if it matches previously stored data

STEP 1

a smartphone including a camera; and
a server, wherein said server is in wireless communication with said smartphone,
wherein said smartphone uses said camera to detect a QR code, converts said QR code to detected QR code data, and wirelessly transmits said detected QR code data to said server,

wherein said server compares said detected QR code data to **(Hmmm.. need previously stored data – and isn’t the data transmission step sort of lose? What actually does this?)**

STEP 2

a smartphone including :

a camera; and

a smartphone wireless transceiver; and

a server including:

a server wireless transceiver; and

a server memory,

wherein said smartphone wireless transceiver is in wireless communication with said server wireless transceiver,

wherein said smartphone uses said camera to detect a QR code, converts said QR code to detected QR code data, and wirelessly transmits said detected QR code data to said server using said smartphone wireless transceiver,

wherein said server receives said detected QR code data and compares said detected QR code data to expected QR code data stored at said server (**where did that come from?**) and

when said detected QR code data matches said expected QR code data, said server transmits said video to said smartphone. (**Hmmm how do we know which video?**)

STEP 3

a smartphone including :

- a camera; and
- a smartphone wireless transceiver; and

a server including:

- a server wireless transceiver; and
- a server memory storing at least one expected QR code data sequence,

wherein said at least one expected QR code data sequence is associated with an associated video,

wherein said smartphone wireless transceiver is in wireless communication with said smartphone wireless transceiver,

wherein said smartphone uses said camera to detect a QR code, converts said QR code to detected QR code data, and wirelessly transmits said detected QR code data to said server using said smartphone wireless transceiver,

wherein said server receives said detected QR code data and compares said detected QR code data to said expected QR code data sequence stored at said server, and

when said detected QR code data matches said expected QR code data sequence, said server transmits said associated video from said server memory to said smartphone using said server wireless transceiver and said smartphone wireless transceiver.

(Hmm, is anything unnecessarily limiting?)

Maybe go with “data transceiver” instead of “a server wireless transceiver;”

Maybe go with something broader than “video” – maybe “ media display file”

add step of displaying media display file?

III. Other Claim Aspects

A. Not saying what you mean

“A system for communicating data, including:” vs.

“A system for communicating data, said system including:”

B. Reciting non-limiting statements of intended use

“designed to acquire” “will” “can be” “adapted to”

“for” doing something

Instead affirmatively recite what it does.

C. No connection of claim elements

Example:

a phone detecting location information and transmitting it to a server; and
a server transmitting an instruction to a remote display device.

Problem? No link between receipt of location information and
transmission of instruction.

D. If there is no mark by a claim or an element, it is not necessarily an endorsement. I did not mark everything wrong in every claim, especially if you were making the same mistake again and again.

E. If you recite a structural claim, like a system or apparatus claim, all claim elements must be structural –

Examples that are NOT structural = link, task, list, administrator, user, a
QR code, a location

F. No “MEANS” claims

Reciting “A module for” is most likely means+function language

Also, “an element for” “a unit”

G. **YOU MUST SAY EXACTLY WHAT YOU MEAN!**

Standard of clarity for claims – that the claim can’t be twisted by a smart,
motivated opposing party.

(i.e., *really* clear!)

The Examiner will make great efforts to cram any prior art into the description of your claim. Thus, anything at any distance is “remote”. Any action at all is “processing”. Basically, the vaguer the word you choose, the more the Examiner will have a field day asserting any prior art that they want to.

H. No slang or foreign languages

“turn on” Slang

incorporating – LLC or C-corp?

sharing –This is a human interpretation of a technological system.

what is the technological reality?

integrating – x/dx?