

Comments On The Claim Drafting Assignment Spring 2013

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.
 - 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?

II. Formatting

Claims should be:

Double-spaced

Line breaks between claim elements

Indent element

Font should be at least 12 point

Don't bold anything

Claim numbers as "1."

No double-column

F. Remove PON statement for future assignments.

III. Claim Language

A. The majority of people seem to be having a vagueness problem coupled with a focus on the effect rather than the system - which leads to a problem defining the invention. For example, "method of killing germs" or "emitting light"?

Really need to think specific "hardware" and functional elements rather than "experience" and how users perceive/interpret the technological function

B. Vagueness - 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 or adopt a strained interpretation.

Too Vague Examples

“in coordination with”

“supports communication”

“on an application”

“on” in general – meaning stored in a memory included as a component?

“implement a profile”

“associated with” – without defining it

C. Imprecise/impossible claim limitations

We also have to be very precise in our claim language. Language that merely allows the reader to understand what is likely meant is not enough. The language must rigorously define the scope of the legal right. For example, there is a huge difference between “data representing a biometric parameter” and “data representing a measurement of a biometric parameter”.

Imprecise/Impossible Examples

“produces a wavelength” – it is like reciting “produces a distance”

“emitting a light value”

“a wavelength providing device”

“signal carries”

“computer contains”

D. Defining the extent of the invention

“killing germs” vs. “emitting light”

“altering a psychological state” vs. “emitting light”

For examples such as the above, the drafters probably started off reciting the PON as a method claim and went through each logical step. However, the likely did not then try to draft re-draft the claim as a system. If they had, it would probably have become apparent that they were claiming things that just didn't work, like “germs” and “a psychological state”.

They could have used that insight to then go back and amend their method

claims to be more properly tied to the actual extent of the PON. This actually works both ways – for those writing method or system claims first – and is a useful self-checking tool, like the ICOA method.

III. Identifying the Points Of Novelty (PONs)

- A. As opposed to previous years, the PONs are more easily understood and it seems like most people can see what they want to claim. They are just having trouble reciting it in precise language.

Let's go through an example:

PON1 – killing germs with violet light, where the violet light can be turned on an off remotely

PON 2 – a light emitter emitting violet light to kill germs and wirelessly receiving instructions to turn on and off

PON 3 – a light emitter including:

a light emitting element that emits violet light and
a wireless receiver; and

a wireless transmitter sending a on/off instruction to the wireless receiver

1. A method for cleansing an area, said method including:
adjusting wirelessly a set wavelength of light to a wavelength value in violet and ultraviolet range;
communicating said wavelength value in violet and ultraviolet range to a light emitting device; and
emitting light from said light emitting device at said wavelength value in violet and ultraviolet range.

2. A method for ~~cleansing an area emitting light~~, said method including:
adjusting transmitting wirelessly a set wavelength of light to a wavelength value, wherein said wavelength value indicates a wavelength that in the visible violet range in violet and ultraviolet range, wherein said transmitting is performed by a wireless transmitter;
~~communicating receiving said wavelength value in violet and ultraviolet range to~~
at a wireless receiver at a light emitting device; and
emitting light from said light emitting device in response to receiving said wavelength value, wherein said light is emitted at said wavelength identified by said wavelength value at said wavelength value in violet and ultraviolet range.

(But do we really need to identify the specific wavelength in the transmission itself?)

3. A method for emitting light, said method including:
transmitting a ~~wavelength value~~ light emission instruction,
wherein said ~~wavelength value~~ indicates a wavelength that in the visible
violet range,
wherein said transmitting is performed by a wireless transmitter;
receiving said ~~wavelength value~~ light emission instruction at a wireless receiver at
a light emitting device; and
emitting light from said light emitting device in response to receiving said
wavelength value,
wherein said light is emitted at a wavelength in the visible violet range
~~wherein said light is emitted at said wavelength identified by said~~
~~wavelength value.~~

(But could an Examiner argue that any wireless light control system could do this in combination with a violet bulb?)

3. A method for emitting light, said method including:
transmitting a light emission ~~instruction~~ request,
wherein said transmitting is performed by a wireless transmitter;
receiving said light emission request at a wireless network receiver;
transmitting said light emission request from said wireless network receiver to a
server, wherein said transmitting takes place through an Internet connection;
receiving said light emission request at said server;
generating a light emission instruction at said server in response to the receipt of
said light emission request;
transmitting said light emission instruction from said server to said network
receiver;
transmitting said light emission instruction, wherein said transmission is
performed wirelessly;
receiving said light emission instruction at a wireless receiver at a light emitting
device; and
emitting light from said light emitting device in response to receiving said
wavelength value,
wherein said light is emitted at a wavelength in the visible violet range.

(Well, that gets away from most PA systems, but do we really need to recite all of those elements?)

4. A method for emitting light, said method including:
transmitting a light emission request,
 wherein said transmitting is performed by a wireless transmitter;
receiving said light emission request at a wireless network receiver;
transmitting said light emission request from said wireless network receiver to a server, wherein said transmitting takes place through an Internet connection;
~~receiving said light emission request at said server;~~
~~generating a light emission instruction at said server in response to the receipt of said light emission request;~~
transmitting said a light emission instruction from said server to said network receiver in response to the receipt of said light emission request at said server;
~~transmitting said light emission instruction, wherein said transmission is performed wirelessly;~~
receiving said light emission instruction from said network receiver at a wireless receiver at a light emitting device; and
emitting light from said light emitting device in response to receiving said wavelength value,
 wherein said light is emitted at a wavelength in the visible violet range.

(Here, it seems like we get to novelty by routing through the internet – recall that the PA LIFX does not go through the internet. We could also get to novelty over the LIFX by reciting the violet as a pre-set that is user-selectable – recall that the LIFX just uses a color wheel.)

III. Other Claim Aspects

A. No connection of claim elements

Several people had instances where claim elements were not connected. Often, this was linked to phrasing difficulties with regard to what was actually being transmitted vs. what the receiver was actually performing.

Example:

transmitting a light color profile; and
emitting light at a light emitting device in accordance with said light color profile”

B. 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.

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

Examples that are NOT structural = profile, application

F. No “MEANS” claims

Also, reciting “a module ” is most likely means+function language if there is no structural limitation.

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

“on a computer”

“takes measurements”

“trigger”