

Comments On The Claim Drafting Assignment Spring 2015

I. General

- A. Everybody's claims need some work, but if you keep trying, you will definitely improve.
- B. Grades – Don't Panic.
 - 1. This is the first year that we are trying the "Official" vs. "Practice Ready" grade.
 - 2. Grades get better during the semester and final grades are typically quite good if you work at improving your product.
 - 3. 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.
- 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

Skip line between claims

Remove PON statements 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 PON of the invention. They are mostly just claiming a black box – what goes in and what comes out, not how the invention actually works. Really need to think specific “hardware” and functional elements rather than the just the desired output.

- However, for many people, they don't actually know how it works, so they try to finesse it/cover it up with vagueness. However, that's not going to work – as will become more clear as you write the detailed description. For example, if the Examiner finds the claim to be indefinite, he rejects it. Also, who is to blame if you don't understand how something works? It is your responsibility to question the inventor so that you are sure that you understand the invention.

- Iterative process to go between claims/description that helps you focus.

Vague Example:

“receives a target UVB radiation exposure level, wherein said target UVB radiation exposure level corresponds to skin tone in a predetermined scale”

- UVB target exposure level “received” from somewhere mysterious – it just appears – not calculated/determined

- Choice of “radiation” – why not just “light”?

- “Corresponds to” – no actual recitation of what this is or how it works

- “Predetermined scale” – is anything, even a constant

Examples:

“scaled using the time of day” – how?

“scaled using the location” – how?

“mobile device communicates with a server to determine skin color”

- B. Vagueness - Vague words that seem helpful, but are really indefinite or undefined. Every year these happen – primarily because they arise in just about every invention. It’s part of the growth process to learn to avoid them – they look like such an easy way out of a difficult situation to describe! However, contrast the requirements for a claim with regular communication. 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 cannot attack it or adopt a strained interpretation.

Examples – Vague words

“accumulating” a time or dose

“integrating” a measurement to form a MED

“environmental conditions”

“context related information”

- C. Imprecise/impossible claim limitations – or trouble with abstraction
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.

Example:

Differentiating between the UV light itself and data representing the UV light – that is, the “measurement” of the light.

“transmitting an intensity [of UV light]” (Actual light itself)

vs. “transmitting data representing the intensity of the detected UV light

D. Lots of Antecedent Basis (AB) problems

Every time you use the word “the/said” – make sure the claim term has already been introduced. Also, you can’t switch terms around.

Examples”

“communication terminal” is not AB to “said terminal”

“a sensor device” is not AB to “said sensor”

“a portable computing device” is not AB to “said mobile device”

E. Preamble Issues

1. Add that comma statement or the Examiner will reject the claim

Example

-“A method of calculating MED including” is reciting what the MED includes, not the method. Compare with “A method of calculating MED, said method including”

2. Whatever you promise in the preamble must be delivered by the claim.

Examples:

-“A method for controlling exposure to UV” which does not end with controlling, just displaying a time

-“A method for lowering cancer risk” that never talks about cancer risks in the claim

-“A method for sun tanning” which only talks about MED, not tanning

IV. Identifying the Points Of Novelty (PONs)

A. Most people are drafting claims that are more description based than novelty based. For example, when determining the MED, do I need to recite scaling based on medical history and tanning lotion in the independent claim? Do I not reach novelty unless I recite those aspects?

B. Really two separate systems and you can reach novelty with the simplest versions of each alone.

-User MED target determination system (pre-exposure)

Simplest version –use of skin color scale based on user picture to determine MED

-UVB exposure determination system (during exposure)

Simplest version – Altering percentage of UVB based on time of day when determining total incident UVB

Something to get you thinking (you will need do more) -

“wherein a first time of day is associated with a first UVB percentage and a second time of day is associated with a second UVB percentage”

C. Time determination is an estimate based on the UVB exposure determination system. The UVB determination drives the time determination, so the determination of time could be a dependent claim.

III. Other Claim Aspects

A. No connection of claim elements

Several people had instances where claim elements were not connected. Need a functional connection not just “X is positioned inside Y”

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 = “application”

D. 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.

E. No slang or foreign languages

“taking a picture”

“via”

F. Avoid statements of criticality – they make for easy design-around
all, each, every

“preventing carcinoma risk”

G. Must use affirmative language

Can’t say “can/could” – must actually do it

H. Use of “or”

Typically not good practice – are BOTH choices necessary for novelty?

I. We are not claiming the Fitzpatrick Scale

Some Actual Claims For Review

1. An apparatus including:
 - a camera, wherein said camera takes a picture of a user's skin in order to determine a user's phenotype;
 - a geo positioning system wherein said geo positioning system determines the user's global position; and
 - a UV sensor wherein the apparatus uses the UV sensor's UV measurements in order to calculate UVB light based on total UV, time of day and cloud coverage.

2. A method for preventing carcinoma risks associated with UVB exposure comprising:
 - taking a picture of a person's skin by using a camera, wherein the camera is attached to a portable electronic device;
 - transmitting the picture to a server, wherein the server is:
 - storing information about the person into a records database,
 - storing 50 data points of the Fitzpatrick Scale (FS) into a pigmentation database, wherein the 50 data points each correspond to an MED data point,
 - storing information of tanning products into a sun protection database, and
 - having a minimal erythemic [sic] dose (MED) determination processor
 - use information from the records database, the pigmentation database, and the sun protection database;
 - using the pigmentation database to match the picture to one of the 50 data points;
 - determining an exposure time using the MED determination processor; and
 - transmitting the exposure time to the portable electronic device.

Claim snippet for consideration

...
an initial MED determination system, wherein said initial MED determination system includes a skin color set comprised of a plurality of potential skin colors, wherein each of said plurality of potential skin colors is associated with a skin numeric color value and with a MED value, wherein each MED value is different,
wherein said initial MED determination system receives said user photograph, wherein said user photograph is composed of a plurality pixels each having a numeric pixel color value,
wherein said initial MED determination system averages said numeric pixel color value for said plurality of pixels to determine a user photograph average color value,
wherein said initial MED determination system determines a skin numeric color value that is closest to said user photograph average color value and identifies the MED associated with said skin numeric color value closest to said user photograph average color value as a user target MED
...

Alternate language:

...a skin color set including a first potential skin color associated with a first MED and a second potential skin color associated with a second MED different from said first MED