Comments On The Claim Drafting Assignment Spring 2016

I.   General

    A.   Everybody's claims need some work, but if you keep trying, you will definitely improve.

    B.   Grades – Don't Panic.

        1.   "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

>   Leave plenty of space between lines for comments

>   Remove PON statements for future assignments.

>   No indenting whole claims

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.

B.   Although the disclosure talks about "reducing the stress of a user", we can't claim a user or their stress. However, we can claim a specific device that operates in a specific way.

1.   Thus, the device does not "sense stress" – but it can record a signal indicative of a heartbeat of a user, store it, and use the stored signal to calculate the current HRV of a user, and then compare the current HRV with a predetermined HRV threshold – and when the current HRV is less than the predetermined HRV threshold, the device may do something.

2.   Additionally, the system/method does not end with "reduction of user stress" – again, we can't claim a person or their stress. Instead the system/method ends with what the device does.

C.   A lot of people are going too broad/vague. Stick with a heart signal and HRV.

D.   Think through carefully about how the device works in a step-by-step fashion. Trace the date/signal. Itwill become more clear as you write the Detailed Description.

E.   Avoid vagueness

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

"monitor and analyze lifesigns data"

"cross threshold" – both up and down?

"approach threshold" – how close?

"a plurality of funcationalities"

"based on a range of values"

"execution of one or more specific operations"

F.   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:

Sensing heatbeat signal vs. sensing "stress"

Sensing a heartbeat signal vs. "sensing" HRV

"shutting down" a device vs. deactivating an app on said device

G.   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.

See examples

H.   Preamble Issues

1.   Not a method of "managing stress" – can't claim stress

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

IV.   Identifying the Points Of Novelty (PONs)

A.   People are going a little too abstract. In some cases, there appear to be items that are easily groupable to form a claim, but when you write it you likely realize that when you get down to the implementation details it functions differently enough that you have to break it into multiple claims.

B.   There are really multiple PON systems

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 "A and B in a mobile device"

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, software, computer code

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

"shutting down"

"via"

F.   Must use affirmative language

Can't say "can/could" – must actually do it

G.   Use of "or"

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

H.   Can's use "human" words

monitoring, disseminating, recognizing

REVIEW ACTUAL CLAIMS