Comments On The Claim Drafting Assignment
Spring 2017

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. "First Year Firm Feedback" 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

      A.   Remove PON statements for future assignments.

      B.   No "<u>an at </u>least one" (

      C.   Commas vs. semicolons – use "wherein" with a comma

             - only use semicolons to separate components, not actions performed

      D.   "at least one" seems to be really messing people up

III.   Claim Language

      A.   The majority of people seem to be having a vagueness problem and/or do not recite linkages between claim elements and/or do not recite a claim that actually DOES something. Although the data that is being sent around is very relevant to our PON, we still need to recite a system with a definite end in the claim

      B.   Thought Question for consideration -
             – Do you need to claim multiple parameters for novelty?
             - What if we were only measuring a single parameter?
             -What if we only transmit one ingredient amount to the dispenser?

      C.   A lot of people are trying to go too broad and are becoming vague. Example - If you just recite that the parameters are transmitted between "computers" rather than with a smartphone, then the Examiner is going to have a field day with regard to the prior art that can be cited against you to reject your claim.

      D.   Think through carefully about how the device works in a step-by-step fashion. You need good descriptive names for all of the components that you will be reciting. You also need good names for the parameter(s) that you might measure and the data transmitted to the drink dispenser.

    - As a thought experiment – think about each part – not necessarily for you to use:

        "a transdermal sensor positioned on the skin of a user, wherein said transdermal sensor senses a concentration of glucose in the bloodstream of said user and transmits data indicating said concentration of glucose in the bloodstream of said user to a server as current blood glucose concentration data"

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

"a client"

"initializing"

"associating"

"a quantity/an amount" "various quantities"

"a mixture"

"a mode of communication"

"a nutritional supplement"

"interacts with"

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:

"measuring a nutritional deficiency"

"signal includes an amount of a bioparameter"

G.   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.

Use "said" when you are talking about a component you have already introduced.

IV.   Identifying the Points Of Novelty (PONs)

A.   People are going a little too abstract. We need a definite and concrete "end" for our system to avoid a 101 rejection. Just transmission of data is not enough. Something much be actuated. Don't get me wrong – we will need the data that is transmitted, but the data must enable some end product. The data itself can't be an end product under 101. We will gain further insight in this in the next few weeks when we start looking at Examiner's rejections and how picky they are.

III.   Other Claim Aspects

A.   No connection of claim elements

Several people had instances where claim elements were not connected. Need functional connection not just "A and B in a communication system" Also need to connect the content of the data – if a server receives first data and transmits second data, you need to recite that the content of the second data is actually the first data if you mean that. If it is not specifically said, then it does not exist.

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. You should review all claims in light of your comments.

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, program

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

"via"

F.   Must use affirmative language

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

"Is capable of" is not an affirmative recitation of actually doing it. Often it is not acceptable to Examiners unless the very fact of what you are reciting the invention is "capable of" is new – and simply transmitting data is not new.

H.   Can't use "human" words

associating (without further limitations

a client

measuring (without a structural limitation)

REVIEW ACTUAL CLAIMS