Comments On The Claim Drafting Assignment Spring 2018

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 "an at least one" - no "the said"

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

- Only use semicolons to separate components, not actions performed

D. "at least one" vs. plurality vs. only one

- People seem to lose track. Recommendation: pick either one or plurality

E. My handwriting is not the clearest, but I would be happy to translate for you – please obscure your secret number to maintain anonymity

F. No AB = No Antecedent Basis

V= Vague

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 –

- What is the simplest embodiment that we need to get to novelty?

- Why not make that the first claim?

Consider - image data is remotely stored and is automatically downloaded to a phone and the phone transmits it to an LED display device. Storing both image data and associated display location data at a server and when current location data is received from a GPS unit positioned proximally to said LED display device that matches the associated display location data, the associated image data is downloaded to the phone and transmitted to the LED display device.

C. A lot of people are trying to go too broad and are becoming vague.

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.

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-side"

"advertising space", "display space"

"time comparing unit"

"battery life"

"display an advertisement"

"receiving by" vs" receiving from"

"coupled to" is vague – could be physical connection?

device determines its location and speed

"Based on an algorithm"

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.

Examples:

-"determining a desired location"

-data representing a desired interval of time vs. start time data and end time data

- activating said display device in accordance with said image data

- storing the velocity of the bicycle vs. storing data representing the velocity of said bicycle

- transmits an image vs. transmits data representing an image

- transmits location, transmits time

G. People are getting better as claim drafting as they write

H. The auction is the most difficult part to claim. Recommendation: Stay away from claiming the auction for now. Too vague. Work on data-level components. and return to it after you write the spec.

I. "LEDs display an image"

Question – what would you see if the wheel was not moving?

Series of color and brightness commands based on angular position?

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.

-no good – "determining a location" and "said determined location"

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 must be actuated or displayed. 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

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", power on

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.
-"determining whether" is the same as "determining if" – avoid these and use"when"
- No – "storing a location where data <u>will be</u> displayed"
- "adapted to" is not an affirmative recitation of actually doing it
- No "can be attached" – must affirmatively recite = "IS attached"

H. Can't use "human" words
associating (without further limitations
desires
regarding a location
measuring (without a structural limitation)
resides