Comments On The Claim Drafting Assignment Spring 2019

I.   General

    A.   Everybody's claims need some work, but if you keep trying, you will definitely improve – you are already much better than when you started.

    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?

    E.   Overall comment – This was the tightest grade distribution for the Claim Drafting assignment that I have ever had. (2018 ranged D to A-). Biggest difference – claim structures were generally good.

II. Formatting

There were a few small claim formatting errors, but overall the claims were pretty well-formatted.

A. Remove PON statements for future assignments.

B. Frequent notes/ abbreviations

No AB = No Antecedent Basis

V= Vague

SL = streetlight

PON= point of novelty

C. "at least one" – this construction often makes your claim awkward. You probably only need to recite one of them for your PON. Also, recall that legally unless you recite "only one", then a claim limitation of "an X" is infringed with multiple Xs.

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

III. Claim Language

A. People seem to be having a tough time getting really solid and focused on a PON. The temptation to include description limitations seems overwhelming. Also, lots of people have a problem with:

-Vagueness

- Lack of operative connections between claim elements that support PON

- Or they 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

- Expressing the claim in terms of just saying "a new component is there" is not enough – we want to go for what the new component functionally does.

B.   Thought Question for consideration –

- <u>What is the simplest embodiment that we need to get to novelty?</u>

- What is the minimum thing that we need to do to have a function that differentiates from the prior art – and what components are needed for that function? Also, pare the functions down to a single target for the claim.

- Why not make that the first claim?

- Alternatively, review your claim and for each limitation ask yourself "would the remainder of the claim still recite a point of novelty if this claim limitation were removed?" Alternatively, "is this limitation necessary to recite the functionality of the point of novelty that I am going for?" If not, then why do you have it? In the claim would still be novel if one limitation were removed, then do you really need to have both limitations?

C.   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.

- Several people are calling different aspects that same name, especially with regard to "memory" at both a server and the streetlight. If you call them both "memory" in the claim, then the claim is unclear. Instead use something like "server memory" and "streetlight memory"

- Also, memories store DATA. If you ae referring to something stored on a memory, it should be something like "audio date" or "audio file". Conversely, the stored audio data may be used to generate an audio signal (analog, no longer binary 0s and 1s) that can be transmitted to a speaker

- Also recognize that we can't claim an abstraction such as "advertising", but we can claim "advertising data". However, without more recitation in the claim of limitations about the advertising data, then "advertising data" is just a name of a data element and does not explicitly recite and structure or function.

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D.   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.

- I purposely add vague word to the invention disclosure because you need to learn to avoid them in practice. One reason the grade distribution is so close is that no one recited "ad spot" in their claims – that is very clearly too vague, but used repeatedly by the inventor. Good job!

Examples – Vague words

- processes the data (without more)

- a suite

-query data (without more)

- "interfaces"

Compare: (for vagueness only)

8050

7879

867-5309

E.   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.

- Biggest aspects – Speaker can't emit the stored audio file. Stored audio file is binary data (you know this because it is stored on a memory). It must be converted to some analog signal output (so that it sounds like music)

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

Recommendation - Although it might not feel great, try writing out your flowcharts for the DD and then drafting your claims again from scratch. Saying this another way – I recommend that you don't spend any more time on your claims until after you have written the DD – then write the claims anew so that you are not "locked-in" to any poor claim structure in the current claims. You can then compare the new claims with these claims if you want – but you will likely find the claims to be pretty different.

G.   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.

H.   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. "receiving audio data and storing it" vs "said stored audio data"

- Also, must use distinct names for separate elements – can't call both a memory on the streetlight and a memory on the server just "memory", but you can use "Streetlight memory" and "server memory"

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IV.   Identifying the Points Of Novelty (PONs)

     A.   People are having a tough time finding the "edges" of an aspect of the invention to claim – where should the claim start/stop? However, we need a definite and concrete "end" for our system to avoid a 101 rejection. Just transmission and storage 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 transmission and/or storage 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.

     B.   Three areas to think about:

- New streetlight – could be sold as its own component. Claim it as a piece that can be plugged into any system. Consequently, we won't claim upstream servers or the cellular network itself. Compare -"including a streetlight memory storing audio data received from an external communications system" vs "including a communications system transmitting data to said streetlight memory in said streetlight"

- There are several functions that touch on the streetlight, but focus on them individually. For example, the "flowchart" for "emitting sound based on an audio data file stored in a streetlight memory" would be a different function/flowchart than that of "determining when a predetermined audio data file is not present on a streetlight memory of a streetlight" and then "transmitting said predetermined audio file to said streetlight memory" Both involve the streetlight memory, but you can appreciate that these are separate functions – claim them separately. (Also, think about whether the adapter is required for novelty or just description.)

- Audio data file distribution system – There are actually several functions/flowcharts to think about individually – you would not need all of them for novelty and they could be claimed separately. For example – checking the streetlight for a predetermined audio file and transmitting it

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to the streetlight if not found is one process. However, identifying the streetlight(s) where you want the audio file to go is a different process. Also, the timed activation portion of the network may be a separate function. For example, if all you did was determine which of a subset of the streetlights to transmit the audio file to for storage on a streetlight memory as part of a process of emitting sound at the streetlight, you have reached novelty – no one has done that before. The aspect of identifying the start/stop time at which to emit sound based on the audio file is not required for this point of novelty. It would only be required if the audio file transmission system already existed in the prior art – otherwise it is "description" rather than "novelty" claiming. Also, the process of emitting a sound based on an audio file already stored on the streetlight memory is a different "fork" of the process from transmitting the audio file to the streetlight memory when it is not already stored on the streetlight memory – we don't need to claim both forks, just the fork that is needed for novelty.

- Determining which audio file of a plurality of stored audio files to should be stored in a predetermined streetlight memory based on predetermined location data and time data – is a tough and involved process – leave it for last after you have a better understanding of the earlier process "pieces"

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 as a limitation in the claim.

Compare: (just looking at connection aspect)

    1456

    149x

    0711

    867-5309

    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.

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

"played"

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.

- No – "audio data <u>will be</u> displayed"

- Audio data "on" a memory vs. "stored in"

G.   Watch accuracy of language

"multimedia file" -Wait, I thought it was just audio? What is the other media? Also, just saying "multimedia file" without reciting the specific data stored in the file is just a recitation of "title" of the file rather than an explicit recitation of structure/function. Compare with "audio file including audio data"

H.   Can't use "human" words

"query" (without more). Also "query data" without reciting the specific functional aspects of the query data and the data structure is just a name for a specific segment of data – not a recitation of any structure or function.

"upload" vs. "transmit"

"keeps track of time"

"ad" or "advertisement" – without more, there is no structural or functional limitation. The fact that the audio data represents an advertisement is a high level abstraction. The fact that "the audio data is used to determine an audio signal and a speaker is actuated in response to said audio signal" is a structural/functional limitation

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