Comments On The Claim Drafting Assignment Spring 2021

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

    F.   How students sometimes experience feedback on their claims
        - Especially when students have not written a lot of claims before – and

they have put a lot of time and effort into the claims (and I certainly acknowledge your effort and commend you!) – the students sometimes get very attached to their claims. Sometimes the claims seem perfect to them as they are – or at least better than someone else's claims in the class. -Some notes – first, the grade is for all three claims. Some people might have one slightly better claim and two slightly worse than another student- but overall it might average out.

-Second, students are making several different types of errors – and in different frequencies and levels of severities over their claims. This again requires overall averaging. Just about everyone has some good parts for at least one claim – and everyone has some parts that need improvement – but the grade is an overall evaluation. However, when students compare claims that are not their own, they can typically detect a difference.

Compare: 944 – 1

4723-1

0021-1

G.   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.

F.   Don't Despair! People get better at claim drafting as they write more claims! In fact, it is the only way to get better.

- 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 a significant portion of 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.

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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

PON= point of novelty

w/ = with

UNK=Unknown

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

- Only use semicolons to separate components

D.   "Further including" should only be used in the dependent claims when adding an additional claim element. Just use "including" in the independent

E.   No pronouns! ("that", "which") – use "wherein said X" instead

F.   "An app/program on said computing device" vs. "said computing device"

App is not structure – it is also not 101-claimable subject matter.

It is also typically not needed – you can typically just claim the device on which the software is functioning.

G.   Spell out abbreviations the first time including "electroencephalogram (EEG)"

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III.   Claim Language

A.   People seem to be having a tough time getting really solid and focused on a PON. The primary issues in order of frequency of occurrence are:

- Defining the start and end points of the invention

-Vagueness

- Relying on the name of an element without defining it.

- Lack of operative connections between claim elements that support PON

- Or they do not recite a claim that actually DOES something. Just storing data or calculating data is not enough. We need to do something with it.

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,

B.   Identifying the Points Of Novelty (PONs)

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.

Things to think about:

-We can only patent a machine. Where does our machine start? Where does it end? How does that differ from how the inventor talks about the

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invention?

- PON is not just a goal – there should be some actual structure and function that differentiates from the prior art.

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

- 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?

- Do we need to claim BOTH the setup AND the operation in the independent claim?

      -Are photos needed for operation?

      - is EEG data needed for setup?

- 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.

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 words to the invention disclosure because inventors CONSTANTLY use them and you need to learn to recognize and avoid them in practice – or figure out a way to structurally and functionally define them.

- Many "human/emotion" words are very vague

- Students often use them to try to cover up parts of the claim that they are not sure how they work –or are complicated – and thus for which they are having a hard time claiming structurally and functionally.

Examples – Vague words

connecting, assigning, allocating, captures, introducing, are given, student, teacher, electronic data collector, implemented in

Vague phrases

-field of view, processes data into a data profile (lots of similar phrases)

-performance matrix

- Do we need to claim "field of view" or "performance matrix" or are these just abstract terms? What are these at the machine/data level?

E.   Need to differentiate between <u>data</u> and what the <u>data represents</u>.

- For example, you can't "transmit an angle", but you CAN "store data representing an angular position" OR "angular position data representing …"

- "EEG signals" vs. "determining an EEG based on detected brainwave signals of a user"

- However! Just calling some data "image data" does not define it. Without additional structural and functional limitations, that is just a name for the data, not an actual claim limitation. That is, without more recitation in the claim of additional limitations, it is just a name of a data element and does not explicitly recite and structure or function of that data

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element.

- Also, the sensor itself can't "sense an EEG". It can sense brainwaves and use them to determine an EEG

- Question: Is determining an entire EEG needed for novelty?

F. 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" only when you are talking about a component you have specifically already introduced.

G. Insufficient connection of claim elements – watch out for lists

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.

H. Remember that all words in the claim are claim limitations – don't include words that are not needed for novelty. For example: "wearable augmented reality device" vs. "augmented reality device" – did we need to recite the "wearable" for novelty? "Raw bio-signal data" is not the same as "bio-signal data"

I. 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.

-"is configured to" is not enough if you only include the end goal and not the structure or specific functional steps to get there.

- no "if"

-no "that can be continually monitored"

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J.   Focus on claiming the machine and the data, not the human

- "user location" vs. "currently detected pointing position of device" vs. "previously stored pointing position" - "spatial position"?, "angular pointing position"?, "oriented at a first angle"? "first positional orientation"? "determined to be oriented toward a first stored spatial position"?

- "alerting a user" vs. "displaying on a display"

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