Comments On The Claim Drafting Assignment

Spring 2023

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" grades. Your grades reflect your status as students in a class – not how a professional would be graded (more harshly).

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.

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 in quality/grade. Let's review some claims

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Point of Novelty = a medical patch including a cellular transmitter

1. An apparatus comprising:
a medical patch including a cellular transmitter.

PON: A pull station that requires only a pull from the user to report shooting incidents.

2. A system for notifying an active shooter situation, said system comprising:
a housing having a front surface and a back surface;
a switch mechanism located within said housing;
a cellular communication transceiver connected to the said switch mechanism, wherein, the said transceiver, through the activation of the said switch mechanism, notifies the occurrence of active shooter situation to a predetermined address; and
a server that receives the notification sent by the said transceiver.

PON – A bandage that has a GPS and a cellular transceiver.

3. A bandage comprising:
a membrane;
an adhesive;
a GPS to provide GPS location data; and
a cellular transmitter connected to said GPS to transmit said GPS location data,
wherein said adhesive, said GPS, and said cellular transmitter are supported by said membrane.

PON: when an alarm is activated, the server will identify the other corresponding alarms or patch boxes.

4. A system comprising:
an emergency activation device including a first identification (ID) memory and a transmitter, wherein the first ID memory stores an activation ID value, wherein the transmitter sends the activation ID value;
a server including a server memory and processor, wherein the server receives the activation ID value from the emergency activation device, wherein the server memory stores an ID data structure, wherein the processor compares the activation ID value of the emergency activation device to the data structure to determine a response ID value of an emergency response device, wherein the server sends a signal to the emergency response device; and
the emergency response device including a second ID memory, wherein the second ID memory stores the response ID value, wherein the emergency response device receives the signal from the server.

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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

WRT = with regard to

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 "GPS" or "ID"

H. Revise the order of the claimed structural elements in the claim so that you introduce them the first time as an "indented" limitation. They don't have to be introduced in the order in which they are activated – you can introduce them and then discuss their operation with "wherein" clauses after they have all been introduced.

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III. Claim Language

A. One goal for improvement is to get more 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.
- Trying to recite two separate elements, data, or processes at once
- Lack of operative connections between claim elements that support PON
- Or they do not recite a claim that actually DOES something. Just transmitting 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. There needs to be some sort of automated control step. Don't get me wrong – we will need the data that is transmitted, but the data must enable some end function beyond mere data display or insignificant post-solution activity. 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 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?

- 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?

Questions to think about:

- Trace through the operation of the pull station. Where do things start getting "new"?

- Can we draft a claim to the patch without having to recite any actual data transmission? What is the structure that fundamentally enables the new functionality?

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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

notification, alarms, facility, value

Vague phrases

transmitting a location

a plurality of alarms present in a facility

notifies the occurrence

E. Need to differentiate between data and what the data represents.

- Just calling some data "identification data" does not define it – and it does not explicitly state what the data actually identifies.
- 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 element. For example, you might think about what the identification data represents or how it is used or stored and recite that in the claim.
- Transmitting "ID value" vs. "Identification data including a unique identification code assigned to said pull station"

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.

-Note if you recite "comparing X and Y", there is no AB for "said comparison" – it needs to be the exact term. (Note: "Comparing" is also vague – at least without more)

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

Several people had instances where claim elements were not connected. Sometimes certain data elements seemed to appear out of nowhere.

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.

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H. Remember that all words in the claim are claim limitations – don't include words that are not needed for novelty. For example:
- "central monitoring server" – is "central" needed?
- reciting front and back surface of a housing when they are never mentioned again in the claim

I. Must use affirmative language
-Can't say "can/could" – must actually do it
-"is configured to" is not enough if you only include the end goal and not the structure or specific functional steps to get there.

J. Can just say that something "is determined" without reciting how. Example – server receives signal from pull station and output "is determined" – but we need to know how

K. "Data Structure" is a broad term for how data is arranged/stored in memory, typically with regard to how data can be retrieved and accessed, including what data can be used to access/identify what other data
- Review construction of school-level data structure including data types.
- We are comparing incoming data to data stored in data structures – not the whole data structure itself

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