

Comments On The Claim Drafting Assignment Spring 2009

I. General

- A. In many cases, the claims need some work, but if you keep trying, I will be happy to help you get better.
- B. In general, people often got caught up in reciting what components were there and did not concentrate on the novel function that was actually the point of novelty.
- C. Grades – Don't Panic. Grades usually get better during the semester and final grades are typically quite good if you work at improving your product.
 - 1. 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. However, please read Patent It Yourself and the MPEP sections first.
 - 2. If you got less than a B, then there will be extra credit opportunities to help you raise your grade – if they are even needed. (They usually are not.)
- D. 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.

II. Frequently occurring problems

A. Having difficulty identifying and claiming the PON

1. Many people seemed to have trouble with this and instead either
 - a) wrote a description claim, or
 - b) wrote a vague claim.
2. Our PON is something doing something – not just random pieces.
3. I think that many people probably wrote agglomeration claims for their ungraded set, realized that they needed to connect the elements, and then just recited some connection – there, done!
Instead, they need to go back and re-think their PON – what FUNCTION are they really trying to claim here? You can claim the function either by reciting the function in terms of what physical elements accomplish the aspects of the function (structural claim) or just claim the function directly (method).

B. Indefinite or Undefined Language

Need to affirmatively recite limitations in your claim that cause your claim to be clearly differentiable from the prior art.

1. reward
2. administrator
3. award
4. accordingly
5. allocate
6. regulating
7. controlling/operating (without more)

7. Not sure what you mean – Not clearly defined in the claim

“said port transfers”

“said port transmits”

“transfers said number”

Lots of other one-time strange phrases

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!)

- C. Reciting non-limiting statements of intended use
“to enable” “capable of” “adapted to”
“for” doing something
Instead affirmatively recite what it does.

EXAMPLE - “a user interface for inputting data ...
“... said input data ...

- D. No connection of claim elements
Unclaimed essential subject matter - p13 , class 3
PRO – It seems like people got the message that there has to be a connection between elements
CON – sometimes connections were not functional
THUS - You are still leaving out essential subject matter –
i.e., how the invention works!

EXAMPLE –

1. An apparatus comprising:
an electrical outlet;
an electrical plug;
a locking mechanism;
a switch;
an input mechanism;
said switch connecting said electrical plug and said electrical outlet;
said locking mechanism regulating access to said electrical outlet, and;
said input mechanism operating said locking mechanism.

E. Preamble

1. Can't use the preamble to establish antecedent basis
2. Preamble is not a claim limitation – language should not appear only in the preamble and not in the claim limitations
3. Example –Don't recite "reward" in the preamble, and then not recite the elements that actually give the "reward" (don't use reward in general, but this is an example of the final step recited in the preamble, but the claim only recites enough elements to get halfway there.)
4. As a learning tool, I recommend that you use a preamble to help focus yourself on the point of novelty as you draft the claim. For example, no more:

"A method comprising"

Instead recite:

"A method for doing X, said method including:"

Where X is your PON.

- F. If there is no mark by a claim or an element, it is not necessarily an endorsement.
- G. It is expected that you will collaborate. Work on your claims with other students. Practice drafting and breaking each other's claims.
- H. If you recite a structural claim, like a system or apparatus claim, all claim elements must be structural –

Examples that are NOT structural = data, program, software

- I. Reciting "A device for" is most likely means+function language
(Also, "an element for")

Let's consider some claims and their problems. These are representative of the graded claims.

1. A system for controlling power to an electrical appliance based on units earned by completing physical activity, said system including:
a device for measuring physical activity of an individual;
a device for controlling power to said electrical appliance; and
a method for managing the network of said physical activity measuring devices and said power control devices.

2. A switching device comprising: an outlet to supply power to an external electronic device, a display device, a lock device preventing an external device from being disconnected from the switching device, a device for communicating with a control device to receive commands wherein said commands tell the switching device when to switch the external electronic device on or off.

3. A method comprising:
transferring an electricity time access data from a central control system to a power switch using a wireless connection; and
sending said electricity time access data from said control system to control said power switch to supply electricity, wherein said power switch outputs said electricity for a period of time, wherein said period of time is the same as said electricity time access.

4. A system including:

an activity measuring device including a sensor, wherein said sensor detects physical activity of a user;

a computing device, wherein said computing device receives activity data from said activity measuring device, wherein said activity data represents said physical activity of said user, wherein said computing device compares said activity data to pre-established goal data; and

an electricity lockout device, wherein said electricity lockout device receives a signal from said computing device when said activity data exceeds said goal data, wherein said electricity lockout device implements said signal by allowing electricity to flow through said electricity lockout device.

5. A power control system, said system including:

a user interface receiving an identifying code from a user;

a wireless transmitter transmitting said identifying code to a remote access control system, said access control system making a power access determination based on said identifying code, wherein said power access determination includes a power access time;

a wireless receiver receiving said power access determination from said access control system; and

an electronic power switch, wherein said electronic power switch provides power from a power input plug to a power output plug, when said power access determination indicates power access is granted,

wherein said power is provided from said power input plug to said power output plug for said power access time.