

Comments On The Claim Drafting Assignment Spring 2011

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. Grades – Don't Panic. Grades 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.)
- 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. Formatting – claims should be double-spaced, indent elements, don't leave large sections of the page blank
- F. Remove PON statement for future assignments.

II. Identifying the Point Of Novelty

- A. The majority of people seem to be aiming too narrowly. There are a lot of structural and functional elements that are recited in the claims that don't necessarily need to be. The claims are a little too "description" rather than PON in many cases. That's a difference from last year when people went too big. However, people are still having a problem with vagueness. However, it seems like two things that are lacking are: a better appreciation for the prior art, and a better understanding of broadness as opposed to vagueness.
- B. Vague words that seem helpful, but are really indefinite or undefined. Every year these happen. It's part of the growth process, but a tough thing to avoid. 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 clear that an Examiner can't adopt an interpretation that we don't like. Do these work?
- a remote device – remote from what? Is the "remote-ness important?"
 - a module - pretty much a "means"
 - initiating negotiation - ?
 - over said channel – slang + do you need the channel?
 - locking said door – is the door really locked or is a lock locked?
 - capturing video – as opposed to recording?
 - a link - non-physical – do you need it?
 - closing a wireless connection
 - invoking a connection-closing command
 - a door security device – any actual limitations here?

C. Although people are starting to turn away from the description-based claim, they still are somewhat stuck in the model because they feel the urge to recite the overall system in the claim.

Example – they identify the point of novelty as sending control signals to the door control system, but then also recite transmission of audio and video and defining communications “links”. Is the transmission of audio AND video both absolutely necessary for novelty – do you need either?

III. Other Claim Aspects

A. Not saying what you mean

Relaying communication between the user and a visitor

a module, wherein said module is fixed in a location visible from a space

adjacent to said door

an activation device that activated the system through some outside stimuli

establishing a wireless loop connection

selecting gateway automation commands

“mounted”

Naming the data to keep it straight

B. Reciting non-limiting statements of intended use

“to enable” “capable of” “adapted to”

“for” doing something

Instead affirmatively recite what it does.

C. No connection of claim elements

Interestingly, this came up several times in method claims.

For example

measuring data using a device;

transmitting said data to a computing device; and

displaying said data.

As opposed to:

measuring data using a measuring device;

transmitting said data from said measuring device to a display device; and

displaying said data at said display device.

D. 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.

- E. If you recite a structural claim, like a system or apparatus claim, all claim elements must be structural –
Examples that are NOT structural = link, software, communication, transmission, command
- F. No “MEANS” claims
Reciting “A module for” is most likely means+function language
Also, “an element for” “a unit”
- G. Some people are still overloading the preamble. If you preamble recites a limitation that is not in your claim elements, there is a problem!
- H. **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”. Anything on a door is a “security device”. 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.

- I. No slang or foreign languages
“via” is Latin – do you mean “through” or “using”?
“transmitting over a connection”
locking a door