

Comments On The Claim Drafting Assignment Spring 2008

I. General

- A. Overall, these were the best claims in years. Thanks for all of your hard work.
- B. Need to concentrate on the novel function. Start with the novel function and only recite the structure that is required for it to operate. Also, watch out for the use of undefined terms like “location data” – location of what?
- C. Remember - our standard of clarity is “So clear that the claim can’t be broken by the other side.”
- D. 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 claims with you to help you improve – just be sure to remove your identifying code before you show me the claims.
 - 2. If you got less than a B, then there will be extra credit opportunities to help you raise your grade.

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.

Discuss points of novelty (not in claim language and not an exclusive list)

Display

an e-paper display that is worn

display includes memory storing location information

includes rechargeable display

location info is passed to remote server

location info received from external source

triggers location info request using a timer

must know start, stop, and present time

has a transmitter and receiver

Question – which is farther away from the prior art? 1) Wearing a display when the display happens to be e-paper? 2) The display includes a transceiver and periodically sends a location request to a GPS receiver during a predetermined time period?

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. “location data/position data”
2. “verifying”
3. “processing”
4. “a location verification system”
5. “a mobile device”
6. ‘a venue”

7. Not sure what you mean – Not clearly defined in the claim
“displays a persistent image”
“communicating with” – is this bi-directional or one-way
“wherein said data confirms”- data just used in the confirmation process?
method limitation – “having” – it is like “providing”

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

“wherein the system is used to verify the presence of an advertiser at a specific venue in order to display a promotion”

Instead affirmatively recite what it does.

Also, you don't have to recite what the system is used to do if it is not necessary for PON. It doesn't help you and may hurt you.

- D. Getting hung up on the specification.
The Inventor uses a term and the term is a bad one, but the term gets lodged in your memory and your basic understanding of the invention and keeps popping into your claim.

Last year it was “web presence” and “portable”

This year it is “pinging”, “forum”, and “venue”, maybe “mobile”

- E. No connection of claim elements
Unclaimed essential subject matter - p13 , class 3
PRO - Improvement over last year – everyone made some connection.
CON – sometimes connections were not functional
“a casing, wherein a display is attached to said casing, wherein a battery is attached to said casing, wherein a memory is attached to said casing, wherein a transmitter is attached to said casing.”
You are still leaving out essential subject matter –
i.e., how the invention works!
- F. Use of “Or”-or “And”
“device is one of A or B” – do I need to recite both to get over PA?
- G. 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
- H. Method claim for reverse auction
NOT – “wherein it is an auction for advertising”
= wherein my wagon is blue – no functional limitation
YES – “wherein said image representing advertising is downloaded to an advertising display device” or some other functional limitation
- I. No slang or foreign languages
“via” is Latin – do you mean “through” or “using”?

J. No step plus function claims

Don't recite "a method comprising the steps of:"

"a receiving step"

Step plus function may cause your claim to be construed under 112,6 like a means plus function claim. This is undesirable.

Avoid step plus function.

K. Format – From now on - double space and space between claims, but no page breaks.

Your claims are "official" now.

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

1. A display apparatus including:
 - an electronic display, wherein an image is maintained on said electronic display when power is not provided to said electronic display; and
 - an operator attachment system attaching an operator to said electronic display.

2. A display apparatus including:
 - a flexible display screen displaying an output message;
 - a case containing said flexible display screen;
 - wherein said case includes an input data receptacle receiving electrical power and data,
 - wherein said case supplies electrical power and data to said flexible display screen; and
 - a load bearing mechanism affixed to said case.

3. A method for allocating advertisers to a sponsor by a matchmaker, comprising:
 - a) receiving a pay maximum, \$X, and a desired number, \$Y, of advertisers from said sponsor;
 - b) receiving "desired pay" bids from advertisers willing to carry out advertising assignments;
 - c) assigning the Y smallest bids (and the advertisers who make them) below \$X (or all of the bids below \$X if there are less than Y) to said sponsor; and
 - d) preparing said assigned advertisers to advertise for said sponsor.