Comments On The Claim Drafting Assignment Spring 2010

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

II. Identifying the Point Of Novelty

A. I think people are still trying to go too big in many cases. I am pleased to see that they seem to have picked up on the fact that writing a description claim is not good because there are too many extraneous limitations. Also, people have picked up on the principle that broad claims are good and are trying to write broad claims. 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. Let's look at the prior art:

Here's a link to a prior art online calculator that was in your invention disclosure:

http://www.carbonify.com/carbon-calculator.htm

Please stop drafting claims that read on this prior art calculator!

(Go through examples)

To put it another way, you need to include an affirmative limitation in your claims so that the Examiner can't take an interpretation of your claim to read on the prior art.

C. If you are running into trouble, you may be trying to do too much with one claim. Try taking smaller bites. Maybe if it is difficult to write a claim that encompasses all three systems for providing data to the web site, try to focus on one at a time. Get a very solid claim that you like crafted and then see if it works any for others. This is a different approach from assuming that all of the systems will be abstractable into a single claim – your ability to include them all may depend on the particular point of novelty that you are claiming – it may not be possible to do so without making the claim unworkably vague.

For example,

PA - scale wirelessly transmits to computer

PON? – automatic re-transmission from computer to pre-configured internet account

D Let's also dig a little deeper. For example, take a look at the actual data that is being transmitted from the three measuring inputs. From the scale you receive a weight – there is a later conversion to a carbon output value based on a user-selection of a conversion factor - Trash Level in this case. However, the conversion is done at the server, not at the scale. Consequently, "measuring a carbon output" or "carbon usage data" is not what the scale does. It just measures weight.

From the iPhone, you get a distance – there is a later conversion to carbon output value based on the user selection of a conversion factor. From the EnergyHub, you get measurements of actual electricity and gas usage – and there would not need to be any user selection of conversion factors by the user here. Can you see why? Would the conversion factor be standard?

E. Try altering your beginning and end points for the claim.
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. That is, in their minds the "invention" and thus the claim still starts with data gathering and ends with offset.
However – what about separate data gathering elements (as above)
Would pieces of our data deliver end still be novel without our offset end?
Is out multi-selection offset still novel regardless of data delivery?

F. 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 to clear that an Examiner can't adopt an interpretation that we don't like. Do these work?

"a portal" – "remote server"?
"carbon footprint" - "carbon output value"?
"carbon usage data" (without definition/limitation in claim)
"of a household" – what is a "household"?
"appropriate remediation products"
    how determined? Is this a technology?
"gathering data" – "receiving"? "calculating" "transmitting"
"a carbon offset"

III. Other Claim Aspects

A. Too Much Abstraction

I can appreciate people wanting to claim broadly, but at some point their language becomes so abstract that it no longer recited an affirmative limitation

"processing data using a parameter"

"performing a calculation to determine a carbon footprint"

B. Not saying what you mean

"determining a carbon output amount and inputting said amount into a computer system"

"monitoring miles travelled using a monitoring device"

C. Reciting non-limiting statements of intended use

"to enable" "capable of" "adapted to"

"for" doing something

Instead affirmatively recite what it does.

D. 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.

Does this actually add any further limitations?

measuring data using a measuring device;
transmitting said data from said measuring device to a display device;
receiving said data at said display device; and
displaying said data at said display device.

E. 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.

F. 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, database

G. No "MEANS" claims

Reciting "A device for" is most likely means+function language

Also, "an element for" "a unit"

H. It is expected that you will collaborate. Work on your claims with other students. Practice drafting and breaking each other's claims.

I. Some people are still overloading the preamble. If you preamble recites a limitation that is not in your claim elements, there is a problem!

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

1. A system for reciprocating a carbon footprint, said system including:

at least one carbon output measurement; and

at least one offset entity, wherein at least one offset purchase is made based on the choice of a user.

2. A method of carbon offsetting, said method including:

determining carbon footprint from carbon usage data;

determining appropriate carbon offset options based on said carbon footprint;

presenting a user with said carbon offset options for purchase;

facilitating said user with said purchase of carbon offset.

3. A method for providing data related to personal carbon generation, said method including:

measuring carbon usage data through one or more devices;

transmitting said carbon usage data to a computing device through a communications system; and

displaying said data on said computing device.

4. A method of providing updated carbon output values for an activity, said method comprising:

measuring levels of performance of an activity using a measuring device;

transmitting said levels of performance from said measuring device to a system applying a number of functions to said levels, said functions including receiving said levels and performing calculations using said levels;

receiving said levels using said system;

calculating a carbon output value based on said levels of performance using said system; and

providing said carbon output value, wherein said carbon output value is updated after said levels of performance change by transmitting subsequent levels and calculating subsequent carbon output values.