Comments On The Claim Drafting Assignment Spring 2014

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.

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 at the end of the semester. (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?

II. Formatting

Claims should be:

Line between claims

Font should be at least 12 point

Remove PON statements for future assignments.

III. Claim Language

A. The majority of people seem to be having a vagueness problem coupled with a focus on the effect rather than the system - which leads to a problem defining the PON of the invention. Really need to think specific "hardware" and functional elements rather than the "experience" and how users perceive/interpret the technological function. There is also a problem differentiating between the a device and data representing a device.

For example, saying "a group includes a device" means the literal, physical device. Instead, the drafter probably meant something like "data representing a device" or "a group including first device data, wherein said first device data includes data identifying a first device". (We discuss below why "group" is a bad term, but it is included here for ease of illustration of the point.)

B. 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 can not attack it or adopt a strained interpretation.

Examples

"on an application" – includes physically on

"on" in general – meaning stored in a memory included as a component?

"administering" an application

parameters "coincide" with other parameters

"Distributes audio signals" without any recitation of how it takes place

"Interfaces with a device"

C. Physical or conceptual structure?

1. We can claim things that are physically there. We can't claim human interpretations or conceptual constructs. So what is a "group"? Is it a physical or conceptual construct? How would a "group" be physically represented? How would a computer "make" a "group" or associate a device with a "group" or be able to tell whether a specific device was associated with a "group"? We need to recite it at the "computer" level, not conceptual.

   "a communication group"
   "in a group"
   "adding to a group"

   "a network" doing X – with no other limitations recited
   Is a "network" conceptual without recitation of structural elements?

C. Imprecise/impossible claim limitations – or trouble with abstraction

We also have to be very precise in our claim language. Language that merely allows the reader to understand what is likely meant is not enough. The language must rigorously define the scope of the legal right. For example, there is a huge difference between "data representing a device" and "data representing a an audio signal received from a device".

Examples

"Connects" a driver with another driver

Not sure if this is more of a conceptual fault, but the drivers are not literally connected.

"receiving voice commands from said first user containing positional information"

- -literally recites that the first user contains positional information. Maybe: **", wherein said voice commands contain positional information"?**

"**a group includes a device**" means the literal, physical device. Instead, the drafter probably meant something like "**data representing a device**" or

"**a group including first device data, wherein said first device data includes an identification of said first device**".

"providing potential targets to a first user"

This is the targets themselves, not just data representing the targets or information identifying the targets?

D. Defining the extent of the invention

"Server configured to exchange information with plurality of devices"

To /from? Both to/from? Both devices?

Do we only need one device talking with one other device? communicating "**among**" devices

Again: To /from? Both to/from? Do we only need 2 devices? reciting "plurality" when you only need two.

Most people would like find their claim easier to write if they switched to "a first device" and "a second device" or "an initiating device" and "a receiving device", for example.

E. Lots of Antecedent Basis (AB) problems

Every time you use the word "the" – make sure the claim term has been introduced. When you first introduce a claim term, make sure that it includes some structural or functional limitation. If you don't include a structural or functional limitation in the claim itself, then the term is undefined. Consequently, without further recitation in the claim, "location data" is likely to be interpreted by an Examiner as meaning ANY data unless there are affirmative limitations in the claim that prevent that interpretation. Note that "location data" alone is not interpreted the same as "location data representing the location of a smartphone" or location data representing the GPS coordinates of a smartphone" or "location data representing the most recently received GPS coordinates received from a smartphone"

IV. Identifying the Points Of Novelty (PONs)

A. Separate the new function being provided from the infrastructure that was already in place. What new hardware has to be added to the infrastructure to implement the invention? Pretty much just the "server" (and/or associated logical and structural elements). The phones, towers, internet, etc. were already there. That doesn't mean that the server will be the only thing in our claim, but it does focus our inquiry.

From a software infrastructure perspective, software is downloaded onto the phone to make it operate in a new way, but the phone was already able to determine and transmit GPS coordinates and use VOIP. The hardware of the phone is not modified. The phone's on-board systems (such as GPS) are actually just infrastructure that is being used by the software – it is infrastructure for our invention, not the invention itself.

III. Other Claim Aspects

A. No connection of claim elements

Several people had instances where claim elements were not connected.

Actual Example:

providing potential targets to a first user to select; and

establishing communication between a first user and a second user.

Where did the targets go? Is there any connection with the last claim element?

B. 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.

C. If you recite a structural claim, like a system or apparatus claim, all claim elements must be structural –

Examples that are NOT structural = information, group, data

D. No "MEANS" claims

Also, reciting "a unit " is most likely means+function language if there is no structural limitation.

E. **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.

F. No slang or foreign languages

"over the network"

"setting up"

"runs"

"an app"

"via"

G. Avoid statements of criticality – they make for easy design-around

all, each, every

the identifier is "Defined by description of motor vehicle"

statement of criticality in disguise

H. Must use affirmative language

Can't say "can" – must actually do it

I. Use of "or"

Typically not good practice – are BOTH choices necessary for novelty?

Some Actual Claims For Review

1. A system of forming an online conversation group of users comprising:

recognizing and identifying users based on their geographical location; and

users, while they are traveling in motor vehicles, can communicate with one another via said system.

2. A method for seamlessly communicating among a plurality of mobile devices, the method including:

a) An initiator wireless device, wherein said device transmits initiator's location information including GPS coordinates representing the geographic location of said initiator wireless device;

b) A receiving wireless device, wherein said receiving wireless device transmits receiving device's location information including GPS coordinates representing the geographic location of said receiving devices and receives communications initiated from said initiator device;

c) A server, which receives geographic locations of initiator and receiver devices and determines a radial proximity representing a geographic area within a predetermined radius from said geographic locations of said wireless devices

3. A method for communicating among a plurality of mobile communication devices, the method comprising:

providing a first mobile communication device;

determining a geographic location of the first mobile communication device;

adding the first mobile communication device to a communication group based on the geographic location of the first mobile communication device;

providing a second mobile communication device;

determining a geographic location of the second mobile communication device;

adding the second mobile communication device to the communication group based on the geographic location of the second mobile communication device;

communicating a live audio to a server from at least one of the first mobile communication device and the second mobile communication device; and

transmitting the live audio from the server to the communication group.

4. A method of wireless communication including:

receiving initiator location information from an initiator wireless device, wherein said initiator location information includes GPS coordinates representing the geographic location of said initiator wireless device;

receiving receiver location information from a receiver wireless device, wherein said receiver location information includes GPS coordinates representing the geographic location of said receiver wireless device;

determining a radial proximity representing a geographic area within a predetermined radius from said geographic location of said initiator wireless device; and

receiving at said receiver wireless device data representing audio information from said initiator wireless device when said geographic location of said receiver wireless device is within said radial proximity.