

Friday Seminar Series

December 9, 2010

Claim Drafting

Statutory Basis – 35 U.S.C. §112

- *¶2 The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.*
- *¶3 A claim may be written in independent or, if the nature of the case admits, in dependent or multiple dependent form.*

Statutory Basis – 35 U.S.C. §112

- *¶14 Subject to the following paragraph, a claim in dependent form shall contain a reference to a claim previously set forth and then specify a further limitation of the subject matter claimed. A claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers.*
- *¶15 A claim in multiple dependent form shall contain a reference, in the alternative only, to more than one claim previously set forth and then specify a further limitation of the subject matter claimed. A multiple dependent claim shall not serve as a basis for any other multiple dependent claim. A multiple dependent claim shall be construed to incorporate by reference all the limitations of the particular claim in relation to which it is being considered.*

Statutory Basis – 35 U.S.C. §112

- ¶6 *An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.*

37 C.F.R. §1.75

- *(a) The specification must conclude with a claim particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention or discovery.*
- *(b) More than one claim may be presented provided they differ substantially from each other and are not unduly multiplied.*
- *(c) One or more claims may be presented in dependent form, referring back to and further limiting another claim or claims in the same application. Any dependent claim which refers to more than one other claim ("multiple dependent claim") shall refer to such other claims in the alternative only. A multiple dependent claim shall not serve as a basis for any other multiple dependent claim.*

37 C.F.R. §1.75

- *The claim or claims must conform to the invention as set forth in the remainder of the specification and the terms and phrases used in the claims must find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description.*
- *Where the nature of the case admits, as in the case of an improvement, any independent claim should contain in the following order:*
 - *(1) A preamble comprising a general description of all the elements or steps of the claimed combination which are conventional or known,*
 - *(2) A phrase such as "wherein the improvement comprises," and*
 - *(3) Those elements, steps, and/or relationships which constitute that portion of the claimed combination which the applicant considers as the new or improved portion.*

Claim Format

- Each claim is to be a single sentence. Each claim begins with a capital letter and ends with a period. Periods may not be used elsewhere in the claims except for abbreviations.
- Where a claim sets forth a plurality of elements or steps, each element or step of the claim should be separated by a line indentation, 37 CFR 1.75(i). There may be plural indentations to further segregate subcombinations or related steps.

Claim Format

- Reference characters (in parenthesis) corresponding to elements recited in the detailed description and the drawings may be used in conjunction with the recitation of the same element or group of elements in the claims. The USPTO considers reference characters as having no effect on the scope of the claims.
- Claim numbering is maintained. Applicant does not renumber claims. Examiner renumbers claims.

Multiple Dependent Claims

- Not advisable
- Costs extra
- Can't depend upon another multiple dependent claim.

The Preamble

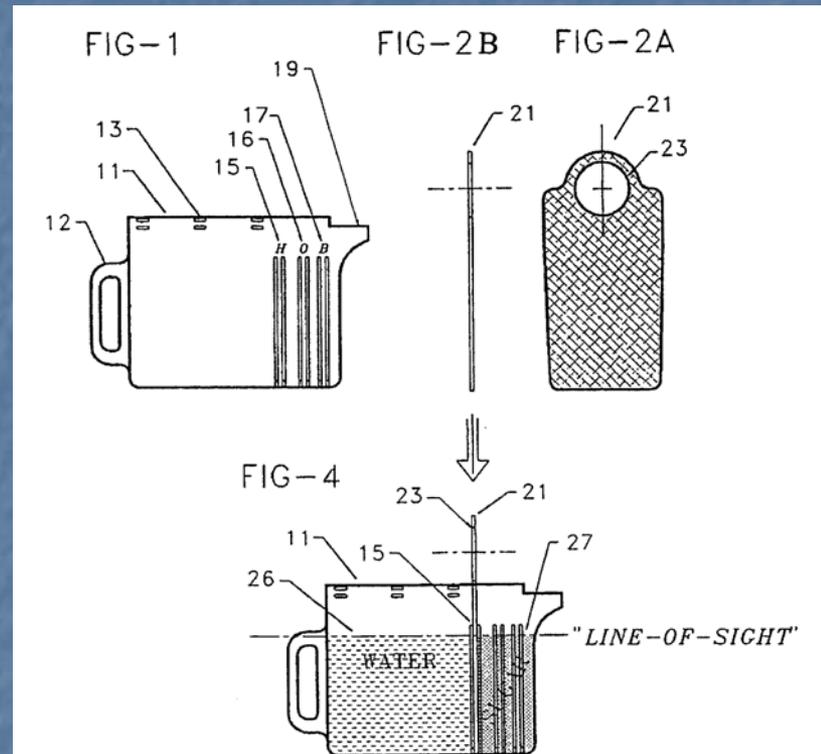
- Breathes life into the claim (see e.g. MPEP 1302.14 II)
- Indicates statutory class
- Consistent with scope
- Keep short
- Examples:
 - "An apparatus for catching mice, comprising:"
 - "A chemical composition for cleaning windows, comprising:."
 - A method for computing future life expectancies, comprising:

The Preamble

- Preamble can limit claim
- Jepsen claim preamble sets forth what is old

Preamble and non-analogous art

In re Klein, _____ F.3d _____ (Fed. Cir. 2011)(2010-1411, decided June 6, 2011, See: <http://www.cafc.uscourts.gov/images/stories/opinions-orders/10-1411.pdf>).



J.A. 112.

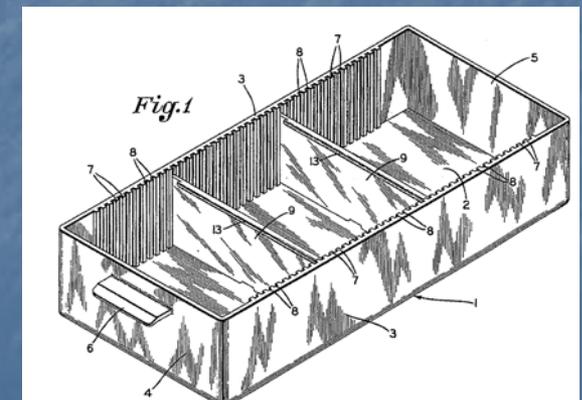
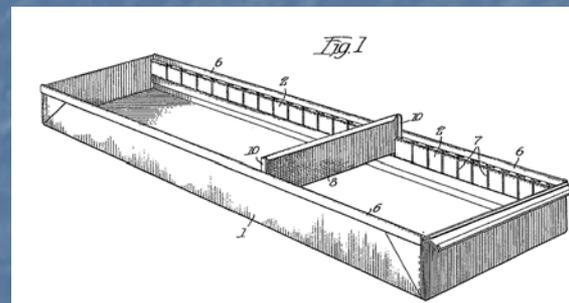
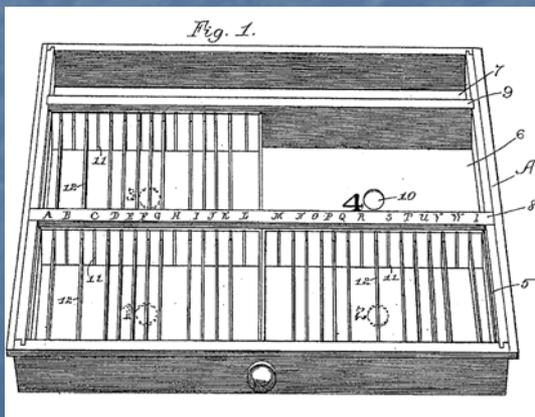
The sole independent claim at issue, claim 21, recites:

21. A convenience nectar mixing device for use in preparation of sugar-water nectar for feeding hummingbirds, orioles or butterflies, said device comprising:

In re Klein

In re Klein pertained to a bird feeder having a claim fairly narrow in terms of both the claim elements and in reciting a purpose of the invention, the preamble reciting a "convenience nectar mixing device for use in preparation of sugar-water nectar for feeding hummingbirds, orioles or butterflies."

In rejecting the claims three of the references were directed toward containers with movable dividers used to separate solid items such as screws or bolts.



In re Klein

In rejecting the claims three of the references were directed toward containers with movable dividers used to separate solid items such as screws or bolts. In determining that those references were non-analogous, the court first considered the problem being solved by Klein and arrived upon a somewhat narrowly defined single problem of: *"making a nectar feeder with a movable divider to prepare different ratios of sugar and water for different animals."*

The court then quickly concluded that the three solid item separators were not pertinent to Klein's problem *"since none of these three references shows a partitioned container that is adapted to receive water or contain it long enough to be able to prepare different ratios in the different compartments."*

Transitional Language

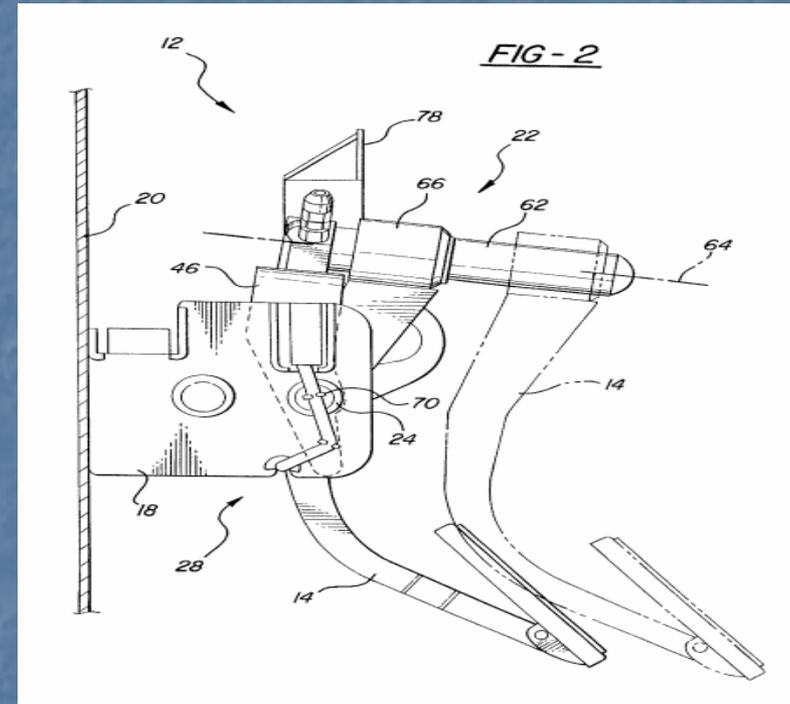
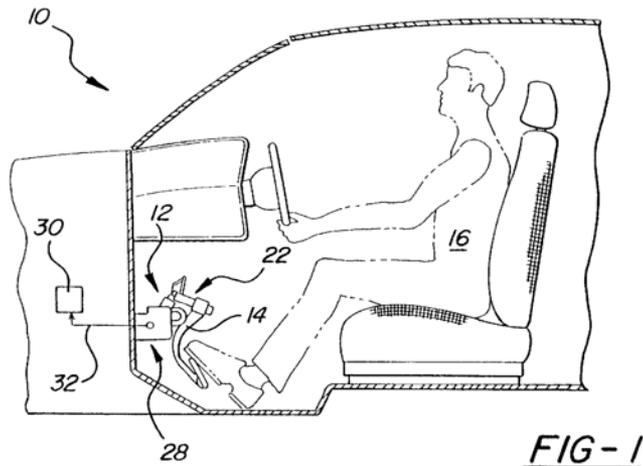
- Open or closed
- “Comprising” - can have extra elements
- “Consisting” - no extra elements
- “Consisting essentially of” - no extra elements of consequence

Body of Claim

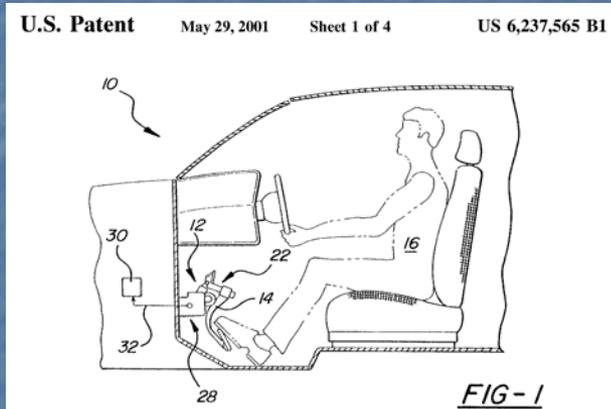
- Sets forth the elements
- Shows how the elements co-operate
- Particularly point out and distinctly claim the subject matter

Apparatus Claim

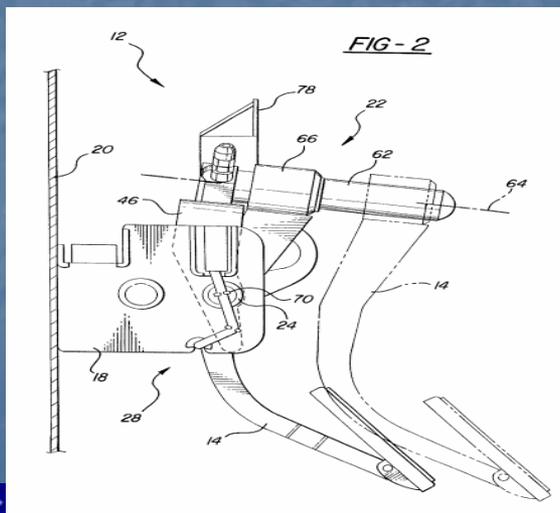
U.S. Patent May 29, 2001 Sheet 1 of 4 US 6,237,565 B1



List Elements



- Support (18)
- Pedal assembly (22)
- Guide member (62)
- Pedal arm (14)
- Electronic control (28)
- Pivot axis (26)
- Signal (32)



Write the Claim

1. An adjustable pedal assembly for a vehicle comprising:

a support (18) for mounting to a vehicle structure;

an adjustable pedal assembly (22) having a guide member (62) rotatably supported by said support (18) for pivotal movement about a pivot axis (26); and

a pedal arm (14) supported on said guide member (62) for rectilinear movement in fore and aft directions relative to said support (18), said guide member (62) and said pivot axis (26) between various adjusted positions;

an electronic control (28) supported on said support (18) and responsive to pivotal movement of said pedal arm (14) and said guide member (62) about said pivot axis (26),

said electronic control (28) being fixed relative to said support (18) such that said pedal arm (14) moves in fore and aft directions with respect to said electronic control (28), said electronic control (28) being responsive to pivotal movement of said guide member (62) about said pivot axis (26) for providing a signal (32) that corresponds to pedal arm (14) position as said pedal arm (14) pivots said guide member (62) about said pivot axis (26).

Method Claim

- Positive steps starting with a gerund "ing" verb: "cooling," "filtering," "impregnating," "coating," "heating," "separating," "removing" and "crystallizing"

1. A process for preparing alcohol-containing powders with a high alcohol content in a high yield, which comprises

mixing a hydrolyzed starch which comprises at least 50% of saccharides having a glucose polymerization degree of 1 to 8 and comprises up to 10% of saccharides having a glucose polymerization degree of 1 to 2, said hydrolyzed starch being soluble in 40 W/W % aqueous solution of an alcohol, with an alcohol-containing aqueous solution having an alcohol concentration of at least 40 W/W %, said starch being present in an amount of 100 to 200% based on the water contained in the alcohol-containing aqueous solution, and spray-drying the resulting liquid mixture.

Method Claim: "Ice Beer"

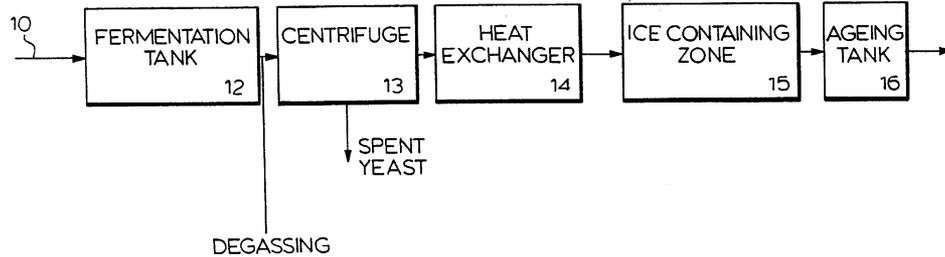


FIG. 1

Mash with water

Heat and separate wort

Ferment

Cool to freezing point

Mix with ice crystals

Extract treated beer

No water content decrease

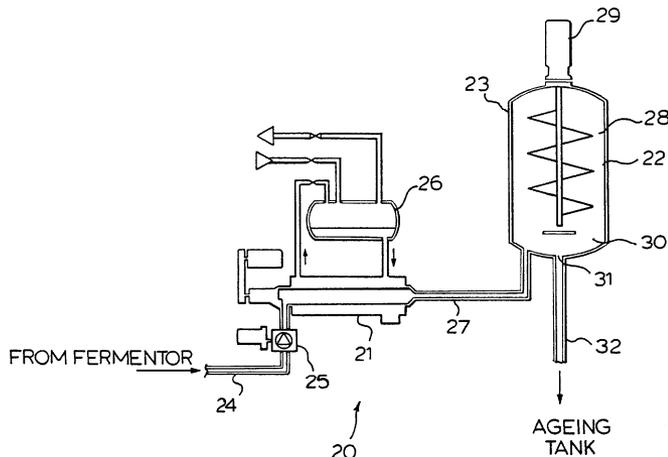


FIG. 2

Method Claim: "Ice Beer"

2. A process for preparing a malt brewery beverage comprising:

mashing brewing materials with water;

heating the resulting mash and separating wort therefrom;

boiling, cooling and fermenting said wort;

subjecting the resulting beer to a cold stage comprising rapidly cooling said beer to a temperature at about its freezing point to form mostly, only nascent ice crystals in minimal amounts thereof;

mixing the resulting cooled beer for a short period of time in a post-cold-stage resident volume of stable ice-crystals dispersed as a slurry without any increase in total ice crystal volume of the resulting mixture; and

extracting the so treated beer from said mixture;

whereby said process is carried out without any substantial collateral decrease in the total amount of water that is contained in the beer.

Omnibus Claims

- “The invention as shown and described”
- Not allowed with two exceptions: design patents and plant patents

Design Patent Claim

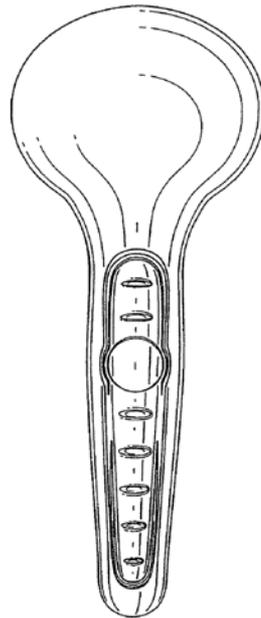


FIG. 2

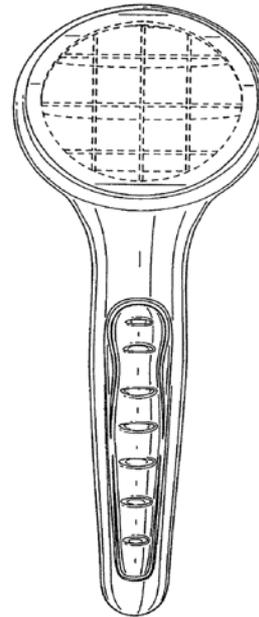


FIG. 3

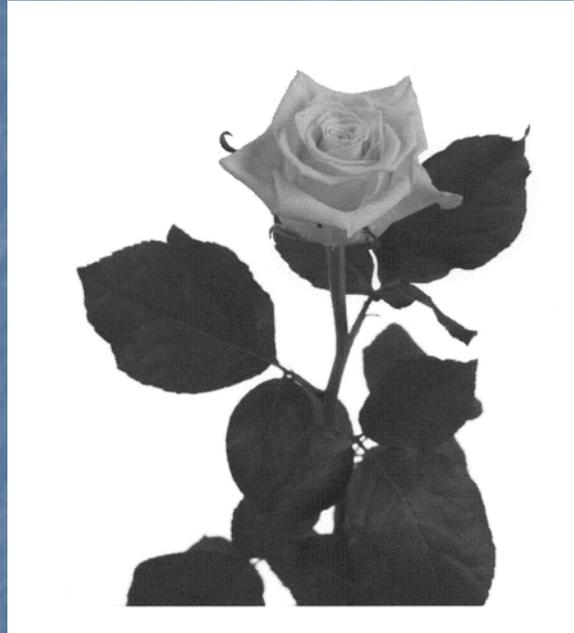
(57)

CLAIM

The ornamental designs for grooming tool, as shown and described.

USD 615,714

Plant Patent Claim



It is claimed:

1. A new and distinct Rose plant named 'Emparaimp' as illustrated and described.

USPP 20,985

Product-by-Process Claims

- Is a product claim, the process steps have no patentable weight.
- But the process steps can limit the claim during litigation.

Other Types of Claims

- Jepsen claim – separates what is old from what is new
- “Use” claim – not statutory

Claim Phraseology

- Antecedent basis – first time by “a” or “an”, later times by “the” or “said”
- Alternative Claiming – use “or” or a Markush phrase: “selected from the group consisting of A, B and C.”
- You can have genus and species in alternative claiming, for example: “selected from the group consisting of amino, halogen, nitro, chloro and alkyl” would be acceptable even though “halogen” is generic to “chloro.” MPEP 2173.05(h).
- No “preferred” – use alternative claiming
- “Optionally” must be analyzed for ambiguity.

Claim Phraseology

- Negative limitation – must have basis in original disclosure. However, if alternative elements are positively recited in the specification, they may be explicitly excluded in the claims. See *In re Johnson*, 558 F.2d 1008, 1019, 194 USPQ 187, 196 (CCPA 1977)
- Relative Terminology – requires analysis – e.g., indefinite: “said front and rear wheels so spaced as to give a wheelbase that is between 58 percent and 75 percent of the height of the rider that the bicycle was designed for” was indefinite because the relationship of parts was not based on any known standard for sizing a bicycle to a rider, but on a rider of unspecified build. But definite: wheelchair dimensions set forth in terms of car doorframe and seats.

Ex parte Brummer, 12 USPQ2d 1653 (Bd. Pat. App. & Inter. 1989) , see *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1 USPQ2d 1081 (Fed. Cir. 1986).

Claim Phraseology – Terms That May Cause Trouble

- “About” – should be in specification
- “Essentially”
- “Similar”
- “Substantially”
- “Type”
- “relatively”
- “of the order of”
- “comparable”
- “superior”
- “aesthetically pleasing”

Claim Phraseology – Limiting and Functional Language

- “adapted to”
- “configured to” e.g. “an impeller configured to emulsify a resin”
- “wherein”
- “whereby”

Wider and Narrower Limitations

- “Preferable” limitations not allowed
“10 to 30 wt.% polyester, *preferably* 20 to 25% polyester” not allowed.

Put narrower range in a separate claim or use alternative phrasing: “10 to 30 wt.% polyester, *or* 20 to 25% polyester”

Means Plus Function

- Evokes 35 USC §112, 6th Paragraph: *"An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof."*
- Format: "means for _____" e.g., , "means for attaching" is correct, but "attachment means" may raise an objection or refusal to acknowledge the evocation of 35 U.S.C. 112, sixth paragraph.
- The specification must set forth an adequate disclosure showing what is meant by that language.

Means Plus Function – 3 Prong Analysis

- As is set forth in MPEP 2181, a claim limitation will be presumed to invoke 35 U.S.C. 112, sixth paragraph, if it meets the following 3-prong analysis:

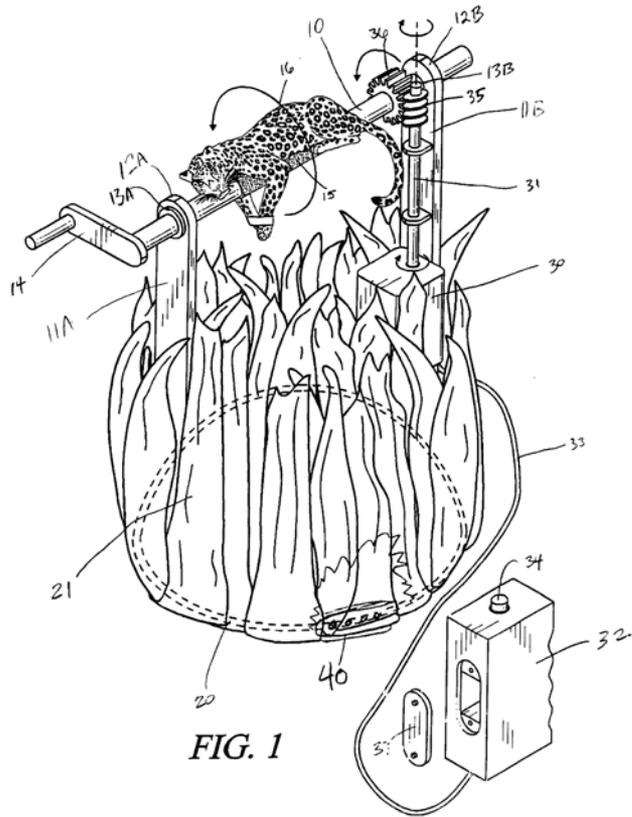
(A) the claim limitations must use the phrase "means for" or "step for;"

(B) the "means for" or "step for" must be modified by functional language; and

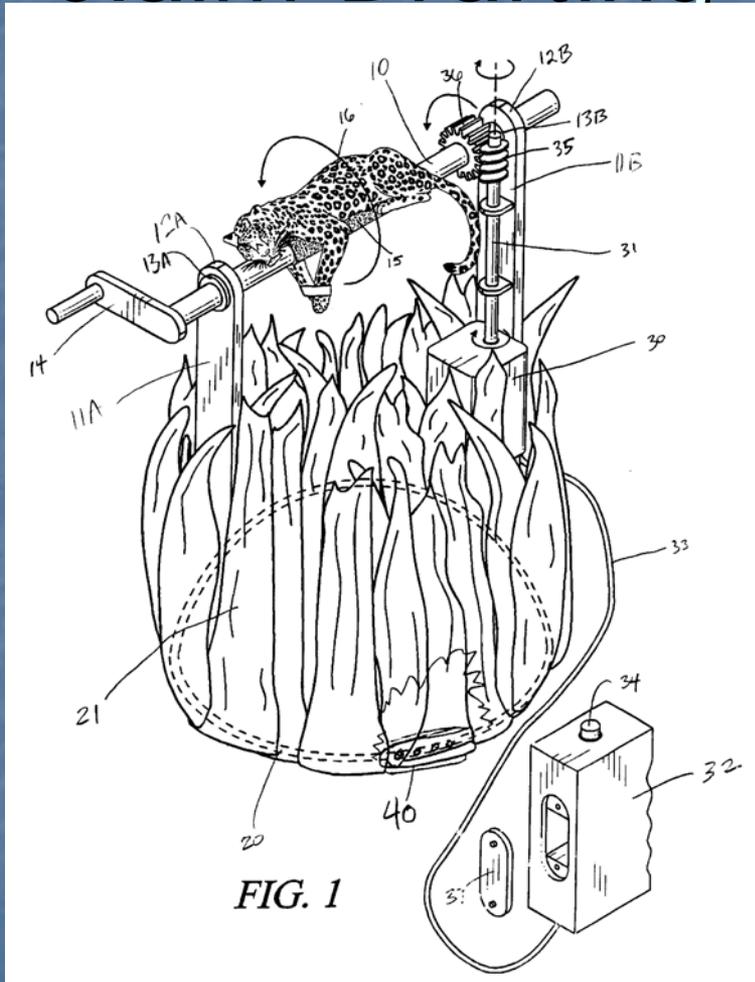
(C) the phrase "means for" or "step for" must not be modified by sufficient structure, material, or acts for achieving the specified function.

Claim Drafting – Picture to Claim

■ USP 6,438,760

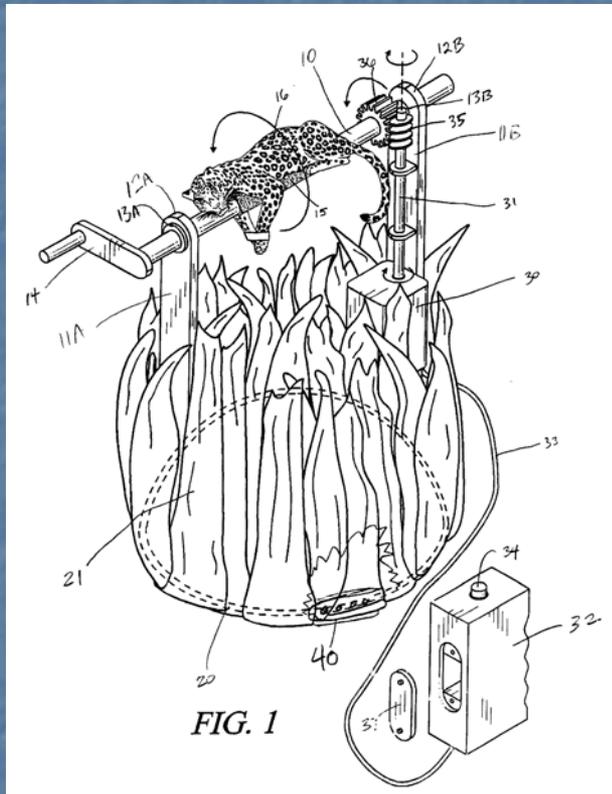


Claim Drafting – Picture to Claim



- a hat
- a spit
- frame supporting the spit
- a headpiece with simulated fire
- a power drive

Claim Drafting – Picture to Claim

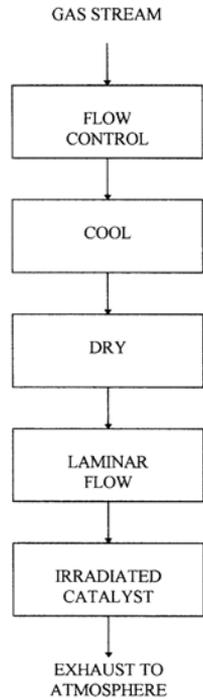


1. A novelty hat apparatus to be worn by a wearer for simulating the spit-roasting of an object, comprising:
 - a spit for holding the object to be roasted;
 - a headpiece for supporting the apparatus on the head of the wearer, the headpiece having at least one simulated fire member attached to the headpiece and extending from the headpiece upward toward the spit; and
 - a frame supporting the spit from the headpiece.
2. The apparatus of claim 1, further comprising a powered drive system for rotating the spit.

Claim Drafting – From Flow

Diagram

Figure 1.



A method for eliminating volatile organic carbons from a gas stream, which comprises:

inducing laminar flow in the gas stream, wherein inducing the laminar flow is accomplished in a plenum packed with a plurality of tubes;

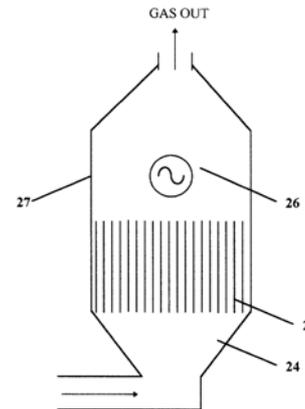
drying the gas stream;

contacting the gas stream with a catalyst; and

irradiating the catalyst with a source of light.

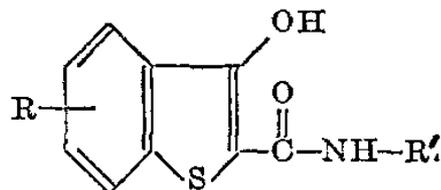
USP 5,866,752

Figure 6.



Claim Drafting – Chemical Formula

1. A benzo(b)thiophene - 2 - carboxanilide compound corresponding to the formula



wherein R represents a member of the group consisting of hydrogen and chlorine, and R' represents a member of the group consisting of chlorophenyl, dichlorophenyl, trichlorophenyl and chloronitrophenyl.

USP 3,413,208

Claim Drafting - Biotechnology

- Biomarkers that serve to identify algae species and strains of algae species as well as detect the presence of algal toxins. Additional embodiments feature methods utilizing algal biomarkers and polypeptides that can serve as biomarkers.
- Disclosure includes SEQ ID NO: 1 and SEQ ID NO: 2
 1. An isolated nucleic acid encoding an isolated polypeptide comprising SEQ ID NO: 1.
 2. The isolated nucleic acid of claim 1, wherein said nucleic acid comprises SEQ ID NO: 2. USP 7,714,117

Thank You