

# Topic 5: Claim Format and Independent Claims

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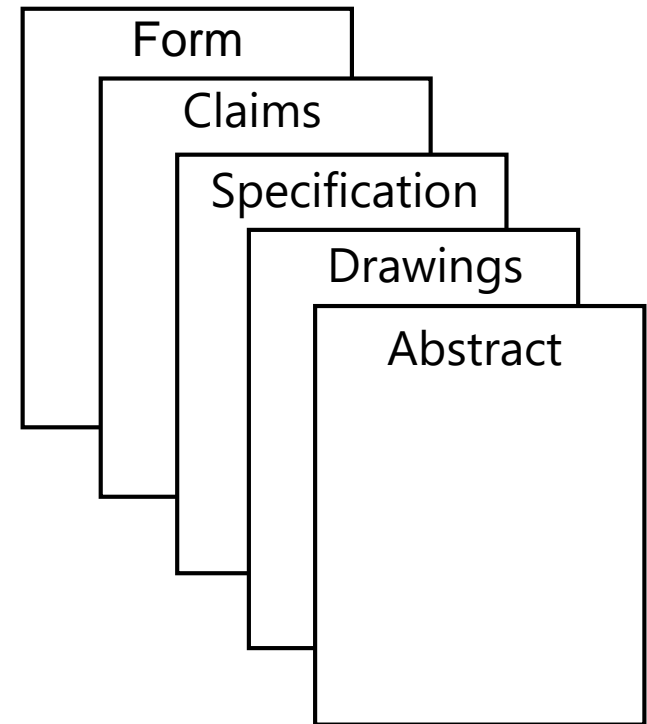
September 2, 2019

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# Typical Parts of a Patent Application

A patent application includes:

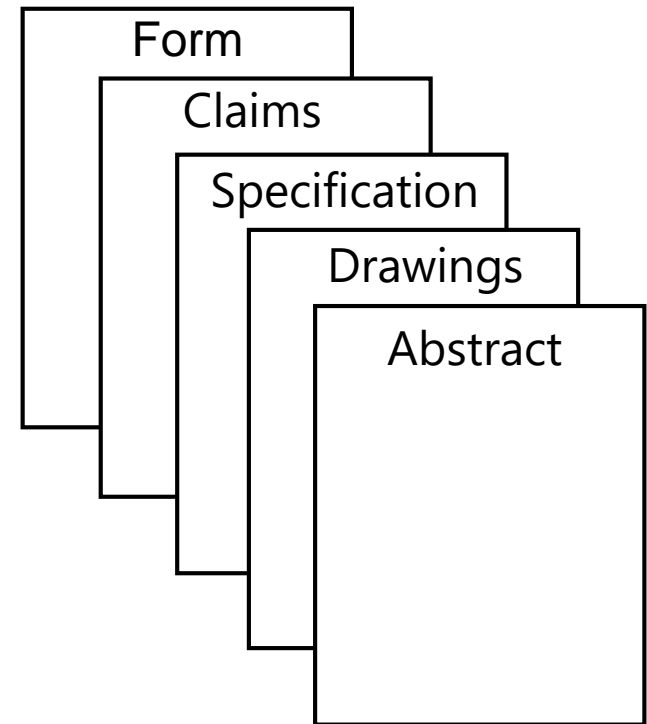
- ✓ Form
  - Applicant
  - Inventor
- ✓ Claims
- ✓ Specification (Description)
- ✓ Drawings (if any)
- ✓ Abstract



# Typical Parts of a Patent Application

A patent application includes:

- ✓ Form
  - Applicant
  - Inventor
- ✓ Claims
- ✓ Specification (Description)
- ✓ Drawings (if any)
- ✓ Abstract



# Claims

- ✓ Claims define the scope of the invention
- ✓ The claim or claims shall define the matter for which protection is sought. (PCT Article 6)
- ✓ The **most important part** of the patent application
  - In prosecution (examination)
  - In litigation (infringement)

# Claim Format

- ✓ Single sentence with punctuation

Claim Parts:

Preamble, Transitional Phrase: Body

# Preamble, Transitional Phrase: Body

A writing device comprising:

a pencil;  
an eraser attached to one end of the pencil; and  
a light attached to a middle part of the pencil.

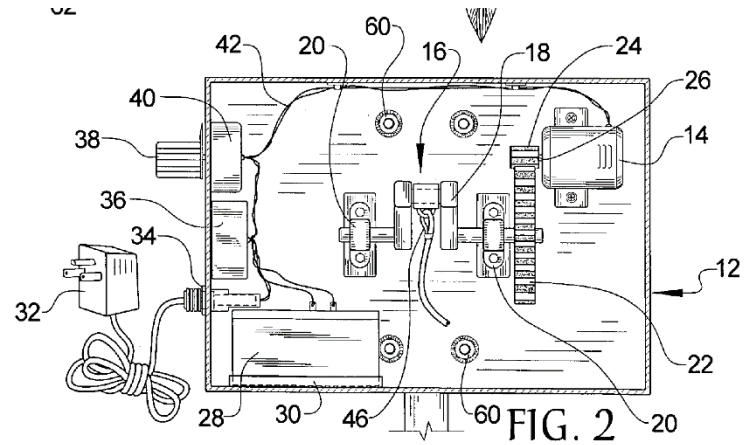
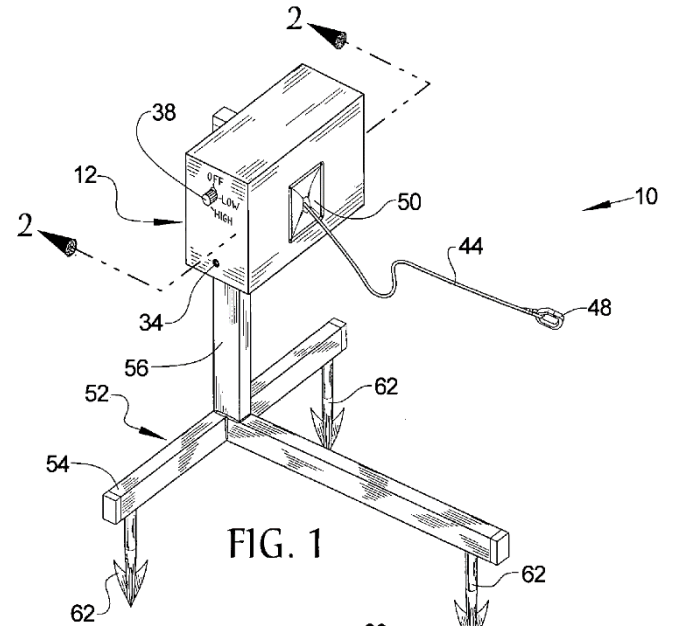
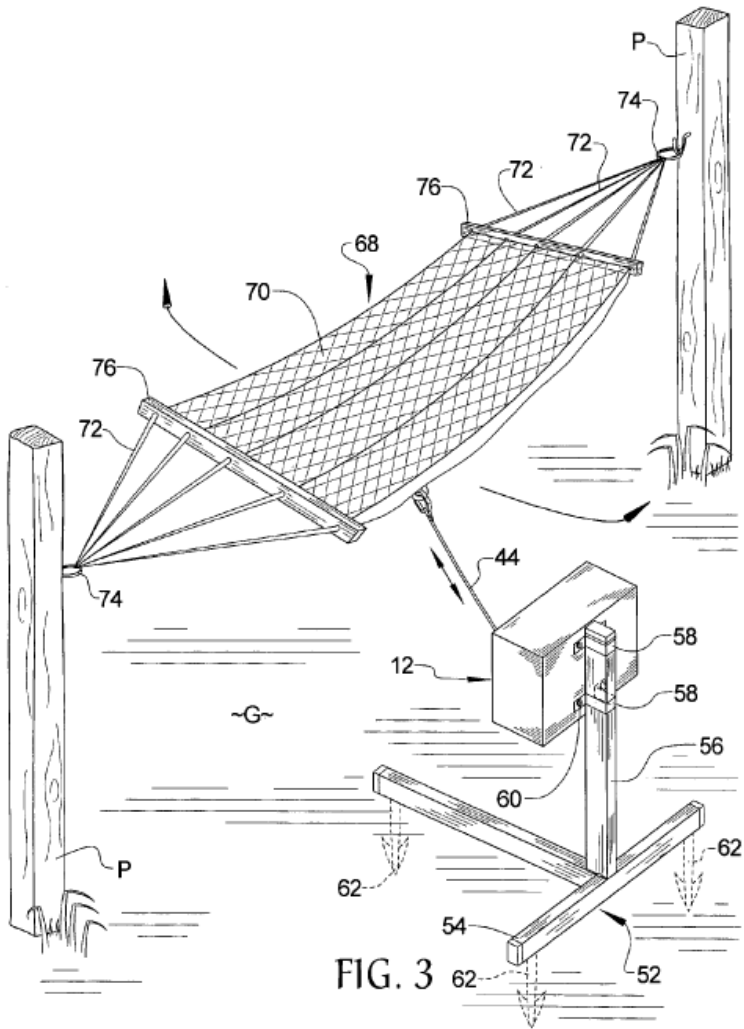
- ✓ Punctuation
- ✓ Antecedent Basis
- ✓ Specify elements one by one
- ✓ Wherein
- ✓ Characterized in that  
(two-part form)



# Preamble, Transitional Phrase: Body

A swinging assembly comprising:

- a housing;
- a motor disposed within the housing;
- a source of electrical power for powering the motor;
- a crankshaft disposed within the housing and operationally connected with the motor such that motor operation causes crankshaft rotation;
- a cable having a first end attached to the crankshaft and a second end adapted to be secured to a hammock, the cable protruding through an opening on the housing;
- a flap covering the opening on the housing, the cable passing through the flap; and
- wherein motor operation causes the crankshaft to rotate, which causes the cable to be reciprocated back and forth imparting a swaying motion on the hammock.





# What is a preamble?

- ✓ Defines a category for the invention
  - Example: An **electronic device** ...
- ✓ Identifies the type of invention
  - Example: A **method** for assembling ...
- ✓ Usually consistent with the title of invention

# What is a preamble?

## Examples:

- ✓ A golf club head for a metal wood type club, the club head comprising:
- ✓ A training device for training the techniques of forcible entry through a locked door using forcible entry tools, comprising:
- ✓ A system for analyzing gait using textile sensors, comprising:
- ✓ A pharmaceutical composition comprising:
- ✓ A method of controlling the movement of a device attached to a limb of a patient, the method comprising:
- ✓ A method for manufacturing a magnetic transducer comprising:

# What is a transitional phrase?

- ✓ Open-ended (almost all the cases)
  - Ex. comprising
- ✓ Closed-ended (very rare)
  - Ex. consisting of
- A device **comprising**: A; B; and C.
  - This claim covers the device with an element other than A, B, and C
- A device **consisting of**: A; B; and C.
  - This claim does **NOT** cover the device with an element other than A, B, and C
    - Ex. A device with A, B, C, and D

# Body: Specify elements one by one

A swinging assembly comprising:

a housing;  
a motor disposed within the housing;  
a source of electrical power for powering the motor;  
a crankshaft disposed within the housing and ... ;  
a cable having a first end attached to the ... ;  
... (omitted) ...

✓ How to choose elements?

- List the elements necessary to solve the problem
- Select the elements on the same level

# Body: How about this claim?

A swinging assembly comprising:

a motor disposed within a housing;  
a source of electrical power for powering the motor;  
...(omitted)...

- ✓ Unclear whether the assembly includes the housing

# Body: How to name each element?

- ✓ **Generalize** and **simplify** as much as possible, but
- ✓ **Specify** to an adequate extent
  - Motor → Actuator → Means for moving ...
  - Battery → Power Source → Means for powering ...
  - "A mechanical moving and controlling device"  
can be simplified to "actuator"
- ✓ How to generalize "Pencil", "Spring", "Keyboard" ?

# Body: Explain how elements are related

A swinging assembly comprising:

a housing;

a motor disposed within the housing;

a source of electrical power for powering the motor;

a crankshaft disposed within the housing and operationally connected with the motor such that motor operation causes crankshaft rotation;

a cable having a first end attached to the crankshaft and a second end adapted to be secured to **a hammock**, the cable protruding through an opening on the housing; ...(omitted)...

# Body: Ways of specifying the number of elements

- ✓ A device comprising **a** motor
- This claim covers both devices having **one** motor and having **two or more** motors
  - ✓ A device comprising **two** motors
  - ✓ A device comprising **at least one** motor
  - ✓ A device comprising **a plurality of** motors
  - ✓ A device comprising **at least two** motors
  - ✓ A device comprising a **first** electrode and a **second** electrode
  - ✓ A device comprising **a pair of** electrodes



# "Wherein" Clause

A swinging assembly comprising:

a housing;

a motor disposed within the housing;

...(omitted)...

a flap covering the opening on the housing, the cable passing through the flap; and

**wherein** motor operation causes the crankshaft to rotate, which causes the cable to be reciprocated back and forth imparting a swaying motion on the hammock.

- ✓ Usually used to describe function, operation, or result that flows from previous structure

# Two-part Form (Europe)



- ✓ A writing device comprising:
  - a pencil;
  - an eraser attached to one end of the pencil; and
  - a light attached to a middle part of the pencil.

**Prior Art**

**Novel Features**

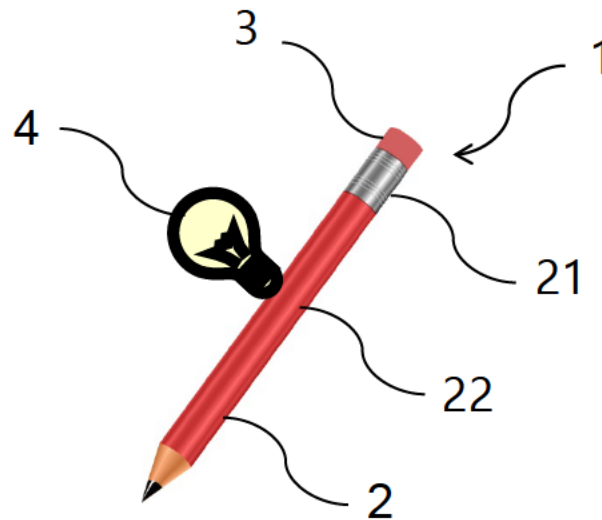
- ✓ A writing device comprising:

a pencil; and  
an eraser attached to one end of the pencil;

**characterized in that** the writing device further comprising a light attached to a middle part of the pencil.

# Reference Numerals (Europe)

- ✓ A writing device (1) comprising:
  - a pencil (2); and
  - an eraser (3) attached to one end (21) of the pencil (2);characterized in that the writing device (1) further comprising a light (4) attached to a middle part (22) of the pencil (2).



Thank you for your kind attention!

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