

TOPIC 6



Dependent claims

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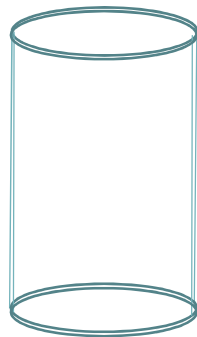
WHAT ARE DEPENDENT CLAIMS GOOD FOR?

- If all goes well, nothing.
- If not, then as a fall-back position.

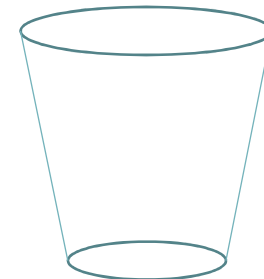
YOUR INDEPENDENT CLAIM SHOULD BE NOVEL OVER THE PRIOR ART ON FILE

But: During the prosecution of the application, the Examiner will most likely come up with new prior art which is unknown at the time of filing.

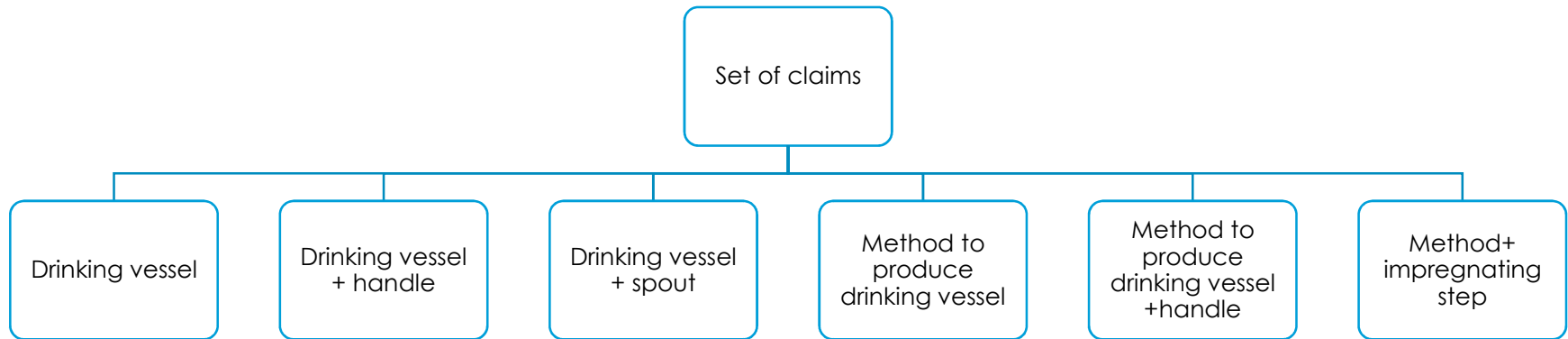
Claim 1:
drinking vessel



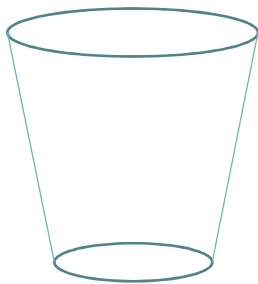
Examiner
Cites:



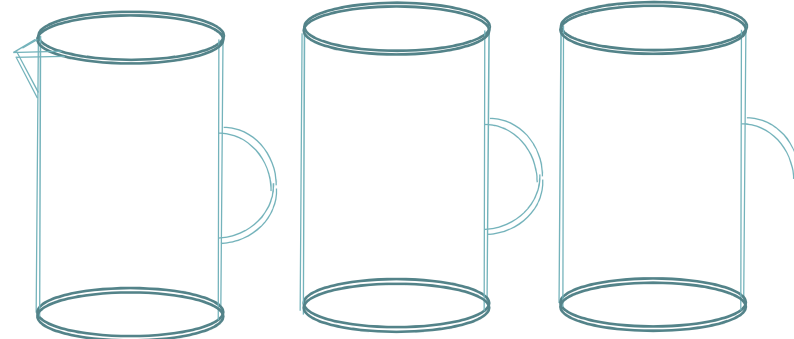
EXAMPLE



Examiner:



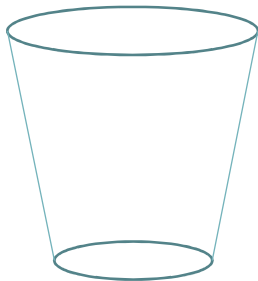
Invention:



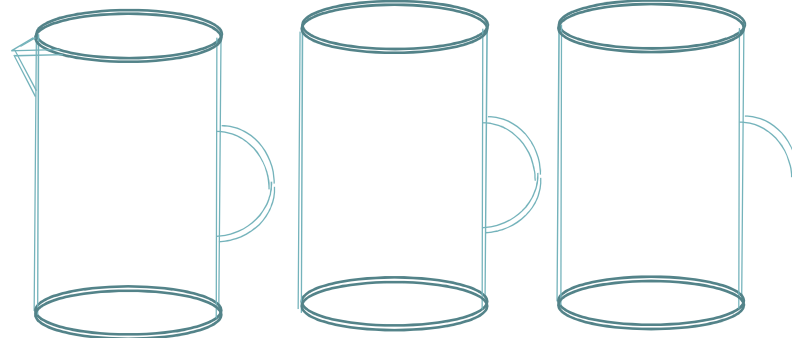
DEPENDENT CLAIMS = FALLBACK-POSITION

- In case the independent claims are considered not novel or not inventive
- For example, new claim 1: Drinking vessel+handle

Examiner:



Invention:



FALLBACK-POSITIONS:

- Claim the specific advantages explained by the inventor in dependent claims, in particular if considered important by the inventor.
 - Look for keywords in the invention disclosure etc.
- Good fallback solution: solves a problem or has an unexpected advantage or effect.
- Do not try to follow the embodiments given by the inventor one-by-one
 - Many features can be used in various embodiments.
- Develop a logical structure wherein the scope of protection becomes gradually smaller.
- Use consistent terminology: drinking vessel vs. drinking cup.

FALLBACK-POSITIONS:

- Wherever possible, claim only one single aspect in a dependent claim. Alternatively, link the features with an “or” not “and” wherever possible.
- When claiming ranges, be concise and narrow the ranges gradually down:
 - The method according to any of the preceding claims, wherein the steel was heated between 500°C to 800°C (preferably between 550°C to 750°C)...
- Mind the antecedent basis for features in the claims.
 - “a” vs. “the”
- If jurisdiction admits, use multiple dependencies.

MULTIPLE DEPENDENCIES:

- A data generating device comprising:..
- The training data generating device according to claim 1, wherein the ...
- The data generating device according to claim 1 or claim 2, further comprising: storage means ...
- The data generating device according to claim 3, wherein the storage means stores...
- The data generating device according to claim 3 or claim 4, wherein the storage means further stores...
- The data generating device according to any one of claim 1 to claim 5, further comprising: image synthesis means...

BUT WHY NOT JUST TAKING FEATURES FROM THE DESCRIPTION INTO THE CLAIMS?

- Claims get examined – indication of patentability of dependent feature.
- Easier to satisfy “fair basis” requirements.
- EP-Perspective:
 - Features may only be disclosed in a certain embodiment where the features are inextricably linked to each other.
 - Taking such a linked feature from the description and incorporating it into the claim may result into added-matter. Not admissible!
 - Taking features from dependent claims may avoid such a situation.

BUT WHY NOT JUST TAKING FEATURES FROM THE DESCRIPTION INTO THE CLAIMS? EXAMPLE:

Embodiments disclosed in description:

- Drinking vessel + crescent-shaped handle + protruding spout
- Cup + round opening
- Cup consisting of glass + handle consisting of metal

Intermediate generalization may be:

- drinking vessel + handle

ANOTHER EXAMPLE

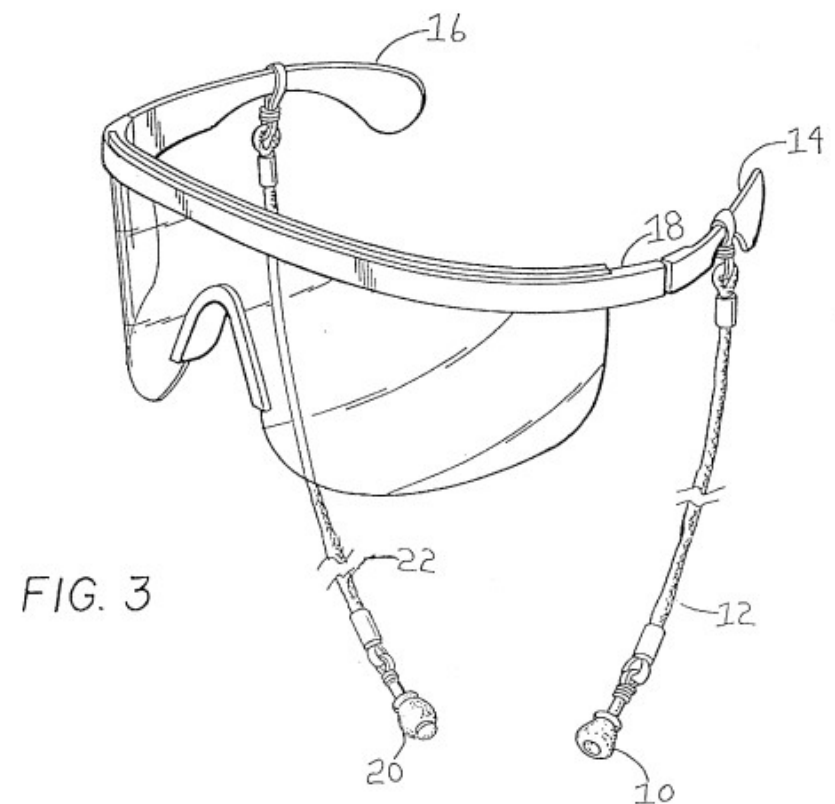
1. **A pair of ear plugs** comprising a first ear plug having a body that has a first end and a second end, said body adapted to be placed into a first ear and a second ear plug having a body that has a first end and a second end adapted to be placed in the other ear, each of said ear plug body **having complementary releasably mating connection means at the first end** which facilitates the connecting and disconnecting of said bodies and a second connection means at the second end which is adapted to be connected to safety glasses.

U.S. Patent

Sep. 15, 1998

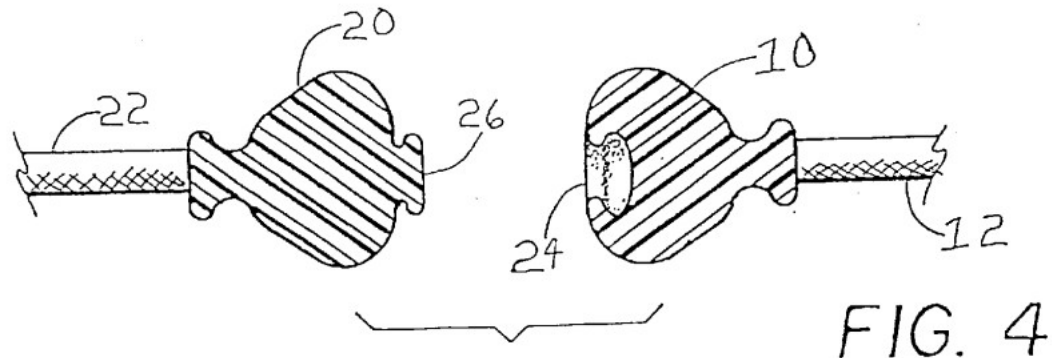
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ANOTHER EXAMPLE (CONTINUED)

2. The ear plugs of claim 1, wherein one of said ear plug bodies has means defining a hole and the other of said ear plug bodies has a protrusion, and mating is accomplished by fitting said protrusion into said hole.



FURTHER EXAMPLE

1. A cup comprising a handle.
2. The cup as claimed in claim 1, which is of clay.
3. The cup as claimed in any one of claims 1-2, which is red.
4. The cup as claimed in any one of claims 1-3, which has only a single handle.



Q&A?



Thank you for your attention!

James Davies