

VIII. Claim Drafting Methodologies

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Claims

A series of numbered statements
in a patent specification, usually following the
description, that

define the invention

and

establish the scope of the monopoly conferred by
the patent.

Each claim consists of **one sentence** starting with a
capital letter and ending with a full stop.

Independent Claims

- At least one such statement (usually the first) will be self contained - this is known as an **independent claim**.
- The first independent claim may be called the main claim because it is the broadest claim in the set of claims

Dependent Claims

Claims that refer to previous claims
using wording such as

”... as claimed in (or as defined by, or according to)
claim 1 or claim 2...”

- these are known as **dependent claims**.

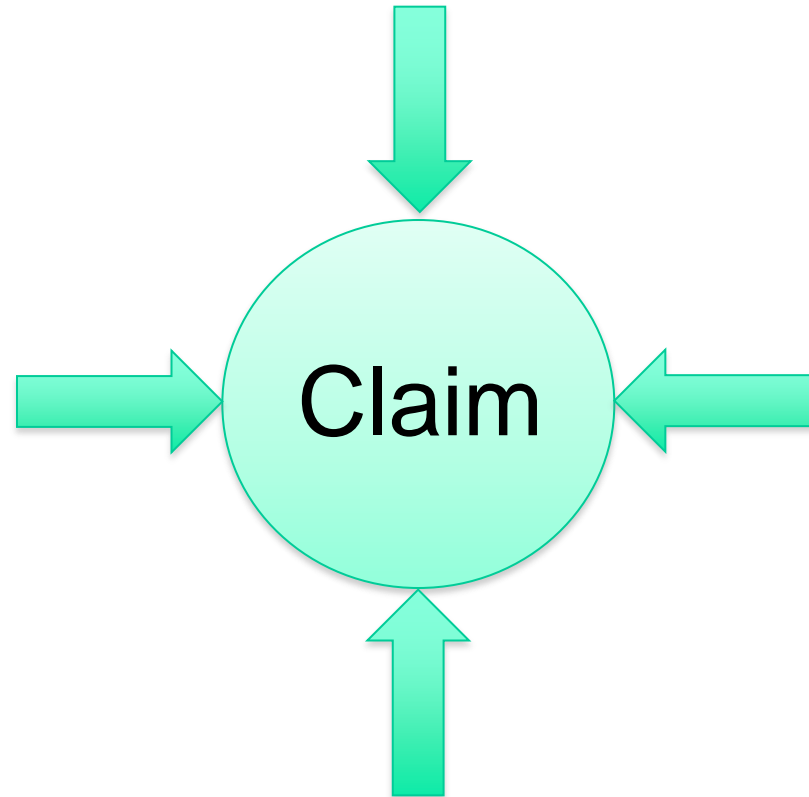
Claim Parts

Preamble, Transitional Phrase: Body.

What you need to understand to draft a claim

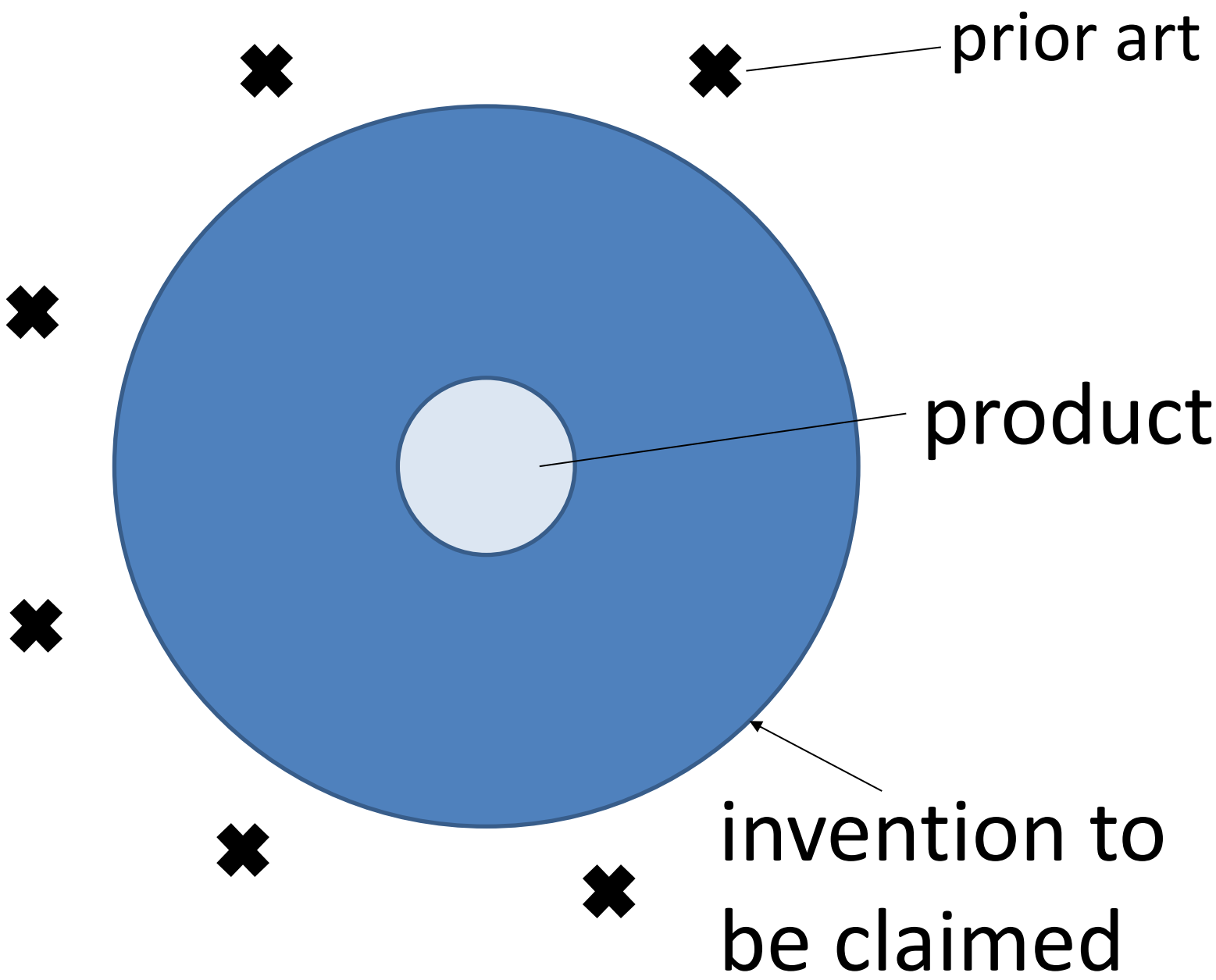
Take into account legal and linguistic rules

New and not
obvious in
view prior art



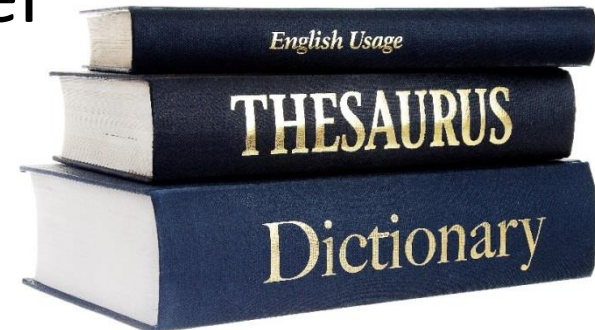
Has value for
client's business

Needs to cover all embodiments / inventive concept



Terminology

- Use words you understand and words your audience will understand too.
- Use a dictionary:
 - Check you understand the word you are using
 - It may trigger your mind to think about other words that may be better



Terminology

Body parts can be useful terminology:

Neck

Shoulder

Arm

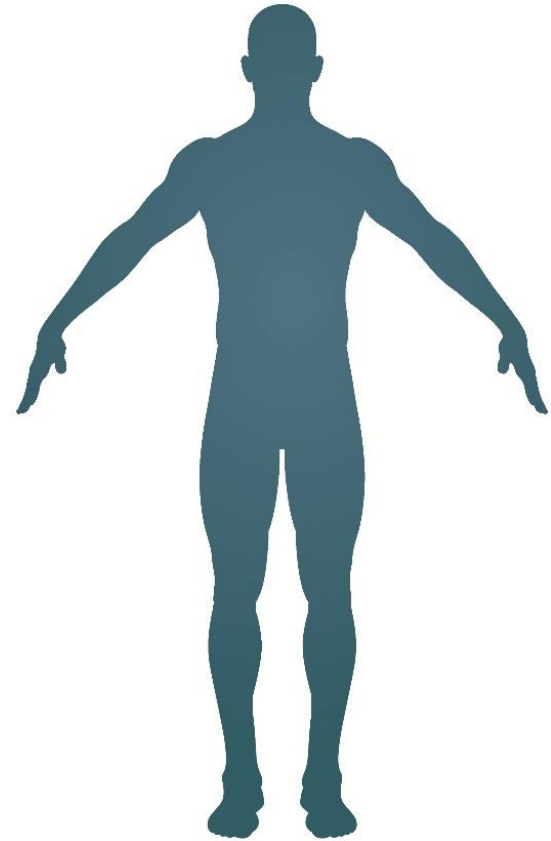
Elbow

Finger

Foot

Ear

Eye



Start with claim 1

- Draft the claims first because it will help you understand the invention better and help you refine the concept of the invention in your mind.
- Once the invention is clear to you, drafting the specification will flow naturally.

How to start with claim 1...

Problem solution approach

Table of features

Start with a picture claim

Problem solution approach

- What is the problem that is being solved by our inventor's idea?
- Which features of the inventor's idea solve that problem?

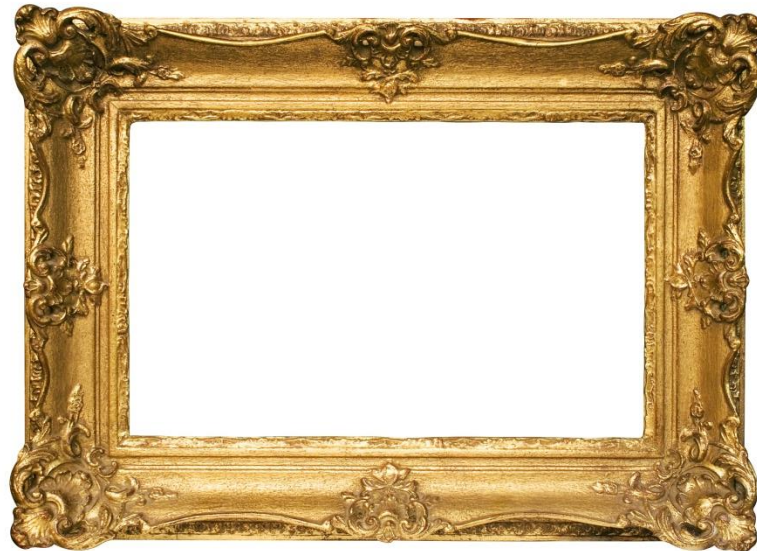


Table of features

Invention	Prior Art 1	Prior Art 2	Prior Art 3

Picture claim

- Write a claim that describes all the features of the embodiment.
- Go through the claim and remove or broaden features that are too narrow.



Claim Parts

Preamble, Transitional Phrase: Body.

Where do you start?

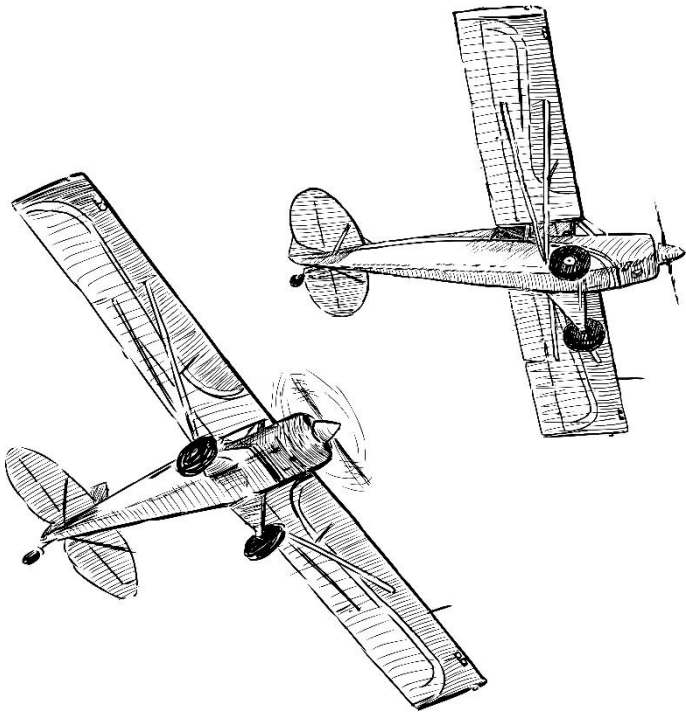
- Most of the time you will start with the beginning of claim 1, e.g.
1. A device for ...
- But sometimes you might want to draft first the characterizing portion (the features that distinguish the invention over the closest prior art, the gist or trick of the invention) and then draft the first part of the claim so that the claim becomes a clear definition of the invention.

Then... draw a sketch of your claim

Read through your claim and draw a sketch of what you have claimed.

What does your sketch look like?

Do you have parts that are floating in space when the relationship to other components is an important feature?



Variations and modifications

- While drafting claims, you should constantly think about variations or different embodiments of the invention.
- Imagine you are a competitor who wishes to get around the claims.
- Think about alternative embodiments that can perform the same function.

Clarity and claim word choice

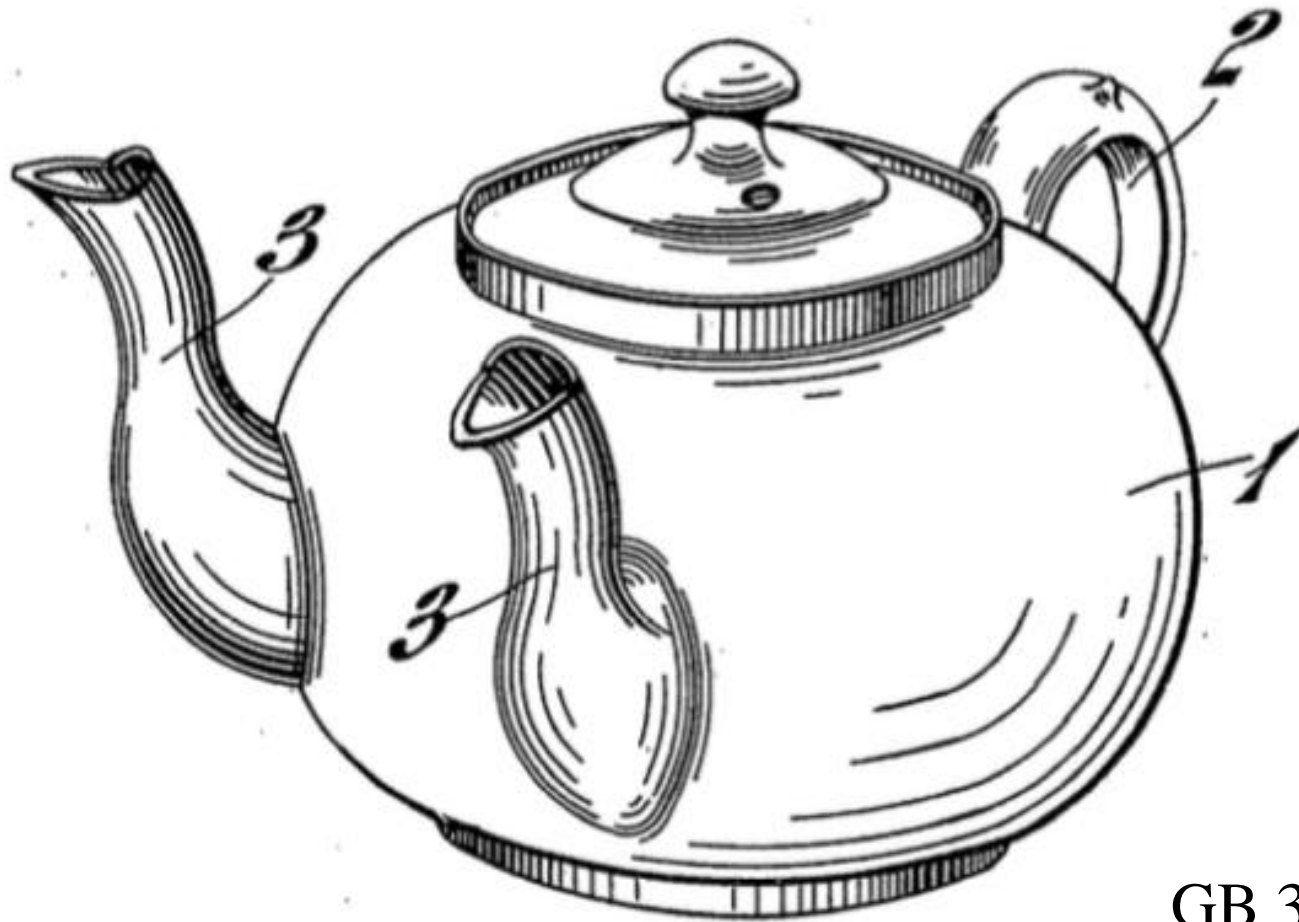
- Be careful using relative words like fast, slow, long, short, tall, wide, perfect because those words may not be clear.
- Relative words may be clear when:
 - they are used with reference to another claim element
 - they are understood in the art.



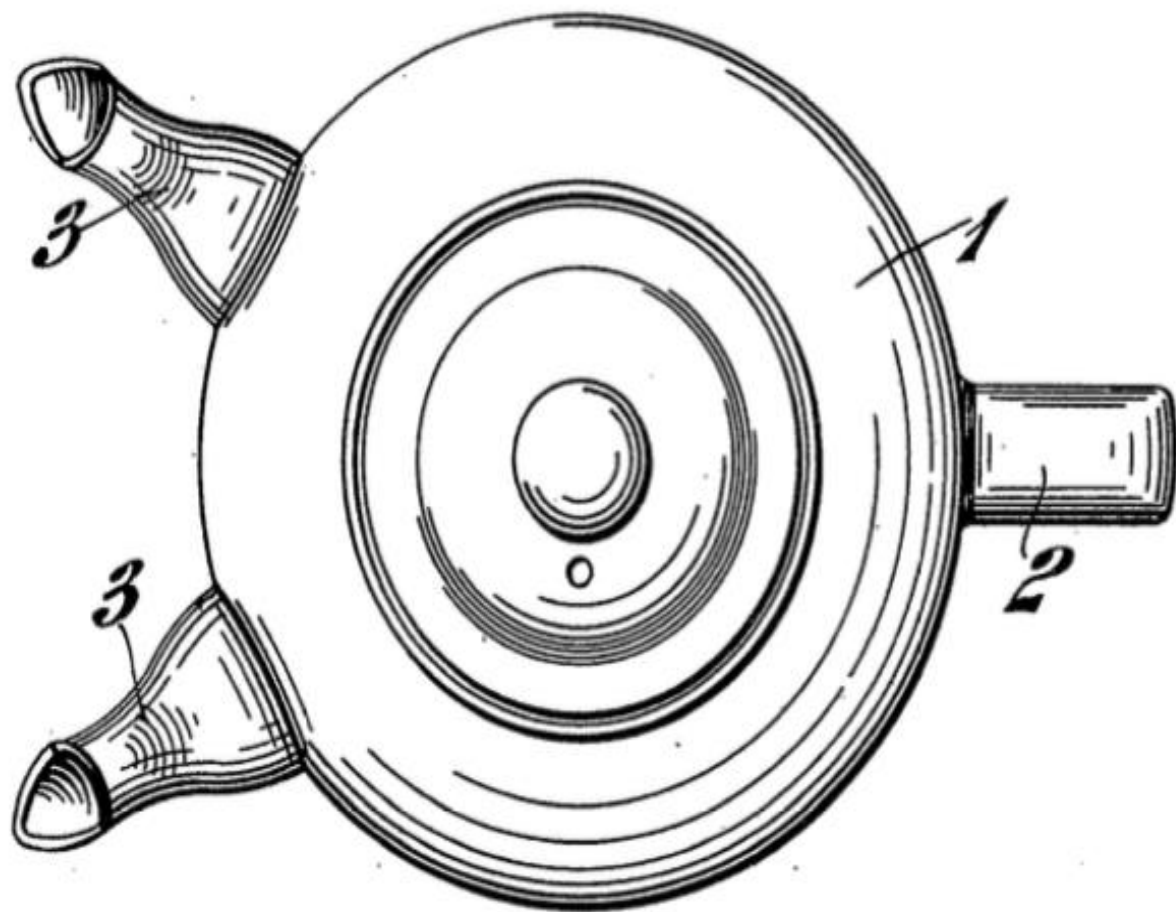
Tea pot example



Inventor says: I have invented a
tea pot with two spouts



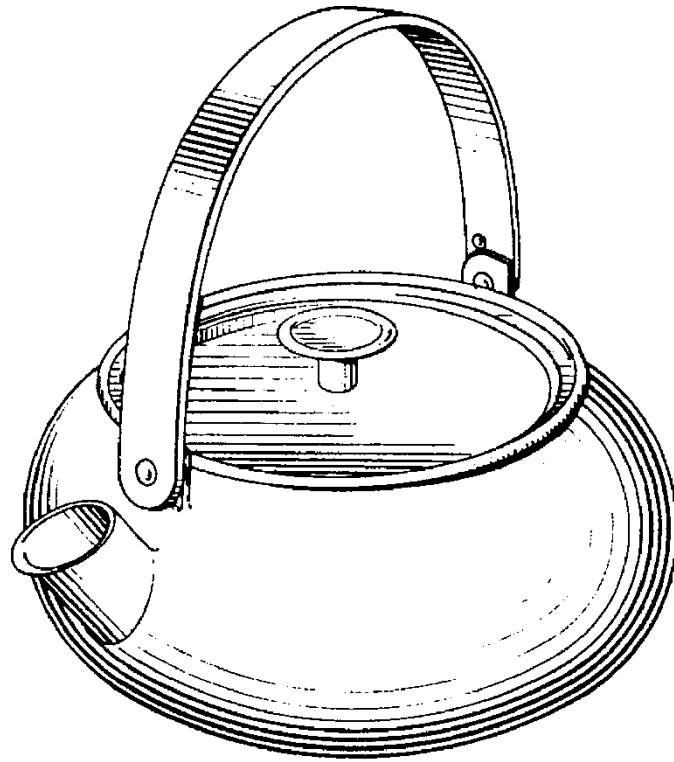
GB 360,253



Questions to the inventor to help ID the invention

What prior art exists?

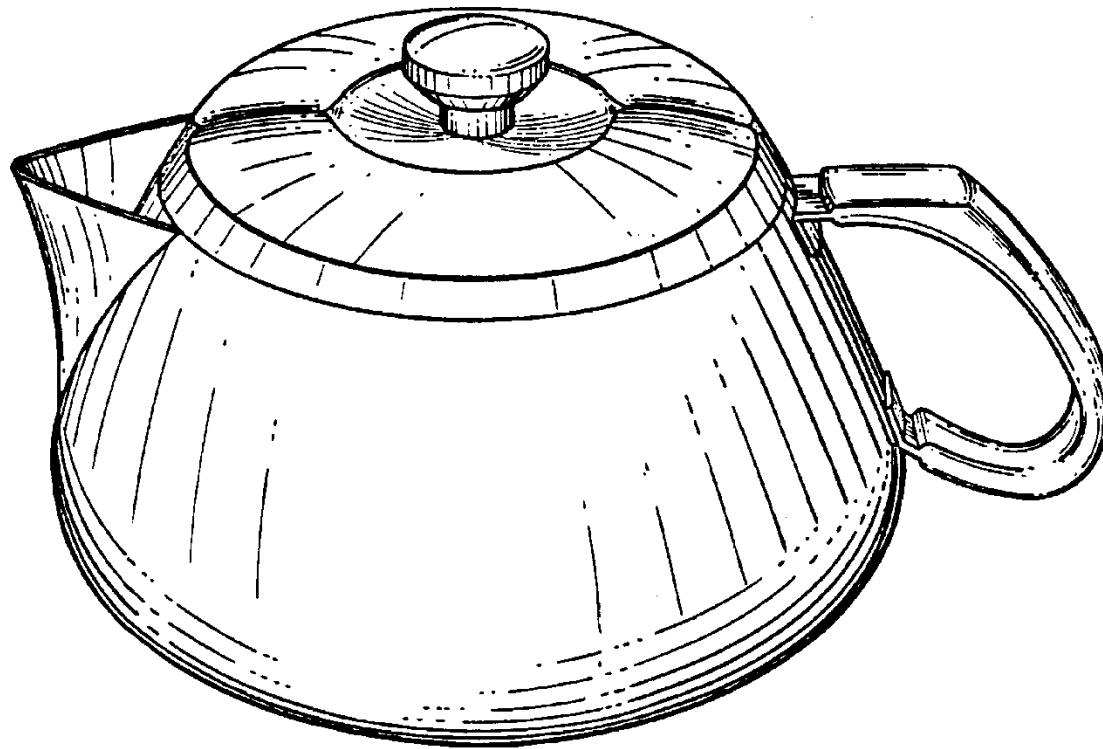
Tea pot 1



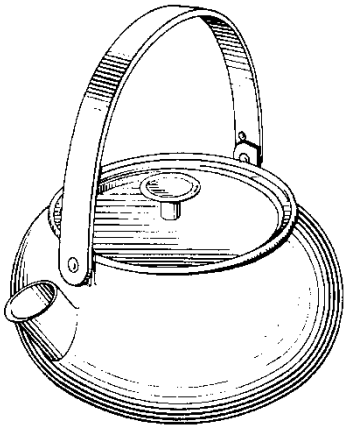
Tea pot 2



Tea pot 3

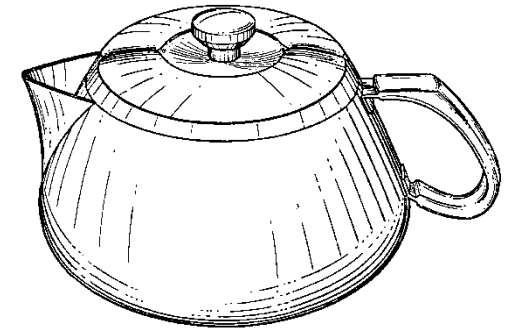


Closest prior art?

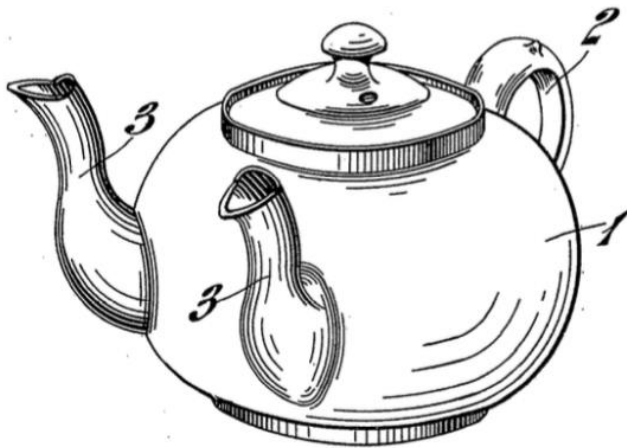


Tea pot 1

Tea pot 2



Tea pot 3



Tea pot of the inventor

Problem solution approach

Table of features

Start with a picture claim

Test the claim

- Does it cover the inventor's product?
- Does it avoid the prior art?
- Does it have any unnecessary limitations?
- Do the elements relate to each other adequately?
- Is the claim clear and concise?

After claim 1...

Finish the claim set and rest of the specification

Remember that the claims must be fully **supported** by the specification

Final Review

- When you have finished your specification (complete description, claims, drawings, abstract) **review it**
 - particularly with reference to the language of the claims (novelty, clarity, unnecessary limitations).
- Are all the features mentioned in the claims also present in the description?

Suggested advice: walk away from it for a while (if you can!!)