

Claim Drafting Tips (cont'd)

Patent Law

September 9, 2013

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Multiple Dependent Claims

- A dependent claim can refer back in the alternative to more than one preceding claim.
- Such a claim must:
 - Follow each of the claims from which it depends
 - Refer in the alternative (disjunctive; “or”) to the claims from which it depends
 - Not depend from any other multiple dependent claim

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Multiple Dependent Claims

- Incorporates by reference all of the limitations of the particular claim in relation to which it is being considered.
- For purposes of fees, counts as the number of dependent claims to which direct reference is made.
- Each claim that depends from a multiple dependent claim counts as the same number of claims as the multiple dependent claim.

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Narrowing By Adding Elements

- Adding elements narrows the claim
 - Broader claim = “genus”
 - Narrower claim = “species”
- Claims with additional elements can be in independent or dependent form

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Dependent Claims

- Use the transitional phrase “further comprising”
- Incorporate by reference all elements and limitations of the claim(s) from which it depends
- Can depend from a dependent claim

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Narrowing By Qualifying Terms

- Use the transitional phrase “wherein”
- Qualifying terms may modify either an element or relationship between elements

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Furniture Example

1. A device for supporting objects, comprising:
 - a horizontal support member; and
 - three vertical support members each having one end connected to the same face of said horizontal support member.

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Furniture Example

2. A device for supporting objects, comprising:
a horizontal support member; and
four vertical support members each having one end connected to the same face of said horizontal support member.

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Furniture Example

3. A device for supporting objects, comprising:
 a horizontal support member; and
 four vertical support members each having one end connected to the same face of said horizontal support member; and
 a vertical planar member connected at one of its ends to an edge of said horizontal support member.

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Furniture Example

- **Dependent form**

2. A device for supporting objects as recited in claim 1, further comprising:

a fourth vertical support member having one end connected to the same face of said horizontal support member as that to which said three vertical support members are connected.

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Furniture Example

- Dependent form

4. A device for supporting objects as recited in claim 1, wherein:

said vertical support members taper in width, from wide to narrow, in the direction from the ends wherein said vertical support members are connected to said face of said horizontal support member.

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Negative Limitations

- Permissible so long as the boundaries of patent protection being claimed are set forth definitely.
- Examples:
 - “said homopolymer being free from the proteins, soaps, resins and sugars present in natural Hevea rubber”
 - “incapable of forming a dye with said oxidizing developing agent”

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Absence of Structure

- Do not claim the absence of structure; e.g., holes, apertures, recesses, hollows, channels as a structural element.
- **Wrong:** “A donut comprising a hole and dough in a ring surrounding said hole.”
- **Right:** “A donut comprising dough in a ring shape defining a hole therethrough.”

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Imprecise Language

- Imprecise language satisfies § 112, ¶ 2 if one of ordinary skill in the art would understand what is claimed, in light of the specification.

About/approximately: OK if prior art is far away from the claimed range

Essentially, substantially, effective amount: OK

“Iron, steel, or any other magnetic material”: OK

“Such as,” “or like material,” “similar”: not OK

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Exemplary Terminology

- **Definite:** A wheelchair “so dimensioned as to be insertable through the space between the doorframe of an automobile and one of the seats.”
 - *Orthokinetics*, CB at 690
- **Indefinite:** “Front and rear wheels so spaced as to give a wheelbase that is between 58% and 75% of the height of the rider that the bicycle was designed for.”
 - *Ex parte Brummer*, 12 U.S.P.Q.2d 1653 (Bd. App. 1989)

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Jepson Claims

- **Preamble:** Defines what is conventional
 - Preamble is limiting
- **Transitional phrase:** “wherein the improvement comprises”
- **Body:** Builds on the preamble, adding or modifying elements

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Markush Groups

- **Form:**
 - “...wherein R is a material selected from the group consisting of A, B, C, and D”
 - “...wherein R is A, B, C, or D”
- **Closed transition is required.**
- **A, B, C, and D must:**
 - be in a recognized class; or
 - be disclosed in the specification as possessing a common property that is responsible for their function in the claimed relationship

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