Patent Claim Format and Independent Claims

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Patent Claim Format

A patent claim has the following three parts:

- preamble
- transitional phrase
- body

A claim is written as a single sentence.

1. An apparatus, comprising:
   part A; and
   part B coupled with part A.
Sample Claim:

1. An apparatus for cooking rice, comprising:
   at least one container for holding rice and water; and
   a heat source configured to transfer heat into the container.
Patent Claim Format

Preamble:

- Defines a category for the invention
  
  1. **A semiconductor device**, comprising:
     
     a substrate; and
     
     electrically conductive pathways on the substrate.

- Often identifies the type of invention
  
  Ex.: **A method for ...**

- Usually consistent with title of patent application
Patent Claim Format

Example:

*Title* of patent application:

“Rice Cooking Apparatus”

*Claim preamble* might read:

1. An apparatus for cooking rice, ...
Patent Claim Format

Example: But suppose that the inventor knows that the apparatus could be used for cooking any type of grain, then a broader preamble might read:

1. An apparatus for cooking grains, ...
Example: Now suppose that the inventor knows that the apparatus could be used for cooking vegetables and melting cheese, then a broader preamble might read:

1. An apparatus for cooking, ...
Patent Claim Format

In drafting claims and their preambles, it is important to know:

- what the invention is,
- how adaptable the invention is to related technologies, and
- how the client plans to make money from the invention.
Patent Claim Format

**Transition:**

- Follows the preamble
- May be preceded with a comma and followed with a colon
- Open or closed (next slide)

1. An apparatus, **comprising**:
   - part A; and
   - part B coupled with part A.
Patent Claim Format

With open transitions:

- recited elements specify the minimum that is needed for infringement;
- the presence of other elements in an infringing device does not defeat infringement claim.

With closed transitions:

- recited elements specify the full scope of what is required for infringement;
- the presence of other elements in an otherwise infringing device defeats infringement claim.
Patent Claim Format

Open Transitions: “Comprising” and “Including”:

- have been construed to mean “including the following elements but not excluding others” in most jurisdictions;

- typically interpreted as being open-ended (allowing inclusion of other elements/steps);

- however, be wary of differences across countries:
  - a few jurisdictions have found “comprising” to be a closed phrase.
Patent Claim Format

Example:

Invention relates to a pencil with an eraser and a light attached to it ...

Claim might be:

1. A lighted pencil, comprising:

   an elongated pencil shaft having two ends and a central region;

   an eraser attached to one of the ends of the elongated pencil shaft; and

   a light attached to the center region of the pencil shaft.
Patent Claim Format

Closed Transitions: “Consisting of”

- has been construed to mean that the claim covers **only** the elements named with nothing more;
- the body of the claim specifies “100%” of everything protected;
- confers a close-ended connotation.
Patent Claim Format

Use closed-ended phrases *sparingly*:

- your client will usually not want to limit the claim to just the recited elements;
- imagine how easily a competitor could make a trivial addition and avoid infringement;
- may alternatively use "consisting essentially of" transition for less-restrictive confinement.

- In chemistry, use of "consisting essentially of" may still cover embodiments that also include inert or other non-active components.
Patent Claim Format

Body:

- follows the transitional phrase;
- recites the *limitations* of the claim;
- explains the *relationship* between the different limitations.

1. An apparatus, comprising:
   
   part A; and
   
   part B coupled with part A.
Patent Claim Format

The following apparatus claim directed to a table would likely be rejected:

1. An apparatus for holding items, comprising:
   a top; and
   at least one leg.

Why?

No relationship is provided between (or among) the recited elements—the above body is merely a “list of parts”.

Patent Claim Format

A better claim might read:

1. An apparatus for holding items, comprising:
   a top; and
   at least one leg **coupled with the top to support the top in an elevated position.**

The above-highlighted language explains how the leg is configured in relation to the table top.
Patent Claim Format

Claim *punctuation*:

- a *comma* appears at the beginning of the transitional phrase;
- a *colon* appears at the end of the transitional phrase;
- a *semi-colon* appears between each subpart;
- the claim ends with a *period*.

*Example*: 1. An apparatus, comprising:

   part A;
   part B; and
   part C coupled with parts A and B.
Patent Claim Format

Provide proper **antecedent basis**: 

- Introduce a new element by initially referring to it with an *indefinite* article ("a" or "an")
  - "a cap"
- In subsequent references (within the same claim set) to that same element, use a *definite* article ("the" or "said")
  - "the cap" or "said cap"
Patent Claim Format

Example invention for illustrating antecedent basis -- Eyeglasses
Patent Claim Format

Antecedent Example (Apparatus):

1. Eyeglasses, comprising:
   a pair of lenses;
   an eyewire frame containing the lenses; and
   a pair of temple arms extending from the eyewire frame.
Patent Claim Format

Antecedent Example (Method):

1. A method for assembling eyeglasses, comprising:
   inserting a pair of lenses into an eyewire frame; and
   pivotably mounting a pair of temple arms to the eyewire frame.
Patent Claim Format

Distinguishing similar parts in a claim:

- If the claim recites two or more identically named parts, then the claim must distinguish between the two parts.

- For example,
  - use "first" and "second"
    - "a first widget attached to a first end and a second widget attached to a second end"
  - if, for example, you have two identical valves in a system, you might refer to an "input valve" and an "output valve".
Patent Claim Format

Example:

1. A device, comprising:
   a first part;
   a second part attached to the first part; and
   a third part fastened to the second part.
Patent Claim Format

Reference Numerals:

In some jurisdictions (e.g., EPO), claims may need reference numerals that match corresponding elements in the drawings and specification of the patent application.
Patent Claim Format

Reference Numerals:

- Assume Figure 1 of the application shows a teapot, which is labeled “123.”
- If the claims recite this particular teapot, then the teapot element may need to be followed by the reference number “123”

1. A method for making tea, comprising:
   filling a teapot (123) with water...
Patent Claim Format

Reference Numerals:

1. A book, comprising:
   a plurality of printed pages (11);
   a binding (14) configured to moveably attach the printed pages (11); and
   a cover (21) attached to the binding (14).

Drawing:

FIG. 1
Patent Claim Format

Words/phrases may be used to further define or characterize a structure or to provide a function associated with a given structure:

- “wherein,” “such that,” and “so as to”
- used to describe function, operation, or result that flows from the recited structure;
- Ex.: “An apparatus, comprising . . . a folder for keeping files, **wherein** the folder is configured to receive and contain the files . . .”

Important to know how these terms/phrases are interpreted in your jurisdiction
Patent Claim Format

Claims usually include *multiple* components or steps.

- A claim usually recites at least two elements.

- But see the first claim of US Patent 3,156,523 ("1. Element 95.").
Patent Claim Format

A patent claim without many components/steps or other limitations may be overly broad.

Compare:

- “a coat” with
- “a coat having five pockets, six buttons, and a silk lining”
Patent Claim Format

Alternatives:

- A claim may refer to various alternatives
  - provided that the alternatives are supported in the specification, and
  - if the claim’s scope is not obscured.

- Such alternatives are sometimes known as “Markush groups”.

- Can be used in all practice areas; most commonly found in chemical practice.
Patent Claim Format

Ex.: A step in a process requires addition of “copper,” “lead,” or “gold.”

■ These are the only “metals” that can be used.

Claim language encompassing all three metals could read:

■ “adding a metal selected from the group consisting of copper, lead, and gold” (classic “Markush” format) or

■ “adding at least one metal selected from copper, lead, and gold”
Patent Claim Format

Markush Groupings:

- Before using such a grouping, the patent agent should verify that there is not a more elegant (or precise) way of phrasing the claim.

- A more precise phrasing may provide the maximum scope of protection.

For example, if “copper,” “lead,” “gold” belong to a class that includes other metals (among the transition elements) that would also work, then the patent agent may better serve his client’s interests by reciting the class name:

- “. . . adding a transition metal . . .”
Questions?