



Dependent 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.

Patent Claim Format

(independent claim – refresher)

Sample Claim:

Claim #

1. An apparatus for cooking rice,

preamble

comprising:

transition

body

at least one container for holding rice and water; and
a heat source configured to transfer heat into the container.

Patent Claim Format

(dependent claim)

Sample Claim:

- Claim #
1. The apparatus of claim 1,
2. further comprising:
- a thermostat positioned to measure the temperature inside the container and configured to control the heat source.
- preamble
- transition
- body
-

Patent Claim Sets

A patent application normally includes at least one patent ***claim set*** (and typically, more than one set).

- Each patent claim set comprises:
 - one independent (main) claim and
 - one or more dependent (sub) claims.

Patent Claim Sets

Independent Claims

- Stand alone
- Limited only by limitations in that claim
- Always broader than dependent claims in same claim set
- One independent claim may be broader than an independent claim in another set

Dependent Claims

- Reference (depend from) another (independent or dependent) claim
- Incorporate all limitations of the referenced (parent) claim
- Add more limitations to the parent claim
- Follow the parent claim

Patent Claim Sets

Example:

Return to the inventor who has created a pencil with an attached light that can be used to write in complete darkness.

Patent Claim Sets

Claim set might read:

- indep.** → 1. A lighted pencil, comprising:
a pencil shaft; and
a light attached to the pencil shaft.
- dep.** → 2. The lighted pencil of claim 1, wherein **the** light is removably attached to **the** pencil shaft.
- dep.** → 3. The lighted pencil of claim 2, further comprising an eraser attached to **the** pencil shaft.

Note the use of **definite article (the)** to reflect **antecedent basis** of terms in a **parent** claim.

Patent Claim Sets

Claim 1 (independent) sets out the invention in its broadest form.

Claim 2 (dependent) depends from claim 1.

- Incorporates by reference all of the limitations recited in the parent claim.
- Adds limitation (*removable nature of the light attachment*) to parent claim.

Claim 3 (dependent) depends from claim 2.

- Incorporates by reference all the limitations of claim 2 and claim 1.
- Adds limitation to the parent claim (claim 2) (*inclusion of eraser*).

Patent Claim Sets

A **dependent claim** can **only add** and not subtract limitations from the parent claim.

For example, claims 1 and 2 cannot read as follows:

1. A lighted pencil, comprising:
 an elongated shaft; and
 a light attached to the elongated shaft.
2. The lighted pencil of claim 1, wherein the light is **not** attached to the elongated shaft.

Patent Claim Sets

Multiple-dependent claims:

- dependent on more than one claim in the alternative
- preamble refers to more than one claim
- more common in European practice than in US practice – but acceptable in both.

Example:

4. The lighted pencil of **claim 1 or 2**, further comprising an eraser attached to the pencil shaft.

Patent Claim Sets

Additional Tips for Claim Sets:

- Varying claim breadth (a) provides flexibility in examination and (b) protects against arguments that the claims are invalid over prior art not available during prosecution.
 - After a patent issues, a third party may attempt to invalidate the patent.
 - The best prior art is often found long after patent prosecution ends.
- Claims of different scope can also assist in showing that someone has infringed the claims.

Patent Claim Design

Example. Assume the client has invented a novel apparatus for turning lead into gold. The client shows the patent agent the physical embodiment of the invention, and this is the embodiment that the patent agent uses in writing the specification.

- The patent agent, however, knows that “the invention” is an abstract concept and something broader than the client’s physical embodiment.

Patent Claim Design

Patent Agent's first draft of an independent claim:

1. An apparatus for turning lead into gold, comprising:
 - a box-like metal frame;
 - an electric motor mounted inside the box-like metal frame;
 - a bowl for retaining scrap lead housed on a surface of the box-like metal frame; and
 - a lead-gold zapper element attached underneath the bowl and inside the box-like metal frame and configured to receive electric power from the electric motor.

Patent Claim Design

Patent Agent's second draft claim:

1. An apparatus for turning lead into gold, comprising:

~~a box like metal frame;~~

an electric motor ~~mounted inside the box like metal frame;~~

a bowl for retaining scrap lead ~~housed on a surface of the box like metal frame;~~ and

a lead-gold zapper element ~~attached underneath~~ operably coupled to the bowl ~~and inside the box like metal frame~~ and configured to receive electric power from the electric motor.

Patent Claim Design

Patent Agent's third draft claim:

1. An apparatus for turning lead into gold, comprising:

~~an electric motor~~ a power source;

a bowl for retaining scrap lead; and

a lead-gold zapper element operably coupled to the bowl and configured to receive ~~electric~~ power from the ~~electric motor~~ power source.

Patent Claim Design

Patent Agent's fourth draft claim:

1. An apparatus for turning lead into gold, comprising:

a power source;

~~a bowl for retaining scrap lead~~ a lead retainer; and

a lead-gold zapper element operably coupled to the ~~bowl~~ lead retainer and configured to receive power from the power source.

Patent Claim Design

Patent Agent's final realization about the invention:

The lead-gold zapper element alone should be the subject of the claim.

Patent Claim Design

The patent agent can prepare dependent claims from things he removed from draft claims while writing broad claims.

Patent Claim Design

Examples of dependent claims:

2. The apparatus of claim 1, further comprising:
a box-like metal frame, wherein the power source and the lead-gold zapper element are retained inside the box-like metal frame.
3. The apparatus of claim 1, wherein the power source is an electric motor.
4. The apparatus of claim 1, wherein the lead retainer is a bowl.
5. The apparatus of claim 4, wherein the lead retainer is configured to receive scrap lead.

Patent Claim Design

For apparatus claims, start the claim body with the “**backbone**”:

1. A robotic human replica, comprising:
 - a backbone having a first end and a second end;
 - a head connected at the first end of the backbone;
 - a pair of legs connected at the second end of the backbone; and
 - a pair of arms connected to the backbone between the head and the legs.



Questions?