

# The Limited Monopoly™

## Staking Your (Patent) Claims - Part I

by Robert Gunderman, PE and John Hammond, PE

Very few topics in the field of patent law are as misunderstood and mysterious as “claims,” the language at the end of a patent or patent application that appears to be written by some long ago purveyor of the English language. This is the first of a two part series on the topic of patent claims. It is intended only to discuss a few basic principles. Most books on the topic of claims, such as *Landis On Mechanics of Patent Claim Drafting* are extensive, to say the least. The Landis text is 970 pages.

### Why Claims Are Important

Claims define the boundaries or property lines of an invention similar to the way in which a survey, an abstract of title, or a miner’s claim from bygone years defines the boundaries of a plot of land. They are the metes and bounds of what you can exclude others from making or using. In claims, virtually every word is important, and the way in which a claim is structured is equally so. Claim language is put under the proverbial microscope first when a patent application is examined by the Patent Office during prosecution, and oftentimes later in its life when the patent is under scrutiny by a potential infringer or is being litigated in court.

During prosecution, a Patent Examiner may reject the claims in an application for a variety of reasons. In responding to a rejection, claims may frequently be amended in an attempt to avoid a prior art patent or publication that is the subject of the rejection. Amending a claim involves changing the wording, usually adding words to the claim.

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The practice of amending claims can change a broad claim to a narrow one, analogous to reducing the area of a “plot of land” defined in a survey. If a claim undergoes too much narrowing, it may be allowed by the Patent

or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.” This is where it all starts. Claims must also be directed to an invention defined within one of the statutory classes of patentable subject matter. For utility patents, the classes are machine (apparatus), process, article of manufacture, and composition of matter. Design patents and plant patents are separate statutory classes; claims for these classes are governed under different laws.

### Some Formatting Basics

The widely accepted formatting of a patent claim in the United States has developed over the years based on the statutes as well as court decisions, and commonly accepted practices. Claim practice in other countries may differ.

In the U.S., claims are placed after the specification as noted above according to 35 U.S.C. 112.

Standard U.S. practice is that each claim be only one sentence, beginning with a capital letter and ending with a period, regardless of how many words are in the claim. There is also an introductory phrase that is stated only once at the beginning of the set of claims that reads “I claim,” “We claim,” “What is claimed is,” or the equivalent.

Office, but it may also have little or no commercial value, since it may be easy to design around. Some narrowing is commonly needed to overcome a prior art reference, but it is critical to give up as little as possible. The future value of the patent, as well as that of the applicant’s products and business may be at stake.

### In The Beginning

Title 35 of the United States Code, section 112 states that “The specification shall conclude with one

Claims must be numbered, each claim starting with an Arabic numeral. In the rare instance in which only one claim is presented, a number is not required. In utility applications, more than one claim is usually submitted; an applicant is allowed to submit twenty claims with the basic application filing fee. In design patent applications and plant patent applications, only one claim is permitted. Claims are typically arranged in order of scope so that the first claim is the broadest. They are also organized in groups by composition, article, apparatus, or process (method), so that they are presented in a logical order.

## The Anatomy of a Claim

The anatomy of a claim is complex. A few basic definitions are as follows:

### The Preamble

A preamble is an introductory statement that usually indicates the statutory class of the claim and further defines what is to be claimed. An example would be “A survey apparatus for digitally rendering property lines...”

### Transitional Word or Phrase

Most claims require a transitional word or phrase between the preamble and the body of the claim. Two common transitional phrases are “which comprises” or “comprising.” The word “comprises” is a very standard word in patent law. It means “including the following elements [as listed in the body of the claim], but not excluding others.” It provides an open claim. Less often used words such as “including,” “having,” or “containing” are similar in meaning to “comprising,” but are not as commonly used.

In contrast to the open nature of the word “comprising,” the transitional word “consisting” or “consisting of” means that the claim covers an invention having only the recited elements, and no more or no less. The transitional word “consisting” should not be used unless additional elements would never be expected to be part of the invention being claimed. The

word “consisting” is used at times in chemical cases because adding a new element to a chemical composition often has an uncertain outcome. There is also the transitional phrase “consisting essentially of” that has a bit more flexibility than “consisting,” but is not as open as “comprising.” It allows for the presence of small amounts of other elements not claimed that are not significant, but are nonetheless present.

### Body

The body of the claim lists the elements of the combination of what is claimed, and further describes how each element works with another, is related to another element, or cooperates with other elements or the whole. Think of the body as listing the gears in a gearbox and describing how each gear (element) is connected to another. It is important to avoid unnecessary or laudatory statements. The body of the claim should describe the invention or the part of the invention claimed, and not how good it is. Most claims have multiple elements. There is the rare case of a single element claim, such as the claim for Teflon®. In United States Patent 2,230,654 to Roy Plunkett, a DuPont chemist, Claim 1 reads simply, “1. Polymerized tetrafluoroethylene.” This is extremely uncommon, however. Most claims have multiple elements and a fair number of words, even though they are still one long sentence.

### Formatting Options

Simpler claims are often written in a single paragraph format, with commas or semicolons between the elements in keeping with the single sentence requirement.

It is also common to see a colon after the transitional phrase. Frequently, each element is set off in a subparagraph or tabular form, or lettered. Oftentimes if there are groups of elements, the groups are further offset by indentations or letters. These various formatting options make the claim easier to read and follow, which

is something the Examiner and others who read the patent application or patent will appreciate.

### Antecedent Basis

An important rule to remember is the use of “a” the first time an element is mentioned in a claim, and the use of “the” or “said” if the element has been mentioned at least once in the claim. The word “said” and the word “the” have essentially the same meaning in a claim. “Said” has a decidedly older tone, and there is no benefit to using “said” instead of “the”, even though the word “said” is still found in many contemporary claims.

### Independent and Dependent Claims

Independent claims stand alone, while a dependent claim refers back to and further limits another preceding claim or claims in the same patent application. Our next article will discuss the various types of claims including independent and dependent claims, apparatus or machine claims, method or process claims, composition of matter claims, article of manufacture claims, biotechnology claims, and more peculiar claims like Jepson claims and Markush claims.

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*Photo credit: gold panning circa 1860 in Nelson Gulch, Montana, provided courtesy of the Western History/Genealogy Department of the Denver Public Library.*

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