

PATENT CLAIMS AND THE CLAIM GAME

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Inventors are supposed to understand the claims of their patent applications. However, understanding claims is not easy. The claims are surely the part of the patent application that requires the most concentrated thought by the patent attorney who prepared the application. What are claims and what are the keys to understanding them?

It is very helpful to make an analogy between a deed to a parcel of land and a patent. A patent can be thought of as a deed to an invention. A deed to land must identify exactly what land is being claimed. That identification is the boundary description, commonly done in angles and distances. In patent law, there is also a requirement to identify the boundaries of the invention. Claims are used to identify the invention.

In a deed to land, only one boundary description is needed. In the case of an invention, only one claim is required but it is common to have more than one. For example, an invention may be viewed as a device and also as a method for making or using the device. Also, because of the uncertainty as to whether a broad claim will “hold up” when challenged, it is common to have backup claims that define the invention more narrowly.

A claim has three parts: a preamble, a transition, and a body. The preamble simply and generally states the type of invention, such as a “device” or a “pump” or a “method for pumping a fluid”. The transition is most often the word “comprising” or “including” which is “open-ended language” and significantly affects the scope of the claim. An open-ended transition from the preamble means that what is recited in the body of the claim defines the most that is required in this invention; anything less is not the invention and anything more will still rely the basic combination.

The body of the patent claim includes one or more elements. An element can be thought of as a component of the invention. The invention is said to “comprise a combination of elements.” When the invention is looked at in its simplest form, its essence, it can always be viewed as a combination of a few basic components that work together to achieve the purpose of the invention. Other elements may be added – the “bells and whistles” – but the essential elements are the only ones that belong in the broadest claims. These elements are recited in the body along with a description of how these elements are interrelated.

Thus, a typical claim will be in a form such as “A device, comprising: an A, a B attached to the A, and a C on top of the B.” The invention is then the combination of A, B, and C. If someone decides that adding a D is an important improvement to the ABC combination, they may be able to obtain a patent on the new ABCD combination but they still need permission from the owner of the ABC combination. Importantly, the ABC combination *inherently* includes additional elements because the transition is open-ended. If an element is known to be an obvious addition to the basic combination, there is no point in writing a special claim to claim it; it is already inherently included. Rather, the claims should be directed to the more significant elements and refinements of elements.

Beyond this simple example, claiming inventions can become very complex. The strategy for what to claim and how to claim it should be worked out with your patent attorney.

He will need to know what you will be selling and what a would-be infringer might do to circumvent your invention. He will need to discuss with you what features of your invention are optional and what are essential. You will need to discuss with him the implications of the prior art that you are aware of and that he might have found in a prior art search. From all of these, you can pull together a realistic picture of what can reasonably be expected from the patent process.