

## A Few Basics of Drafting Patent Claims

*(Note for people who might find this on the internet: This is for law students to get a flavor of patent claiming to further their understanding of patent law at a very general level. I do not recommend it for DIY legal purposes.)*

### The subject and verb

The claims section begins with the words “I claim:”, “We claim:”, “What is claimed is:”, or something similar. Each claim in a patent is a single sentence, but all the claim sentences share that same subject and verb set out at the beginning of the claims section.

### Punctuation, capitalization, and style

At the beginning of each separate claim, use one capital letter. At the end of each separate claim, put one period. Do not use dashes, quotes, or parentheses. Do not use trademarks or abbreviations.

### Preamble

Start with an article (“A” or “An” for an independent claim), then articulate some noun or noun phrase – either the statutory class (e.g., “machine,” “process,” “composition of matter,” etc.) or something else (e.g., “device,” “paper holder,” “item of furniture,” “apparatus for electrically connecting two cables,” etc.).

### Transition Phrase

Then use a transition phrase:

- |                                    |  |
|------------------------------------|--|
| <i>“comprising”</i>                | ← this is broad and open; it means at least the specified elements that follow, but maybe more   |
| <i>“consisting of”</i>             | ← this is closed; it means only the specified elements that follow and not others  |
| <i>“consisting essentially of”</i> | ← this is mostly closed; it means only the specified elements that follow, plus others that don’t materially affect the characteristics of the claimed invention |

### Body

The body consists of a recitation of the elements of the claim. For the first element, set out one part of the invention. For the next element, set out another part of the invention, showing how it relates to or is connected to the first element. For each succeeding element, do likewise.

## Articles “a,” “an,” “said,” and “the”

The articles *a* and *an*, *said*, and *the* all have particular, technical uses.

- use *a* or *an* for the first mention of an element
- use *said* for a second mention of an element where you are using exactly the same words as you used previously
- use *the* for the mention of some aspect of an element already mentioned, but where you haven't used exactly the same words previously

## Strategy

Use a mixture of broad and narrow claims. Broader claims have fewer elements and thus have a greater scope of potential infringement. Narrower claims have more elements and thus are more defensible against potentially discoverable prior art.

Use dependent claims as a way of creating more defensible, narrower claims.

A multiple dependent claim is a dependent claim that depends on a dependent claim. This narrows scope (and increases defensibility) even more.

## Claim Structure, Not Function

You can't claim just the function of your invention. For instance, the following claim would be rejected:

*I claim: A battery less than a cubic meter in size that can be fully charged in less than an hour and can power an electric car for 1,000 miles.*

Instead, you must claim structure.

*I claim: A battery comprising an anode of erbium, a cathode of yttrium dioxide, and an electrolyte of copper trioxide.*

## Means-Plus-Function Claiming

A permissible way of bringing function into your claim is “means-plus-function” claiming. To use this, write “means for” and then articulate the function.

*I claim: An electric lamp comprising [define structure] ... and means for connecting said power supply portion to an electrical outlet.*

## Leverage Examples

Use examples of claims in granted patents for guidance in drafting your own claims.

**Credits:** A primary source for this handout was David Pressman's book, *Patent It Yourself*. That's actually a great resource for DIY patent applicants. I recommend it.