

Patent Claims

The specification of a patent shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter that the applicant regards as his invention. The claims must include at least one independent claim and optionally one or more dependent claims.

35 U.S.C. §112, second paragraph, requires:

- 1 The claims must set for the subject matter that an applicant regards as the invention, and
- 2 the claims must particularly point out and distinctly define the metes and bounds of the subject matter that will be protected by the patent.

The first requirement of 35 U.S.C. §112, second paragraph, is subjective because it depends upon what the applicant for a patent regards as the invention. Patent claims are not frequently rejected for failure to comply with this requirement. It cases where such rejections are made extrinsic evidence is normally introduced.

The second requirement of 35 U.S.C. §112, second paragraph, is evaluated in the context of whether the claim is definite to a hypothetical person having ordinary skill in the pertinent art. To comply with this requirement the claim must be:

- 1 precise
- 2 clear
- 3 correct, and
- 4 unambiguous

The claims are at the end of the patent and are introduced with language such as:

- 1 What is claimed is:
- 2 I claim:
- 3 We claim:
- 4 Claims:

The claims of a patent can be directed to:

- 1 a machine,
2. an article of manufacture,
3. a process, or
4. a composition of matter

Claims are always a single sentence that can include commas, colons, and semi-colons. However, a claim can only have one period at the end (except for abbreviations).

Standard Element Claims and Step Format Claims include:

- 1 a preamble (described the technical field in which the invention is used or has application and does not generally limit the scope of the invention),
- 2 transitional language (sets the context for the specific elements called for in the body of the claim),
 - comprising, which comprises, including (open ended)
 - consisting of, which consists of (closed ended)
 - consisting essentially of (leaves the claim open to the inclusion of some additional elements that do not materially alter the basic and novel characteristics of the invention)
- 3 a body (recites the specific elements called for in the claim)

Single Element Claims (e.g. 2-hydroxydodecyl 2'-hydroxyethyl sulfide)

Jepson Claim have preambles which are "admitted" prior art. Jepson claims start with the word "In" and normally have "the improvement which comprises" as transitional language.

Kit Claims can be used to cover inventions where all of the elements of the invention are not physically connected.

Alternative Expressions can be used in claims. Such alternative expressions include:

- "or"
- "and/or"
- "a member selected from the group consisting of" (the classical Markush group)
- "at least one member selected from the group consisting of"
- "optionally"

Negative Limitations can be used in claims. Such negative limitations include:

- "in the absence of"
- "other than"
- "wherein there is no"
- "non-alcoholic"
- "void of" or "free of"

Means-plus function language can also be used in claims with out reciting a specific element.

An antecedent basis must be established for every element used in a claim. This is done by referring the element with the word “a” or “an” when the element is first introduced into the claim (the first time that the element is used in a claim).

After an antecedent basis is established for an element used in a claim it is subsequently referred to using the word “the” or the word “said”.

Certain relative terms can be used in claims without rendering the claim indefinite. Some examples of relative terms that are deemed to be acceptable include:

- “about”
- “at least”
- “no more than”
- “essentially”
- “substantially”
- “effective amount”
- “sufficient”

However, some other relative term are deemed to render claims indefinite. Some examples of terms that have been held to render claims indefinite (invalid) include:

- “at least about”
- “similar”
- “type”

Dependent claims further limit an invention delineated in an independent claim. Dependent claims cannot be infringed without infringing the independent claim on which they depend. Dependent claims can be used to narrow elements called for in a claim or to add additional elements.

Dependent claims are generally of the format:

A [process, composition, or article] as specified in claim X, [wherein or which further comprises] . . .

The word “wherein” is used to narrow elements and the language “which further comprises” is used to add new elements.

The terms used in claims carry their ordinary dictionary meaning, unless it appears that the inventor used them differently. To determine if a patent uses a term differently from its ordinary meaning, the specification and prosecution history will be considered.

Inventors can act as their own lexicographers by creating their own language for use in claims. However, the inventor must describe in the specification the meaning of the word or term.