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IP ESSENTIALS

A Toolkit for Entrepreneurs, Innovators, and Business Owners

PATENT CLAIMS

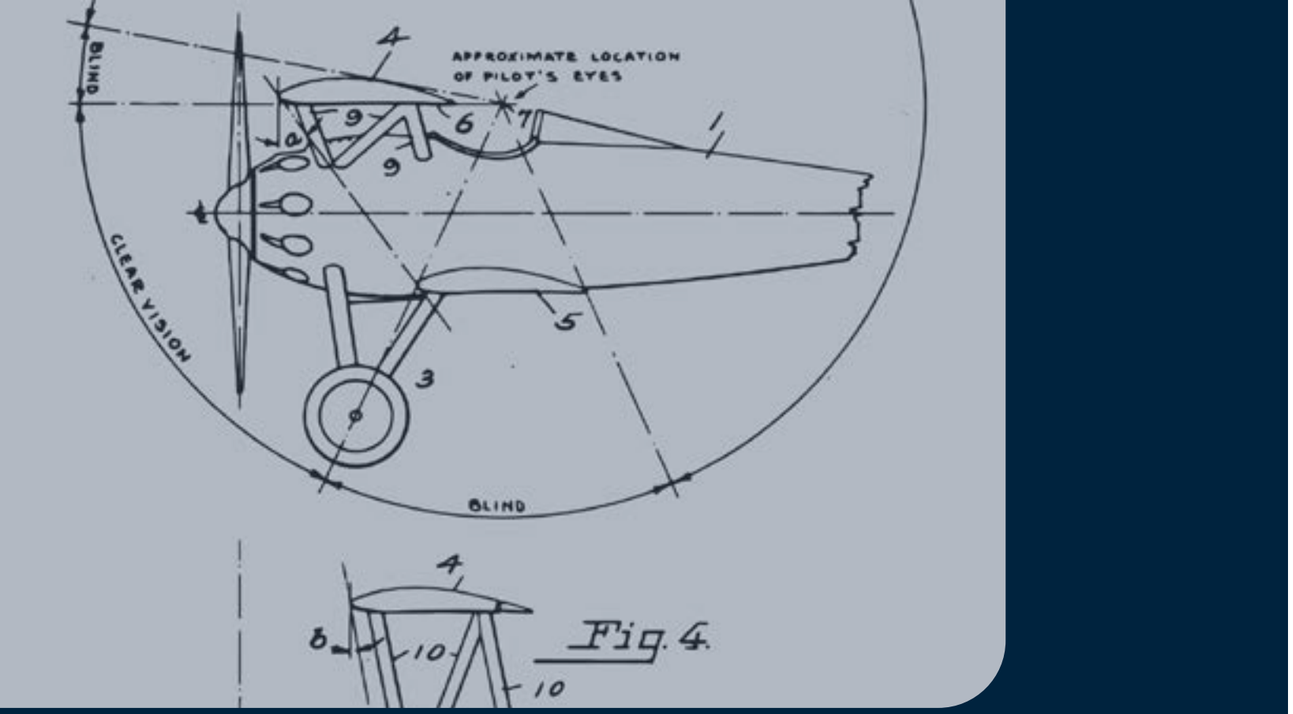

Fig. 4.

PATENT CLAIMS

An issued patent must conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the inventor or a joint inventor regards as the invention. The claims of an issued patent define the invention the patent owner has the right to exclude others from making, selling, using, or importing.

Q&A SERIES

Q ***What kind of inventions can patent claims cover?***

A There are three types of patents with fundamentally different types of claims.

1. **Utility patents**: one may claim “any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof.”
2. **Design patents**: claims cover ornamental designs of an object, for example, a design of a fabric pattern or a user interface of a computing device.
3. **Plant patents**: new and distinct varieties of plants.

Q ***At what point in the application process does one need to determine what is included in their claims?***

A A patent application may be filed with only a single claim. One may amend the claims of a patent application or add new claims throughout prosecution of the patent application. Any new claims added must be directed to the same general invention as the existing claims after a Patent Examiner first issues an opinion on the patentability of the claims. Prior to the Patent Examiner issuing their first opinion, with few restrictions, one is generally free to amend or replace the claims of an application. As discussed below, many jurisdictions limit the number of claims that can be included in a patent application without having to pay a surcharge.

Q ***Can I add new claims to my patent after it issues?***

A Yes. After a patent issues one may request a **reissue** in which one may add or amend the claims of the issued patent. The added claims may, under certain circumstances and within two years of the issuance of the patent, be broader than the originally issued claims. There is a risk to this procedure as one must surrender the existing patent and the amended or new claims will be examined by the Patent Examiner and may possibly be objected to and/or rejected.

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Q ***How are utility patent claims structured?***

A Utility patent claims include a preamble that describes the general nature or class of the claimed invention. A preamble may be as simple as: "An apparatus . . ." or "A method . . ." The preamble is followed by a transitional phrase, typically "comprising," "consisting of," or "consisting essentially of." The choice of transitional phrase determines the scope of the claimed invention defined by the elements. The transitional phrase "comprising" means that the claimed invention includes *at least* the recited elements *and may also* include other features. The phrase "consisting of" means the claimed invention includes *only* the recited elements. The phrase "consisting essentially of" means the claimed invention includes the recited elements *and excludes* additional elements that would "materially affect the basic and novel characteristic(s) of the claimed invention."

Q ***Are there any exceptions to what you can claim in a utility patent?***

A Yes. You cannot claim a biological component such as an organ, an abstract idea such as a mathematical formula, a law of nature, or even a computer program *per se*. Some software inventions may be patentable if they meet certain requirements, such as controlling some physical system or improving the functioning of a computer itself.

Q ***Why would one want a claim to be as general as possible?***

A Ideally a patent claim includes only what is necessary to render the claimed invention novel and inventive. This way, the claim can be used to protect not only one particular commercial embodiment of an invention, but other embodiments as well. For example, if a claim describes an apparatus as having a "power supply," this claim may encompass versions of the apparatus including any of a battery, an ultracapacitor, a solar panel, or even a flywheel as the power supply, as long as these different options are described in the body of the patent application. Claims may include language such as "means for" accomplishing a particular objective. These claims are interpreted to include any mechanism for achieving the claimed objective described in the specification, and equivalents thereof, but no other mechanisms for achieving the objective.

"Ideally a patent claim includes only what is necessary to render the claimed invention novel and inventive."

Q ***What are independent and dependent claims?***

A An independent claim stands on its own and defines the claimed invention most generally. A dependent claim may be used to claim the invention more specifically by adding a further limitation. A dependent claim may also be used to more specifically define one or more of the elements of the claim from which it depends. Dependent claims can depend from independent claims, other dependent claims, or even multiple claims, however, in the United States, claims that depend from multiple claims cannot depend from another claim that depends from multiple claims. A claim in dependent form is considered to incorporate by reference all the limitations of the claim to which it refers. Dependent claims are useful, for example, in litigation where a party might argue that the independent claims of a patent are invalid and unenforceable. If a court determines that an independent claim is invalid, a dependent claim describing an invention in more specific terms may still be considered valid and enforceable.

Q ***How many claims should there be in a patent?***

A A patent should have enough claims to describe a commercial embodiment of a particular invention, as well as feasible variations of the commercial embodiment, to prevent competitors from designing around the commercial embodiment by using one of these variations. Cost may be a consideration when determining how many claims to include in a patent application. In the United States Patent and Trademark Office (USPTO), one is allowed three independent claims and a total of 20 claims without surcharge above the basic application filing fees. Additional claims require additional fees. In other jurisdictions the number of claims permitted for the basic filing fee and the surcharge for extra claims differ. In the European Patent Office (EPO), for example, an applicant is generally limited to one independent apparatus claim and one independent method claim and 15 total claims. Excess claim fees in the EPO are far costlier than in the USPTO.

Q ***Can I claim more than one invention in a single patent?***

A No. A patent may issue for only a single invention, although the claims may describe the invention at various degrees of specificity. In some instances, for example, one may seek to claim both a product and method of making the product, and the USPTO may require the applicant to choose one of the product or the method. In this instance, one may seek to obtain a patent for the unelected category of invention in a divisional patent application.

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Q ***Why do patent claims tend to be very long and often grammatically incorrect?***

A By law, patent claims must be a single sentence. If a claimed invention has several features, this may make the claim seem like a run-on sentence. Patent attorneys try to word patent claims to be as general as possible while still defining a novel invention. This may lead to a patent claim including terms that may seem vague. Further, a patent applicant can define their own terminology in a patent application, and if this terminology appears in a claim, it might not be clear what is meant unless one reads the definition of the terminology in the patent application.

Q ***How do you claim an ornamental design?***

A Design patents include drawings of the design that is being claimed, applied to a particular type of object for which the design is intended. A design patent will include a single claim such as "The ornamental design for (the article which embodies the design or to which it is applied) as shown." For a more in-depth look at this type of patent, please see our Q&A on design patents.

Q ***How do you claim a new variety of plant?***

A In a plant patent, the specification must contain as full and complete a disclosure as possible of the plant and the characteristics thereof that distinguish it from related known varieties, and its antecedents, and must particularly point out where and in what manner the variety of plant has been asexually reproduced. Plant patents have a single claim, such as "A new and distinct variety of (the plant), substantially as illustrated and described herein."

This IP Essentials Topic is one of a series:

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