

# Promoting Patent Claim Clarity

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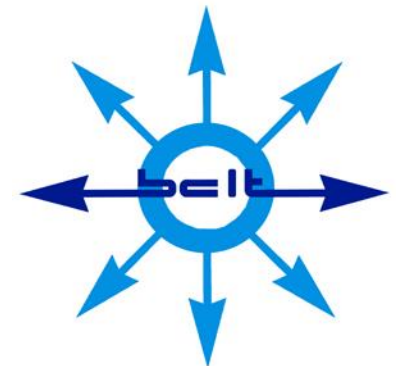
**University of California at Berkeley School of Law**

**Thomas Alva Edison Visiting Professional, USPTO (2012-13)**



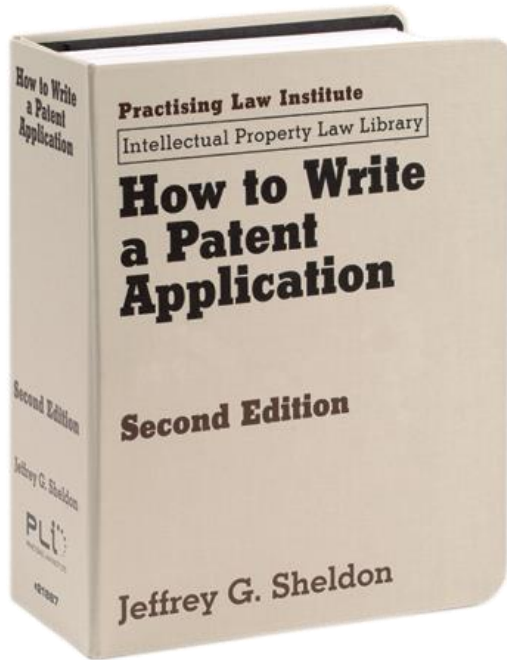
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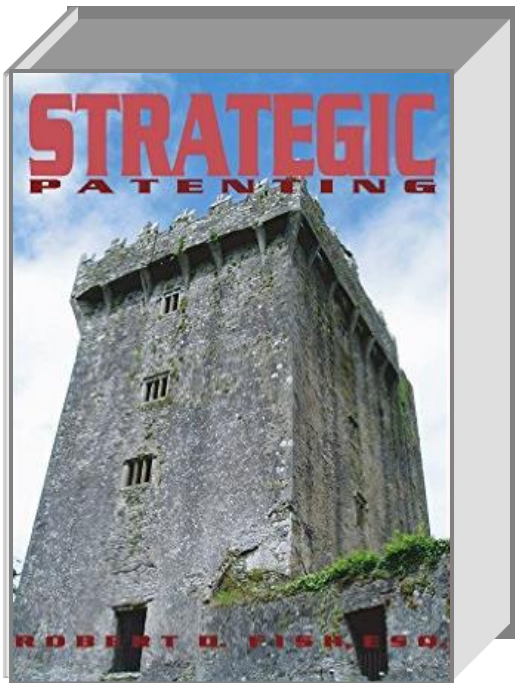
**The growth of the patent system in the last quarter of a century in this country has reached a stage in its progress where the variety and magnitude of the interests involved require accuracy, precision, and care in the preparation of all the papers on which the patent is founded. . . . The developed and improved condition of the patent law, and of the principles which govern the exclusive rights conferred by it, leave no excuse for ambiguous language or vague descriptions. The public should not be deprived of rights supposed to belong to it, without being clearly told what it is that limits these rights. The genius of the inventor, constantly making improvements in existing patents – a process which gives to the patent system its greatest value – should not be restrained by vague and indefinite descriptions of claims in existing patents from the salutary and necessary right of improving on that which has already been invented. It seems to us that nothing can be more just and fair, both to the patentee and to the public, than that the former should understand, and correctly describe, just what he has invented, and for what he claims a patent.**

***Merrill v. Yeomans, 94 U.S. 568 (1877)***



## § 7.5.20 Include Ambiguous Claims

offering numerous “strategies” for “intentionally writ[ing] ambiguous claims”



advising drafters to “[a]void . . . like the plague” claim language that clearly identifies the “gist of the invention” or the “factor” that makes it “unique” (page 7-35)

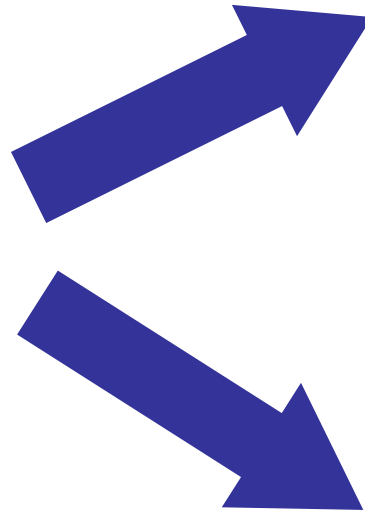
# Who Is Affected by Ambiguous Claims?

- **Patent Examiners**
- **Other Inventors/Competitors—Freedom to Operate**
- **Patent attorneys/agents—opinion letters**
- **Judges**
- **The Public**

# Claim Construction

**Validity**

**Claim  
Construction**



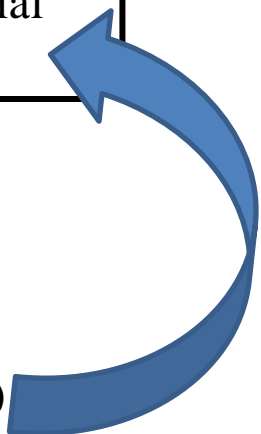
**Comparison of:  
claimed invention and  
accused device**



# Patent Claim Template

**Patent Specification**

- Structure
- Material
- Acts



**Preamble**

**Limitation**

**Transitional Clause**



**comprising**



**consisting of**



**consisting essentially of**



**claim limitation - novel**



**Means/Step + Function 112(f)**

**Claim Limitation 1**



**claim limitation - novel**



**Means/Step + Function 112(f)**

**Claim Limitation 2**



**combination of limitations - novel**

\* \* \*

**default general dictionary:** \_\_\_\_\_

**default technical dictionary:** \_\_\_\_\_

# **Related Recommendations**

**Layered, Redlined Documents – with comments**

**PTO Glossaries**

- **within art groups**
- **work with professional/academic scientific/ engineering organizations – e.g., IEEE**
- **work with technical lexicographers**

**Move all patent documents (including applications) to digital format**