

Different Countries, Different Practices

We prosecute many US national phase entries and applications that claim priority to a foreign application under the Paris Convention. In either case we recommend and routinely make certain changes to the specification and claims as outlined in this paper.

The Invention

We are concerned that a US court could read limitations into the claims, if the specification explicitly defines what "the invention" is or which elements must be present "according to the invention". We review foreign documents for potentially limiting definitions of "the invention" and eliminate those. Instead of referring to "the invention" we often refer to "the disclosure". The term "according to the invention" can often simply be deleted.

In particular, preferably

The USPTO will reject claims if they contain ambiguous phrases. Among those are expressions of preference often found in foreign applications, e.g. "in particular" or "preferably". There are generally three approaches to resolving these terms:

1. The preferable element is removed from the claim (the claim is worded broadly).
2. The preferable element becomes a mandatory part of the claim (the claim is worded narrowly).
3. The claim is split into two claims, one with and one without referring to the preferred element.

Multiple dependent claims

Multiple dependent claims are prohibitively expensive in the US. A "device according to one of the claims 1 to 3" counts as three claims when determining claim fees. Additionally, a separate fee for having multiple dependent claims applies. We amend dependent claims to refer to a single parent, that is the first claim that recites all elements which the dependent claim relies on.

Characterized in that...

"Jepson Claims" are commonly used or even mandated in foreign jurisdictions. These claims contain a preamble describing the prior art, and then claim an improvement over the prior art. The improvement is usually introduced with the words "characterized in that". While this format is permissible in the US, it is not commonly used. The preamble will be considered an admission of prior art, which can cause significant disadvantages without any beneficial return. We rephrase

claims to follow US practice of simply listing all required elements. The term "characterized in that" often becomes wherein".

Reference numerals in claims

Reference numerals are not usually used in US claims. We typically remove them from the claims, either upon filing or after allowance (if they seem useful to have during prosecution). In some cases, reference numerals are used as quasi-names (the lever 6 is connected to the lever 9). In those cases, we will reword the claims to instead name the different elements with a number: The first lever is connected to the second lever.

Definite and indefinite articles

The USPTO will reject claims if terms are used without antecedent basis: Every element must be introduced with an indefinite article ("a lever") and thereafter referred to with a definite article ("the lever"). We use quality control software to ensure that the rules are followed.

Means

Many foreign applications refer to "means" to broadly claim a structure. Unfortunately, this may have the opposite effect in the US if it invokes a means-plus-function interpretation. We will generally replace "means" and similar terms with a descriptive noun.

At least one...

Especially in German-language documents the term "at least one" is frequently used because "an element" and "one element" cannot be distinguished in German. We find that "at least one" sometimes causes more confusion than benefit and replace it with a simple "a".

Abstract

We shorten the abstract to contain less than 150 words in accordance with USPTO regulations.

Questions?

Smartpat was founded in 2007 by Axel Nix with the goal of transferring automotive manufacturing principles such as continuous improvement, automation, and productivities to the legal sector.

We are happy to discuss how those can benefit your US patent applications.

