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Practical Tips for Claim Drafting

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Drafting patent claims can be tricky, in that sometimes we may not think about the implications of how we choose to draft a given claim. For example, is there really any significant difference between “The method of claim 1, wherein the particle size is between 6 mm and 12 mm” as compared to “The method of claim 1, wherein the particle size is from about 6 mm to about 12 mm”?

Or what about “The device of claim 1, wherein the device further comprises at least one of A, B, C, and D” versus “The device of claim 1, wherein the device further comprises at least one of A, B, C, or D”?

Finally, what about “The device of claim 1, wherein the substrate is selected from the group consisting of A, B, C, D, and combinations thereof” versus “The device of claim 1, wherein the substrate comprises at least one of A, B, C, or D”.

In the first example, there may be a question as to whether the endpoints are actually included within the claimed range or not, as well as whether the “about” applies to both values in the recited range or just the first value.

In the second example, while true that patent examiners in years past did not like the use of the term “or” in a patent claim as potentially being indefinite, such objections are no longer typically raised by the patent office. The use of the connecting term “and” potentially raises a question as to whether the claim requires each and every one of A, B, C, and D, or if any one of those 4 possibilities is sufficient.

In the third example, many of us were taught in law school or elsewhere to use conventional Markush style claim structure. That said, it is important to realize that when doing so, the conventional Markush structure includes the phrase “consisting of”, meaning that the claim is closed with respect to the listing of substrate materials. Is that really what you intend, as the claim drafter?

These are all important questions and issues to consider when drafting claims.