

# A Dozen Reasons For Dependent Claims

By **Kelce Wilson**

Law360, New York (August 1, 2017, 11:59 AM EDT) --  
Did you know there were so many reasons? How many do you use?  
Do you have defined criteria for when to pay excess claim fees and  
when to drop claims?

Ask your colleagues in patent prosecution how they select material  
for dependent claims; you might be surprised how few carefully  
refined strategies you hear. And that is if your colleagues can even  
articulate coherent strategies. So then, how do you optimize claim  
sets, to ensure your clients receive high-quality, cost-effective  
patents?

[U.S. Patent and Trademark Office](#) guidance is slim. Although 35  
U.S.C § 112 ¶ 4 does specify a requirement for “further limitation  
of the subject matter claimed,” this only defines what claims cannot  
be included — for example , a claim that attempts to expand  
coverage beyond what the independent claim properly covers alone.  
Sadly, there is no PTO guidance about what should be included.  
Thus, many widely differing opinions about claim drafting strategy  
can all easily fit within the patent prosecution rules. See reference  
[1] for commentary on the 35 U.S.C § 112 ¶ 4 requirements.



Kelce Wilson

Some recommendations are provided here for you to consider as your dependent claim strategy, in three sets: (1) a five-phase claim optimization strategy, (2) a dozen enumerated reasons for including a dependent claim, and (3) a prioritization scheme for when your candidates list grows large enough to incur excess claim fees. By drafting candidate dependent claims that fit each of the recommended reasons, as many as you can think of for each, and then using the prioritization scheme, you will be working according to the suggested optimization strategy.

There are already some paradigms proffered, including one in reference [2] that suggests limiting dependent claims to those having sufficient justification. Reference [2] also provides some example reasons meeting that author’s threshold for sufficient justification. The suggestions here are somewhat similar, although in finer detail, adding some new reasons, and introducing a prioritization scheme to use when the set of justifiable candidate claim set drives the expected prosecution burden beyond the client’s preferences.

## **Five-Phase Strategy**

The most important thing about a claim drafting strategy is that it should fit the client’s needs — not only preserving the client’s legal rights, but also accommodating the client’s budget and business strategy. Not every client needs the broadest rights in order to achieve its business objectives for a patent, and also, a prolonged prosecution battle for broad coverage might be prohibitively expensive. See references [3] and [4] for suggestions on aligning prosecution strategy with a client’s business needs.

As a quick preview, the five-phase strategy fits this order: (1) exhaust all aspects of novelty, (2) maximize licensing or product-differentiation opportunities by covering feasible variations, (3) add litigation-assisting claims, (4) add prosecution-assisting claims, and then (5) keep the client happy.

When attempting to exhaust all aspects of novelty for a single invention, try to limit each claim to a single novel aspect. With the most economically significant novel aspect in the independent claims, other novel

aspects are available for dependent claims. The most economically significant aspect of novelty is typically a combination of (1) good resistance to design-around and (2) providing economic value to the invention. See reference [5] for suggestions for drafting claims to enhance patent value. Note, however, that this approach should not be used for independent claims of some inventions, if it would result in omission of essential matter and trigger a rejection under 35 U.S.C. § 112(a). See M.P.E.P. § 2172.01 for more detail on this requirement.

### ***Phase 1***

Drafting the claims to exhaust all aspects of novelty helps reduce the risk that a competitor will be able to design around the claims, and thus may define a good limit on the minimum claim count you should recommend to the client. During an invalidity attack, a determined litigation opponent or assertion target might hire technology experts to locate obscure prior art that the PTO didn't find. So, dependent claims that provide fallback positions with genuinely clever novelty will be more survivable than dependent claims that add limitation based mainly on design choices. The key to maintaining patent value is selecting fallback novelty positions that are resistant to design-around.

This recommendation of minimizing novelty in each claim might not always fit well with your circumstances. Instead, you might prefer to file an early application with narrow independent claims, to speed initial allowance and see the PTO's relevant prior art search results — and then filing broader claims in continuation applications after the examiner seems convinced that there is a true invention. Be prepared for the possibility that the examiner won't cooperate, though. So inquire of the inventor what the most impressive aspect of novelty might be; hopefully the invention has some aspect that can provide a “wow factor” for the examiner. It might be different than the most economically significant aspect. If so, that should be a ready amendment, in case you have difficulty with the initial allowance.

### ***Phase 2***

As a second phase, draft dependent claims to cover a set of feasible variations that balances a narrow focus (to survive new prior art challenges) with design-around resistance. The difference between this phase and the earlier phase is that the design-around resistance in the dependent claims can be shared by different dependent claims — each addressing a smaller field of possibilities. Sometimes, when attempting this strategy, more than one patent will be needed if you roll up a dependent claim into the independent claim in an amendment and then receive a restriction/election requirement. In some situations, you should consider requesting one, if the examiner puts you into a situation in which a divisional application is desirable and you prefer to try avoiding a terminal disclaimer.

The need to request a restriction/election requirement can arise, for example, in a relatively common situation. Consider the possibility that you have two or more dependent claims that are drawn to incompatible variations of an invention. If the independent claim is allowable, then both incompatible dependent claims are permitted in the same patent. However, if during prosecution, one of those incompatible dependent claims is rolled up into the independent claim in order to obtain allowance, then the other incompatible dependent claim should properly no longer depend from the now-amended independent claim.

See US Patent No. [6,970,917](#), claims 1 and 2 for an example of a patent prosecutor's mistake in this regard. Claim 1 contains a limitation, “without a request from the wireless device,” that is fundamentally incompatible with dependent claim 2, which recites “transmitting a request for the contents of the mailbox from the wireless device to the server.” Originally, these incompatible limitations were in separate dependent claims. One of the original dependent claims was pulled into claim 1 in order to obtain allowance, and the patent prosecutor did not address the newly-created conflict between the amended independent claim and one of its remaining dependents. The consequence was fitting: invalidation of claim 2 during litigation, and the defendant eventually won on noninfringement.[6]

If you find yourself in a situation of an incompatibility between claims that resulted from an amendment, a restriction/election would be proper. If the examiner doesn't notice, then consider requesting a

restriction/election. If the examiner agrees, you might avoid a terminal disclaimer in the divisional. Keep in mind the additional costs, delay, and other burdens on the client, though.

Whenever making amendments to the independent claims, ask the inventor about the possibility of design-arounds that could permit competitors to provide market-acceptable substitutes that don't infringe the newly amended independent claims. You do not need to patent all conceivable variants of an invention, if some are impractical. Instead, aim for protecting variants that are feasible for a competitor to market, relying on impracticality issues to push competitors either out of the market or into a licensing arrangement.

Here, you have a potential stopping point for what you suggest as a minimum claim set, even if it triggers excess claim fees. Beyond this, there should be a cost/benefit analysis that considers the client's budget and plans for using the patent. Each additional candidate claim should be justified or dropped, so that excess claim fees are sensible, rather than arbitrary and thus possibly wasted.

### ***Phase 3***

Moving into the third phase, if budget and claim count permit, provide additional claims that can be used to enhance litigation position. There are several options; such as a claim that unmistakably describes a consumer-ready product using plain language. Few things will be more convincing to a jury than a clearly written claim — not in legalese, but ordinary language — that maps cleanly onto a competitor's product. If you have a highly detailed claim, such as a "picture claim" that may be nearly impossible to invalidate, and yet it maps well onto an accused device, your litigation opponent will appear nonsensical to the jury when arguing noninfringement. A "picture claim" is a narrow claim that is unmistakably drawn to a specific embodiment of the invention, such as a market-ready product.

There are others types of litigation-assisting claims. One is a dependent claim that limits scope to exclude as-yet-undiscovered prior art, even if the limitations aren't really all that clever. This type of claim effectively just moves a litigation opponent from anticipation obviousness, which may provide them with a lower likelihood of success.

Another is a claim that attempts to invoke the doctrine of claim differentiation. Although a dependent claim cannot properly expand the scope of an independent claim, using a properly worded dependent claim can make the argument for a broad interpretation of the independent claim more convincing. Also, spreading limitations into more claims, each with fewer limitations, can improve clarity over using fewer claims that are longer.

### ***Phase 4***

In the fourth phase, provide additional claims that can be used to reduce future prosecution costs, by signaling to the future prosecutor what you and the inventor believe to be a sensible amendment strategy. Can you predict who will be handling office actions, years into the future? Even if you do handle them yourself, how well will you remember the details of the inventive concepts and distinctions from prior art? If someone else will be responding to the office actions, how much time will it take that person to come up to speed on the relevant issues?

A single lousy amendment in the independent claims can destroy a patent's value. However, you can reduce the risk of a value-destroying amendment occurring, as well as potentially reduce the client's future prosecution costs by leveraging your understanding of the invention at the time you are initially drafting claims. Placing the best amendment candidates in the dependent claims during the initial filing can often be a superior approach over amending from the specification. This is because a proper office action will address the patentability of all dependent claims. Amending an independent claim using a dependent, for which the examiner has already addressed the issue of novelty, can shorten the path to allowance, compared with giving the examiner something entirely new to consider.

It is possible, though, that by the time you reach this phase of the strategy, all of the best amendment

candidates will already be in the claim set — placed there during an earlier phase of the process. However, it is worth considering this aspect of the strategy, just to make certain you haven't left anything out. You should also revisit any Markush claims — if you have any — and consider separating the limitations into different claims. A Markush claim can be anticipated if any one of the list items is found in the prior art, so a set of separated claims may be easier to patent and also be more survivable in litigation.

A picture claim can also be a prosecution-assistant, if it gives the examiner an "aha" moment that convinces the examiner that there truly is an invention. When patent claims are drafted to be as general as possible, the language might seem somewhat nebulous — although hopefully avoiding problems with the [U.S. Supreme Court's](#) *Nautilus* decision.[7] So, assisting the examiner to see novelty with a picture claim could speed allowance for other claims.

### ***Phase 5***

The final phase is to use any surplus claim count for improving writing style, marketing the invention, and adding in claims that the client wants to see — even if such claims don't really improve the client's legal rights. Throughout this claim drafting process, though, be careful to ensure that each dependent claim further limits the claim from which it depends, in order to satisfy 35 U.S.C. §114 ¶ 4.

This final set of claims are to keep the client happy, and so they don't need to improve the client's rights. The primary considerations are that the claims do not damage the client's rights, harm the patent's value, or waste the client's money. You may have already addressed most of them in a prior phase. Perhaps your "wow factor" claim for the examiner might also function as a marketing claim the client wants to show investors — or perhaps you might need another. At this point, the analysis is to ensure you hadn't omitted anything potentially valuable.

Patents are not necessarily just documents for describing legal rights. They can also be tools for obtaining critical investment funding and improving a company's prestige. Often, a patent needs to impress people who might not fully understand all of the legal issues involved with claim language, but who do have significant control over the patent owner's economic prospects. Thus, a patent with a picture claim that has marketing value might be worth more value to the patent owner, by impressing an investors and customers, than do patents with claims that impress only lawyers. This concept might actually be new to some in the patent prosecution community.

### **List of the Dozen Reasons**

1. Feature claims that provide additional novelty for patentability and are difficult or expensive to design around, even for the most basic marketable system.
2. Feature claims that provide additional novelty for patentability and add market value, but are optional in a marketable system.
3. Feature claims that provide additional novelty for patentability but might not add market value to a system.
4. Scope-narrowing claims that might not add much novelty, but move invalidity attacks from anticipation to obviousness.
5. Claims that unmistakably invoke claim differentiation by clearly defining a term narrower than it could reasonably be interpreted in a higher claim.
6. Claims that spread out limitations to improve writing style and clarity.
7. A picture claim that makes blatant copying easily identifiable and convincing to a jury.

8. Other good amendment candidates that have not yet already been included.
9. Breaking up a Markush group into individual claims.
10. A marketing claim that may be beneficial to the client's business needs, if different than the picture claim above.
11. A claim that places the invention within a larger, more expensive system.
12. The client wants it, and there is no good reason for it, but also no legal harm to the client.

## **Prioritization Scheme**

If you have a sufficient number of candidate claims that the client wishes to trim some, the process for prioritizing candidates is straightforward. Assign each candidate to one of the enumerated reasons. The reasons list is numbered according to a roughly descending order of value for most situations. So, this assignment step immediately provides a rough ranking order.

Then sort within each reason classification to select the best allowance/survivability/scope trade-offs. At this point, you may be able to discard some candidates, even in the higher ranking classes. How far down you go down the list for determining the suggested minimum number of claims will depend on the client's tolerance for excess claim fees and business needs for the patent.

Some clients need a solid patent for product differentiation, to protect revenue. For these patents, consider suggesting to the client using reason classes 1-4 as a mandatory minimum, even if doing so triggers excess claim fees. Only go beyond that number for claims that the client believes have sufficient marginal value to justify the added expense. Some clients attempt to maximize patent count and need to keep costs low, so you might avoid excess claim fees for even good claim candidates.

When candidates are properly prioritized, you can move down the list, making a yes/no decision until the first "no." Then, you have a defensible stopping point. With a smart claim prioritization scheme, you are on the road to providing your clients with quality legal products.

---

*[Kelce S. Wilson](#), Ph.D., is a partner at Grable Martin Fulton PLLC in Dallas, with a practice spanning patents and privacy.*

*The opinions expressed are those of the author(s) and do not necessarily reflect the views of the firm, its clients, or Portfolio Media Inc., or any of its or their respective affiliates. This article is for general information purposes and is not intended to be and should not be taken as legal advice.*

[1] Gary Maze and Richard Redano, "Dependent Claims, Genus/Species, and Disjunctive Limitations: How to Run Afoul of the Rarely Litigated § 112 ¶¶ 3-4," *Intellectual Property Today*, Nov. 2011, pp. 16-18.

[2] Ronald Slusky, "Invention Analysis and Claiming: What's This Claim Doing Here?" *Intellectual Property Today*, Aug. 2011, p. 7.

[3] Kelce Wilson and Claudia Tapia Garcia, "The Three Classes of Patent Usage," *les Nouvelles*, pp. 283-290, December 2011.

[4] Kelce Wilson and Claudia Tapia Garcia, "Patent Application Prioritization and Resource Allocation Strategy," *les Nouvelles*, pp. 87-91, June 2011.

[5] Kelce Wilson, "Claim Drafting in 5D," *Law360*, June 13, 2017

[6] Mformation Tech. v. [Research In Motion Ltd.](#), consolidated cases 2012-1679 and 2013-1123, U.S. Court of Appeals for the Federal Circuit, Aug. 22, 2014.

[7] Nautilus, Inc. v. BioSig Instruments, Inc., (2014)

All Content © 2003-2017, Portfolio Media, Inc.