



WHAT'S ALL THE FUSS ABOUT CLAIMS?

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- B.A. Biochemistry from University of Arizona with minors in Math and Physics
- M.P.H. from San Jose State University
- J.D. from Santa Clara University
- 10 years as a working engineer. Process control systems, video distribution systems



FIRM

- Founded in 2006
- Computer & Software, Semiconductor Manufacturing, Telecommunications, and Mechanical
- Patent Prosecution, Opinions, Litigation Support, Trademarks, and Copyrights
- Electronic Office Paradigm



DISCLAIMER

- Based on personal experience
- Does not reflect the opinion or position of the USPTO or any person employed or affiliated with the USPTO
- No Statutory basis (35 USC, 37 CFR, MPEP)



OUTLINE

- **New Stuff**
- Claims – What you want to protect
- Disclosure – What you want to publish



NEW STUFF

- Extended Missing Parts Pilot Program (EMPPP)
 - File a non-provisional application within 12 months of a provisional application directly claiming the benefit there from
 - Oath/Declaration
 - Basic filing fee
 - Claims
 - Specification
 - 2-month to correct with extension available
 - Submit a certification and request to participate in the EMPPP



CERTIFICATION AND REQUEST FOR EXTENDED MISSING PARTS PILOT PROGRAM (Page 1 of 2)	
First Named Inventor:	Nonprovisional Application Number (if known):
Title of Invention:	
<p>APPLICANT HEREBY CERTIFIES THE FOLLOWING AND REQUESTS TO PARTICIPATE IN THE EXTENDED MISSING PARTS PILOT PROGRAM FOR THE ABOVE-IDENTIFIED APPLICATION.</p> <ol style="list-style-type: none"> 1. This certification and request is being filed with the nonprovisional application. The application is an original nonprovisional utility or plant application filed under 35 U.S.C. 111(a) within the duration of the pilot program. The following are excluded from the program: design applications, provisional applications, national stage applications, PCT international applications, reissue applications, and reexamination proceedings. 2. The application directly claims the benefit of a provisional application filed within the previous 12 months. Applicant is including the benefit claim to the provisional application in the first sentence of the specification or an application data sheet (see 37 CFR 1.78). 3. A nonpublication request is not included. 4. By filing this certification and request, applicant also acknowledges the following: <ul style="list-style-type: none"> ▪ A nonprovisional application must have a specification including at least one claim and a drawing(s) if necessary for an understanding of the invention to be entitled to a filing date (see 35 U.S.C. 111(a)) and thus be eligible for the pilot program. ▪ The nonprovisional application as originally filed must have a complete disclosure that complies with the enablement and written description requirements of 35 U.S.C. 112, first paragraph, which is sufficient to support the claims submitted on filing and any claims submitted later during prosecution. New matter cannot be added to an application after the filing date of the application. See 35 U.S.C. 132(a). ▪ Provisional rights to a reasonable royalty under 35 U.S.C. 154(d) may only be available if the claims that are published in the patent application publication are substantially identical to the patented claims that are infringed (if a patent is granted). Therefore, applicant may wish to consider the benefits of submitting a complete set of claims on filing of the nonprovisional application. ▪ Any foreign application (or international application) must still be filed within 12 months of the provisional application's filing date if applicant wishes to rely on the provisional application in the foreign application (or international application). ▪ Any patent term adjustment (PTA) accrued by applicant based on certain administrative delays by the USPTO is offset by a reduction for failing to reply to a notice by the USPTO within three months. See 37 CFR 1.704(b). Thus, if applicant replies to a notice to file missing parts more than three months after the mailing date of the notice, the additional time that applicant takes to reply to the notice will be treated as an offset to any positive PTA accrued by the applicant. In no event will a reduction under 37 CFR 1.704(b) reduce the 20-year patent term (if a patent is granted). For more information on patent term, see MPEP § 2701. ▪ A general authorization to charge fees, or a specific authorization to charge the search, examination, and/or excess claims fees to a deposit account, should not be submitted if participation in the pilot program is desired. ▪ Fees are subject to change and the fees that are due are the fees in effect at the time of fee payment. Therefore, if the search fee, examination fee, excess claims fees, and/or the surcharge (or any other fees) have increased after the mailing of a Notice to File Missing Parts, applicant will be required to pay the increased fee amounts. Applicants should consult the current fee schedule on the USPTO Web site before paying any fees that are due. 	

CERTIFICATION AND REQUEST FOR EXTENDED MISSING PARTS PILOT PROGRAM (Page 2 of 2)
<p>5. Applicant acknowledges that if the application is not in condition for publication, applicant will be required to place the application in condition for publication within two months (extendable under 37 CFR 1.136) of notification.</p> <p>To be in condition for publication (37 CFR 1.211(c)), the application must contain the following:</p> <ol style="list-style-type: none"> a. Basic filing fee; b. Executed oath or declaration in compliance 37 CFR 1.63; c. Application size fee (if required); d. Specification in compliance with 37 CFR 1.52; e. Abstract in compliance with 37 CFR 1.72(b); f. Drawings in compliance with 37 CFR 1.84 (if required); g. Sequence listing in compliance with 37 CFR 1.821-1.825 (if applicable); and h. English language translation and statement in compliance with 37 CFR 1.52(d) (if required).

Signature	Date
Name (Print/Typed)	Practitioner Registration Number
<p><i>Note: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required in accordance with 37 CFR 1.33 and 11.18. Please see 37 CFR 1.4(d) for the form of the signature. If necessary, submit multiple forms for more than one signature, see below.</i></p>	
<input type="checkbox"/> *Total of _____ forms are submitted.	



NEW STUFF

- Extended Missing Parts Pilot Program (EMPPP)
 - File a non-provisional application within 12 months of a provisional application directly claiming the benefit therefrom
 - Oath/Declaration
 - Basic filing fee
 - Claims
 - Specification
 - 2-month to correct with extension available
 - Submit a certification and request to participate in the EMPPP
 - No non-publication request
 - 18 months from time of provisional filing



NEW STUFF

- 12-months from Filing
 - Surcharge: 65.00 SE, 130.00 LE
 - Examination fee
 - Search fee
 - Excess Claims fee
- Duration of Program
 - 12 months from December 8, 2010
- Issues
 - PCT filings
 - PTA
 - Reasonable Royalties (Claims)
 - Do you really save any money?



OUTLINE

- New Stuff
- **Claims – What you want to protect**
- Disclosure – What you want to publish



CLAIMS – WHAT YOU WANT TO PROTECT

- What do you want to prevent others from doing?
- Claims should be made using structure and function language
- Claims should be **reasonably** broad
- Claims should be directed to different aspects of the invention:
 - Article of manufacture
 - Method of use of article
 - Methods of manufacture



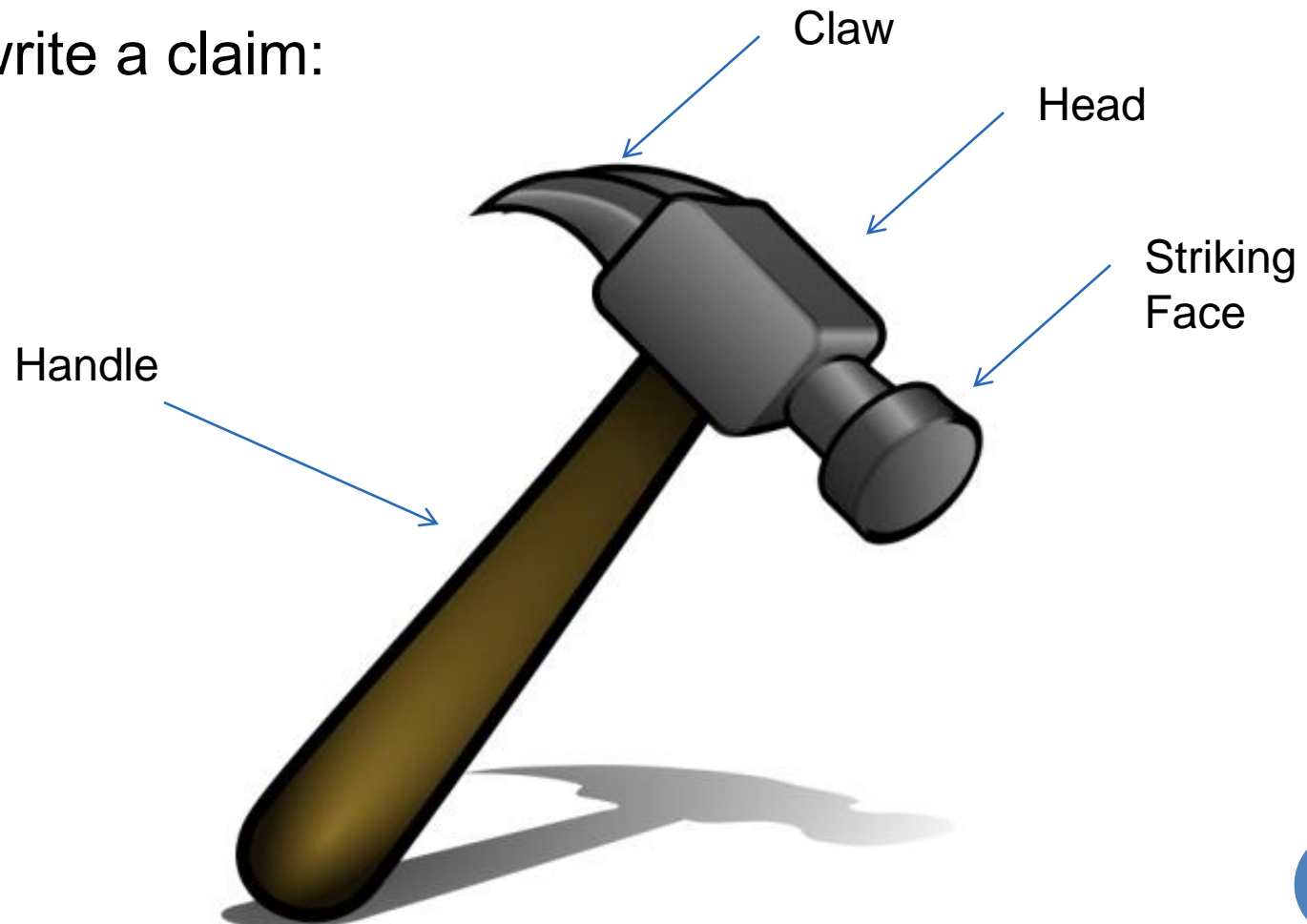
CLAIMS – WHAT YOU WANT TO PROTECT

- Let's write a claim:



CLAIMS – WHAT YOU WANT TO PROTECT

- Let's write a claim:



CLAIMS – WHAT YOU WANT TO PROTECT

- Let's write a claim:
 - I Claim:
 - 1) A hammer comprising:
 - a handle;
 - a head;
 - a striking face; and
 - a claw.



CLAIMS – WHAT YOU WANT TO PROTECT

- Let's write a claim:

I Claim:

1) A hammer comprising:

a handle for providing a graspable surface for the hammer; and
a head attached at a proximal end, the head including,

a striking face configured to provide a planar striking
surface, and

a claw configured to provide a prying surface.



CLAIMS – WHAT YOU WANT TO PROTECT

- Let's write a claim:

I Claim:

1) A hammer comprising:

a handle for providing a graspable surface for the hammer; and
a head attached at a proximal end, the head including,
a striking face configured to provide a planar striking
surface, and
a claw configured to provide a prying surface.

2) The hammer of claim 1, wherein the head further comprises:

a strain gauge responsive to a compressive force applied to the
head;
an LED readout display for displaying the compressive force.



CLAIMS – WHAT YOU WANT TO PROTECT

- Let's write a claim:

I Claim:

1) A hammer comprising:
a handle for providing a graspable surface...

...

6) A method of manufacturing a hammer comprising:
forming a handle from a semi-rigid material, the handle
configured to provide a graspable surface...

...

11) A method of using a hammer comprising:
grasping a handle, the handle configured to provide a graspable
surface...



CLAIMS – WHAT YOU WANT TO PROTECT

- Let's write another claim:

I Claim:



OUTLINE

- New Stuff
- Claims – What you want to protect
- **Disclosure – What you want to publish**



DISCLOSURE – *WHAT YOU WANT TO PUBLISH*

- You need not claim everything in the Specification in the first application
- You may claim unclaimed subject matter in later filed application if continuity is preserved.
- You cannot keep anyone from doing something that is only disclosed, but not claimed.
- What you disclose is fair game for use in examining a patent application.



Thanks



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