

# Claim Drafting Strategies for Multiple Dependent Claims



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## Before We Get Started...



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UK Principal

## Dr John Collins

Dr. John Collins is a UK and European patent attorney and UK trademark attorney at Schwegman Lundberg & Woessner, P.A. John has considerable experience in proceedings before the European Patent Office, including oppositions and appeals. He has over 30 years experience of international patent drafting and prosecution.



# Outline

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- EPO principles
- Approach to structuring claims
- Tip for US filing
- EPO filings– Tip to avoid claims fees
- Summary

# EPO Legal Principles

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- Article 84 EPC requires claims to be concise
- No express exclusion to the use of multiple claim dependencies
- Claims fees are expensive- each claim over 15 incurs a fee of €245 (about \$300). But they are only paid based on the actual number of claims and not on the calculated claim combinations
- Very restricted on claim amendments after filing (PCT filing date is EP filing date) the basis for the combination of features claimed must be “directly and unambiguously derivable” from the application as filed – beware intermediate generalization
- The same standard for basis is applied to the assessment of the right to a priority claim; priority application should include multiple claim dependency basis

# Type of claims

- Usually only a single independent method claim and a single independent apparatus claim exceptions possible for transmitter/receiver inventions, client/server inventions, plug/socket inventions, encoder/decoder inventions, etc
- Computer-readable medium claims. These can cover storage media (nontransitory media) and signals (transitory media).
- The EPO allow claims to depend on claims of a different type to enable a very compact set of claims, e.g.
  - A method of using the system of any one of claims 1 to 5, the method comprising.....
  - A system comprising a processor, and a storage medium storing instructions, which when executed by the processor, causes the system to carry out the method of any one of claims 1 to 5.
  - A machine-readable medium carrying machine readable instructions, which when executed by a processor of a machine, causes the machine to carry out the method of any one of claims 1 to 5.
- Note - ensure software method claims refer to the use of technical means-reciting “A computer implemented method” is enough

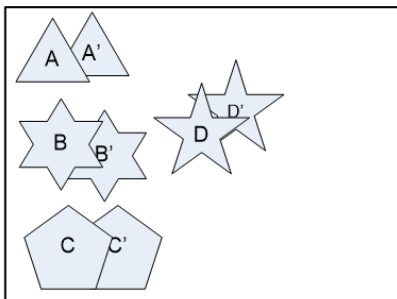
# Approach to Map Claim Structure

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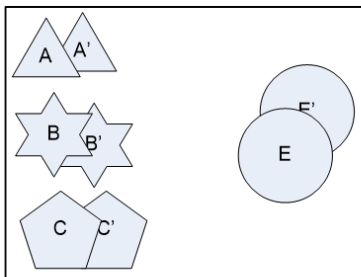
- Identify claim features for claim 1
- Identify modifications to those claim features and new claim features
- Map relationships and possible combinations
- Reorder where necessary to ensure correct dependency relationships
- Avoid complex dependency relationships where possible e.g. The method of claim 5 when dependent on claim 3, wherein .... (such a conditional dependency is allowed by the EPO but is not good practice – better to try to reorder claims).

# Example Invention

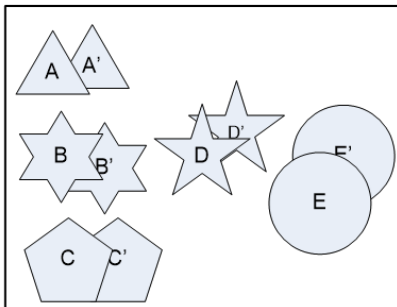
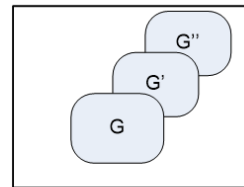
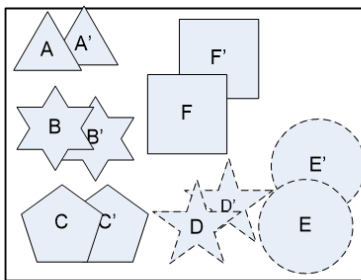
EMBODIMENT 1



EMBODIMENT 3



EMBODIMENT 2

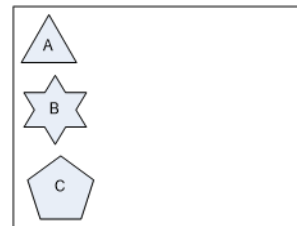
EMBODIMENT 4  
- D and/or E  
optionalEMBODIMENT 5  
- MAY BE USED WITH  
ANY OF  
EMBODIMENTS 1 TO  
3 AND NOT 4



# Feature identification

## Claim 1

- A + B + C
- These are the common technical features of all embodiments. A generalised embodiment should be included in the description corresponding to claim 1 to provide basis.

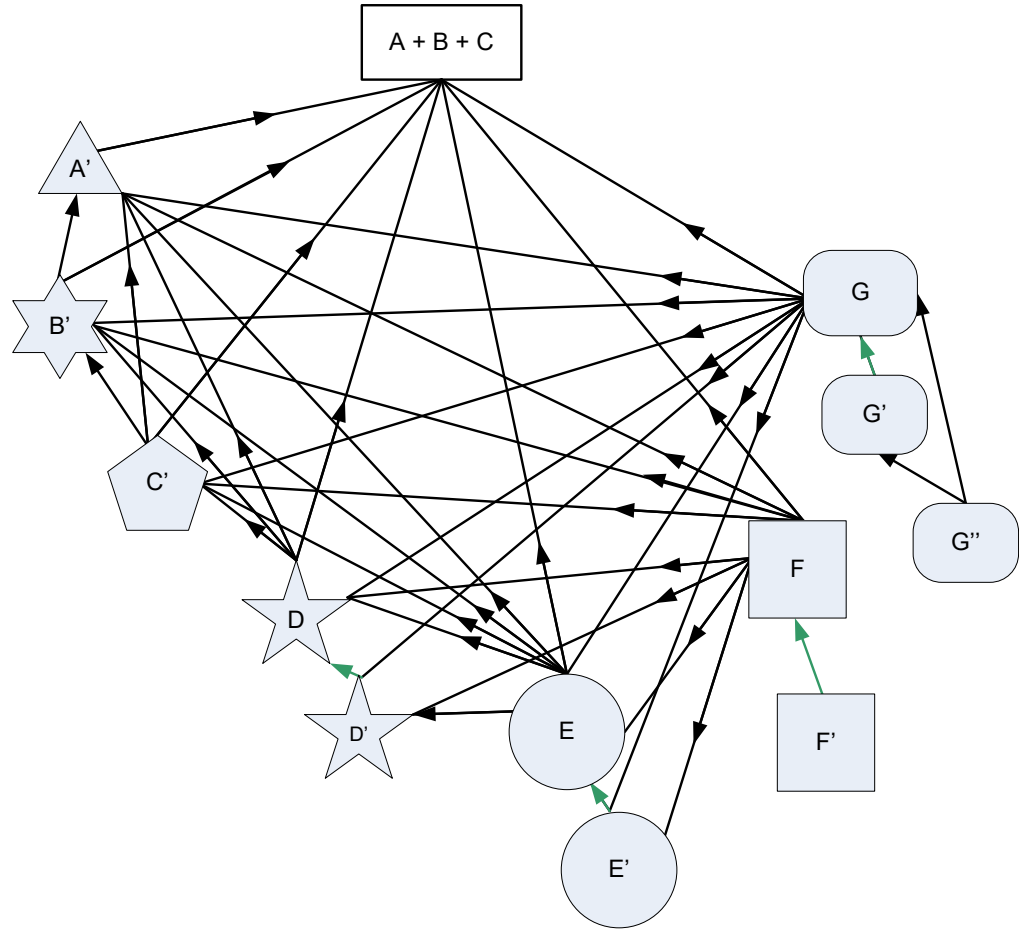


## Optional features for dependent claims

- A', B', C, D, D', E, E', F, F', G, G', G''

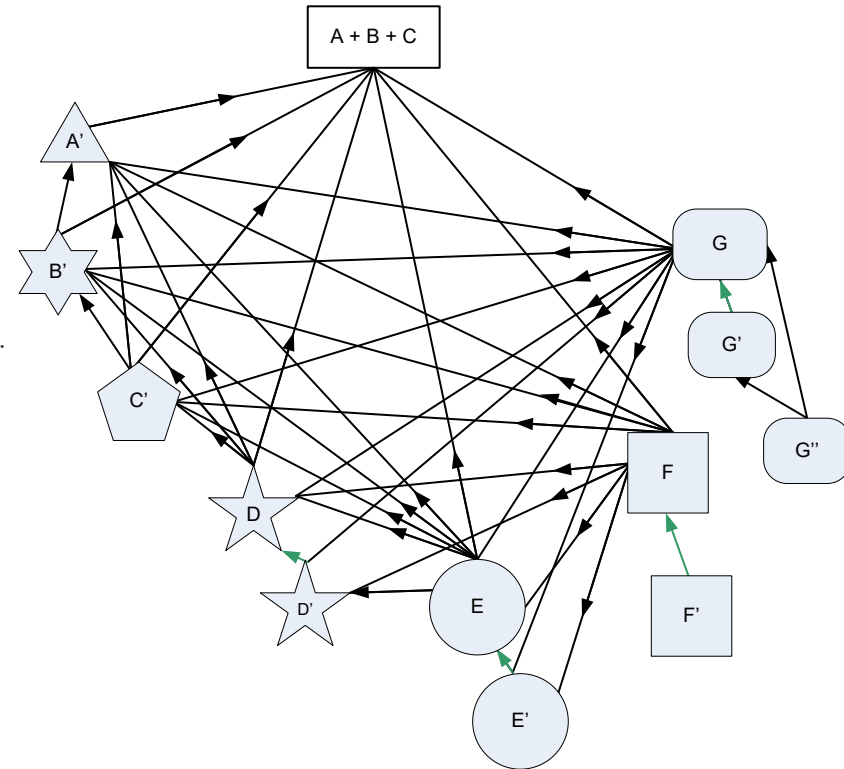
# Define structure

- The 'Mind Map'



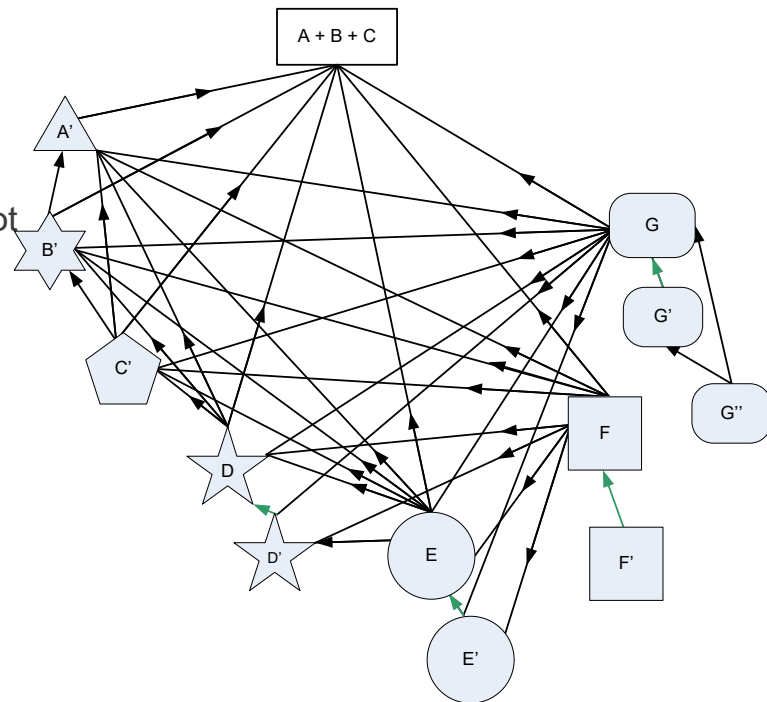
# The claims

1. A method of A, B and C.
2. The method of claim 1, wherein A comprises A'.
3. The method of claim 1 or claim 2, wherein B comprises B'.
4. The method of any one of claims 1 to 3, wherein C comprises C'.
5. The method of any one of claims 1 to 4, including D.
6. The method of claim 5, wherein D comprises D'.
7. The method of any one of claims 1 to 6, including E.
8. The method of claim 7, wherein E comprises E'.
9. The method of any one of claims 1 to 8, including F.
10. The method of claim 9, wherein F comprises F'.
11. The method of any one of claims 1 to 8, including G.
12. The method of claim 11, wherein G comprises G'.
13. The method of claim 11 or claim 12, G comprises G''.
14. A system comprising a processor, and a storage medium storing instructions, which when executed by the processor, causes the system to carry out the method of any one of claims 1 to 13.
15. A machine-readable medium carrying machine readable instructions, which when executed by a processor of a machine, causes the machine to carry out the method of any one of claims 1 to 13.



# Points to note in claim dependencies

- Claim 1 includes for the first time in the structure the features A, B and C in combination. Claim 2 defines A' + B + C. If claim 3 were just dependent on claim 1 this would only cover (and hence 'disclose') A + B' + C and if claim 4 were just dependent on claim 1 this would only cover (and hence 'disclose') A + B + C'. What is not covered and disclosed is A' + B' + C', A' + B' + C, and A + B' + C'
- Note that D', E', F' and G' are narrower features and need only depend on D, E, F and G respectively, since D, E, F and G are introduced into the claims separately.
- Note that G has two overlapping narrowing features G' and G''. G'' can be used with G or G'. Hence, a claim to G'' must depend on both G and G', e.g. G states pulses used as a signal, G' states the pulse height is 1V, and G'' states that the pulse width is 1ms.
- Note that F and G are not compatible features, and relationships (dependencies) should not be formed between them in the claims.



# Tip for when filing at USPTO

- The basis for a valid priority claim is strict. The US priority application must contain the basis for the claim combinations.
- But USPTO does not allow multiple claim dependencies and claims fees are high.
- Solution is to include a section headed “Examples” and to include the numbered claims in multiply dependent form but with the word “claim” or “claims” replaced with “example” or “examples”, e.g.

## Examples

The following numbered examples are embodiments.

1. A method of A, B and C.
2. The method of **example 1**, wherein A comprises A’.
3. The method of **example 1** or example 2, wherein B comprises B’.
4. The method of any one of **examples 1** to 3, wherein C comprises C’.
5. The method of any one of **examples 1** to 4, including D.
6. The method of **example 5**, wherein D comprises D’.
7. The method of any one of **examples 1** to 6, including E.
8. The method of **example 7**, wherein E comprises E’.....etc

# How to amend to reduce claims

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When filing at the EPO regional phase based on US style claims, the claims may look like:

- A method of A, B and C.
- The method of claim 1, wherein A comprises A'.
- The method of claim 1, wherein B comprises B'.
- The method of claim 1, wherein C comprises C'.
- The method of claim 1, including D.
- The method of claim 5, wherein D comprises D'.
- The method of claim 1, including E.
- A system comprising a processor, and a storage medium storing instructions, which when executed by the processor, causes the system to do A, B and C.
- The system of claim 8, wherein A comprises A'.
- The system of claim 8, wherein B comprises B'.
- The system of claim 8, wherein C comprises C'.
- The system of claim 8, including D.
- The system of claim 12, wherein D comprises D'.
- The system of claim 8, including E.
- A machine-readable medium carrying machine readable instructions, which when executed by a processor of a machine, causes the machine to do A, B and C.
- The machine-readable medium of claim 15, wherein A comprises A'.
- The machine-readable medium of claim 15, wherein B comprises B'.
- The machine-readable medium of claim 15, wherein C comprises C'.
- The machine-readable medium of claim 15, including D.
- The machine-readable medium of claim 19, wherein D comprises D'.

# How to amend to reduce claims

- This is how to amend them with no loss of claim scope
  1. A method of A, B and C.
  2. The method of claim 1, wherein A comprises A'.
  3. The method of claim 1, wherein B comprises B'.
  4. The method of claim 1, wherein C comprises C'.
  5. The method of claim 1, including D.
  6. The method of claim 5, wherein D comprises D'.
  7. The method of claim 1, including E.
  8. A system comprising a processor, and a storage medium storing instructions, which when executed by the processor, causes the system to ~~do A, B and C~~ carry out the method of any one of claims 1 to 7.
  9. ~~The system of claim 8, wherein A comprises A'.~~
  10. ~~The system of claim 8, wherein B comprises B'.~~
  11. ~~The system of claim 8, wherein C comprises C'.~~
  12. ~~The system of claim 8, including D.~~
  13. ~~The system of claim 12, wherein D comprises D'.~~
  14. ~~The system of claim 8, including E.~~
  15. A machine-readable medium carrying machine readable instructions, which when executed by a processor of a machine, causes the machine to ~~do A, B and C~~ carry out the method of any one of claims 1 to 7.
  16. ~~The machine readable medium of claim 15, wherein A comprises A'.~~
  17. ~~The machine readable medium of claim 15, wherein B comprises B'.~~
  18. ~~The machine readable medium of claim 15, wherein C comprises C'.~~
  19. ~~The machine readable medium of claim 15, including D.~~
  20. ~~The machine readable medium of claim 19, wherein D comprises D'.~~

(Better still, if numbered examples are in the description, multiple claim dependencies can be used)

If the description includes multiply dependent examples, you could also use this as the basis for making the method claims 3-7 multiply dependent

# Summary

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- Multiple claim dependencies are:
  - a useful tool for international patent drafters
  - an essential consideration for strong EPO patents
- An organised approach is required to maximise the benefit afforded by them
- Remember them at US filing and when converting a US specification for EP filing





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Thank you for your interest.

# Questions?



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