

Topic 6: Dependent Claims

Masaharu Kizu

Japanese Patent Attorney

SOEI Patent & Law Firm, Tokyo

September 3, 2019

Harare

Dependent Claim

- ✓ Depends from an independent claim
- ✓ Always narrower than the independent claim

Example:

1. A writing device comprising:
a pencil;
an eraser attached to one end of the pencil.
2. The writing device **of claim 1**, further comprising:
a light attached to a middle part of the pencil.



What for?

- ✓ Fallback positions in the examination
 - Examiner may cite prior art that Applicant did not know at the time of filing
 - Examiner may reject independent claim but allow dependent claim

- ✓ Save examination time and costs
 - Obtain allowance with less Office Actions

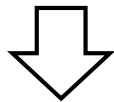
- ✓ Post allowance
 - Granted independent claim may be attacked and canceled
 - Limited opportunities for amending claims

Claim Amendment

- ~~1. A writing device comprising:
— a pencil;
— an eraser attached to one end of the pencil.~~



2. The writing device of claim 1, further comprising:
a light attached to a middle part of the pencil.



1. (Amended) A writing device comprising:
a pencil;
an eraser attached to one end of the pencil; and
a light attached to a middle part of the pencil.

Format

Acceptable

1. A writing device comprising:
a pencil;
an eraser attached to one end of the pencil.
2. The writing device **according to claim 1**, further comprising a light attached to a middle part of the pencil.
3. The writing device **of claim 2**, wherein the light is a light bulb.
4. The writing device **as in claim 1**, wherein the pencil has a circular cross section.



Format

Acceptable?

1. A writing device comprising:
a pencil;
an eraser attached to one end of the pencil.
2. The writing device according to claim 1, further comprising a light attached to a middle part of the pencil.
3. The writing device of claim 1, wherein **the light** is a light bulb.
4. The writing device as in claim 1, wherein the pencil has a circular cross section.



Format

Acceptable?

1. A writing device comprising:
a pencil;
an eraser attached to one end of the pencil.
2. The writing device according to claim 1, further comprising a light attached to a middle part of the pencil.
3. The writing device of claim 2, wherein the light is a light bulb.
4. The writing device as in claim 3, wherein **the light is a LED.**



Format

Acceptable?

1. A writing device comprising:
a pencil;
an eraser attached to one end of the pencil.
2. The writing device according to claim 1, further comprising a light attached to a middle part of the pencil.
3. The writing device of claim 2, wherein the light is a light bulb.
4. The writing device as in claim 2, wherein the light is a LED.



Format

Acceptable?

1. A writing device comprising:
a pencil;
an eraser attached to one end of the pencil.
2. The writing device according to claim 1, further comprising a light attached to a middle part of the pencil.
3. The writing device of claim 2, wherein the light is a light bulb.
4. The writing device as in claim 1, wherein **the eraser is not attached to the pencil.**
5. The writing device as in claim 1, wherein **the eraser is attached to the center of the pencil.**



Claim Set

Is this a good claim set?

1. A writing device comprising:
a pencil;
an eraser attached to one end of the pencil.
2. The writing device according to claim 1, further comprising a light attached to a middle part of the pencil, wherein the light is a light bulb and the pencil has a circular cross section.



Multiple Dependent Claims

Acceptable

1. A writing device comprising:
a pencil;
an eraser attached to one end of the pencil.
2. The writing device **according to claim 1**, further comprising a light attached to a middle part of the pencil.
3. The writing device **of either claims 1 or 2**, wherein the pencil has a circular cross section.
4. The writing device **as recited in any one of claims 1, 2, and 3**, wherein the eraser is made of plastic.



Multiple Dependent Claims

Not Acceptable

1. A writing device comprising:
a pencil;
an eraser attached to one end of the pencil.
2. The writing device according to claim 1, further comprising a light attached to a middle part of the pencil.
3. The writing device of **claims 1 and 2**, wherein the pencil has a circular cross section.
4. The writing device as recited in any one of claims 1, 2, and 3, wherein the eraser is made of plastic.



Multiple Dependent Claims

Acceptable?

1. A writing device comprising:
a pencil;
an eraser attached to one end of the pencil.
2. The writing device according to claim 1, further comprising a light attached to a middle part of the pencil.
3. The writing device of either claims 1 or 2, wherein the pencil has a circular cross section.
4. The writing device as recited in any one of claims 1-3, wherein **the light is a light bulb.**



Tips

- ✓ Multiple dependent claim may cause additional official fees
- ✓ Multiple dependent claim cannot depend from other multiple dependent claim in some jurisdictions
- ✓ Excess claim fees may be incurred depending on the total number of claims
 - Better to avoid adding unnecessary dependent claims

Exercise: Draft some dependent claims

A cup with a handle (new)



A conventional cup

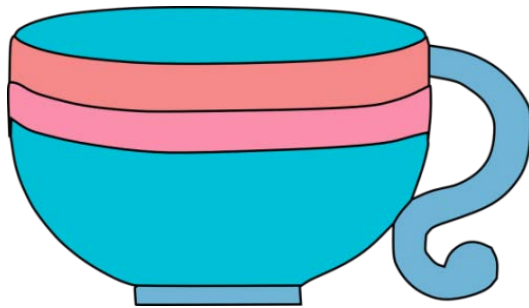


1. A cup comprising:

a body for containing hot beverage; and
a handle fixed to the body part.

Exercise: Draft dependent claims to differentiate from the conventional cups below

1. A cup comprising:
a body for containing hot beverage; and
a handle fixed to the body part.



Thank you for your kind attention!

Masaharu Kizu

Japanese Patent Attorney

SOEI Patent & Law Firm, Tokyo

Email: kizu@soei-patent.co.jp