

Drafting Claims (and Their Specifications) That Will Be Infringed

Dale Lazar
Adjunct Professor
George Mason University
Antonin Scalia Law School

March 23, 2023

I. Minimize the Likelihood of Avoiding Literal Infringement

A. Draft the broadest claim the prior art allows

- Recite the feature that distinguishes over the prior art and then wrap the rest of the invention around the distinguishing feature in the broadest possible terms
- Consider the possibility of claiming a broader subcombination, including replacement and repair parts
- Eliminate unnecessary words

I. Minimize the Likelihood of Avoiding Literal Infringement

B. Start with the Target (point of novelty)

1. A copying machine comprising:
 - a photosensitive element having a surface of amorphous silicon;
 - an optical system disposed to create an image of an original on the photosensitive element; and
 - a transfer system disposed to transfer the image on the photosensitive element to a sheet.

I. Minimize the Likelihood of Avoiding Literal Infringement

2. A copy machine comprising:
 - a photosensitive element;
 - an optical system disposed to create a pattern of charges on the photosensitive element corresponding to original;
 - a developer disposed to apply toner to the photosensitive element to create a visible image on the photosensitive element, the developer including at least three rollers; and
 - a transfer system disposed to transfer the visible image to a sheet.

I. Minimize the Likelihood of Avoiding Literal Infringement

- C. Consider subcombinations, including replacement and repair parts
- 3. A photosensitive member comprising:
 - a base; and
 - a layer of amorphous silicon disposed on the base.
- 4. A developer comprising:
 - a container for holding toner;
 - a first roller;
 - a second roller; and
 - a third roller, the first, second and third rollers being disposed to transfer toner from the container.

I. Minimize the Likelihood of Avoiding Literal Infringement

- D. Consider Functional Language
- 1. Consider functional, e.g., “an effective amount” sort of language.
- 2. “An effective amount” is useful in chemical inventions.
- 3. Consider how the Federal Circuit has interpreted functional claim language.

Find the full text of this and thousands of other resources from leading experts in dozens of legal practice areas in the [UT Law CLE eLibrary \(utcle.org/elibrary\)](https://utcle.org/elibrary)

Title search: Drafting Claims That Will Be Infringed

Also available as part of the eCourse

[2023 Advanced Patent Law \(USPTO\) eConference](#)

First appeared as part of the conference materials for the

18th Annual Advanced Patent Law Institute session

"Drafting Claims That Will Be Infringed"