INVENTION ANALYSIS AND CLAIMING:
Dependent Claims and The Planned Retreat

BY RONALD SLUSKY

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Why *do* we write dependent claims?

The most important reason, of course, is that we never know what prior art may surface that will force a retreat from what we thought was the broad invention. If the broadest claims prove to be unpatentable (during prosecution) or invalid (after issuance) there will still be claims of intermediate and/or narrow scope to prosecute and/or assert.

This fundamental principle of patent practice seems, however, often not to be in the forefront of practitioner's minds when dependent claims are actually drafted. Witness the all-too-common appearance of essentially worthless claims such as

> 2. The invention of claim 1 wherein said personal computer is a desktop computer.

Even if prior art cited against claim 1 discloses the invention in the context of a laptop, rather than a desktop, it is difficult to conjure up a scenario that would save claim 2 from an obviousness rejection.

Dependent claims, then, should recite feature(s) of the embodiment(s that would at least appear to add something new and non-obvious to the subject matter of the claim(s) that they depend from. One or more such "fallback features" can serve as a hook for patentability if the broader claims prove to be unpatentable. Not that this is the whole story. A feature may be super- novel and non-obvious. But if competitors can devise marketable products without that feature, we may have won the battle (drafted an allowable/valid claim) but lost the war (no one will ever infringe it).

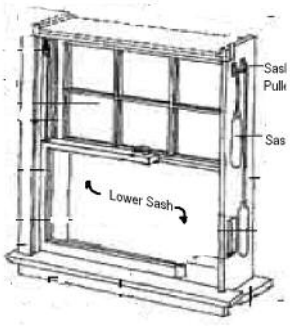
THE PLANNED RETREAT

The Planned Retreat is a powerful paradigm that addresses the dual concerns of patentability and "infringeability." It is a way of analyzing the inventor's disclosure to develop an *effective* array of successively restricted fallback positions to which we can retreat if newly identified prior art forces us to do so. Each successive stage of possible retreat—that is, each successively narrower claim—should fulfill two criteria:

1) Give up as little valuable intellectual property as possible, and

2) Establish a defensible position for what's left.

To "give up as little valuable intellectual property as possible" means preserving coverage for those features of the embodiment(s) that seem more likely than others to appear in competitors' marketplace offerings because, for example, a saleable product probably will not be able to do without them. For example, if the invention were to be the broad idea of the double-hung window (Fig. 1), a fallback, position meeting this criterion would be a means for counteracting the weight of the lower sash. We would anticipate that such a means (e.g., sash weights or springs) might well be an indispensable feature of any commer-cially viable double-hung window. Thus even if the double-hung window *per se* turned out to be in the prior art, we would still have a valuable claim, assuming that the later-surfacing double-hung-window prior art disclosed other, less-attractive ways of holding up the lower sash, such as a friction fit or a stick to prop the window open.



The second Planned Retreat criterion—"establish a defensible position for what's left"—means that the narrower invention definition we may have to retreat *to* should have some additional likelihood of being patentable over the position we are retreating *from*. It does little good to establish a position of retreat—no matter how likely it is that the market will demand it—if the invention is no more patentable with that feature than without it. Claim 2 above certainly meets the *first* Planned Retreat criterion, since a great deal of the marketplace would likely involve desktop computers. However, claim 2 does not meet the second criterion. It defines a position of retreat that is not defensible and, as such, will fall right along with its parent claim 1.

A powerful way of developing a Planned Retreat for a given invention is to use the problem-solution paradigm many practitioners already employ to identify the broad invention. Recall that the reason we have dependent claims in the first place is that what we thought was the broad invention may actually turn out to be in the prior art. What we should do, then, in developing and rank-ordering our fallback positions and developing the overall Planned Retreat, is actually assume that eventuality. That is, having claimed the invention at a particular level of breadth in a particular independent or dependent claim, we put the invention thus claimed into the prior art in our minds and analyze the embodiments on *that* basis, identifying such further problems as the embodiment(s) may solve. The embodiment feature(s) that solve those problem(s) are typically the most worthwhile fallback features.

This approach will be demonstrated in detail in the next article in this series in which we will identifiy fallback features, and develop a Planned Retreat, for the invention of chair, the assumed broad invention being the notion of elongated seat supports, or "legs". IPT