

# Dependent Claims

Dr. Shoichi Okuyama  
Okuyama & Sasajima  
Tokyo Japan

February 14, 2017  
Kuala Lumpur

# Starting point - independent claim

1. An apparatus, comprising:
  - a pencil; and
  - an eraser attached to the pencil.

# Dependent claims - examples

2. The apparatus of claim 1, further comprising a light attached to the pencil.

This is a shorthand for an independent claim which reads:

2. An apparatus, comprising:  
a pencil;  
an eraser attached to the pencil; and  
a light attached to the pencil.

# Examination

- The examiner is supposed to review the independent and dependent claims separately.
  - Even if claim 1 is not somehow patentable, claim 2 should be reviewed separately from claim 1 for patentability.
  - Assume the examiner rejects claim 1, but finds claim 2 allowable, the applicant has two basic options:
    - Delete claim 1 and rewrite claim 2 as a new claim 1 as above, or
    - Argue for the patentability of the rejected claim 1.
      - Possibly other amendments may be considered.
- Dependent claims form a readily available basis for future amendments during the examination.

# Types of dependency 1

3. The apparatus of claim 2, wherein the light is not attached to the pencil.

Is this acceptable?

# Types of dependency 2

3. The apparatus of claim 2, in which the eraser is replaced by a light.

Is this acceptable?

Not allowed generally, but allowed in Japan.

# Types of dependency 3

- Narrowing an element or feature by further characterizing the element or feature.
  - The apparatus of claim 1, wherein the pencil is red colored.
  - The apparatus of claim 1, wherein the eraser is round.
- Adding an additional element or feature taken from the spec.
  - The apparatus of claim 1, further comprising a light and a battery.
  - The apparatus of claim 1, wherein the apparatus is powered by an outside power source.

# Multiple dependent claims

3. The apparatus of claim 1 or 2, further comprising a pencil lead release bottom attached to the pencil.

What about this?

3. The apparatus of claims 1 and 2, further comprising a pencil lead release bottom attached to the pencil.

# Multiple dependent claims

What about this?

3. The apparatus of any of the preceding claims, further comprising a pencil lead release bottom attached to the pencil.

# Possible problems

- A multiply dependent claim (e.g. claim 3) may attract an additional fee and count as more than one claim (in this case, two).
- Fees may increase significantly in places like the U.S.

# Multiple-on-multiple dependent claims

Assume we have claim 4:

4. The apparatus of claim 1 or 2, further comprising a pencil lead release bottom attached to the pencil.

Is this acceptable?

5. The apparatus of claim 3 or 4, further comprising a battery for the light.

# Multiple-on-multiple dependent claims

- Allowed in some jurisdictions, but outright prohibited in other jurisdictions (most notably in the U.S.).

# Claim categories?

What about this?

6. A process of making the apparatus of claim 1, comprising the steps of:
  - attaching a piece of the eraser at one end of the pencil;
  - placing a cylindrical metal piece over the eraser and the one end of the pencil; and
  - applying forces from surrounding to squeeze the metal piece so as to fix the pencil and the eraser together.

# Claim categories?

OK, what about this?

6. A process of manufacturing the apparatus of claim 1.