

Claims Strategies in Patent Applications – Matching or Varied?

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Up to 20 claims, including three independent claims, are paid for in the standard filing fee for a US non-provisional patent application. Some clients prefer matching claims in the claim set, others prefer varied claims. What are the pros and cons of each?

Matching claims have identical or near-identical claim language across the independent claims and again across the dependent claims, and near identical scope. Varied claims have different words, phrasing, punctuation and/or scope. For example, a claim set could have a method for the first independent claim, a tangible, computer-readable media with instructions for a processor to perform a method as the second independent claim, and a system in which components perform actions of a method, as the third independent claim. Clearly, these claims have at least slightly different scope, as one is to a method, one is to a media and one is to a system. In a matching claim set, these three types of claims would have different preambles, and the bodies of the independent claims would have identical or near-identical claim language tailored to meet the preamble. In a varied claim set, different claim terms, nouns, verbs, adjectives, structures, connections among elements, actions, relationships among elements, etc., can be employed to capture various novel aspects.

Matching claim sets have the advantage that they may be relatively easier to prosecute, since the arguments need be made only once (e.g., for the first independent claim and the first of any dependent claims argued). Arguments for subsequent independent claims and dependent claims can just reference the earlier arguments. Amendments, similarly, need be crafted only once for the first independent claim and any dependent claims that depend from it, as needed, and then copied (or slightly modified) for the other two independent claims and respective dependent claims. This can save costs for a client, since it should take less time to write amendments and arguments.

Varied claim sets have the advantage that they cover more scope for the invention. They can also allow for exploration of different amendments, to see which one has better success during examination. For example, if one independent claim has allowed subject matter, and the other two don't, the strategy followed in the successful independent claim can be propagated to the other two independent claims. A varied claim set may have a (slightly) better chance of surviving legal challenge, with one branch of claims surviving, although claims often stand or fall together in the courts.

A varied claim set can get restricted during examination. This isn't necessarily good or bad, just something to be aware of. A restriction requirement, and the paperwork to elect an invention and select corresponding claims, followed by submitting additional claims to fill out the claim set again for examination, can add to costs and delays for a client.

Matching claim sets can be easier to handle for PCT (patent cooperation treaty) and foreign applications. It is easier to meet the unity requirement, and likely also easier to communicate across different languages, with a matching claim set. There are also licensing considerations, however licensing issues are beyond the scope of this article. Ultimately, with all the above considerations, it can also just come down to personal preference. Write them the way they want them. All part of the art of patenting.

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