



Patent Claim Drafting

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October 2019

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“The specification and claims of a patent, ... constitute one of the most difficult legal instruments to draw with accuracy”

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The specification and claims of a patent, particularly if the invention be at all complicated, constitute one of the most difficult legal instruments to draw with accuracy; and, in view of the fact that valuable inventions are often placed in the hands of inexperienced persons to prepare such specifications and claims, it is no matter of surprise that the latter frequently fail to describe with requisite certainty the exact invention of the patentee, and err either in claiming that which the patentee had not in fact invented, or in omitting some element which was a valuable or essential part of his actual invention.
Topliff v. Topliff, 145 U.S. 156, 12 S.Ct. 825, 36 L.Ed. 658

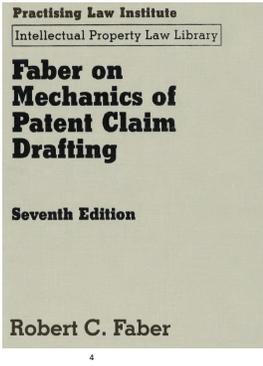
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INTRODUCTION

Use resources:



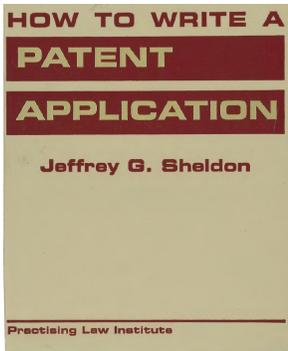
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INTRODUCTION

Use resources:



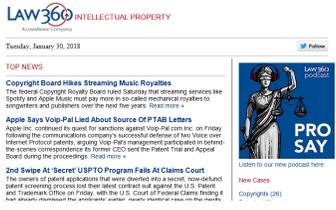
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INTRODUCTION

- Follow the law
 - IP Law 360: <https://www.law360.com/ip>



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INTRODUCTION

- Follow the law, cont'd
 - Blogs
 - PatentlyO: <https://patentlyo.com/>
 - IPWatchdog: <https://ipwatchdog.com/>

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35 U.S.C. § 101

- Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

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TYPES OF CLAIMS

- Apparatus, product, device, machine or system
- Method or process
 - Method of manufacture
 - Method of use
- Chemical composition
- Product by process

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CLAIMS

- The claims follow the specification
- Claims are introduced by
 - Claims:
 - What is claimed is:
 - I/We claim:
 - The invention claimed is:
- Claims are separately numbered
- Each claim begins with a capital letter and ends with a period
- A claim begins with the article “A” or “An”

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CLAIMS

- Independent claims
 - 1. A pencil comprising parts A and B.
- Dependent claims
 - 2. A pencil according to claim 1 further comprising part C.

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BEFORE YOU START WRITING

1. What is the invention?
2. What are the pieces and parts that make up that invention?
3. How do the pieces and parts relate to one another?
4. Do you have more than one invention?
5. Are there multiple versions of each invention?

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INCLUDE THE HOOK



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STOEL RIVES

STRUCTURE OF A TYPICAL CLAIM

- Preamble (A system . . .)
- Transitional phrase (comprising)
- Elements/steps (A, B and C)

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PREAMBLE

- Define a broad statutory class:
 - A process for producing salt . . .
 - A system for . . .
 - A method of . . .
 - A composition . . .
 - A data input system . . .
 - A circuit . . .

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PREAMBLE, CONT'D

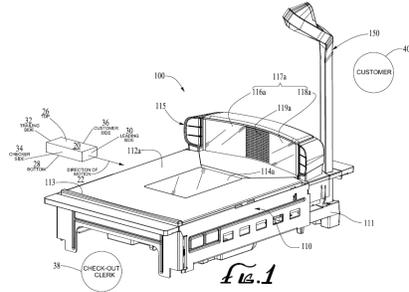
- Specific terminology
 - A catheter . . .
 - A timing device . . .
 - A folding door system . . .
 - A method of reading a barcode on an item . . .
 - An automobile frame . . . (narrow?)
 - A vehicle frame . . . (broader?)

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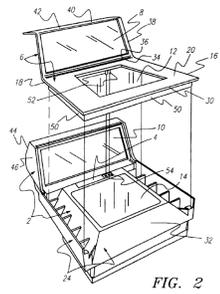
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EXAMPLE DISCLOSURE: A SCANNER-SCALE WITH A TWO-PLANE WEIGH PLATTER FOR RETAIL CHECKOUT COUNTER



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THE INVENTION DISCLOSURE



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PREAMBLE, CONT'D

- A barcode scanner
- An optical code reader
- A data reader
- A multi-plane optical reader
- A system for reading an optical code on an item being passed through a read zone
- A weigh platter
- A method of reading optical codes
- A method of weighing items on a scanner-scale

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PREAMBLE, CONT'D

Jepson Claim

- In a multi-plane optical reader having a first scan window oriented in a generally horizontal plane, a second scan window oriented transversely to and adjacent to the first scan window, and a weighing device, an improved weigh platter for supporting an object being weighed, comprising

Remember: use of Jepson format will normally be taken as an admission that those elements in the preamble are **prior art** against the claimed invention.

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PREAMBLE AS LIMITATION

- Preamble as claim limitation: Precedent is split as to whether preambles limit the claims – the general rule is that the preamble is a limitation if it “breathes life and meaning into the claim” (MPEP §2111.02), and is not a limitation if it “simply states the intended use or purpose of the invention.”

C.R. Bard, Inc. v. M3 Systems, Inc., 157 F.3d 1340 (Fed. Cir. 1998)

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PREAMBLE AS LIMITATION, CONT'D

- *Catalina Mktg. Int'l*, 289 F.3d 801, 808-09 (Fed. Cir. 2002) (“[C]lear reliance on the preamble during prosecution to distinguish the claimed invention from the prior art transforms the preamble into a claim limitation because such reliance indicates use of the preamble to define, in part, the claimed invention.... Without such reliance, however, a preamble generally is not limiting when the claim body describes a structurally complete invention such that deletion of the preamble phrase does not affect the structure or steps of the claimed invention.”)

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PREAMBLE AS LIMITATION

- Put another way:
 - The preamble is not limiting unless, upon review of the entire patent, the preamble recites essential structure or steps of the invention.
 - The preamble is not limiting if the claim body, standing alone, describes a "structurally complete system."

Georgetown Rail Equipment Co. v. Holland L.P. (Fed. Cir. 2017).

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REASONS FOR DIFFERENT PREAMBLES:

- A multi-plane optical reader comprising:
 - a lower housing portion with a horizontal window;
 - a first upper housing portion with a first vertical window positioned above and to one side of the lower housing portion;
 - a weigh platter comprising . . .

So to infringe this claim, an accused must make/use each of these components, including the reader housing portions.

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REASONS FOR DIFFERENT PREAMBLES:

- A weigh platter for an optical reader, the optical reader having a horizontal surface and a vertical scan window disposed to one side of the horizontal surface, said weigh platter comprising

In this claim, only the weigh platter need to be made for an accused infringer to infringe the claim.

Note: this claim will have a smaller royalty basis because it is directed only to the weigh platter.

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REASONS FOR DIFFERENT PREAMBLES:

- Types of infringement
 - Direct infringement - if all the components are made (used, imported) by the same entity
 - If not, indirect infringement
 - Contributory or inducing infringement
 - » Potentially the direct infringer is the customer
 - » Divided infringement – particularly in method claims, the steps of a method may be divided between the maker/supplier and the user/customer
- As you write the claims, think about who is the infringer

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TRANSITIONAL PHRASES

- Comprising
 - Comprising the steps of
- Including
- Having
- With
- Consisting of
- Consisting essentially of

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TRANSITIONAL PHRASES

- Consisting of
 - Most narrow, typically in chemical and composition claims, means “consisting only of” and excludes any element, step, or ingredient not specified in the claim; Including the following elements, no more, no less
- Consisting essentially of
 - Still narrow, but broader than just “consisting of” but still limits the scope of a claim to the specified materials or steps “and those that do not materially affect the basic and novel characteristic(s)” of the claimed invention.

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TRANSITIONAL PHRASES, CONT'D

- Comprising
 - Broadly interpreted as “including but not limited to the following elements” (open-ended)
- Comprising the steps of:
 - “including but not limited to the following steps”
- Including
 - Most practitioners think that “including” means the same as “comprising” but there is some case law arguably saying that “including” is narrower Toro Co. v. White, 199 F.3d 1295 (Fed. Cir. 1999)

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TRANSITIONAL PHRASES, CONT'D

- With and Having
 - more typically used within a claim phrase to further define an element:
 - “a top section with a smooth surface”
 - “a lower housing having a central opening”
- When in doubt: just use “comprising”

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CLAIM BODY

- The body of the claim recites the elements of the claim and describes how they cooperate structurally, physically or functionally to form an operative invention.

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BODY OF CLAIM: ELEMENTS

- Recite the minimum number of elements
- Do not modify or qualify the elements any more than is needed
- Broaden generic terminology as much as possible
- Typically, you need to specify some sort of connection as between the elements
 - By function
 - By relationship
 - By connection
 - By interconnection/communication
 - Assembled as a kit for . . .

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CLAIMING METHODS, CONT'D INTRODUCING AN ELEMENT

- Meaning of "A"
 - e.g., A barcode scanner comprising a housing;
 - a light source disposed in said housing . . .
- The indefinite article "a" typically means "one or more" in open-ended claims containing the transitional phrase 'comprising'. *Baldwin Graphic Sys., Inc. v. Siebert, Inc.*, 512 F.3d 1338, 1342 (Fed. Cir. 2008). In *Baldwin*, the claim recited a system comprising "a pre-soaked fabric roll" and a "means for locating said fabric roll" the court concluded that the claim encompassed systems with more than one fabric roll.
- However, *Harari v. Lee* 656 F.3d 1331 (Fed. Cir. 2011) ruled that *Baldwin* does not set a hard and fast rule that "a" always means one or more than one. Instead, the limitation is read in light of the claim and specification to discern its meaning, citing *Insituform Techs., Inc. v. Cat Contracting, Inc.*, 99 F.3d 1098, 1105-06 (Fed. Cir. 1996) (analyzing the "claims, specification and file history" to determine that "a vacuum cup" means one and only one vacuum cup). When the claim language and specification indicate that "a" means "one and only one", it is appropriate to construe it as such even in the context of an open-ended "comprising" claim.

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INTRODUCING A CLAIM ELEMENT

What is the meaning? One or more than one?

Claiming options:

- a light source
- at least one light source
- one or more light sources
- a first light source (potentially infers that there may be a second light source)

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INTRODUCING A CLAIM ELEMENT

Make sure that the phrase “a light source” means “one or more light sources”

- Include in the specification an embodiment wherein “the light source” may comprise “one or more” light sources.
- Confirm multiplicity via a dependent claim, such as “wherein the light source comprises a first LED light and a second LED light”

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**INTRODUCING A CLAIM ELEMENT, CONT'D
PLURAL ELEMENTS**

- a plurality of light sources
- at least two light sources
- a first light source and a second light source
- a plurality of light sources including at least a first light source and a second light source

wherein the first light source and the second light source are disposed in the housing

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ANTECEDENT BASIS

- Subsequent referral to an element previously introduced must be referred to by “the” or “said”
- A claim is indefinite when it contains words or phrases whose meaning is unclear. *In re Packard*, 751 F.3d 1307, 1314, 110 USPQ2d 1785, 1789 (Fed. Cir. 2014).

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MEANS PLUS FUNCTION CLAIMS

- Authorized by Section 112(f) or sixth paragraph: An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

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MEANS PLUS FUNCTION CLAIMS

- Examples:
 - means for hanging a painting on a wall
 - means for fastening
 - means for connecting

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MEANS PLUS FUNCTION, CONT'D

- E.g., rather than claiming a nail or a screw, the claim element may be defined as a “means for fastening,” which would be limited to the corresponding fasteners/structures disclosed in the specification (such as, nails, screws, staples, and glue) and equivalents thereof.
- Remember, absent this corresponding structure, material, or acts for performing the claimed function in the specification, the claim will be invalid for indefiniteness under 35 U.S.C. § 112(b).

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MEANS PLUS FUNCTION, CONT'D

- Remember, even in the means plus function format, the term used may still be limiting:
 - See, Slimfold Manuf., 932 F.2d 1453 (Fed. Cir. 1991) where the claim term “latch means . . . for releasable retaining” was found not to include a wedge: “As its name implies, the latching means latches, i.e., grabs onto the head portion of the pivot rod.”

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MEANS PLUS FUNCTION CLAIMS

- Alternative claiming
 - means for hanging a painting on a wall
 - wall hanger
 - means for fastening
 - a fastener
 - means for connecting
 - a connector

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MEANS PLUS FUNCTION

- Don't rely solely on means plus function claims.
- They have their place, for example, a means plus function claim can be prepared to track a method claim (and probably avoid restriction).

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CONVERTING A METHOD CLAIM INTO AN APPARATUS CLAIM

- A method for manufacturing a shoe, comprising
 - retaining a shoe in a selected position;
 - placing a shoe upper on top of the shoe sole;
 - sewing the shoe upper to the shoe sole.
- A system for manufacturing shoes, comprising
 - means for retaining a shoe in a selected position;
 - means for placing a shoe upper on top of the shoe sole;
 - means for sewing the shoe upper to the shoe sole.

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MEANS PLUS FUNCTION

- Examiners will apply 35 U.S.C. 112(f) or pre-AIA 35 U.S.C. 112, sixth paragraph to a claim limitation if it meets the following 3-prong analysis:
 - (A) the claim limitation uses the term "means" or "step" or a term used as a substitute for "means" that is a generic placeholder (also called a nonce term or a non-structural term having no specific structural meaning) for performing the claimed function;
 - (B) the term "means" or "step" or the generic placeholder is modified by functional language, typically, but not always linked by the transition word "for" (e.g., "means for") or another linking word or phrase, such as "configured to" or "so that"; and
 - (C) the term "means" or "step" or the generic placeholder is not modified by sufficient structure, material, or acts for performing the claimed function.
- MPEP 2181

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NONCE WORDS

- mechanism for
- module for
- device for
- unit for
- component for
- element for
- member for
- apparatus for
- machine for
- system for

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SUPPORT FOR THE CLAIM – IN THE DRAWINGS AND SPECIFICATION

- Section 112 – The specification shall contain a written description of the invention . . . to enable any person skilled in the art . . . to make and use the same, and shall set forth the best mode contemplated by the inventor or joint inventor of carrying out the invention.
- 37 CFR 1.83(a) The drawing in a nonprovisional application must show every feature of the invention specified in the claims.

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CLAIMING STRATEGIES – ALTERNATE EXPRESSIONS

- Alternate expressions (e.g., use of “or”) is not *per se* indefinite as long as there is no ambiguity
- Generally, the PTO tends to object to the use of alternative language “or” as indefinite
- Accepted practice is the Markush claim format:
 - wherein the illumination source is selected from the group consisting of: LEDs, incandescent, halogen, fluorescent, and combinations thereof.
- Markush claims are very useful as dependent claims to broadly define term in the independent claim.

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Questions?
