

# PATENT LAW

Randy Canis

CLASS 7

**The Patent Specification pt. 1;  
Claims pt. 1**

## The Patent Specification pt.

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## The Patent Specification

- What must the specification describe?

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## Patent Specification Requirements

35 U.S.C. §112 requires that the Specification of a patent application must contain:

- (A) A written description of the invention;
- (B) The manner and process of making and using the invention (the enablement requirement); and
- (C) The best mode contemplated by the inventor of carrying out the invention.

M.P.E.P. 2161

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## §112 - Specification

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention. The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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## Enablement

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## Enablement Requirement

- The specification must teach someone of skill in the art (1) how to make and (2) how to use the invention without undue experimentation.
- MPEP 2164

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## Enablement

- Enablement = how to make and use the invention
- §112 ¶1 ... “requires both that the applicant disclose ‘how to make’ and ‘how to use’ the claimed invention, as well as that the specification must include a ‘written description’ of the invention.
- “As the essential bargain for the exclusive right of the patent, the patentee must teach the public how the invention works: the patent instrument itself must ‘enable’ other skilled artisans to practice the disclosed technology.”
- Purpose = ensure adequate disclosure

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## Enablement

- Enablement is for claimed subject matter
- What if a claim is not supported by the specification?

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## Gould v. Hellwarth

- “It is not questioned that the disclosure of the Q-switching feature would be adequate if the application disclosed an operable laser in which the feature could be incorporated.”

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## Undue Experimentation

- “Factors to be considered in determining whether a disclosure would require undue experimentation have been summarized by the board. The include (1) the quantity of experimentation necessary, (2) the amount of direction or guidance presented, (3) the presence or absence of working examples, (4) the nature of the invention, (5) the state of the prior art, (6) the relative skill of those in the art, (7) the predictability or unpredictability of the art, and (8) the breadth of the claims.”

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## Deposit Requirement

- “Some inventions cannot be enabled by a written explanation. The way to enable such inventions is to provide a sample. Major patent offices therefore adopted a procedure whereby inventors of novel microorganisms could fulfill statutory enablement requirements by depositing a sample of the microorganism in a facility open to the public.”

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## Atlas Powder Co. v. E.I. Du Pont De Nemours & Co.

- Amount of Experimentation Required
  - “That some experimentation is necessary does not preclude enablement; the amount of experimentation, must not be unduly extensive. Determining enablement is a question of law.”

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Must be Enabled at the Time of Filing

- “To overcome a *prima facie* case of lack of enablement, applicant must demonstrate by argument and/or evidence that the disclosure, as filed, would have enabled the claimed invention for one skilled in the art at the time of filing.”
- MPEP 2146.05

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Unpredictable Arts

- Chemistry and Biotechnology
- Patent specifications within the unpredictable arts must show with reasonable specificity how to practice the invention across the entire scope of the claim.

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In re Wright

- “[T]he PTO set forth a reasonable basis for finding that scope of the appealed claims is not enabled by the general description and the single working example in the specification.”
- Burden shifted to Wright
- Wright failed to meet the burden

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## ALZA Corp. v. Andrx Pharmaceuticals LLC

- Case History
- D.C. of Delaware found 6,919,373 nonobvious but asserted claim was not infringed and invalid for lack of enablement.
- Panel Fed. Cir. of Dyk, Schall, and Prost
  - Affirmed invalid for lack of enablement

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## ALZA Corp. v. Andrx Pharmaceuticals LLC

- Invention
- Patent on a drug treatment for attention deficit and hyperactivity disorder
- ALZA determined that MPH plasma concentrations that had ascending patterns provided greater efficacy for treating ADHD than concentrations that were constant.

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## ALZA Corp. v. Andrx Pharmaceuticals LLC

- Claim 1
- A method for treating ADD or ADHD comprising administering a dosage form comprising methylphenidate that provides a release of methylphenidate at an ascending release rate over an extended period of time.

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### ALZA Corp. v. Andrx Pharmaceuticals LLC

- [C]laim construction adopted by the district court requires the enablement of both osmotic and non-osmotic dosage forms and they also agree that osmotic dosage forms are enabled.
- Does the specification enable a person of ordinary skill in the art to create non-osmotic oral dosage forms without undue experimentation?

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### ALZA Corp. v. Andrx Pharmaceuticals LLC

- Specification
  - Focuses on how osmotic systems can be adapted to create an ascending release dosage form to treat ADHD.
  - Mentions non-osmotic dosage forms.
- Andrx's attempted to limit the scope of the claim to osmotic dosage forms

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### ALZA Corp. v. Andrx Pharmaceuticals LLC

- District Court
  - Asserted claims are invalid for lack of enablement because the specification does not enable the full scope of claim 1, which covers both osmotic and non-osmotic dosage forms.
  - Claim 1 invalid for lack of enablement

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### ALZA Corp. v. Andrx Pharmaceuticals LLC

- Issue on Fed. Circ.
  - Specification would have enabled a person of ordinary skill in the art to create non-osmotic oral dosage forms—namely, tablets and capsules—with ascending release rates without undue experimentation at the time of filing.

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### ALZA Corp. v. Andrx Pharmaceuticals LLC

- “Whether undue experimentation would have been required to make and use an invention, and thus whether a disclosure is enabling under 35 U.S.C. § 112, ¶ 1, is a question of law that we review de novo, based on underlying factual inquiries that we review for clear error.”

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### ALZA Corp. v. Andrx Pharmaceuticals LLC

- “Because patents are presumed valid, lack of enablement must be proven by clear and convincing evidence.”
- A reasonable amount of experimentation is ok, but it can’t be undue.
- “[T]he rule that a specification need not disclose what is well known in the art is ‘merely a rule of supplementation, not a substitute for a basic enabling disclosure.’”

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### ALZA Corp. v. Andrx Pharmaceuticals LLC

- “[W]hen there is no disclosure of any specific starting material or of any of the condition under which a process can be carried out, undue experimentation is required.”
- “Patent protection is granted in return for an enabling disclosure of an invention, not for vague intimations of general ideas that may or may not be workable.”

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### ALZA Corp. v. Andrx Pharmaceuticals LLC

- “ALZA successfully argued to the district court that the claims encompassed both osmotic and non-osmotic dosage forms. However, ALZA’s patent specification does not enable the full scope of the claims, namely non-osmotic oral dosage forms with ascending release rates.”
- “We conclude that the asserted claims are invalid for lack of enablement under 35 U.S.C. § 112, ¶ 1.”

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### Magsil Corp. and MIT v. Hitachi

- Case History
- D.C. Delaware
  - Summary judgment that the claims are invalid for lack of enablement
- Panel Fed. Cir. of Rader, O’Malley, and Reyna
  - Affirmed

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## Magsil Corp. and MIT v. Hitachi

- Invention
  - read-write sensors for computer hard disk drive storage systems

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## Magsil Corp. and MIT v. Hitachi

### Claim 1

1. A device forming a junction having a resistance comprising:
  - a first electrode having a first magnetization direction,
  - a second electrode having a second magnetization direction, and
  - an electrical insulator between the first and second electrodes, wherein applying a small magnitude of electromagnetic energy to the junction reverses at least one of the magnetization directions and causes a **change in the resistance by at least 10% at room temperature.**

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## Magsil Corp. and MIT v. Hitachi

- “Enablement is a question of law based on underlying factual findings. ... A party must prove invalidity based on non-enablement by clear and convincing evidence.”
- Enablement
  - Ensures adequate disclosure of the claimed invention
  - Prevents claims broader than the disclosed invention

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Magsil Corp. and MIT v. Hitachi

- “The scope of the claims must be less than or equal to the scope of the enablement to ensure that the public knowledge is enriched by the patent specification to a degree at least commensurate with the scope of the claims.”

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Magsil Corp. and MIT v. Hitachi

- “[T]he specification at the time of filing must teach one of ordinary skill in the art to fully perform this method across that entire scope.”

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Magsil Corp. and MIT v. Hitachi

- “[T]his field of art has advanced vastly after the filing of the claimed invention. The specification containing these broad claims, however, does not contain sufficient disclosure to present even a remote possibility that an ordinarily skilled artisan could have achieved the modern dimensions of this art. Thus, the specification enabled a marginal advance over the prior art, but did not enable at the time of filing a tunnel junction of resistive changes reaching even up to 20%, let alone the more recent achievements above 600%.”

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### Magsil Corp. and MIT v. Hitachi

- “The asserted claims of the '922 patent cover resistive changes from 10% up to infinity, while the '922 patent specification only discloses enough information to achieve an 11.8% resistive change. ... Yet, the claims covered changes far above 20% or 100% even when the inventors could not explain any way to achieve these levels. As MagSil's expert Dr. Murdock testified, since 1995 when the specification was filed, resistive changes now stretch up to above 600%.”

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### Magsil Corp. and MIT v. Hitachi

- “The '922 patent specification only enables an ordinarily skilled artisan to achieve a small subset of the claimed range. The record contains no showing that the knowledge of that artisan would permit, at the time of filing, achievement of the modern values above 600% without undue experimentation, indeed without the nearly twelve years of experimentation necessary to actually reach those values. The enablement doctrine's prevention of over broad claims ensures that the patent system pre-serves necessary incentives for follow-on or improvement inventions.”

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### Enablement Points

- Make sure to include at least some dependent claims (or, preferably, an independent claim) with a range that is clearly within the grasp of the specification
- If you are going to include a more expansive range, include details in the specification on how such a range could be achieved

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## Claims pt. 1

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## United States Peripheral Claiming Technique

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## Claims

- Claims define “the invention” described in a patent or patent application
- Example:

A method of electronically distributing a class via distance education comprising:  
initiating a class session for a plurality of students on a server;  
receiving a plurality of sign-in requests for the class session, a particular sign-in request of the plurality of sign-in requests associated with a particular student of the plurality of students and received from a particular computing device associated with the particular user; and  
broadcasting video for the class session from the server to a plurality of computing devices, the plurality of computing devices including the particular computing device.

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## Claim Contribution and Meaning

- "Claims should reflect a careful analysis of the inventor's contribution to the technical arts, as well as a foresighted prediction of how others might employ the invention and what prior art, not yet known, might exist.
- Definiteness Requirement - each claim should have a well-defined meaning for those of skill in the art.

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## §112 – Statutory Basis

[2] The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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## §112 – Statutory Basis

[3] A claim may be written in independent or, if the nature of the case admits, in dependent or multiple dependent form.

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## §112 – Statutory Basis

[4] Subject to the following paragraph, a claim in dependent form shall contain a reference to a claim previously set forth and then specify a further limitation of the subject matter claimed. A claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers.

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## §112 – Statutory Basis

[5] A claim in multiple dependent form shall contain a reference, in the alternative only, to more than one claim previously set forth and then specify a further limitation of the subject matter claimed. A multiple dependent claim shall not serve as a basis for any other multiple dependent claim. A multiple dependent claim shall be construed to incorporate by reference all the limitations of the particular claim in relation to which it is being considered.

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## §112 – Statutory Basis

[6] 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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## Ex Parte Fressola

- BPAI 1993
- Case History
  - Appeal from Examiner's final rejection
  - BPAI
    - The Board affirmed the examiner's final rejection of claim 42 that claim 42 is indefinite and fails to particularly point out and distinctly claim what applicant regards as his invention as required by Section 112 ¶ 2.

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## Ex Parte Fressola

- Invention
  - “[A] method and system of producing stereographic images of celestial objects which use distance information to offset one of two images produced on a display device.”

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## Ex Parte Fressola

- 42. A system for the display of stereographic three-dimensional images of celestial objects **as disclosed in the specification and drawings herein.**

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## Ex Parte Fressola

- “The claims measure the scope of the protected patent right and ‘must comply accurately and precisely with the statutory requirements.’”
- “Claims in utility applications that define the invention entirely by reference to the specification and/or drawings, so-called “omnibus” or “formal” claims, while perhaps once accepted in American patent practice, are properly rejected under Section 112 ¶ 2 as failing to particularly point out and distinctly claim the invention.”

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## Ex Parte Fressola

- “Modern claim practice requires that the claims stand alone to define the invention. Incorporation into the claims by express reference to the specification and/or drawings is not permitted except in very limited circumstances.”
- “Modern claim interpretation requires that the claims particularly point out and distinctly claim the invention without reading in limitations from the specification.”

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## Ex Parte Fressola

- “The conversion from the central definition to the peripheral definition was due to the more rigorous requirements for the claim to stand alone to define the invention and the refusal of the courts to expand the scope of the claims beyond their literal terms. ... Modern claim interpretation requires that the claims particularly point out and distinctly claim the invention without reading in limitations from the specification.”

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## Ex Parte Fressola

- “The mere reference to the body of the specification by the terms ‘substantially in the manner described’ is not ‘particularly pointing out and ‘distinctly’ claiming the alleged invention, and therefore does not comply with the requirements of the statute.”
- “The description includes large quantities of extraneous matter ... which obscures the ... claim boundaries...”

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## Ex Parte Fressola

- “... [An] omnibus claim does not satisfy Section 112 ¶ 2 because the claim does not itself define the invention, but relies on external material.”

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## Additional Notes on Claims

- “... [C]laims are to be read in light of the specification.”
- “... a patent claim [must] be composed as a single English sentence.”
- “... the narrower the claim, the greater the likelihood that such a claim will withstand a defense of invalidity.”
- “... the patentee also wants the broadest claim possible in order to have the possibility of reaching as many competitors as possible.”

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## Patent Claim Format

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## Elemental Claim Structure

Three basic parts of a claim:

- 1) A preamble
- 2) A transition phrase
- 3) A body

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## The Preamble

- “Immediately stated at the beginning of the claim is the object of the sentence, e.g., ‘*A method of making coffee ...*’ The introduction (‘preamble’) may or may not constitute a limitation to the scope of the claim.”  
“... a preamble is a limitation if it gives ‘meaning to the claim’ ...”

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Catalina Marketing International v.  
CoolSavings.com, Inc.

Case History

- N.D. IL
  - No infringement of claims 1 and 25
- Panel Fed. Circ. 2002 of Mayer, Rader, and Prost
  - Decision affirmed-in-part, reversed-in-part, vacated-in-part, and remanded

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Catalina Marketing International v.  
CoolSavings.com, Inc.

- Invention
  - Distribution system for discount coupons

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Catalina Marketing International v.  
CoolSavings.com, Inc.

- What is the accused infringer doing?
  - Web-based coupon system to monitor and control the distribution of coupons from its website
  - Users browse the website for coupons
  - Users select and print coupons for in-store redemption

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Catalina Marketing International v.  
CoolSavings.com, Inc.

- 1. A system [sic] for controlling the selection and dispensing of product coupons at a plurality of remote terminals located at predesignated sites such as consumer stores wherein each terminal comprises:
  - activation means for activating such terminal for consumer transactions;
  - display means operatively connected with said activation means for displaying a plurality of coupons available for selection;
  - selection means operatively connected with said display means provided to permit selection of a desired displayed coupon by the consumer;
  - print means operatively connected with said selection means for printing and dispensing the coupon selected by the consumer; and
  - control means operatively connected with said display means for monitoring each consumer transaction and for controlling said display means to prevent the display of coupons having exceeded prescribed coupon limits.

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Catalina Marketing International v.  
CoolSavings.com, Inc.

- "Catalina sued Coolsavings, alleging that Coolsavings' web-based coupon system infringed the '041 patent. The district court construed the claim language 'located at predesignated sites such as consumer stores,' and held that Coolsavings did not infringe, either literally or by equivalents, the construed language. After determining that Coolsavings did not infringe under the doctrine of equivalents, the district court then alternatively held that prosecution history estoppel barred Catalina from seeking equivalents on the location of the terminals."

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Catalina Marketing International v.  
CoolSavings.com, Inc.

"Whether to treat a preamble as a limitation is a determination 'resolved only on review of the entire[] ... patent to gain an understanding of what the inventors actually invented and intended to encompass by the claim.' ...

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Catalina Marketing International v.  
CoolSavings.com, Inc.

“In general, a preamble limits the invention if it recites essential structure or steps, or if it is ‘necessary to give life, meaning, and vitality’ to the claim. ... Conversely, a preamble is not limiting ‘where a patentee defines a structurally complete invention in the claim body and uses the preamble only to state a purpose or intended use for the invention.’”

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Catalina Marketing International v.  
CoolSavings.com, Inc.

- Indications that the preamble may limit claim scope
  - Jepson preamble
  - “... dependence on a particular disputed preamble phrase for antecedent basis...”
  - “... when reciting additional structure or steps underscored as important by the specification”
  - “clear reliance on the preamble during prosecution to distinguish the claimed invention from the prior art...”

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Catalina Marketing International v.  
CoolSavings.com, Inc.

- Indications that the preamble may not limit the claim scope
  - Claim body describes a structurally complete invention
  - Preamble extols benefits or features (unless reliance on those features as being patentably significant and/or to distinguish prior art)
  - Describes use of the invention

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Catalina Marketing International v.  
CoolSavings.com, Inc.

- “Because the district court erroneously relied on non-limiting language in the preamble of Claim 1, this court vacates the district court’s judgment of non-infringement of Claim 1, both literally and by equivalents, to give the district court the opportunity to construe the limitations of Claim 1.”

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Current Preamble Practice

- Many companies now do not wish to include extraneous words in the preamble for fear of having the preamble being used to limit the invention.
- For example:
  - An apparatus comprising:
  - A method comprising:
  - A system comprising:

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Computerized Method

- Will a patent claim directed to a computerized method be infringed if one of the steps, under a specific condition described in the claim, is performed manually?

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## The Transition

- A claim normally has one or more elements or steps which follow the introductory object and any function prepositional statement. Joining these elements is a transition phrase which [ ] tells the reader that the claim is “open” or “closed” to additional elements”

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## The Open Transition

“The Open Transition (‘comprising’):  
The use of the term ‘comprising’ captures technologies with all the elements described in the body of the claim; whether the technology has additional elements is irrelevant. Thus, if a claim recites elements ‘A’ and ‘B’, a device with ‘A’, ‘B’ and others is an infringement.”

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## The Open Transition

An apparatus comprising:

A;

B; and

C

• Does:

– A, B, & C infringe?

– B, C, & D infringe?

– A', B, & C infringe?

– A, B, C, & D infringe?

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## The Closed Transition

“The Closed Transition (‘consisting of’): In contrast, a claim which employs the term ‘consisting of’ is ‘closed’ to additional ingredients. Infringement can occur only when the accused technology has exactly the same elements recited in the claim-no more or no less.”

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## The Closed Transition

A method consisting of:

A;

B; and

C

• Does:

– A, B, & C infringe?

– B, C, & D infringe?

– A', B, & C infringe?

– A, B, C, & D infringe?

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## The Hybrid Transition

“The Hybrid Transition (‘consisting essentially of’): ... This terminology renders the claim “open” to include additional elements that do not materially affect the basic and novel characteristics of the claimed combination.”

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## The Hybrid Transition

A composition of matter consisting essentially of:

A;

B; and

C

• Does:

- A, B, & C infringe?
- B, C, & D infringe?
- A', B, & C infringe?
- A, B, C, & D infringe?

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## The Body

### Relation of Elements

- “The body of the claim provides the elements of the invention, as well as how these elements cooperate either structurally or functionally.”
- “The drafter should also indicate how [each] element interacts with the [other elements] to form an operative technology ...”

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## The Body

### Element Introduction

- “Elements of an invention are ordinarily introduced with indefinite article, such as ‘a’ or ‘an,’ as well as terms such as ‘one,’ ‘several,’ or ‘a plurality of.’ When that element is noted later in the claim, claims drafters ordinarily employ the definite article ‘the’ or the term ‘said.’”
- “If an element appearing for the first time is accompanied by ‘the’ or ‘said,’ then it will ordinarily be rejected by an examiner as lacking so-called ‘antecedent basis.’”

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## The Body

### Element Introduction Example

- An apparatus comprising:
  - a first module to receive a video signal from a source;
  - a second module to access the video signal from the first module and encode transitioning data into one or more frames of the video signal; and
  - a third module to broadcast the video to the plurality of display devices.
- What's wrong with this claim?

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## Listing Elements Separately

- What is the implication if elements in the body of a claim are listed separately?

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## Dependent Claims

- "Section 112, paragraphs 3-5 allow the use of so-called 'dependent' patent claims. The statute mandates that dependent claims recite an earlier claim and provide additional limitations."
- "a patentee is free to be his or her own lexicographer..."

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## Dependent Claim Examples

- The method of claim 5, further comprising: selecting a personal digital assistant (PDA) as the hand-held device.
- The apparatus of claim 3, wherein the processor is further configured to receive the video signal from a signal source.
- The system of claim 1, further comprising: an output device for providing at least one of an audio signal or a video signal to a hand-held device.

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## Accent Packaging v. Leggett & Platt

### Case History

- D.C. For S.D. of Texas
  - Claims 1-5 of 7,373,877 and claims 1, 3, 4, 7, and 10-14 of U.S. Patent No. 7,412,992 not infringed
- Panel Fed. Cir. 2013 of Rader, Prost, and Reyna
  - Reversed grant of summary judgment with claims 1-4 of '877 patent and remand for summary judgment for Accent
  - Affirm grant of summary judgment with claim 5 of '877 patent and all asserted claims of '992 patent

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## Accent Packaging v. Leggett & Platt

- Invention
  - “a wire tier device that is used to bale recyclables or solid waste for easier handling”

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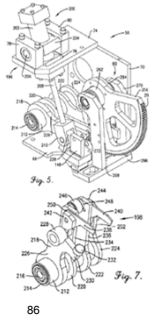
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### Accent Packaging v. Leggett & Platt



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### Accent Packaging v. Leggett & Platt

- Claim 1 of '877 patent
- In a knotting device including a knotting assembly having a gripper for selectively gripping one of two adjacent wire sections, a rotatable knotter operable to twist-knot the two adjacent wire sections, a cutting element for cutting of the other of said adjacent wire sections after twist-knotting of the sections and a shiftable cover located adjacent said knotter for maintaining the wire sections within the knotter during feeding said twist-knotting and thereafter movable to a wire-clearing position permitting passage of the twist-knotted wire sections from the knotter, the improvement which comprises an operator assembly for timed operation of said gripper, knotter, cutting element and cover, and a single drive assembly coupled with said operator assembly for effecting said timed operation,

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### Accent Packaging v. Leggett & Platt

- *said operator assembly including a pivotal shaft assembly and elongated operator bodies, with each of the operator bodies being operably coupled with a respective one of said gripper, knotter, cutting element and cover so as to supply driving power from the single drive assembly thereto,*
- *each of said operator bodies projecting radially from and being fixed to the shaft assembly such that rotational movement of the shaft assembly causes the operator bodies to swing about a shaft axis,*
- *said shaft assembly effecting said timed operation by rotating in a single direction about the shaft axis,*
- *each of said operator bodies including an interacting element associated therewith,*
- *each of said interacting elements being drivingly connected to a respective one of the gripper, knotter, cutting element, and cover wherein swinging of the operator bodies in the single direction effects said timed operation.*

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### Accent Packaging v. Leggett & Platt

- Claim 1 of '992 patent
- In a knotting device including a rotatable knotter operable to twist-knot a pair of adjacent wire sections, and a cover located adjacent said knotter in a wire-maintaining position for maintaining the wire sections within the knotter during feeding and knotting operations, the improvement which comprises a *mount for said cover permitting the cover to be pivoted away from said knotter to a knotter access position remote from said wire-maintaining position and though a pivot arc of at least about 90°*.
- said cover being pivotal relative to the knotter to open from the wire-maintaining position to a wire-clearing position, with the cover permitting passage of the twist-knotted wire sections from the knotter when in the wire-clearing position,
- said cover being further pivotal relative to the knotter to open beyond the wire-clearing position to the knotter access position.

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### Accent Packaging v. Leggett & Platt

- Issue – interpretation of claim language

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### Accent Packaging v. Leggett & Platt

- Leggett
  - argued that the language “each of the operator bodies being operably coupled with a respective one of said gripper, knotter, cutting element and cover” requires four elongated operator bodies—each operably coupled to one and only one of said gripper, knotter, cutting element, or cover.
- Accent
  - argued that these claims are not limited to a specific number of elongated operator bodies because they allow for a single elongated operator body to perform multiple functions.

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### Accent Packaging v. Leggett & Platt

- Leggett
  - argued that its Pinnacle device does not include a cover mount that permits the cover to pivot “through an arc of at least about ninety degrees.”
- Accent
  - argued that the Pinnacle’s cover mount does in fact allow its cover to pivot through an arc of ninety degrees and that only an easily removable mechanical stop prevents the cover mount from so rotating.

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### Accent Packaging v. Leggett & Platt

- Why did the DC find summary judgment of noninfringement?
  - The word each, in this patent, refers to one of *four* arms” and that “[a]n ordinary reading of the language, therefore, assigns the machine’s four arms a single function.” ... *The district court determined that because the claims require four arms, Leggett’s Pinnacle device does not infringe.*
  - Pinnacle’s mount does not pivot greater than 90°

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### Accent Packaging v. Leggett & Platt

- Does “each” and “a respective one” require four elongated bodies?
- Accent
  - No requirement; see the preferred embodiment disclosed in the specification, which explicitly shows two elongated operator bodies that are operably coupled to both the knotter and the cover.
- Leggett & Platt
  - The asserted claims of the ‘877 patent recite four separate and distinct operator elements, the claims require at least four elongated operator bodies so that “each” of the elongated operator bodies is coupled to “a respective one” of the four claimed operator elements.
  - The preferred, and only, embodiment in the specification has a “total of four operating arms.”

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Accent Packaging v. Leggett & Platt

- “Claim terms are generally given their ordinary meaning as understood by persons skilled in the art in question at the time of the invention.”

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Accent Packaging v. Leggett & Platt

- D.C. erred
- “[T]he preferred embodiment features an elongated operator body that is operably coupled to *one or more operator* elements. We have held that ‘a claim interpretation that excludes a preferred embodiment from the scope of the claim is rarely, if ever, correct.’”

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Accent Packaging v. Leggett & Platt

- “It is true that ‘each’ operator body must be coupled to ‘a respective one’ of the gripper, knotter, cutter, and cover. But that does not necessarily prevent an elongated operator body from being coupled to a second or even a third operator element as well.”

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Accent Packaging v. Leggett & Platt

- “an indefinite article ‘a’ or ‘an’ in patent parlance carries the meaning of ‘one or more’ in openended claims containing the transitional phrase comprising” unless a patentee has “evidence[d] a clear intent’ to limit ‘a’ or ‘an’ to ‘one’”

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Accent Packaging v. Leggett & Platt

- “[A] device does not infringe simply because it is possible to alter it in a way that would satisfy all the limitations of a patent claim.”

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Accent Packaging v. Leggett & Platt

- “[I]f a device is designed to be altered or assembled before operation, the manufacturer may be held liable for infringement if the device, as altered or assembled, infringes a valid patent.”

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## Special Topic

- Claim drafting

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## Randy Claim Drafting Style Notes

- How does Randy want his claims to be drafted?

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## Transitions

- Comprising
- Single use of the transition
- Colon

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## Comprising

- The transition should almost always be “comprising”;
  - Must have a compelling reason to deviate

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## Single Use of the Transition

- The word “comprising” should only be used at the transition.
- When reciting elements in other portions of the claim, use the word “including”.
- In general, do not otherwise use the term “comprises” in the claim unless it is a system claim in which the hardware elements have subcomponents.

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## Colon

- A colon should generally only be used once in the claim—immediately after the transition.
- However, a colon may be used in a system claim in which the hardware elements have subcomponents.

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## Body

- Numbering of Elements
- Human-Performed Steps
- Human Receiver

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## Numbering of Elements

- The elements of the claim should not be numbered.
  - Numbering of the elements (especially for method claims) could cause someone interpreting the claims to connote an order that otherwise would not be present.
- Do not put element numbers in parenthetical in claims.
  - While required in some foreign countries, this could unduly limit the claims in the United States

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## Human-Performed Steps

- Human-performed steps should not be included in the claim
- Describe what happens on a technological basis in the claim
  - For example, if a product is placed in packaging, wouldn't we a recording that the packaging shipped be recorded or transmitted?

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## Human Receiver

- Generally avoid characterizing a person's involved with the claim—especially with an independent claim

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## Method Claims

- Action Steps
- Type of Recitation

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## Action Steps

- Include at least one action step in a method claim
- Concern with claims that only include “accessing” and “providing” steps

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## Type of Recitation

- Positive Recitation
- Negative Recitation

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## Claim Considerations for the Patent Drafting Attorney

- Who will infringe the claims as drafted?
- How will the claims be infringed as drafted?
- Will we be able to identify whether someone else infringes the claims?
- Is there an easy work around to the claims?
- Avoid "falling in love" with terms of art or coined terms for patentability
- Include support for crafting claims to combat design around efforts by third parties
- Analyze known competitors' and other third party technology to draft claims that literally infringe

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## ***Program Completed***

All course materials - Copyright 2002-16 Randy L. Canis, Esq.

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