

PATENT LAW

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CLASS 8

The Patent Specification pt. 2;

Claims pt. 2:

**ST: Drafting a Patent Application & Jobs
in Patent Law**

The Patent Specification pt. 2

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Written Description Requirement

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Written Description Requirement

- To satisfy the written description requirement, a patent specification must describe the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention.
- MPEP 2163

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Written Description

- “112, ¶ 1 ensures that, as of the filing date, the inventor conveyed with reasonable clarity to those of skill in the art that he was in possession of the subject matter of the claims.” Union Oil Co. of Calif. V. Atlantic Richfield Co., 208 F.3d 989 (Fed. Cir. 2000)
- “When new claims are added after the original filing date—either in their entirety or through alterations to earlier claims—the ‘written description’ test requires that the augmented material must find a basis somewhere in the original application as filed.

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Written Description Violations

- Broad Claims
 - Claims cannot cover inventions never contemplated or disclosed by the inventor
- Narrow Claims
 - Each limitation must be supported by written description
- Addition of New Matter
 - To obtain benefit of earlier-filed application, claims of a continuation (or CIP) must be supported by original specification

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New Matter?

- 35 U.S.C. §132(a) – “...No amendment shall introduce new matter into the disclosure of the invention.”
- “... [T]o amend a claim or add a new claim without encountering the new matter proscription, an applicant must show that the original application disclosed or contained the subject matter included in the amendment.”

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Vas-Cath Inc. v. Mahurkar

- “The purpose of the ‘written description’ requirement is broader than to merely explain how to ‘make and use’; the applicant must also convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention.”

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No Support in Specification for Claims

- “When claimed subject matter is only presented in the claims and not in the specification portion of the application, the specification should be objected to for lacking the requisite support for the claimed subject matter...”
- MPEP 2146

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The Gentry Gallery, Inc. v. The Berkline Corp.

- Case History
- D.C. ruled that Berkline does not infringe 5,064,244
- Panel Fed. Cir. of Rich, Friedman, and Lourie
 - Affirmed-in-part and reversed-in-part

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The Gentry Gallery, Inc. v. The Berkline Corp.

- Invention
 - a unit of a sectional sofa in which two independent reclining seats face in the same direction. A console is between two recliners which face in the same direction and accommodates the controls for both reclining seats
- Where is the control means located?
 - “[T]he patent’s disclosure does not support claims in which the location of the recliner controls is other than on the console.”
- How is the disclosure written?

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The Gentry Gallery, Inc. v. The Berkline Corp.

1. A sectional sofa comprising:
 - a pair of reclining seats disposed in parallel relationship with one another in a double reclining seat sectional sofa section being without an arm at one end
 - each of said reclining seats having a backrest and seat cushions and movable between upright and reclined positions
 - a fixed console disposed in the double reclining seat sofa section between the pair of reclining seats and with the console and reclining seats together comprising a unitary structure,
 - said console including an armrest portion for each of the reclining seats; said arm rests remaining fixed when the reclining seats move from one to another of their positions,
 - and a pair of control means, one for each reclining seat; mounted on the double reclining seat sofa section

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The Gentry Gallery, Inc. v. The Berkline Corp.

- How was the disclosure drafted?
 - What was the concern?
- “[A] claim may be broader than the specific embodiment disclosed in a specification.”
- “An applicant is entitled to claims as broad as the prior art and his disclosure will allow.”

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The Gentry Gallery, Inc. v. The Berkline Corp.

- “We agree with Gentry that the term ‘fixed’ requires only that the console be rigidly secured to its two adjacent recliners. The term ‘fixed’ and the explanatory clause ‘with the console and reclining seats together comprising a unitary structure’ were added during prosecution to overcome a rejection based on a sectional sofa in which the seats were not rigidly attached. Thus, because the term “console” clearly refers to the complete section between the recliners, the term ‘fixed’ merely requires that the console be rigidly attached to the recliners.
- “There is no dispute that Berkline’s center seat and recliners form a unitary structure, we conclude that the ‘fixed’ limitation is met by Berkline’s sofas.”

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The Gentry Gallery, Inc. v. The Berkline Corp.

- “We agree with Berkline that the patent’s disclosure does not support claims in which the location of the recliner controls is other than on the console.”

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The Gentry Gallery, Inc. v. The Berkline Corp.

- “In this case, the original disclosure clearly identifies the console as the only possible location for the controls. It provides for only the most minor variation in the location of the controls, noting that the control ‘may be mounted on top or side surfaces of the console rather than on the front wall . . . without departing from this invention.’ ‘244 patent, col. 2, line 68 to col. 3, line 3. No similar variation beyond the console is even suggested. Additionally, the only discernible purpose for the console is to house the controls.”

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The Gentry Gallery, Inc. v. The Berkline Corp.

- “[A] narrow disclosure will limit claim breadth.”
- How should disclosures be written?
 - “An applicant is entitled to claims as broad as the prior art and his disclosure will allow.”
 - “[A] narrow disclosure will limit claim breadth.”

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Claims as Filed

- Regulation of claims included in the application as filed
- “[E]ven if the precise claim language had been included in the original specification, still the work done by the inventor is insufficient to support the breadth of the claim.”

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Ariad Pharmaceuticals, Inc. v. Eli Lilly & Co.

- “We now reaffirm that §112, first paragraph, contains a written description requirement separate from enablement ...”

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Ariad Pharmaceuticals, Inc. v. Eli Lilly & Co.

- “[P]ossession as shown in the disclosure’ is a more complete formulation. Yet whatever the specific articulation, the test requires an objective inquiry into the four corners of the specification from the perspective of a person of ordinary skill in the art. Based on that inquiry, **the specification must describe an invention understandable to that skilled artisan and show that the inventor actually invented the invention claimed.**”

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Best Mode

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Best Mode

- The specification shall set forth the best mode contemplated by the inventor of carrying out his/her invention.
- Is this an objective or subjective standard?

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Best Mode

- The best mode of carrying out the invention must be disclosed.
- The test for a best mode violation is a two prong inquiry.
- PRONG 1 (Subjective) – Did the inventor possess a best mode for practicing the invention?
- PRONG 2 (Objective) – Does the written description disclose the best mode so that a person skilled in the art could practice it?
- MPEP 2165

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Chemcast Corp. v. Arco Industries Corp.

- “The best mode inquiry focuses on the inventor’s state of mind as of the time he filed his application—a subjective, factual question. ... Our statements that ‘there is no objective standard by which to judge the adequacy of a best mode disclosure,’ and that ‘only evidence of concealment (accidental or intentional) is to be considered,’ ... assumed that both the level of skill in the art and the scope of the claimed invention were additional, objective metes and bounds of the best mode disclosure.”

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Chemcast Corp. v. Arco Industries Corp.

- Test
 1. At the time the inventor filed his patent application, did the inventor know of a mode of practicing the claimed invention that he/she considered to be better than any other?
 2. If so contemplated, is the disclosure adequate to enable one skilled in the art to practice the best mode (i.e., has the best mode been concealed)?

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Best Mode Violation?

What May Establish Subjective Evidence of Concealment?

- Inventor testimony
- Inventor's lab notebook
- Inventor's contemporaneous articles, notes, speeches, etc.?
- Other corporate disclosures cannot impute knowledge to inventor (Glaxo Inc. v. Novopharm Ltd., 52 F.3d 1043 (Fed. Cir. 1995))
- Commercial embodiment is not necessarily the best mode. (Zygo Corp. v. Wyko Corp., 79 F.3d 1563 (Fed. Cir. 1996))

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Best Mode

- Specific instrumentalities and techniques as the best way of carrying out the invention.
- "Compliance with the best mode requirement is a question of fact, and invalidity for failure of compliance requires proof by clear and convincing evidence that the inventor knew of and concealed a better mode of carrying out the invention than was set forth in the specification." Scripps Clinic & Research Foundation v. Genentech, Inc., 927 F.2d 1565, 18 USPQ2d 1001, 18 USPQ2d 1896 (Fed. Cir. 1991)

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Best Mode

- The disclosure of routine details is unnecessary because they are readily apparent to one of ordinary skill in the art. Eli Lilly & Co. v. Barr Laboratories, Inc., 251 F.3d 955, 58 USPQ2d 1865 (Fed. Cir. 2001)
- An inventor need not disclose a mode for obtaining unclaimed subject matter unless the subject matter is novel and essential for carrying out the best mode of the invention."

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Best Mode Post AIA – Major Questions

- Is the best mode still a requirement?
- Does this affect patent process before the USPTO?
- Can an examiner still reject a patent application under the best mode requirement?

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Claims pt. 2

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Product by Process Claims

- When an invention can be described in no other way besides the way of making a product (i.e., structural characteristics cannot adequately describe the invention)
- Defines the product by the process of making it

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Product by Process Claim Example

- A diamond-bearing material prepared by a process comprising the steps of
 - detonating a charge consisting essentially of a carbon-containing explosive having a negative oxygen balance to form a detonation product; and
 - cooling the detonation product at a rate of about 200 to 6,000 degrees/minute.

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Product by Process Claim Scope of Protection

- The product may not be limited by the described process.
- However, consider *Atlantic Thermoplastics Co. Inc. v. Faytex Corp.*

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Atlantic Thermoplastics Co. Inc. v. Faytex Corp.

- “The PTO’s treatment of product-by-process claims as a product claim for patentability is consistent with policies giving claims their broadest reasonable interpretation.”

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Atlantic Thermoplastics Co. Inc. v. Faytex Corp.

- “This court has repeatedly stated that infringement requires the presence of every claim limitation or its equivalent ... Thus, ignoring the claim limits of a product-by-process claim would clash directly with basic patent principles enunciated by the Supreme Court and this court.”

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Functional Claiming

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Means-Plus-Function Format

- Claiming an element in its functional terms
- Used with a combination of elements
- Means for performing a specified function
- Does not recite the structure, material or acts disclosed in the specification
- Used where the description of the structure or acts might be difficult to articulate in a claim

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Means-Plus-Function Format

- “It requires the applicant to describe in the patent specification the various structures that the inventor expects to perform the specified function. The statute then expressly confines coverage of the functional claim language to ‘corresponding structure, material, or acts described in the specification and equivalents thereof.’”

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AI-Site Corp. v. VSI International, Inc.

Case History

- D.C. For S.D. of Florida
 - Infringement
- Panel Fed. Cir. 1999 of Mayer, Rich, and Rader
 - Errors in claim construction, but infringement still found

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AI-Site Corp. v. VSI International, Inc.

- Issue:
 - How is means-plus-function claim language interpreted?

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AI-Site Corp. v. VSI International, Inc.

- “This court has delineated several rules for claim drafters to invoke the strictures of 35 U.S.C. § 112, ¶ 6. Specifically, if the word “means” appears in a claim element in combination with a function, it is presumed to be a means-plus-function element to which §112, ¶6 applies. ... Nevertheless, according to its express terms, §112, ¶6 governs only claim elements that do not recite sufficient structural limitations. ... Therefore, the presumption that §112, ¶6 applies is overcome if the claim itself recites sufficient structure or material for performing the claimed function.”

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AI-Site Corp. v. VSI International, Inc.

- “Although use of the phrase “means for” (or “step for”) is not the only way to invoke §112, ¶6, that terminology typically invokes §112, ¶6 while other formulations generally do not. ... Therefore, when an element of a claim does not use the term “means,” treatment as a means-plus-function claim element is generally not appropriate. ... However, when it is apparent that the element invokes purely functional terms, without the additional recital of specific structure or material for performing that function, the claim element may be a means-plus-function element despite the lack of express means-plus-function language. ...”

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AI-Site Corp. v. VSI International, Inc.

- “Section 112, ¶6 recites a mandatory procedure for interpreting the meaning of a means- or step-plus-function claim element. These claim limitations ‘shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.’ 35 U.S.C. §112, ¶6. Thus, § 112, ¶6 procedures restrict a functional claim element’s ‘broad literal language . . . to those means that are ‘equivalent’ to the actual means shown in the patent specification.’ ... Section 112, ¶6 restricts the scope of a functional claim limitation as part of a literal infringement analysis. ...”

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AI-Site Corp. v. VSI International, Inc.

- “Thus, an equivalent under §112, ¶6 informs the claim meaning for a literal infringement analysis. The doctrine of equivalents, on the other hand, extends enforcement of claim terms beyond their literal reach in the event ‘there is ‘equivalence’ between the elements of the accused product or process and the claimed elements of the patented invention.’” ...

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AI-Site Corp. v. VSI International, Inc.

- “[A]n equivalent structure or act under §112 for literal infringement must have been available at the time of patent issuance while an equivalent under the doctrine of equivalents may arise after patent issuance and before the time of infringement. ... An “after-arising” technology could thus infringe under the doctrine of equivalents without infringing literally as a § 112, ¶6 equivalent. Furthermore, under §112, ¶6, the accused device must perform the identical function as recited in the claim element while the doctrine of equivalents may be satisfied when the function performed by the accused device is only substantially the same.”

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Aristocrat Technologies Australia Pty Ltd. v. International Game Technology

Case History

- D.C. for Nevada
 - Claims invalid for indefiniteness
- Panel Fed. Cir. 2008 of Lourie, Schall, and Bryson
 - Affirmed

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Aristocrat Technologies Australia Pty Ltd. v. International Game Technology

- Invention
 - An electronic slot machine that allows a player to select winning combinations of symbol positions

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Aristocrat Technologies Australia Pty Ltd. v. International Game Technology

Claim 1

- A gaming machine
- having display means arranged to display a plurality of symbols in a display format having an array of n rows and m columns of symbol positions,
- game control means arranged to control images displayed on the display means,
- the game control means being arranged to pay a prize when a predetermined combination of symbols is displayed in a predetermined arrangement of symbol positions selected by a player, playing a game, including one and only one symbol position in each column of the array,
- the gaming machine being characterized in that selection means are provided to enable the player to control a definition of one or more predetermined arrangements by selecting one or more of the symbol positions and
- the control means defining a set of predetermined arrangements for a current game comprising each possible combination of the symbol positions selected by the player which have one and only one symbol position in each column of the display means,
- wherein the number of said predetermined arrangements for any one game is a value which is the product $k_1 \cdot X \cdot k_i \cdot X \cdot k_m$ where k_i is a number of symbol positions which have been selected by the player in an i th column of the n rows by m columns of symbol positions on the display ($0 < i \leq m$ and $k_i \leq n$).

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Aristocrat Technologies Australia Pty Ltd. v. International Game Technology

- Patent was found invalid for indefiniteness
- Key question of the case involves use of the term game control means

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Aristocrat Technologies Australia Pty Ltd. v.
International Game Technology

- “[T]he scope of that claim limitation had to be defined by the structure disclosed in the specification plus any equivalents of that structure; in the absence of structure disclosed in the specification to perform those functions, the claim limitation would lack specificity, rendering the claims as a whole invalid for indefiniteness under 35 U.S.C. 112 P 2.”

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Aristocrat Technologies Australia Pty Ltd. v.
International Game Technology

- “[T]his court has consistently required that the structure disclosed in the specification be more than simply a general purpose computer or microprocessor.”
- Purpose – to avoid purely functional claiming

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Aristocrat Technologies Australia Pty Ltd. v.
International Game Technology

- “[S]imply disclosing a computer as the structure designated to perform a particular function does not limit the scope of the claim to ‘the corresponding structure, material or acts’ that perform the function as required by section 112 paragraph 6.”

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Aristocrat Technologies Australia Pty Ltd. v.
International Game Technology

- “[A] general purpose computer programmed to carry out a particular algorithm creates a ‘new machine’ because a general purpose computer ‘in effect becomes a special purpose computer once it is programmed to perform particular functions pursuant to instructions from program software.’”

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Aristocrat Technologies Australia Pty Ltd. v.
International Game Technology

- Court analysis
 - “The described language simply describes the function to be performed, not the algorithm by which it is performed.”
 - “[T]he equation is not an algorithm that describes how the function is performed, but is merely a mathematical expression that describes the outcome of performing the function.”

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Aristocrat Technologies Australia Pty Ltd. v.
International Game Technology

- What should/could Aristocrat have done?
 - Disclosed the algorithm
 - Avoided using means-plus-function format for claim element

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Corresponding Structure

- “If there is no structure in the specification corresponding to the means-plus-function limitation in the claims, the claim will be found invalid as indefinite.”
- Robert Bosch, LLC v. Snap-On Inc.

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Williamson v. Citrix

- 2015 Fed. Cir. (panel/en banc)
- Invention
 - Distributed virtual classroom

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Williamson v. Citrix

8. A system for conducting distributed learning among a plurality of computer systems coupled to a network, the system comprising:
- a presenter computer system of the plurality of computer systems coupled to the network and comprising:
 - a content selection control for defining at least one remote streaming data source and for selecting one of the remote streaming data sources for viewing; and
 - a presenter streaming data viewer for displaying data produced by the selected remote streaming data source;
 - an audience member computer system of the plurality of computer systems and coupled to the presenter computer system via the network, the audience member computer system comprising:
 - an audience member streaming data viewer for displaying the data produced by the selected remote streaming data source; and
 - a distributed learning server remote from the presenter and audience member computer systems of the plurality of computer systems and coupled to the presenter computer system and the audience member computer system via the network; and comprising:
 - a streaming data module for providing the streaming data from the remote streaming data source selected with the content selection control to the presenter and audience member computer systems; and
 - a **distributed learning control module** for receiving communications transmitted between the presenter and the audience member computer systems and for relaying the communications to an intended receiving computer system and for coordinating the operation of the streaming data module.

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Williamson v. Citrix

- “In its claim construction order, the district court also concluded that the limitation of claim 8, **‘distributed learning control module,’** was a **means-plus-function term** under 35 U.S.C. §112, para. 6. The district court then evaluated the specification and concluded that it **failed to disclose the necessary algorithms** for performing all of the claimed functions. The district court thus held claim 8 and its dependent claims 9–16 **invalid as indefinite** under §112, para. 2.”

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Williamson v. Citrix

- “In making the assessment of whether the limitation in question is a means-plus-function term subject to the strictures of §112, para. 6, our cases have emphasized that the essential inquiry is not merely the presence or absence of the word ‘means’ but **whether the words of the claim are understood by persons of ordinary skill in the art to have a sufficiently definite meaning as the name for structure.**”

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Williamson v. Citrix

- “Our consideration of this case has led us to conclude that such a heightened burden is unjustified and that we should abandon characterizing as ‘strong’ the presumption that a limitation lacking the word ‘means’ is not subject to §112, para. 6.”

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Williamson v. Citrix

- “Henceforth, we will apply the presumption as we have done prior to Lighting World, without requiring any heightened evidentiary showing and expressly overrule the characterization of that presumption as ‘strong.’ We also overrule the strict requirement of ‘a showing that the limitation essentially is devoid of anything that can be construed as structure.’”

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Williamson v. Citrix

- The standard is whether the words of the claim are understood by persons of ordinary skill in the art to have a sufficiently definite meaning as the name for structure. ... When a claim term lacks the word ‘means,’ the presumption can be overcome and §112, para. 6 will apply if the challenger demonstrates that the claim term fails to ‘recite sufficiently definite structure’ or else recites ‘function without reciting sufficient structure for performing that function.’ ... The converse presumption remains unaffected: ‘use of the word ‘means’ creates a presumption that §112, ¶ 6 applies.’”

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Williamson v. Citrix

- “‘Module’ is a well-known nonce word that can operate as a substitute for ‘means’ in the context of §112, para. 6. As the district court found, “‘module’ is simply a generic description for software or hardware that performs a specified function.’ ... Generic terms such as ‘mechanism,’ ‘element,’ ‘device,’ and other nonce words that reflect nothing more than verbal constructs may be used in a claim in a manner that is tantamount to using the word ‘means’ because they ‘typically do not connote sufficiently definite structure’ and therefore may invoke §112, para. 6.”

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Jepson Claims

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Jepson Claim

- Defines an invention in two parts:
 - A preamble which recites the admitted prior art,
 - Followed by an “improvement” clause which recites what the applicant regards as his invention
- Referred to as a two-part claim in other parts of the world
 - Most popular in Germany

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In Re Fout

- Procedural Background
- Factual Background
- Issue:
 - Does an invention set forth in the preamble constitute “prior art” under 35 USC 103?

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In Re Fout

- “This court has recognized that section 102 is not the only source of section 103 prior art. Valid prior art may be created by the admissions of the parties. Nor is it disputed that certain art may be prior art to one inventive entity, but not to the public in general.”

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In Re Fout

- “We hold that appellants’ **admission** that they had actual knowledge of the prior Pagliaro invention described in the preamble **constitutes an admission that it is prior art to them.**”

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Markush Groups

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Markush Groups

- Common in Chemical Practice
- Claim a family of compounds by defining a structure common to all members of the family, along with one or more alternatives selected from the set consisting of named chemical compounds.
- Example
 - A compound of the formula OH-CH-R, where R is selected from the group consisting of chlorine, bromine and iodine.

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Claim Definiteness

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Datamize, LLC v. Plumtree Software, Inc.

- Invention
 - “[S]oftware program that allows a person to author user interfaces for electronic kiosks.”
 - The person has a limited range of pre-defined design choices
 - Claim describes that the interface screens are to be uniform and “aesthetically pleasing”

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Datamize, LLC v. Plumtree Software, Inc.

- The district court held each claim of the patent invalid for indefiniteness under 35 U.S.C. 112 P 2.
- Issue on appeal is whether aesthetically pleasing is definite

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Datamize, LLC v. Plumtree Software, Inc.

- “[T]he purpose of the definiteness requirement is to ensure that the claims delineate the scope of the invention using language that adequately notifies the public of the patentee’s right to exclude”

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Datamize, LLC v. Plumtree Software, Inc.

- Court’s analysis on aesthetically pleasing
 - is completely dependent on a person’s subjective opinion
 - some objective standard must be provided in order to allow the public to determine the scope of the claimed invention
 - there are not good standards for aesthetics

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Nautilus, Inc. v. Biosig Instruments, Inc.

- Case History
- S.D.NY
 - Summary judgment of invalidity for indefiniteness
- Panel Fed. Cir. of Newman, Schall, and Wallach
 - Reversed district court’s invalidity determination
- Supreme Court

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Nautilus, Inc. v. Biosig Instruments, Inc.

- Supreme Court 2014
- Issue
 - What is the definiteness standard under 35 U.S.C. 112, second paragraph?

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Nautilus, Inc. v. Biosig Instruments, Inc.

- “In place of the ‘insolubly ambiguous’ standard, we hold that a patent is invalid for indefiniteness if its claims, read in light of the specification delineating the patent, and the prosecution history, fail to inform, with reasonable certainty, those skilled in the art about the scope of the invention.”

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Nautilus, Inc. v. Biosig Instruments, Inc.

- Was “spaced relationship” indefinite?
- Fed Cir.
- “A claim is indefinite, the majority opinion stated, ‘only when it is “not amenable to construction” or “insolubly ambiguous.””

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Nautilus, Inc. v. Biosig Instruments, Inc.

“[W]e read §112(b) to require that a patent’s claims, viewed in light of the specification and prosecution history, inform those skilled in the art about the scope of the invention with reasonable certainty. The definiteness requirement, so understood, mandates clarity, while recognizing that absolute precision is unattainable. The standard we adopt accords with opinions of this Court stating that ‘the certainty which the law requires in patents is not greater than is reasonable, having regard to their subject-matter.’”

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Interval Licensing LLC v. AOL, Inc

- Case History
- W.D.WA
 - Judgment of invalidity for indefiniteness
- Panel Fed. Cir. of Taranto and Chen (Rader)
 - Affirmed district court’s judgment of invalidity

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Interval Licensing LLC v. AOL, Inc

Claim 1 of ‘314
A method for engaging the peripheral attention of a person in the vicinity of a display device, comprising the steps of:
providing one or more sets of content data to a content display system associated with the display device and located entirely in the same physical location as the display device;
providing to the content display system a set of instructions for enabling the content display system to selectively display, in an unobtrusive manner that does not distract a user of the display device or an apparatus associated with the display device from a primary interaction with the display device or apparatus, an image or images generated from a set of content data; and
auditing the display of sets of content data by the content display system;

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Interval Licensing LLC v. AOL, Inc

- “Interval’s suit alleged that the Defendants infringe the patents through products and software that use ‘pop-up’ notifications to present information to users.”

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Interval Licensing LLC v. AOL, Inc

- “A claim fails to satisfy this statutory requirement and is thus invalid for indefiniteness if its language, when read in light of the specification and the prosecution history, ‘fail[s] to inform, with reasonable certainty, those skilled in the art about the scope of the invention.’”

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Interval Licensing LLC v. AOL, Inc

- “The definiteness standard ‘must allow for a **modicum of uncertainty**’ to provide incentives for innovation, but must also require “**clear notice** of what is claimed, thereby appris[ing] the public of what is still open to them.”

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Interval Licensing LLC v. AOL, Inc

- “Claim language employing terms of degree has long been found definite where it provided enough certainty to one of skill in the art when read in the context of the invention.”

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Interval Licensing LLC v. AOL, Inc

- “The claims, when read in light of the specification and the prosecution history, must provide **objective boundaries** for those of skill in the art.”

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Interval Licensing LLC v. AOL, Inc

- “The patents’ ‘unobtrusive manner’ phrase is highly subjective and, on its face, provides little guidance to one of skill in the art.”
- “[A] term of degree fails to provide sufficient notice of its scope if it depends ‘on the unpredictable vagaries of any one person’s opinion.’”

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Media Rights Technologies, Inc. v. Capital One Financial Corp.

- Case History
- E.D.VA
 - Judgment on the pleadings that the asserted claims are invalid for indefiniteness
- 2015 Panel Fed. Cir. of O'Malley, Plager, and Taranto
 - Affirmed

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Media Rights Technologies, Inc. v. Capital One Financial Corp.

- Invention
 - System that “prevents unauthorized recording via a compliance mechanism, which diverts incoming media content protected by law or agreement from being output from a system in order to stop the illegal copying or sharing of that content”

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Media Rights Technologies, Inc. v. Capital One Financial Corp.

1. A method of preventing unauthorized recording of electronic media comprising:
Activating a **compliance mechanism** in response to receiving media content by a client system, said **compliance mechanism** coupled to said client system, said client system having a media content presentation application operable thereon and coupled to said **compliance mechanism**;
Controlling a data output pathway of said client system with said **compliance mechanism** by diverting a commonly used data pathway of said media player application to a controlled data pathway monitored by said **compliance mechanism**; and
Directing said media content to a **custom media device** coupled to said **compliance mechanism** via said data output path, for selectively restricting output of said media content.

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Media Rights Technologies, Inc. v. Capital One Financial Corp.

- “A claim fails to satisfy [§112(b)] statutory requirement and is thus invalid for indefiniteness if its language, when read in light of the specification and the prosecution history, ‘fail[s] to inform, with reasonable certainty, those skilled in the art about the scope of the invention.’”

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Media Rights Technologies, Inc. v. Capital One Financial Corp.

- “[A] claim is **indefinite if its language ‘might mean several different things** and no informed and confident choice is available among the contending definitions.”

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Media Rights Technologies, Inc. v. Capital One Financial Corp.

- “It is well settled that [a] claim limitation that actually uses the word ‘means’ invokes a **rebuttable presumption** that §112, ¶6 applies.” ¶ And, it is equally understood that “a claim term that does not use ‘means’ will trigger the rebuttable presumption that §112, ¶6 does not apply.” ¶ But this presumption against the application of §112, ¶6 to a claim term lacking the word “means” can be overcome if a party can “demonstrate[] that the claim term fails to ‘recite sufficiently definite structure’ or else recites ‘function without reciting sufficient structure for performing that function.’” ¶ “In undertaking this analysis, we ask if the claim language, read in light of the specification, recites sufficiently definite structure to avoid §112, ¶6.

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Media Rights Technologies, Inc. v. Capital One Financial Corp.

- Avoiding means plus function?
- “Because ‘the claims indicate[d] that “modernizing device” **functions as an electrical circuit** that receives signals, processes signals, and outputs signals to other components’ and the specification ‘**depict[ed] the modernizing device and its internal components,**’ ‘show[ed] how the **elements were connected together,**’ and further described **how these components perform the claimed functions,** we concluded that ‘modernizing device’ was not a means-plus-function limitation. ¶ Here, unlike *Inventio*, the claims do not use the term ‘compliance mechanism’ as a substitute for an electrical circuit, or anything else that might connote a definite structure.”

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Media Rights Technologies, Inc. v. Capital One Financial Corp.

- “Because ‘compliance mechanism’ is a means-plus function term, we now must ‘attempt to construe the disputed claim term by identifying the “corresponding structure, material, or acts described in the specification” to which the claim term will be limited.’ ¶ **Where there are multiple claimed functions,** as there are in this case, the **patentee must disclose adequate corresponding structure to perform all of the claimed functions.** ¶”

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Media Rights Technologies, Inc. v. Capital One Financial Corp.

- "Because these functions are computer-implemented functions, moreover, the structure disclosed in the specification must be more than a general purpose computer or microprocessor. [] Instead, **we require that the specification disclose an algorithm for performing the claimed function.** [] The algorithm may be expressed as a mathematical formula, in prose, as a flow chart, or in any other manner that provides sufficient structure. []"

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ST: Drafting an Application

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Parts of the Specification

- **37 CFR 1.77 Arrangement of application elements.**
- ...
- (b) The specification should include the following sections in order:
 - (1) Title of the invention, which may be accompanied by an introductory portion stating the name, citizenship, and residence of the applicant (unless included in the application data sheet).
 - (2) Cross-reference to related applications (unless included in the application data sheet).
 - (3) Statement regarding federally sponsored research or development.
 - (4) The names of the parties to a joint research agreement.

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Parts of the Specification

- (5) Reference to a "Sequence Listing," a table, or a computer program listing appendix submitted on a compact disc and an incorporation-by-reference of the material on the compact disc (see § **1.52(e)(5)**). The total number of compact discs including duplicates and the files on each compact disc shall be specified.
- (6) Background of the invention.
- (7) Brief summary of the invention.
- (8) Brief description of the several views of the drawing.
- (9) Detailed description of the invention.
- (10) A claim or claims.
- (11) Abstract of the disclosure.

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Title of the Invention

- **Title Requirements**
- May not exceed 500 characters in length
- Must be as short and specific as possible.
- 37 CFR 1.72

- Example Titles
- Modular Data Analysis
- Method and System for Database Archiving

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Cross-Reference to Related Applications

- Used to identify when inventions are related. For example, (1) multiple applications may be filed on the same specification with different sets of claims, or (2) a nonprovisional patent application may claim priority to one or more previously filed provisional patent applications.
- Example cross-reference
- CROSS-REFERENCE TO RELATED APPLICATIONS
- This application claims the benefit of United States Provisional Patent Applications entitled "Encrypted Data Parsing", Serial No.: 60/XXX,XXX, filed 5 January 2007, and "Method and System for Voice Restoration", Serial No.: 60/XXX,XXX, filed 5 April 2007, the entire contents of which are herein incorporated by reference.

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Background of the Invention

- According to the MPEP, the Background of the Invention ordinarily includes (1) Field of the Invention and (2) Description of the Related Art. §608.01(c)
- However, the inclusions as suggested by the MPEP are not mandated. Because of concerns arising out of case law, the Background of the Invention is no longer drafted in this way.

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Field of the Invention

- Usage
- When included, in the application should be identified as “Field” or “Technical Field” instead of “Field of the Invention”.
- Should include a general recitation to avoid narrowly limiting the patent.
- Example
- This application relates to a method and system for data processing, and more specifically to methods and systems for differential data encoding and decoding.

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Background of the Invention

- Usage
- When included, in the application should be identified as “Background” instead of “Background of the Invention”.
- Should not include any limiting language, description of prior art, or identification of something as being prior art.

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Summary of the Invention

- Usage
- When included, in the application should be identified as “Summary” instead of “Summary of the Invention”.
- Should include one or more paragraphs with short sentences providing support for the independent claims. The language of the paragraphs should directly correlate to language in the claims.

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Summary of the Invention

- Example Claim
- A method comprising:
- providing a multimedia lecture to a plurality of attendees;
- providing a feedback request to the plurality of attendees; and
- receiving feedback from at least one attendee of the plurality of attendees in response to the feedback request.

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Summary of the Invention

- Example Summary
- SUMMARY
- In an example embodiment, a multimedia lecture may be provided to a plurality of attendees. A feedback request may be provided to the plurality of attendees. Feedback may be received from at least one attendee of the plurality of attendees in response to the feedback request.

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Abstract

- “The purpose of the abstract is to enable the United States Patent and Trademark Office and the public generally to determine quickly from a cursory inspection the nature and gist of the technical disclosure.”

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Abstract

- Requirements:
- Include in the application (preferably following the claims)
- Under the heading “Abstract” or “Abstract of the Disclosure”
- Not exceed 150 words in length.

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Abstract

- Because of potential use of the Abstract as a limitation by a court, the abstract should be broad and usually reflect the broadest claim.
- Also consider some boilerplate language to indicate its intended use. For example:
“The Abstract of the Disclosure is provided to comply with 37 C.F.R. §1.72(b), requiring an abstract that will allow the reader to quickly ascertain the nature of the technical disclosure. It is submitted with the understanding that it will not be used to interpret or limit the scope or meaning of the claims.”

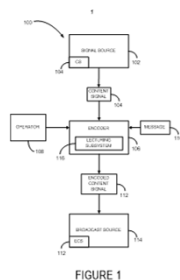
112

Parts of the Description

- Consider including the following drawings for the application:
- General system overview figures (1 or 2 total)
- Subsystem figures with modules
- Flowcharts
- Demonstrative pictures included throughout
- Specific system, subsystem, or other boilerplate figures
- Computer System

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GENERAL SYSTEM FIGURE



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Hardware Diagrams for System Claims Support

- Provide structure for the software in the application
- Create modules to correspond to one or more steps of the various claims
- Group the modules into one or more subsystems
- Tie the modules of a subsystem together

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SUBSYSTEM FIGURE WITH MODULES

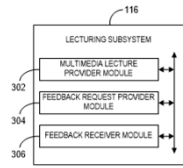


FIGURE 3

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Hardware Diagrams for System Claims Support

- Example
- A lecturing subsystem 116 may include a multimedia lecture provider module 302, a feedback request provider module 304, and/or a feedback receiver module 306. Other modules may also be used.
- The multimedia lecture provider module 302 provides a multimedia lecture to a number of attendees. The feedback request provider module 304 provides a feedback request to the plurality of attendees. The feedback receiver module 306 receives feedback from one or more attendee in response to the feedback request provided by the feedback provider module 304.

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Flowcharts

- Each independent claim should be fully described in a single figure
- Dependent claims may also be included with the single figure or may be included in an additional figure.

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Flowcharts

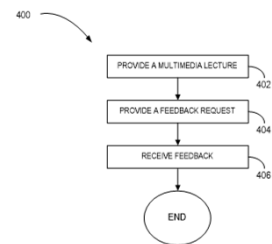


FIGURE 4

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Flowcharts

- Example
- FIG. 4 illustrates a method 400 for feedback processing according to an example embodiment. The method 400 may be performed by the encoder 106 (see FIG. 1) or otherwise performed.
- A multimedia lecture is provided to a number of attendees at block 402. A feedback request is provided to the attendees at block 404. At block 406, feedback is received from one or more attendees in response to the feedback request.

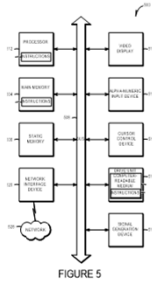
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Screen Shots/User Interface

- Pictures can be valuable for demonstrating invention to Examiner or establishing support
- Screen shots may be rejected and may need to be made into illustrations

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Computer System



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Sequence Listing and Sequence Identifiers

- **37 CFR 1.821(c)** requires that applications containing nucleotide and/or amino acid sequences that fall within the above definitions, contain, as a separate part of the disclosure on paper or compact disc, a disclosure of the nucleotide and/or amino acid sequences, and associated information, using the format and symbols that are set forth in **37 CFR 1.822** and **37 CFR 1.823**. This separate part of the disclosure is referred to as the "Sequence Listing." The "Sequence Listing" submitted pursuant to 37 CFR 1.821(c), whether on paper or compact disc, is the official copy of the "Sequence Listing."
- See MPEP 2422.03

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General Guidance

- Make sure to supplement the specification with other information not in the claims to satisfy other requirements (e.g., best mode) and to provide a fall back position (e.g., a more narrow limitation)
- Use a common number to identify the same object throughout the specification
- Be careful regarding the use of certain words including must, require, necessary that could later be used to limit the scope of a claim

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What to Include

- Appropriate terminology for technology and industry
- Definitions
- Embodiments
- Lots of appropriate details

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What to Avoid

- Patent Profanity
- Objects of the invention

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Patent Profanity

- Make very limited use of the term "invention";
- Terms to avoid include preferred, preferably, must, require, present invention, "i.e.", shall, important, object, object of the invention
- Other possible terms and phrases to avoid include "the inventors have found", "have been developed", useful, presently, innovative, significant

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ST: Jobs in Patent Law

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Patent Law Jobs

- In-house Counsel
- Outside Counsel
- Patent Agent
- In-house Facilitator
- Patent Examiner

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In-house counsel

- Primary Responsibilities
- One of few or one of many
 - Drafting and prosecuting applications (?)
 - Managing outside counsel
 - Working with patent committee
 - Working with inventors
 - Determining patent strategy for company
 - Monetizing IP
 - Design around efforts

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Outside Counsel

- Primary Responsibilities
 - Drafting and prosecuting applications
 - Preparing opinions
 - Drafting and negotiating license agreements
 - Litigating patents
 - Working with in-house counsel
 - Rainmaking

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Patent Agents

- Primary Responsibilities
 - Drafting and prosecuting applications
 - Provide specialized technical knowledge to drafting patent attorneys

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In-house Facilitator

- Primary Responsibilities
 - Assist inventors with identifying new inventions
 - Obtain disclosure regarding new inventions
 - Preparing invention disclosures for new inventions
 - Work with in-house counsel, outside counsel, and inventors

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Patent Examiner

- Primary Responsibilities
 - Examine patent applications in a technical field

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***Program
Completed***

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