

# Considerations for Patent Prosecutors from the Litigation Viewpoint

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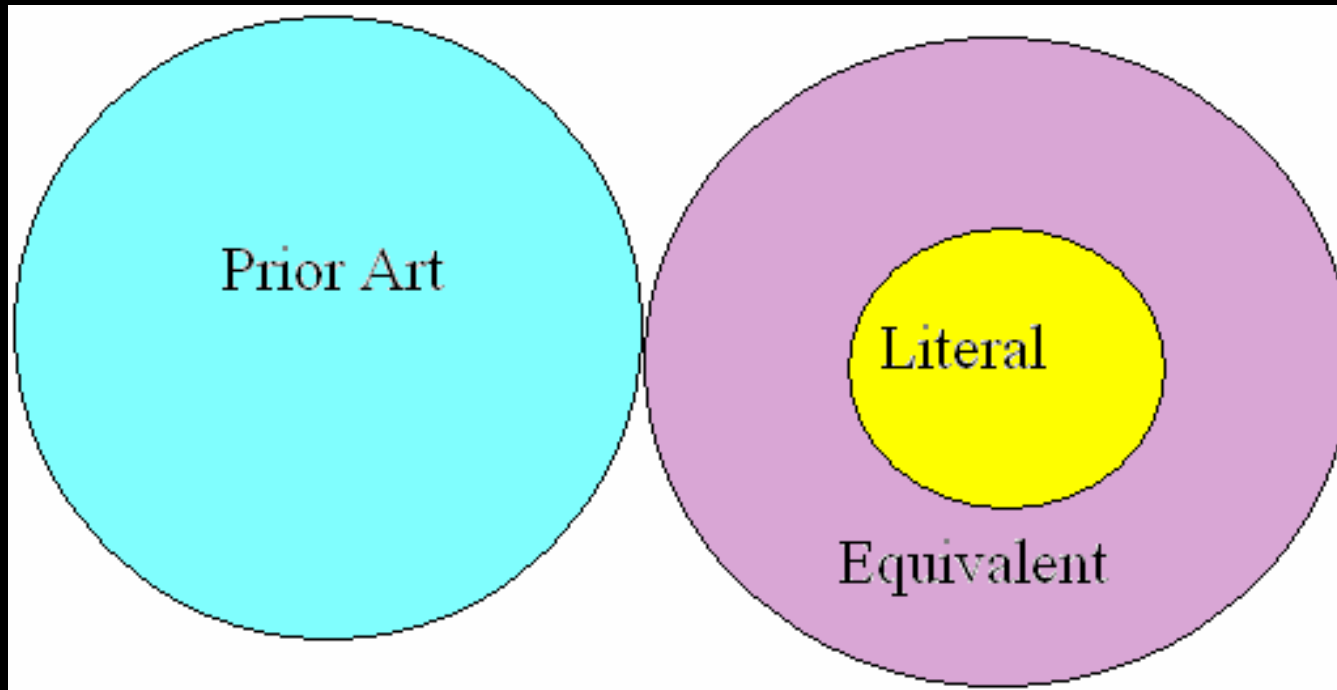
# Overview

1. Background of how the law has changed
2. Initial considerations at the time of disclosure
3. Claim construction
4. Prosecution issues
5. Other issues

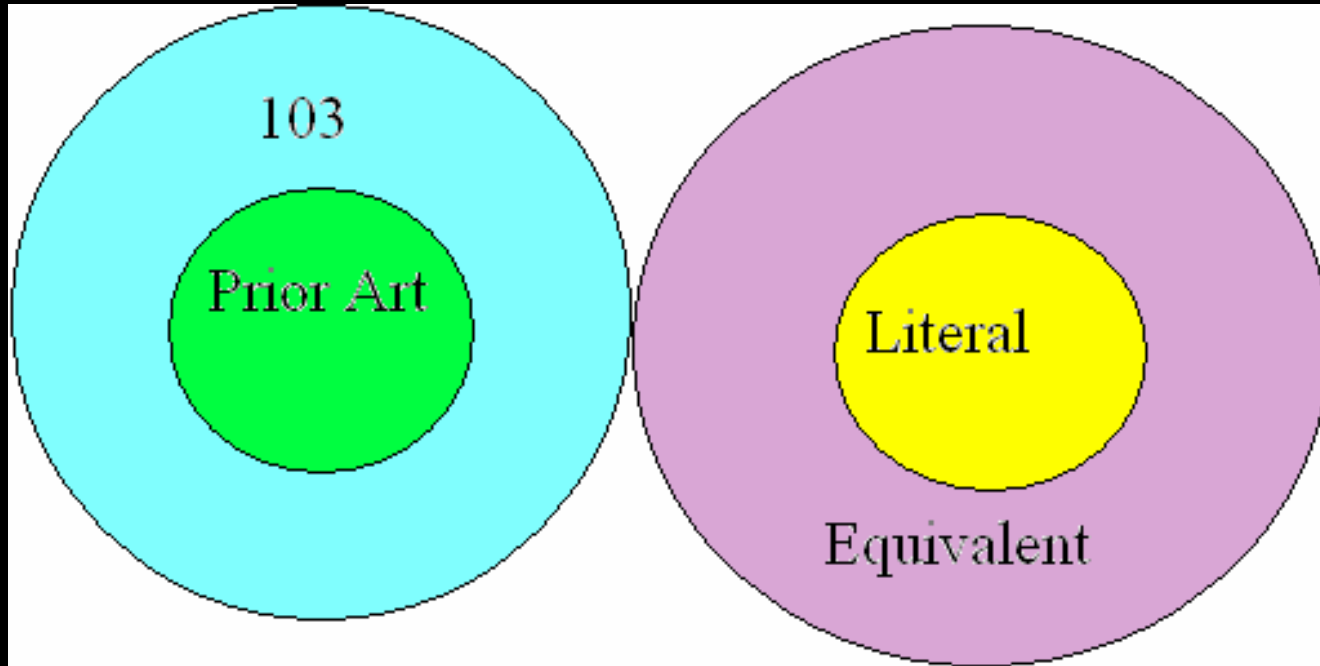
# Background of Law

- Interpretation has shifted from protection of the patentee to notice to the public.
  - *Wilson Sporting Goods*, 904 F.2d 677 (1990)
  - *Warner Jenkinson*, 520 U.S. 17 (1997)
- Interpretation may shift again – today's good practices may not be good tomorrow.

# Background of Law (cont'd)



# Background of Law (cont'd)



# Initial Considerations

1. Businesses obtain patents to advance the business, not the art.
2. Set a reasonable budget based on value.
3. Draft application with business objectives in mind.
4. Draft claims based on what will be sold.

# Claims Construction

- Understand the meanings of the transition clauses and use them properly.
- Be careful when using any word or phrase that is part of a legal term of art.
- “Group of first, second and third blades.”
  - *Gillette*, 405 F.3d 1367 (2005)
- Was it close-ended like “from the group consisting of”?
  - *Markush*, 1925 C.D. 126 (Comm’r Pat. 1925)

# Claims Construction (cont'd)

- Do you mean “means” or “means for performing a function”?
  - If not, strike “means”.
- A “whereby” clause may be considered a limitation of the claim.
  - Does it state a condition of patentability?

# Claims Construction (cont'd)

- Avoid time-dependent terms like “conventional,” “traditionally” and “standard.”

Example: “input/output port normally connectible to a conventional computer input/output port” (emphasis added).

- Limited to a port available at the time the application was filed.
- *PC Connector Solutions*, 406 F.3d 1359 (2005)

# Claims Construction (cont'd)

- To be or not to be indefinite?

Example: “Substantially dust free and non-dusting” or “dust free and non-dusting”

- In *Rhodia Chimie* the claims said dust free but the examples showed there was dust.
- Court concluded it should be read as “reduced dusting.”

# Claims Construction (cont'd)

- Don't expect forgiveness.
- Grammar matters.
  - Heating “to” is not the same as heating “at” in a claim for heating dough.
    - *Chef America*, 358 F.3d 1371 (2004)
  - “Objects fetched from said clients” should have read “objects fetched for said clients.”
    - *Teknowledge*, 73 U.S.P.Q.2d 1021 (2004)

# Claims Tiepos (*sic*)

- Typographical errors can be fixed if:
  - The correction is not subject to reasonable debate based on an evaluation of the claims and specification; *and*
  - The prosecution history does not suggest a different interpretation.
- In the previous example, the “from” was not a typo, and the court refused to rewrite the claim to make it operable.

# Claims Tiepos (cont'd)

Example: “Stop means formed on a rotatable with said support finger” (emphasis added).

– *Novo Industries*, 350 F.3d 1348 (2003)

- Possible changes:
  - Delete “a rotatable with”
  - Delete “with said”
  - Change “a” to “and”
- Because the correct choice was unclear, the claim was deemed indefinite.

# Functional Language in Claims

- Functional language is not inherently bad.
- The USPTO routinely rejects it.
- Tests for acceptable functional language:
  - Language must be sufficiently precise and definite to provide clear indication of the scope of the claim.
  - Language cannot be so broad that it causes the claim to have a potential scope beyond that which is justified by specification.

# Theories in Claims

- Avoid including theories of operation in the claim.

Example: Microwave/self-cleaning conventional oven combination.

“So that when [certain parts are in certain configurations, air passes into the waveguide and through the vent] notwithstanding the autoignition pressure.”

# Theories in Claims (cont'd)

- In the previous example, the “so that” clause was read as a means-plus-function clause.
- Because the function described did not occur, the claim was deemed invalid.
  - Enablement must exist.
  - The impossible can not be enabled.
  - *Raytheon*, 724 F.2d 951 (1983)

# Specification

- Avoid admissions of prior art.
  - Admission controls, even if it is wrong
    - *Riverwood Int'l Corp*, 324 F.3d 1346 (2003)
- Consider whether a background section is needed.
- If used, confine it to the relationship of the invention to other parts it is used with.

# Specification (cont'd)

- Avoid dedication to public by not claiming disclosed subject matter.

Example: In a vacuum cleaner— “said cover including means for increasing the pressure” (emphasis added).

- *Toro*, 383 F.3d 1326 (2004)
- Court found this required a one-piece cover.
- The specification noted the inferiority of a two-piece cover.

# Specification (cont'd)

- Patentee argued if sufficient to disclose for dedication, it was sufficient to support.
- Standards are not the same.
- Dedication needs only:
  - If one of ordinary skill can understand the unclaimed disclosed teaching upon reading the written description, the alternative matter disclosed has been dedicated to the public.

# Specification (cont'd)

- Unclaimed disclosed alternatives will be dedicated.

Example: Disclosure of “others metals, such as stainless steel or nickel alloys.”

- Claims recited only aluminum.
- Other metals, such as stainless steel or nickel alloys were dedicated.
- *Johnson & Johnston Assocs.*, 285 F.3d 1046 (2002)

# Specification (cont'd)

- Avoid limitations on the claims.
- “All embodiments of the present invention” limited claims to the coaxial lumen and did not cover a side-by-side arrangement.
  - *SciMed Life*, 242 F.3d 1337 (2002)

# Specification (cont'd)

- Be careful in using the word “invention” in the specification.
- “Statements that describe the invention as a whole, rather than statements that describe only preferred embodiments, are more likely to support a limiting definition of a claim term.”
  - *C.R. Bard*, 388 F.3d 858 (2004)

# Specification (cont'd)

- “Locking element” was construed to require play.
- In the specification, “invention” has “play.”
- All disclosed figures and embodiments expressly disclosed play.
- No suggestion of an embodiment without play.
  - *Alloc, Inc.*, 342 F.3d 1361 (2003)

# Specification (cont'd)

- Identify more than one embodiment in the summary of invention.
- Consider deletion of these terms and phrases:
  - Only, critical, crucial, key, essential, necessary, only embodiment, the invention
  - The invention, in all embodiments, in accordance with the present invention, advantages of the present invention

# Specification (cont'd)

- Terms of Art
  - How does a judge know if a term used in a patent is a term of art?
- Determine if any of the terms are terms of art.
  - Check technical dictionaries
  - Identify the terms of art.

# Specification (cont'd)

- Help define infringement.
- Be careful that chemical composition percentages are correct.
- The method of measurement should be stated.
  - Viscosity – Brookfield Standard
  - Make sure that standard methods have not been modified.

# Specification (cont'd)

- Avoid incorporation of reference.
  - Dedication possibilities
  - Inconsistencies in use of terms
- All examples should be clear and accurate.
- Prophetic examples should be clearly identified.
- Use dotted lines in design patents to illustrate unclaimed portions.

# Specification (cont'd)

- Statements can limit by stating what the invention is not.
  - *Omega Eng'g v. Raytek*, 334 F.3d 1314 (2003)
  - Therein the prosecution history was used to limit the limit the claims in that the patentee put the public on notice of the crucial feature of the invention – the invention would not add appreciable heat to the energy zone.

# Prosecution

- Restriction requirements
  - The subsequent applications must be divisional applications *Bristol Meyers*
  - Parent application with a restriction
  - Continuation application with all original claims
  - A different restriction was issued in continuation
  - Later two patents issued – one invalid for double patenting

# Prosecution

- Amendments
- Statements can limit the claims.
- Be careful when stating what the invention is.
  - *Microsoft v. Multi-Tech*, 357 F.3d 1340 (2004)
  - Invention limited to communication over the phone line

# Prosecution

- Affidavits – 131 and 132
- Targets
  - “If you give me six lines written by the hand of the most honest of men, I will find something in them which will hang him.” Cardinal Richelieu
- 131 -- Conception and reduction to practice.
- 132 – Can be submitted for various purposes— understand the legal requirements the purpose it is being submitted.

# Prosecution

- Submit affidavit only if needed.
- Make sure that it is an accurate representation of events.
- Do not treat any affidavit as a pro-forma matter.

# Are you part of the team?

- Keep in contact with people working on related applications.
- Keep in contact with people working on related regulatory matters.

# Prosecution

- Double patenting—remember they must be commonly owned at the time of invention.
- Examiner's reason for allowance:
  - Contest them
  - They will limit the scope of the claims
  - Failure to respond to a narrow reading is acquiescence
  - Consider a continuation

# Prosecution

- After allowance:
  - Review the claims
  - Correct typographical errors
  - Add additional claims
  - Consider a continuation
- After issuance:
  - Submit certificates of correction as needed

# Discovery and you

- Assume that each document you prepare may be discovered.
- If you believe it is privileged add to the document indicia of privilege
  - Identify the lawyers
  - Identify the request from the client
  - Label as privileged
  - Label with restricted distribution

# Conclusion

- Prosecution requires a delicate balance of precision and ambiguity.
- Great care must be exercised in selecting words remember:

“The difference between the right word and the almost right word

is the difference between

lightning and the lightning bug.”

Mark Twain

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