

Patent Enforceability - Increasing the Odds

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Strategies for Drafting Infringeable Claims



Securing Innovation

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A. Statutory Requirements

- Number of statutes affect claim enforceability/patentability
- Have no control over some
 - 35 U.S.C. 102 (Novelty)
 - 35 U.S.C. 103 (obviousness)
- Concentrate on what have control over
 - 35 U.S.C. 101
 - 35 U.S.C. 112

1. 35 U.S.C. 101 & Claim Drafting

- 35 U.S.C. 101:
 - Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.
- What does this mean?
 - Utility: Must have real world utility
 - Cannot be too abstract
 - If product exists or is natural phenomenon, claim process

1. 35 U.S.C. 101 & Claim Drafting (Cont.)

- Claims not exact duplicates
 - “a patent”
 - Double patenting rejection
- One invention per application
 - Restriction/election practice
- Examiner’s inconsistent with restriction
 - Product + Method
 - Combination + Sub-combination
- Reality: Imposed when too many claims
- Always take the 20 total claims and 3 independent claims
 - Not always cost effective to file more since will likely be restricted



1. 35 U.S.C. 101 & Claim Drafting (Cont.)

- Statutory subject matter
 - “process, machine, manufacture, or composition of matter”
 - When drafting, need to decide which it is
- Microorganisms
 - Type of Manufacture
 - If result of human intervention, can patent
- Computer software
 - Can claim as machine, manufacture, process
 - If want software on disk, need more than mere arrangement of data
 - Need functional links
 - Need to have encoded in a memory

2. 35 U.S.C. 112 & Claim Drafting

- 35 U.S.C. 112, First Paragraph
 1. Written Description
 2. Enablement
 3. Best Mode
- Practically, when drafting claims, can prevent by ensuring description supports invention
 - Similar terminology helpful
 - Some like to copy claims into specification

2. 35 U.S.C. 112 & Claim Drafting (Cont.)

- 35 U.S.C. 112, Second Paragraph
 1. Subject matter which applicant defines as invention
 2. Definiteness
- Practically, when drafting claims, can prevent by ensuring
 - Claims do not conflict with statements about what is not the invention
 - Claims do not have typos, have antecedent basis
- Remember: Breadth is *not* indefiniteness
 - Relative terminology, numerical ranges, lexicographer ok
 - Usually good to have depending claims further defining

2. 35 U.S.C. 112 & Claim Drafting (Cont.)

- 35 U.S.C. 112, Sixth Paragraph
 - Means + function
 - Can be very narrow since applies only to the disclosed structure + equivalents
 - Deceptive since look broad
 - Use sparingly or only for features with large number of embodiments
- If use, must ensure have strong support in specification
 - Heightened written description requirement

B. Types of claims

- Independent claims
 - System claim
 - Collection of items operating together
 - Especially useful where part of novelty is interaction
 - Method claim
 - How the invention works in real life
 - Often used in software claims to claim functionality independent of hardware
 - Process claim (type of method)
 - If invention involves manufacturing, process can be valuable
 - Apparatus claim
 - The item itself, claimed stand alone
 - Product by process claims (type of apparatus)
 - Where process defines structure

B. Types of claims

- Dependent claims
 - Have 20 total claims, take them
 - Never know at filing what is “the invention”
 - Usually multiple small advances in same application
 - Depend claims flush out individual items of novelty
 - Dependent claims often force broader construction for term
 - Dependent claim means depends on prior claim
 - Consider instead of new independent claims
- Multiple dependent claims
 - European practice
 - Used rarely if ever in US since incur surcharge

C. Keep possible infringers in mind

- Heart of claim drafting is having target of claim
 - Otherwise, just an expensive technical report
 - Read consumer magazines to keep eye on market
 - Know your customer's market
- Who is the potential infringer/licensee?
 - Manufacturer
 - Supplier
 - Distributor
 - Seller
 - Customer
 - Customer rarely sued: If claims only cover customer, must rely on inducement/contributory infringement for remaining targets
- Once identify, draft claim from perspective of target

C. Keep possible infringers in mind (Cont.)

- What is market for licensing
 - Single item sale
 - Per transaction
 - After-market sales/consumables
- Type of market helps govern what will claim
 - If market is single item sale
 - Claim apparatus in all variants (no methods, no system)
 - If market is consumables
 - Claim system independent of consumed item
 - Razor + razor blade system separate from consumable razor blade
 - Per transaction
 - Claim method covering each transaction individually from perspective of target
 - Transaction from perspective of server as opposed to browser

1. System claims

- System claims cover collections of items
 - E.g., computer interacting with server, car and tires, printer and cartridge
- Problems with system claims
 - Often no direct infringement by one entity alone
 - Usually combination of customer and seller
 - Get into cross border issues
 - Expensive to enforce
- Useful where know system is sold as a whole to one entity
 - Providers: Manufacturer, Supplier, Distributor, Seller
 - Receiver: Customer who uses system

2. Method claims

- Method claims useful where infringement is per use or where novelty is only in process
 - Broader since independent of apparatus
 - Harder to enforce (more \$\$ to enforce) since must show process performed
- Are benefits for preventing importation since lower standard
 - 35 U.S.C. 271(g): covers importation of processes performed outside US
 - Burden shifting under 35 U.S.C. 295: only substantial likelihood that method used
 - 337 Action before ITC has broad coverage

2. Method claims (Cont.)

- Are benefits for signal transfers/per transaction invention
- Claim method according to target
 - Processor/Importer: Manufacturer, Supplier, Distributor, Seller
 - Transaction provider: Seller's interaction with Customer
 - End user: Customer use
- Don't forget to ensure covers U.S. based infringement
 - Claiming activity occurring only outside US does you no good
 - RIM versus NTP

3. Apparatus claims

- Apparatus claims
 - Especially useful for single item sales and/or consumables
 - Allows for creative licensing
 - E.g., *LG Electronics, Inc. v. Bizcom Electronics, Inc.*, 453 F.3d 1364, 79 USPQ2d 1443 (Fed Cir. 2006)
 - End user license restricting combination of patented apparatus with only certain products and not others
 - Restrict after market sales by withholding license on separately patented consumables
- Coverage
 - Provider: Manufacturer, Supplier, Distributor, Seller
 - User: Customer

4. Special topics

- If system claim, can infringement be avoided by placing components outside the U.S.?
 - Highlights problems with system claims
 - Often within reach of 35 U.S.C. 271(f)
 - Whoever without authority supplies or causes to be supplied in or from the United States all or a substantial portion of the components of a patented invention, where such components are uncombined in whole or in part, in such manner as to actively induce the combination of such components outside of the United States in a manner that would infringe the patent if such combination occurred within the United States, shall be liable as an infringer.
- Expensive to show
 - Better to provide infringement of components being supplied?

4. Special topics (Cont.)

- Will patentee be pursuing direct infringers or indirect infringers?
 - Always want direct infringement
 - Easier/cheaper to prove
 - Problem with indirect infringer
 - Need to show some element of knowledge
 - If not active inducement, are defenses based upon substantial non-infringing uses
- Is claim written such that only end-user/customer is the direct infringer?
 - If only end user, not typical licensee or desired target