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Phone: +1 646 783 7100 | Fax: +1 646 783 7161 | customerservice@law360.com

5 Ways To Draft Bulletproof Patent Claims

By **Erin Coe**

Law360, New York (January 25, 2011) -- The value of a patent boils down to its claims, and if prosecutors fail to say exactly what they mean during the drafting process, they can cost their clients dearly down the road, attorneys say.

When Chef America Inc. accused Lamb-Weston Inc. of infringing a patent covering a process for making dough, it ran into problems with one of its patent claims that required "heating the resulting batter-coated dough to a temperature in the range of 400 degrees Fahrenheit to 850 degrees Fahrenheit."

Lamb-Weston argued that heating the dough between that temperature range would turn it to charcoal, and while Chef America asserted its claim really meant to heat the oven to that temperature, the U.S. Court of Appeals for the Federal Circuit ruled in 2004 that it was stuck with what the claim actually said and affirmed Lamb-Weston did not violate the patent as a result.

"This is why claims matter," said Edmund J. Walsh, a shareholder of Wolf Greenfield & Sacks PC. "A very large percentage of patent trials end in some way by settlement, dismissal or summary judgment right after the judge determines what the claims mean. They drive the resolution of a case."

Here are five strategies for prosecutors to shield patent claims from attacks in court and boost licensing deals:

Consider the Targets of the Patent

When drafting patent claims, prosecutors must take into account the parties that a client would want to sue in a patent infringement action or engage in licensing discussions, according to attorneys.

"When drafting claims, prosecutors need to look at who the client wants the infringer to be and make sure the claims are covering that," said Robert A. Kalinsky, a partner of Merchant & Gould.

If the client seeks to prevent a competitor from developing the same product, the claims need to protect the way the invention is made, and if the client wants to keep parties from using an important part of its product, the claims should protect the method of using the invention, he said.

Patent attorneys, however, want to avoid claiming the use of a product if that only targets a client's end consumers, he said.

Kalinsky recently came across a poorly written patent for an automobile part, in which the

claim language only allowed for the patent to be infringed if the party possessed the entire car.

"It was a claim that was probably of little value because the only infringer would be the end user, not the person making the part since that person wouldn't have the complete automobile that the claim covered," he said.

The claims should also show that one entity is performing all elements of the claims, according to attorneys.

"Sometimes claims are written that require steps or pieces of a claim to be done by multiple people," Walsh said. "If no one person has done all of the steps, there will be nobody to sue."

Prosecutors should also not lose sight of who the claims are designed to protect. If a prosecutor is drafting a patent on behalf of a nonpracticing entity, which is mainly interested in collecting and licensing a portfolio of patents, there can be benefits to writing claims that are intentionally vague, according to Paul B. Hunt, a partner at Barnes & Thornburg LLP.

"In general, large established companies that are making widgets or drugs are more interested in making sure their true inventions are not used by others and benefit more from clear claim language," he said. "But those involved in large-scale patent portfolio collection and licensing may obtain more value with less clarity in claims because it may make others a little uncertain about whether they need the patent or not."

Understand Your Client's Business Objectives

In order to decide what should be highlighted in a patent's claims, prosecutors need to get a sense of the client's business goals and the competitive landscape.

"When working on a patent application, the practitioner should start off by reviewing the commercial problem the client is trying to solve with the invention and discuss with the client a core list of features that should appear in the claims," Walsh said. "Focusing on a solution to a problem makes a patent valuable."

A common mistake prosecutors make is writing claims from the perspective of how the client views products versus how competitors see them, and prosecutors would be wise to take note not only of their client's particular language to describe its products, but recognize the language used for rivals' products, he said.

"Considering how competitors might think around a claim will lead to a better patent," Walsh said.

Patent attorneys always need to be looking ahead at how an invention will be practiced after the patent is granted and years into the future, he said.

"Prosecutors must abstract the core ideas that will be persistent over time," he said. "They need to think about the words that will describe what will be important when the client goes to use the patent."

Know What the Claim Terms Mean

The main skill that prosecutors bring to the table is selecting the appropriate terms to describe an invention, and using the wrong word can put the client at a severe disadvantage in litigation and licensing talks.

"In expensive cases, every word written will be dissected," Hunt said.

Patent attorneys often face real budget constraints when drafting a patent application, and while they may have a budget of \$10,000 for prosecution, the patent that comes out of that process may end up being asserted in a \$5 million litigation battle in which the accused infringer is going to spend time and money to comb through and identify any weaknesses in the claim language, he said.

"Prosecutors don't have unlimited time to make sure every word is as precise as it should be," Hunt said. "Although they may think they understand the words they use, prosecutors frequently use words in documents that don't precisely match up with what the dictionary terms mean."

Patent attorneys should not just make sure the words they are using line up with the dictionary context, but should also consider how the courts and those in the art are interpreting a term, Kalinsky said.

For example, using the phrase "substantially 100 percent" may seem like there is some wiggle room in the claim, but courts have given the term "substantially" a narrow definition. Using the term "about" instead may give a broader construction for litigation purposes, according to Kalinsky.

"Prosecutors are better off not relying on adjectives and adverbs because you never can be sure how they are going to be interpreted," he said. "In litigation, every word is scrutinized and every word is a potential argument for noninfringement by an accused infringer. If claims have extra adjectives or adverbs that are not necessary for patentability purposes, they should be pulled out."

Words can often have multiple meanings — even words as seemingly straightforward as "when."

In Renishaw PLC's case alleging Marposs Societa' Per Azioni infringed a patent covering a touch probe used to check dimensions of machine parts, the main dispute on appeal centered on the requirement that the claimed probe generated a trigger signal when a sensing tip contacted an object and a stylus holder was deflected.

The district court determined that "when" meant "as soon as contact is made and deflection occurs," but Renishaw argued that "when" should be interpreted more broadly as "at or after the time that" or "on condition that," indicating that a trigger signal could not be generated until after contact is made and deflection begins. But the Federal Circuit in 1998 agreed with the district court's construction that the events happened simultaneously, holding that the patent was not infringed.

"It's unlikely the prosecutor who used the word 'when' had thought much about the term, but it made all the difference in the outcome," Hunt said.

Avoid Limiting the Scope of the Claimed Invention

When filling out information for a patent application, prosecutors must be careful about unintentionally narrowing the scope of the claimed invention, according to Joseph M. Potenza, a shareholder of Banner & Witcoff Ltd.

In Hill-Rom Co. Inc.'s case alleging Kinetic Concepts Inc.'s hospital beds infringed its patent, Hill-Rom claimed the district court erred in interpreting the term "cushion" to mean "an inflatable enclosure or bag, which, when inflated, should provide basic support and comfort, but which does not necessarily have to be inflated at all times," and should have been interpreted more broadly to mean "an enclosure or bag capable of being inflated."

The Federal Circuit in 2000 affirmed that Kinetic did not infringe the patent, in part by pointing to Hill-Rom's abstract, which emphasized the support and comfort provided by the cushions, according to Potenza.

"The defendant's product was inflated to help turn a patient rather than to provide support and comfort, and that distinction raised by the defendant was what the court relied on," he said.

Prosecutors can also run into trouble when summarizing the invention. The Federal Circuit in 2004 upheld that C.R. Bard Inc. failed to show U.S. Surgical Corp. infringed its patent covering a device to repair hernias, in part noting that in its summary of the invention, the patentee referred to a mesh surgical plug that includes a pleated surface.

The pleated reference was held to be limiting under the facts of the case, Potenza said.

By mentioning certain features in a patent application, prosecutors could risk being penned in by them, he said.

In Honeywell International Inc.'s case alleging ITT Industries Inc. violated a fuel system patent, the Federal Circuit in 2006 upheld a district court's grant of summary judgment of noninfringement that found the patentee's written description characterized a fuel filter as the only embodiment of the invention, not merely a preferred version of all possible embodiments.

The Federal Circuit agreed that the fuel filter and the defendant's products — quick connects that join components of a fuel injection system together — were not equivalent devices, Potenza said.

These court examples signify prosecutors have to stay on top of what happens in litigation and how certain disclosures made in patent applications may be potentially limiting, according to Potenza.

Defendants and third parties are always on the lookout for a potential hook in a case so they can argue a plaintiff's claims do not cover the accused products, he said.

Make a Complete Disclosure

Another critical aspect in writing up an application is making sure to submit a full disclosure that may give the client more flexibility later.

By including alternatives to the invention or other material that a client is not claiming initially, prosecutors may find that the additional information becomes useful down the road, such as when competitors are practicing something mentioned in the disclosure, according to Kalinsky.

"Get as full a disclosure as you can up front because once you file it, that sets your universe," he said. "You are free to claim what's in that universe, but you can't go outside of that."

After one of Kalinsky's clients noticed a competitor's product had a particular feature related to plastic coupling technology, it reviewed a pending patent application that had mentioned the same feature in its disclosure but had never claimed it.

"We wrote the claims to that feature and we were able to cover what the competitor was doing," he said. "The only reason we were able to do so was because the disclosure had the material in it."

Many patent applications also run up against prior art. By having extra material in the patent application that hasn't been claimed yet, an applicant may be able to shift the focus of its claims and distinguish them from the prior art, Kalinsky said.

However, Kalinsky noted there are also advantages to submitting a narrowly drafted patent application, especially with software applications.

"Some clients value getting a patent that may be slightly narrower if they are able to get it through the patent office," he said. "The application is more likely to move through prosecution quickly and lead to a patent."

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