

Klarquist



Creative and Strategic Claim Drafting

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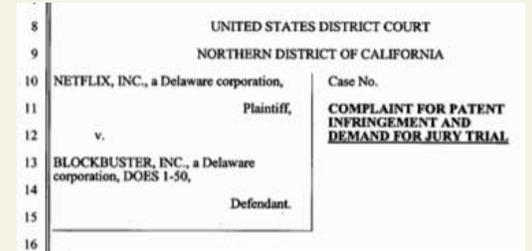
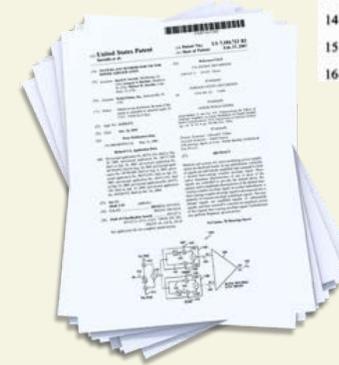
No “Best” Way To Draft Claims

- Numerous scenarios
- Numerous approaches
 - Not all always applicable
 - Not all always possible

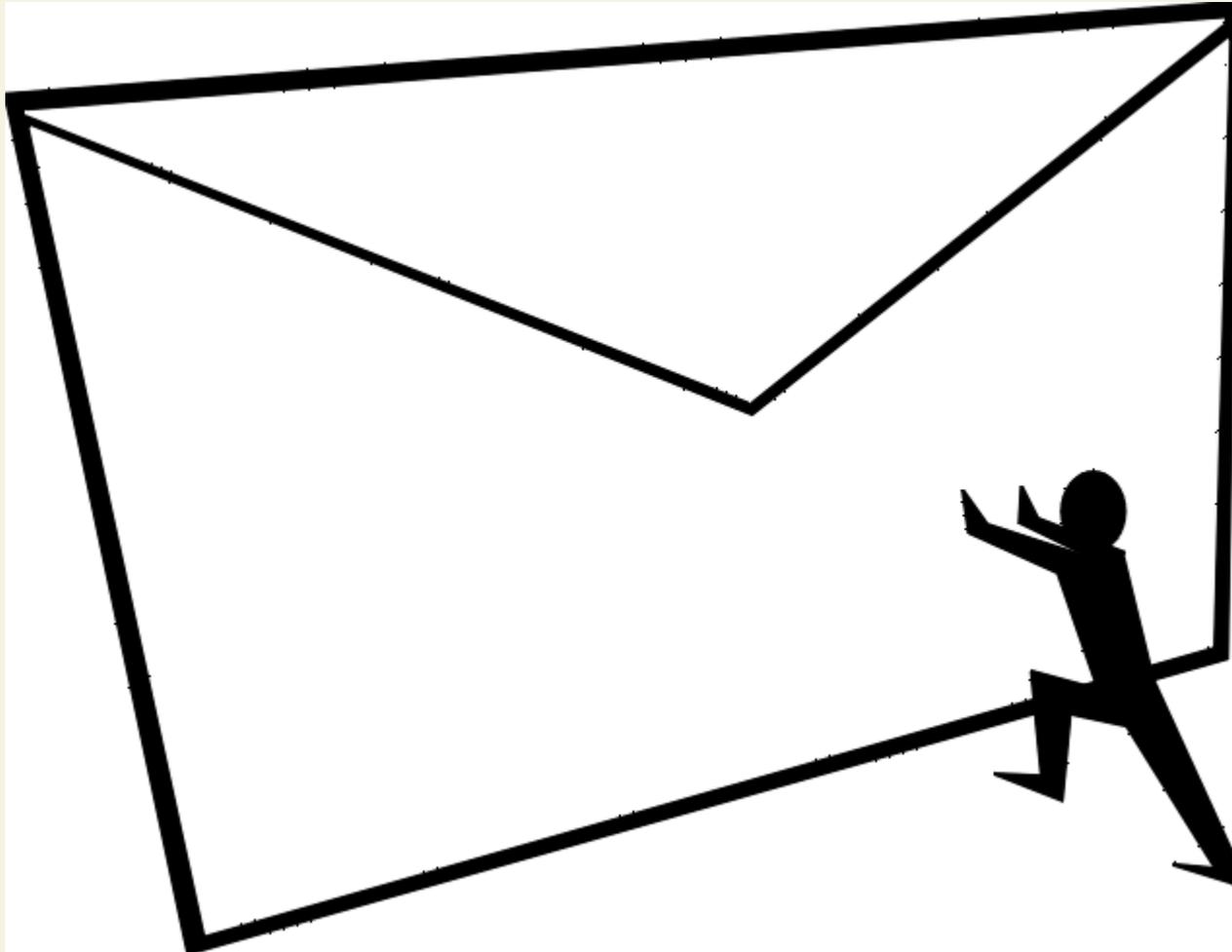


Considerations / Limitations

- End goal (assertion or stack of patents?)
- Budget
- Timeline
- Application (are your claims supported?)
- Jurisdiction (U.S. v. foreign filing)
- Invention (breakthrough or incremental?)
- Expect PTAB challenge?
- Will the law change (e.g., Myriad)

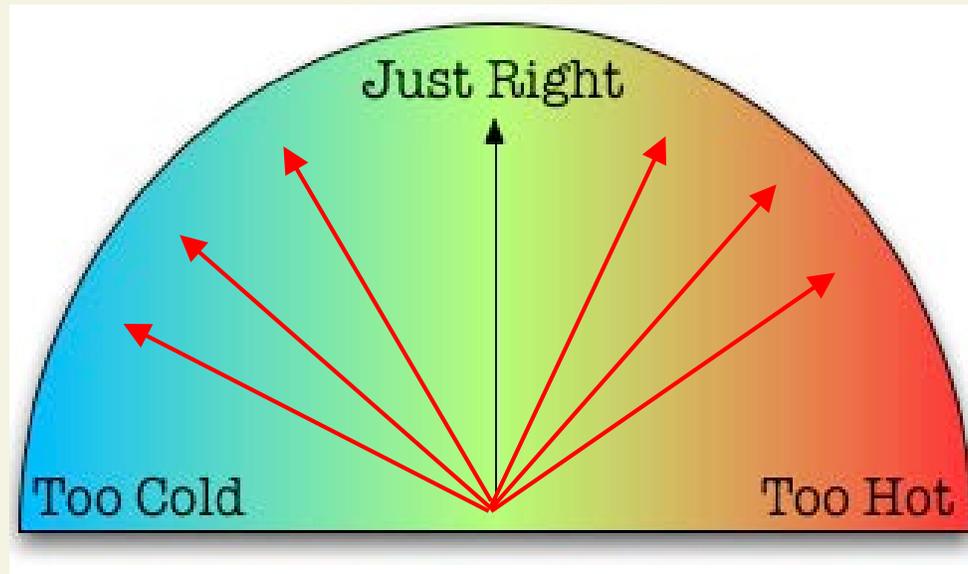


Push the Envelope (Push the Client)



“Goldilocks” Claim

- Broad and enforceable
- But clearly distinct from prior art



Property-Based Claims

- Don't specify your material (in broadest claims)
- Specify its properties
- Include a detailed and repeatable test in the specification



Property-Based Claims

- Why / when:
 - make it hard to do noninfringement analysis
 - make it hard for examiner to find specific prior art
- *But see Atlas Powder v. Ireco* (Fed. Cir. 1999); *see also* MPEP 2112.01-.02
- Downsides
 - Prior art
 - Full scope enablement?
 - Indefiniteness (functional claiming)?

Property-Based Claims

Example

- Claim: “a diaper material positioned between two layers, wherein said material can absorb at least 2 ounces of mysterious blue liquid per minute”
- Spec: describes test for measuring this rate of absorption
- A better alternative: “wherein said material has a Huggie quotient of 2.0”



Capability Claims

- Claim system / apparatus capabilities
 - “transceiver configured to”; “processor capable of”; “memory for”
- But be thoughtful
 - Avoid the quick-and-dirty apparatus-as-method claim
 - Draft carefully and consider your specification
 - Only introduce MPF consciously
 - make sure you have a structure, especially post-*Williamson*!



Capability Claims

- Why / when:
 - Make it hard to find prior art
 - Easier to establish direct infringement by mfr.
 - Bypass 112/6 downsides
 - But be careful post-*Williamson* (“functional” claiming?)
 - Useful when targeting standards
 - But beware patentable weight issues

Capability Claims

- “adapted to”
- “configured to”
- “capable of”
- “suitable for”
- “for”

Capability Claims

- “Adapted to”
 - “‘adapted to’ is sometimes used in claim drafting to carry the broader meaning [of ‘suitable for’], and sometimes to carry a narrower meaning closer to [‘configured to’]”
 - “In this case, we conclude that the narrower meaning is correct.”

Aspex v. Marchon (Fed. Cir. 2012)

Capability Claims

Example #1

12. A portable, keyboardless, computer comprising:

...

a **memory for storing** at least one data collection application configured to determine contents and formats of said inquiries displayed on said screen;

a **processor** coupled to said memory and said input/output device **for executing** said data collection application

...

Typhoon Touch v. Dell et al. (Fed. Cir. 2011)

Capability Claims

Example #1

- “a memory for storing at least one data collection application”
 - Construction: A memory that must perform the recited function [device must store or be structured to store at least one “data collection application”]
 - Spec support: “[T]he memory of the portable computer stores a data collection application.”

Capability Claims

Example #1

- “processor . . . for executing said data collection application”
 - Construction: “the recited function must be performed (namely, executing the application and the libraries to facilitate data collection operations)”
 - Spec support: “The CPU of the portable computer executes the application and processes the manually entered data pursuant to the application.”

Capability Claims

Example #2

1. A communications station comprising:

a processor for arranging information for transmission including providing at least one first field in which payload information is disposed and providing at least one second field, separate from said first field, which includes a service type identifier which identifies a type of payload information provided in said at least one first field; and

a transmitter for transmitting information received from said processor including said at least one first field and said at least one second field.

Ericsson v. D-Link (Fed. Cir. 2014)

Capability Claims

Example #3

The apparatus of claim 3 wherein the coordinate region locator includes a **controller adapted to**

(a) move the main sensor in a predetermined pattern surrounding the expected location of the subset, and

(b) stop the movement of the main sensor when the coordinate region of the subset is located within the field of view of the main sensor.

Mikkelsen v. Zund – (E.D. Wisc. 2011)

Capability Claims

[W]hen the asserted claims recite capability, our case law supports finding infringement by a **“reasonably capable” accused device on a case-by-case basis** particularly where, as here, there is evidence that the accused device is actually used in an infringing manner and **can be so used without significant alterations.**

Ericsson v. D-Link (Fed. Cir. 2014); *see also Fantasy Sports v. Sportsline* (Fed. Cir. 2002); *but see Typhoon Touch v. Dell et al.* (Fed. Cir. 2011) (“memory for” construed to require that memory actually perform recited function); *Ball Aerosol v. Limited Brands* (Fed. Cir. 2009) (no infringement because no facts showing that accused device had to be placed in infringing configuration); *Telemac Cellular Corp. v. Topp Telecom, Inc.* (Fed. Cir. 2001).

Capability Claims

- MPEP 2181

“The following is a list of non-structural generic placeholders that may invoke 35 U.S.C. 112(f) or pre-AIA 35 U.S.C. 112, paragraph 6:

‘mechanism for,’ ‘module for,’ ‘device for,’ ‘unit for,’ ‘component for,’

‘element for,’ ‘member for,’ ‘apparatus for,’ ‘machine for,’ or ‘system for.’”

- MPEP 2114 – inherency in functional claims

Environmental Claiming

- Build up the claim by limiting the environment
- Elements that “limit only the claimed environment [do] not need to be performed or used by the accused infringer.”
 - *Advanced Software v. Fiserv* (Fed. Cir. 2011)

Environmental Claiming

- Why / when:
 - Distinguish prior art without multi-actor infringement issue
 - Get around unrelated art with similar structure
- Potential downsides
 - Must still be satisfied (by someone) for finding of infringement

Environmental Claiming

Example #1

1. A process of validating a negotiable financial instrument made by a payor, in which selected information . . . is encrypted . . . to generate a control code which is printed on the financial instrument . . . , the process comprising:

reading the selected information from the financial instrument; and one of

- (i) decrypting the control code to . . . , and
- (ii) re-encrypting the selected information as presented on the financial instrument to

Environmental Claiming

Example #2

19. A remote registration station incorporating remote licensee unique ID generating means, said station forming part of a registration system for licensing execution of digital data in a use mode,

said digital data executable on a platform,

said system including [system requirement],

said system further including [system requirement]; and

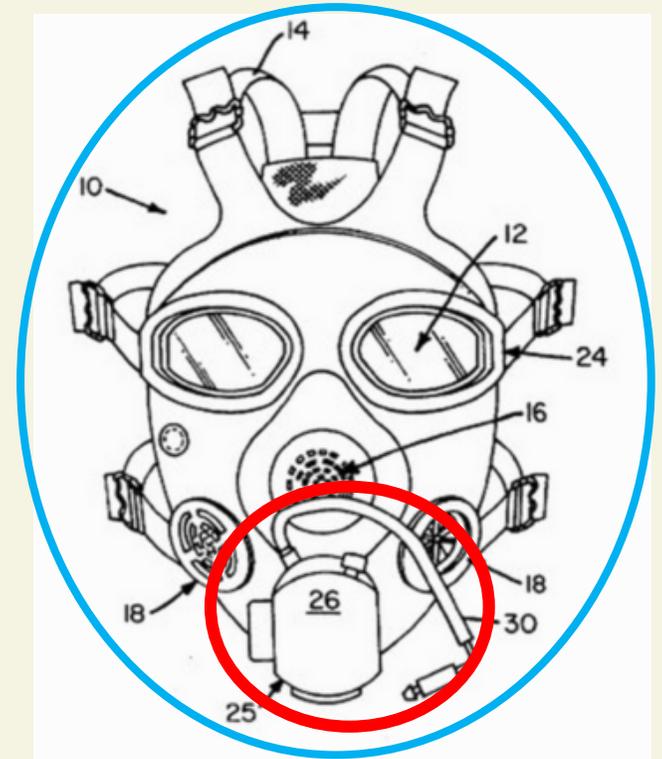
wherein said remote licensee unique ID generating means comprises

Environmental Claiming

- *Advanced Software* (Fed. Cir. 2011)
 - “preamble steps of system claim . . . merely define the financial instrument that the claimed system validates”
 - “the claims at issue in this case contain preambles that define the environment”
- *Uniloc v. Microsoft* (Fed. Cir. 2011)
 - “That other parties are necessary to complete the environment in which the claimed element functions **does not necessarily divide the infringement** between the necessary parties.”

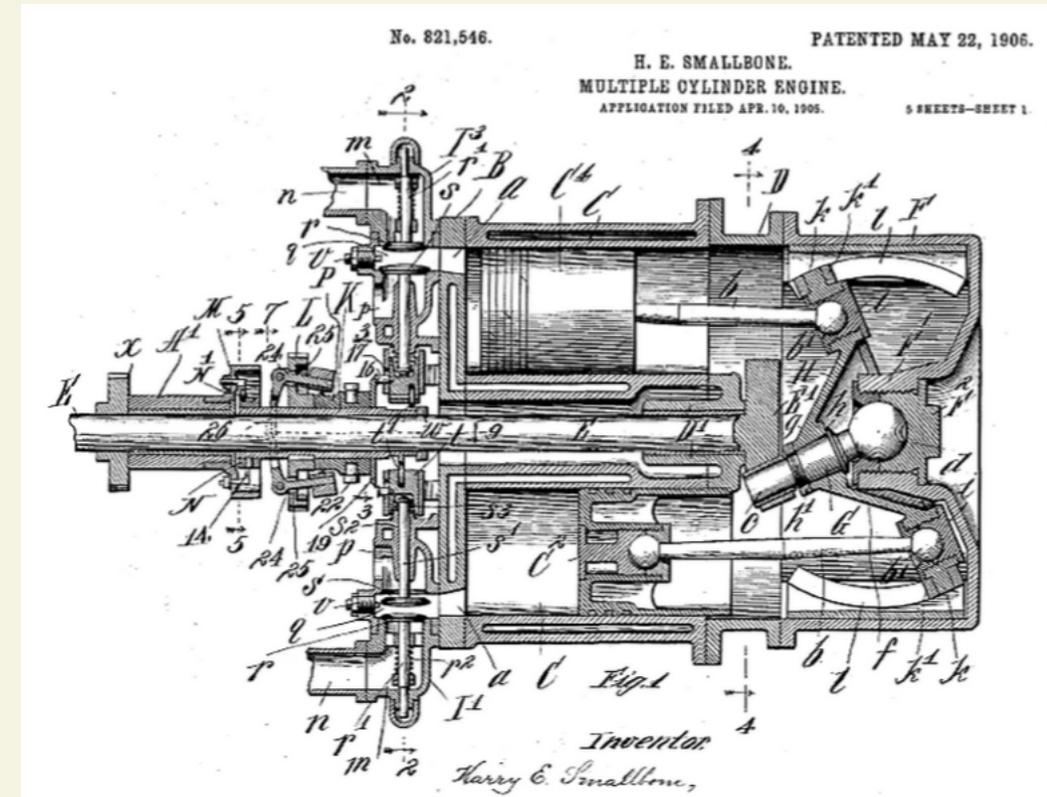
Isolate the parts

- Direct claims to only a portion of the invention
- Why / when:
 - Easier to establish direct infringement
 - Avoid multi-actor scenarios
 - ITC exclusion of partially completed product
- Possible downsides:
 - Easier to find prior art?
 - Do claims stray from your point of novelty?
 - Lower damages?



Isolate the parts

- Intermediate point claim
- Claim a portion of the process
 - or move a portion to the environment
- *See Exxon v. Lubrizol* (Fed. Cir. 1995)
 - Claim to chemical composition
 - Patentee forced to target product in pre-final state
- *See Suprema, Inc. v. ITC*



Claim the whole

- Build the claim up around the invention?
 - “claim the truck, not the engine”
 - Good use of dependent claim
- Why / when
 - Increase your damages base.
 - *But see VirnetX v. Cisco* (Fed. Cir. 2014)
 - Make it harder to find prior art



Lengthen the claim?

- Ask inventors for additional related features, even if seemingly obvious
- Why / When
 - Make prior art searching more difficult – hit the prior art sweet spot
- *Examples*
 - *Supra* environmental claiming
 - Intended use language



Post-manufacture usage

- Look beyond the initial product state
- How will your composition be used?
- How will your product change?



Post-manufacture usage

- Why / when:
 - Compounds often intended for particular uses
 - Structures change through use
 - Will a worn part fall outside your claim scope?
 - Is there a worn part that customers will want to replace?
 - Avoid exhaustion and similar problems
 - But pay attention to forthcoming *Lexmark* opinion
 - 271(g)



Post-manufacture usage – combination

- See *Exxon v. Lubrizol* (Fed. Cir. 1995)
 - Claim to chemical composition
 - Patentee forced to target product in pre-final state



Post-manufacture usage – wear and tear

- *Lexmark v. Impression Prod.*
 - *en banc* hearing on October 2, 2015
- *Surfco v. Fin Control* (Fed. Cir. 2001)



Claim all solutions

- Don't just claim the primary solution
- Have your inventors back up, explain the initial problem posed, and explain all options they pursued (or thought of pursuing)
- Why / When
 - Keep competitors from using alternative approaches
 - If your client's R&D process develops numerous possible approaches to a problem



Choose your language carefully

- Don't accept inventor statements at face value
- Make sure it's actually a term of art!
- When appropriate, specifically define your terms
- Why / When
 - People have different understandings of terms (attorney, inventor, examiner)
 - Avoid a lengthy fight by having necessary definitions in the spec
- Downsides
 - If your term is over-narrow, it may pose infringement problems



Choose your language carefully

Example

A method comprising:

modifying the operating system registry . . .

Avoid terms of art?

- Consider describing basic concepts more creatively
- Why / When
 - make prior art searching hard, but still allow you to argue infringement
 - May give the claim a “loftier” feel
- Examples
 - It’s not a screw, it’s a “threaded fixation device”
 - It’s not a timestamp, it’s a “modification identifier”



Careful use of terms of approximation

- Avoid relative terms in the claims?
 - absent a compelling reason and a compliant examiner
- Why / when
 - Examiners dislike them
 - Avoid indefiniteness fight
- But . . . consider discussion or definition in the specification
 - E.g., “unless otherwise stated, discussion of a particular amount encompasses that amount +/- 10%”
 - This approach has downsides too
 - Don’t go overboard, i.e., “conjunctive means disjunctive” is risky

Careful use of terms of approximation

- *Seattle Box Co. v. Indus. Crating & Packing* (Fed. Cir. 1984) (“When a word of degree is used the district court must determine whether the patent’s specification provides some standard for measuring that degree.”)
- *Ecolab, Inc. v. Envirochem, Inc.* (Fed. Cir. 2001) (“[T]he term ‘about,’ the term ‘substantially’ is a descriptive term commonly used in patent claims to ‘avoid a strict numerical boundary to the specified parameter.’”)
- Will *Nautilus* change definiteness of these terms?

Data structures?

- Allows you to capture the interesting effects of the data on the computer, e.g., more efficient memory usage, faster processing
- Why / When
 - Claim tangible benefits of storing and interrelating data in specific ways
 - E.g., calculations are done more efficiently, less memory is used, etc.
- Shaker ground post-*Alice*
 - Not enough to merely allow computer automation
 - *Alice*: stressed distinction between abstract idea and abstract idea integrated “into something more”

Meaningful dependent claims

- Have a purpose!
 - Make dependent claims into something people care about
 - Do you really want a claim “wherein the wheel is red”?
 - Explain / flesh out your independent claim terms

PTAB Challenge?

- Make it hard for petitioner to hit the page limits!
- Strategies
 - File more claims
 - Include more diverse claims – “cluster claiming”
 - Include an MPF claim(s)
 - Submit a declaration?

Intentionally Narrow Independent Claim

- Draft to your client's (or competitor's) product
- Don't lose context
- Why / when
 - Avoid prior art, avoid RCE
 - Helps identify scope of what is allowable → focus prosecution
- Possible outcomes
 - Examiner does not even look at it (one extreme) → still get RCE
 - Examiner latches onto it and forces all other claims to contain its limitations (other extreme) → make sure it's an enforceable claim

Write 5-7 independent claims that are as different as possible

- Why / When:
 - Whenever time allows
 - Your budget may not allow you to file all of them, but the exercise should help you figure out your best claims
- Include
 - Method
 - Apparatus
 - System
 - Composition
 - Property-based
 - Function-based
 - Means-plus-function

Add claims to the spec?

- Dedicates to public (-)
- Preserves options without extra claim costs (+)
- May avoid new matter rejections down the road (+)
- Takes more time (-)
- Protection in Europe (+)

More to think about

- Multi-actor infringement – *Akamai, Centillion*
- Use claim differentiation?
- Delete unnecessary claim limitations in initial application?
 - Generally impermissible to read a limitation into a claim when that limitation previously has been deleted from the claim
- 102(g) overseas manufacture
 - Claim the final manufacturing step, even if not the focus of your invention

Trouble drafting?

- Draft an absurdly broad or absurdly narrow claim
- Then work to the middle
- Supra “goldilocks” claim

To Do

- Try to spend 30 minutes thinking about alternative claims and, when pertinent, push your client to add those claims
- Push the envelope – add more value
- Ask a litigator
- Review Klarquist Patent Defenses at least every January, July
 - www.patentdefenses.com

Why take the time?

- Adds value for the client
- Makes it more fun
- Gives opposing litigators fits



Thank you!

Follow-up questions:

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