NEEDLE & ROSENBERG
INTELLECTUAL PROPERTY ATTORNEYS

Interviewing Inventors and Claim Drafting

for the State Bar of Georgia, IP Law Section

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Agenda

- Claim Drafting
- Interviewing Inventors

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"In theory, theory and practice are the same." In practice, they are not."

Attributed to Lawrence Peter "Yogi" Berra

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What is a Claim?

- Defines the meets and bounds of the invention
  - Similar to a real property deed
  - Central claiming *versus* peripheral claiming

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Example Claim

A conductive composition comprising
(a) copper and
(b) gold.

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Claims in the Larger Context

- Parts of the application
  - Specification
  - Claims
  - Figures

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Purposes of Claims (and Patents)

- Licensing asset
- Asset for sale
- Asset for investment
- Asset in a foreign country for partnering
- Monopoly prices
- Injunction/exclusion

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Purposes of Claims (and Patents) (*cont'd*)

- Exclusion of competitors in a pioneering field to gain a substantial foothold in the market
- Bargaining chip for litigation
- Scarecrow
- Publishing the invention
- Marketing

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Statutory Requirements of Claims

- Patentable Subject Matter 35 U.S.C. § 101
- Utility 35 U.S.C. § 101
- Novelty 35 U.S.C. § 102
- Non-Obviousness 35 U.S.C. § 103
- Definiteness 35 U.S.C. § 112, ¶ 2
- Interaction with specification requirements of enablement, written description, and best mode 35 U.S.C. § 112, ¶ 1

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General Format of Claim

- One sentence
- No set format regarding paragraphs or numbering within a claim

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Basic Parts of a Claim

- Preamble
- Transitional phrase
- Body

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Preamble

- Can be a limitation, but may not be

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Transitional Phrases

- Comprising
  - Including the following elements but not excluding others ("at least")
  - Open ended
  - Embedded comprising
  - Comparable words: "having," "including," containing" but can be open to interpretation so use "comprising"

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Transitional Phrases (*cont'd*)

- Consisting of
  - No more, no less than the recited elements
  - Closed term
  - Comparable words: "composed of," "constituting," "having," "being," "is"
  - Rarely used

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Transitional Phrases (*cont'd*)

- Consisting essentially of
  - Includes other elements that do not materially affect the basic and novel characteristics of the claimed invention
  - Middle ground between open and closed
  - Comparable words: "composed of"
  - Useful when the prior art teaches A+B+C and invention is A+B

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Transitional Phrases (*cont'd*)

- Summary
  - Use comprising unless absolutely necessary to go narrower

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Body of Claim

- List necessary elements for novelty, non-obviousness, operability, enablement

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Claim Drafting Procedures

- Go through every single phrase, clause, word, and decide whether it is necessary or unduly limits the invention
- Forward looking prosecution strategy – can amend the claim during prosecution to potentially narrow the claim
  - Difficult to broaden during prosecution
  - However, estoppels for narrowing claims

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International Considerations

- Consistency between countries?
- Patentable subject matter may differ

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Independent *versus* Dependent Claims

- Stand alone *versus* incorporates limitations of other claims (§ 112, ¶ 3-5)
- All claims are legally required to be treated separate from each other for patentability
- Practical advantages to independent claims

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Broad *versus* Narrow Claim

- Adding a limitation creates narrowness, providing likelihood of patentability in claiming around the art but potentially making it more difficult for infringement enforcement

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How Many Inventions to Put in a Case?

- Various claim types – compound, composition, article, device/machine, process for making/synthesis, process for using, product by process
- Restriction issues

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Specific Embodiment Considerations

- Covering the commercial embodiment
- Covering potential competitor's designs
- Fall back positions

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Claims Should Do the Following

- Claim around the prior art for novelty and non-obviousness
- Claim an enabling invention
- Claim as broadly as possible for current invention, variations of invention, and alternative embodiments of the invention
- Claim potential design arounds to keep the competitor out

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Relative Terms and Definiteness

- For example: soluble, high temperature, low viscosity, tacky, soft
- *OrthoKinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565 (Fed. Cir. 1986)
  - In the claim, "In a wheel chair having a seat portion, a front leg portion, and a rear wheel assembly, the improvement wherein said front leg portion is **so dimensioned** as to be insertable through the space between the doorframe of an automobile and one of the seats thereof....", "so dimensioned" held as definite under § 112
  - § 112 requires a determination of whether those skilled in the art would understand what is claimed when the claim is read in light of the specification. As long as those of ordinary skill in the art realized that the dimensions could be easily obtained, § 112 requires nothing more
  - Is as accurate as the subject matter permits, automobiles being of various sizes

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How Terms in Claims are Construed by Courts

Phillips v. A WH Corp., 415 F.3d 1303 (Fed. Cir. 2005) (*en banc*)

- Intrinsic evidence (more relevant)
  - Claims
  - Context
  - Other claims
  - Specification ("single best guide to the meaning of a disputed term")
  - Special definition given to a claim term
  - Intentional disclaimer
  - Prosecution history
  - Demonstration of how inventor understood the invention
  - How inventor limited invention in the course of prosecution

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How Terms in Claims are Construed by Courts (*cont'd*)

- Extrinsic Evidence (less relevant)
  - Expert and inventor testimony
  - Dictionaries
  - Learned treatises

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Method Claims

- Like a cookbook recipe – recite manipulative steps
  - Mix, heat, and separate
- Claim different number of steps for different patentability
  - Heating A+B to get C; then mixing C+D to get E
  - Providing C; then mixing C+D to get E

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Basic Drafting Procedure

- Review invention disclosure
- Discuss invention with inventor
- Review prior art
  - Prior art search
- Draft preamble
- Draft transitional phrase

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Basic Drafting (*cont'd*)

- Draft minimum elements to enable the invention and describe minimum novelty and non-obviousness over the prior art
- Iterate claim drafting with inventors' comments on the invention
- Draft the specification
- Iterate between claim drafting and specification drafting for further refinements

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Interview with the Inventor

- Goals
  - Determine/confirm what the invention(s) is
  - Get details for claims
    - Specific wording
    - Additional embodiments
    - Back-up elements
  - Get details for specification
  - Define inventorship
  - With defined inventors, determine the best mode

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Interview with the Inventor (*cont'd*)

- Gather information on business aspects
  - Commercial embodiments
  - Direction of research
  - Defining what is most important for inventive concepts
- Background – what problem was being solved?
- Initial view of prior art
  - Identification of key prior art documents
  - Identification of closest prior art documents
- Defining any critical events that are bars or that would trigger the clock to run for a future bar

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Practical Aspects of Interviewing Inventor

- Advantage of reviewing written description of invention prior to interview
  - Invention disclosure, record of invention, and invention report
- Advantage of preliminary prior art review
- Typically a non-adversarial process

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What is the Format of an Interview?

- Setting
- General description of the invention
- Q&A
- On the spot claim drafting
- Follow-ups and action items

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