

LITIGATORS CORNER: A Claim Does Not Describe An Invention



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During litigation — as well as while preparing for it — we litigators often have the opportunity to second-guess the attorneys who prosecute patent applications. Theirs is an increasingly difficult — and maybe even a thankless — job. For one thing, legal requirements have changed in the past ten years, and so even a prosecuting attorney with a crystal ball and a ouija board has trouble figuring out what the law will be one, two or three years down the road.

Our firm just completed briefing claim construction in a case where I was struck by the defendant's desire to include all the features of the invention in every claim. Of course, I believe part of the reason for this was to add limitations to the claims, in order to give the accused infringer a better chance to escape a judgment of infringement later on.

But there was probably another tendency at work, too. The defendant's attorney seemed to believe that every

independent claim had to recite all elements or features of the invention, in order for a complete, workable model to be claimed.

One possible reason for this confusion about how to write a claim may be found in the difference between writing and litigating claims. Put simply, deriving claims is a process of abstraction, of taking away. Litigating them is the opposite: defining, adding to, rewriting, and so forth.

A claim can include too many elements for reasons other than simply being over-inclusive. One such instance is when a claim is written to describe an invention that may be practiced by multiple entities, separated temporally or geographically. A geographical example occurred in one of our cases, where the invention was for a coextruded film that was combined with a pressure-sensitive adhesive and a covering for the adhesive, called a liner. The coextruded film was manufactured by one company; another company applied the adhesive and the liner. Therefore, infringing the apparatus claim required the activities of two different companies, at two different times, in two different places. Even though the specification of the patent said that the manufacturing steps could take place in one location, or in several locations, the district court was never comfortable with our client's position that the two companies were co-infringers.

The coextruded film patent was a manufactured article. This kind of shared infringement has become much more common, especially in the arena of software or internet-related patents. It has become common to claim inventions that involve, for example, a server computer at one location run by one company, and a client computer at another location operated by a customer or client, each communicating with the other over a network or the internet.

Another way in which the problem manifests itself is through the addition of unnecessary limitations to a claim. A claim need not and should not recite everything in the specification, even if the thing described is

an element of the invention. In *Stiftung v. Renishaw PLC*, 945 F.2d 1173 (Fed. Cir. 1991), the inventor made a measuring machine with a spring-loaded probe at the tip. Earlier probes had hard tips that would not stop quickly enough on contact, damaging the probe or the measured object. Because of the spring, Renishaw's probe did not do damage, and was also more accurate. Now, because of the addition of the spring, when the tip contacts the object being measured, the tip moves, pushing the spring and breaking an electrical circuit between the tip and the controlling computer. This signals the computer that the probe has contacted the object being measured. Repeating the process allows a computer to calculate the dimensions of the object.

During litigation, the district court held one claim invalid because it recited only a probe, not the electrical circuit or computer. The Federal Circuit reversed, holding:

It has long been held, and we today reaffirm, that it is entirely consistent with the claim definiteness requirement of the second paragraph of section 112, to present "subcombination" claims, drawn to only one aspect or combination of elements of an invention that has utility separate and apart from other aspects of the invention. As one of our predecessor courts stated, "it is not necessary that a claim recite each and every element needed for the practical utilization of the claimed subject matter," as it is "entirely appropriate, and consistent with § 112, to present claims to only [one] aspect.

945 F.2d at 1181 (citing and quoting *Bendix Corp. v. United States*, 600 F.2d 1364, 1369 (Ct. Cl. 1979).

Some famous patents omit things in their claims, which are essential for the "practical utilization" of the invention. The Wright brothers' patent on their flying machine does not include in its claims either an engine or a propeller. Henry Ford's U.S. Patent No. 1,005,186 claims a transmission for use with an automobile motor, but does not claim the axles and wheels which the motor and transmission drive, nor does it claim fuel for the motor. Chester Carlson's U.S. Patent No. 2,297,691 gave birth to Xerox. His claim 1 recites making an image on a drum of a photocopier, but does not

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claim transferring the image to a sheet of paper. Carlson's goal was to make a copy on paper. It was the point of his invention. But his attorney wrote a claim that did not include that goal.

You don't need to include all the elements of the invention in every claim. The Wright Brothers' first claim doesn't include a fuselage, a seat, a rudder, an engine, or the forward horizontal control surface. Here it is:

In a flying machine, a normally flat aeroplane having lateral marginal portions capable of movement to different positions above or below the normal plane of the body of the aeroplane, such movement being about an axis transverse to the line of flight, whereby said lateral marginal portions may be moved to different angles relatively to the normal plane of the body of the aeroplane, so as to present to the atmosphere different angles of incidence, and means for so moving said lateral marginal portions, substantially as described.

This is effectively a claim on one wing (the aeroplane) with "lateral portions," which later became known as ailerons. Their second claim referred to two wings, or "aeroplanes" — that is, a biplane. Another claim referred to simultaneous movement of the lateral portions. They did not get to a vertical rudder until claim 8, and the forward horizontal rudder (a canard) did not appear until claim 9. The Wright Brothers' flyer that hangs in the Smithsonian had two

wings, ailerons, rudders, a canard, an engine and propellers. Powered flight required all this. In my opinion, their attorney knew very well how to write a claim. But, he also knew not to throw everything into every claim. He saw a complete airplane, and began abstracting to get to the claims.

Thus, claims need not recite every feature of an invention. It would have been so much better if our patent in the film case had claims that did not depend on different companies preparing different parts of the accused structure. We did have other claims along those lines, but they included elements that were not present in the film that infringed the claims we asserted.

To win a lawsuit, you want the simplest infringement theory: direct infringement. Contributory infringement gets you into one messy issue about staple and non-staple articles, and inducing infringement requires proof of knowledge of the patent. Direct infringement is the easiest to prove. While prosecuting a patent, if you can, avoid claims requiring co-infringers. If you decide to use such claims, write other claims that can be infringed by the actions of one party. Patent cases are hard enough for judges and juries. Your proof needs to be as simple as possible.

There is more reason nowadays to write claims that do not depend on any concerted action. (Here, I would like to credit two of my partners, Ray Niro and Chris Lee, for their ideas.) More and more patents today claim some action taking place over the internet. For example, a server computer

may transmit information over a network to a user or client. As a second step in a claim, the user or client may respond. But note that if the claim is written this way, there are two parties involved in the infringement, just as in our film case. A better way to write such a claim might be to require transmission by the server, and then receipt of information by the same server. Another possibility is to write separate claims, one directed at the server side, and another directed at the client side. Keep in mind that not all the elements of the invention need to be recited in every claim.

Since many of you are prosecution attorneys, you probably know all this, better than I do. But I hope this column serves as a good reminder of what can happen to a claim in litigation. To summarize, abstract from the specification to get to good claims. Don't put all the elements of the invention in every claim. And finally, think about whether the claim, as written, will require cooperative action before it can be infringed. **IPT**