

Patent Law

- Slides for Module 7
- Claims

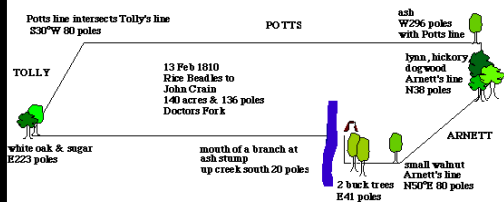
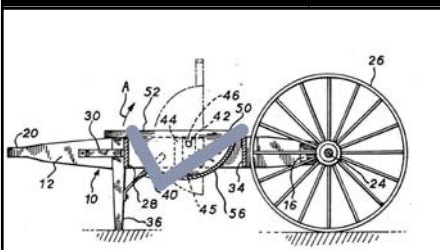
7-1

Peripheral claiming – an analogy to “regular” property law

Claim 1	Label
1. A wheelbarrow . . . comprising	
a frame having two . . . rails . . . and at least one cross brace . . .	frame [10]
an axle . . .	axle [24]
a wheel . . . [with] minimum diameter of 30 inches	wheel [26]
a pair of mounting brackets . . . mounted . . . Intermediately . . .	brackets [42, 44]
a box having a semicylindrical closed bottom, upstanding side walls having a C-shaped bottom edge . . . Including a pair of axially aligned pivot posts . . .	box [50]
a support . . .	support [36, 38]

JONES sells 140 acres and 36 poles of land in HAYES County on WEST Fork to SMITH for 200 dollars. Land bounded as follows...:

- Beginning at the mouth of a branch at an ash stump
- thence up the creek S 20 poles to 2 beach
- thence east 41 poles to a small walnut in Arnett's line
- thence north 50 east 80 poles to a linn hickory dogwood in said line
- thence north 38 poles to an ash
- thence west 296 poles with Potts's line till it intersects with Tolly's line
- thence south 30 west 80 poles to a whiteoak and sugar
- thence east 223 poles to beginning....



7-2

Claims – definiteness requirement	
§ 112	
[¶1] The specification shall contain a written description of the invention, and of the <u>manner and process of making and using it</u> , in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to <u>make and use</u> the same,	Written Description requirement. Enablement requirement.
and shall set forth the best mode contemplated by the inventor of carrying out his invention.	Best Mode requirement.
[¶2] The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.	Definiteness requirement.
• Various issues fall under the definiteness requirement • Omnibus/formal claims (as in <u>Ex parte Fressola</u>) • Antecedent basis – a claim recitation that lacks antecedent basis renders the claim indefinite • First: a/an Later: said/the • Inferential claiming – claim that fails to positively recite an element, i.e., refers to the element only “inferentially” may be indefinite	

7-3

Ex parte Fressola (PTO 1993)

- Method and system of producing stereographic images of celestial objects which use distance information to offset one of two images produced on a display device
- Claim 42
 - A system for the display of stereographic three-dimensional images of celestial objects **as disclosed in the specification and drawings herein.**
- Rejected as “failing to particularly point out and distinctly claim the subject matter which applicant regards as his invention”

7-4

Ex parte Fressola (PTO 1993)

- Progression of claims

- From “omnibus” to



- Expression of cooperative relationship of the elements
- “central” definition to “peripheral” definition
 - Central definition involves the drafting of a narrow claim setting forth a typical embodiment coupled with broad interpretation by the courts to include all equivalent constructions
 - Peripheral definition involves marking out the periphery or boundary of the area covered by the claim and holding as infringements only such constructions as lie within that area.

7-5

Ex parte Fressola (PTO 1993)

- Claim 42

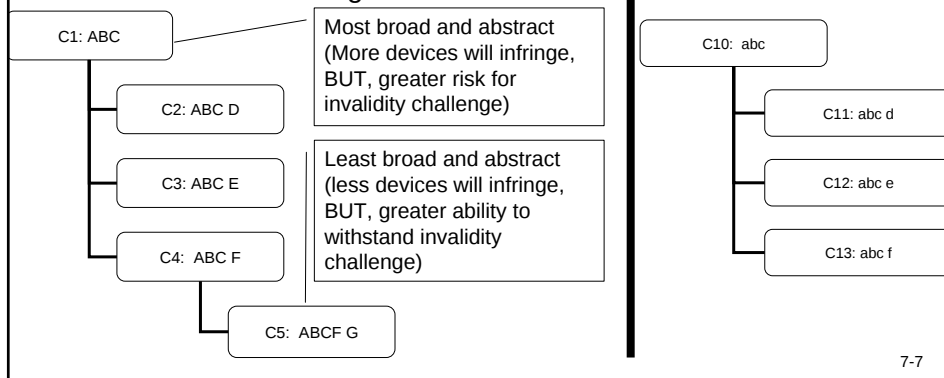
- Invalid because it relies entirely on incorporation by reference (“IBR”) [sometimes known as “backfiring” claims]
 - No exception applies because the system can be described in words without reference to the specification and drawings
- Impossible to determine how much of the specification to incorporate [not a “picture” claim]
- Even if IBR were allowed, the specification does not particularly point out and distinctly define what invention is covered by claim 42
 - 19 figures, 147 pages, 45 pages of code, 73 pages of data
 - Why, with all this detail, does the specification not “particularly point out and distinctly define” the claimed invention?
 - What if claim pointed out particular items?
- Public notice function of the claim

7-6

Ex parte Fressola (PTO 1993)

• Notes

- Even though omnibus claims are not allowed, there is interplay between the claims and the specification
 - Interpret claims in light of the specification
 - Use of §112 ¶ 6 in claims
- One-sentence rule
- “Art of Claim Drafting”



7-7

Preamble, transition, and body

what is claimed is:

1. An adjustable pedal assembly for a vehicle comprising;
a support (18) for mounting to a vehicle structure;
an adjustable pedal assembly (22) having a guide member (62) rotatably supported by said support (18) for pivotal movement about a pivot axis (26); and
a pedal arm (14) supported on said guide member (62) for rectilinear movement in fore and aft directions relative to said support (18), said guide member (62) and said pivot axis (26) between various adjusted positions;
an electronic control (28) supported on said support (18) and responsive to pivotal movement of said pedal arm (14) and said guide member (62) about said pivot axis (26),

7-8

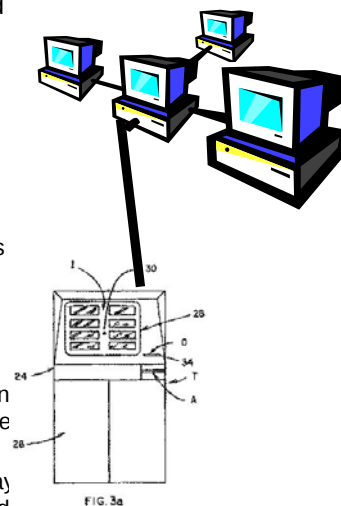
Claim preamble

- Role in the claim
 - States the general use or purpose of the invention
 - Helps to show the area of technology
- Under what conditions does it limit the claim?
 - Difficult rule to state
 - Issue arises in the claim construction process
 - Depends on importance of the preamble to give meaning to the claim
 - A preamble term serves as a limitation “when it matters”
 - Preamble has the import that the claim as a whole assigns to it
 - Other ways to formulate the test – the preamble is limiting when
 - It is “essential to point out the invention defined by the claim”
 - The body of the claim refers back to terminology in the preamble
 - A preamble term “recites not merely a context in which the invention may be used, but the essence of the invention without which performance of the recited steps is nothing but an academic exercise”
 - Where it is “necessary to give life, meaning, and vitality to the claim”

7-9

Catalina Mktg. Int'l v. Coolsavings.com, Inc. (Fed. Cir. 2002) (Rader)

- 1. A system [sic] for controlling the selection and dispensing of product coupons at a plurality of remote terminals ***located at predesignated sites such as consumer stores*** wherein each terminal comprises:
 - activation means for activating such terminal for consumer transactions;
 - display means operatively connected with said activation means for displaying a plurality of coupons available for selection;
 - selection means operatively connected with said display means provided to permit selection of a desired displayed coupon by the consumer;
 - print means operatively connected with said selection means for printing and dispensing the coupon selected by the consumer; and
 - control means operatively connected with said display means for monitoring each consumer transaction and for controlling said display means to prevent the display of coupons having exceeded prescribed coupon limits.



7-10

Catalina Mktg. Int'l v. Coolsavings.com, Inc.

- 1. A system [sic] for controlling the selection and dispensing of product coupons at a plurality of remote terminals **located at predesignated sites such as consumer stores** wherein each terminal comprises:
 - activation means . . . ;
 - display means . . . ;
 - selection means . . . ;
 - print means . . . ; and
 - control means
- 25. A system for controlling the selection and dispensing of product coupons at a plurality of remote terminals **located at predesignated sites such as consumer stores**, comprising:
 - a plurality of free standing coupon display terminals **located at predesignated sites such as consumer stores**, each of said terminals being adapted for
 - bidirectional data communication with a host central processing unit; each of said terminals comprising
 - activation means . . . ;
 - display means . . . ;
 - selection means . . . ;
 -

7-11

Catalina Mktg. Int'l v. Coolsavings.com, Inc.

- Prosecution activity
 - Amendments in response to obviousness rejection
 - Catalina did not argue that the location of terminals in stores distinguished the invention from the prior art, but did state that their invention involved terminals “located in stores” for dispensing coupons “on-site”
- Potentially infringing system
 - Coolsaving’s internet-based coupon review and printing web site
- Issues
 - Was the preamble phrase “**located at predesignated sites such as consumer stores**” a limitation?
 - If so, was the district court’s claim construction correct?
 - This was the only claim term the court construed to conclude that there was no literal or DOE infringement

7-12

<u>Catalina Mktg. Int'l v. Coolsavings.com, Inc.</u>		
Limit?		Does not limit
Does	Recites essential structure or steps , or if it is " necessary to give life, meaning, and vitality " to the claim	a patentee defines a structurally complete invention in the claim body and uses the preamble only to state a purpose or intended use for the invention (patentability of apparatus or composition claims depends on the claimed structure, not on the use or purpose of that structure)
Does	Jepson claiming ("the improvement comprising")	
May	Dependence on a particular disputed preamble phrase for antecedent basis may limit claim scope because it indicates a reliance on both the preamble and claim body to define the claimed invention	preamble language merely extolling benefits or features of the claimed invention does not limit the claim scope without clear reliance on those benefits or features as patentably significant
Does	the preamble is essential to understand limitations or terms in the claim body	
May	Recites additional structure or steps underscored as important by the specification	
Does	clear reliance on the preamble during prosecution to distinguish the claimed invention from the prior art transforms the preamble into a claim limitation because such reliance indicates use of the preamble to define, in part, the claimed invention	the claim body describes a structurally complete invention such that deletion of the preamble phrase does not affect the structure or steps of the claimed invention

7-13

Catalina Mktg. Int'l v. Coolsavings

A

A composition for polishing shoes

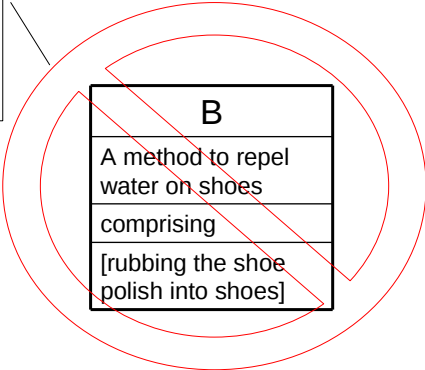
comprising

[shoe polish]



Query: Is this hypothetical irrelevant to the analysis?

Inherent in the normal use of the polish to shine shoes



B

A method to repel water on shoes

comprising

[rubbing the shoe polish into shoes]

B

A method to grow human hair

comprising

[rubbing the shoe polish on bare human skin]

7-14

Catalina Mktg. Int'l v. Coolsavings.com, Inc.

	Claim 1
Recites essential structure or steps , or if it is " necessary to give life, meaning, and vitality " to the claim	No – no use of the phrase " located at predesignated sites such as consumer stores " to define the invention
Jepson claiming ("the improvement comprising")	No
Dependence on a particular disputed preamble phrase for antecedent basis may limit claim scope because it indicates a reliance on both the preamble and claim body to define the claimed invention	No
the preamble is essential to understand limitations or terms in the claim body	No
Recites additional structure or steps underscored as important by the specification	No
clear reliance on the preamble during prosecution to distinguish the claimed invention from the prior art transforms the preamble into a claim limitation because such reliance indicates use of the preamble to define, in part, the claimed invention	No – getting past the obviousness rejection was based on amendments in the claim body, the examiner considered terminal location insignificant

7-15

Claim Interpretation – Sources / Canons / Procedure

Source(s)		Canons
Plain meaning	Dictionaries (but often disfavored if disputed term)	Claim / Specification relationship - Don't read a limitation into a claim - One may look to the written description to define a term already in a claim limitation Presumptive breadth - Claim should be interpreted so as to preserve validity (not favored now) - If a claim is subject to two viable interpretations, the narrower one should apply Others - Inventor's interpretations after issuance are given no weight - Claim differentiation
Specification	The specification can be used to enlighten the court as to the meaning of a claim term	
Prosecution history	Effect on claim construction?	
Extrinsic Evidence	Proper to resort to extrinsic evidence?	

● Procedure

- Markman – the meaning of the claims is a question of law, and thus subject to de novo review and a matter for the judge, not the jury

7-16

Claims - Transitional phrases		
Type	Words	Meaning / Notes
Open	Comprising [the steps of] =	"having at least" The most common and desirable Does not exclude additional, unrecited elements or method steps
Closed	consisting of	"having only" Closes the claim to the inclusion of other elements (except impurities)
Partially closed	consisting essentially of	"having nothing else that affects operation" Limits the scope of the claim to the specified elements "and those that that do not materially affect the basic and novel characteristics"
- Examples - Open: ABCX is within the scope of coverage of an open claim to ABC - Closed: ABCX is NOT - Partially closed: If element X would NOT materially change the composition, then ABCX IS within the scope of the partially closed claim to ABC		

7-17

Other transitional phrases

- "including," "having,"⁴⁸ "characterized by,"⁴⁹ "being,"⁵⁰ "composed of,"⁵¹ "comprised of,"⁵² "containing,"⁵³ and "group of."⁵⁴
- What do these mean?
- Useful references:
 - Landis on Mechanics of Patent Claim Drafting
 - Ronald Slusky, Invention Analysis and Claiming

7-18

More claim rules : Claim body

- Elements and interaction among elements
- Words/terms of art, for example: integral, extrinsic, approximately, horizontal, solid.
 - a/an: One or more (usually).
 - plurality: More than one.
- Antecedent basis
 - 1. A combustion enhancement device, comprising:
 - a housing which defines an interior chamber;
 - at least one magnet disposed within said interior chamber;
 - a far infrared ray generating composition comprising [. . .] disposed within said interior chamber; and
 - said **[at least one magnet] [magnet(s)]** having polarization in a range of approximately 10-40.

7-19

More claim rules

- Dependent claims
 - Must further limit
 - Further comprising - add “elements”
 - A combustion enhancement device as in claim 1, further comprising a sleeve internal to said housing
 - Wherein – add “limitations”
 - A combustion enhancement device as in claim 2, wherein said housing is made of metal.
- Multiple dependent claims
 - A combustion enhancement device as in claim 2 or 3, further comprising . . .

7-20

More claim rules

§112

[¶3] A claim may be written in independent or, if the nature of the case admits, in dependent or multiple dependent form.

[¶4] Subject to the following paragraph, a claim in dependent form shall contain a reference to a claim previously set forth and then specify a further limitation of the subject matter claimed. A claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers.

[¶5] A claim in multiple dependent form shall contain a reference, in the alternative only, to more than one claim previously set forth and then specify a further limitation of the subject matter claimed. A multiple dependent claim shall not serve as a basis for any other multiple dependent claim. A multiple dependent claim shall be construed to incorporate by reference all the limitations of the particular claim in relation to which it is being considered.

7-21

Product-by-Process Claims

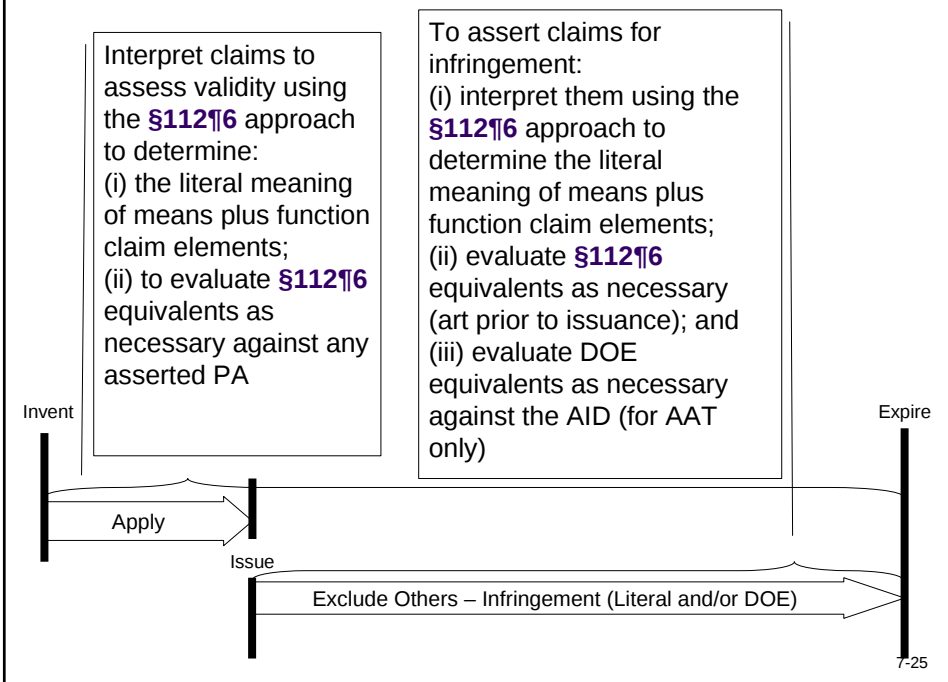
- Product claims that define the product by a process of making the product
 - E.g., “The molded innersole produced by the method of claim 1.”
- Question: If the product is “novel,” should the patentee be entitled to a claim on the product regardless of the process used to make it? That is, even if the product is defined by a particular process.
- Scripps Clinic v. Genentech (Fed. Cir. 1991): The claims are not limited to the product prepared by the process set forth in the claims. [Also the rule at the PTO.]
- Atlantic Thermoplastics v. Fayatex (Fed. Cir. 1992): The Scripps court ignored Supreme Court law. A earlier panel decision does not control if the later panel determines that SCT precedent reaches a contrary result. Under that precedent, the product is limited by the enumerated process.

7-22

Functional Claiming	
§112	
[¶6] An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof	“means plus function” or “step plus function” (step-plus-result) claims
7-23	

§112 ¶6 - Means + Function Claims ● Cover structure disclosed in the specification ● Are they narrower or more broad than “regular” claim elements/limitations? ● Differences between PTO versus courts? ▪ PTO – allowed broadest reasonable interpretation (for claims generally, including §112 ¶ 6 elements in claims) ▪ BUT, PTO is required to apply the §112 ¶6 approach to determining the meaning of means plus function elements
7-24

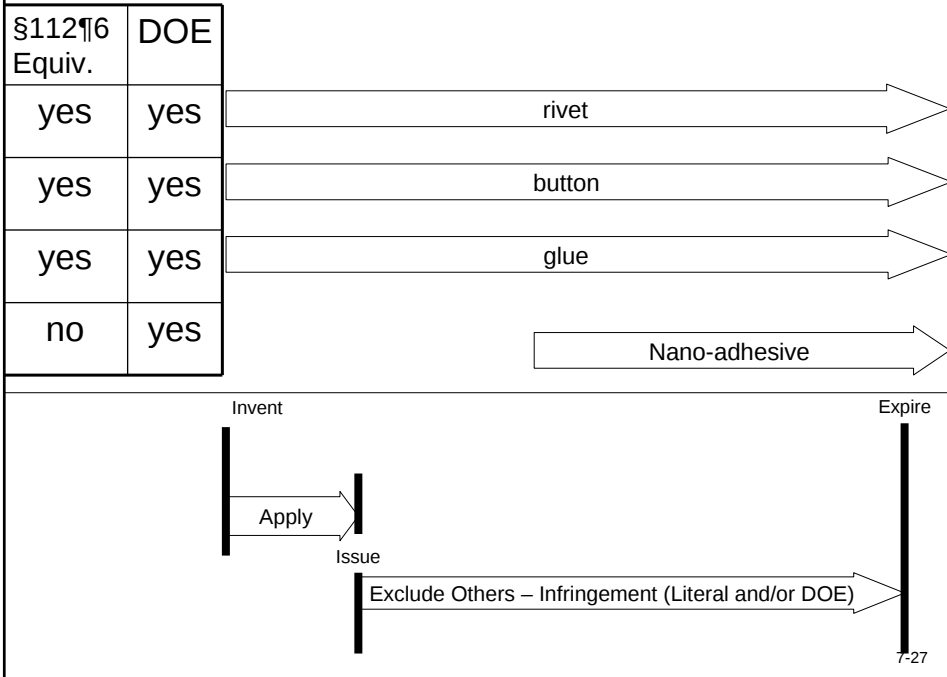
§112 ¶6 - Means + Function Claims



§112 ¶6 - Means + Function Claims

- How is a §112 ¶6 equivalent different from a DOE equivalent?
 - Function
 - Function-Way-Result
 - DOE – substantially similar function, way and result
 - §112 ¶6 – **identical** function, substantially similar way and result
 - Insubstantial Differences
 - DOE – substantially similar function, insubstantial structural differences
 - §112 ¶6 – **identical** function, insubstantial structural differences
 - “After arising” technology
 - DOE covers “after arising” technology
 - §112 ¶6 equivalents cover technology arising prior to issuance
 - See n.2 in Al-Site v. VSI

§112 ¶6 - Means + Function Claims



Al-Site Corp. v. VSI Int'l, Inc. (Fed. Cir. 1999) (Rader)

• Literal infringement of the '532 patent

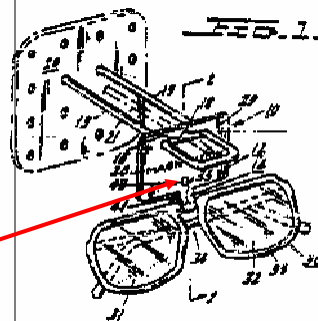
- 8. A pair of eyeglasses and hanger means for removably mounting said eyeglasses on a horizontally extending cantilevered support;

said eyeglasses including first and second lenses positioned side by side with a nose gap open at one end disposed therebetween, a bridge extending across said gap at its other end, and temples operatively connected to said lenses at pivot points disposed remote from said nose gap;

said hanger means including a body having aperture means adapted to receive a horizontally extending cantilevered support, an extension projecting from a bottom edge portion of said body and bent to pass through said gap and form a loop that encircles said bridge, and **fastening means** in engagement with said extension to maintain said loop closed;

said loop being proportioned to cooperate with said eyeglasses for preventing separation of said hanger means from said eyeglasses without opening said loop, and for permitting a customer to try on said eyeglasses while said hanger means is mounted thereto;

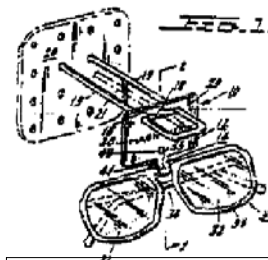
with said temples folded, said eyeglasses constituting an elongated unit having its longitudinal axis positioned horizontally and below said body when said eyeglasses are mounted on a horizontally extending cantilevered support by said hanger means.



- fastening means disclosed in the specification
 - Rivet
 - button
- Accused Infringing Device (VSI Version 1)
 - glue

Al-Site Corp. v. VSI Int'l, Inc.

- Literal infringement of the '532 patent
- §112 ¶6 analysis
 - Identical to Disclosed Structure?
 - The glue is not a rivet or a button
 - §112 ¶6 equivalents [still literal infringement] (or “structural equivalents”) analysis
 - (1) F-W-R approach
 - The function is identical
 - The function is to fasten such that the extension encircles the nose bridge of the eyeglasses and is held in place
 - The function fastens the extension in a closed loop
 - The “Way” is substantially similar
 - This is the element most often at issue in the F-W-R test
 - Is the way substantially similar because it connects the extension to the body?
 - No. The question “is not whether both structures serve the same function, but whether it was known that one structure was an equivalent of an another.”
 - The “Result” is substantially similar
 - The closed loop is kept closed

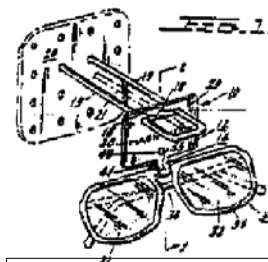


Patent embodiment

7-29

Al-Site Corp. v. VSI Int'l, Inc.

- Literal infringement of the '532 patent
- §112 ¶6 analysis
 - Identical to Disclosed Structure?
 - The glue is not a rivet or a button
 - §112 ¶6 equivalents [still literal infringement] (or “structural equivalents”) analysis
 - (2) Insubstantial Differences approach (used by the court)
 - Function analysis is the same
 - The structural differences are insubstantial
 - Expert testified that a rivet, glue, or staple were all “equivalent” structures
 - Post Warner-Jenkinson, arguably if either test is met, sufficient.



Patent embodiment

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Al-Site Corp. v. VSI Int'l, Inc.

- Rules for claim drafters to invoke the strictures of §112¶6
 - If the word "means" appears in a claim element in combination with a function, it is presumed to be a means-plus-function element to which §112¶6 applies.
 - Nevertheless, according to its express terms, §112¶6 governs only claim elements that do not recite sufficient structural limitations
 - Therefore, the presumption that §112¶6 applies is overcome if the claim itself recites sufficient structure or material for performing the claimed function
 - For example, "perforation means for tearing"

7-31

Al-Site Corp. v. VSI Int'l, Inc.

- Although use of the phrase "means for" (or "step for") is not the only way to invoke §112¶6, that terminology typically invokes §112¶6 while other formulations generally do not
 - Therefore, when an element of a claim does not use the term "means," treatment as a means-plus-function claim element is generally not appropriate
 - However, when it is apparent that the element invokes purely functional terms, without the additional recital of specific structure or material for performing that function, the claim element may be a means-plus-function element despite the lack of express means-plus-function language
 - For example, one court interpreted "lever moving element" and "movable link member" under §112¶6)

7-32

Al-Site Corp. v. VSI Int'l, Inc.

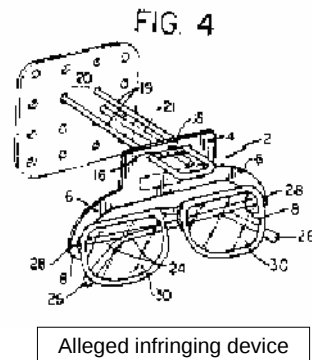
- Infringement of the other three patents

Element	Language in Claim	Properly a M+F Claim?
Eyeglass hanger member ('345 & '726)	"made from flat sheet material," and having an "opening means formed ... below [its] upper edge." ('345) "an attaching portion attachable to a portion of said frame of said pair of eyeglasses to enable the temples of the frame [to be opened and closed]." ('726)	No - no use of "means," sufficient structure
"attaching portion attachable to a portion of said frame of said pair of eyeglasses" ('726)	The element language itself supplies structural, not functional terms	No – no use of "means"
Eyeglass contacting member ('911)	having an encircling portion adapted to encircle a part of said frame of said pair of eyeglasses. ('911)	No - no use of "means," sufficient structure
means for securing a portion of said frame of said eyeglasses to said hanger member ('345)		YES

7-33

Al-Site Corp. v. VSI Int'l, Inc.

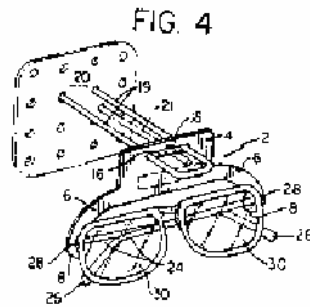
- The final issue relates to the "means for securing" from the '345 patent
 - means for securing a portion of said frame of said eyeglasses to said hanger member
- This element was held to properly be a means-plus-function element
- But, Magnivision (Al-Site's successor in interest) alleges error because the jury instruction did not include "or equivalents thereof" when referring to the rivet or button fastener
 - Although Magnivision obtained a jury DOE verdict, it argues that with a proper jury instruction, it would have obtained a §112¶6 literal infringement verdict (which includes §112¶6 "equivalents")



7-34

AI-Site Corp. v. VSI Int'l, Inc.

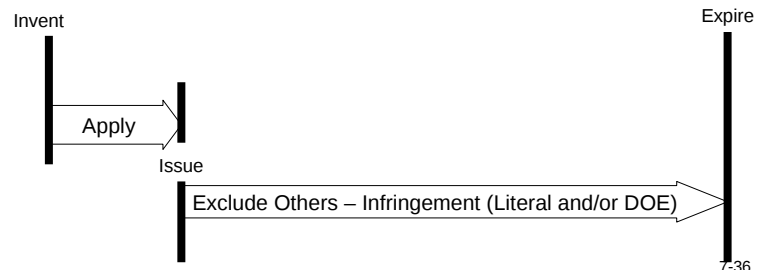
- In essence, the court says that
 1. Knowing the differences between §112¶6 equivalents and DOE equivalents, AND
 2. Knowing that the parties agreed that the function was identical, AND
 3. Knowing that there is no after arising technology (the holes in the accused device are not after-arising technology)THEN
 4. Logically, we can hold that the jury's DOE verdict also indicates a finding of §112¶6 equivalence
- AS A RESULT
 - Any error from the slightly wrong jury instruction is harmless
- What is the logic the court applies in step 4?



7-35

Notes for AI-Site

- Where to draw the line for after developed technology?
 - The words of a claim are fixed upon its issuance
 - From this the court measures “after” from date of issuance
 - What about the filing date?



7-36

Aristocrat v. Intl Gaming Technology (Fed. Cir. 2008)

- Means at issue was a “control means” on a computerized slot machine system
- Patentee argues that “microprocessor” is sufficient structure for claimed functions
- Holding: The structure disclosed in the specification corresponding to a claimed function must “be more than simply a general purpose computer or microprocessor”
- However, disclosure of a specific algorithm that can perform the function on the computer is sufficient, because a specific algorithm running on a computer converts into a “special purpose computer”
 - Is this still good law after Bilski?

7-37

Jepson claims – In re Fout (CCPA 1982)

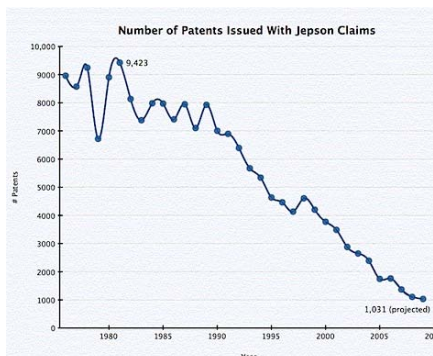
- Claim 1 of application:
 - In a process for producing a decaffeinated vegetable material suitable for consumption in beverage form wherein caffeine-containing vegetable material is extracted with a volume of recirculating liquid, water-immiscible edible fatty material in a decaffeination zone for a period of time sufficient to transfer caffeine from said vegetable material into said fatty material, and wherein the caffeine-laden fatty material resultant from extraction is separated from said vegetable material and is conveyed to a regeneration zone for removal of caffeine prior to recirculation to said decaffeination zone, **the improvement which comprises**

subjecting the caffeine-laden fatty material in said zone to regenerative vaporization conditions such as to vaporize caffeine from said fatty material and further to vaporize from said fatty material any fatty material degradation products present therein.
- Held: Claim is obvious.

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Jepson claims

- How does the Jepson claim help a patent examiner?
 - 1. The combination of A, B & C'
 - 2. In the combination of elements A, B & C, the improvement which comprises use of C' as the element C
- How does a Jepson claim help an applicant?



7-39

“Markush” Claim elements/limitations

- There is a way of describing a claim element/limitation where adding items increases the scope of the claim
 - This occurs when a “Markush” group is used
 - Name is from a case which allowed listing of items in the alternative in specific situations
 - Traditionally used to claim chemical compounds, can now be applied in any claim
- Example (compare the two claims on the next overhead)

7-40

“Markush” Claim elements/limitations

Claim 4

- A seating apparatus, comprising:
- (a) a horizontal seat; and
- (b) three legs each having one end connected to the bottom of said horizontal seat.
- (c) said connection between said legs and bottom of said horizontal seat being a slim **brass** metal piece partially traversing some of said leg and said seat.

Claim 5

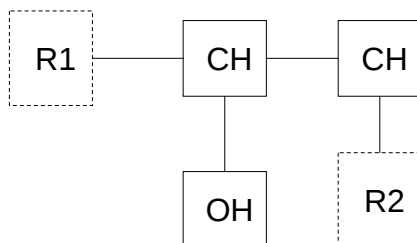
- A seating apparatus, comprising:
- (a) a horizontal seat; and
- (b) three legs each having one end connected to the bottom of said horizontal seat.
- (c) said connection between said legs and bottom of said horizontal seat being a slim metal piece partially traversing some of said leg and said seat, **wherein the metal of said slim metal piece is brass, steel, iron, or tin.**
- Alternative language for element/limitation 5(c):
- (c) said connection between said legs and bottom of said horizontal seat being a slim metal piece partially traversing some of said leg and said seat, **wherein the metal of said slim metal piece is selected from the group consisting of brass, steel, iron, and tin.**

7-41

Example in a hypothetical chemical compound claim

claim

A compound of the formula



wherein R1 is hydrogen or methyl, and R2 is chlorine, bromine or iodine.

Compounds covered by the claim

Rest of the Molecule	R1	R2
CH-CH OH	H	C
CH-CH OH	H	B
CH-CH OH	H	I
CH-CH OH	M	C
CH-CH OH	M	B
CH-CH OH	M	I

7-42

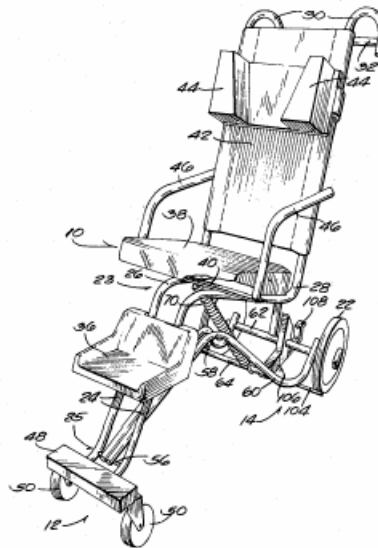
“Markush” Claim

- Requirements for use
 - Ordinarily, the members of the group must belong to a recognized class
 - Also permissible in a process or combination claim if
 - The members of the group are disclosed in the specification to possess a property in common which is mainly responsible for their function in the claimed relationship, and
 - It is clear from their nature or the prior art that all possess the property
- Potential Downside
 - Prior art showing any single embodiment will invalidate claim
 - Cf. multiple dependent claims (inference is that a multiple dependent claim contains separate claims)

7-43

Claim definiteness – Orthokinetics (Fed. Cir. 1986) (Markey)

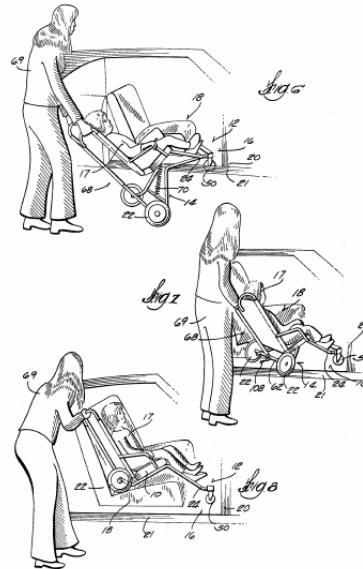
- Jury said patent was not invalid for indefiniteness
 - “so dimensioned”
- Dist. Ct. granted JNOV invalidating the patent
- Federal Circuit reversed



7-44

Claim definiteness – Orthokinetics (Fed. Cir. 1986) (Markey)

- 1. 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 whereby said front leg is placed in support relation to the automobile and will support the seat portion from the automobile in the course of subsequent movement of the wheel chair into the automobile, and the retractor means for assisting the attendant in retracting said rear wheel assembly upwardly independently of any change in the position of the front leg portion with respect to the seat portion while the front leg portion is supported on the automobile and to a position which clears the space beneath the rear end of the chair and permits the chair seat portion and retracted rear wheel assembly to be swung over and set upon said automobile seat.



7-45

Claim definiteness – Orthokinetics (Fed. Cir. 1986) (Markey)

- In granting JNOV, the dist. Court stated:
 - The D's expert testimony "clearly and convincingly establishes that claim 1 of the patent does not describe the invention in 'full, clear, concise and exact terms'" because one cannot tell whether a chair infringes unless one tests the chair on vehicles "ranging from a Honda Civic to a Lincoln Continental to a Checker cab."
 - Fundamental concern expressed is the public notice function of the claim
- Federal Circuit
 - Mixes §112¶1 with §112¶2
 - Test is whether those skilled in the art would understand what is claimed when the claim is read in light of the specification
 - The phrase "so dimensioned" is as accurate as the subject matter permits
 - Here, PHOSITAS would realize that the dimensions could be easily obtained

7-46

Notes – Orthokinetics

- Words of degree in claims
 - About, approximately, “close to” “substantially equal” . . .
 - Does the patent’s specification provide some standard for measuring that degree
 - Does the level of imprecision with the words of degree create a risk of reading on the prior art?
 - Amgen v. Chugai (Fed. Cir. 1991)
- Potential for ambiguity as to whether functional language other than §112 ¶ 6 (whereby, etc.) is limiting or merely states a necessary result
 - “whereby the fluid will not directly engage the device and electrical connection means at high velocity, and the connectors will be secured against appreciable displacement by the fluid”

7-47

Datamize v. Plumtree (Fed. Cir. 2005)

- Federal Circuit tests
 - “Not amenable to construction”
 - “Insolubly ambiguous”
 - “If the meaning of the claim is discernible, even though the task may be formidable and the conclusion may be one over which reasonable persons will disagree, we have held the claim sufficiently clear to avoid invalidity on indefiniteness grounds.” (Exxon, Fed. Cir. 2001)
- Cf. Supreme Court test
 - “[the claims] must clearly distinguish what is claimed from what went before in the art and clearly circumscribe what is foreclosed from future enterprise”
 - Has the CAFC obliterated the SCT test (yet again)?

7-48

Datamize v. Plumtree (Fed. Cir. 2005)

- After Exxon, could anyone possibly write an indefinite claim?
- Apparently so—claim that which is “aesthetically pleasing”!
- Is there any reason whatsoever to include any of the limitations containing this term in the claim-at-issue?