

# Advanced Patent Prosecution

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## “reading claims is the key to work around a patent”

- ◆ The scope of a patent is defined by one or more ‘numbered’, ‘single’ sentences given at the end of a patent specification which are called ‘claims’ [Sec.10(4)(c)] or 35USC §112
- ◆ Claims determines the *metes and bounds* of the invention
- ◆ Typically claims must be single sentences (MPEP 608.1(i)) and numbered (no specific provision in the Indian law). If there is only a single claim in an application the claim is not numbered (MPEP608.01(j))
- ◆ Claims can be in an ‘independent form’ or ‘dependent form’. As for example:
  - 1A method of preparing a macrolide citrate salt, comprising:
    - dispersing a macrolide in an organic solvent;
    - adding an aqueous solution comprising citric acid to said macrolide organic solution with stirring to form a mixture; and
    - removing the organic solvent from the mixture to form a macrolide ciliate salt, wherein the citric acid and macrolide are present in substantially equimolar quantities.

## independent & dependent claims

- ◆ The following is a 'dependent claim':

2. The method of claim 29, further comprising washing the macrolide citrate salt with cold water and drying the salt.

- ◆ In some countries multiple dependent claims are permissible. As for example in India, the Patent Office allows multiple dependent claims of the following type:

3. The method according to any one of claims 29 to 39, the method comprising characterizing said isolated macrolide citrate salt by analyzing at least one property of the isolated ciliate salt.

- ◆ In some countries certain types of multiple dependent claims are not permissible. As for example in the US the following types of multiple dependent claims are not allowed:

4. The method according to claim 29 and 30, further comprising..

5. The method according to claims 29-30 in which...

6. The method according to any of the preceding claims, the method further comprising..

## multiple dependent claims

◆ Certain types of multiple dependent claims are acceptable in the US. The examples are:

20. A method according to claims 18 or 19, the method further comprising..

21. A method as in either claim 1 or claim 2, further comprising..

- The principle here is that a multiple dependent claim has to be a dependent claim which refers back in the alternative to more than one preceding independent or dependent claim.
- Any dependent claim which refers to more than one other claim should refer to such other claims in the alternative only.
- A multiple dependent claim cannot 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 each of the particular claims in relation to which it is being considered

## multiple independent claims

◆ Multiple Independent claims refers to the inclusion of more than one independent claim in patent application. As for example, the claims of a patent application can be directed at:

- A compound having antiinflammatory activity of formula (I), ##STR148##, wherein.....
- A process for the preparation of compound of formula (I), ##STR148##, the process comprising .....
- A pharmaceutical composition comprising the compound of formula (I), ##STR148##....
- A process for producing the pharmaceutical composition..
- A method of treating inflammation by administering a therapeutically effective amount of a compound of formula (I), ##STR148##...

◆ In the above instance, the application contains 5 independent claims. This is typically not acceptable in India. Section 7 (1) contains one of the basic principles in patents law- every application for a patent shall be for one invention only. So the inclusion of multiple independent claims is often objected by the Examiners.

◆ The Patents (Amendment) Act, 2002 incorporated a new sub-section (10)(5) that permits the inclusion of claims directed at “a group of inventions linked so as to form a single inventive concept” in a given application.

# structure of a claim

- Preamble

- ◆ “A method for unlocking a door” the method comprising ..

- The preamble may not usually limit the scope of the claim
    - In *Corning Glass Works v. Sumitomo Elec. USA, Inc*, Court held that the question whether a preamble would limit the scope of the claim can be decided only on the basis of a complete reading of the claim in light of the specification.
    - In *Catalina Marketing Intl. Inc v. coolsavings.com Inc*, the court held the preamble will not limit the claim when it merely serves to define the environment in which the invention is to be used or operated.

## transitional phrase

- ◆ The phrase used to connect the preamble and the body of a claim is known as ‘transitional phrase’ or link
- ◆ Commonly used transitional phrases include “comprising”, “consisting essentially of”, “consisting of”, “including”, or “containing”
- ◆ ‘Comprising’ is an open-ended phrase. It means including but not excluding
- ◆ In Ex parte Davis the Court held that “consisting of” would mean restricted to those elements, steps or ingredients recited in the claim.
- ◆ ‘Consisting essentially of’ is a transitional phrase that is less limiting than “consisting of”.
  - As for example, in “a method for unlocking door comprising step A, Step B and Step C”, adding an additional Step D would avoid infringement if the transitional element used is “consisting of”.
  - If the transitional element used is “consisting essentially of” adding additional Step D would only avoid infringement if Step D was material in view of Steps A, B and C. Otherwise A, B, C and D would infringe. (AFG Indus)

## body of a claim

- ◆ Body of a claim typically contains elements set off as paragraphs. This serves in framing the infringement enquiry
- ◆ Each claim element ordinarily will comprise of a given structural component or a particular step
- ◆ As for example the structural element of a claim can be “a lock” whereas the functional claim element may be “unlocking a lock”
- ◆ It is often possible to recite a claim element without in fact reciting a structure. As for example a claim reciting a door-lock can be recited as “a means for releasably securing a door”.

## functional language

Whereby” or “wherein” are often used as language functionally limiting the claimed invention. One will find this at the end of a claim or group of elements.

We claim:

1. A communication system comprising:
  - a remote communications device configured to communicate through a telecommunication network;
  - a base station in communication with the remote communications device, the base station having a notification system interfacing with the remote communications device, wherein the base station is configured to provide location based notifications to the remote communication device using the notification system.
2. The system according to claim 1 wherein the remote communications device comprise a mobile phone.
3. The system according to claim 1 wherein the remote communications device comprise any device capable of communicating through a telecommunications device.
4. The system according to claim 1 wherein the base station is configured to provide location based notifications to the remote communications device.
5. A system for providing location based notifications, the system comprising:
  - a remote communications device configured to communicate through a telecommunications network; and
  - a base station in communication with the remote communications device, the base station having:
    - a personalization engine configured to interface with the remote communications device and receive personal preferences from the remote communications device;
    - a user preference repository configured to store user preferences obtained by the personalization engine from the remote communications device upon termination of the interface between the remote communications device and the personalization engine;
    - a registry configured to receive and store predefined user information;
    - a preference profiler configured to receive user preferences from the user preference repository and user information from the registry and to create notifications;

# Can you work around patented inventions?

- ◆ To effectively work around patents, one must have the ability to find gaps in patent claims
- ◆ How do you find gaps in a patent disclosure?
  - Read claims
  - Read limitations into claims
- ◆ How do you read limitations into claims?
  - Read limitation into claims from the detailed description of the invention
  - Read limitations into claims from prosecution history
  - Prosecution history estoppel is a bar on the flexibility of doctrine of equivalents.
  - Read Prior art into the claims – invalidate the claim
  - Find absence of ‘Enablement Requirement’ in the specification
  - Find absence of the disclosure of best mode in the specification

# claim construction

- Can you read into the claims limitations based on written description provided in the specification?

Yes, If you do not recite alternatives properly.

- In *O.I Corporation v. Tekmar Company* (Fed. Cir. 1997) the invention was concerning a
  - *device for removing water vapor from a stream of gas, contaminant and water that flows through a temperature controlled “passage”. The written description covered only non-smooth geometries for the passage.*
- The Court was called upon to construct the scope of “passage”. Even though the claims did not refer to any geometry of passage, the Court held that “passage” means “non-smooth passage”.
- This is a typical case of reading limitation into claims by constructing the claim language based on written description.

# how to construe claims

- ◆ Who has the right to interpret claims in the context of a potential infringement - the answer is simple – the court.
- ◆ In *Markman v. Westview Instruments*, the CAFC decided that claim construction is a question of law. The US Supreme Court concurred with this decision.
- ◆ The dispute in *Markman* focused on the meaning of the term “inventory” in a patent claim. The claim covered a ‘system for monitoring “inventory” for a dry-cleaning establishment. Markman’s patented system permitted the user to input information in respect of articles to be cleaned and generate bar-coded tags to attach to the articles. The employees of the cleaning company can then use the bar-codes to the status of the articles being cleaned.
- ◆ On the other hand Westview employed a product which was capable of tracking invoices or cash totals during the cleaning process. Westview’s contention was that its product did not track articles of clothing and did not monitor “inventory” as required in the *Markman* claim. Markman, however, contended that “inventory” was not limited to articles of clothing but could also include ‘cash’ or ‘invoices’.

## “reading limitations into the claims”

- ◆ The Federal Court rejected Markman’s contention and held that “inventory” referred to ‘articles of clothing’. To arrive at this, the Court considered the construction of the meaning of “inventory” as a matter of law and relied on for that purpose the Specification and the Prosecution History.
- ◆ That means in Markman the Court used the specification and the prosecution history to read limitations into the claims.

## prior art



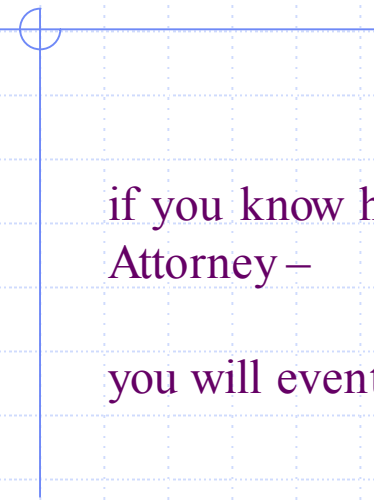
Can you preempt possible attacks on your claims based on prior art while drafting and prosecuting patent applications?

## using prosecution history to limit claims

- ◆ Question is this – can you regain something which you stopped from claiming during prosecution?
- ◆ If you amend your claim during prosecution you would presumptively create an estoppel – as there is a rebuttable presumption that the amendment relates to patentability, the patentee is estopped from recapturing the subject matter relinquished.
- ◆ Tampering with your claims in insubstantial details to avoid infringement is what is prevented by doctrine of equivalents. You read the claims element by element. Each element contained in a patent claim is material to defining the scope of the claim.
- ◆ File wrapper estoppels limit you from applying equivalents in constructing claims and from recapturing what you relinquished.

you may keep this in mind when you look at a claim

- ◆ Review the claims to ensure that the examining attorney will not raise substantive objections.
- ◆ What an examining attorney will identify and evaluate each claim limitation
  - you limit your claim language by excluding subject matters other than what is recited in the claim ‘controlled release pharmaceutical formulation comprising clarithromycin citrate salt’ or a ‘clear suspension formulation of dexibuprofen’
- ◆ The examining attorney will read each claim limitation based on the written description. [(The Markman rule) Markman v. Westview Instruments 31USPQ2d.]
- ◆ In interpreting a specific term the examining attorney will look for explanations provided in the text description. What is the limiting effect of the language in a claim – intended use – adapted to use – wherein – whereby –



if you know how to work around a claim to escape from the Examining Attorney –

you will eventually learn the trick of working around a patent claim



Thank You