

# *Fitch, Even, Tabin & Flannery*

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FITCH EVEN TABIN & FLANNERY  
INTELLECTUAL PROPERTY LAW | EST. IN 1859

## **Preparing Patents With An Eye Toward The Courtroom**

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# Know Your Audiences

- **Patent Examiner**
  - Legally and technically skilled
- **Person Skilled In The Art**
  - Technically Skilled
- **Competitor's Counsel**
  - Legally and technically skilled
- **Judge**
  - Most have little experience with technology
  - Most have little experience with patent law
- **Jurors**
  - Same as judges

# *Draft For The Judge And Jury*

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- Have The Most Difficulty Understanding
- Make Decisions In An Adversarial Setting
- Determine Return On A Substantial Investment
- Focusing On Judge/Jury Will Also Satisfy Other Audiences
  - Examiners are time constrained
  - Experts lack understanding of patent law
  - Competitors may evaluate jury appeal of patent

# *Draft For The Judge And Jury*

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- Present Invention In Understandable Language
  - Minimize Technical Jargon
  - Sell The Invention As An Advancement
  - Simplify Very Complex Inventions
  - “Spruce Up” Simple Inventions
    - Show that there is a lot involved to solve problem
    - Include supporting data
    - Provide reasons to distinguish art that lacks the data
  - Emphasize Problems Addressed and Solved
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# *Use Inventors Effectively*

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- Juries Like Inventors
- Juries Comprehend Stories
- A Patent Should Tell An Inventor's Story (Or The Story Of A Project)
- Inventors Often Have Great Insights
- Inventors Can Help Get A Patent Allowed
- Inventors Are Often Key Trial Witnesses

# *The Inventor Interview*

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- Provides Foundation Of An Effective Patent
- Be Prepared
  - Study the invention
  - Learn the relevant terminology
- Let The Interview Direct Content Of Application
  - Disclosure forms often don't tell the whole story
- Review Chronology Of The Development
  - What worked?
  - What didn't work?
  - What areas posed the greatest challenges?

# *The Inventor Interview*

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- **Identify The Heart Of The Invention**
  - Why is the inventor excited?
  - Why will the invention lead to success in the marketplace?
  - How will the invention be touted to customers?
- **Obtain Any Sales Materials**
  - Helpful in developing a “sales pitch” in patent
  - Match patent terminology to likely testimony of inventor and business representatives at trial
- **Discuss Known Prior Art**
  - What are the shortcomings of prior art?
  - What are the shortcomings of competitor’s product?
  - Was there a problem that others overlooked?

# *The Inventor Interview*

- **Discuss Each Element Of Apparatus Or Process**
  - Why was this element chosen?
  - What is its function?
  - How does it work?
  - Did you consider alternatives for this element?
  - Why is chosen element better than alternatives?
  - What would a competitor substitute to avoid the element?
- **Extract All Advantages Of The Invention**
  - Advantages permit functional distinctions over the art
  - Difficult to distinguish art at trial when advantages not disclosed in patent
- **Address Future Generations Of The Product**

# Patent Drawings

- **Make Good Drawings**
  - Extremely useful at trial
  - More readily understood than text
  - Displayed frequently
  - Jury may compare drawings to accuse device
- **The First Drawings Are Most Important**
  - Jury will focus on cover page and first few drawings
  - Should clearly capture heart of invention
  - Perspective views are more readily understood
  - Fig. 1 – general environment of the invention
  - Fig. 2 – most important aspects of invention

# *The Background*

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- Most Readers Of A Patent Start Here
- Lay Foundation To Establish Invention As Advancement
- Do Not Reveal The Solution
- Tell A Story
- Avoid Damaging Admissions Regarding The Prior Art
- Show That There Is A Lot Wrong With Prior Art
  - State problems of each prior art solution
  - Make the problems seem insurmountable

# *The Summary*

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- **Very Important Section**
  - Reader will review to understand the invention
  - Often the best place to show support for proposed amendment
- **Should Answer This Request From The Court:**
  - “Please read one or two paragraphs from your patent, telling us what this invention is all about.”
- **Describe Environment Of Invention**
- **Do Not Limit Invention To That Described**

# *The Summary*

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- **Give A Sales Pitch**

- V.P. of marketing may testify at trial

- Provides link to establishing commercial success and damages

- How did inventor solve the problem?

- Why is it an advancement?

- Why is it commercially valuable?

- Relate each advantage to a problem addressed in the background

- Describe invention in broad, problem-solving terms

- Discuss important structure of independent claims

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# The Claims

- Assume Every Term Is Subject To Judicial Interpretation
- Use Consistent Terminology
- Use Broad Generic Terms For Each Element
  - Element, member, actuator, operator, driver, support
- Consult A Dictionary
  - Important evidence of claim meaning
  - Infringer will use the narrowest definition to limit claim
- Use Functional Language
  - Broad claim scope
  - More likely to avoid doctrine of equivalence

# The Claims

- **Vary Claim Scope**

- Broad-fewest elements to define invention and distinguish art
- Narrow – describe commercial embodiment

- **Include Narrower Independent Claims**

- Infringement of long claims upsets jury
- Dependent claims more difficult to explain at trial
- Judges often ignore dependent claims

- **Include Method Claims**

- Provide basis for divisional/continuation practice
- Provide broader scope of protection
- Create other classes of infringers
- Support additional damage theories

# The Claims

- Claim Inventive Feature Outside Its Environment

→Example:

- “Grounding strap for telephone line”
- Infringed by use for cable TV lines?

- Draft Preamble Cautiously

→Limiting if “breathes life and meaning into the claim”

→Example:

- “A probe station chuck suitable to reduce measurement noise”
- Claimed structure – “at least one insulator layer coated with a conductive layer”
- Non-adhered interfaces increase noise
- Claim interpreted to require all insulators to be coated

# The Claims

- **Avoid Antecedent Basis Problems**
  - Can lead to invalidity or narrower claim interpretation
  - Recite each claim element positively
  - Check dependencies when canceling claims
- **Consider Means-Plus-Function Claims**
  - Potentially broad in light of recent case law
  - Potential tool for avoiding *Festo* issues when making amendments

# *The Detailed Description*

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- **Provide Broad Description Up Front**
  - Overall environment
  - Problems addressed
  - Inventive features of independent claims
- **Follow with more narrow details**
  - Paint a word picture of the invention
  - Establish fall back positions for amendments
  - Best mode, enablement, written description
  - Summarize operation of device or system
  - Discuss alternatives
  - Make it clear invention not limited to narrow details

# *The Detailed Description*

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- **Introduce Each Element By Stating Its Broad Function**

→ “An actuator 20 is provided for the purpose of actuating the locking lever 21 between its release position and the locking position. Herein, the actuator 20 is pushed by the finger of the person pushing on the push button 21...”

- **Describe The Structure As Preferred**

→ “The preferred actuator is a bellcrank 24 having a first arm 25 operatively associated with the push button and a second arm operatively associated with the locking lever which directly engages the locking lever.”

# *The Detailed Description*

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- **Describe Alternative Structures**
  - Helps establish equivalency
  - Emphasize benefits of preferred structures to avoid art
  - Describe main and sub-aspects of invention in broad, functional, problem-solving terms
  - Address each sub-aspect in a separate paragraph
  - Provide basis for more than one theory of invention

# *The Detailed Description*

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- **Avoid Absolutes**

- Essential, critical, necessary, prevent, eliminate, etc.

- *Gentry Gallery*, 134 F.3d 1473 (Fed. Cir. 2001) (disclosed “caching” feature read into claim term “server”)

- *Biovail Corp.* 239 F.3d 1297, 1301 (Fed. Cir. 2001) (limitation read into a claim based on “the totality of the patent’s applicable prosecution history”)

# *The Detailed Description*

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- **Stay In The Real World**

- “Secondary considerations” resonate with jurors
- Faster operation, greater throughput, less downtime, higher efficiency, etc.
- Technical experts will focus on commercial advantages
- Damage theories will focus on commercial advantages
- Experts will not use patentese
- Jury wants to know:
  - how invention works
  - why it works better

# *The Detailed Description*

- **Figures Are Relevant Intrinsic Evidence**
  - Especially when express definition not provided
  - Describe figures as only illustrative
- **Abstract Is Relevant Intrinsic Evidence**
  - *Hill-Rom Co. v. Kinetic Concepts, Inc.*, 209 F.3d 1339,1341 n.1 (Fed. Cir. 2000) (“we are aware of no legal principle that would require us to disregard that potentially helpful source of intrinsic evidence as to the meaning of claims”)
  - Don’t treat as a clerical detail
  - Use to lend support to broad scope of claim terms

# *The Detailed Description*

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- Statement of Reasons For Allowance Is Relevant Intrinsic Evidence
  - *Elkay v. Ebco*, 192 F.3d 973, 979 (Fed. Cir. 1999) (patentee “disavowed a potential interpretation” by not responding to Statement of Reasons for Allowance that set forth Examiner’s contrary understanding of claim terms)
  - File response broadly

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