

Drafting Lessons for Patent Prosecutors

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Patent Claim Construction

Atlanta, Georgia

April 27, 2007

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Main Drafting Challenges

- **Role of Specification in Claim Construction**
- **Prior Art Knowledge**
- **Person of Ordinary Skill in the Art**

Main Drafting Objectives

- **Capture the Full Scope of the Invention**
 - **Secure competitive advantage**
 - **Maximize return on investment**
- **Minimize the Zone of Uncertainty**

Drafting Tools

- **Explicit Definitions**
- **Objects of Invention**
- **Disclaimers**
- **Alternative Embodiments**
- **Means-Plus-Function Claim Elements**

Drafting Pitfalls

- **Invention Characterizations**
- **Summary of the Invention**
- **Field of the Invention**
- **Implicit Definitions**
- **Preambles**

Drafting Pitfalls

■ Means-Plus-Function Language

- **Claim elements reciting insufficient structure (e.g., “lever moving element for moving the lever”)**
- **Claim elements reciting sufficient structure to perform the recited function (e.g., “perforation means for tearing”)**

Drafting Pitfalls

- **No structure disclosed for performing the recited function (e.g., failure to disclose algorithm for computer-implemented means)**
- **Non-Sensical Claims**
- **Inoperative Claims**

Drafting Approaches

- **Expansive Disclosure Approach**
- **Minimal Disclosure Approach**
- **Glossary Approach**
- **Claim-Centric Approach**
- **Integrated Approach**

Expansive Disclosure Approach

- **Avoid singular references to “invention” or “embodiment”**
- **Avoid limiting language like “important” or “essential”**
- **Avoid characterizing invention (e.g., description of drawings section)**

Expansive Disclosure Approach

- **Describe a broad range of equivalents**
- **Describe a representative range of embodiments**
- **Avoid prior art admissions and figures**

Minimal Disclosure Approach

- **Avoid disclosure of material not necessary for enablement or best mode**
- **Avoid objects of the invention**
- **Avoid excessive examples**
- **Avoid statements on problems solved by invention**

Glossary Approach

- **Use explicit definitions**
- **Cite key prior art publications**
- **Discuss claims with inventor(s)**

Claim-Centric Approach

- **Draft claims before drafting the specification**
- **Limit to scope of independent claims:**
 - **Summary of Invention**
 - **Title**
 - **Field of Invention**

Integrated Approach

- **Use terminology of inventor(s)**
- **Use words from the specification for claim terms**
- **Use words consistently throughout the patent and within its patent family**

Strategies Based on Judge Michel's FICPI Drafting Tips

■ **Avoid claim amendments**

- **Use a range of independent claims from broadest to narrowest with each including patentably distinct limitations**
- **Conduct a prior art search and claim the invention precisely**
- **Rely on the specification instead in responding to §112 rejections**

Strategies Based on Judge Michel's FICPI Drafting Tips

- **Make sure every claim term is supported**
 - **Avoid claim terms not described in the specification**
 - **Use dependent claims to recite the corresponding structure for means-plus-function language**

Strategies Based on Judge Michel's FICPI Drafting Tips

- **Describe multiple embodiments wherever possible**
 - **Ask inventors about alternative embodiments**
 - **“Tree” approach**
 - ◆ **Trunk - Preferred embodiment**
 - ◆ **Branches - Alternative embodiments**

Strategies Based on Judge Michel's FICPI Drafting Tips

- **Check appropriateness of claim term meaning**
 - **Check a technical dictionary**
 - **Ask inventor's understanding of claim terms**
 - **Check use of claim terms by prior art**

Strategies Based on Judge Michel's FICPI Drafting Tips

- **Draft claims that will be literally infringed**
 - **Avoid use of embodiment-specific language in independent claims**
 - **Identify all known corresponding structures for means-plus-function language**