



## Patent Resources Group

### Crafting & Drafting Winning Patents

#### Course Syllabus

#### I. PROFESSOR KAYTON'S OVERVIEW CHAPTER

- A. Crafting and Drafting a Winning Patent Is Shockingly More Difficult to Achieve Than Ever Before
- B. The Major Source of the Aggravated Difficulty – *de novo* Review of Claim Construction
- C. The Underlying Defect in *de novo* Federal Circuit Review of Claim Construction
- D. The Generic Solution to the Difficulty – Low Profile, Common Denominator (LP-CD) Practice
- E. Some Federal Circuit Generated Chaos Regions in *ex parte* Patent Practice
  - 1. Chaos Region I. 35 USC §112, ¶1 (Description Requirement); the Federal Circuit's New Attack on Validity, and Its New Attack No. 1 on Literal Infringement
  - 2. Chaos Region II. Claim Interpretation; the Federal Circuit's New Attack No. 2 on Literal Infringement
  - 3. Chaos Region III. 35 USC §112, ¶6 (Means-Plus-Function Clauses); the Federal Circuit's New Attack No. 3 on Literal Infringement
  - 4. Chaos Region IV. Infringement, *vel non*, Under the Federal Circuit's Judicial Doctrine of Equivalents
  - 5. Chaos Region V. Prosecution History Estoppel Defeats Not Only Equivalence Infringement, But Also Literal Infringement, Even When the Amended Claim Reads Literally and Also Distinguishes From the Prior Art; the Federal Circuit's New Attack No. 4 on Literal Infringement
- F. Even So, *ex parte* Patent Practitioners Can Prevail

#### II. THE CRITICAL ROLES OF THE SPECIFICATION, CLAIMS AND PROSECUTION IN CLAIM CONSTRUCTION – LOCKING IN LITERAL INFRINGEMENT

- A. Use of Specification, Abstract of the Disclosure, and Claims in Claim Construction – Pre-*Phillips*
  - 1. *Multiform Desiccants* – “Degradable” Limited to “Dissoluble” Based on Specification
  - 2. Even the Abstract May Be Employed to Construe Claims



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3. *SciMed v. ACS* – Protection Limited to Arrangement in Specification Based on Statement in Specification
4. *Kimberly-Clark v. Tyco* – Protection Limited by Statements in Specification Despite Broadening Amendment
5. *Teleflex v. Ficosa North America* – Ordinary Meaning of Claim Terminology Prevails
6. *CCS Fitness v. Brunswick* – Exceptions to Use of Ordinary Meaning Crystallized
- B. *Phillips v. AWH Corp.*
  1. District Court Finds No Infringement
  2. Original Federal Circuit Three-Judge Panel Affirms
  3. Federal Circuit *en banc* Decision – Rules of Claim Construction
  4. The Role of Extrinsic Evidence, Including Dictionaries
  5. Claims Should Not Be Limited to Details of the Embodiment Disclosed
  6. Application of Claim Construction Principles to the Facts in *Phillips*
  7. The Principle of Attempting to Preserve Claim Validity Has Limited Application to Claim Construction
  8. The Court Declines to Address the Deference to Be Accorded to a District Court’s Interpretation
  9. Judge Mayer’s Dissent
  10. Judge Lourie’s Dissent
- C. Post-*Phillips* Claim Construction
  1. *Nystrom v. Trex* – “Board” Means “Wooden Board” Based on Specification and Despite Claim Differentiation
  2. *Izumi Products v. Koninklijke Philips Electronics* – Claim Differentiation Fails to Save Broad Claim Construction
  3. *Pause Technology v. TiVo* – Intrinsic Record Trumps Encyclopedia to Narrow Claim Interpretation
  4. *Cannon Rubber v. The First Years* – Start With the Ordinary Meaning and Then See if the Specification Requires Anything Else



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5. *NCube Corp. v. Seachange International* – Panel Rejects Defendant’s Request to Limit Claims to Specification Based Primarily on Claim Differentiation
  6. *Honeywell v. ITT and TG Fluid Systems* – Limitations from Specification Read Into Claims
  7. *Cook Biotech v. ACell* – Incorporation of Second Patent by Reference Causes Narrow Claim Construction
  8. *Acumed v. Stryker* – Limitations From Specification Not Read Into Claims; Further Disputes Regarding Dictionary Definitions
  9. *PODS Inc. v. Porta Stor Inc.* – Panel Gives Claim Differentiation No Significance
  10. *Oatey Co. v. IPS Corp.* – An Attempt Should Be Made to Construe Claims to Cover at Least Disclosed Embodiments
  11. *Ormco Corp. v. Align Technology, Inc.* – Inconsistent Use of *Phillips* Within a Single Opinion
  12. *Decisioning.com v. Federated Dep’t Stores* – Preferred Embodiment Narrows the Claims
- D. Use of Prosecution History to Interpret Claims
1. *Tol-O-Matic v. Proma Produkt-Und* – Prosecution History Limits Claim Scope
  2. *Hockerson-Halberstadt* – Patentee Held to Clear Error in Prosecution History to Narrow Claim Interpretation
  3. *Wang Laboratories v. AOL* – Correct Factual Statement About Prior Art in Prosecution History Construed as Distinguishing Invention From Prior Art to Limit Protection
  4. *Microsoft v. Multi-Tech* – Comments in Child Application After Parent Issues Limits Protection Provided by Parent
  5. *Liebel-Flarsheim v. Medrad* – Ordinary Meaning Prevails, Claims Broadened During Prosecution After Patentee Discovers Defendant’s Product
  6. *Hakim v. Cannon Avent Group* – Narrow Construction Based on Disclaimed Scope in Parent Application Despite Continuation Amendment
- E. Use of Extrinsic Evidence to Interpret Claims



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1. *Vitronics v. Conceptronic* – If Intrinsic Evidence Is Sufficient to Construe Claims, Extrinsic Evidence Is Entitled to No Weight
  2. *Fromson v. Anitec Printing Plates* – Extrinsic Evidence Used to Narrow Scope of Protection to Less Than Ordinary Meaning
  3. *Pitney Bowes v. Hewlett Packard* – Extrinsic Evidence Can Always Be Considered, But Can Never Override Intrinsic Evidence
  4. *Global Maintech v. I/O Concepts* – Re-affirming the Proper Use of Extrinsic Evidence in Claim Construction in the Post-*Phillips* Era
  5. *Helmsderfer v. Bobrick Washroom Equipment* – Extrinsic Evidence Can Exclude Disclosed Embodiments
- F. LP-CD Techniques to Avert Unduly Narrow Claim Construction
1. Describe Multiple Embodiments, Multiple Alternatives for Each Element, and Multiple Features (e.g., Shapes and Locations) for Each Element in the Specification
  2. Conduct the Most Exhaustive Pre-Filing Prior Art Investigation That Your Client's Resources Permit
  3. File Numerous Claims of Widely Varying Scope
  4. Make No Reference in the Specification to "The Invention" (as Distinguished From "An Embodiment of the Invention") or Its Advantages

**III. UNDERSTANDING AND AVERTING THE INVALIDITY ATTACK BASED ON 35 USC §112, ¶1**

- A. The Case Law
1. The Relevant Case Law Prior to *Gentry*
  2. *Gentry Gallery v. Berkline*
  3. *Tronzo v. Biomet*
  4. *Johnson v. Zebco*: *Gentry* Is Narrowly Limited
  5. *Toro v. Ariens*: *Gentry* Is Applied Broadly
  6. *Cooper v. Kvaerner*: The Author of *Gentry* and *Toro* Denies the Existence of an "Essential Element" Requirement



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7. *Amgen v. HMR: A Gentry-Based Attack on Generic Claims in an Unpredictable Technology Is Rejected; Written Description Support Was Not Defeated by Later-Developed Technology*
  8. *Chiron v. Genentech* – Later-Developed Technology Held to Defeat Written Description Support; *Amgen, Phillips* and *Koller* Are Ignored
  9. *In re Curtis: Tronzo* Reincarnated
  10. *LizardTech v. Earth Resource Mapping* – Broad Original Claims in Predictable Technology Held Invalid for Lack of Written Description Support
  11. *Purdue Pharma v. Faulding*: The Federal Circuit Imposes an Alarming New Prerequisite to Satisfaction of the §112, ¶1 Written Description Requirement
  12. *Gilbert Hyatt v. Dudas* – *Prima Facie* Case for Written Description
  13. Summary of the Case Law – Chaos Reigns
  - B. LP-CD Prosecution Measures to Reduce Risks of Invalidity Imposed by *Gentry, Tronzo, Toro, Curtis* and *Purdue Pharma*
- IV. CRAFTING MEANS-PLUS-FUNCTION CLAIMS TO PRESERVE LITERAL INFRINGEMENT**
- A. Means-Plus-Function Construction
  - B. Tying Means-Plus-Function Clause to Specification
    1. *In re Dossel* - Written Description Must Describe Structure Corresponding to a Means-Plus-Function Clause Except When That Structure Would Be Inherently Known to Those Skilled in the Art
    2. Written Description Must Link the Function of the Claim to the Corresponding Structure in the Written Description
    3. Failure of the Written Description to Describe the Structure Corresponding to a Means-Plus-Function Clause Invalidates the Claim
  - C. Meaning of Equivalents in §112, ¶6
  - D. Language Which Does/Does Not Invoke §112, ¶6
    1. General Rule - Use of “Means for” Creates a Presumption That §112, ¶6 Was Intended to Be Invoked, and Absence



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of “Means For” Creates Presumption That §112, ¶6 Was Not Intended to be Invoked

2. *York Products v. Central Tractor Farm & Family Center* - Use of “Means” Without Function Does Not Trigger §112, ¶6
  3. Recitation of Structure in Claim Sufficient to Perform Function Recited in Means Clause Precludes Interpretation Under §112, ¶6
  4. Claim Elements Without “Means” and Without Structure Can Be Interpreted Under §112, ¶6
  5. Instances of Common Claim Language That Do NOT Invoke §112, ¶6
- E. Method Claim Elements Interpreted Under §112, ¶6
- F. USPTO Interpretation of Means-Plus-Function Clauses
- G. Claim Differentiation and Means-Plus-Function Clauses
- H. Employing Means-Plus-Function Clauses in Effective Patent Applications

**V. DOCTRINE OF EQUIVALENTS/PROSECUTION HISTORY ESTOPPEL**

- A. The Slow, Steady and Continuing Decline of the Doctrine of Equivalents
1. Background of the Doctrine of Equivalents
  2. *Warner-Jenkinson v. Hilton Davis*
  3. Reward for Design Arounds
  4. Unrewarded Pioneer Patents
  5. Present Trend
- B. The Slow, Steady and Continuing Rise of Prosecution History Estoppel
1. *Warner-Jenkinson v. Hilton Davis* – the Supreme Court Imposes a New Presumption and a New Burden on Patentees
  2. *Festo Corp. v. Shoketsu*
  3. An Infringement Decision Tree in View of *Festo VIII* and *IX*
  4. The Federal Circuit's Ever-Expanding List of Estoppel-Creating, Equivalence-Barring Events



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- C. Solutions for Overcoming the Limitations of the Doctrine of Equivalents
  - 1. Draft Broadest Patentable Claims, Including Claims to Patentable Subcombinations
  - 2. Draft Narrower Claims in Finely Varying Scope
  - 3. Avoid Patent Profanity
  - 4. Set Up Equivalency in the Specification
  - 5. Continuation Practice to Maintain Flexibility
- VI. PROSECUTION THAT CONTROLS CLAIM CONSTRUCTION AND AVOIDS PROSECUTION HISTORY ESTOPPEL**
  - A. Basic Concepts
  - B. How and Why to Avoid Amending the Claims or Arguing Patentability of the Invention or Specific Claim Limitations
    - 1. Responding to a Defective §102 Rejection
    - 2. LP-CD Attack (Rather Than Rebuttal) of a Defective *Prima Facie* Obviousness Rejection
    - 3. Non-LP-CD Attack of a Defective *Prima Facie* Obviousness Rejection (Akin to Rebuttal)
    - 4. Responding to Other "Patentability" Rejections
    - 5. Using Interviews to Obtain the Broadest Possible Claims and Minimize Prosecution History Estoppel
    - 6. Example of LP-CD Attack in Response to a Complex §103 Rejection
    - 7. Fall Back to Declaration Practice.
- VII. ETHICAL CONSIDERATIONS FOR PATENT PROSECUTION**
  - A. Basic Principles of Inequitable Conduct
    - 1. Materiality
    - 2. Intent
    - 3. Balancing Materiality and Intent
  - B. Withholding Material Information
    - 1. Prior Art
    - 2. Cumulative Prior Art
    - 3. Translations of Foreign Prior Art
    - 4. Prior Sales
  - C. Withholding Other Information Potentially Affecting Patentability
    - 1. Inventorship



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2. Enablement
  3. Best Mode
  4. Declarant's Relationship with Applicant
  - D. Submission of False or Misleading Information
    1. Examples Described in Specification
    2. Affidavits
    3. Prior Art Search in a Petition to Make Special
    4. "Unintentional" Abandonment in a Petition to Revive
- VIII. SURVEY OF LOW PROFILE, COMMON DENOMINATOR TECHNIQUES (LP-CD) IN *EX PARTE* PRACTICE**
- A. The Way in Which the LP-CD Techniques Are Presented in This Chapter
    1. Generic and Species Techniques
    2. Triage in LP-CD Generated Factors
  - B. Chronology of LP-CD Practice Techniques for Every Winning Patent
    1. *Technique No. 1:* The Pre-Filing Prior Art Search Is the *Sine Qua Non* of LP-CD Practice
    2. *Technique No. 2:* Insure That the Broadest Allowable Claims Are Submitted in the Application as Filed
    3. *Technique No. 3:* File Numerous Claims of Widely Varying Scope
    4. *Technique No. 4:* Ignore the USPTO's MPEP-Based Request for a Preferred Stylized Specification Format
    5. *Technique No. 5:* Make No Reference to "the Invention" (as Distinguished From "an Embodiment of the Invention") or Its Advantages
    6. *Technique No. 6:* Describe Multiple Embodiments, Multiple Alternatives for Each Element, and Multiple Features (e.g., Shapes and Locations) for Each Element in the Specification
    7. *Technique No. 7:* Do Not Characterize any Element or Feature as Essential, Critical, Required, Necessary, Important, Advantageous, Beneficial, Desirable or Preferred



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8. *Technique No. 8:* Optimum Approach to Writing the Abstract of the Disclosure
  9. *Technique No. 9:* Incorporate Priority Applications by Reference, But Only if the Priority Applications Satisfy LP-CD Practice
  10. *Technique No. 10:* Attack Obviousness Rejections for Want of *Prima Facie* Support
  11. *Technique No. 11:* Use Rule 1.132 Declarations to Support Attacks on Obviousness Rejections
  12. *Technique No. 12:* Attack Improper §102 Rejections
  13. *Technique No. 13:* Use Rule 1.131 or 1.132 Declarations When the Examiner's Rejection Is Formally Proper
  14. *Technique No. 14:* Prosecution Should Be Terse
  15. *Technique No. 15:* Avoid Jepson Claims
  16. *Technique No. 16:* Take Advantage of Continuation Practice
  17. *Technique No. 17:* Beware of Foreign Filing and Prosecution That Generate Problems in the U.S.
- C. Checklist for Crafting and Drafting Winning Patents  
D. Modified LP-CD Practice