

Landis on Mechanics of Patent Claim Drafting

Fifth Edition

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In this release, author Robert C. Faber updates and expands *Landis* with practical information and commentary on a variety of issues affecting patent claim drafting. Among the topics covered are the following:

- **Statutory classes:** The Federal Circuit's *In re Nuijten* found that a transitory form of signal transmission, such as a radio broadcast, an electrical signal transmitted through a wire, and a light pulse through a fiber optic cable, were not directed to statutory subject matter, as the signal has no physical form or concrete structure. In particular, it is not a "manufacture." Claimed otherwise, it might fall within a class, including claims with, for example, the preamble "A method of embedding supplemental data in a signal." Therefore, the claim writer should use physical articles for creating or using the object which itself lacks physical form for the claim to fall within a statutory class. See § 1:3.
- **Transitional terms—alternatives to "comprising":** Although "comprising" is recommended as the standard term, other terms given the same meaning include "characterized by" or "characterized in that" (a transition used in claims in non-U.S. applications by foreign attorneys). Another alternative is "comprised of"—although a district court misconstrued it as closed-ended and had to be corrected by the Federal Circuit. See § 2:5.
- **Words of approximation:** In *Young v. Lumenis, Inc.*, the Federal Circuit held that "near the edge" was not indefinite, because the intrinsic evidence, here the specification, provided guidance and there was no need to resort to extrinsic evidence. A precise numerical measurement was not required. A person of ordinary skill would know where to make a cut. The court said "near" was akin to "approximately." See § 3:16, at note 195.1.
- **"Means" clauses:** The Federal Circuit's *Biomedino LLC v. Waters Techs. Corp.* illustrates the harm caused by insufficient disclosure of a means element in the specification. The claim recited "control means," which the court construed as under section 112, paragraph 6. The only references in the specification that might be construed as disclosure were a box labeled "control" in a figure, and a statement in the specification that the process "may be controlled automatically by known differential pressure, valving and control equipment." The court found that these references failed to identify structure corresponding to "control means," so the claim was indefinite. See § 3:25, at note 335.1.
- **Markush groups:** The examiner may require provisional election of a single species for initial search and examination. Then, if claims to the elected species are allowable, the search and examination of the *Markush* claim will be extended

to the nonelected species to the extent necessary to determine patentability of the claim. Claims drawn to species patentably distinct from the elected species are held withdrawn from consideration. See § 6:2.

- **Scope of claims:** The author advises including a claim that is likely to be practiced by a single entity only, and that need not be, or is likely not to be, practiced by more than one entity. The point is illustrated by the Federal Circuit's *BMC Resources v. Paymentech, L.P.* (finding no infringement when different respective steps in one process claim of a patent were performed by different entities). See § 7:1.
- **Claim differentiation:** The flip side of duplicate claiming is the doctrine of claim differentiation. That doctrine usually applies in the context of a broader or independent claim, on the one hand, and a narrower or dependent claim, on the other hand. Claim differentiation refers to the presumption that an independent claim should not be construed as requiring a limitation added by a dependent claim. See § 8:2.
- **Double patenting:** A patentee may not obtain two patents with an identical claim or on the "same invention," as this would be prohibited statutory double patenting of the claim. MPEP 804 specifies the conditions for statutory double patenting. There is also a judicially created doctrine of nonstatutory, obviousness-type double patenting, which precludes claims in separate patents and/or applications from being so alike that granting both claims would effectively extend the life of those patent claims. See new § 8:2A.

In addition, this release includes **Appendix C1** (selected sections of the patent statute), **Appendix C2** (selected sections of the rules of practice), and **Appendix D** (glossary and index of patent terms).

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