



Topic 3: Common Pitfalls in Drafting and Prosecuting a Patent Application

National Patent Drafting Course

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Objectives of Preparation and Prosecution

- Prosecute claims of sufficient scope to read on the competition, yet just narrow enough to avoid the prior art.
- Fully describe the inventor's conception to provide support for the broadest claim construction possible and to comply with the requirements of various written description laws.
- Obtain strong, enforceable claims that will withstand validity challenges and be difficult to design around to achieve non-infringement.



The Top Five Drafting and Prosecution Mistakes That Impact Enforcement

1. Patent's own words restrict claims
2. Unnecessary amendment and/or arguments
3. Prior Art – unaware or ill-informed
4. Mischaracterization of results/facts
5. Obviousness/Enablement balance

Patent's Own Words Restrict Claims

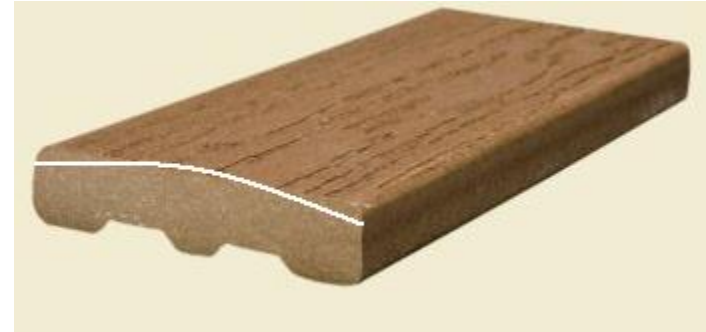
- The U.S. has a uniquely complex patent system
 - Statements made in the specification and prosecution history that would have no impact on claim scope in other jurisdictions, such as India, may narrow claim scope in the U.S.
- And U.S. case law makes drafting the specification **even more critical**.
 - “The specification is always highly relevant to claim construction analysis ... it is the single best guide to the meaning of a disputed term.” *Phillips v. AWH* (Fed. Cir. 2005) (en banc).

Troublesome Specifications

- Even if claims are broad, if the specification is not written with care, it may limit the claims.
 - Vague claim terms with corresponding narrow disclosure
 - Inconsistent use of terms throughout the application
 - Highlighting non-claimed features of embodiments
 - Narrow examples without a more general description
 - Describing unclaimed benefits of the invention
 - Attributing the word “invention” to unclaimed features
 - Ordinary words may be limiting

TREX Case

Claim 1. A flooring board having a slightly curved configuration...

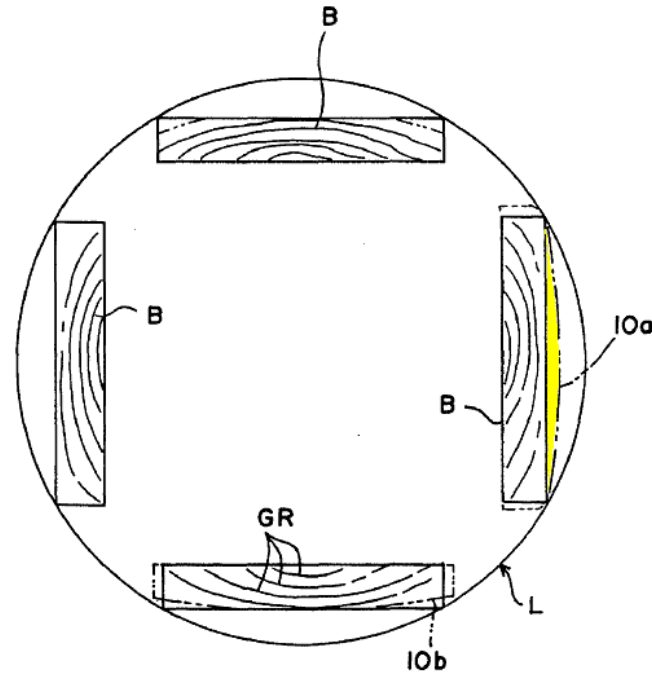


Case turned on whether a composite plastic/wood particle structure is a “board”.

Infringement? Yes or no?

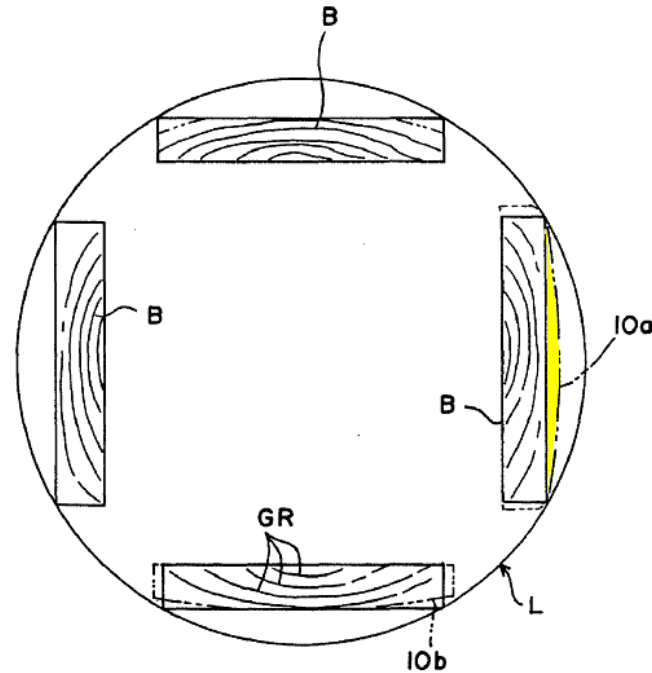
Depends On Definition Of Board

- Court noted emphasis in specification on described benefits when the board is cut from a log.



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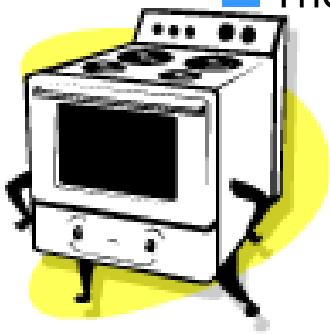


Not Infringed

“At” v. “To”

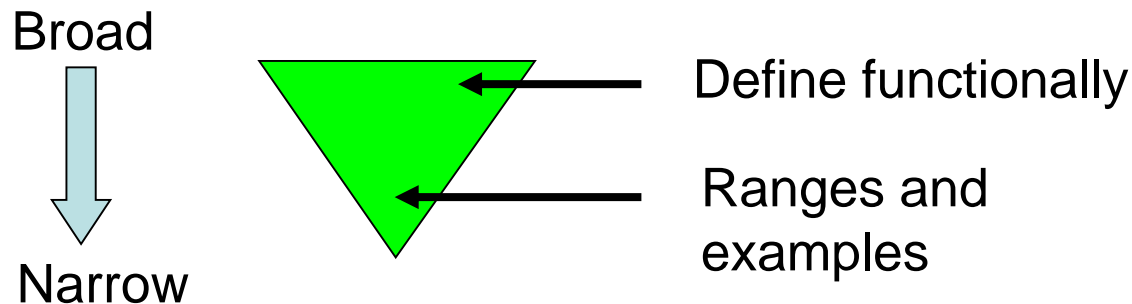
■ *Chef America, Inc. v. Lamb-Weston, Inc.*, (Fed. Cir. 2004)

- Claim: process for baking dough by “heating the . . . dough **to** a temperature in the range of about 400 degrees F to 850 degrees F.”
- Specification: two examples, each stating that the dough product is placed in a multi-layered convection oven and baked “at temperatures” or “at a temperature” of 680° F to 850° F.
- Court: construed claim to mean temperature of dough, therefore it found no infringement.
 - “Courts may not redraft claims.”
 - The patentee could have chosen “**at** a temperature”, but did not.



Lessons

- Be careful of statements that impose limitations on scope of invention.
 - The control unit “is” vs. “may be”
 - The “invention is” vs. “the invention may include”
- Define claim terms broadly (and consistently!)



- Carefully review terms in the specification

Lessons (cont'd)

■ Avoid “Patent Profanity” when drafting specification and responding to Office Actions

- Peculiar
- Significant
- Critical
- Special
- Essential
- Key
- Necessary
- Preferable (?)

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Unnecessary Amendments And/Or Arguments

- Remember that overcoming the rejection by amendments and arguments may create potential estoppels.
- Make the Examiner do their job!
 - The Examiner must first make the case for the rejection
 - First response: Attack the basis for rejection
 - Second response: Carefully crafted amendments
- Arguments must be as concise and focused as possible.
- If amending the claims, make certain that the most valuable embodiments are still covered by the claims.

Attack The Premise Of The Rejection

- Attacking the premise of an obviousness rejection rather than amending the claim is important to avoid prosecution history estoppel.
 - Arguments are focused on the prior art rather than the claimed invention.
 - No suggestion or motivation to modify/combine the prior art.
 - No reasonable expectation of success to make the modification suggested by the Examiner.
- *KSR Intern. Co. v. Teleflex, Inc.* makes the patent practitioner's job more difficult, but not impossible.

Emphasize Unpredictability

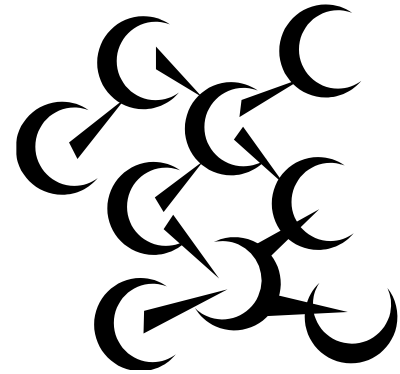
■ USPTO's KSR Guidelines – Rationales to Support Obviousness Rejections

- A. Combining prior art elements according to known methods to yield **predictable** results
- B. Simple substitution of one known element for another to obtain **predictable** results
- C. Use of known technique to improve similar devices in same way to achieve **predictable** result
- D. Applying a known technique to a known device ready for improvement to yield **predictable** results
- E. “Obvious to try”—choosing from a finite number of identified, **predictable** solutions, with a reasonable expectation of success
- F. Known work in one field may prompt variations of it for use in same or different field based on design incentives or market forces if the variations would have been **predictable**
- G. TSM test (“**T**eaching, **S**uggestion, **M**otivation”)

Specific Industries

■ Chem/Bio

- well-recognized unpredictable art
- Still a lot of ammunition, including no “reasonable expectation of success”



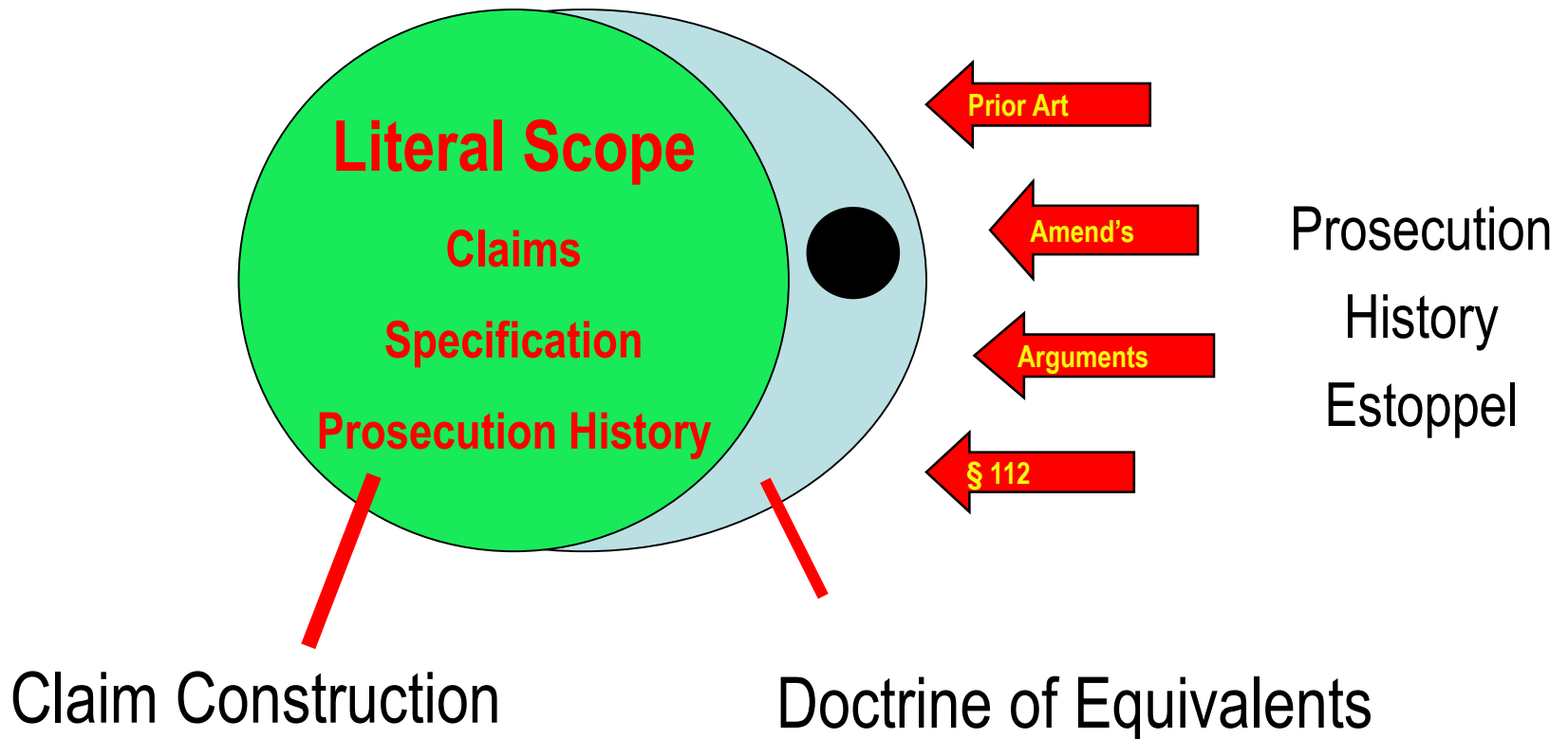
■ Mechanical/Electrical

- more predictable art
- obviousness may be easier for competitor to show because a “reasonable expectation of success” may now be easier to show



Surrendering Equivalents

- In U.S., this can arise when determining claim scope or ability to rely on doctrine of equivalents.



Narrowing Might Get You Stuck Later

Rule:

- Narrowing amendments made for purposes of patentability create a presumption that you have surrendered all equivalents for that narrowed element.



Lessons

- Focus arguments on the prior art relied upon by the Examiner rather than the claimed invention.
 - Mine the prior art for disclosures that would guide one of ordinary skill in the art away from the combination suggested by the Examiner.
 - Here, “patent profanity” in the prior art is our friend!
- If amendments are necessary, be surgical.
 - Consider examples to ensure coverage
 - Present additional independent claims to recite subject matter in an alternative way to avoid the prior art

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3. Prior Art – Unaware or ill-informed

- Most patents fail during enforcement based on prior art newly discovered after the patent issues.
- Particularly troublesome when don't have good fallback positions (e.g., in dependent claims).

28. The computer program product of claim **27** wherein the computer readable medium is selected from the group consisting of CD-ROM, floppy disk, tape, flash memory, system memory, and hard drive.

Lessons

- Better prior art searching leads to stronger patents. Certainly look in your own files. This provides an opportunity to craft the claims around the prior art.
- Don't view prior art through rose-colored glasses.
- Craft multiple tiers of claim strategies so that if one falls, you have a backup.
 - Effective use of dependent claims.



Admissions Regarding Prior Art

- A statement in application that something is prior art is binding for determinations of anticipation and obviousness.
 - Even if characterizations unclear and do not even describe prior art.
 - Same reasoning applies to admissions in an IDS.



Lessons

- Do not make the admission in the first place!
 - Do not use a heading like “Description of “Prior Art” which can be construed as an admission.
- Is there really a need to discuss the prior art at all in the specification?
 - Is there really any need to use the term “prior art” at all during prosecution?

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Mischaracterization of Results/Facts

- In the U.S., anyone involved in the patenting process, including inventors and attorneys, has an obligation to bring to the Patent Office's attention **information** that might affect the Examiner's decision to grant a patent.



Defendant will try to find evidence that tends to show such information was withheld.

General Principles of Inequitable Conduct

■ Inequitable conduct exists if patent *applicant*:

1. Failed to disclose material information;
2. Submitted false material information; or
3. Made affirmative misrepresentation of a material fact.

AND

Did so with
intent to deceive
the USPTO

******During prosecution***

Result: Entire Patent is Unenforceable

Consideration Of Examples

- Examples written in the past tense suggests the work was done
 - Find out before filing if the examples were actually performed
 - Scrutiny heightened if the examples are relied on during prosecution to establish patentability
- Check to see if examples as written accurately reflect the work that was actually done
- Check to see if inventor has any published statements that are inconsistent with the results in the examples

Lessons

■ Must ask questions!

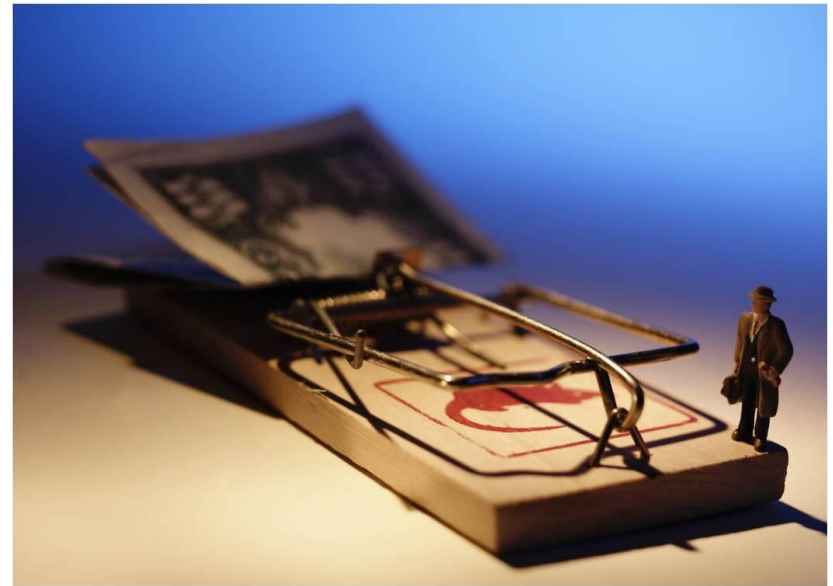
- Do the inventors have any articles or publications on the subject matter of the invention?
- Were all the experiments described in the specification actually performed?
- Are there experiments that were not included in the specification or Rule 132 Declarations?
- Are the comparative examples statistically significant
- Is there undisclosed or inconsistent data?

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Obviousness/Enablement Balance

- Patent practitioners can get carried away when presenting arguments against an obviousness rejection.
 - Fall into a trap of arguing how hard it would be to make the modification suggested by the Examiner.
 - Try to establish appropriate level of skill in the art that balances obviousness and enablement.



Questions?

Thank You!