



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

National Patent Drafting Course

**Bangkok, Thailand
January 22 to 25, 2019**

**Louis M. Troilo
U.S. Patent Attorney, FINNEGAN LLP**

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

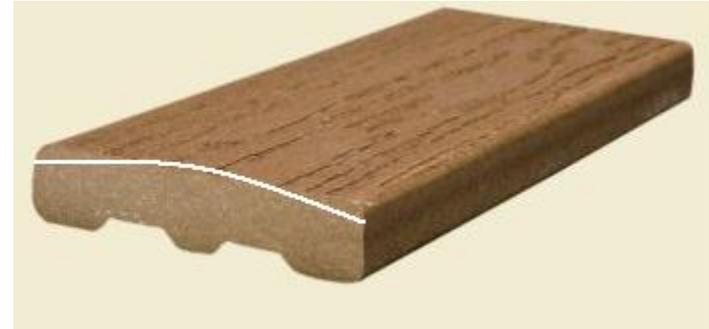
- The U.S. has a uniquely complex patent system
 - Statements made in the specification and prosecution history that would have no impact on claim scope in other jurisdictions, such as India, may narrow claim scope in the U.S.
- And U.S. case law makes drafting the specification **even more critical**.
 - “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...

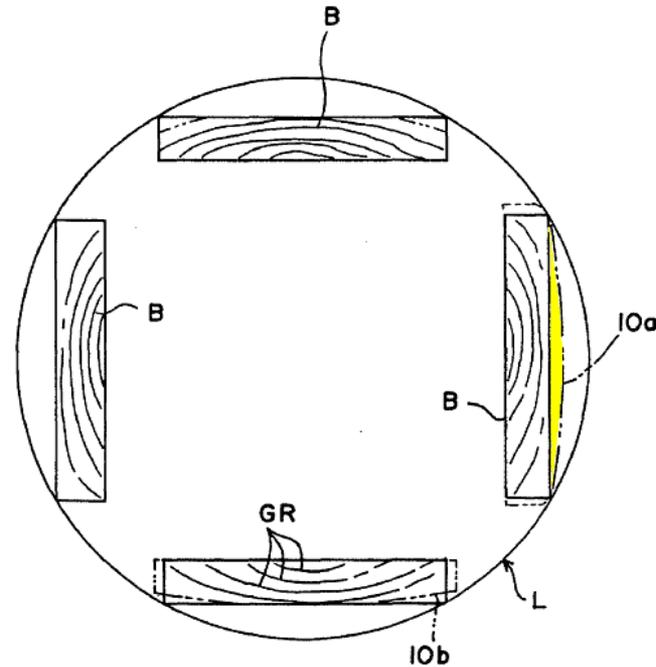


Case turned on whether a composite plastic/wood particle structure is a “board”.

Infringement? Yes or no?

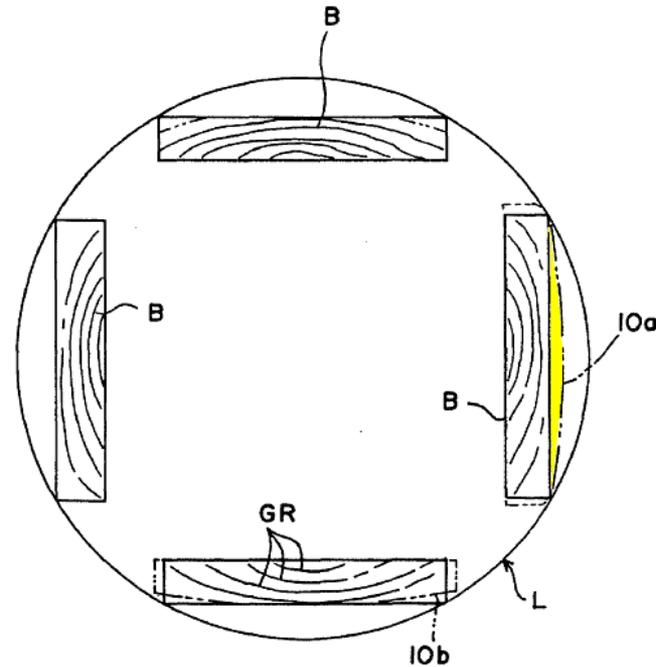
Depends On Definition Of Board

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



Depends On Definition Of Board

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

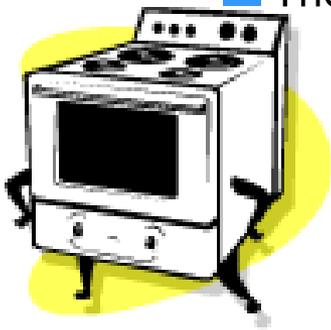


Not Infringed

“At” v. “To”

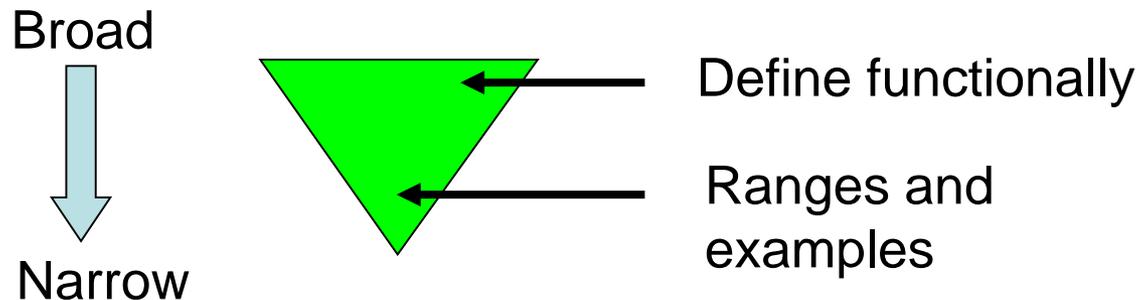
■ *Chef America, Inc. v. Lamb-Weston, Inc.*, (Fed. Cir. 2004)

- 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 (?)

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

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

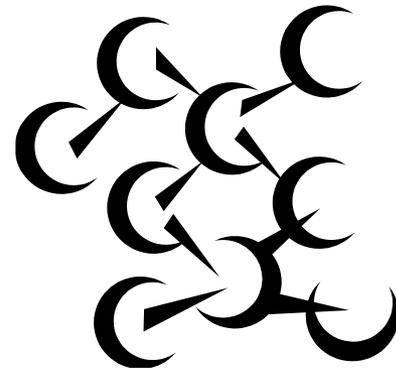
■ USPTO's KSR Guidelines – Rationales to Support Obviousness Rejections

- 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”



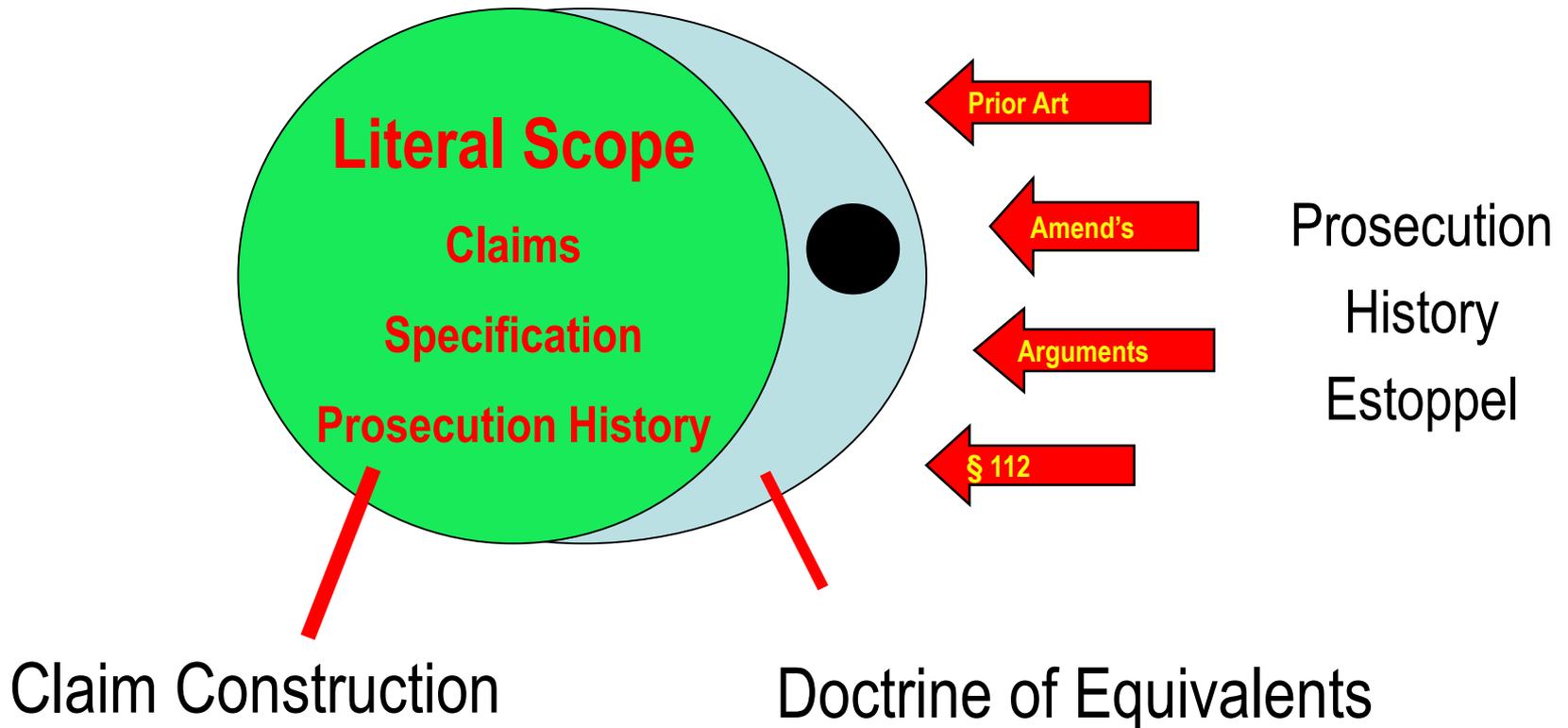
■ Mechanical/Electrical

- 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

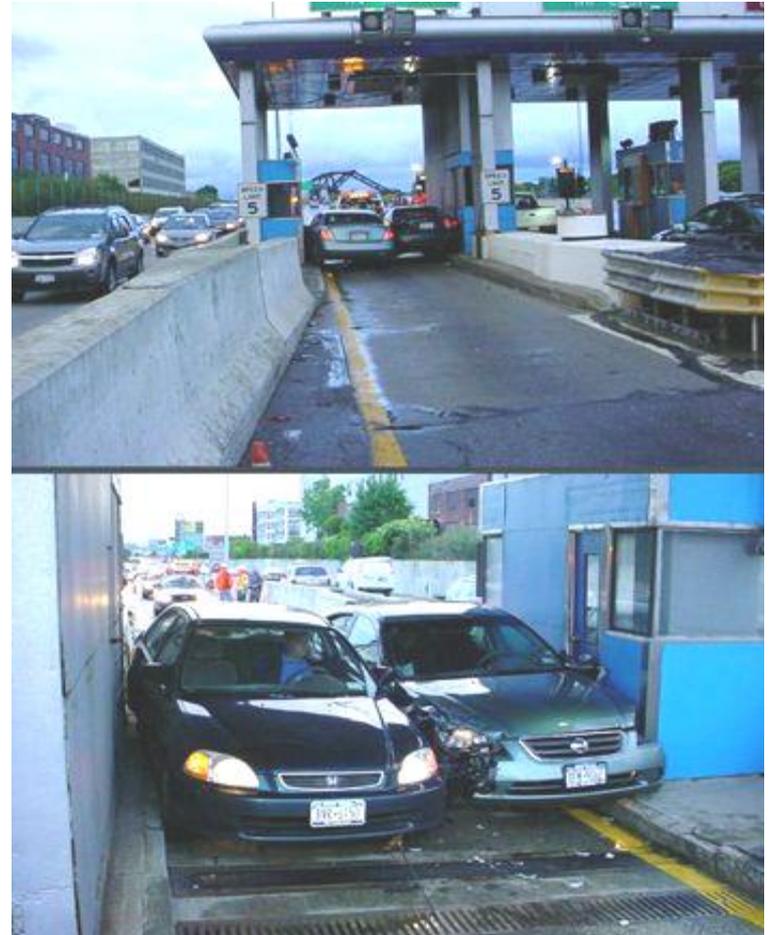
- In U.S., this can arise when determining claim scope or ability to rely on doctrine of equivalents.



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

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

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?

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

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!

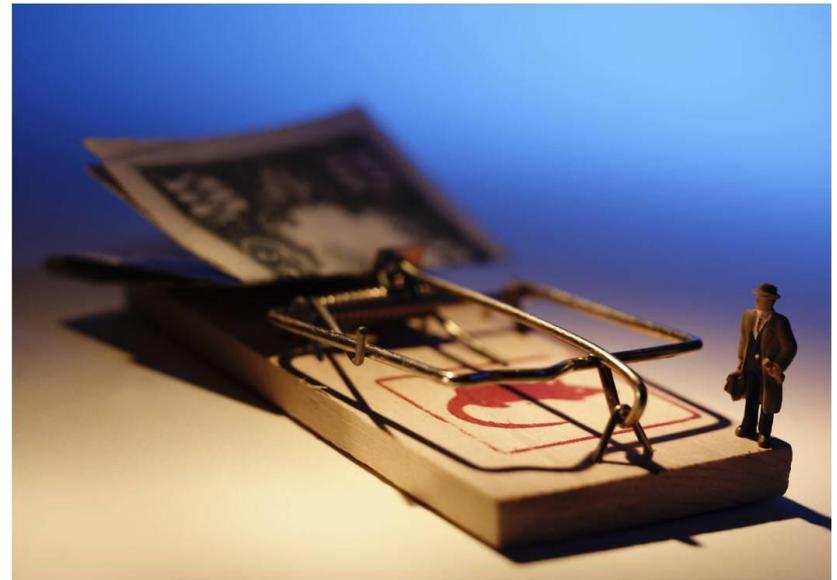
- Do the inventors have any articles or publications on the subject matter of the invention?
- Were all the experiments described in the specification actually performed?
- Are there experiments that were not included in the specification or Rule 132 Declarations?
- Are the comparative examples statistically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

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

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!