

This is your Release #10 (June 2020)

Faber on Mechanics of Patent Claim Drafting

Seventh Edition

by **Robert C. Faber**

(Ostrolenk Faber LLP, New York City)

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

Patent-eligible subject matter—computers: In *Data Engine Technologies LLC v. Google LLC*, the Federal Circuit found a claim for a specific method for navigating through a three-dimensional electronic spreadsheet not directed at an abstract idea, satisfying *Alice* step one and avoiding the need to determine eligibility via *Alice* step two. The method provides a specific solution to technological problems in computers and prior art electronic spreadsheets. Also, the product requires a specific interface and implementation for navigating the spreadsheets using techniques unique to computers. Specific steps for such navigation were also claimed. The foregoing made the claims patent-eligible. See § 1:4.2[A], at note 117.9.

Status indicators for claims: The release explains the meaning and use of the various status indicators for claims—“Currently Amended,” “Withdrawn,” “Allowed,” and others—that are applied to claims in the application as filed, published, examined, and issued. See new § 2:3.1.

“Consisting essentially of”: Claims using “consisting essentially of” for defining an open-ended list of ingredients are indefinite, if the basic and novel property (or properties) of the claim to the invention introduces an improper zone of uncertainty. In *HZNP Medicines LLC v. Actavis Laboratories UT, Inc.*, the Federal Circuit noted that the claim described a “better drying time” property. But no standard for that property was disclosed, rendering this basic and novel property indefinite, and the claim was therefore indefinite. See § 2:6, at note 131.2.

Patentee-defined terms: In the Federal Circuit’s *Plastic Omnium Advanced Innovation & Research v. Donghee America, Inc.*, the patentee was its own lexicographer for a “parison,” and that definition excluded the accused parison even though the alleged infringer’s product literature specifically described a parison. Based on the patentee’s lexicography, the scope of a claimed parison was narrowed, and the patentee’s definition of parison, construed by the court,

(continued on reverse)

Practising Law Institute
1177 Avenue of the Americas
New York, NY 10036
#290609

not the accused party's literature, controlled whether the accused product fell within the scope of patentee's claim. See § 3:7, at note 67.1.

Claims referring to industry standards: Claims often identify industry or government standards. A standard may be changed in some manner over time, but without changing the name, title, or identification of the standard. If the standard is in the claim, or is identified by its name, or is identified in the claim or the specification, the claim may be found to be indefinite. To avoid that possibility, additional information clearly defining the standard should appear in the specification and the claims. For example, expressly refer to the standard or protocol by an identifier and by its effective date, so that it is capable of being identified. See § 3:7, at note 83.1.

Disavowal: In *Techtronic Industries Co. v. ITC*, the Federal Circuit stated that where a patentee consistently describes an invention as including a particular feature, the claim must be considered as including that feature. In this case, involving garage door openers, the patentee moved an infrared detector from a head unit to a wall console. The assertion in the specification that described moving the detector to the wall console as the present invention was held by the Federal Circuit to disavow contrary embodiments also discussed. See § 3:9, at note 234.1.

Process claims—pharmaceuticals: The broad pharmaceutical claim discussed in *Idenix Pharmaceuticals LLC v. Gilead Sciences Inc.* covered a method of treatment using a nucleoside, and it covered perhaps millions of compounds. The Federal Circuit noted that the claim allowed for “nearly any imaginable substituent.” Despite a functional limitation that the nucleoside must be effective to treat hepatitis, that would not be known to one skilled in the art. The court held the claims nonenabled, due to the large numbers of compounds and the immense breadth of screening required; undue experimentation was required, although the synthesis and screening steps were routine. See § 4:7, at note 47.1.

Design claims—title of the invention: The M.P.E.P. states that the title of the invention in the specification, title, and claim “may contribute to defining the scope of a claim.” This is applicable also when the application was filed with one invention title, but the title was amended to a different name or description of the design, and even if the examiner proposed the change in the invention title after the application was filed. In *Curver Luxembourg, SARL v. Home Expressions Inc.*, the applicant filed for “Furniture (Part of—),” but the applicant amended the title at the examiner's request to “Pattern for Chair.” No chair was disclosed in the application as filed. According to the Federal Circuit, this title and claim limited patent scope to a chair and excluded the pattern as used on a basket. See § 5:4, at note 40.1.

Markush claims: In January 2020, in *Amgen Inc. v. Amneal Pharmaceuticals, LLC*, the Federal Circuit made a significant change to *Markush* claiming, overruling past decisions. The court held that a claim including “comprising” as a transition phrase followed by a limitation requiring a component that “consists of” items listed in a *Markush* group is open-ended, so that it does not exclude additional, unnamed items, unless there is intrinsic evidence manifesting an alternative meaning. Therefore, the *Markush* groupings drawing the transition word “comprising” are themselves open-ended and do not exclude additional unnamed claims. See § 6:2, at note 7.6.

In addition, this release updates the **Table of Authorities** and the **Index**.

Thank you for purchasing *Faber on Mechanics of Patent Claim Drafting*. If you have questions about this product, or would like information on our other products, please contact customer service at info@pli.edu or at (800) 260-4PLI.

FILING INSTRUCTIONS

Faber on Mechanics of Patent Claim Drafting

**Release #10
(June 2020)**

**REMOVE OLD PAGES
NUMBERED:**

- Title page to 6-41
- T-1 to I-25

**INSERT NEW PAGES
NUMBERED:**

- Title page to 6-42
- T-1 to I-25

Practising Law Institute
1177 Avenue of the Americas
New York, NY 10036
#290609

