This is your Release #4 (June 2017)

Faber on Mechanics of Patent Claim Drafting

Seventh Edition

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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 eligibility—computer-related claims: Several recent Federal Circuit opinions emphasize that patent claims directed to data processing or pure software can be patent-eligible. Software modifications that improve functioning or capacity of a known system are generally patent-eligible. This applies to improvements in computer functionality or solving technology-based problems, even with conventional generic components when combined in an unconventional manner. It is recommended to disclose and discuss the practical benefits of the claim in the specification. The differences from the art, the technological improvement, and the reasons for this may convert what appears to be known technology into something patent-eligible. See § 1:5.5, at note 88.3.

Preamble: The Delaware federal district court observes that the preamble defines the field of the invention claimed, or a purpose or intended result of an invention, and it is then not treated as a claim limitation or as limiting claim scope (*Takeda Pharmaceutical Co. v. Actavis Laboratories FL, Inc.*). See § 2:4, at note 12.1.

Dependent claims: As the Federal Circuit has noted, a dependent claim may never be broader in scope than a prior claim, whether that prior claim is independent or dependent (*Intendis GmbH v. Glenmark Pharmacueticals Inc*.). See § 2:9, at note 153.1.

"Around": That "around" has multiple dictionary definitions does not mean that all the meanings are reasonable in light of the specification, according to the Federal Circuit in *PPC Broadband, Inc. v. Corning Optical Communications RF, LLC*. See § 3:8, at note 124.1.

(continued on reverse)

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Disclaimers: According to recent Federal Circuit cases, absence of a "clear and unambiguous" surrender of claim scope, considered in the context of the prosecution history, prevents a disavowal. Statements that are "ambiguous or amenable to multiple reasonable interpretations" are not prosecution disclaimers. See § 3:9, at note 174.4.

"Visually negligible": Words of approximation are not restricted to words like "about," "approximately," and "substantially." The Federal Circuit held that "visually negligible" was definite because the specification provided examples of visually negligible indicators, namely an objective baseline to determine what is visually negligible based on what can be seen by the normal human eye, and neither the examiners nor the experts during prosecution and reexamination had apparent difficulty determining the scope of this term (*Sonix Technology Co. v. Publications International, Ltd.*). See § 3:19, at note 389.1.

Functional expressions: Patent Office examiners are objecting to "adapted to" as an introduction to a functional recital. But the Federal Circuit has accepted "adapted to" as meaning "made to" or "configured to" rather than "suitable for" or "capable of." It is not what the claim element might be caused to do, it is what the element actually does, what it was designed for and intended to do, that may be claimed. See § 3:24, at note 428.1.

Reissue patent claims: A reissue claim cannot redefine the scope of an original patent claim, as illustrated in the Federal Circuit's *ArcelorMittal France v. AK Steel Corp*. See § 5:3, at note 30.2.

Claims in continuing applications—claim construction: According to the Federal Circuit, where more than one patent derives from, that is claims priority to, a common parent, construction of the same claim in two or more of those patents should be the same, since they are all based off the same disclosure and specification (*Trustees of Columbia University v. Symantic Corp.*). See § 5:5, at note 43.1.

"Therapeutically effective": According to the federal district court in Delaware, claim terms referring to a composition as "therapeutically effective" are not indefinite in a claim because they accomplish some specific therapeutic result. Examples include "therapeutically effective concentration," "therapeutically effective amount," "therapeutically effective blood levels," and "therapeutic effect" (*Acorda Therapeutics v. Aiken Laboratories Ltd.*). See § 9:12, at note 134.1.

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

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