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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—diagnostic methods: In *Athena Diagnostics, Inc. v. Mayo Collaborative Services LLC*, Athena used the patented method to diagnose neurotransmission or development disorders. A man-made, not naturally occurring, protein was put into bodily fluid and filtered to detect antibodies. The claim focused on an interaction of the antibody with the bodily fluid, which is naturally occurring. According to the federal district court, the focus on the natural occurrence made the claims ineligible for patent; the patent claimed a process for detecting antibodies, not a process for creating them. The author suggests some general strategies to avoid this kind of result. See § 1:4.1, at note 32.6.

Patent eligibility—digital image processing: In two Federal Circuit cases, claims involving digital images were found to be patent-ineligible. Discussed are *RecogniCorp, LLC v. Nintendo Co.*, involving a method for facial image transmission by customizing composite image features, and *Digitech Image Technologies, LLC v. Electronics for Imaging, Inc.*, where the court indicated the claims were merely starting with data, adding an algorithm, and ending with revised data, that is, adding one abstract idea to another. However, the court in *RecogniCorp* suggested that a “particularized application of encoding and decoding image data” might be patent-eligible. See § 1:5.5, at note 88.16.

Markush groups: To avoid an issue as to whether a recited element in a *Markush* group is actually part of the group, do not include that element in the group of elements introduced by the transition “consisting of.” List it separately or not at all in the claim. The presumption of inclusion in the *Markush* group may be overcome by showing that an element

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listed in the *Markush* group is unrelated to the invention. Because the presence of any one member of a *Markush* group in the prior art will make that entire group prior art, you do not want elements unrelated to the invention as a whole or to the group to be listed in the group. See § 2:6, at page 2-24.

Equivalents: In *Mylan Institutional LLC v. Aurobindo Pharma Ltd.*, the Federal Circuit noted that court precedents on equivalents were “sparse and confusing.” Citing Supreme Court authority, the court observed that “non-mechanical eases may not be well-suited to consideration under the [function-way-result] test.” The Federal Circuit reversed the district court because it had found the same “function,” oxidation, but did not consider the “way” oxidation was performed. Findings on all three aspects are needed for this test for equivalency. See § 2:13, at note 189.2.

Disclosure-dedication rule: An applicant may argue for a narrow interpretation of a claim element to avoid prior art, but, after patent grant, argue for a broad interpretation of the same claim language to encompass more potentially infringing products, methods, etc., at that point relying on the broader disclosure of the specification, possibly using the doctrine of equivalents. But the original claims dedicate the embodiments not claimed originally. See § 2:13, at note 195.1; see also Appendix D, Glossary and Index of Patent Terms, “Disclosure-dedication rule.”

Words of approximation: Avoiding indefiniteness continues to be a challenge for claim drafters. The author suggests that it is better to either not use an approximation word or else define its limits or other relevant parameters or characteristics as used in the claim with an explanation in the claim itself, the specification, the prosecution history (intrinsic record), or publications relevant to the subject of the claim element (extrinsic record). Examples from several cases, all decided in the Eastern District of Texas, illustrate some of the drafting issues. See § 3:19, at note 365.1.

Means-plus-function limitations: The broadest reasonable interpretation of a means-plus-function limitation is determined by the structure in the specification that is described there as performing the function recited in the means-plus-function limitation. The Federal Circuit found noninfringement because a construction that introduced new functionality was not explicitly recited in the means-plus-function claim limitation (*Core Wireless Licensing S.a.r.l. v. Apple Inc.*). See § 3:29.4, at note 517.1.

Composition of matter claims—*Markush* expressions: The Federal Circuit notes that if a *Markush* clause in a claim begins “selected from the group consisting of;” or “selected from the group composed of;” or another closed-ended phrase, the *Markush* claim is treated in its interpretation like any closed-ended term, limiting its scope to cover only the recited members of the claimed group of elements (*Shire Development, LLC v. Watson Pharm., Inc.*). See § 6:2, at note 7.3.

In addition, this release updates **Appendix D (Glossary and Index of Patent Terms)**, the **Table of Authorities**, and the **Index**.

FILING INSTRUCTIONS

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REMOVE OLD PAGES NUMBERED:

- Title page to 3-179
- 6-1 to 6-40
- 10-1 to 10-55
- App. C1-1 to App. C2-15
- App. D-1 to I-25

INSERT NEW PAGES NUMBERED:

- Title page to 3-182
- 6-1 to 6-40
- 10-1 to 10-55
- App. C1-1 to App. C2-15
- App. D-1 to I-25

