# Faber on Mechanics of Patent Claim Drafting
## *Sixth 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:

**Subject matter eligibility—laws of nature, etc.:** The Supreme Court's much-anticipated decision in *Alice Corp. Pty. Ltd. v. CLS Bank International* considered a patent directed to a computerized trading platform whereby the risk of nonsettlement of the parties' obligations is eliminated by using a trusted third party to settle the obligations. The Court held that abstract ideas implemented in a method claim by a general-purpose computer or recited in a system in a nonmethod claim and which claimed conventional components and/or operation of a general-purpose computer are ineligible for patent protection and are nonstatutory under section 101 of the Patent Act. The author discusses the Court's reasoning, offers his views as to the implications of the decision for computer-implemented inventions, and takes note of two relevant post-*Alice* decisions in the Federal Circuit. See § 1:4, at note 28.2.

**Infringement of method claims**: Where performance of the steps in a method claim is divided among a number of unrelated entities, questions have arisen as to the conditions under which such claims may be infringed. In *Limelight Networks, Inc. v. Akamai Techs., Inc.*, the Supreme Court indicated that infringement of such claims requires either that one party perform all the steps, or that one party control all the entities that separately perform the steps. See § 2:4, at note 44.3.

**Dependent claims:** As illustrated in *Albecker v. Contour Products, Inc.*, an independent claim, or more generally, a parent claim, may not be inconsistent with a dependent claim. At least one of them is invalid. See § 2:9, at note 101.1.

**Definiteness—a new standard:** Section 112(b) of the patent statute requires that the specification conclude with one or more claims "particularly pointing out

and distinctly claiming the subject matter which the inventor or joint inventor regards as the invention." Until June 2014, the Federal Circuit had defined a threshold of definiteness such that the claim would satisfy the statute if it was "amenable to construction" and not "insolubly ambiguous." In *Nautilus, Inc. v. Biosig Instruments, Inc.*, the Supreme Court held that the Federal Circuit standard of definiteness was insufficient to satisfy section 112. The Court replaced the previous standard with a "reasonable certainty" standard. See new § 2:14.

**Plain meaning of claim terms:** In *Hill-Rom Services, Inc. v. Stryker Corp.*, the Federal Circuit said: "We depart from the plain and ordinary meaning of claim terms based on the specification in only two instances, lexicography and disavowal." See § 3:8, at note 60.3.

**Words of approximation:** Patent Office examiners have recently routinely rejected use of any size or comparative word as not defined in any claim, if the specification does not define that size or comparative word. Often the specification does not specify limits of or parameters for determining such a term. The fact that the word is used in common language to "soften" a precise limit is ignored. The author recommends not using words without definite limits in a claim, unless the criteria for their scope are stated in the specification. See § 3:19, at page 3-82.

**Numerical ranges:** According to the Federal Circuit, while overlap of at least part of a range in a claim over a range of the same feature in the prior art is enough to make the later claim obvious, closeness of ranges that is less than an overlap may not be obvious (*In re Patel*). See § 3:20, at note 272.4.

**"Means" language and its absence:** The Federal Circuit has provided a further rationale for the "reverse presumption" that use of another word than "means" does not always avoid section 112(f). In *Robert Bosch LLC v. Snap-On, Inc.*, the words "means for" were not used. Instead, "program recognition device" and "program loading device" were used. "Device" was construed as being under the statute. The specification did not disclose sufficiently definite structure. The issue is whether the claim names particular structures or only a general category of what performs the function. If the claim only defines the function, it is like a means-plus-function element. Merely listing examples of possible structures is insufficient. Supporting structure in the claim itself or in the specification is required. See § 3:29.8, at note 404.4.

**Method claims—order of the steps:** In *MFormation Techs, Inc. v. Research in Motion Ltd.*, the Federal Circuit notes that the order of the steps is required "when the claim language, as a matter of logic or grammar, requires that the steps be performed in the order written, or the specification directly or implicitly requires" that order. See § 4:3, at note 13.1. If grammar, logic, specification, or prosecution history require sequential performance of the steps, then the claims will be so construed and limited (*Apple, Inc. v. Motorola, Inc.*). See § 4:3, note 18.1.

In addition, this release updates **Appendix C1** (selected sections of the patent statute), **Appendix C2** (selected sections of the rules of practice), **Appendix C3** (selected sections of the MPEP), and the **Index.**

# FILING INSTRUCTIONS

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### (November 2014)

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