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Drafting Tips

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Key Lessons from Patent Litigation for Drafting and Prosecuting Utility Patent Applications

In almost every US patent suit, the patentee's counsel considers how the case could have been facilitated had the patent at issue been drafted and prosecuted differently. These considerations demonstrate that patents should be drafted and prosecuted with an eye toward the possibility of litigation. There have been several landmark decisions in patent cases that directly impact patent prosecution. This publication analyzes some of those decisions in chronological order to provide suggestions for a patent prosecutor in drafting or prosecuting a patent application.

"Invention" Should Be Cautiously Used in the Description Section of the Specification and During Prosecution

The implementation protected by a patent is set forth in the claims. Prosecutors have traditionally used the term "invention" in the specification and during prosecution to highlight aspects of the claimed implementation. In 2007, the Federal Circuit, however, noted in *Verizon v. Vonage* [503 F.3d 1295 (Fed. Cir. 2007)], that "[w]hen a patent...describes the features of the present invention as a whole, this description limits the scope of the invention" [*Id.* at 1309].

As the scope of the patent is well understood to be defined by the

claims, this Federal Circuit ruling indicates that the use of the term "invention," even when used in the specification or during prosecution, can narrow the scope of the claims. To avoid the issue of whether each disclosed "invention" limits the claims during a possible infringement suit, prosecutors typically should avoid use of the term "invention" throughout drafting and prosecution.

Path of Attaining an End Result Should Be Described in the Specification

Subsequently, in 2010, the Federal Circuit ruled in *Ariad v. Lilly* [598 F.3d 1336 (Fed. Cir. 2010)], that: (a) 35 U.S.C. § 112 requires the written description requirement in that section to be separate from the enablement requirement therein [*Id.* at 1344], and (b) the description in the patent application satisfies the written description requirement when "the disclosure of the application relied upon reasonably conveys to those skilled in the art that the inventor had possession of the claimed subject matter as of the filing date" [*Id.* at 1351]. The Court indicated that a patent that merely describes a desired outcome instead of showing to a skilled artisan how that outcome can be achieved does not satisfy the written description requirement [*Id.* at 1357].

This decision highlights the importance of presenting in the application the path taken to reach an outcome instead of merely presenting the outcome. While drafting applications in the biotechnology arena, prosecutors may benefit by not only mentioning, for example, molecules capable

of performing a functionality but also supporting those claims in the specification with examples, which can be working or "prophetic" [*Id.* at 1357], of performing that functionality or supporting those claims with a description of how the claimed molecules are synthesized to perform the functionality. This holding is extendible to other areas as well. For instance, in drafting applications in the software space, prosecutors should consider not only mentioning, for example, a black-box computer configured to achieve an end result, as approved in some traditional patents, but additionally specifying how that black-box functions to attain the end result.

Claimed Invention Should Be Sufficiently Described in the Application to Teach a Layman How to Reproduce That Invention

On June 2, 2014, the US Supreme Court held in *Nautilus v. Biosig* [134 S. Ct. 2120 (2014)] that "a patent is invalid for indefiniteness if its claims, read in light of the specification delineating the patent, and the prosecution history, fail to inform, with reasonable certainty, those skilled in the art about the scope of the invention" [*Id.* at 2123]. The Court also indicated that "a patent must be precise enough to afford clear notice of what is claimed, thereby 'appris[ing] the public of what is still open to them.'" [*Id.* at 2129 (citing *Markman v. Westview Instruments*, 517 U. S. at 373 (1996) (quoting *McClain v. Ortmyer*, 141 U.S. at 419, 424 (1891))]. This is the evenhanded result because a patent provides a patentee with monopoly over a claimed territory; this monopoly is a property right; and "like any property right, its boundaries should be clear." [*Id.* at 2124 (quoting *Festo Corp. v. Shoketsu Kinzoku*

Kogyo Kabushiki Co., 535 U.S. at 722, 730 (2002)].

In light of this ruling, prosecutors should describe the claimed invention in sufficient detail in the specification to teach a layman how to reproduce the claimed invention. For example, in an application directed to an engine, prosecutors should consider disclosing all aspects of the engine, including those well understood by a skilled artisan. Even though the legal test for indefiniteness does not require that a layman be able to reproduce the invention—the test only requires that one of ordinary skill in the art can reproduce it—having this layman constraint is favorable because enabling a layman to reproduce the invention ensures that a skilled artisan can reproduce it as well. This can prevent a party trying to invalidate the patent from successfully asserting that a skilled artisan has a low level of skill and thus cannot reproduce the claimed invention.

Business Methods Performed by Computing Systems Should Be Described with a Detailed Level of Computational Granularity

Subsequently, on June 19, 2014, the US Supreme Court ruled in *Alice v. CLS Bank* [134 S. Ct. 2347 (2014)] that a claim is invalid when it is: (1) directed to patent-ineligible subject matter such as a law of nature, a natural phenomenon, or an abstract idea; and (2) fails to recite something significantly more that can transform the patent-ineligible concept to a patent-eligible concept [*Id.* at 2355]. Notably, the Court stated that a “mere recitation of a generic computer cannot transform a patent-ineligible abstract idea into a patent-eligible invention” [*Id.* at 2358].

The disputed patent in *Alice* was directed to intermediated settlement,

which the Court deemed as abstract for being “a fundamental economic practice.” [*Id.* at 2356 (quoting *Bilski v. Kappos*, 561 U.S. 593 (2010)).] This ruling has perplexed many, because: (a) although the Court considered fundamental economic practice to be an abstract concept, the Court did not provide an exhaustive list of all areas that should be deemed abstract; and (b) the Court did not provide clear details on what should be considered “significantly more.” To address these two issues, the US Patent and Trademark Office (PTO) published several examination guidance and training documents with examples of abstract concepts, non-abstract concepts, and limitations that qualify as “significantly more” [See documents currently listed under “Examination Guidance and Training Materials” at <http://www.uspto.gov/patent/laws-and-regulations/examination-policy/examination-guidance-and-training-materials>]. Despite the PTO’s efforts, in many instances PTO examiners and applicants still disagree as to whether pending claims satisfy the above-referred limitations.

To avoid such disagreements, prosecutors drafting applications directed to business methods can benefit by presenting implementations with a detailed level of computational granularity. The prosecutors can elucidate on, for example, structural details of computational architecture, architectural components involved, distinct manners in which those components function, and how and why those components perform in the distinct manners. These details can enable the prosecutor to argue that these details describe improvements to the functioning of the computer (which is one of the limitations qualifying the subject matter as “significantly more”), thereby rendering the claimed concept as “significantly more” and thus patent-eligible even if the claim is assumed by the PTO examiner to be abstract.

Claims Should Be Drafted from the Perspective of a Single Actor (e.g., a Computing Server) Rather Than Multiple Actors (e.g., a Computing Server and a Third Party)

In August 2015, the Federal Circuit ruled in *Akamai v. Limelight* [797 F.3d 1020 (Fed. Cir. 2015)] that an alleged infringer may infringe even when a step recited in the claim is employed by a third party, such as a customer of the alleged infringer. This ruling was a reversal of the Court’s previous decision [*Akamai Techs., Inc. v. Limelight Networks, Inc.*, 786 F.3d 899 (Fed. Cir. 2015)] where the Court had found that the alleged infringer did not infringe when one step of the claim was performed by the customer. The Court reversed its judgment because evidence showed that “[the alleged infringer]’s customers do not merely take [the alleged infringer]’s guidance and act independently on their own. Rather, [the alleged infringer] establishes the manner and timing of its customers’ performance so that customers can only avail themselves of the service upon their performance of the method steps” [*Akamai*, 797 F.3d at 1025 (Fed. Cir. 2015)].

A patent may therefore be infringed by an alleged infringer even where a third party associated with that alleged infringer performs some claimed steps, but only when the third party is under the alleged infringer’s guidance. A prosecutor accordingly should not include in the claims a step performed by a party not under the patentee’s guidance. A more risk-averse prosecution strategy is to present each claim from the perspective of a single actor characterizing the tangible element (for example, a processor) intended to be protected by the patentee, thereby eliminating the concern of whether the party performing a claimed step is under the patentee’s guidance.

Conclusion

The suggestions above can help a prosecutor draft and prosecute applications that, once patented, are strong enforcement weapons and, at the same time, present a reduced risk of being successfully challenged for invalidity.

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