



Patent Claims

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Ice Breaker

- What is the pictured invention?
- Problem Statement: In apartments, children and babies do not sufficient access to fresh air.

Mar. 13, 1923.

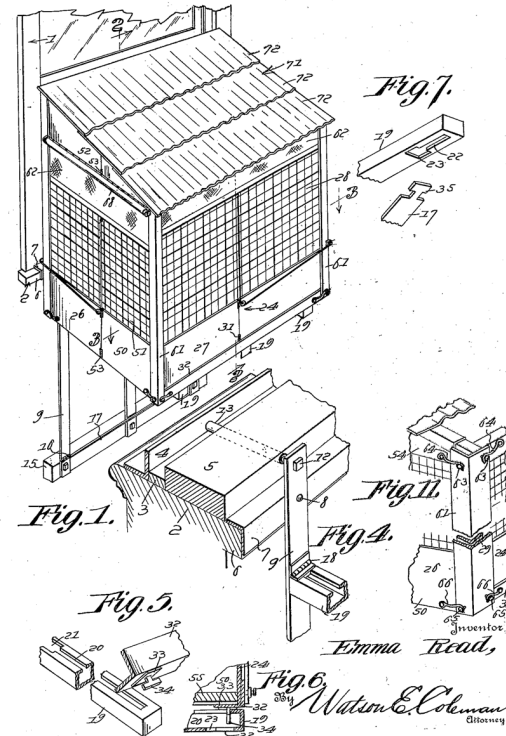
E. READ

1,448,235

PORTABLE BABY CAGE

Filed July 19, 1922

2 sheets-sheet 1



Ice Breaker- Continued

- That's right... A baby cage for apartment windows.
- The cages became popular in London in the 1930s among apartment dwellers without access to backyards.



Shared Problem Solving

- Fun Strategy Tidbits?
- Any problems you are encountering with the USPTO?
- Any practice issues arising?
- Any technical issues you are facing?

Claim Strategies – Overview

- **What Are Claims?**
- **How to Claim**
- **Claim Transitions**
- **Claim Strategy**
- **Infringers/Infringement**
- **Example Case Studies**
- **Takeaway**

Claims

“The name of the game is the claim.” Giles Rich (Chief Judge of the Federal Circuit 1982-1999)

- **Claims are often referred to as the metes and bounds of a patent**
- **Claims define the subject-matter that is protected by the patent or sought to be protected by the patent application**

What Can be Claimed? (Utility)

- **Machine**
 - Example: A new and useful paving machine
- **Process**
 - Example: A new and useful method of paving
 - Method of Treatment
- **Article of Manufacture**
 - Example: A new and useful shovel for paving
- **Composition of Matter**
 - Example: A new and useful pavement composition
- **OR any new and useful improvement thereof**

Claim Transitions

- **Comprising**
 - Most common
 - Can be combined with any element known in the art and motivation for a prima facie case to combine
- **Consisting of**
 - Limited to only elements recited
 - Infers that the invention is only as described
 - May be chemical, pharmaceutical, biotech, or in art that is unpredictable
- **Consisting essentially of**
 - Intermediate between comprising and consisting of
 - May include elements which do not materially affect the invention

Method of Treatment Claims

- Typically take the form of: A method of treating [medical condition X] which comprises administering to a subject an effective amount of [compound Y]
- Can be patentable in USA, Australia, and Russia
- Many countries, including, Canada, China, Israel, Japan, South Korea and Taiwan do not allow the patenting of method of treatment

How to claim?

- Clear: shouldn't allow for speculation
- Supported: should be supported in the description and drawings
- Complete: should cover the invention adequately
- **AND don't forget that you are trying to capture the idea.... Not the design!!!**

How to claim? (continued)

- Independent claims
 - Standalone
 - Includes the minimum limitations for the invention
- Dependent claims
 - Adds limitation(s) to the independent and any previous dependent claim
 - May define alternative embodiments
 - Add non-essential limitations
 - Adds breadth to the independent claim

Claim Strategies

- What is the invention?
- What is the prior art?
- What is the company? Selling a product, a service, product and a service, and/or attempting to monetize the patent?
- Who are the competitors?
- Who is the infringer?

35 USC 271(a)- Except as otherwise provided in this title, whoever without authority makes, uses, offers to sell, or sells any patented invention, within the United States or imports into the United States any patented invention during the term of the patent therefor, infringes the patent.

Infringers

- Who might be the infringer? Where are they?
- Can you identify them? Can you spot the infringement?
- Is the infringement direct or indirect?
- How do we make sure the infringement is done by one entity?

Divided Infringement

- Divided infringement occurs when more than one actor collectively performs all the steps of a method claim, or use disparate elements of a system claim such that no one party directly infringes a patent under § 271(a).
- A recent Federal circuit ruling established a more expansive test for divided infringement: divided infringement has not occurred (1) where the first party directs or controls the actions of the other party; and (2) where the first party and the other party form a joint enterprise (a principal-agent relationship, a contract, etc.).

Divided Infringement: Example

- **Tropp v. Travel Sentry, Inc**
- **A method of improving airline luggage inspection by a luggage screening entity, comprising: (1) providing a luggage lock with an identifier that can be unlocked by a master key, (2) marketing the lock to emphasize that it is subject to a special screening procedure, (3) the identifier signaling to a luggage screener that the lock can be opened with the master key, and (4) the luggage screener using the master key to open the luggage**

Infringement case part 1/5

- Syngenta Crop Prot., LLC (SCP) v. Willowood, LLC (WW)
- SCP asserted four patents directed to a fungicide compound and its manufacturing process

Infringement case part 2/5

- Syngenta asserted four patents to which it is assignee
- '076 and '256 patent-
 - Composition patent for compounds including azoxystrobin
- '138 patent-
 - Method patent
 - Two step process-
 - An etherification step to form an intermediate compound then used in a condensation step to produce azoxystrobin
- '761 patent-
 - Method patent
 - Processes for the preparation of Azoxystrobin using DABCO [diazabicyclooctane] as a Catalyst and Novel Intermediate Used in the Process
 - Requires at least “the presence of between 0.1 and 2 mol% of DABCO”

Infringement case part 3/5

- '076 and '256 patent-
 - Composition patent for compounds including azoxystrobin
 - Found to be directly and inducedly infringed by WW USA but not by WW China

Infringement case part 4/5

- '138 patent-
 - Method patent
 - Two step process-
 - An etherification step to form an intermediate compound then used in a condensation step to produce azoxystrobin
 - Were not found to be infringed due to divided infringement... but was later reversed by the Federal Circuit, directly citing 35 USC 271(g)

Infringement case part 5/5

- **'761 patent-**
 - **Method patent**
 - **Processes for the preparation of Azoxystrobin using DABCO [diazabicyclooctane] as a Catalyst and Novel Intermediate Used in the Process**
 - **Requires at least “the presence of between 0.1 and 2 mol% of DABCO”**
 - **Was found to be infringed**

Takeaway as a Practitioner

- As a practitioner, claim drafting is paramount and is one of the first steps of drafting an application.
 - Ensures that the practitioner and the client are on the same page with what is being invented
 - Allows the practitioner an opportunity to brainstorm strategy with the client
 - Ensures that appropriate support will be formed by the specification and the figures

Summary Quote

- "Ninety percent of the mental exercise in drafting patents is in the strategy of looking around corners, anticipating the future, and trying to capture as many would-be infringers as possible."
- - David Coen

Questions/Discussion

