Published on *The National Law Review* https://natlawreview.com

Well-Drafted Patent Claims Foreclose Competition

Article By:

Intellectual Property at Much

In today's technology-driven economy, patents are vital to creating and maintaining competitive advantage and strategic market presence. They can contribute significant capital to a company, increase market share, foreclose competition, provide income streams and create business opportunities. Yet the scope of a patent is defined by its patent claims, and obtaining meaningful patent claim coverage involves many complexities appropriate for the guidance of competent patent counsel. Ultimately, the value of a patent hinges upon well-drafted patent claims that will foreclose competition in the subject matter they define.

The Substance and Purpose of Patent Claims

A patent grants its owner a territorial right to exclude others from making, selling, using or importing the subject matter of the patent—as defined in its patent claims—for a limited term, usually 20 years from an application's filing date. To be clear, a patent does not give its owner any right to actually make, use, sell or import an invention embodying the subject matter of the patent; it provides only a negative right to exclude others from doing so. However, the exclusivity and market power afforded by a patent only extend to the scope of its issued patent claims.

A patent may have as many claims as is justified by novelty, utility, non-obviousness and specific description over the **"prior art" (the prior state of technology)**. Each claim defines the scope and boundaries of the patented invention for licensing, design-around and infringement purposes—analogous to the way the legal description of a plot of land determines what constitutes trespassing. Each patent claim serves as a legal notice of the scope of the patent owner's right and what others must refrain from doing.

The purpose of a patent claim is not to explain the technology or how it works, but to state the legal boundaries of the patent grant. Patent claims must be carefully drafted and prosecuted because they lay the groundwork for future success in patent litigation and silent victories in the ancillary areas of licensing, exploitation and preventing design-around competition.

A successful set of patent claims must account for what is necessary or essential in each claim, what is arbitrary or optional to each claim, what is covered by each claim, what and who are foreclosed by each claim, and what others might do to avoid each claim. They should also address several audiences that are keenly interested in the claims, including the patent examiner, persons of skill in

the art, opposing patent counsel, judges, jurors, licensees, design-around competitors, intellectual property asset managers, investors, and others with a present or future need to examine the patent and the scope of its proprietary right established by the defined claims.

Language Is Key

Well-drafted patent claims require an outstanding command of language to ensure that all words are carefully measured for scope, both singularly and collectively. This comprehensive vocabulary, often informed by prior art patents, must be extremely sensitive to scope, shade and accurate recognition of meaning. For example, differing uses of nouns will affect the meaning of patent claim "elements," and the selection of differing adjectives will alter the limitations upon those "elements." Terms of structure, function, relation, location, content, shape, properties, range, degree, etc., all must be measured for their connotations and implications both as individual words and in their combined claim context.

An experienced patent attorney uses this command of language to establish dual boundaries: (1) the demarcation between the prior art and the inventive point at which the patent applicant's invention begins, and (2) the outer limit of the invention as defined by the patent claim. Such lines cannot be haphazardly drawn. Wording of sufficiently broad scope must be used in the main "independent" patent claim so that it is, at least, commensurate with the essential elements of the applicant's invention that are new and different—departing from the previous—and giving rise to benefit, advantage or superiority. Preferably, such wording will also encompass foreseeable or potential design developments or modifications to such critical elements that seek to capture the benefit, advantage or superiority they yield.

Proving Infringement

Well-drafted patent claims eliminate and minimize obstacles to proving patent infringement long before a court case is filed. A determination of patent infringement involves two steps.

First, the court determines the scope and meaning of the asserted patent claims in what is known as a **"Markman hearing."** This procedure is normally conducted under the local rules of a specific federal district court and in accordance with established legal requirements for **"claim construction."**

Second, the court compares the properly construed claims of the patent owner to the allegedly infringing subject matter to determine whether all of the limitations of a patent claim are present, either literally or by a substantial equivalent. To prove infringement, a patent's owner must show that the accused product, system or process embodiesevery limitation of any patent claim, either literally or equivalently.

Literal infringement requires that every limitation set forth in the language of a patent claim be found in the accused product—exactly. In patent lingo, that means the entire claim "literally reads upon" and "finds exact element correspondence in" the accused product, system or process.

However, even if the alleged infringing subject matter does not satisfy every literal limitation in a plaintiff's patent claim, a defendant may be liable under what is known as the "doctrine of equivalents." A finding of infringement under this doctrine requires proof that there are insubstantial differences between the accused product and the patent claim limitations, assessed according to an

objective standard on an element-by-element basis. Does the accused substitute element match the function, way and result of the patent claim element that is missing under the literal infringement analysis? Would the differences between the two be considered "insubstantial" to one of ordinary skill in the art?

Rather than getting embroiled in the intricacy of litigated claim construction or doctrine-of-equivalents analysis, well-drafted patent claims strive to define the invention so as to literally "read upon" foreseeable infringing activity. Careful claim drafting draws the legal boundary of the patent in a manner that will support the scope of the patent owner's claimed rights and strategic market power while serving as public notice of the infringing actions from which others must refrain.

A comprehensive knowledge of the myriad aspects of intellectual property law, combined with skill sets cultivated over many years of education and experience, places patent attorneys in a unique position to render valuable service to clients. Well-drafted patent claims are the crown of their art.

National Law Review, Volume I, Number 221