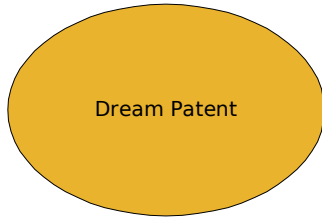
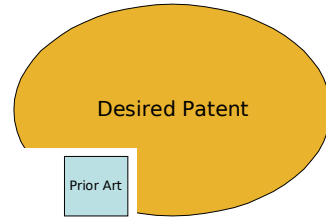


Tensions in Patent Drafting



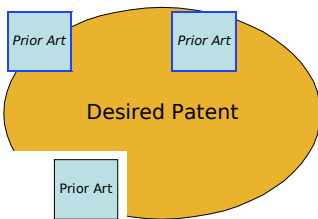
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Excluding known prior art



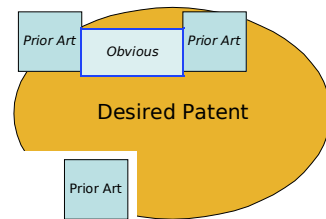
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Amendments during prosecution § 102 anticipation



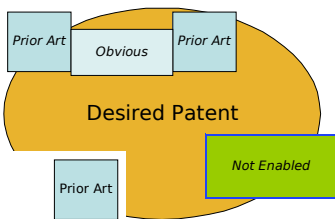
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Amendments during prosecution § 103 obviousness



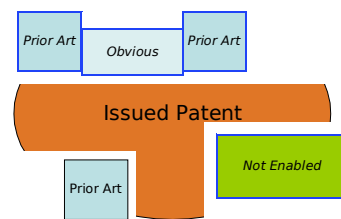
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Amendments during prosecution § 112 enablement



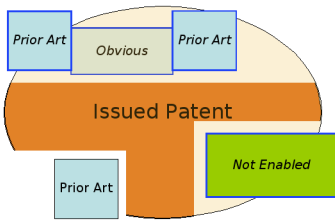
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Patent, as amended presumed valid



6

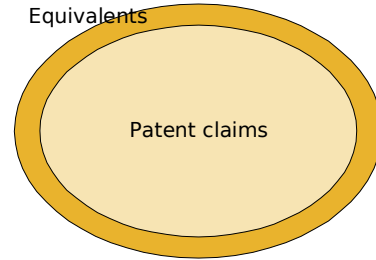
Prosecution history



7

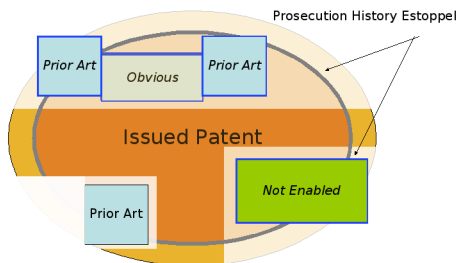
Doctrine of Equivalents

Equivalents



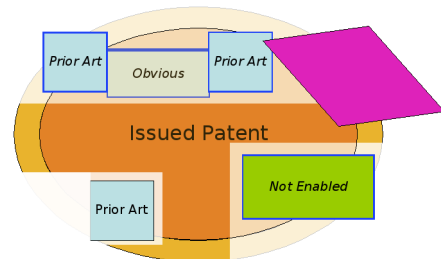
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What happens in an infringement suit?



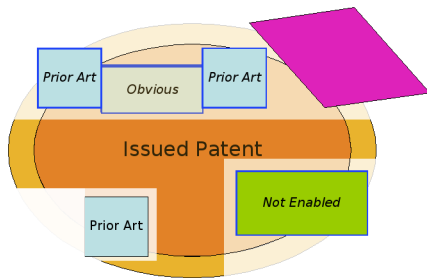
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Infringement:



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Design-around:



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Sealed crustless sandwich

1. A sealed crustless sandwich, comprising:

a first bread layer having a first perimeter surface coplanar to a contact surface;

at least one filling of an edible food juxtaposed to said contact surface;

a second bread layer juxtaposed to said at least one filling opposite of said first bread layer, wherein said second bread layer includes a second perimeter surface similar to said first perimeter surface;

a crimped edge directly between said first perimeter surface and said second perimeter surface for sealing said at least one filling between said first bread layer and said second bread layer;

wherein a crust portion of said first bread layer and said second bread layer has been removed.

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Sealed crustless sandwich

• Prior art includes

- Crustless tea sandwiches
- Ravioli
- Panini presses

• Is it novel (§ 102)?

• Is it obvious (§ 103)?

1. A sealed crustless sandwich, comprising:

a first bread layer having a first perimeter surface coplanar to a contact surface;

at least one filling of an edible food juxtaposed to said contact surface;

a second bread layer juxtaposed to said at least one filling opposite of said first bread layer, wherein said second bread layer includes a second perimeter surface similar to said first perimeter surface;

a crimped edge directly between said first perimeter surface and said second perimeter surface for sealing said at least one filling between said first bread layer and said second bread layer;

wherein a crust portion of said first bread layer and said second bread layer has been removed.

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Sealed crustless sandwich +

- Joe's Diner invents a new tofu-loaf (same texture as bread, half the carbs).

- Joe wants to make and sell sealed crustless sandwiches with tofu-loaf. Joe concedes that they look very much like Uncrustables.

- Does Joe's new dish infringe?

- Can Smuckers make sandwiches with tofu-loaf?

1. A sealed crustless sandwich, comprising:

a first bread layer having a first perimeter surface coplanar to a contact surface;

at least one filling of an edible food juxtaposed to said contact surface;

a second bread layer juxtaposed to said at least one filling opposite of said first bread layer, wherein said second bread layer includes a second perimeter surface similar to said first perimeter surface;

a crimped edge directly between said first perimeter surface and said second perimeter surface for sealing said at least one filling between said first bread layer and said second bread layer;

wherein a crust portion of said first bread layer and said second bread layer has been removed.

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Literal infringement

- Accused product or process contains every element of a patent claim
 - Does it have to infringe all patent claims?
- What do the claims mean?
 - Claim construction is a matter of law
 - "Markman hearings"

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Phillips v. AWH Corp.

- **Steel shell modules for prisoner detention facilities**, Edward H. Phillips
- Patent 4,677,798
- <http://www.google.com/patents?id=5k8rAAAAEBAJ&dq=4677798>

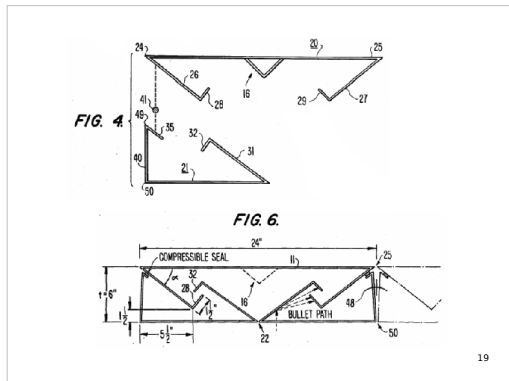
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Phillips v. AWH Corp.

What is claimed is:

1. Building modules adapted to fit together for construction of fire, sound and impact resistant barriers and rooms for use in securing records and persons, comprising in combination, an outer shell of substantially parallelepiped shaped with two outer steel plate panel sections of greater surface area serving as inner and outer walls for a structure when a plurality of the modules are fitted together, sealant means spacing the two panel sections from steel to steel contact with each other by a thermal-acoustical barrier material, and further means disposed inside the shell for increasing its load bearing capacity comprising internal steel baffles extending inwardly from the steel shell walls.

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Sources of claim construction

- Intrinsic evidence
 - Claims
 - as understood by PHOSITA
 - Specification
 - key part of the integrated patent instrument
 - Prosecution history
 - “ongoing negotiation between PTO and applicant”
- Extrinsic evidence – when patent is ambiguous
 - Dictionary definitions- lay and/or technical
 - Expert and inventor testimony
 - Learned treatises

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Larami Corp. v. Amron

1. A toy comprising an elongated housing having a chamber therein for a liquid,

a pump including a piston having an exposed rod end extending rearwardly of said toy facilitating manual operation for building up an appreciable amount of pressure in said chamber for ejecting a stream of liquid therefrom an appreciable distance substantially forwardly of said toy, and means for controlling the ejection.

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SS 20

1. A toy comprising an elongated housing having a chamber therein for a liquid,

a pump including a piston having an exposed rod end extending rearwardly of said toy facilitating manual operation for building up an appreciable amount of pressure in said chamber for ejecting a stream of liquid therefrom an appreciable distance substantially forwardly of said toy, and means for controlling the ejection.

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Equivalents

- Patentee shouldn't be denied rights against “insubstantial variation” from patent claims
 - “Substantially the same **function**, in substantially the same **way**, to obtain substantially the same **result**”
- Why might inventor have left substitutes out of a claim?
 - They were in the prior art or obvious from it
 - Couldn't enable them
 - Didn't think of them
 - Language wasn't precise enough to specify them
 - Technology didn't exist yet
 - Had a sloppy patent agent
 - Knew about the doctrine of equivalents and behaved strategically
- Which of these should the inventor be able to reclaim through equivalents? 23

Warner-Jenkinson Co. v. Hilton-Davis Chem. Co.

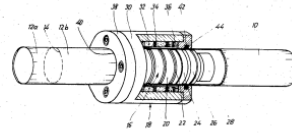
- Ultrafiltration process for purification of dyes useful in foodstuffs
- "In a process for the purification of a dye ... the improvement which comprises: subjecting an aqueous solution ... to ultrafiltration through a membrane having a nominal pore diameter of 5-15 Angstroms under a hydrostatic pressure of approximately 200 to 400 p.s.i.g., at a pH from approximately 6.0 to 9.0, to thereby cause separation of said impurities from said dye...." (emphasis added).
- D's filtration operates at pH 5.0 24

Measuring Equivalence

- “All elements”
 - substantially equivalent means, way, result on each element of the claim
- Equivalence evaluated at the time of alleged infringement
 - after-developed technologies can be equivalent

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Festo Co. v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd.



- ...slidingly engaging said internal wall and **first sealing rings** located axially outside said guide rings for wiping said internal wall as said piston moves along said tube to thereby cause any impurities that may be present in said tube to be pushed along said tube ... having end face means with **second sealing rings** located axially outside said second permanent annular magnets for wiping the external wall surface of said tube
- Accused device used one sealing ring with a two-way lip
- “The patent-holder should know what he owns and the public should know what he does not.”

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Doctrine of Equivalents

- What’s at stake?
 - Incentives to inventor
 - Certainty and predictability of patent system
 - Notice to public
 - Efficiency
 - Fairness
 - Public access
 - Competition

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Prosecution History Estoppel

- “Estoppel arises when an amendment is made to secure the patent and the amendment narrows the patent’s scope.”
- But amendment doesn’t dictate that the new claim is perfect
- Presumed disclaimer of surrendered equivalents
 - Patentee’s burdens:
 - show amendment was not made for purposes of patentability
 - show amendment does not surrender particular equivalent in question

Johnson & Johnson v. R.E. Serv

- Specification: “While aluminum is currently the preferred material for the substrate, **other metals, such as stainless steel or nickel alloys may be used.**”
- Claims: “1. A component for use in manufacturing articles such as printed circuit boards comprising:
 - a laminate constructed of a sheet of copper foil which, in a finished printed circuit board, constitutes a functional element and a sheet of **aluminum** which constitutes a discardable element;
 - one surface of each of the copper sheet and the aluminum sheet being essentially uncontaminated and engageable with each other at an interface....”
- Has Johnson claimed steel?
- Should Johnson get steel as an equivalent?

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Contributory infringement

- Who can be liable for patent infringement?
- Recall *MGM v. Grokster*

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