

The Importance Of Good Claims Upon Filing



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Recent changes in US patent law make it more important than ever before to try to draft good claims upon filing. This is of particular importance for patent applications which were first-filed outside the US and are now being filed in the US.

A first change in US law relates to publication of pending US patent applications. Under US law infringement damages now can begin to accrue from the date of publication. (Formerly, damages could begin only upon issuance of the patent.) Importantly, however, the damages accrue only if a claim infringed upon issuance has a substantially identical claim in the published application. This is a first reason why it is important to attempt to draft good claims so that when the publication occurs, the claims have the best possible chance of being substantially identical to issued claims.

A second change in US law relates to the "Doctrine of Equivalents," under which a patent owner may be able to establish infringement even when a claim is not literally infringed. As is well known to most practitioners, in the recent case of *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 56 USPQ2d 1865 (Fed. Cir. 2000),¹ the Court of Appeals for the Federal Circuit drastically reduced the range of circumstances in which the Doctrine of Equivalents is available to a patent owner. Briefly, the Court decided that an amendment to a claim element during prosecution will make the Doctrine of Equivalents unavailable with respect to that claim element (except in the special case where there is some stated reason, other than to

secure patentability, why the amendment was made).

A third trend in US patent law is found in a series of decisions by the Court of Appeals for the Federal Circuit in recent years which have greatly developed the "Written Description" doctrine. One of the leading cases is *Vas-Cath Inc. v. Mahurkar* (Fed. Cir. 1991) 19 USPQ2d 1111, 935 F2d 1555.² Under this doctrine, a patent will only be granted if (and is valid only if) the patent application as filed contained a written description of the invention. This requirement is distinct from the "enablement" requirement, namely that the patent application as filed must contain sufficient disclosure to enable someone skilled in the art to practice the invention. It is also distinct from the requirement that a US patent application disclose the "best mode" known to the inventor for practicing the invention. As discussed in the Patent Office's *Guidelines for Examination of Patent Applications under the "Written Description" Requirement*,³ there is a presumption that if a claim was in the patent application as filed, then the invention covered by that claim is within the "written description" provided in the application as filed.

It should be appreciated, then, that there are three distinct and important reasons why it is extremely desirable to include, within the US patent application as filed, claims which represent the inventor's best efforts at drafting of claims for US practice. For most inventors it should be a goal to draft a range of claims in various styles and of varying scope to improve the chances that each claim as issued will find an identical or nearly identical claim among the claims of the application as filed.

The inventors for which these considerations are of particular importance are the non-US inventors whose applications were first filed in countries other than the US,

applications prepared by patent firms outside the US. Such applications are, quite naturally, drafted in the style of the country in which they are filed. Yet such an application may be ill-suited for US purposes, for example because its claims may be less than optimal for US examination. Such problems are exacerbated where the first filing was in a language other than English and where it is proposed to file, in the US, an English translation of the first application.

For many non-US patent firms, it has been standard practice to minimize US filing cost by simply filing, in the US, the same application (and the same claims) that were filed in the first filing (the priority document), translated into English if necessary. This practice assumes that if any changes to the claims or the specification turn out to be needed (as indicated by the US Examiner in the first US Office Action), the changes can be made in an amendment after the first Office Action.

From the above discussion, however, it will be appreciated that many non-US inventors will be better served if good US-style claims are drafted prior to filing the US application, rather than waiting to draft them after the first Office Action. A US patent firm which receives a patent application from non-US patent firm may wish to counsel the non-US patent firm to consider incurring the cost of paying US patent counsel to review the application in some detail and to bring the claims into the best possible US style, prior to filing. **IPT**



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ENDNOTES

1. <http://www.ll.georgetown.edu/Fed-Ct/Circuit/fed/opinions/95-1066.html>
2. <http://www.patents.com/plaw/vas-cath.htm>
3. <http://www.uspto.gov/web/offices/com/sol/notices/writdesguide.pdf>