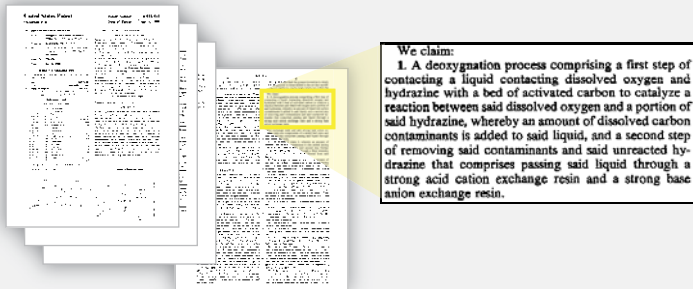


How to Interpret U.S. Patent Claims

Clifton E. McCann and
Keith G. Haddaway, Ph.D.
Venable LLP

A claim defines the exclusive right defined by a patent. They are the numbered paragraphs at the end of the patent document.



Claim Interpretation

Claim interpretation is important in determining the scope of your patent rights and in determining whether anyone else has a patent that would prevent you from making, using, selling or importing an apparatus or method.

How Claims Are Interpreted

Claims are interpreted as to their meaning when viewed by a person of ordinary skill in the art and in light of:

The Patent's
Written Description

Arguments Made
to the Patent Office

Dictionary
Definitions

Claim terms are given their ordinary meaning unless the patent's written description or arguments made to the patent office indicate otherwise. Occasionally, prior art references and expert witnesses are used to resolve ambiguity.

How Claims Are Infringed

To show patent infringement, an accused device, method, system or composition must possess each claimed element, or something equivalent to the element. An equivalent can be something that does substantially the same thing in substantially the same way, to achieve substantially the same result. The range of equivalents can be limited by the claim's interpretation, as discussed above.

Claim Structure

Preamble – Generally does not limit the claim; identifies the category of the invention or what it does.

Transitional phrase – Certain words have well-established meanings:

“comprising” – open – the invention includes each of the recited limitations and can contain any additional elements

“consisting of” – closed – the invention is limited to the exact elements recited. An apparatus with additional elements usually avoids infringement

“consisting essentially of” – partially open – allows for the presence of additional elements that do not change “the basic and novel characteristics of the invention”

Elements or limitations – The components that make up the claimed invention

We Claim:

- Independent Claim — 1. An apparatus comprising A, B, C, and D.
- Dependent Claim — 2. The apparatus of claim 1, further comprising E.

Glossary of Claim-Related Terms

Claim Differentiation – A principle used in claim interpretation that says, in essence, different claims in a patent have some difference in meaning that should be taken into account when interpreting the different claims.

Freedom to Operate or Right to Use Opinion – Opinion prepared by patent counsel after searching patents to determine whether patents of others prevent the making, using, selling or practicing a product or process. May also include a discussion of whether a particular claim is valid.

Functional Limitation – A limitation based upon what something does or causes as a way of further limiting a structure. These kinds of limitations are generally acceptable.

Imprecise Terms – “about,” “substantially,” “generally” – usually acceptable. The amount of variation is determined by the facts on a case-by-case basis.

Indefinite and Ambiguous Terms – “normally,” “ordinarily,” “preferably,” “particularly,” “and the like,” “similar to” – not usually acceptable.

Markush Claim – This claim covers any one of the recited members of the group, as well as combinations. Example: An ion exchange resin selected from the group consisting of strong base anion resin, strong acid cation resin and mixed bed resin.

Means-Plus-Function Limitation – Limitation that describes an element mostly by what it does. Covers the element as described in the specification as well as equivalents of what is described in the specification. Example: Means for attaching two boards. If the specification describes a nail, a screw may also be covered. However, glue may not be.

Patentability Opinion – Opinion prepared by patent counsel after searching patent and non-patent literature to determine whether a patent might be obtained for an invention and/or to determine the scope of patent protection that might be available.

Prior Art – Anything known in the art that might be applied in rejecting a claim or holding it invalid. Can include patents, published literature from scientific journals to advertisements, prior sales or offers for sale, public displays, possibly things generally known or recognized in the art. Whether something is “prior art” depends on its nature and timing relative to the date of invention. What constitutes prior art can vary from country to country.

Product-by-Process Claim – Claims a product by how it is made. In general, the claim is not valid if the same product existed before, regardless of how it was made. The product may be infringed if the same product is made by another process. Example: A novel polymer prepared by reacting methyl methacrylate and ethyl acrylate.

Validity – An assessment of whether a claim should be or should have been issued in a patent. A claim is invalid if anticipated (described in a single prior art reference), obvious to one of ordinary skill (may be based on a combination of prior art references or general knowledge in the art), indefinite, not enabled, or not adequately described. Governed by the Federal Patent Statute, 35 U.S.C. §§ 102, 103, 112 and others.

DISCLAIMER

This presentation is for information purposes only and does not constitute legal advice on any matter. The reader should not rely on, or act on the basis of, the materials presented herein. These materials and information are not a substitute for obtaining legal advice from a competent lawyer.

Claim interpretation is a matter of law, although it is frequently affected by underlying facts.