Claim Drafting Strategies Revisited — How Much, If Any, Preamble Is Necessary?

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PREAMBLES AS CLAIM "NOISE"

A claim drafter faces several substantial problems in defining the legal metes and bounds of a client's invention. Among these problems are the imprecise nature of language, a less than complete understanding of what the invention really is and what the prior art teaches, and how competitors will attempt to construe terms in design-around efforts with later-developed technology. There is one advantage, however, that belongs to the claim drafter. That is, the author of a claim, like an artist who paints, starts with a blank canvas. That author has the ability to control the words that go on the page just as the artist decides which paints will be applied to the canvas. Within the frame bounded by the statutory requirement as to what a claim must do, the claim author is, so to speak, free to choose how much of the page is occupied with words, keeping in mind that, as a general rule, the more words on the page, the greater the problems that the patentee is likely to face in enforcing patent rights.

This article's author suspects, however, that many claim drafters may approach preambles too casually, as innocuous things constituting a "warm up" to reciting the real claim features. Little, or certainly less, thought is likely given by them to how preambles may later affect issues of validity and infringement in future enforcement efforts or even in obtaining patent protection during prosecution than is given to how intended claim limitations affect those issues. The extent to which preambles, largely — if not wholly — unnecessary or not required in presenting a claim which is clear and definite, continues to be the subject of claim construction opinions from the U.S. Court of Appeals for the Federal Circuit (Federal Circuit) strongly suggests that their inclusion is often more an automatic reflex than the product of forethought.

What has recently been referred to by the Federal Circuit as the "art of claim drafting"[1] is certainly not advanced by wooden adherence to longstanding PTO-approved practices which fail to capture nuances of inventions in cutting-edge technologies or by ignoring the rules being applied by courts. Examination of the Single Sentence Rule (see, "Claim Drafting Strategies Revisited — Is The "Single Sentence Rule" Too Inflexible?" in the August 2003 issue) was an initial effort to explore, at the most fundamental level, the soundness of the common practices used by claim drafters in pursuing their art. Here, we begin at the opening portion of a claim, i.e., with the preamble.

THE NATURE OF CLAIM PREAMBLES

What is the preamble of a claim? It is not defined by statute, rule or even in the Manual of Patent Examining Procedure (MPEP). Generally speaking, it is the word or words that begin the sentence following the claim number and that precede a transitional phrase such as "comprising" or "consisting of." The preamble generally sets out the category of invention, i.e., apparatus, method of making, method of using, or composition. Very often, the preamble will contain a functional statement and, in some instances, structural features that are also referred to in the claim "body" containing the limitations or elements that are considered to constitute the novel and unobvious combination. It is those structural features or functional statements that may be later found to be part of the claimed combination and thus a limitation on the scope of the invention when the claim has to be construed by a court. This may work to the advantage or disadvantage of the patent owner. It is often a "great unknown" in claim construction proceedings until a final court determination.

As was true in discussing the Single Sentence Rule, and as is true with other aspects of patent claims, there is no statutory requirement for a preamble as acknowledged by the Patent and Trademark Office (PTO) in the MPEP[2] A claim, irrespective of how it is constructed, need only particularly point out and distinctly claim the subject matter which the applicant regards as the invention.[3]

The Patent Act is silent as to what a claim should look like except for the broad guidelines found in Section 112 of Title 35, U.S. Code. The PTO Rules of Practice also, as above noted, do not require the presence of a claim preamble. 37 CFR § 1.75(e) merely states that

> Where the nature of the case admits, as in the case of an improvement, any independent claim <u>should</u> contain in the following order:
>
> (1) A preamble comprising a general description of all the elements or steps of the claimed combination which are conventional or known,
>
> (2) A phrase such as "wherein the improvement comprises," and
>
> (3) Those elements steps and/or relationships which constitute that portion of the claimed combination which the applicant considers as the new or improved portion. (emphasis added)

Patent practitioners will recognize this suggested form of claim, in which the preamble elements are impliedly admitted to be old in the art, as a "Jepson" claim[4], which is occasionally used but is not believed to be the most widely used claim format in U.S. practice. Instead, the more common preamble practice, say with regard to apparatus claims, is to set forth "An apparatus" likely followed by a functional description, e.g., "for forming apertures in a workpiece" and then a listing of those elements deemed to constitute the patentable combination.

The MPEP refers to preambles in only two contexts, namely their inclusion in a Jepson claim as defined in 37 CFR § 1.75(e) as an implied admission of prior art (§ 2129)[5] and their effect in limiting the claim of a utility patent (§ 2111.02). The latter presents the more interesting issue for the patent prosecutor because it is here that the PTO has to ascertain the applicant's intentions on a case-by-case basis with the use of guideposts rather than a single objective test. Of course, the applicant has the opportunity during prosecution to remove any doubt by reformulating the claim or expressing his intention that the preamble is intended and necessary to give life, meaning and vitality to the claim so that it defines over the prior art. To the

extent that the Examiner's reasoning is not clearly articulated in the prosecution history, however, a court presented with a validity challenge based on new prior art could well reach a different conclusion as to the "saving" effect of the preamble in defining over that new prior art.

Theoretically, it would seem, no preamble is required other than, perhaps, the preamble of a dependent claim to set forth its dependency upon a particular claim or claims. This is one of those situations where less may be more, i.e., more in the patentee's favor. To the extent a claim drafter concludes otherwise, however, there does not appear to be any rational basis to use more than a single word such as "apparatus" or "method" to describe the category of the invention.

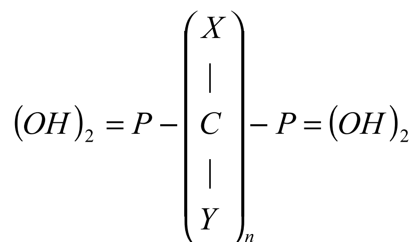
PREAMBLES AS RISKS

Even though it is a long-held and widespread belief, often found to be true, that a preamble is not a "limitation" whose presence is required in an accused product or method for proving infringement, the mere presence of a preamble — particularly one constituting a prolix introductory paragraph raises a risk that it may be construed as subject matter which the applicant indeed regards as part of the invention so as to preclude infringement. The very imprecision in the application of claim construction canons dictates that the claim drafter carefully consider at the outset, when the "canvas" is blank, whether a preamble is necessary or desirable and to what extent one should be provided.

Claim drafters who use preambles, particularly preambles that contain structural and/or functional features, potentially raise a "life, vitality and meaning" issue which a court may be called upon to construe. That is, the presence of a preamble may require a court to determine if its language is an integral part of the claim, and thus a limitation, or merely an introductory phrase serving to provide a context for the real claim limitations. If the latter, there is no requirement to provide a context. It may well be dangerous to do so as a patentee cannot know in advance if a court will breathe more life, meaning and vitality into the phrase. If the former, it would be more straightforward to include the phrase in the body of the claim. Doing otherwise runs the risk that the patentee may be forced to expend thousands of dollars, and possibly substantially more, in a Markman claim construction hearing explaining why the preamble language is or is not part of the claim. Federal Circuit and lower court precedent has laid out where the perils of a preamble lay. Preambles are two-edged swords, and each side in a patent dispute can wield them during a Markman hearing in construing disputed claim language, using not just the claims but prosecution history and expert testimony as well.[6] They can save a patent from invalidity[7] but they also have the potential to determine the infringement issues as well.[8]

DO PREAMBLES HAVE REAL VALUE?

In the case of the chemical formula used in the above-referenced article on claim drafting strategy from the August 2003 issue, namely,



$$(OH)_2 = P - \begin{pmatrix} X \\ | \\ C \\ | \\ Y \end{pmatrix}_n - P = (OH)_2$$

it would serve little purpose to tell one skilled in the art that the structural formula, if submitted as a claim following an enabling disclosure, is directed to a "composition." Nor is a purely functional statement of its intended use in a composition-of-matter claim likely to convince an Examiner of its patentability[9] or to satisfy the utility requirement if presumably the specification has already done so in compliance with 35 USC §§ 101 and 112, ¶ 1.[10]

For present purposes, indeed for almost all purposes, we can assume that the Single Sentence Rule is appropriate and does not create any artificial barriers to broad claiming of an invention. To the extent that the listing of claims at the end of the specification begins with the words "I claim:" or "We claim:", then a listing of the elements in accordance with 37 CFR § 1.75(e)(3), such as the chemical formula set out above, would appear fully to comply with the Single Sentence Rule requirement, assuming, of course, that the listed element or elements (or steps) particularly point out and distinctly claim the invention.

The inclusion of a preamble, unless otherwise intended by the patent applicant, in many — if not most — cases serves as no real aid for the applicant, the PTO, or eventually the public, in interpreting the metes and bounds of elements. To the contrary, a preamble may well serve to limit the scope of the invention at a later time in a manner never intended by the patentee. The patentee, public and would-be infringers have to await a court's determination. In fact, the total elimination of a preamble also has the added beneficial effect of dispensing with the need for a transitional phrase such as "comprising" and "consisting of," things which in themselves have resulted in putting much judicial ink to paper.[11]

PREAMBLE CLAIM CONSTRUCTION ISSUES

There has been much consternation and criticism over what appears to be the regular reversal by the Federal Circuit of district court claim construction rulings.[12] Although there may be some inconsistency in the manner in which the claim construction canons have been applied at the appellate level,[13] the Federal Circuit does not regularly create new rules out of whole cloth.[14] There seems to be little introspection shown among members of the Patent Bar about the fact that claim drafters continue to write claims that are fraught with difficult construction issues, notwithstanding the relative clarity in the articulation of these claim construction canons (if not in their application in specific cases), the preeminent canon appearing to be the "ordinary meaning" of the claim language.[15]

One of the problems causing this may be the disciplinary twain that often exists between skilled prosecutors and trial counsel. The longstanding question is, should a prosecutor have some litigation experience or should a litigator have some prosecution experience? The answer is likely that each ideally should understand the basic processes of the other's discipline. The trial lawyers, as with district courts and the Federal Circuit, are, however, largely at the mercy of what the claim drafter has done. They are faced with a *fait accompli* and must make the best out of the situation. This suggests that claim drafters must have an appreciation of the real goal of prosecution which is not merely the issuance of a patent with apparently broad but defensible claims. The goal ought to be the elimination of as many downstream claim construction issues as can be reasonably foreseen. The preamble seems like the appropriate starting place to achieve that goal.

Ideally, if not in the real world, obtaining a claim covering a commercial embodiment that is sufficiently broad to read on all

equivalent structures (some of which may be yet unknown) and sufficiently narrow to exclude previous equivalent structures with the interposition of minimal interpretational interference from a court should be the finish line for the claim drafter, perhaps an elusive target. Nevertheless, it remains a paradox why seasoned patent claim drafters overpaint their canvases by ignoring what courts have already told them raises problems.

PREAMBLE USE SHOULD BE A CALCULATED DECISION

For at least the past ten years, a substantial amount of preamble law has been generated, all of which ought to suggest that preambles, if used, be used with forethought and with careful draftsmanship. Unfortunately, courts cannot draw a bright line as to whether a preamble is a claim limitation. No longer, however, should the claim drafter casually use a preamble based on the assumption that it doesn't count. Both the PTO and the courts have signaled that preambles will be treated by using a grey scale, not litmus paper.

There is a current school of thought that patent disclosures ought to be drafted with a minimum profile. In other words, they should be devoid of a description of the prior art, a statement of the invention's objectives and a summary of the invention.[16] To the extent this is an appropriate strategy, claims should probably be drafted in a consistent manner such that unneeded terms are eliminated in the claim drafting stage to avoid serving as pegs upon which to later hang limitations that are found to preclude broad coverage.

"Minimal" claiming is one art form whose value has been elevated to increased heights by Festo.[17] Thoughtless amendments of preambles, later found to be claim "limitations", may also well result in precluding the application of the Doctrine of Equivalents. To the extent that a preamble is used at all, prudence should dictate that any intended meaningful circumscription of the claimed invention be accomplished outside the preamble; that is, in the body of the claim where the elements can evidence that which is intended to give life, vitality and meaning.

The potential problems posed by preambles appear to be technology-neutral. That is, they appear to favor or disfavor no particular technology. Nor do they appear to be a prerequisite for particularly pointing out and distinctly claiming an improvement in the electrical, chemical, mechanical and biotechnology arts. The purpose here, as with the Single Sentence Rule, is not to deconstruct cherished claim drafting principles. Rather, the goal is to treat each claim in a patent as a thing uninhibited by hoary rules whose origins and purposes are only vaguely known and incompletely contemplated.

PTO ASSISTANCE TO THE PUBLIC AND THE COURTS

The PTO is in a position to help this situation and provide greater certainty for the courts and public — thereby departing from subjective analysis of the patent applicant's intentions — with a simple administrative "fix." Specifically, in the same manner that it deems the single sentence to be the appropriate practice, it could engage in rulemaking subject to the Administrative Procedure Act or better a policy statement or guideline that the preamble should be a single word or phrase, namely "Apparatus," "Method," "Composition," Product," "Method of Use" or "Product-by-Process." There is no need for a claim drafter to go beyond this without entering a twilight zone. This policy would eliminate the PTO's searching, often elusive, effort to divine an applicant's intentions without making a clear record of what was concluded regarding those intentions.

Unless and until, if ever, the PTO undertakes to address the preamble issue more directly, every word that the claim drafter adds to a claim ought to be preceded by the question "Is this really necessary to define the invention?" In the case of a preamble, whether it be a word such as "apparatus" or an entire phrase, the question is particularly apposite because of its potential and often unknowable downstream effects.

ENDNOTES

1. Anchor Wall Systems, Inc. v. Rockwood Retaining Walls, Inc., ___ F.3d ____, ____ 2003 WL 21920278, *10 (Fed. Cir. 2003).
2. § 608.01(m). The PTO states its policy to be that each claim must be the object of a single sentence starting with "I claim" or "We claim" or "The invention claims is" (or the equivalent).
3. 35 USC § 112, ¶ 2.
4. Ex parte Jepson, 1917 C.D. 62, 243 O.G. 526.
5. MPEP § 2129 acknowledges that in situations where an applicant explains that the Jepson format is being used to avoid a double patenting rejection over the applicant's own copending application, the implication that the preamble is admitted prior art is overcome. Se also, In re Eirreich, 200 USPQ 504 (CCPA 1979).
6. See, Vanpel Textilmaschinen KG v. Meccanica Euro Italia s.p.a., 944 F.2d 870, 880 (Fed. Cir. 1991).
7. See, e.g., In re Paulsen, 30 F.3d 1475, 1479 (Fed. Cir. 1994).
8. See, e.g., Storage Tech. Corp. v. Cisco Systems, Inc. 329 F.3d 823, 836 (Fed. Cir. 2003); Catalina Marketing Int'l., Inc. v. Coolsavings.com, Inc., 289 F.3d 801, 810 (Fed. Cir. 2002); General Electric Co. v. Nintendo Co., 179 F.3d 1350, 1362 (Fed. Cir. 1999).
9. In re Paulsen, supra note 7.
10. In re Trovato, 42 F.3d 1376, 1382 (Fed. Cir. 1994); Ex parte Van Tanen, 67 USPQ2d 1518, 1523 (Bd. Pat. App. & Int. 2003) (Unpublished)
11. See, e.g., Abbott Lab. V. Baxter Pharm. Prod., Inc., 334 F.3d 1274, 1281 (Fed. Cir. 2003).
12. Cybor Corp. v. FAS Tech., Inc., 138 F.3d 1448, 1476 (C.J. Rader, dissenting) (Fed. Cir. 1998).
13. SciMed Life Systems, Inc. v. Advanced Cardiovascular Systems, Inc., 242 F.3d 1337, 1347 (C.J. Dyk, concurring) (Fed. Cir. 2001).
14. For example, the recent ruling in Texas Digital Systems v. Telegenix, Inc., 308 F.3d 1193, 1202-03 (Fed. Cir. 2002) arguably represents one of those instances where a new direction in claim interpretation is charted by the Federal Circuit in ruling that dictionaries, encyclopedias and treatises are no longer "extrinsic" evidence but a first recourse by courts in construing claims.
15. See, e.g., Anchor Wall Systems, Inc. v. Rockwood Retaining Walls, Inc., supra note 1 at *5.
16. D. Lazar, The Impact of Recent Federal Circuit Decisions on Crafting Patent Applications, presented at the AIPLA 2003 Advanced Patent Prosecution Seminar (June 12, 2003).
17. Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., 535 U.S. 722 (2002).