

# Claim Drafting Strategies Revisited — Is The “Single Sentence Rule” Too Inflexible?

BY JAMES F. MCKEOWN

**T**oday, patent lawyers are preoccupied with claim construction issues. The Court of Appeals for the Federal Circuit (CAFC) was created in 1982 to bring about uniformity in patent law principles and thereby greater certainty among patentees as to the enforceability of their patent properties. That promise appeared to be fulfilled for about the first ten years of the Court’s existence during which there was a previously unrealized doctrinal consistency. The decisional law that has developed during the 1990’s and into the new millennium has, however, created substantial uncertainty as to the rules governing claim construction. Practitioners who draft patent applications are now in a quandary about the basic notions of how a claim should be drafted in light of the uncertain treatment it is likely to be given in the future by district courts and the Federal Circuit.

Moreover, the latitude that patentees once thought they enjoyed under the doctrine of equivalents may no longer be available to cure careless claim drafting. Thus, in considering the subject of claim drafting — a process that is now very likely, at its inception, to evermore determine a patent’s scope — it seems appropriate to begin with the simplest precept of what a claim should be. The “single sentence rule” (SSR) is the ideal candidate, particularly as it appears to be among the most inflexible of the “sacred cow” claim drafting rules and the least controversial in that it seems to be a practical way to formulate a claim and has stood the test of time.

One of the more unchallenged notions in U.S. patent practice is that a claim must be a single and complete sentence, no more and no less. That is, each claim in a patent must be stated in one sentence. This rule is followed regardless of the impact that it has on the readability of the claim or its length, or upon the claimed subject matter or category of invention. The Patent and Trademark Office has successfully argued, without any apparent factual basis, that the

standardization brought about by the SSR has fostered efficient processing of several million patent applications. Less certain, and perhaps of greater importance, is its argument that the rule has no impact on the clarity of claims. Whatever the merits of the rule, however, it is one admittedly not founded in statute or even rule. Given the tremendous distance the world has come technologically in the last fifty years, the more liberal qualification of other types of inventions as a subject for “utility” patents (e.g., business methods and plants) and the interpretational quandary now faced by patentees and the public alike in construing patent claims, we might benefit from a rethinking of the SSR and see if even it bears modification or some limited exception.

The only statutory requirement regarding utility patent claims is found in section 112 of Title 35, U.S. Code. Specifically, that section provides that the specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as the invention. The statutory options for drafting claims consist of writing the claim in independent form as well as in dependent or multiple dependent form. In addition, an element in a claim may be expressed as a means or a step for performing a specified function.

The rules of practice do not shed any further light on precisely how a claim should be constructed. Rule 51 (37 CFR § 1.51) merely states that a complete application must include a claim or claims, referring to Rules 71 to 77 (37 CFR §§ 1.71 to 1.77). Of the latter rules, Rule 75 (37 CFR § 1.75) specifically deals with claims and paraphrases section 112. In addition, it requires the claims to conform to the invention as set forth in the remainder of the specification and must find “clear support or antecedent basis in the description.” Rule 75 also specifies, for certain type of claims (e.g., Jepson-format “the improvement comprising”-type claim), an order for the claims, namely a preamble, the “wherein the improvement comprises” phrase, and the novel elements,

and requires that claims be numbered “consecutively in Arabic numerals” with each element or step in a plurality of such elements or steps being “separated by a line indentation.” There is, however, no mention made of a single sentence except for the policy statement contained in the PTO’s Manual of Patent Examining Procedure (MPEP) which reflects the presumptions under which the PTO operates but which does not have the force of law.

Claims in the form we know them today were not required by statute, rule or practice until 1836 when the Patent Act of that year required claims which particularly point out and distinctly claim the invention. Until that time, “omnibus”-style claims were common, i.e., claims very much like those found in today’s design and plant patents, i.e., the design “as shown” or “as shown and described” or the plant “as described and illustrated.” U.S. Patent No. 10, issued on August 10, 1836 for a cutting and shaving machine, uses what appears to be a multiple sentence single claim:

This applicant does not claim the invention of a wheel with cutting, or plane irons set therein, but

The invention of wheel with faces inclined to each other, wherein the plane-irons are set, in combination as aforesaid, the cutters taking the wood not at right angles with the grain of the wood, but diagonally as a penknife when used in cutting toward the person’s wrist who uses it. This bottom of the trough therefore should be below the center of the wheel so that all the wood be below it, when the cutters take it in order, that the cutting or shaving may be diagonally as aforesaid.

Apparently, the SSR did not come into existence until some later date.

The only decisional reference dealing specifically with the SSR is *Fressola v. Manbeck*, 36 USPQ2d 1211 (D.D.C. 1995) granting summary judgment in favor of the PTO Commissioner’s denial of a petition to have a claim consisting of multiple sentences in a patent application. The independent claim in question had nine individual sentences. An objection was made during prosecution under MPEP § 608.01(m) which states, in relevant part, that

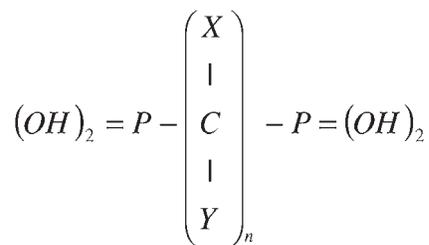
While there is no set statutory form for claims, the present Office practice is to insist that each claim must

be the object of a sentence.... Each claim begins with a capital letter and ends with a period. Periods may not be used elsewhere in the claims except for abbreviations.

Much of the remainder of the MPEP section deals with ministerial or formal aspects of presenting claims (e.g., commencing on a separate sheet, line indentation, ordering of claims, etc.) and, as such, are uncontroversial. It is the above-quoted language which is the focus here and for which there is no stated rationale.

The claim consisting of multiple sentences which was the subject of the Fressola case could unquestionably have been broken into several individually numbered claims. There seems to be little basis to question the SSR in this regard. The court was not, however, asked to address the situation where a claim is not a complete sentence or a sentence at all (a chemical structural formula or a drawing). The district court's opinion is largely based upon the patent applicant's failure to demonstrate that the SSR was anything other than a formal requirement which had no substantive implications. In such situations the PTO will be given, as it always has been and should be, wide latitude. No administrative due process is implicated in such a case. Without any analysis of the interplay between, on one hand, Section 112's requirement for particularity and distinctness and, on the other hand, a specific technology where the SSR may work contrary to that requirement, however, the district court characterized the rule as procedural rather than substantive.

What was true of the invention in Fressola (a method for displaying three-dimensional images) may not be true for other types of technologies in existence today or bearing tomorrow's inventive fruits. A characterization as "formal" or "procedural" could, for example, be questioned as regards chemical compositions where a sentence may be unnecessary, indeed undesirable, if a precise structural formula is available. Take, for instance, a compound which can be represented as



wherein  $n$  is an integer from 1 to 10 inclusive,  $X$  is a member selected from the group consisting of hydrogen and lower alkyl groups and  $Y$  is a member selected from the group consisting of hydrogen, hydroxyl, and lower alkyl groups.

No readily apparent purpose would be served by making this formula the object of a sentence, and requiring a preamble or period at the end. This may be even truer with regard to hereinafter developed technology where a single sentence (or, for that matter, any number of sentences) may not be the most particular and distinct way of claiming a new thing. Indeed, requiring such structural formulae, which are often present in chemical composition claims, to be "wrapped around" by a preamble and other words runs the risk of introducing ambiguities, rather than particularity and distinctness, into the claims as well as unnecessary limitations to a patentee's detriment.

It is now very clear — and probably should have come as no surprise — that every word in a claim can substantially impact the literal infringement determination as the addition of narrowing limitations drastically reduces the chances for successfully using the doctrine of equivalents. The hundreds of thousands of dollars spent by parties in arguing the meaning of prepositions such as "on" and "in" during Markman claim construction hearings suggests that patentees at least ought to be given maximum flexibility in deciding how best to present a patent claim. The SSR may be a useful starting point and, in fact, the best format in virtually every case. It ought not, however, be completely inflexible. The simple "fix" is to amend the MPEP to include the introductory phrase in Section 608.01(m) "Where the nature of the case permits...". Of course, a petition to the PTO Director directed to a situation not specifically provided for or to waive the rules is also available as a possible remedy.

It is difficult to conceive of a situation where the "multiple sentence" claim of the

type proposed in Fressola would be preferable to a single sentence. Yet, the possibility should not be foreclosed as a way of claiming technology of the future just as a claim which is not a sentence at all is likely preferable in some cases even today. The bottom line is that applicants ought to approach patent claim drafting, including the normally innocuous SSR, without any preconceived notions save statutory requirements. Where the situation seems to dictate a different approach, the notion of a single sentence claim requirement may be ripe for challenge if its substantive impact can be demonstrated in a case where other considerations, such as foreign filing requirements, do not dictate a more conservative approach.

It is likely true that the SSR is rational and most workable for the vast majority of utility patent inventions such as mechanical and electrical devices as well as chemical processes. To that extent, questions regarding the rule do not raise significant concerns. The rule's value is less clear for a chemical composition and the like which need not necessarily be defined by needlessly ambiguous words and can be better described by a simple chemical structural formula, i.e., a picture of the compound. In the appropriate case, the Patent and Trademark Office may be compelled to acknowledge that even the SSR, like almost all other rules, has its exceptions, and that there may be cases where a single complete sentence is less particular and distinct, or at least two sentences are preferable. The current problems surrounding claim interpretation have nothing to do with this rule. Nevertheless, the claim drafting process might be better served by fewer rules, particularly ones that are so inflexible.