

PATENTABLY DEFINED

THE PATENT PROSECUTION BLOG OF MICHAEL E. KONDOUDIS

A TECHNIQUE TO ASSERT THE PATENTABLE WEIGHT OF A CLAIM PREAMBLE

BY MICHAEL E. KONDOUDIS

THE PATENTABLE WEIGHT OF A CLAIM PREAMBLE

GENERALLY, DURING THE EXAMINATION OF AN APPLICATION, AN EXAMINER ATTEMPTS TO REBUT THE NOVELTY AND NON-OBVIOUSNESS OF A CLAIM BY IDENTIFYING, IN THE PRIOR ART, TEACHINGS OR SUGGESTIONS OF EACH FEATURE OF THAT CLAIM. SOME CLAIM FEATURES, HOWEVER, MAY BE IGNORED IN THIS ANALYSIS. THESE FEATURES ARE SAID NOT TO BE ENTITLED TO ANY “PATENTABLE WEIGHT.”

ONE OF THE CLAIM COMPONENTS THAT FREQUENTLY GIVES RISE TO DISPUTES ABOUT PATENTABLE WEIGHT IS A CLAIM’S PREAMBLE (E.G., A DEVICE FOR) WHICH, ALONG WITH A TRANSITIONAL PHRASE (E.G., COMPRISING) AND A BODY (E.G., A WHEEL), CONSTITUTES A CLAIM.

EXAMINERS GENERALLY DECLINE TO CONSIDER THE NOVELTY AND NON-OBVIOUSNESS OF A CLAIM’S PREAMBLE BECAUSE PREAMBLES TEND TO ONLY PROVIDE A CONTEXT OR A PURPOSE FOR A CLAIMED INVENTION. SIMILARLY, EXAMINERS OFTEN DISMISS AS UNPERSUASIVE PATENTABILITY ARGUMENTS BASED ON FEATURES RECITED IN A PREAMBLE. THIS IS, HOWEVER, BY NO MEANS A PER SE RULE. INDEED, THERE ARE CIRCUMSTANCES WHEN FEATURES IN A CLAIM’S PREAMBLE MUST BE GIVEN PATENTABLE WEIGHT. CONSEQUENTLY, WHEN AN APPLICANT RELIES ON FEATURES IN A PREAMBLE TO TRAVERSE A CLAIM REJECTION, IT OFTEN BECOMES NECESSARY TO EXPLAIN TO THE EXAMINER WHY THOSE FEATURES ARE ENTITLED TO PATENTABLE WEIGHT.

THE TEST AND THE LAW

THERE IS NO LITMUS TEST FOR DETERMINING WHETHER A PREAMBLE SHOULD BE GIVEN PATENTABLE WEIGHT. BASICALLY, A CLAIM PREAMBLE IS SAID TO BE AS IMPORTANT AS THE CLAIM AS A WHOLE SUGGESTS.

A PREAMBLE IS ENTITLED TO PATENTABLE WEIGHT WHEN IT IS “NECESSARY TO GIVE LIFE, MEANING, AND VITALITY” TO THE CLAIM. PITNEY BOWES, INC. V. HEWLETT-PACKARD Co., 182 F.3D 1298, 1305 (FED. CIR. 1999). THE FEDERAL CIRCUIT HAS HELD THAT A PREAMBLE MAY GIVE “LIFE, MEANING AND VITALITY” TO A CLAIM EITHER: (1) EXPLICITLY (THE CLAIM EXPRESSLY USES THE PREAMBLE AND THE BODY OF THE CLAIM TO DEFINE THE CLAIMED INVENTION); OR (2) IMPLICITLY (PROPER CONSTRUCTION OF THE CLAIM REQUIRES REFERENCE TO THE PREAMBLE). SO, WHEN AN APPLICANT USES THE BODY OF A CLAIM AND THE PREAMBLE TO DEFINE THE CLAIMED SUBJECT MATTER, THE PREAMBLE SHOULD BE ACCORDED PATENTABLE WEIGHT.

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CONVERSELY, WHEN THE BODY OF THE CLAIM “FULLY AND INTRINSICALLY” SETS FORTH THE CLAIMED INVENTION, THE PREAMBLE MAY NOT BE ENTITLED TO PATENTABLE WEIGHT. AS THE PITNEY BOWES COURT INSTRUCTED, WHEN A PREAMBLE “OFFERS NO DISTINCT DEFINITION OF ANY OF THE CLAIMED INVENTION’S LIMITATIONS, BUT RATHER MERELY STATES . . . THE PURPOSE OR INTENDED USE OF THE INVENTION,” THEN THE PREAMBLE CANNOT BE READ AS A LIMITATION ON A CLAIM.

THE MPEP ADDRESSES THE PATENTABLE WEIGHT OF PREAMBLES IN SECTION 2111.02, WHICH PROVIDES THE FOLLOWING LIMITED, SPECIFIC GUIDANCE:

1. PREAMBLES THAT LIMIT STRUCTURE MUST BE GIVEN PATENTABLE WEIGHT (MPEP 2111.02(I)); AND

2. PREAMBLES RECITING A PURPOSE OR AN INTENDED USE MAY BE GIVEN PATENTABLE WEIGHT (MPEP 2111.02(II)). SPECIFICALLY, FEATURES IN THE PREAMBLE RECITING THE PURPOSE OR INTENDED USE OF THE CLAIMED INVENTION MUST BE EVALUATED TO DETERMINE WHETHER THE RECITED PURPOSE OR INTENDED USE RESULTS IN A STRUCTURAL DIFFERENCE (OR, IN THE CASE OF PROCESS CLAIMS, MANIPULATIVE DIFFERENCE) BETWEEN THE CLAIMED INVENTION AND THE CITED ART. IF SO, THE RECITATION SERVES TO LIMIT THE CLAIM.

AN EXAMPLE OF AN ARGUMENT THAT A CLAIM PREAMBLE SHOULD BE GIVEN PATENTABLE WEIGHT

PRESUME THAT CLAIM 1 RECITES THE FOLLOWING:

A METHOD OF TRANSMITTING A PACKET OVER A SYSTEM INCLUDING A CLIENT AND A SOURCE DEVICE, THE PACKET INCLUDING A SOURCE ADDRESS AND A DESTINATION ADDRESS, THE METHOD COMPRISING:

ASSIGNING, BY THE SOURCE DEVICE, ONE OF PLURAL TREES TO BROADCAST THE PACKET TO THE DESTINATION ADDRESS; ...

ASSOCIATING WITH THE PACKET AN IDENTIFIER INDICATIVE OF ONE OF THE TREES.

AN APPROPRIATE RESPONSE TO AN OFFICE ACTION THAT DISMISSES A PATENTABILITY ARGUMENT BASED ON FEATURES RECITED IN THE PREAMBLE (THAT THE CITED ART DOES NOT TEACH OR SUGGEST A PACKET THAT INCLUDES A DESTINATION ADDRESS), MAY BE THE FOLLOWING:

APPLICANT NOTES, AT PAGE 4 OF THE OFFICE ACTION, THE OFFICE’S CONTENTION THAT FEATURES RECITED IN THE PREAMBLE OF CLAIM 1, AND IN PARTICULAR A PACKET “INCLUDING ... A DESTINATION ADDRESS” NEED NOT BE ACCORDED ANY PATENTABLE WEIGHT. THIS CONTENTION

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IS RESPECTFULLY TRAVERSED AS BEING INCORRECT AS A MATTER OF LAW.

IT IS ESTABLISHED LAW THAT WHEN A PREAMBLE OF A CLAIM PROVIDES MORE THAN JUST CONTEXT FOR THE CLAIMED INVENTION, THAT PREAMBLE SHOULD BE GIVEN PATENTABLE WEIGHT. INDEED, WHEN, AS IS THE CASE HERE, THE BODY OF THE CLAIM EXPRESSLY REFERS TO FEATURES IN A PREAMBLE AND USES THOSE REFERENCED FEATURES TO DEFINE THE CLAIMED INVENTION, IT IS LEGAL ERROR NOT TO GIVE THAT PREAMBLE PATENTABLE WEIGHT.

CLAIM 1 RECITES “ASSIGNING ... [ONE TREE] TO BROADCAST A PACKET TO A DESTINATION ADDRESS.” AND, THIS PACKET IS EXPRESSLY DEFINED BY THE CLAIM PREAMBLE TO INCLUDE THAT DESTINATION ADDRESS. THUS, THE BODY OF CLAIM 1 EXPRESSLY INCORPORATES BY REFERENCE THE PREAMBLE FEATURE OF A PACKET THAT INCLUDES A DESTINATION ADDRESS. IN THIS WAY, THE BODY OF THE CLAIM DEPENDS ON THE PREAMBLE FOR COMPLETENESS AND GIVES LIFE, MEANING, AND VITALITY TO THIS CLAIM. FOR THIS REASON ALONE, THE PREAMBLE OF CLAIM 1 SHOULD BE AFFORDED PATENTABLE WEIGHT. SEE MPEP 2112.02(II).

THE PREAMBLE OF CLAIM 1, HOWEVER, SHOULD BE AFFORDED PATENTABLE WEIGHT FOR ANOTHER REASON. THE MPEP INSTRUCTS THAT PREAMBLES THAT LIMIT STRUCTURE MUST BE GIVEN PATENTABLE WEIGHT. (SEE MPEP 2112.02(I)). THE INCORPORATION BY REFERENCE OF THE PREAMBLE FEATURE OF A PACKET “INCLUDING ... A DESTINATION ADDRESS” DEFINES A PACKET THAT HAS A DATA STRUCTURE NOT FOUND IN THE APPLIED ART. THUS, THE PREAMBLE OF CLAIM 1 MUST BE GIVEN PATENTABLE WEIGHT.

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