INVENTION ANALYSIS AND CLAIMING: Identifying the Inventive Concept — Consult with Colleagues, Part I[1]

BY RONALD SLUSKY

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There are as many approaches to analyzing inventions as there are practitioners plying this trade. The analysis of virtually any invention can therefore invariably be enhanced by discussing it with a colleague. Inevitably a co-worker will have offer one or more questions or insights that can shed further light on the problem and/or the solution.

This month's column presents some invention-identification ideas that a number of practicing patent attorneys have shared with the author.[2] Their approaches coalesce into a few thematic strands, which echo many of the ideas that appears in this space. We are, after all, all focused on the same goal—answering the patent attorney's quintessential question, *What is the Invention?*

FIRST "SEE" THE INVENTION

One colleague refers to his starting-point process as "seeing" the invention. The paradigm is a powerful one. The notion of seeing the invention implies a mind's eye grasp of an answer to the question *What's Really Going On?*

> Before beginning the claim drafting process, one must first "see" the invention, and not just an embodiment of the invention, although sometimes it is not easy to distinguish between the two. Nonetheless I believe that the key to understanding the invention is to gain a fundamental understanding of the concept(s) *behind* the embodiment(s). By understanding the principle behind the result, the claim drafter should be able to draw a broader claim than otherwise.
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> I usually get there by continuing to ask questions of the inventor, each time stripping away verbally the extra stuff so that I can change the example that had been presented and still have the inventor say, "Yes, that is what I mean." Or, "Yes, that will work also!"
>
> I was trained to always write a problem-solution and a claim. Now I boil the invention down by simply writing a claim that reflects my thought process. But I think that in the back of my mind I have worked through the problem and solution while forming the claim in my mind.

USE THE EUROPEAN ("JEPSON") CLAIM FORMAT AS AN INVENTION ANALYSIS MODEL

Another attorney thinks about the invention in terms of the European, or Jepson-type, claim format at the invention analysis stage, whether or not he ultimately wants to have claims of that type in the patent application. Readers may already be familiar with this format in which the so-called inventive departure is set off from the rest of the claim by a transitional phrase such as "the improvement comprising" or "characterized in that."

Here, for example, is such a claim directed to the idea of keeping the food moving within a microwave oven to solve the problem of non-uniform heating:

> A microwave oven comprising
>
> an oven cavity, and
>
> a microwave energy source for heating food within the cavity,
>
> THE IMPROVEMENT COMPRISING
>
> means for engendering relative motion during the heating process between the food and the microwave energy source.

Such point-of-novelty claiming might not be where you want to end up. However,

> it may be a place that you want to start your thinking process from. It helps one conceptualize what was done before, and what was added or changed by the inventor to solve the problem or yield the improvement. If the improvement is simply stated (just one element), you have a good start on a broad claim. Then, you look at the preamble—the words leading up to "the improvement comprising"—and see if the same improvement works in other environments.

This approach serves as the basis of the inventive-departure-based claiming technique presented in an earlier column.[3]

ENVISION THE MARKETPLACE

Another attorney focuses on the ultimate marketing of the invention and, in so doing, attempts to engage the inventor on his own terms.

> I ask the inventor to envision the marketplace. What would he tout about his invention if he had to actually sell it? Is it, for example, faster than the known alternatives? Lighter? Less expensive? More efficacious? Once he has told me, I ask him to point to what exactly it is in his system or process that makes those advantages possible. We then proceed to sketch out the invention on a piece of paper and refine the picture to a point where it contains only the minimum necessary prior art structure to support the thing that he pointed to. A particular benefit of this approach is that it enables the inventor to supply what the attorney needs within an analytical framework that is natural and routine to the inventor rather than my having to turn

the inventor into a junior patent attorney in the first instance.

IMAGINE YOU ONLY HAVE 60 SECONDS TO DESCRIBE THE INVENTION

Another colleague suggests that distilling the invention down to its essence can often be achieved by asking the question, "What would you say if you had to say it in 60 seconds?"

When I supervised attorneys in a corporate setting, I recommended as follows: "Envision yourself having to explain the invention to a manager who holds the patent filing purse strings. The manager is in a hurry to attend a meeting. Imagine that you have only 60 seconds to describe the invention's novelty while accompanying him to the meeting room door. What would you say in one or two sentences?"

I also strongly urged that any such one- or two-sentence description of the invention should focus on the inventive solution and its benefit. Knowing what the benefit is helps you identify those few things that are necessary to provide that benefit and thus those few things that should be contained in the broadest claim.

Next month: *Writing the Detailed Description.*

ENDNOTES

1.
2. Thanks are due to my colleagues David Tannenbaum, Barry Freedman, Gregory Ranieri and Henry Brendzel for their insights.
3. *Intellectual Property Today*, September, 2008.