

INVENTION ANALYSIS AND CLAIMING: The Summary of the Invention PART II¹



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In a previous column² I explained my preference for a “story-telling” type of Summary of the Invention. This style of Summary presents the invention in narrative form, thereby continuing the problem-solution story that was begun in the Background.

A Summary that effectively explains what the invention is goes a long way toward showing the would-be licensee that he is not being asked to pay something for nothing. Moreover, a patent whose Summary makes the invention clear is less likely to get into litigation because the Opposing Team³ is more likely to agree (at least among themselves) that their product implements the inventor’s teachings. They are also more likely to conclude that a judge and jury will also see it that way.

By contrast, the “claim-restatement” type of Summary is a substantially verbatim reprise of the broadest, and perhaps other, claims. Proponents of the claim-restatement type of Summary have litigation in mind. The concern is that a court may deem one or more embodiment details essential to the invention because they are mentioned in the Summary. The patented subject mat-

ter may then be interpreted as being limited by those details, even when the claims don’t recite them.

We certainly do not want claimed subject matter to be limited by embodiment details contained in the Summary but not contained in the claim being asserted. But we give up a lot by forgoing the advantages that flow from a well-thought-out story-telling type of Summary in order to address a speculative and infrequent litigation contingency.

It is possible, in any event, to address that contingency and still employ the story-telling type of Summary by writing the Summary carefully and thoughtfully, as discussed below.

STATE THE INVENTIVE SOLUTION IN ONE SENTENCE

Whenever possible, the Summary should contain a one-sentence statement of the invention. It should usually be the Summary’s first sentence. Any contextual or terminological antecedents for the inventive solution will have been provided in the Background. This is what allows the inventive solution to be stated in the Summary so directly.

Here are four examples of such Summaries, in which the second sentence closes the problem-solution loop, as discussed below:

In a traffic signal embodying the principles of the invention, the indicia displayed for the first direction of travel are changed automatically in predetermined coordination with changes in the indicia displayed for the second direction of travel. Such automatic changing of the indicia avoids the inconsistencies that can result when the indicia are changed manually.

In accordance with the invention, the non-uniform heating problem is solved by engendering relative motion between the microwave energy source and the food to be heated. In this way, no one portion of the food is maintained in a region of the oven cavity where standing waves are formed, where they would

be heated to a greater degree than would other portions.

In accordance with the invention, light pen locations determined during previous scans are used to predict the location of the pen during the upcoming scan and thus to determine where the scanning patch is to be centered on the screen. This technique allows the patch to be made smaller than in the prior art, substantially decreasing the average time required to identify the new pen location.

In accordance with the invention, each display point is energized to have an intensity proportional to the average intensity of a cluster of cells of the dithered image rather than the intensity of a single dithered image cell, as in the prior art. This has the effect of averaging the brightness of each two-line pair which, in turn, eliminates the flicker.

In some situations, the one-sentence solution is not the Summary’s opening sentence. For example, when the inventor’s contribution to the art includes discovery of something about the problem, or when the inventor has discovered the very existence of the problem or its source, the Summary should begin by explaining that discovery. The one-sentence solution follows that.

PRESENT THE SOLUTION FUNCTIONALLY

The inventive solution should be stated as functionally as possible with a minimum of “hardware” limitations. See the examples above. The opening paragraph(s) of the Summary should specify *what* is done to solve the problem rather than *how* the embodiment happens to pull it off. A Summary that defines the invention principally in apparatus terms is very often narrower than it has to be.

CLOSE THE PROBLEM-SOLUTION LOOP

The Background has laid out a problem and the Summary presents the solution to that problem. How the solution actually solves the problem is sometimes immediately apparent, but not always so. In the latter case, the story-telling function of the Background and Summary is enhanced when the Summary closes out the problem-solution loop by explicitly stating how the inventive steps or structure solve the problem. See the last sentence of each of the Summaries above.

USE THE WORD “INVENTION” CAREFULLY; DESIGNATE OPTIONAL FEATURES AS SUCH

The word “invention” should be used with great care. This is a point that cannot be emphasized often enough or strongly enough. The word “invention” should be used in an unqualified way only when referring to the broad inventive concept. We should not call something “the invention” unless we are willing to have the patent coverage limited to that.

If the Summary says that something is “the invention,” the Opposing Team will argue to the Court that it *is* the invention, regardless of what the claims say, and various reported decisions will back them up.⁴ Broad terms in the claims have been interpreted narrowly because the Summary characterized something as being a part of “the invention.” Indeed, entire claim elements nowhere to be found in a claim have been imported into it based on such a characterization of “the invention” in the specification.

Thus the Summary must make clear that fallback features or other embodiment details that it mentions are only illustrative or optional. There should never be a question about what is absolutely required by the broad invention and what is not.

This is accomplished by appropriate use of appropriate qualifying terms, as in the following examples:

- If, desired, particular embodiments may optionally include step S.
- Element E may be, for example, the particular type of E known as an E1.
- The invention may be used to particular advantage in context C.

Other ideas for constructing an effective story-telling type of Summary will be presented in a future column. Next month’s column, however, returns us to claiming practice with a discussion of a type of claim that is routinely included in patent applications but is rarely taught or talked about—the *definition claim*.

ENDNOTES

1. Copyright © 2007-2008 American Bar Association. Adapted with Permission. All Rights Reserved.
2. *Intellectual Property Today*, November, 2007.
3. The Opposing Team is a metaphor used by the author to refer to potential infringers and their patent attorneys. See *Intellectual Property Today*, October, 2007.
4. See, e.g., *Hoffer v. Microsoft Corp.*, 405 F.3d 1326, 1329, 74 USPQ2d 1481, 1483 (Fed. Cir. 2005).