

INVENTION ANALYSIS AND CLAIMING: Be Detailed Where the Invention Lives¹



BY RONALD SLUSKY

Ronald Slusky mentored dozens of attorneys in “old school” invention analysis and claiming principles over a 31-year career at Bell Laboratories. He is now in private practice in New York City. This article is adapted from his 2007 book “*Invention Analysis and Claiming: A Patent Lawyer’s Guide*.” Upcoming presentations of Ron’s two-day seminar based on the book will be in **Washington D.C.** and **Philadelphia**. Ron also offers the seminar on-premises to law firms and in-house patent departments. See www.sluskyseminars.com Ron can be reached at 212-246-4546 and rdslusky@verizon.net.

How detailed should the Detailed Description be?

An effective rule of thumb is *Be Detailed Where the Invention Lives*. This means that aspects of the embodiment that relate most closely to the inventive concept should be described in the greatest detail. Conversely, aspects of the embodiments that are further removed from the inventive concept can be described in less detail.

Consider the invention of the chair, the assumed original embodiment of which is shown in FIG. 1. Based on the assumed prior art shown in FIG. 2, we may conclude

that the inventive concept is the use of one or more “elongated support members” to hold up the seating platform, leading to a claim such as the following:

**Apparatus comprising
a platform, and
means for supporting the platform
above an underlying surface,
the means for supporting includ-
ing at least one elongated support
member.**

The height of the seat above the supporting surface—about 18 inches, say—is close to where the invention lives because the invention relates to how the seat is supported and the height of the seat is determined by the length of the inventive “elongated support members.” On the other hand, methods for felling trees in order to obtain wood to build a chair is far from where the invention lives and one could feel safe in leaving a discussion of wood-shaping methods out of the specification (assuming the prior art knew some way to carve wood into a desired shape).

We will return to this example momentarily.

The reason for the prescription to be detailed where the invention lives is that details that are closest to where the invention lives are most likely to be details that may need to be relied on to distinguish the invention from invention-irrelevant prior art.

Recall that “invention-irrelevant” prior art is prior art that anticipates a claim, rendering it overbroad, but does not disclose the inventive concept. The words of the claim just happen to read on that prior art.

When cited prior art is invention-irrelevant, there is no need to fall back to a narrower view of the invention by incorporating one of the embodiment’s fallback features into the broadest claims.² What needs to be done instead is to add language to the claim that firms up the invention boundaries that were always intended.³

Upon reviewing the cited invention-irrelevant prior art in light of our inventor’s contribution, it becomes clear soon enough what additional language is needed to firm up the intended invention boundaries. Sometimes that language will define a context to which the invention applies or in which the problem arises. Sometimes it is an operational parameter or a relationship between parameters. Sometimes it is an explicit definition for a term that an examiner might be interpreting more broadly than the claim drafter intended or envisioned. In all these cases, amending the claim to include the additional language does narrow the claim, but only to the extent of better defining the subject matter intended to be encompassed in the first place.

Here’s the catch: The additional limitation(s) need to find support in the specification. Therein lies a dilemma. On the one hand, it is difficult to predict when drafting the original claims just what additional details might be needed; the nature of the invention-irrelevant prior art that may come up during prosecution is unpredictable. On the other hand, it is not cost-effective or practical to disclose every minute detail of every element or method step in the embodiment on the off-chance that any particular one of them might hold the key to firming up the invention boundaries in the face of invention-irrelevant prior art. Choices have to be made in order to meet realities of time and budget.

Being detailed where the invention lives is an effective way of making those choices.

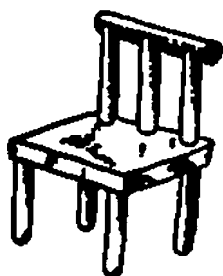


FIG. 1 — The First Chair

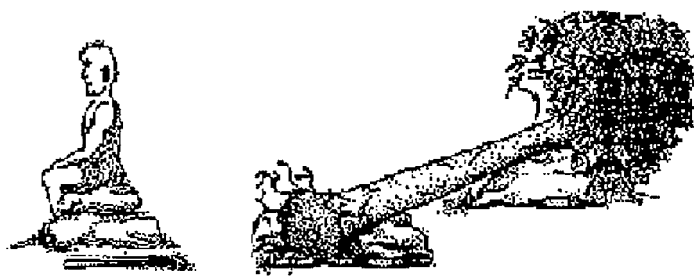


FIG. 2 — Chair Prior Art

Returning now to our chair example, an illustrative height of the seat above the supporting surface may seem like an irrelevant detail not even worthy of mention. After all, one might think, if the invention is that the support members are “elongated,” who cares how high they position the seat?

Such a detail could save the day, however, if prior art that comes to light after the patent application is filed discloses a standard-height table—this being prior art that anticipates the above claim. The claim could then be amended to recite the seat height—an arguably non-obvious distinction.

The author was once called upon to study a patent whose claims referred to a “stripe.” The file history showed that the examiner was able to read the claims on

invention-irrelevant prior art by interpreting the term “stripe” very broadly. The prior art’s “stripe” was quite different from what the patent applicant had in mind. It would not have given up any significant invention coverage to amend the claim to include a geometrical definition of the kind of “stripe” that would be appropriate to solve the problem the invention was directed to.

Unfortunately, the specification nowhere defined what the inventor meant by “stripe” and there was therefore no support for such an amendment. Indeed, the attorney had a great deal of trouble getting the patent application allowed.

Adherence to the prescription *Be Specific Where the Invention Lives* would have cer-

tainly helped in this case. A term used in a claim is not just *close* to where the invention lives. It is at the very *heart* of where the invention lives. Following this prescription would therefore have led the claim drafter to present as full a discussion as could be mustered in the specification about what was intended to be meant by the claim term “stripe” in the context of the invention at hand. **IPT**

ENDNOTES

1. Copyright © 2007, 2009 American Bar Association. Adapted with Permission. All Rights Reserved.
2. *Intellectual Property Today*, June, 2007.
3. *Intellectual Property Today*, May, 2008.

Yes, You Can Use Copyrighted Material in Your Open Courseware

New Code of Best Practices Addresses Newest Twist on Copyright Confusion in Higher Education

OpenCourseWare, the Web-based publication of academic course content launched in 2002 by the **Massachusetts Institute of Technology** (MIT) has been lauded for making college-level courses available to anyone anywhere in the world for free. The movement has expanded to include offerings from some of the nation’s most selective universities including the University of Notre Dame and Yale University.

Open Courseware has presented a new twist on the issue of using copyrighted materials in the classroom as syllabi, lecture notes, power-point presentations, exams, audio and video used to teach a course are not limited to students in a physical classroom, but virtually broadcast via the Internet around the world. Does a professor of an open courseware biology course need to worry about copyright infringement if she wants to use an illustration of a heart that originally appeared in a text book as part of her course materials? What about a music professor who during video-taped class lectures plays audio clips of different recordings of Beethoven’s symphonies?

Now, educational organizations have a guide that simplifies the legalities of using copyrighted materials in open courseware—The Code of Best Practices in Fair Use for OpenCourseWare. The code was developed by experts in media and fair use at American University and a committee of practitioners of open courseware from Johns Hopkins Bloomberg School of Public Health, MIT, Tufts University, University of Michigan, University of Notre Dame, and Yale University.

To read the full code, go to <http://www.centerforsocialmedia.org/ocw>.

The code aims to help OCW designers at U.S. educational organizations recognize situations to which fair use applies and situations that require they get permission from third-party rights holders.

“This is an important moment for OCW,” said Lindsey Weeramuni, intellectual property supervisor for MIT OpenCourseWare, who led the code’s production. “It gives us an additional tool we can use to publish high quality course materials while still respecting the rights of content owners.”

“The advantage of this code of best practices is that the professors and OCW staff can have confidence that they’re making the right decisions on their own,” said Patricia Aufderheide, director of American University’s Center for Social Media.

Renowned for coordinating codes of best practices in fair use—most recently for user-generated content and media literacy education—Aufderheide and Peter Jaszi of AU’s Program on Information Justice and Intellectual Property assisted the Committee of Practitioners with drafting the code.

The number of higher education institutions and associated organizations around the world that offer OCW has grown to more than 200 since MIT launched it seven years ago.

“It’s exciting to see the best-practices model extend into the open courseware community,” said Peter Jaszi. “Having seen profound market effects in our other work with creator and user communities, we expect to see this greatly improve the opportunities for open courseware makers.”

Located in Washington, D.C., American University is a leader in global education, enrolling a diverse student body from throughout the United States and more than 150 countries. The university provides opportunities for academic excellence, public service, and internships in the nation’s capital and around the world.