

INVENTION ANALYSIS AND CLAIMING: “Incomplete” Claims¹



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Depending on my mood, I am amused, frustrated or angered when an examiner rejects a claim under 35 USC 112, ¶2 as being in *her* view “incomplete” while at the same time reproducing ¶2’s provision that a claim should set forth that which the *applicant* regards as the invention.

So it was in an Office action I received recently. All claims were rejected under 35 USC 112, ¶2, as being “incomplete for omitting essential elements.” According to the examiner, my broad claims to the device A+B+C needed to further recite the disclosed, but unclaimed, features D and E because “it is unclear how the claimed device could function as intended without” those features.

This is an improper ground of rejection.

WHERE WOULD IT ALL END?

Claims are not intended or required to *teach* anything. A claim passes muster under 35 USC 112, ¶2 so long as a) it has a meaning that is discernible to one of ordinary skill in the art and b) so long as the applicant has not otherwise indicated, e.g., during prosecution or in the specification

itself, that the claim does not correspond with that which applicant regards as the invention.² Teaching is the realm of the *specification*, per section 112, ¶1, not the realm of the claims. It is thus irrelevant that a claim does not recite all the piece parts or method steps that might be seen as “essential” to implement a working device or process.

Indeed, if it were proper for an examiner to require a claim to include a particular element because she deems it to be “essential” and/or because the claimed subject matter could not “function as intended” without that element, where would it all end? A claim directed to a self-propelled missile with an improved wing profile could be required to affirmatively recite, for example, “a quantity of fuel.” Or a launcher. Or myriad other things without which the missile could not “function as intended.” Does that mean that a claim directed to a missile with the novel wing profile must recite all those other elements?

Or consider a novel electrical transformer intended for use on a utility pole. Such a device cannot “function as intended,” without benefit of an electric power plant, cables to bring the electrical energy from the power plant to the transformer, and some means to affix the transformer to the utility pole. Does that mean that all those other elements must be recited?

The answer in both cases is, of course, “no.” The line between that which is essential to the claimed invention and that which is not is a line to be drawn by the applicant, not the examiner.

THE ANTICIPATED ENFORCEMENT SCENARIO

The anticipated enforcement scenario makes this issue one of no small moment; even a single seemingly innocuous extra limitation can turn what would have been an extremely valuable claim into just so many words on a piece of paper.

Of course, any “extra” limitation has the potential to create a infringement loophole that allows competitors to design around a claim while appropriating the essence of the inventors’ teaching.

But what is less often thought about is the question of who will be the direct infringer.

In our self-propelled missile example, for instance, one might think that there is no great harm in including an “essential” element such as “a quantity of fuel” if an examiner were to require it. After all, a self-propelled missile needs fuel in order to operate, as a practical matter, so what’s the problem?

The answer is that when a copy-cat competitor delivers its missiles to its customer—say, the U.S. government—the missiles are not likely to be pre-fueled, nor delivered with a launcher, nor with any number of other elements that are “essential” for the missile to “function as intended.” Thus if the patent’s claims were to affirmatively recite such elements, competitors using the novel wing profile would, at best, be no more than contributory infringers or inducers.

This is a problem because a case of indirect infringement (i.e., inducement or contributory infringement) is, at best, a more complicated case to prove than one of direct infringement. And at worst, it may be impossible to establish the scienter or other proof elements that indirect infringement require.³

Yes, we might find direct infringement on the part of the end-user—one who actually causes the inventive device to “function as intended.” But asserting a patent against such direct infringers may not be a practical option. In the case of a consumer product, for example, the direct infringers may easily number in the tens of millions. Go find and sue them all. And even if the direct infringers are relatively few in number, they may be customers of the patent owner. For example, the patent owner may be a manufacturer of a broad line of telecommunications equipment and the direct infringer may be a telephone company that has purchased a particular infringing piece of equipment from a competitor of the patent owner. Suing one’s own customers is not the best way to engender good will for future sales.

AND WHAT’S “ESSENTIAL” ANYWAY?

And who’s to say, in any event, that any particular detail *is* required in order for a disclosed inventive combination of elements to “function as intended?” New ways of implementing desired functionalities are invented every day, and there is no basis in

the law for saying that having made a broad invention, applicants need to restrict their claims to include disclosed implementational details, even if those details are only way applicants have disclosed for carrying out a practical embodiment.

In short, having have fulfilled their obligation to provide an enabling *disclosure*, applicants are entitled to *claims* that are as broad as the prior art (and the “written description” requirement) allow for, just so long as the claims’ meaning and scope are clear and just so long as they set forth that which the *applicant*, not the *examiner*, regards as the invention.

ENDNOTES

1. Copyright © 2010 Ronald D. Slusky. All Rights Reserved.
2. See MPEP §§2172-2173 and the cases cited therein.
3. 35 USC 271 (b)-(c)