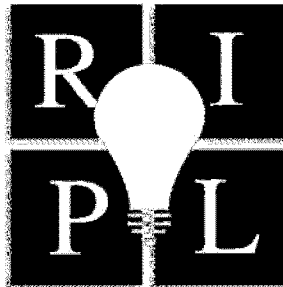


# THE JOHN MARSHALL REVIEW OF INTELLECTUAL PROPERTY LAW



## CLAIM PREAMBLES AND THE UNASSAILABLE PATENT CLAIM

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### ABSTRACT

In order to diminish the extensive confusion surrounding claim preambles, one must not consider what a preamble should do; rather, it is helpful to consider what a preamble should not do. Traditionally, a preamble is defined as an introduction to a statute or deed stating the document's basis, purpose, aim, justification, and objective. However, in patents, a claim preamble does not serve this purpose. While a preamble undeniably functions as an introduction to the rest of the claim, that claim is limited in scope and therefore, so too, is the preamble. The basis, purpose, aim, justification, and objective of the invention are properly contained elsewhere in the specification, not in the claim. Indeed it is the role of the specification, not the claim preamble, to shed light on the claim terms; to describe how to make and use the invention and to disclose the best mode contemplated for its use. None of this is within the purview of the claim, or its preamble, whose purpose is solely to highlight those novel and patentable aspects of an invention. Strengthened by this knowledge, the conscientious claim drafter will realize that while a carelessly worded preamble can be a liability, a well constructed preamble can be a powerful asset.

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## CLAIM PREAMBLES AND THE UNASSAILABLE PATENT CLAIM

KYLE PETAJA\*

### INTRODUCTION

The art of war teaches us to rely not on the likelihood of the enemy's not coming, but on our own readiness to receive him; not on the chance of his not attacking, but rather on the fact that we have made our position unassailable.<sup>1</sup>

It is the responsibility of the claim drafter to provide his client with an unassailable patent. This responsibility does not stop once a patent has been issued, but continues throughout the entire life of the patent. A well written patent has a more profound impact on the future of that patent than the most talented litigator could dare dream. A patent that clearly describes the attributes of an invention can defeat interference or infringement actions before they reach the courtroom.

In order to make a patent unassailable, a practitioner must give the claim preamble the attention it deserves. While the claim preamble may be incorrectly dismissed as a mere formality, willful ignorance of the power it has over the claim is foolish. A carelessly drafted claim preamble may give rise to unanticipated claim interpretation issues during patent prosecution, litigation, or interference proceedings. A well structured claim preamble, on the other hand, can help avoid or minimize these costly proceedings.

The rules governing the claim preamble's role in claim interpretation has long been a source of confusion.<sup>2</sup> Determining when and to what extent the claim preamble affects the scope of the claim has been a subject of debate for many years.<sup>3</sup> The lack of a definition of the claim preamble in any statute, rule, or even the Manual of Patent Examining Procedure ("MPEP") has led to a series of "opaque" and "perplexing" court decisions.<sup>4</sup> Magnifying this state of confusion are countless court decisions wherein the court fails to clearly explain the rationale behind its ruling.<sup>5</sup>

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<sup>1</sup> SUN TZU, *THE ART OF WAR* 39 (James Clavell ed., 1983).

<sup>2</sup> *Bell Commc'ns Research v. Vitalink Commc'ns Corp.*, 55 F.3d 615, 620 (Fed. Cir. 1995). "Much ink has, of course, been consumed in debates regarding when and to what extent claim preambles limit the scope of the claims in which they appear." *Id.*

<sup>3</sup> See Willis Higgins, *The Significance of Preambles in Chemical Composition Claims*, 49 J. PAT. OFF. SOC'Y 337, 337 (1967); Vincent Millin, *PTO Practice: Preamble—Prelude to Patentability*, 72 J. PAT. & TRADEMARK OFF. SOC'Y 348, 348 (1990); Alton D. Rollins, *Is It New or Not?*, 68 J. PAT. & TRADEMARK OFF. SOC'Y 89, 89 (1986).

<sup>4</sup> See James F. McKeown, *Claim Drafting Strategies Revisited—How Much, If Any, Preamble Is Necessary?*, INTELL. PROP. TODAY, Apr. 2004, at 21; see Patrick J. Flimm, *Claim Construction Trends in The Federal Circuit*, in PATENT LITIGATION Sept./Oct./Nov. 1999, at 317, 335–36 (PLI

This comment focuses on interpretation of claim preambles and the difficulties which courts, as well as practitioners, confront when determining the effect claim preambles have on claims. The background section explores the relevant principles and doctrines that currently guide a court's interpretation of a claim's preamble. The analysis section, through in-depth examination of influential case law and scholarly comments, simplifies these previously complex principles. The next section develops a proposal for alleviating this uncertainty through reforms in the methodology practitioners traditionally take in their approach to drafting claim preambles. The final section concludes with a summarization of significant points.

## I. BACKGROUND

The claim preamble has humble beginnings and a tumultuous history. Present day treatment of a claim's preamble evolved out of a series of court decisions that have gradually intertwined themselves into an almost indecipherable mess. This section outlines the basics of claim construction, as it relates to preambles, and identifies the typical scope of a claim preamble versus a traditional preamble.

While defining the function of a claim preamble is extremely difficult, recognizing the claim preamble is relatively simple. The vast majority of patent claims are composed using a three section format.<sup>6</sup> The first section is a claim preamble, which sets out the context of the invention, or explains the type of invention being claimed.<sup>7</sup> The second section is a transition, which often uses forms of the words "comprise" or "consist" in order to introduce the formal elements of the claim.<sup>8</sup> The transition connects the claim preamble to the claim body, and defines how the subsequent elements are to be interpreted.<sup>9</sup> The third section is the body, which includes one or more elements, also known as "limitations," that define the scope of the claim.<sup>10</sup> Those elements that define the invention are recited in a body of the claim.<sup>11</sup>

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Pats., Copyrights, Trademarks, & Literary Prop. Course, Handbook Ser. No. 572, 1999), *available at* WL 572 PLI/PAT 317 (stating that the manner in which claim preambles are currently examined for limitations to be "opaque"); Higgins, *supra* note 3, at 337 (referring to how one determines the extent to which a claim's preamble can be a limitation on a patent as "one of the most perplexing questions in patent law"); *see also* Stephen P. Koch, *Recent Developments in Patent Law*, 11 TEX. INTELL. PROP. L.J. 117, 118 (2002) ("[C]ourts and commentators have generally concluded that there is neither a simple solution nor a litmus test for the claim preamble interpretation question . . .").

<sup>5</sup> Indeed the vast majority of cases involving the interpretation of a claim's preamble are structured the same way. A court will initially recite several broad principles it uses to govern the interpretation of claim preambles. Then the court will produce a holding that somehow incorporates key language from each of the earlier principles without a clear explanation of how it arrived to the end from the beginning.

<sup>6</sup> Report of the Patent Litigation Committee of the American Intellectual Property Law Association, *The Interpretation of Patent Claims*, 32 AIPLA Q.J. 1, 13 (2004).

<sup>7</sup> *Id.* at 13–17.

<sup>8</sup> *Id.* at 13.

<sup>9</sup> *Id.* at 13, 18–20.

<sup>10</sup> *Id.* at 13–14, 20–23.

<sup>11</sup> Thomas D. Brainard, *Patent Claim Construction: A Graphic Look*, 82 J. PAT. & TRADEMARK OFF. SOC'Y 670, 676 (2000).

The dictionary defines a traditional preamble as an introduction to a statute or deed stating its purpose, aims, justifications, bases, and objectives.<sup>12</sup> A common definition of a claim preamble is “an introductory phrase that may summarize the invention, its relation to the prior art, or its intended use or properties.”<sup>13</sup> Claim preambles typically supply the background and contextual information in a patent claim, such as the basic class of the invention, e.g., composition, apparatus, or method.<sup>14</sup> While the claim preamble typically contains basic background and contextual information relevant to the patent claim, the preamble generally does not add anything to the public notice function of a claim.<sup>15</sup> The claim preamble, therefore, does not normally limit the scope of the claim.<sup>16</sup>

The extent of a claim preamble’s limitation on the entire claim, if any, is examined by the United States Patent and Trademark Office (“USPTO”) on a case-by-case basis.<sup>17</sup> Before a court can determine the limiting effect of a claim preamble, the entire patent must be reviewed in order “to gain an understanding of what the inventors actually invented and intended to encompass by the claim.”<sup>18</sup> The facts of each case help determine the extent of the limitation.<sup>19</sup> Specifically, in order to determine what invention the patentee intended to define and protect, courts explore the overall form of the claim elements, the invention as described in the patent specification, and the invention as defined in the prosecution history.<sup>20</sup> The

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<sup>12</sup> BLACK’S LAW DICTIONARY 1194 (7th ed. 2000); THE NEW OXFORD AMERICAN DICTIONARY 1340 (2001 ed.).

<sup>13</sup> See 3-8 DONALD S. CHISUM, CHISUM ON PATENTS § 8.06(1)(b)(i) (2004).

<sup>14</sup> Patent Litigation Committee of the American Intellectual Property Law Association, *supra* note 6, at 14; McKeown, *supra* note 4, at 21.

<sup>15</sup> See *ADE Corp. v. KLA-Tencor Corp.*, 220 F. Supp. 2d 303, 310 (D. Del. 2002). The court noted that the claim preamble added nothing to the public notice function of the claim by merely stating an intended use of the invention. *Id.* See generally WILLIAM H. FRANCIS & ROBERT C. COLLINS, CASES AND MATERIALS ON PATENT LAW 81 (5th ed. 2002). Issuing a patent accomplishes three goals: (1) it rewards the inventor for his invention; (2) it stimulates him, as well as the public, to make similar efforts in the same or similar manner; and (3) it gives to the public knowledge of the character and scope of the invention (public notice) as well as unrestricted access to it upon expiration of the patent. *Id.*

<sup>16</sup> *ADE Corp.*, 220 F. Supp. 2d at 310; Patent Litigation Committee of the American Intellectual Property Law Association, *supra* note 6, at 14

<sup>17</sup> McKeown, *supra* note 4, at 22.

<sup>18</sup> *Corning Glass Works v. Sumitomo Elec. U.S., Inc.*, 868 F.2d 1251, 1257 (Fed. Cir. 1989); see also *Applied Materials v. Advanced Semiconductor Materials Am.*, 98 F.3d 1563, 1573 (Fed. Cir. 1996); *Bristol-Myers*, 86 F. Supp. 2d at 450.

<sup>19</sup> *In re Paulsen*, 30 F.3d 1475, 1479 (Fed. Cir. 1994) (finding that the presence of the ambiguous word ‘computer’ in the preamble lead to the examination of the “patent as a whole”). “Whether a preamble stating the purpose and context of the invention constitutes a limitation of the claimed process is determined on the facts of each case in light of the overall form of the claim, and the invention as described in the specification and illuminated in the prosecution history.” *Applied Materials Inc. v. Advanced Semiconductor Materials Am. Inc.*, 98 F.3d 1563, 1572–73 (Fed. Cir. 1996); see *In re Stencel*, 828 F.2d 751, 754 (Fed. Cir. 1987) (stating that the claim preamble is interpreted in light of the invention as a whole); *Perkin-Elmer Corp. v. Computervision Corp.*, 732 F.2d 888, 896 (Fed. Cir. 1984) (holding that the limitations stated in the claim preamble give meaning to the claim and can serve to define the invention).

<sup>20</sup> *Bell Commc’ns Research v. Vitalink Commc’ns Corp.*, 55 F.3d 615, 621 (Fed. Cir. 1995) (looking to patent specification to determine whether claimed invention includes preamble recitations); *Vaupel Textilmaschinen KG v. Meccanica Euro Italia SPA*, 944 F.2d 870, 880 (Fed. Cir. 1991) (looking to the claims, specification, prosecution history and drawings of the patent in order to

importance of a complete review is commonly overlooked. Language employed by an inventor patenting a unique invention acquires a whole new level of complexity upon consideration of a person having ordinary skill in the art.<sup>21</sup>

A verbose claim preamble increases the risk of being adversely construed by a court as the claim preamble may include subject matter not intended to be a part of the invention. Such statements may be interpreted as a claim limitation not contemplated by the patentee.<sup>22</sup> Therefore, claim drafters must be vigilant when writing claim preambles in order to prevent unintentionally inserting structural or functional language.<sup>23</sup> If particular language contained in the claim preamble is an integral part of the claim, it is almost certainly safest to simply move such language to the body of the claim.<sup>24</sup> By not doing so, claim drafters place their clients at risk of spending considerable sums of money during *Markman* proceedings in which the claim drafters themselves will be called upon to explain how and why such language found its way into the claim preamble.<sup>25</sup>

## II. ANALYSIS

While there are many court decisions focusing, at least in part, on the importance of a claim's preamble, the issue of how the preamble should be analyzed for potential limitations is still far from clear.<sup>26</sup> This section identifies the sources of this difficulty, and separates the attributes of a limiting claim preamble from those of a non-limiting claim preamble.

The repeated use of overly broad statements by courts makes it much more difficult for other courts to consistently interpret claim preamble language. One such expansive standard is: after having read the claim preamble, is the reader's attention

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define the invention.); *Corning Glass*, 868 F.2d at 1257 (considering the specification's statement of the problem with the prior art to limit the claim); *Kropa v. Robie*, 187 F.2d 150, 152 (C.C.P.A. 1951) (noting that claim preamble sets out distinct relationship among remaining claim elements); *Rowe v. Dror*, 112 F.3d 473, 479 (Fed. Cir. 1997) (noting that the appellant's specification evidenced a particular and distinct structural meaning for "balloon angioplasty," which was contained in the claim preamble, distinguishing it from "balloon catheters" generally).

<sup>21</sup> *Kropa v. Robie*, 187 F.2d 150, 152 (C.C.P.A. 1951) (finding that the claim preamble may be particularly useful in those instances where the article discussed in the claim preamble may contain a problem that confronted prior artisans where the solution was not conceived by or known to them). The nature of the problem and the manner in which it was solved may best be addressed by placing it within the preamble of the claim. *Id.* In this form, the preamble is essential to distinguish the claim or count over the prior art and cannot be overlooked. *Id.*

<sup>22</sup> McKeown, *supra* note 4, at 22.

<sup>23</sup> Inclusion of such language presents the risk of raising "life, vitality, and meaning" issues, which a court called upon to construe all claim limitations may rule on against the applicant. McKeown, *supra* note 4, at 22; see also *Schram Glass Mfg. Co. v. Homer Brooke Glass Co.*, 249 F.2d 228, 232-33 (7th Cir. 1918).

<sup>24</sup> McKeown, *supra* note 4, at 22. If a claim drafter places structural or functional language in a claim preamble he creates the distinct risk of raising a "life, vitality, and meaning" issue which a court may be called upon to construe. McKeown, *supra* note 4, at 22. The court then must decide if the preamble is an integral part of the claim, and therefore a limitation, or merely an introduction placing the invention in its proper context. *Id.*

<sup>25</sup> *Id.*

<sup>26</sup> *Bristol-Myers Squibb Co. v. Immunex Corp.*, 86 F. Supp. 2d 447, 450 (D.N.J. 2000) (stating that certain rules for analyzing claim preambles are somewhat "opaque").

ever drawn back to the claim preamble?<sup>27</sup> In other words, if the body of the claim does not need to be read in light of the claim preamble for one of ordinary skill in the art to understand the elements of the claim and how those elements are interrelated, then the claim preamble should not constitute a limitation.<sup>28</sup> However, this standard is not completely accurate and has become the source of confusion.<sup>29</sup> Several cases have ruled that merely finding something useful in a claim preamble does not alone justify treatment as a limitation.<sup>30</sup>

### A. Situations Where the Claim Preamble Is Limiting

In order to help determine whether a claim preamble serves to limit the scope of a claim, rather than to merely provide background information, courts have established several guideposts.<sup>31</sup> One of these guideposts is the *Jepson* claim, which contains, in the preamble, elements the inventor impliedly admits to be conventional or known.<sup>32</sup> Where a claim preamble incorporates the language of the prior art, such incorporation may indicate reliance on the claim preamble to define the claimed invention's context and also the claim's scope.<sup>33</sup> Use of this form is a clear signal to

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<sup>27</sup> *ADE Corp. v. KLA-Tencor Corp.*, 220 F. Supp. 2d 303, 310 (D. Del. 2002).

<sup>28</sup> *ADE Corp.*, 220 F. Supp. 2d at 310; *Bristol-Myers Squibb Co. v. Immunex Corp.*, 86 F. Supp. 2d 447, 451 (D.N.J. 2000) (finding that the claim preamble phrase need not be referenced to practice the invention set out in the body of the claim because the objectives of toxicity reduction and tumor regression are not “intimately meshed with the ensuing language in the claim”) (quoting *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1306 (Fed. Cir. 1999)); *cf.* *Boehringer Ingelheim Animal Health v. Schering-Plough Corp.*, 984 F. Supp. 239, 247–48 (D.N.J. 1997) (finding that the claim preamble included words necessary to enable the claim and hence constituted a limitation); *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305 (Fed. Cir. 1999) (stating that where “the claim preamble offers no distinct definition of any of the claimed invention's limitations, but rather merely states, for example, the purpose or intended use of the invention, then the preamble is of no significance to claim construction because it cannot be said to constitute or explain a claim limitation”).

<sup>29</sup> *See STX, Inc. v. Brine, Inc.*, 37 F. Supp. 2d 740, 752 (D. Md. 1999).

<sup>30</sup> *Id.*

<sup>31</sup> *Catalina Mktg. Int'l v. Coolsavings.com, Inc.*, 289 F.3d 801, 808 (Fed. Cir. 2002).

<sup>32</sup> U.S. PAT. & TRADEMARK OFFICE, U.S. DEP'T OF COMMERCE, MANUAL OF PATENT EXAMINING PROCEDURE §§ 2129, 608.01(m) (8th ed., 2nd rev. 2004) [hereinafter MPEP]. “Drafting a claim in *Jepson* format . . . is taken as an implied admission that the subject matter of the preamble is the prior art work of another.” *Id.* The manual states that a “preamble of a *Jepson*-type claim to be admitted prior art where applicant's specification credited another as the inventor of the subject matter of the preamble”. *Id.* (citing *In re Fout*, 675 F.2d 297, 301 (C.C.P.A. 1982)); *see also* 37 C.F.R. § 1.75(e) (2004) (stating, in relevant part, “[w]here the nature of the case admits, as in the case of an improvement, any independent claim should contain in the following order: (1) A preamble comprising a general description of all the elements or steps of the claimed combination which are conventional or known”; *In re Fout*, 675 F.2d 297, 301 (C.C.P.A. 1982); *Rowe*, 112 F.3d at 479 (finding “angioplasty” to be a structural limitation of appellant's claim because it is used in the preamble of a “*Jepson*” claim).

<sup>33</sup> *Rowe*, 112 F.3d at 479; *Pentec, Inc., v. Graphic Controls, Corp.*, 776 F.2d 309, 315 (Fed. Cir. 1985). “Although a claim preamble is impliedly admitted to be prior art when a *Jepson* claim is used, . . . the claimed invention consists of the claim preamble in combination with the improvement.” *Pentec, Inc.*, 776 F.2d at 315. “[T]he [*Jepson* form] is to be considered a combination claim. The claim preamble of this form of claim is considered to positively and clearly include all the elements or steps recited therein as a part of the claimed combination.” MPEP, *supra* note 32, § 608.01(m).

the claim interpreter that the applicant intends “to use the preamble to define, in part, the structural elements of [the] invention.”<sup>34</sup>

There are two ways an applicant may rebut the presumption that the *Jepson* form is an admission of the applicant’s intent to use the preamble to define, and hence limit, structural elements of the invention.<sup>35</sup> First, offering a credible reason for employing the *Jepson* format.<sup>36</sup> Second, proving that the material contained in the claim preamble is the patentee’s own work, and is not previously known.<sup>37</sup>

Claim preambles are also limiting when they distinguish the invention from prior art in an attempt to avoid an anticipation rejection.<sup>38</sup> Where the claim preamble is used to avoid anticipation, the claim preamble may constitute a structural limitation.<sup>39</sup> However, a claim preamble may merely express an intended purpose or intended result without constituting a limitation.<sup>40</sup>

Claim preambles may also be limiting when they narrow a claim in order to avoid infringement.<sup>41</sup> Such a situation exists when the invention described in the claim is the patentee’s improvement upon another’s prior invention. The prior invention may have contained a flaw that the original inventor, or any subsequent inventors, either failed to realize or were unable to solve. When an improvement on

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<sup>34</sup> *Rowe*, 112 F.3d at 479; *Epcon Gas Sys., Inc. v. Bauer Compressors, Inc.*, 279 F.3d 1022, 1029 (Fed. Cir. 2002); *In re Fout*, 675 F.2d 297, 301 (C.C.P.A. 1982) (finding that where applicant’s specification credited another as being the inventor of the subject matter in the claim preamble of a *Jepson*-type claim such art was admitted to be prior art).

<sup>35</sup> See MPEP, *supra* note 32, § 2129 (stating that the “implied admission that the subject matter of the preamble is the prior art work of another . . . may be overcome where applicant gives another credible reason for drafting the claim in *Jepson* format”); *In re Ehrreich*, 590 F.2d 902, 909–10 (C.C.P.A. 1979) (finding that because the examiner cited no prior art containing the subject matter of the claim preamble, and applicant explained that the *Jepson* format was used to avoid a double patenting rejection in a co-pending application, the claim preamble was not admitted prior art); *Reading & Bates Constr. Co. v. Baker Energy Res. Corp.*, 748 F.2d 645, 650 (Fed. Cir. 1984) (holding that where the claim preamble of a *Jepson* claim describes applicant’s own work, the preamble may not be used against the remaining claims).

<sup>36</sup> *In re Ehrreich*, 590 F.2d at 909–910.

<sup>37</sup> *Reading & Bates Constr.*, 748 F.2d at 650.

<sup>38</sup> See *Diversitech Corp. v. Century Steps, Inc.*, 850 F.2d 675, 678 (Fed. Cir. 1988). The court found that the preamble to the claim was necessary to give meaning to the claim, and therefore constituted an essential limitation in determining whether the claim was anticipated. *Id.*; see also *Corning Glass Works v. Sumitomo Elec. U.S.A.*, 868 F.2d 1257, 1257 (Fed. Cir. 1989); *CHISUM*, *supra* note 13, § 8.06(1)(d).

<sup>39</sup> *Corning Glass Works v. Sumitomo Elec. U.S.*, 868 F.2d 1251, 1257 (Fed. Cir. 1989). The Federal Circuit held that the district court correctly interpreted the preamble to the claim in a suit—“an optical waveguide”—as a structural limitation on the scope of the claim rather than a statement of purpose. *Id.* By including this limitation in the claim preamble, concerning a doped silica core and a sheath of silica, the claim was not anticipated by a prior art patent which disclosed a doped silica core and a sheath of silica but did not contemplate its use as an optical waveguide even though it could have functioned crudely as one. *Id.*

<sup>40</sup> *Bristol-Myers Squibb Co. v. Ben Venue Labs., Inc.*, 246 F.3d 1368, 1375 (Fed. Cir. 2001) (holding that the phrases were not limiting but merely expressed a purpose and intended result of the recited steps of the method).

<sup>41</sup> *Applied Materials, Inc. v. Advanced Semiconductor Materials Am., Inc.*, 98 F.3d 1563, 1573 (Fed. Cir. 1996) (holding the claim preamble to be limiting because processes entailing the “cold purge” could only solve the problems of prior art when the temperature was below 180 degrees Celsius).



a prior invention is patented, the preamble to that claim may be deemed essential to disclose what is novel, patentable, and distinguishable over the prior inventions.<sup>42</sup>

The claim preamble may also constitute a limitation when obviousness is at issue.<sup>43</sup> Differences in the intended use of an invention and prior art, as stated in the claim preamble, may be used in determining whether the invention is obvious in light of the prior art.<sup>44</sup>

Another guidepost for the interpretation of claim preambles is the use of statements in the claim preamble which are essential to enable the process, machine, manufacture, or composition of matter patented.<sup>45</sup>

If the body of a patent claim fully and intrinsically sets forth the complete invention, including all of its limitations, and the claim preamble offers no distinct definition of any of the claimed invention's limitations, but rather merely states, for example, the purpose or intended use of the invention, then the preamble is of no significance to claim construction because it cannot be said to constitute or explain a claim limitation.<sup>46</sup>

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<sup>42</sup> *Kropa v. Robie*, 187 F.2d 150, 152 (C.C.P.A. 1951). The court notes that there are instances where the claim preamble is “expressly, or by necessary implication, given the effect of a limitation.” *Id.* Such is the case when the invention contains an article containing a problem which confronted prior artisans where a solution was “not conceived by or known to them.” *Id.* Here, an introductory phrase may be deemed essential to point out the invention defined by the claim. *Id.* The claim preamble may be “considered necessary to give life, meaning, and vitality to the claims or counts” by including elements comprising the article, “so as to distinguish the claim or count over the prior art.” *Id.*

<sup>43</sup> *In re Duva*, 387 F.2d 402, 407 (C.C.P.A. 1967). “[R]eference in the preamble of a patent claim to a use or function of the claimed device does not prevent prior art devices having all of the thereafter positively recited structural elements, but perhaps used for a different purpose, from anticipating the claimed structure, or rendering it obvious.” *Plastic Container Corp. v. Cont'l Plastics of Okla., Inc.*, 515 F. Supp. 834, 849 (W.D. Okla. 1981).

<sup>44</sup> CHISUM, *supra* note 13, § 8.06(d)(i)(A). An applicant was rejected on grounds of obviousness. *In re Duva*, 387 F.2d at 405. The Patent Office reasoned that the claim preamble statement “for chemically depositing gold” was a statement of intended use that could be disregarded and that the omission of elements from the Campana bath did not render the applicant's bath patentable. *Id.* at 407. The court reversed. *Id.* at 407. The difference in intended use between Campana and the applicant can be considered in determining whether the cyanide limitations in the applicant's claim are obvious in the light of Campana. *Id.*

<sup>45</sup> *Brystol-Myers Squibb Co. v. Immunex Co.*, 86 F. Supp. 2d 447, 450 (D.N.J. 2000); *see* *Preemption Devices, Inc. v. Minn. Mining & Mfr. Co.*, 732 F.2d 903, 907 (Fed. Cir. 1995).

<sup>46</sup> *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305 (Fed. Cir. 1999); *see also* *Catalina Mktg. Int'l, Inc. v. Coolsavings.com, Inc.*, 229 F.3d 801, 809 (Fed. Cir. 2002). The ADE court found that a claim preamble which read “[a] surface inspection method” clearly indicated what the intended use of the invention was and therefore was not limiting. *ADE Corp. v. KLA-Tencor Corp.*, 220 F. Supp. 2d 303, 310 (D. Del. 2002). “Preamble statements are limiting when necessary to ‘give meaning to the claim’, not when the preamble merely enunciates upon the intended use of the invention.” *Id.* at 320; *see* *C.R. Bard, Inc. v. M3 Sys., Inc.*, 157 F.3d 1340, 1350 (Fed. Cir. 1998) (holding that where “the preamble simply states the intended use or purpose of the invention . . . Such a preamble usually does not limit the scope of the claim unless the preamble provide antecedents for ensuing claim terms and limits the claim accordingly.”).

However, stating novel and unobvious elements of an invention in the claim preamble may help define the invention and therefore have a limiting effect.<sup>47</sup>

One of the only bright-line rules concerning the effect to be given claim preambles is when a claim preamble provides the only antecedent basis for a term appearing later in the claim.<sup>48</sup> Where the claim preamble contains the only antecedent basis for terms used later in the claim body, the claim preamble cannot be ignored.<sup>49</sup> Presence of the antecedent basis for subsequent term or phrase indicates a reliance on both the claim body and the claim preamble to define the invention, and hence limits the claim.<sup>50</sup>

Another guidepost as to when the claim preamble acts as a limitation, is when the preamble language serves to give “life, meaning, and vitality” to the claim.<sup>51</sup> A claim preamble “may entirely fail to supply a necessary element in a combination yet it may so affect the enumerated elements as to give life and meaning and vitality to them, as they appear in the combination,” and therefore serve as a limitation.<sup>52</sup> Stated differently, the claim preamble is a limitation when it is essential to understanding the claim body.<sup>53</sup> This determination is based “on the facts of each case in view of the claimed invention as a whole.”<sup>54</sup>

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<sup>47</sup> McKeown, *supra* note 4, at 21. These novel and unobvious elements may be limiting when stated in the claim preamble through either functional or structural statements. *Id.*

<sup>48</sup> Rapoport v. Dement, 254 F.3d 1053, 1059 (Fed. Cir. 2001). “References throughout the rest of the claim to circuit boards rely upon and derive antecedent basis from this preamble language. Therefore, this preamble definition limits the term ‘circuit boards’ throughout the claim.” *Electro Scientific Indus., Inc. v. Dynamic Details, Inc.*, 307 F.3d 1343, 1348 (Fed. Cir. 2002).

<sup>49</sup> McKeown, *supra* note 4, at 21. “It is those structural features or functional statements that may be later found to be part of the claimed combination and thus a limitation on the scope of the invention when the claim has to be construed by a court.” *Id.*; see also *Bristol-Myers Squibb*, 86 F. Supp. 2d at 451 (stating that one factor in not finding a limitation is where the claim preamble “phrase need not be referenced to practice the invention set out in the body of the claim”); *Bell Commc’ns Research v. Vitalink Commc’ns Corp.*, 55 F.3d 615, 621 (Fed. Cir. 1995); *Gerber Garment Tech., Inc. v. Lectra Sys., Inc.*, 916 F.2d 683, 689 (Fed. Cir. 1990) (noting that the claim preamble recitations provided antecedent basis for terms used in body of claim).

<sup>50</sup> *Bell Commc’ns Research, Inc. v. Vitalink Commc’ns Corp.*, 55 F.3d 615, 620 (Fed. Cir. 1995) (“When the claim drafter chooses to use both the preamble and the body to define the subject matter of the claimed invention, the invention so defined, and not some other, is the one the patent protects.”).

<sup>51</sup> *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305 (Fed. Cir. 1999); *Kropa v. Robie*, 187 F.2d 150, 152 (C.C.P.A. 1951); *Bristol-Myers Squibb Co.*, 86 F. Supp. 2d at 451 (stating that “[w]here the claim preamble ‘is necessary to give life, meaning, and vitality to the claim’ or is ‘essential to point out the invention defined by the claim,’ it should be construed as a claim limitation”); *Boehringer Ingelheim Animal Health v. Schering-Plough Corp.*, 984 F. Supp. 239, 247 (D.N.J. 1997); *Gen. Elec. Co. v. Nintendo Co.*, 179 F.3d 1350, 1361–62 (Fed. Cir. 1999); *Schram Glass Mfg. Co. v. Homer Brooke Glass Co.*, 249 F. 228, 232–33 (7th Cir. 1918) (stating that a claim preamble “may entirely fail to supply a necessary element in a combination, yet it may so affect the enumerated elements as to give life and meaning and vitality to them, as they appear in the combination”); *Allen Eng’g Corp. v. Bartell Indus., Inc.*, 299 F.3d 1336, 1346 (Fed. Cir. 2002).

<sup>52</sup> *Schram Glass Mfg.*, 249 F. at 232–33.

<sup>53</sup> *Catalina Mktg. Int’l Inc. v. Coolsavings.com, Inc.*, 289 F.3d 801, 808 (Fed. Cir. 2002); see also *Pitney Bowes*, 182 F.3d at 1306.

<sup>54</sup> *In re Stencil*, 828 F.2d 751, 754 (Fed. Cir. 1987).

Where words in the claim preamble are necessary to give meaning to the claim and properly define the invention, they may be construed as limiting.<sup>55</sup> Any phrases that help define the invention will be given weight regardless of where it appears in the claim.<sup>56</sup> There are several ways in which the claim preamble may contribute to the definition of a claim and therein constitute a limitation.

Where the claim preamble recites a structure acted on by the elements of the claim body, the USPTO and the courts give effect to that usage.<sup>57</sup> A claim preamble will be a limitation in those situations where a claim's patentability depends on structural limitations contained in the claim preamble.<sup>58</sup> If a claim body depends upon limitations in the claim preamble, the claim preamble limits the claim body.<sup>59</sup> Such limitations in the claim preamble are periodically necessary to give meaning to the claim in addition to properly defining the invention.<sup>60</sup> In such a case, the claim preamble contributes to the definition of the claim.<sup>61</sup>

Likewise, by explaining terms or steps recited in the claim body, the claim preamble contributes to the definition of the claim thereby limiting its scope.<sup>62</sup> Statements distinctly pointing out the process, machine, manufacture, or composition of matter which is patented, and not its advantages, are routinely interpreted as claim limitations.<sup>63</sup> Additionally, the claim preamble may operate as a claim limitation when reciting additional structure or steps underscored as important by

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<sup>55</sup> Gerber Garment Tech., Inc. v. Lectra Sys., Inc., 916 F.2d 683, 688 (Fed. Cir. 1990); Perkin-Elmer Corp. v. Computervision Corp., 732 F.2d 888, 896 (Fed. Cir. 1984); *Allen Eng'g Corp.*, 299 F.3d at 1346; *Pitney Bowes*, 182 F.3d at 1306; *Kropa v. Robie*, 187 F.2d 150, 152 (C.C.P.A. 1951).

<sup>56</sup> *In re Stencel*, 828 F.2d 751, 754 (Fed. Cir. 1987) (stating that the existence of a limitation is a matter to be determined on the facts of each case in view of the claimed invention as a whole); *see, e.g.,* *Loctite Corp. v. Ultraseal Ltd.*, 781 F.2d 861, 866 (Fed. Cir. 1985) (stating that while the term "anaerobic" appears in the preamble of the patent's claims, the term "anaerobic" breathes life and meaning into the claims and, hence, is a necessary limitation to them).

<sup>57</sup> *C.R. Bard*, 157 F.3d at 1350; *Rowe v. Dror*, 112 F.3d 473, 478 (Fed. Cir. 1997) (holding that "[w]here a patentee uses the claim preamble to recite structural limitations of his claimed invention, the PTO and courts give effect to that usage").

<sup>58</sup> *STX, Inc. v. Brine, Inc.*, 37 F. Supp. 2d 740, 752 (D. Md. 1999); *C.R. Bard, Inc. v. M3 Sys., Inc.*, 157 F.3d 1340, 1350 (Fed. Cir. 1998); *Rowe*, 112 F.3d at 478 (holding that "[w]here a patentee uses the claim preamble to recite structural limitations of his claimed invention, the PTO and courts give effect to that usage").

<sup>59</sup> *C.R. Bard*, 157 F.3d at 1350; *see also* *Perkin-Elmer Corp. v. Computervision Corp.*, 732 F.2d 888, 896 (Fed. Cir. 1984) (noting that the limitations appearing in the claim preamble are necessary to give meaning to the claim and properly define the invention).

<sup>60</sup> *C.R. Bard*, 157 F.3d at 1350.

<sup>61</sup> *Id.* Claim preamble contributes to the definition of the claim because it recites a structure that is acted on by the elements of the apparatus claim. *Id.*

The shank is defined in the preamble as that portion of the hanger "between the supporting hook for the hanger and the support for the garment." This is not merely a suggested use or "clarifying language," as London argues, but rather a limitation supported by structure which *must be satisfied by Samsonite's clamp*, either literally or equivalently[,] if infringement is to be found.

*London v. Carson Pirie Scott & Co.*, 946 F.2d 1534, 1539 (Fed. Cir. 1991).

<sup>62</sup> *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305 (Fed. Cir. 1999) (finding that a claim preamble "cannot be said to constitute or *explain* a claim limitation" where the "*body* of a patent claim fully and intrinsically sets forth the complete invention, including all of its limitations") (emphasis in original).

<sup>63</sup> *See* *Preemption Devices, Inc. v. Minn. Mining & Mfg. Co.*, 732 F.2d 903, 907 (Fed. Cir. 1984).

the specification.<sup>64</sup> A structure or step in the claim preamble that is highlighted by the patent specification may signal that the claim preamble is a claim limitation.<sup>65</sup>

Prosecution history is another guidepost relied on by the courts.<sup>66</sup> “Clear reliance on the preamble during prosecution to distinguish the claimed invention from the prior art transforms the preamble into a claim limitation because such reliance indicates the use of the preamble to define, in part, the claimed invention.”<sup>67</sup> Clear reliance on the claim preamble during reexamination may also lead to the claim preamble being held as a limitation.<sup>68</sup> Also, by acquiescing to an examiner’s treatment of a claim preamble as a limitation, the patentee impliedly accepts it as such.<sup>69</sup>

### *B. Situations Where the Claim Preamble Is Not Limiting*

As we have already established, claim preambles may be limiting when they narrow a claim in order to avoid infringement.<sup>70</sup> However, this rule does not apply when a claim body completely defines an invention without having to rely on the claim preamble.<sup>71</sup> Therefore, when a claim preamble states a purpose or intended

<sup>64</sup> *Corning Glass Works v. Sumitomo Elec. U.S., Inc.*, 868 F.2d 1251, 1257 (Fed. Cir. 1989) (limiting claim scope to “optical waveguides” rather than all optical fibers in light of specification); *see also* *Gen. Elec. Co. v. Nintendo Co.*, 179 F.3d 1350, 1361–62 (Fed. Cir. 1999); *Rowe v. Dror*, 112 F.3d 473, 479–80 (Fed. Cir. 1997); *Applied Materials v. Advanced Semiconductor Materials Am.*, 98 F.3d 1563, 1573 (Fed. Cir. 1996).

<sup>65</sup> *Catalina Mktg. Int’l v. Coolsavings.com, Inc.*, 289 F.3d 801, 808 (Fed. Cir. 2002); *Corning Glass*, 868 F.2d at 1257 (limiting claim scope to “optical waveguides” rather than all optical fibers in light of specification); *Gen. Elec. Co.*, 179 F.3d at 1361–62 (holding that the claim preamble clearly limited the claim scope to a “raster scanned display device” rather than all display systems in view of specification’s focus on the prior art problem of displaying binary data on a raster scan display device); *Rowe*, 112 F.3d at 479–80; *Applied Materials*, 98 F.3d at 1573.

<sup>66</sup> *Catalina Mktg. Int’l v. Coolsavings.com, Inc.*, 289 F.3d 801, 808 (Fed. Cir. 2002); *Pitney Bowes*, 182 F.3d at 1309.

<sup>67</sup> *Catalina Mktg.*, 289 F.3d at 808; *see Applied Materials*, 98 F.3d at 1572–73 (Fed. Cir. 1996). “Whether a preamble stating the purpose and context of the invention constitutes a limitation of the claimed process is determined on the facts of each case in light of the overall form of the claim, and the invention as described in the specification and illuminated in the prosecution history.” *Applied Materials*, 98 F.3d at 1572–73.

<sup>68</sup> *In re Cruciferous Sprout Litig.*, 301 F.3d 1343, 1347–48 (Fed. Cir. 2002) (explaining that patentee’s argument during reexamination demonstrated “clear reliance by the patentee on the preamble to persuade the . . . Patent Office that the claimed invention is not anticipated by the prior art . . . as such, the preamble is a limitation of the claims”).

<sup>69</sup> *Fantasy Sports Props., Inc. v. Sportsline.com, Inc.*, 287 F.3d 1108, 1115 (Fed. Cir. 2002). “The prosecution history demonstrates that the examiner treated all of the claims in [the patent owner’s] application as containing the ‘computer’ limitation in order to comply with the written description requirement of 35 U.S.C. § 112, and [the patent owner] acquiesced in that treatment.” *Id.* at 1118.

<sup>70</sup> *Applied Materials*, 98 F.3d at 1573.

<sup>71</sup> *Marston v. J.C. Penney Co.*, 353 F.2d 976, 986 (4th Cir. 1965). “If the preamble merely states a purpose or intended use and the remainder of the claim completely defines the invention independent of the preamble, it is not a limitation on the claims.” *Id.* The court further noted that:

On the other hand, if the claim cannot be read independently of the preamble and the preamble must be read to give meaning to the claim or is essential to point out the invention, it constitutes a limitation upon the claim. . . . In the present case

use, the claim preamble should not be held as a limitation on the claim. Such is the case where “the [claim] preamble does not describe a unique article to which the claim alone is referable . . . and the [claim] preamble is not essential to a reading and understanding of the claim.”<sup>72</sup> The claim preamble does not result in a limitation if “the portion of the claims following the [claim] preamble is a self-contained description of the invention”.<sup>73</sup>

Claim preambles that describe the intended use or objective of an invention typically do not limit a claim because “the patentability of apparatus or composition claims depends on the claimed structure, not the use or purpose of that structure.”<sup>74</sup> Therefore a claim preamble does not necessarily limit the scope of the claims if it merely praises the features or benefits of a claimed invention.<sup>75</sup> However, a claim limitation exists if those benefits or features are relied upon as the basis for patentability.<sup>76</sup>

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the preamble does not describe a unique article to which the claim alone is referable . . . and the preamble is not essential to a reading and understanding of the claim. The invention arises from the combination and arrangement of the various elements described in the claims and the portion of the claims following the preamble is a self-contained description of the invention.

*Id.*

<sup>72</sup> *Id.*

<sup>73</sup> *Id.*; *Kropa v. Robie*, 187 F.2d 150, 152 (C.C.P.A. 1951) (indicating that the claim preamble would be permitted to limit a claim where it “was deemed essential to point out the invention defined by the claim”); *IMS Tech. Inc. v. Haas Automation Inc.*, 206 F.3d 1422, 1434 (Fed. Cir. 2000) (holding that a claim preamble phrase in a patent’s claim was merely “a descriptive name to the set of limitations in the body of the claim that completely set forth the invention”).

<sup>74</sup> *Catalina Mktg. Int’l v. Coolsavings.com, Inc.*, 289 F.3d 801, 809 (Fed. Cir. 2002); *Depuy Orthopaedics, Inc. v. Androphy*, No. 99–C–0068, 2000 U.S. Dist. LEXIS 661 at \*47 (N.D. Ill. Jan. 19, 2000) (finding that language in a claim preamble is not a limitation because it merely describes a purpose or intended use of the invention claimed).

The court cannot transform a statement of objective into a structural limitation . . . Here the preamble phrase need not be referenced to practice the invention set out in the body of the claim . . . The objectives of toxicity reduction and tumor regression are not “intimately meshed with the ensuing language in the claim.”

*Bristol-Myers Squibb Co. v. Immunex Corp.*, 86 F. Supp. 2d 447, 451 (D.N.J. 2000); *see also* *Purdue Pharma L.P. v. Boehringer Ingelheim GmbH*, 98 F. Supp. 2d 362, 377 (S.D.N.Y. 2000), *aff’d*, 237 F.3d 1359 (Fed. Cir. 2001) (holding that claim preambles “do not state an independent limitation of the claimed inventions but merely set forth an intended use or benefit of the . . . formulations set forth in the claims”). *But see In re Gardiner*, 171 F.2d 313, 315–16 (C.C.P.A. 1948). “It is trite to state that the patentability of apparatus claims must be shown in the structure claimed and not merely upon a use, function, or result thereof.” *Id.*

<sup>75</sup> *Catalina Mktg.*, 289 F.3d at 809. “Thus, preamble language merely extolling benefits or features of the claimed invention does not limit the claim scope without clear reliance on those benefits or features as patentably significant.” *Id.*; *see also* *STX, L.L.C. v. Brine, Inc.*, 211 F.3d 588, 591 (Fed. Cir. 2000) (finding that a claim preamble stating that the invention provides “improved playing and handling characteristics” is not a limitation); *Bristol-Myers Squibb Co. v. Ben Venue Labs., Inc.*, 246 F.3d 1368, 1375 (Fed. Cir. 2001) (finding that the steps of claimed method are performed the same way regardless of whether, as stated in the claim preamble, a reduction of hematologic toxicity occurs).

<sup>76</sup> *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305 (Fed. Cir. 1999) (stating that the claim preamble is not merely a statement of intended use but is intimately meshed with the ensuing claim language).

In fact, it is well established that “[t]he inventor of a machine is entitled to the benefit of all the uses to which it can be put, no matter whether he had conceived the idea of the use or not.”<sup>77</sup> More specifically, this means that a patent grants the right to exclude others from any use of that apparatus or composition, whether or not the patentee envisioned such use.<sup>78</sup> Patent protection does not limit the scope of protection solely to those uses recognized by the inventor prior to receiving a patent.<sup>79</sup>

Statements of intended use or asserted benefit will limit claims if they are clearly and unmistakably relied on to distinguish the patentable invention over the prior art.<sup>80</sup> In order not to be limiting, the statement must merely set forth the intended purpose of the invention using only relative terms that have no interpretive frame of reference.<sup>81</sup>

“The mere fact that a patentee finds something useful in a claim preamble in the patent litigation does not alone justify treatment of a claim preamble as a limitation.”<sup>82</sup> Without clear reliance on the claim preamble during prosecution, a claim preamble generally is not limiting when the claim body describes a structurally complete invention whereby deletion of the claim preamble phrase does not affect the structure or steps of the claimed invention.<sup>83</sup> Therefore, when the body of the claim sets forth a complete invention, and the claim preamble merely states a purpose or intended use of the invention, the claim preamble does not normally constitute a claim limitation.<sup>84</sup> Additionally, a claim preamble is not necessarily limiting if the

<sup>77</sup> *Roberts v. Ryer*, 91 U.S. 150, 157 (1875).

<sup>78</sup> *See* 35 U.S.C. § 271 (2000).

<sup>79</sup> *Id.*

<sup>80</sup> *See Pitney Bowes*, 182 F.3d at 1305 (finding a statement in the preamble is necessary to give life, meaning, and vitality to the claim because it “is not merely a statement describing the invention’s intended field of use. Instead, that statement is intimately meshed with the ensuing language in the claim.”); CHISUM, *supra* note 13, § 8.06(1)(d).

<sup>81</sup> *Allen Eng’g Corp. v. Bartell Indus., Inc.*, 299 F.3d 1336, 1347 (Fed. Cir. 2002) (finding that the phrase “fast steering” in a claim does not limit the claim because it is a “relative term” without an “interpretive frame of reference” and merely states the claimed inventions “intended purpose”); *Catalina Mktg. Int’l, Inc. v. Coolsavings.com, Inc.*, 289 F.3d 801, 809 (Fed. Cir. 2002).

<sup>82</sup> *Bristol-Myers Squibb Co. v. Immunex Corp.*, 86 F. Supp. 2d 447, 450 (D.N.J. 2000); *see also* *STX, Inc. v. Brine, Inc.*, 37 F. Supp. 2d 740, 752 (D. Md. 1999). The court stated that “[i]nspection of the entire record in this case, as set forth above, reveals that the claim preamble is not a structural limitation”. *STX*, 37 F. Supp. 2d at 752. The court took special note of the preamble of claim 1, “improved handling and playing characteristics,” to be a mere recitation of the use, function, purpose, and outcome of the open sidewall lacrosse head invention. *Id.* The court further noted that the body of claim 1 defined a structurally complete invention. *Id.* At best the phrase is a shorthand encapsulation of the *advantages* of the invention. *Id.*

<sup>83</sup> *IMS Tech., Inc. v. Haas Automation, Inc.*, 206 F.3d 1422, 1434 (Fed. Cir. 2000) (explaining that a claim preamble phrase “control apparatus” does not limit claim scope where it merely gives a name to the structurally complete invention); *STX, L.L.C. v. Brine, Inc.*, 211 F.3d 588, 591 (Fed. Cir. 2000) (holding that the body of claim which followed the claim preamble phrase, “which provides improved playing and handling characteristics,” was a self-contained description that could stand alone, with or without the preamble). The court further pointed to the fact that the patent examiner rejected the claim for obviousness even after the claim preamble language had been added. *STX*, 211 F.3d at 591. This suggests that the phrase was not essential in distinguishing it over the prior art, and was not decisive in securing allowance of the claim during prosecution. *Id.*; *Rowe v. Dror*, 112 F.3d 473, 478 (Fed. Cir. 1997); *Bristol-Myers Squibb Co.*, 86 F. Supp. 2d at 450; *see also* *Kropa v. Robie*, 187 F.2d 150, 152 (C.C.P.A. 1951).

<sup>84</sup> *Pitney Bowes*, 182 F.3d at 1305.

patentee's arguments during examinations and reexamination do not substantially rely on the claim preamble.<sup>85</sup>

A very useful method of gauging the impact of a claim preamble on the remainder of the claim is if a preamble must be used as a reference point for the rest of the claim.<sup>86</sup> If the elements of the claim and their interrelationship may be understood by one of ordinary skill in the art without having to refer back to the claim preamble, then no limitation exists.<sup>87</sup> The claim preamble is therefore not a limitation upon the finding that the claim preamble phrase need not be referenced to practice the invention set out in the body of the claim.<sup>88</sup>

Inclusion of an element into the claim preamble is not considered to be limiting when the element is worked on by the invention.<sup>89</sup> These "reference points [or] work pieces" are necessary to describe the invention, but are not essential to the patentability of the invention.<sup>90</sup> This principle is best illustrated with a hypothetical,

"[I]f one were to invent a new paper hole puncher, the claims would necessarily describe a location for positioning the paper, a punching die adapted to pierce the paper, and the like. But that would not make paper an element of the claim, such that one could freely knock off the hole puncher and sell it without liability for infringement as long as no actual piece of paper is packaged with the hole puncher."<sup>91</sup>

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"If the body of a patent claim fully and intrinsically sets forth the complete invention, including all of its limitations, and the claim preamble offers no distinct definition of any of the claimed invention's limitations, but rather merely states, for example, the purpose or intended use of the invention, then the preamble is of no significance to claim construction because it cannot be said to constitute or explain a claim limitation."

*Id.*; *Rowe*, 112 F.3d at 478; *cf.* *Corning Glass Works v. Sumitomo Elec. U.S., Inc.*, 868 F.2d 1251, 1257 (Fed. Cir. 1989); *Kropa*, 187 F.2d at 152.

<sup>85</sup> *See In re Cruciferous Sprout Litig.*, 301 F.3d 1343, 1347–48 (Fed. Cir. 2002) (holding that a patentee's argument during reexamination demonstrated "a clear reliance by the patentee on the preamble to persuade the . . . Patent Office that the claimed invention is not anticipated by the prior art. As such, the preamble is a limitation of the claims").

<sup>86</sup> *ADE Corp. v. KLA-Tencor Corp.*, 220 F. Supp. 2d 303, 310 (D. Del. 2002) (holding that if [o]nce having read the preamble, the reader's attention is never drawn back to it because the body of the claim does not need to be read in light of the preamble for one of ordinary skill in the art to understand the elements of the claim and how those elements are interrelated, no limitation exists).

<sup>87</sup> *ADE Corp.*, 220 F. Supp. at 308, 310.

<sup>88</sup> *Bristol-Myers*, 86 F. Supp. 2d at 451 (finding that the claim preamble phrase need not be referenced to practice the invention set out in the body of the claim as the objectives of toxicity reduction and tumor regression are not "intimately meshed with the ensuing language in the claim").

<sup>89</sup> *SDS USA, Inc. v. Ken Specialties, Inc.*, 107 F. Supp. 2d 574, 592–93 (D.N.J. 2000) (finding that in claims one and six of the patent at issue, "the ribbon stock functions as such a 'reference point,' or as [the patentee] calls it, a 'workpiece' of the apparatus defined by claims 1-6.").

<sup>90</sup> *Id.*

<sup>91</sup> *Id.*

## III. PROPOSAL

As long as the USPTO has been in existence, inventors, and the attorneys who represent them, have made great efforts to perfect the art of claim drafting.<sup>92</sup> Evidence of this ongoing process is found in the many questions surrounding how to precisely construct the claim's preamble. Several rules have been proposed, all of which were subsequently rejected or failed to gain wide-spread acceptance.<sup>93</sup> Making an already confusing situation worse, court rulings have produced an increasingly large number of quotable phrases that are haphazardly applied thereafter by other courts.<sup>94</sup> In this section, the heart of the problem is examined to reveal why the most obvious solution is the best, most efficient solution.

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<sup>92</sup> See *Topliff v. Topliff*, 145 U.S. 156, 171 (1892). The court found that:

The specification and claims of a patent, particularly if the invention be at all complicated, constitute one of the most difficult legal instruments to draw with accuracy, and in view of the fact that valuable inventions are often placed in the hands of inexperienced persons to prepare such specifications and claims, it is no matter of surprise that the latter frequently fail to describe with requisite certainty the exact invention of the patentee, and err either in claiming that which the patentee had not in fact invented, or in omitting some element which was a valuable or essential part of his actual invention.

*Id.*

<sup>93</sup> See, e.g., CHISUM, *supra* note 13, § 8.06(d)(i)(A). Also noting that post *Kropa v. Robie* decisions appear to take predictable positions on claim preamble interpretation depending on the type of proceeding. See *id.*

These decisions are best explained by emphasizing the difference between the scope of a claim for determining anticipation (lack of novelty) and infringement and matters which may be considered in determining the obviousness (Section 103) of a product that is literally new but resembles old products that were used for different purposes.

*Id.* "A preamble that is purely a statement of intended use does not constitute a limitation for the former purposes but can be considered for the latter purpose." *Id.*; Koch, *supra* note 4, at 119, 124–125 (2002). Developing a claim interpretation process that purported to be consistent with the conclusions of the courts in sixty-nine examples beginning with *Kropa v. Robie*. Koch, *supra* note 4, at 119, 124–125 (2002). "[T]he process implicitly looks to determine a clear statement in the claim preamble of the subject matter of the invention, and to disregard words which go beyond those needed to define that subject matter." *Id.* The process analyzed the effects court gave to how claim nouns are effected by general and specific introductory modifiers and posterior modifiers. *Id.*

<sup>94</sup> See *Catalina Mktg. Int'l v. Coolsavings.com, Inc.*, 289 F.3d 801, 808–09 (Fed. Cir. 2002). While no litmus test defines when a preamble limits claim scope, certain guideposts have been established. *Id.* First, *Jepson* claiming generally indicates intent to use the claim preamble to define the prior art, thereby limiting claim scope. *Id.* Second, dependence on a particular disputed claim preamble phrase for antecedent basis may limit claim scope because it indicates a reliance on both the claim preamble and claim body to define the claimed invention. *Id.* Third, when the claim preamble is essential to understand limitations or terms in the claim body, the claim preamble limits claim scope. *Id.* Fourth, when reciting additional structure or steps underscored as important by the specification, the claim preamble may operate as a claim limitation. *Id.* Fifth, clear reliance on the claim preamble during prosecution to distinguish the claimed invention from the prior art transforms the claim preamble into a claim limitation because such reliance indicates use of the claim preamble to define, in part, the claimed invention. *Id.* Sixth, claim preamble language merely extolling benefits or features of the claimed invention does not limit the claim scope without clear reliance on those benefits or features as patentably significant. *Id.* Seventh, claim preambles describing the use of an invention generally do not limit the claims because the patentability of apparatus or composition claims depends on the claimed structure, not on the use or purpose of that. *Id.*



In order to diminish the extensive confusion surrounding claim preambles, “one of the great mysteries of patent law,” we will not look at what a preamble should do, but what it should *not* do.<sup>95</sup> We must begin with the specification.<sup>96</sup> The specification is required to contain a written description of the invention, the manner and process of making and using the invention so as to enable a person skilled in the art able to make and use the invention, the best mode contemplated by the inventor to carry out his invention, and at least one claim.<sup>97</sup> A claim is defined as a “[f]ormal statement describing the novel features of an invention and defining the scope of the patent’s protection.”<sup>98</sup>

It is at this point where the function of a preamble used in the traditional legal context and the function of the claim preamble begin to diverge. Typically the traditional preamble is defined as an introduction to a statute or deed stating its purpose, aim, justification, basis, and objective.<sup>99</sup> In a patent situation, a claim preamble does not function in a similar manner. While it undeniably functions as an introduction to the rest of the claim, the function of the claim is limited in scope and, therefore, so is the function of the preamble.<sup>100</sup> The purpose, aim, justification, basis and objective of the invention are properly contained elsewhere in the specification, *not* in the claim.<sup>101</sup>

Viewing a claim as but a part of the specification clarifies the intended scope of the claim. The claim, and hence the preamble, *should not* contain a description of the invention. That requirement is met elsewhere in the specification.<sup>102</sup> The claim *should not* disclose the manner and process of making and using the invention to one skilled in the art. That requirement is also met elsewhere in the specification.<sup>103</sup> The claim *should not* reveal the best mode contemplated by the inventor. That requirement is, again, met elsewhere in the specification.<sup>104</sup> The claim *should* point out for protection only those novel features of the invention.<sup>105</sup>

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<sup>95</sup> Charles L. Gholz, *A Critique of Recent Opinions in Patent Interferences*, 85 J. PAT. & TRADEMARK OFF. SOC’Y 401, 409 (2003). “Whether or not a preamble has substantive impact on the interpretation of a claim has long been one of the great mysteries of patent law.” *Id.*

<sup>96</sup> See 35 U.S.C. § 112 (2000).

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

*Id.*

<sup>97</sup> *Id.*

<sup>98</sup> BLACK’S LAW DICTIONARY 241 (7th ed. 2000). “The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.” 35 U.S.C. § 112 (2000).

<sup>99</sup> BLACK’S LAW DICTIONARY 1194 (7th ed. 2000); THE NEW OXFORD AMERICAN DICTIONARY 1340 (2001 ed.).

<sup>100</sup> See 35 U.S.C. § 112 (2000).

<sup>101</sup> See *id.*

<sup>102</sup> See *id.*

<sup>103</sup> See *id.*

<sup>104</sup> *Id.*

<sup>105</sup> *Id.*

Influenced by the traditional preamble's role, some courts have erroneously applied the traditional definition of a preamble to claim preambles.<sup>106</sup> This has no doubt contributed to the confusion over the proper role of a claim preamble. Indeed, it is the role of the specification, not the claim preamble, to shed light on the claim terms, to describe how to make and use the invention, and to disclose the best mode contemplated for its use.<sup>107</sup> None of this is within the purview of the claim or its preamble.<sup>108</sup>

Once the practitioner comes to understand the claim's narrow role within a specification, so to will he understand the preamble's role within the claim. Although a claim is sometimes referred to as having three sections, the claim as a whole has one unified goal: to define the invention in order to protect it.<sup>109</sup> The claim preamble is inseparable from the rest of the claim, and should not be independently construed or, for that matter, drafted. Only the claim as a whole may be examined for limiting content.<sup>110</sup> Simply put, construing the claim preamble "presents no deeper mystery than the broader task of claim construction, of which it is but a part."<sup>111</sup> The reviewing court must "construe the preamble and the remainder of the claim . . . as one unified and internally consistent recitation of the claimed invention" wherein the claim as a whole should be construed consistent with those basic principles of claim construction.<sup>112</sup> We must resist the temptation to overcomplicate an otherwise simple fact.<sup>113</sup> The claim preamble is a part of a claim whose purpose is to highlight what is novel and patentable in an invention.<sup>114</sup> Preambles are typically found not to be limiting simply because they are written that way, not because they are

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<sup>106</sup> See CHISUM, *supra* note 13, § 8.06(1)(b)(i). Based on many court decisions, Chisum defines definitions a claim preamble as "an introductory phrase that may summarize the invention, its relation to the prior art, or its intended use or properties." *Id.*

<sup>107</sup> 35 U.S.C. § 112 (2000).

<sup>108</sup> See *id.* Evidence that the claim is not intended to contain more than the novel features of an invention can be found in the scope of an invention's protection. *Id.* The inventor is entitled to the benefit of all uses to which his invention may be put, regardless of whether he conceived of the idea or use at the time. *Roberts v. Ryer*, 91 U.S. 150, 157 (1875). It is only consistent with such protection for a claim, which states the patentable attributes of an invention, to disclose only those novelty elements of an invention and leave the description and explanation of those elements for elsewhere in the specification.

<sup>109</sup> *Bristol-Myers Squibb Co. v. Immunex Corp.*, 86 F. Supp. 2d 447, 451 (D.N.J. 2000). "A patent claim is normally divided into three sections: (1) the preamble; (2) the transition; and, (3) the body." *Id.*; see also *STX, Inc. v. Brine, Inc.*, 37 F. Supp. 2d 740, 752 (D. Md. 1999); 35 U.S.C. § 112 (2000).

<sup>110</sup> *In re Neugebauer*, 330 F.2d 353, 356 n.4 (C.C.P.A. 1964). "The claims as a whole must be analyzed in light of the disclosure to see if the article defined thereby is distinguishable in fact . . . over the prior art." *Id.*

<sup>111</sup> *Bell Commc'ns Research v. Vitalink Commc'ns Corp.*, 55 F.3d 615, 621 (Fed. Cir. 1995).

<sup>112</sup> *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1306 (Fed. Cir. 1999); see *United States v. Adams*, 383 U.S. 39, 48-49 (1966) (en banc) (stating that the two basic principles of claim construction are: (1) the language of the claims determines their scope of protection; and (2) claims are construed in light of their specification).

<sup>113</sup> But see Stephen P. Koch, *Recent Developments in Patent Law*, 11 TEX. INTELL. PROP. L.J. 117, 118-19 (2002). After quoting case law stating that claims should only be viewed as one unified and internally consistent recitation of the claimed invention those cases same cases were criticized for failing to "provide specific, well-supported guidance on the approach courts and patent holders should take in determining claim preamble significance vis-a-vis the remainder of the claim." *Id.*

<sup>114</sup> See 35 U.S.C. § 112 (2000).

statutorily insignificant. The claim preamble should not be viewed as separable from the rest of the claim and hence its function cannot exceed the function of the claim.

Viewing the claim preamble as a part of a unified claim is consistent with both case law as well as scholarly comment, while eliminating much of the confusion. The ways in which case law will be affected, coupled with the reasons why this approach should be adopted, demonstrates the advantages of such an approach.

In general, the claim preamble, as part of a claim, is intended to contain only the novel and patentable attributes of an invention.<sup>115</sup> There is no advantage to adding material that describes more than those essential features of the invention. Even if the preamble is not construed to be limiting, it may affect the interpretation of the claim in unknown ways and is therefore properly housed in the remainder of the specification. The purpose of a claim is to highlight the patentable features of an invention, not to tell a comprehensive story of the invention.<sup>116</sup> It is important not to confuse the role of the claim (to disclose the novel attributes of an invention) with the remainder of the specification (to explain those novel attributes of an invention). Words that are not essential to disclose the novel attributes of the invention have no place in a claim. Each word contained in a claim preamble may become a claim limitation, whether intentionally or unintentionally, that a patentee may easily avoid by omitting it from the claim preamble.<sup>117</sup>

In many situations, this approach will not fundamentally alter the impact a claim preamble has on the remainder of a claim. Many claim preambles are already so generic and ambiguously written that they are incapable of adding anything to the claim.<sup>118</sup> In these situations the claim preamble is a preface to the remainder of the claim, and is not worthy of any consideration, no matter how the claim is interpreted, because only limiting language may be given effect.<sup>119</sup>

While many claims make no attempt to utilize the claim preamble, there may be a potential benefit in doing so. If the claim preamble is utilized as an inseparable element of a claim, it may prove to be a more valuable asset to a well written claim than most realize. The fact that a preamble can have a limiting effect on the scope of a claim should not be a surprise because that is the express purpose of the claim.<sup>120</sup> Remember, phrases that help define the invention will be given weight regardless of

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<sup>115</sup> See *id.* The exception to this rule is the *Jepson* claim. See *supra* note 32 and accompanying text.

<sup>116</sup> See 35 U.S.C. § 112 (2000).

<sup>117</sup> *Id.*

<sup>118</sup> *Rowe v. Dror*, 112 F.3d 473, 478 (Fed. Cir. 1997) (stating that language that offers no distinct definition of any of the defined claim limitations cannot be held to constitute or explain a claim limitation).

<sup>119</sup> *Kropa v. Robie*, 187 F.2d 150, 152 (C.C.P.A. 1951); *cf. Rowe*, 112 F.3d at 478 (stating that language that offers no distinct definition of any of the defined claim limitations cannot be held to constitute or explain a claim limitation); *Biacore, AB v. Thermo Bioanalysis Corp.*, 79 F. Supp. 2d 422, 457 (D. Del. 1999) (finding that when the claim preamble offers no definition of any of the claimed invention's limitations the claim preamble is of no significance); *Boehringer Ingelheim Animal Health v. Schering-Plough Corp.*, 984 F. Supp. 239, 247–48 (D.N.J. 1997) (finding that the claim claim preamble constituted "an integral part of the process which cannot be separated" from the remainder of the patent).

<sup>120</sup> See 35 U.S.C. § 112 (2000).

where they appear in the claim.<sup>121</sup> It is an incontrovertible fact that a claim must contain limitations. What difference does it make if those limitations are located in the claim preamble as long as they are placed there as carefully as limitations elsewhere in the claim?

The realization that the preamble may be limiting should be closely followed by the recognition that this power may be harnessed to construct a better claim. A claim preamble can concisely place an invention into its proper context more efficiently than the body of the claim. The claim preamble is also capable of quickly guiding the claim interpreter to the proper field of invention while laying out some basic parameters of the invention.<sup>122</sup> This is best accomplished by the claim preamble because it contains the first words of a claim to be read.

Because the claim preamble can lead to a more concise claim, it will improve the overall efficiency of the patent process. Every practitioner must fully appreciate the impact a claim preamble has on the path his patent application will take through the USPTO. The USPTO assigns an application to a particular Examining Art Unit for review and action, often based on the claim preamble.<sup>123</sup> Because of this immediate impact on the examination of the patent, the claim preamble should carefully describe the invention. In doing so, the patentee can rely on the claim preamble to aid the examiner in classifying and assigning a newly filed application to the correct Examining Art Unit.<sup>124</sup>

In striving to construct a clear and concise claim, a practitioner would be wise to fully embrace every tool at his disposal. As long as he constructs his claims as a cohesive whole, there is no compelling reason to reflexively dismiss the preamble as a liability because it may easily become an asset.

#### IV. CONCLUSION

The goal of every practitioner should be to provide the inventor with a patent that protects the inventor's idea while subjecting him to as little undesirable litigation as possible. Practitioners must look beyond the patent prosecution process when writing a claim, and they must take into account possible interference or infringement litigation involving the claim. Merely believing that a claim is defensible in court should not be the goal. A patent claim must be drafted in such a way that these actions are rarely brought to court, thereby preventing the inventor from having to commit resources to litigation.

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<sup>121</sup> *In re Stencel*, 828 F.2d 751, 754 (Fed. Cir. 1987) (stating that the existence of a limitation is a matter to be determined on the facts of each case in view of the claimed invention as a whole); *see, e.g.,* *Loctite Corp. v. Ultraseal Ltd.*, 781 F.2d 861, 866 (Fed. Cir. 1985) (stating that while the term "anaerobic" appears in the preamble of the patent's claims, the term "anaerobic" breathes life and meaning into the claims and, hence, is a necessary limitation to them).

<sup>122</sup> MARTIN J. ADELMAN ET AL., *CASES AND MATERIALS ON PATENT LAW* 534 (2d ed. 2003) ("The preamble generally sets out the category of invention, i.e., apparatus, method of making, method of using, or composition."); ROBERT C. FABER, *LANDIS ON MECHANICS OF PATENT CLAIM DRAFTING* § 2:4, at 2-4 (5th ed. 2003).

<sup>123</sup> FABER, *supra* note 122, at 2-8.

<sup>124</sup> *Id.*

One critical step toward this ideal patent is writing a competent claim preamble. Claim preambles, like claims in general, should be written so that there is no room for interpretation contrary to the patentee's intentions. In order to accomplish this, a practitioner must view the claim preamble not as an independent part of the claim but as an integral part of the claim. Claim preambles written with the entire claim in mind will be of superior clarity and functionality. Additionally, such an approach to writing claim preambles will make claim interpretation easier for others. This will expedite the patent applicant's travels through the USPTO, reduce the risk of future infringement or interference litigation, and minimize the amount of resources the inventor must expend in order to protect and enforce the patent.