

Invention Analysis and Claiming, A Patent Lawyer's Guide

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Effective patent claim drafting attempts to balance discrete disclosure of all elements comprising the invention against broad claiming that anticipates future improvements and provides the inventor with the most protection allowable in light of the prior art. The intended result is a “claim suite” that complies with the disclosure requirements of the patent statute¹ without defining the invention with such specificity that a competitor will be able to avoid literal infringement through minor changes to the inventor’s embodiment. In *Invention Analysis and Claiming*, Ronald Slusky brings a problem-solution approach to patent claim drafting that involves characterizing the invention by defining the abstract problem being solved rather than claiming the concrete embodiment the inventor has used to solve it.² The author transitions between step-by-step instruction and the use of simple examples from existing patents to construct a framework that allows the drafter to claim an invention in the broadest way possible while still capturing the inventive elements that distinguish it over the prior art.

Slusky emphasizes the importance of conceptualizing the invention in terms of the problem being solved and proceeds on the thesis that broad yet enforceable claims can be drafted relatively easily once the inventive concept is captured in the form of a problem-solution

¹ The Patent Act, 35 U.S.C. §112 (requiring that the patent application possess one or more claims particularly pointing out and distinctly claiming the subject matter that the applicant regards as his invention).

² RONALD D. SLUSKY, *INVENTION ANALYSIS AND CLAIMING* 11 (American Bar Association 2007).

statement.³ Claim drafting in this manner is particularly valuable in light of the rules of patent prosecution which generally do not limit the breadth of claims to the particular embodiments shown in the figures, or otherwise read limitations from the other parts of the application into the claims.⁴ Instead, the claims stand alone and define the invention.⁵ Working with the inventor to identify his solution to a particular problem allows the claim drafter to largely ignore the structure of the invention and stake out a parcel of intellectual property that encompasses after-arising embodiments that solve the same problem.

The text makes excellent use of actual claims from simple inventions to illustrate the importance of identifying the often elusive inventive concept. Examples include John Loud's ballpoint pen⁶ and the Konaclip paper clip.⁷ Both inventions possess inventive concepts that stray considerably from the physical embodiment in which they were brought to market. The author uses these simple devices, and the patent applications that failed in providing their inventors with effective protection against future competitors, to illustrate the danger in analyzing the embodiment over the problem.

In implementing his problem-solution approach, Slusky begins by guiding the reader through the inventor interview, during which the inventor and attorney can work together to complete the problem solution analysis and draft a problem solution statement. The author warns of the inventor's tendency to narrowly conceptualize the solution and emphasizes the duty of the patent attorney to challenge his client to broadly define his contribution to the art. To this end, specific techniques are advanced to avoid the potential pitfalls of attorney-inventor

³ *Id.* at 19.

⁴ MANUAL OF PATENT EXAMINING PROCEDURE, §608.01(k) (8th ed., rev. 4, October 2005) (stating that the claim is the definition of that for which protection is granted).

⁵ *Warner-Jenkinson Co., Inc. v. Hilton Davis Chemical Co.*, 117 S. Ct. 1040, 1051 (1999).

⁶ U.S. Patent No. 392,046 (issued Oct. 30, 1888).

⁷ U.S. Patent No. 648,841 (issued May 1, 1900).

collaboration as well as methods of distilling the problem solution statement to a broad yet functional form in an effort to “see” the invention before claim drafting begins.

Once the problem solution statement has been drafted, it may be used as the basis for drafting the broadest claims of the application. The author thoroughly explains the process of “stitching” the problem-solution statement into claim form. Examples of technique are interspersed throughout the chapters, with several claim types being touched upon.

The reasons for employing different claim types are also very well explained throughout the discussion of claim drafting. By providing examples of claims of different types, all of which capture the inventive concept of the underlying invention, the author very effectively illustrates the multi-faceted nature of effective claim drafting. Each example claim or set of claims is explained in light of its breadth of protection as well as the strategic purposes it could serve in the context of litigation. Through this layered approach, a distinction between the seemingly equivalent goals of patentability and enforceability becomes apparent to the reader.

After describing the process leading up to effective claim drafting, the author guides the reader through preparing and prosecuting the patent application. While a discussion of patent prosecution seems outside the scope of inventive analysis and claim drafting introduced in earlier chapters, it is limited to the role of the problem-solution paradigm in making decisions relative to prosecuting the patent application. Again, the author provides examples of the “right approach” and the “wrong approach” to drafting the other sections of the application. He clearly articulates the discrete purpose of each section of the application, while bearing in mind the drafter’s need to comply with the disclosure requirements of the patent statute.⁸ Keeping the goal of broad

⁸ 35 U.S.C. § 112 (requiring that the specification contain a “written description of the invention, and 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...to make and use the same, and shall set forth the best mode contemplated by the inventor in carrying out his invention).

problem-solution claiming in mind, the reader is instructed where and how to reveal inventive details so as to avoid having them limit an analysis of the invention that may occur in unforeseen litigation.

Finally, the appendices include a series of inventive concepts and their corresponding problem solution statements and claims as well as a drafting exercise that guides the reader through the process of invention analysis. This provides a review of the topics addressed throughout the text and gives the reader an opportunity to apply them. Also included are a collection of selected statutes and regulations applicable to patent drafting as well as a brief glossary of terms which may be unfamiliar to the lay reader.

The book devotes substantial attention to the early stages of inventive analysis and presents a logical progression from broad claim conception to narrowly tailored construction of specific claim elements. While a pleasantly written and coherently presented tutorial, the text would also make a valuable reference for the practitioner seeking insight into a specific area of invention analysis or claim drafting. Of particular value to the experienced practitioner would be the author's extensive discussion of working with the inventor, which offers insight into effective human interaction that transcends the area of law to which the book pertains.

In view of proposed changes to the patent statute⁹ and the increased number of patent disputes being litigated in the Supreme Court in recent years¹⁰, it would be logical to assume that a patent drafting handbook would become quickly dated and irrelevant. However, while *Invention Analysis and Claiming* contains information about drafting and prosecuting the patent

⁹ Patent Reform Act of 2007, S. 1145, 110th Cong. (2007) (changes include proposing a "first-to-file" system, limitations on number of claims and re-examination procedures, as well as alterations to post-grant opposition proceedings and damages).

¹⁰ Supreme Court of The United States Blog, *Patent Cases Before The Supreme Court*; <http://www.scotusblog.com/wp/commentary-and-analysis/patent-cases-before-the-supreme-court/> (last visited Nov. 13, 2007) (stating that, after averaging little over one intellectual property case per term since 1982, the Supreme Court has taken nine patent cases since 1999, and three in the current term).

application under the current rules, the overarching theme is more general and instructs the reader on conceptualizing the invention, rather than attempting to provide a handbook for drafting patent applications. As a result, the problem-solution based lessons contained within the text will remain valuable to the patent attorney seeking to provide the broadest allowable protection to his client, regardless of the rules of patent examining procedure under which he is operating.

Despite the technical nature of the subject matter, *Invention Analysis and Claiming* provides a simple framework for approaching patent claim drafting that is accessible to readers across a broad spectrum of expertise and applicable to inventions in various fields of endeavor. However, given the skills driven approach of the author, the text would be best suited to an audience having some prior patent drafting experience and education. The book is highly effective because the author challenges the reader to reconsider the notion of invention and precisely illustrates the correlation between distilling the invention down to its fundamental inventive concept and effective patent claim drafting.