

Invention Analysis and Claiming: The Summary of the Invention ¹

By Ronald Slusky

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There are two main schools of thought about the patent specification's Summary of the Invention.

Many attorneys believe in the "claim-restatement" type of Summary. This is a substantially verbatim reprise of the broadest, and perhaps other, claims, with only minor changes, such as changing "said" to "the." Others use the "story-telling" type of Summary, which presents the invention in narrative form, thereby continuing the problem-solution story that was begun in the Background.

The author is in the latter school, as this column explains.

The Effective Specification

Let's first talk about the specification as a whole.

An effective patent specification speaks to an audience extending far beyond the person skilled in the art. Indeed, although we often say that the audience for the specification is the person skilled in the art, there is no such real-life reader. The person skilled in the art is only a legal construct defining a standard for the specification's required level of detail.

The specification's real-life audience is multi-faceted, comprising the patent examiner, the Opposing Team,² and possibly a judge and jury. When written with this wider audience in mind, the specification can further the interests of the patent owner in ways that a specification that is merely "enabling" may not. Such a specification can facilitate allowance in the PTO, make the patent easier to license, and provide an effective platform from which a litigator can argue the merits of the invention to the judge and jury.

In one sense, everything ultimately does come down to the claims. For example, the examiner is principally focused on ensuring that the claims do not read on the prior art. However, allowance of the claims is helped along when the examiner understands what the invention is and is convinced that there is inventive subject matter to be claimed. The specification is the place to convince him of that.

The Opposing Team is also focused on the claims. They want to know whether or not the claims read on their product. But even if the claims do read on the Opposing Team's product, they will resist taking a license, or acceding to a demand to "cease and desist," unless convinced that their product takes advantage of something novel/non-obvious taught by the patentee. The patent owner would like the Opposing Team to lay down their arms with as little fuss as possible. They will certainly not do so if they feel they are being asked to pay something for nothing. The specification is a place to convince the Opposing Team that they are *not* being asked to pay something for nothing.

Judges and juries must decide if the claims are valid and infringed. But before they award millions of dollars to the patent owner, judges and juries want to believe that justice is being done—that the essence of the invention has actually been appropriated by the accused infringer. They are therefore likely to look to the specification to be assured that justice *is* being done. Patent claims are a mystery to most non-patent professionals—a seemingly impenetrable morass of "said's" and "means for." The specification should be written in a way that judges and juries will at least try to read and understand it. Indeed, a jury convinced that the inventive essence has been appropriated may return a finding of infringement even if the claims somewhat miss the mark.

A specification that achieves all of this is more than just a compendium of technical facts. It tells a story. It is a story of a problem, and of a solution made possible by the patentee's recognition of something that eluded others in the field.

The Summary

This brings us to the Summary of the Invention.

Proponents of the claim-restatement type of Summary have litigation in mind. It is felt that a court may deem one or more embodiment details essential to the invention because they are mentioned in the Summary.³ The patented subject matter may then be interpreted as being limited by those details, even when the claims don't recite them, creating a loophole for the accused infringer. This is all avoided if the Summary exactly mimics the claims.

Unfortunately, the claim-restatement type of Summary usually leaves the reader in the dark as to what the invention is, as in the following:

Summary of the Invention

In accordance with the invention, the problem of damage to the plastic of the worm gear is avoided by forming the longitudinal connector as one piece with the worm gear itself.

The advantage of the claim-restatement type of Summary is, moreover, largely theoretical. Only a tiny percentage of patents are ever involved in litigation. Even a smaller number are subjected to a claim-narrowing interpretation based on language in the Summary.

Furthermore, although claims are usually amended during prosecution, practitioners rarely amend the Summary, and so the Summary in the issued patent typically does not jibe with the issued claims anyway.⁴

By contrast, a much larger percentage of patents are the subject of licensing negotiations. A Summary that effectively explains what the invention is goes a long way toward showing the would-be licensee that he is not being asked to pay something for nothing. It helps smooth the way toward a successful deal-closing, particularly if a business executive is involved in the negotiations. A story-telling Summary is something he can understand. "Are we doing this?" he may ask his people, "And, if so, why are we fighting this?"

A patent whose Summary makes the invention clear is less likely to get into litigation because the Opposing Team is more likely to agree (at least among themselves) that their product implements the inventor's teachings. They are also more likely to conclude that the judge and jury will see it that way as well.

This is not to negate the concern that informs some practitioners' preference for a claim-restatement type of Summary. We certainly do not want claimed subject matter to be limited by embodiment details contained in the Summary but not contained in the claim being asserted. But the claim-restatement type of Summary throws out the baby with the bath water. One gives up a lot by forgoing the advantages that flow from a well-thought-out story-telling type of Summary to address a speculative and infrequent litigation contingency.

It is possible, in any event, to address that contingency and still employ the story-telling type of Summary by writing the Summary carefully and thoughtfully, observing such guidelines as:

- State the inventive solution in one sentence (as in the example above)
- Use the word "invention" ever so carefully
- Present the solution functionally
- Designate optional features as such

These guidelines will be discussed in detail in a future column. But the next two months' columns, styled *Reaching for Breadth*, return us to claiming practice, offering some approaches to analyzing the inventor's embodiment(s) to identify the broad inventive concept.

Endnotes

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² The Opposing Team is a metaphor used by the author to refer to potential infringers and their patent attorneys. See last month's column in *Intellectual Property Today*.

³ See, e.g., *Hoffer v. Microsoft Corp.*, 405 F.3d 1326, 1329, 74 USPQ2d 1481, 1483 (Fed. Cir. 2005).

⁴ The author thanks colleague Peter Priest for pointing this out.