

INVENTION ANALYSIS AND CLAIMING: The Summary of the Invention PART III¹



BY RONALD SLUSKY

Ronald Slusky mentored dozens of attorneys in “old school” invention analysis and claiming principles over a 31-year career at Bell Laboratories. He is now in private practice in New York City. This article is adapted from his 2007 book *“Invention Analysis and Claiming: A Patent Lawyer’s Guide.”* Ron’s two-day seminar based on the book will be given **this month in Chicago and Boston**, followed by Santa Clara, Philadelphia, Washington D.C., Dallas and New York. See www.sluskyseminars.com. Ron can be reached at 212-246-4546 and rdslusky@verizon.net.

Previous columns² explained my preference for a “story-telling” type of Summary of the Invention, which presents the invention in narrative form, thereby continuing the problem-solution story that was begun in the Background.

A Summary that effectively explains what the invention is, and why it is advantageous, goes a long way toward showing the would-be licensee that he is not being asked to pay something for nothing. Moreover, a patent whose Summary makes the invention clear is less likely to get into litigation because the Opposing Team³ 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.

The previous columns also presented some prescriptions for composing the Summary in a way that minimizes the possibility that a court will import details from the Summary into the patent’s broadest claims—something that has, in fact, happened.⁴ Among those prescriptions . . .

- State the inventive solution in one sentence;
- Present the solution functionally;
- Use the word “invention” only when referring to the broad inventive concept;
- Designate optional features as such.

THE INVERTED PYRAMID

This month’s column presents an advantageous way of formatting the Summary to implement the above prescriptions—the so-called “inverted pyramid.”

The “inverted pyramid” format is ubiquitous in newspaper stories. The first sentence of the story presents its essential kernel. Important details appear in the next few paragraphs. Quotes, fill-in information and less important details come after that. Very little that is unimportant appears ahead of anything more important. Here is an example of such a newspaper story:

FREEDONIA, May 2 — An earthquake of monumental proportions struck this island nation today, killing hundreds of people and injuring thousands more. Property damage was estimated at \$250 million.

The quake, which began at 5 A.M. AST, measured 8.5 on the Richter scale. It was the second major earthquake to strike this island nation in five years.

The previous quake measured 7.6. Since the Richter scale is logarithmic, today’s event was considerably more powerful.

“We have barely recovered from the last earthquake,” Prime Minister Quincy Adams Wagstaff said at a press conference shortly after, “and now this.”

Note how the story could be pruned paragraph-by-paragraph from the end and would still make sense. This is because the paragraphs are self-contained, convey the most important information first, and leave less important details for later.

The Summary in a patent specification should be similarly constructed. Only what is essential to defining the invention appears in the one-sentence solution. This

should be followed by the most important details—the important fallback features, advantageous contexts in which the invention may be implemented, and so forth. Further details, such as less-important fallback features, come after that.

The following is a Summary for the invention of the chair leg following the inverted pyramid format. The assumed prior art is a) two rocks piled on top of one another, and b) a felled tree laid across two rock supports, leaving unsolved the problem of how to construct a seating device that is portable.

SUMMARY

In accordance with the invention, the portability of seating devices is enhanced by utilizing one or more elongated members as the support structure for the seat. Such a support member can hold up a large load relative to its own weight when compressed along its longitudinal axis, thereby achieving a significant reduction in weight when compared to prior art seating devices. Such a seating device is referred to herein as a “chair” and the elongated support members as “legs.”

The chair can have any desired number of legs. Three or four legs have proven to be the most advantageous, however.

In particular embodiments of the invention, the legs may be perpendicular to the seat and may be attached near the seat edge. Also in particular embodiments, the seat is substantially rectilinear and has four legs attached at the corners. Each of these details provides particular advantages and can be implemented independently of the others.

The legs can be made from any desired material. Indeed, they can be integral with a chair carved from stone, resulting in a seating device that is much lighter than those having solid-stone support structures as in the prior art. Particular embodiments of the invention may, however, advantageously, use wood for at least the support members.

The legs can be friction-fit into recesses formed in the underside of the seat. If desired, however, greater structural integrity for the chair as a whole can be achieved by securing the legs in the recesses with an adhesive material.

Any news story always omits some details because they are not significant enough to report. So too when constructing a Summary, there always comes a point where further embodiment details—even

if included in one or more of the narrower claims—are not sufficiently important to be highlighted in the Summary. The dividing line is arbitrary. There is no particular harm in going “too far” as long as it is made clear that such details are merely illustrative or optional. A useful test is to ask whether a particular detail would be helpful to the first-time reader in understanding the invention or how it can be advantageously implemented.

The effectiveness of the inverted pyramid technique in presenting the most important details first can be further appreciated by comparing the earthquake story above with the following alternative version in which

the inverted pyramid format is violated in the extreme:

FREEDONIA, May 2 — Freedonia Prime Minister Quincy Adams Wagstaff called a press conference at 8 A.M. AST this morning to comment on this island nation’s latest travail. Mr. Wagstaff reminded the assembled journalists, who were on-island for a conference, that some five years ago Freedonia was hit by an earthquake measuring 7.6 on the Richter scale. It was only within the last several months, he pointed out, that all damage from that quake had been repaired and all services restored.

It was against that backdrop that Mr. Wagstaff announced that this

latest incident brought thousands of people to the hospital, and caused at least \$250 million in damage. Hundreds more were killed when, at 5 A.M. AST, Freedonia was hit with another earthquake, measuring 8.5.

ENDNOTES

1. Copyright © 2007, 2009 American Bar Association. Adapted with Permission. All Rights Reserved.
2. *Intellectual Property Today*, November, 2007, April, 2008.
3. The Opposing Team is a metaphor used by the author to refer to potential infringers and their patent attorneys. See *Intellectual Property Today*, October, 2007.
4. See, e.g., *Hoffer v. Microsoft Corp.*, 405 F.3d 1326, 1329, 74 USPQ2d 1481, 1483 (Fed. Cir. 2005).

FILLER

BOX = 7.5"W x 6.75"H